

PART II — SUBSISTENCE OF COPYRIGHT

I *Threshold Requirements*

A *Introduction*

In Australia, copyright subsists by operation of the *Copyright Act 1968* (Cth) (*'Copyright Act'*). Several threshold requirements must be satisfied before an expression will receive copyright protection under the Act:

- **Recognition**
The expression must be classified as a 'work' or 'subject matter other than a work', which categories define the taxonomy and boundaries of matters afforded copyright protection;
- **Geographical nexus**
There must be some connection between the expression and Australia; this may be because it was first published there, or in the case of an unpublished work, because of the author's identity, or because of a reciprocal arrangement at international law with authors of another nationality;
- **Qualification**
The author must be a qualified person; that is, an Australian citizen or a citizen of a country with which a reciprocal arrangement exists;
- **Authorship**
The expression must be the traceable product of human endeavour, and must specifically be authored (or deemed to be authored) by the person claiming protection;
- **Originality**
The expression must be original, meaning simply that it must originate from its author, and its creation must reflect some industry or initiative on the part of that author; and
- **Subject-specific requirements**
Requirements specific to the matter being protected must be complied with, such as the requirements for works that they be substantial and they be reduced to a material form.

Collectively, these requirements comprise what may be termed threshold criteria for protection. If they are not satisfied by an expression, copyright will not subsist in that expression. They are necessary (but sometimes insufficient) preconditions for protection.

Because different threshold requirements apply to works and subject matter, it is necessary to discuss their subsistence separate. This analysis therefore proceeds by examining the first three threshold criteria in relation to works and subject matter other than works. It then discusses — in sections II and III — the threshold requirements that apply to works, before turning to consider — in section IV — those requirements insofar as they apply to subject matter other than works.

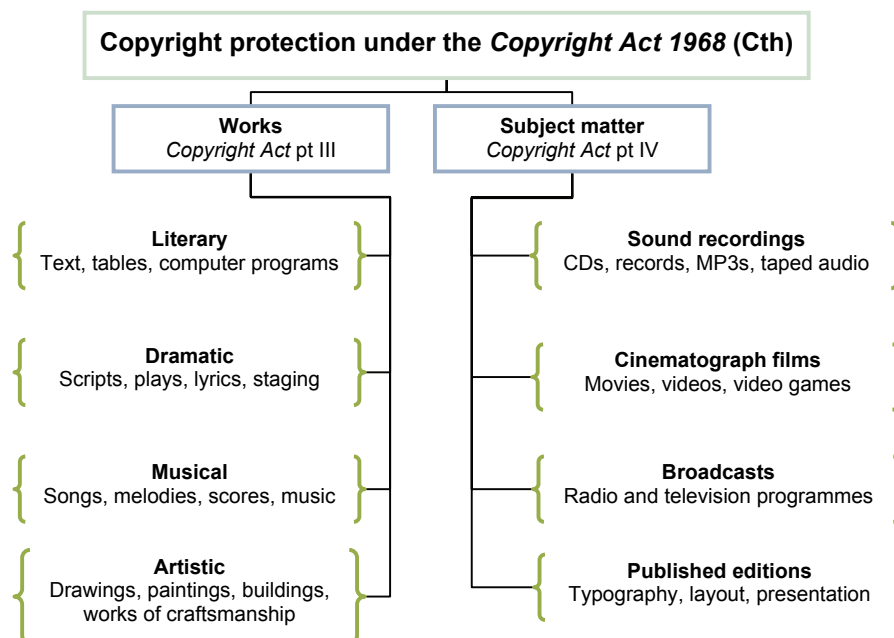
Having identified the matters in which copyright may subsist under the Act, this Part then considers — below in section V — the content of those copyrights.

B Recognition

Rather than extend broad protection by reference to general principles, the *Copyright Act* creates discrete pockets of specific copyright protection in particular, exhaustively defined fields. This is reflective of a preference — present throughout the Act — for specific, particularised provisions rather than the creation of overarching norms. (This theme is most evident in the context of recent reforms to copyright infringement exceptions, revisited below.)

1 Part III works and Part IV subject matter

To receive protection, then, an expression must fall within one of the discrete categories enumerated in the *Copyright Act*. The top-level copyright taxonomy comprises two forms of expressions:



Part III is concerned with the protection of ‘works’. Works typically encompass the creative expressions of authors.

Part IV is concerned with expressions that do not fall within Part III but which are nevertheless eligible for copyright protection. It is therefore given the unimaginative and misleading title of ‘subject matter other than works’ — unimaginative because of its soporific and circumlocutory qualities and misleading because many of its contents are also protected as works.

Part IV expressions are generally entrepreneurial in nature, held by producers or publishers rather than authors. Because of this distinction, pt IV expressions do not require a human author, whereas pt III works do: *Copyright Act* ss 32(4), 84.

The reason for distinguishing between pt III and pt IV copyright protection relates to the scope and content of their respective monopolies. Put simply, pt IV copyrights encompass different, narrower exclusive rights than pt III copyrights.

2 Differences between pt III and pt IV protection

Exclusive rights under pt III are broad: they encompass non-literal reproductions and confer expansive controls upon publication and distribution. Part IV rights are narrower; they do not extend to non-literal infringement, and confer exclusive rights with respect to fewer dealings. That is, pt IV copyrights can only be literally infringed — the actual copying of a physical point, pixel, frame or sample from the copyright work.

The differences between pt III and pt IV protection are explored further in the context of infringement.¹

3 Overlap between pt III and pt IV protection

A given expression can give rise to both pt III and pt IV copyrights. The fact that protection is received under one Part will not preclude protection under the other. In fact, those protections are completely independent and do not affect one another:

Copyright Act 1968 (Cth) s 113 — Copyrights to subsist independently:

- (1) ... where copyright subsists in any subject-matter by virtue of [Part IV], nothing in [Part IV] shall be taken to affect the operation of Part III in relation to any literary, dramatic, musical or artistic work from which that subject-matter is wholly or partly derived, and any copyright subsisting by virtue of [Part IV] is in addition to, and independent of, any copyright subsisting by virtue of Part III.
- (2) The subsistence of copyright under any provision of [Part IV] does not affect the operation of any other provision of [Part IV] under which copyright can subsist.

What s 113 means is that a pt III work can still exist within a pt IV subject matter, and vice versa. Indeed, pt IV subject matters will routinely encompass multiple pt III works. Several examples follow:

- A cinematograph film (pt IV subject matter) might comprise a screenplay (literary work);
- Such a film might encompass a music soundtrack (musical or perhaps dramatic work);
- The musical work comprising the soundtrack might in turn comprise lyrics (a literary or perhaps dramatic work);
- The soundtrack might also be a sound recording (pt IV subject matter)
- The film might further contain credits (a literary work); and
- The film might contain animated sequences or illustrated images, which would be artistic works (a pt III work).

These examples provide some sense of the many and varied interactions between pt III and pt IV copyrights. In essence, the categorisation is neither prescriptive nor mutually exclusive.

¹ See below Chapter IV.

C Geographical Nexus

A nexus is required between the expression in which copyright is alleged to subsist and the Commonwealth of Australia. This is so for both constitutional reasons (in that Parliament's extraterritorial legislative power may not extend to the protection of any creation in any jurisdiction, absent some international obligation so to protect) and practical ones.

The requisite nexus may be demonstrated in either of two ways.

1 Reciprocal nexus

The first connecting factor involves showing that the expression is eligible to receive reciprocal recognition pursuant to Australia's international treaty obligations. For example, a work may be authored in another country, being a party to the *Berne Convention*, so that the foreign author will receive equivalent protection to domestic authors in Australia.

In practice, equal treatment is guaranteed by the operation of ss 184–8 of the *Copyright Act*, which collectively provide that the domestic threshold requirements may be read as if the foreign author were a domestic citizen. Naturally, however, the expression must still be eligible for protection under Australian law.

A list of countries with which reciprocal copyright recognition arrangements exist is found in sch 1 to the *Copyright (International Protection) Regulations 1969* (Cth).

2 Domestic nexus

The requirements necessary for establishing a domestic nexus differ between works and other subject matter.

(a) Works

The requirements for works are set out in *Copyright Act* s 32:

Copyright Act 1968 (Cth) s 32 — Original works in which copyright subsists:

- (1) Subject to this Act, copyright subsists in an original literary, dramatic, musical or artistic work that is unpublished and of which the author:
 - (a) was a qualified person at the time when the work was made; or
 - (b) if the making of the work extended over a period — was a qualified person for a substantial part of that period.
- (2) Subject to this Act, where an original literary, dramatic, musical or artistic work has been published:
 - (a) copyright subsists in the work; or
 - (b) if copyright in the work subsisted immediately before its first publication— copyright continues to subsist in the work; if, but only if:
 - (c) the first publication of the work took place in Australia;
 - (d) the author of the work was a qualified person at the time when the work was first

- published; or
- (e) the author died before that time but was a qualified person immediately before his or her death.

Essentially, these provisions create several avenues for establishing a connection to Australia. Which is applicable depends upon the type of work, and upon whether the work is published or unpublished:

- *Unpublished works*: the author must be a qualified person when the work was made or for a substantial part of the period during which it was made: s 32(1);
- *Published works*: first publication must take place in Australia, or the author must be a qualified person either at the time of publication or of their death: s 32(2); and
- *Building or artistic work attached to a building*: the building must be located in Australia: s 32(2).

(b) *Subject matter other than works*

The nexus requirements for pt IV subject matter are, somewhat haphazardly, set out in the sections creating each type of subject matter protection:

Copyright Act 1968 (Cth) s 89 — Sound recordings in which copyright subsists:

- (1) ... copyright subsists in a sound recording of which the maker was a qualified person at the time when the recording was made.
- (2) ... copyright subsists ... in a sound recording if the recording was made in Australia.
- (3) ... copyright subsists ... in a published sound recording if the first publication ... took place in Australia.

A pattern quickly emerges: connection is demonstrated by the maker's origin, the origin of manufacture, or the place of first publication. This trifecta approach is continued in s 90:

Copyright Act 1968 (Cth) s 90 — Cinematograph films in which copyright subsists:

- (1) ... copyright subsists in a cinematograph film of which the maker was a qualified person for the whole or a substantial part of the period during which the film was made.
- (2) ... copyright subsists ... in a cinematograph film if the film was made in Australia.

- (3) ... copyright subsists ... in a published cinematograph film if the first publication of the film took place in Australia.

Broadcasts are connected more simply; they need to have originated within Australia:

Copyright Act 1968 (Cth) s 91 — Television broadcasts and sound broadcasts in which copyright subsists:

- (1) ... copyright subsists in a television broadcast or sound broadcast made from a place in Australia ...

Published editions of works must, by definition, have been published, so s 92 omits the place of manufacture limb, instead retaining the publication and maker's location limbs:

Copyright Act 1968 (Cth) s 92 — Published editions of works in which copyright subsists:

- (1) ... copyright subsists in a published edition of a [work] ... where:
- (a) the first publication of the edition took place in Australia; or
 - (b) [its] publisher ... was a qualified person at the date of ... first publication ...

As may be surmised from the above, a connecting factor may generally be demonstrated with respect to pt IV subject matter by showing:

- *Sound recordings and cinematograph films*: that the maker was a qualified person during production, or that the subject matter was first published in Australia;
- *Television and sound broadcasts*: the broadcast originated from Australia;
- *Published editions of works*: that the publication took place in Australia or that the publisher was then a qualified person.

As to the meaning of 'publication', see below Part IV.

D Qualification

Many of the preceding geographical nexus requirements make reference to the author, maker or publisher having been a 'qualified person' at some time or for a certain period. The meaning of this phrase is again dependant upon the context in which it is used.

1 Works

'Qualified person' is defined, in relation to works, in s 32(4):

Copyright Act 1968 (Cth) s 32:

- (4) In this section, **qualified person** means an Australian citizen, an Australian protected person or a person resident in Australia.

This definition contains an important qualification:

The author of a work under pt III must be a natural person. A corporation cannot be a qualified person, and hence cannot author as work.

This qualification is present both on the face of the definition (corporations cannot be Australian citizens, protected persons or residents) and by implicit omission, relative to the definition of qualified person in pt IV.

2 Subject matter other than works

The definition of 'qualified person' in relation to pt IV subject matter is contained in s 84:

Copyright Act 1968 (Cth) s 84:

In [Part IV] ... **qualified person** means:

- (a) an Australian citizen, an Australian protected person or a person (other than a body corporate) resident in Australia; or
- (b) a body corporate incorporated under a law of the Commonwealth or of a State.

The ability of corporations to author expressions protected under pt IV is broadly consistent with the notion of those expressions being 'entrepreneurial' in nature.

E *Excluded Subject Matter*

By virtue of the exhaustive and narrow definition of copyright subsistence, any expressions falling outside the boundaries of the taxonomy established by pts III and IV will necessarily be denied status as an expression protected by copyright. That said, it is difficult to state with certainty whether there can exist fixed categories of expression that could never be protected.

F *Formalities*

Pursuant to Australia's treaty obligations, there are no formalities required to obtain copyright protection. Copyright is conferred automatically upon the occurrence of the last of the following conditions:

- Original expression of a recognised type;
- Reduction to a material form; and
- A nexus provided by way of connecting factors.

At that point, copyright vests in the first-identified author, subject to any subsequent dealings.

Because nexus depends upon publication, and publication in turn upon reduction to a material form, nexus is often the last of these requirements to be satisfied. The exception may be where an ephemeral work, such as a play or speech, is performed: such performance does not count as publication (s 29(3)) and the work will not be in a material form until recorded in some fashion.

For the purposes of the Act, a 'work' exists from the moment that it is first reduced to a material form: *Copyright Act* s 10(1).

G *Publication*

The issue of publication is potentially relevant to two subsistence issues. First, it may determine whether a connecting factor has been established with Australia. Second, it may determine the commencement of the period of protection and, hence, the expiration of protection.

1 *Definition of 'publication'*

Section 29 of the *Copyright Act* sets out the circumstances in which a work or a subject matter other than a work will have been published:

Copyright Act 1968 (Cth) s 29 — Publication:

(1) Subject to this section ...

- (a) a literary, dramatic, musical or artistic work, or an edition of such a work, shall be deemed to have been published if, but only if, reproductions of the work or edition have been supplied (whether by sale or otherwise) to the public;
- (b) a cinematograph film shall be deemed to have been published if, but only if, copies of the film have been sold, let on hire, or offered or exposed for sale or hire, to the public;

and

- (c) a sound recording shall be deemed to have been published if, but only if, records embodying the recording or a part of the recording have been supplied (whether by sale or otherwise) to the public.
- (2) In determining, for the purposes of paragraph (1)(a), whether reproductions of a work or edition have been supplied to the public, section 14 does not apply.
- (3) ... the performance of a literary, dramatic or musical work, the supplying (whether by sale or otherwise) to the public of records of a literary, dramatic or musical work, the exhibition of an artistic work, the construction of a building or of a model of a building, or the 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, does not constitute publication of the work.
- (4) A publication that is merely colourable and is not intended to satisfy the reasonable requirements of the public shall be disregarded for the purposes of this Act except in so far as it may constitute an infringement of copyright or a breach of a duty under Part IX.
- (5) ... a publication in Australia or in any other country shall not be treated as being other than the first publication by reason only of an earlier publication elsewhere, if the two publications took place within a period of not more than thirty days.
- (6) In determining, for the purposes of any provision of this Act:
- (a) whether a work or other subject-matter has been published;
 - (b) whether a publication of a work or other subject-matter was the first publication of the work or other subject-matter; or
 - (c) whether a work or other subject-matter was published or otherwise dealt with in the life-time of a person;
- any unauthorized publication or the doing of any other unauthorized act shall be disregarded.
- (7) Subject to section 52, a publication or other act shall, for the purposes of the last preceding subsection, be taken to have been unauthorized if, but only if:
- (a) copyright subsisted in the work or other subject-matter and the act concerned was done otherwise than by, or with the licence of, the owner of the copyright; or
 - (b) copyright did not subsist in the work or other subject-matter and the act concerned was done otherwise than by, or with the licence of:
 - (i) the author or, in the case of a sound recording, cinematograph film or edition of a work, the maker or publisher, as the case may be; or
 - (ii) persons lawfully claiming under the author, maker or publisher.
- (8) Nothing in either of the last two preceding subsections affects any provisions of this Act relating to the acts comprised in a copyright or to acts constituting infringements of copyrights or any provisions of Part IX.

2 *Application to works and subject matter*

The circumstances required for publication vary depending upon whether the matter being published is a work of other subject matter:

- *Works and editions of works*: when reproductions are ‘supplied (whether by sale or otherwise) to the public’: s 29(1)(a);
- *Cinematograph film*: when a copy is ‘sold, let on hire, or offered or exposed or sale or hire, to the public’: s 29(1)(b); and
- *Sound recordings*: when a record of the recording is supplied to the public: s 29(1)(c).

Sales need not be completed: offering for sale is sufficient to amount to a supply (*British Northrop Ltd v Texteam Blackburn Ltd*).

Note that for works and editions of works, the requirement is that ‘reproductions’ (plural) be supplied to the public. This must be taken to mean that more than one copy has to be made.

Publication is likely to occur by placing a copy of a work on the internet, since it must now be taken to amount to a supply ‘to the public’ at large. The point of publication would be the point at which more than one download of the work was recorded.

3 *Conduct excluded from publication*

Section 29 creates a number of carve-out provisions. The effect of these is to exempt acts such as the following from amounting to publication:

- Section 29(3) exemptions:
 - Performing a work;
 - Supplying records of a work to the public;
 - Exhibition of an artistic work;
 - Construction of a building or a model of that building;
 - Supplying photographs or engravings of a building or sculpture to the public;
- Any supply that is ‘unauthori[s]ed’ within the meaning of s 29(7): s 29(6);
- Any supply that is ‘merely colourable’ within the meaning of s 29(4);
- Any supply that is made in any country within 30 days of a first publication elsewhere: s 29(5); and
- Any supply of only a part of a work or subject matter: s 29(2).

4 *Substantial part*

Section 29(2) excludes the operation of s 14 from a determination of publication. This is significant because it means that it is not sufficient to establish publication merely with respect to a ‘substantial part’ of the work (unlike infringement). Thus, supply of a part of a work, however large, will not amount to publishing that work unless the whole of it is made available to the public.

This is just one of the many differences between an assessment of publication for the purposes of subsistence and its assessment in the context of infringement.

Table 1: Subsistence of Copyright in Australia

Nature of the Work	Originality Requirement	Author	Qualifying Factor	Publication	Duration	Scope of Monopoly	First Owner
Literary	Must be original: ss 32(1), 32(2) Originates from the author (of amanuensis) (<i>Donoghue; Lane</i>) A product of skill, labour or expertise (<i>McDougall</i>)	Must be a natural person: s 10(1) Must be reduced to material form: s 22(1)	Australian citizen or citizen of reciprocal country: ss 32(4), 184–8		70 years after author's death: s 33(2) Or 70 years after year first published: s 33(3)		
Dramatic							
Musical							
Artistic							
Cinematograph films	No express originality requirement Cannot be entirely copied (<i>University of London Press</i>)	Can be a corporation: s 84 No requirement of material form, except to extent entailed by subject-matter definitions	Australian citizen or citizen of reciprocal country: s 84, 184–8 Incorporated in Australia or in reciprocal country: ss 184–8		70 years from publication: ss 93, 94(1) 50 years from broadcast year: s 95		
Sound recordings							
Television and sound broadcasts							
Published editions of works					25 years from year published: s 96		
Other	No copyright subsists in the expression						

II Works: Subsistence Criteria

A Introduction

As discussed above, a work will receive protection under the *Copyright Act* to the extent that it falls within a recognised category of works, is geographically proximate to Australia, and is authored by a qualified person. In addition, works must satisfy the following requirements:

- **Authorship**
The work must be a work of authorship; that is, it must be the product of the intellect or industry of a human being;
- **Originality**
The work of authorship must be original; that is, it must 'originate' from its author, and its creation must have involved some skill or enterprise;
- **Material form**
The work must first have been reduced to a material form; and
- **Substantiality**
The work must not be trivial so as to lack coherency, or be the product of a trivial degree of effort.

These requirements are now explored in turn. In the course of this exploration, several controversial situations involving works are examined in detail.

B Authorship

Section 32 of the *Copyright Act* makes clear that copyright in a work must initially be held by a natural person. Precisely who that is will depend upon the identity of that work's author. However, that a work must have been authored is beyond dispute; it cannot be a random confluence of data or facts unmediated by any human intervention.

The notion of authorship is rarely controversial when a single creator is readily identifiable. However, the requirement can become problematic in circumstances of joint- or co- authorship, particularly where one of the parties plays a passive or indirect role. The issue here is whether a person whom, while not actually reducing the expression to material form, is connected in some way with its production, can be described as its author.

Whether such a person is an author depends upon whether they choose the particular form of language (or other expressive material) in which copyright is alleged to subsist. If a person is responsible for the expression, then he or she will be an author of the resulting work. This is to be contrasted with a mere scribe or 'amanuensis' to whom the form of expression is dictated by its actual author. Such an amanuensis is not an author (*Donoghue v Allied Newspapers Ltd*).

Donoghue v Allied Newspapers Ltd (1939) UK CA:

Facts

- Donoghue is a prominent English jockey; he agrees to give certain interviews to a journalist employed by the publication *News of the World*

- Articles are subsequently written by that journalist, and published by the newspaper
- Later, these articles are reprinted, in abridged form, in another newspaper, with the permission of *News of the World*
- Donoghue objects to this republication, claiming that he is the author of the stories and entitled to damages for their reproduction, which was not authorised by him

Issue

- Is Donoghue a coauthor of the articles?

Reasoning (Farwell J)

- The journalist is the sole author of the articles
- Donoghue simply volunteered information about various incidents in his life
- Donoghue does not own the copyright to this information — they are mere ideas:
 - ‘A person may have a brilliant idea for a story, or for a picture, or for a play, and one which appears to him to be original; but if he communicates that idea to an author or artist or a playwright, the production which is the result of [that] communication ... is the copyright of the person who has clothed the idea in form [ie, the author or artist or playwright]. ... The explanation of that is this, that in which copyright exists is the particular form of language by which the information which is to be conveyed is conveyed. ... [T]he copyright exists in the particular form of language in which ... the information or the idea is conveyed to those who are intended to read it or look at it.’ (at 109–10)
- However, the result may be different in a case where the originator of these ideas employed a scribe or clerk to jot them down
 - In that situation, the scribe is simply a writer employed to take down in shorthand a story whose words are dictated by the originator of the ideas
 - There, the scribe is a ‘mere amanuensis’ and owns no copyright in the product
 - This is because the words are authored by the originator, and not the scribe
 - [Similarly, it may be supposed, if the skill involved in reducing something to material form is limited to literal transcription by means of technological assistance (such as a tape recorder or iPod), then that device, and its activator, will be a mere amanuensis, so that the originator of the words recorded will be the author of those words]
- Hence, *News of the World* is the vicarious owner through its contract of employment with the journalist
- Therefore, it was entitled to grant permission on the journalist’s behalf to republish the articles in an abridged format elsewhere

Decision

- Donoghue is not a coauthor because he is the mere originator of the ideas and not the person who expressed them in a form protected by copyright
- The journalist chose the precise words to be used and is therefore the author of the expressions comprising the articles
- Unless the scribe is a mere amanuensis for the originator of the ideas, the scribe, by virtue of choosing the expression of those ideas, will be the author of the result

To elevate a scribe’s role into something more than that of mere amanuensis, it is necessary that the scribe demonstrate some skill in choosing (*Donoghue*) or reproducing the expression of the ideas in material form. *Cummins v Bond* provides an example of a situation where the author’s skill lies in translating and rapidly recording the words provided by ‘another’ (the reason for this definitional irrelevance will soon become clear). In *Cummins*, the scribe’s role is said to be one of authorship and not of amanuensis because of the exercise of this higher level of skill and ability.

Cummins v Bond (1927) UK Ch:Facts

- Cummins considers herself a spiritual medium; she would write automatically while in a trance state
- Bond is interested in certain automated writings produced by Cummins
- During one séance, at which Bond is present, Cummins' writing produces 'The Chronicle of Cleophas', which is an archaic text dating to the sixteenth century
- Bond seeks to publish the text, but Cummins objects
- Bond therefore claims ownership of the text, arguing that as this text was addressed to him and inspired by his presence, he is its author, or alternatively that no copyright subsists in the writings at all

Issue

- Is Bond a coauthor of the séance writings?

Reasoning (Eve J)

- The writings 'could not have reached us in this form without the active co-operation of some agent competent to translate them from the language in which they were communicated [Aramaic] to [Cummins] into something more intelligible to persons of the present day [archaic English]' (at 173)
- 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 writings
- Bond is not a mere amanuensis or conduit of the 'spirit's' words, because she exercised skill in translating and reproducing those words
 - [Doubtless, the fact that the Court of Chancery has no jurisdiction with respect to the spiritual realm may have something to do with this finding; the Court could hardly declare the spirit to be an author]

Decision

- Cummins is an author of the work; Bond

Where *Donoghue v Allied Newspapers Ltd* concerned the copyright of a scribe as against the progenitor of the ideas he recorded, *Walter v Lane* dealt with the rights of the scribe as against third parties. The scribes in *Walter* were journalists who recorded a speech delivered by the Earl of Rosebery; the third parties were unauthorised publishers of the printed accounts. The House of Lords held that the scribe was entitled to copyright protection as an author of the printed record, even though that record reproduced the speaker's words verbatim.

Two rationales for so holding may be identified among their Lordships in the majority:

- (a) The scribes, in faithfully recording the speeches, exercised and exceeded some minimum threshold of skill and effort deserving of protection as authorship; this effort may be either:
 - (i) The putting of the speaker's ideas into material form, which entails a degree of original endeavour sufficient for authorship; or;
 - (ii) The inherent art in and training required to act as a competent stenographer; and

- (b) The scribes, as mere amanuenses, do not possess copyright in the speeches themselves, but they do possess copyright in the printed record of those speeches, because they authored that record, if not the words themselves.

The minority judgment differs in the degree of skill and effort said to be required before sufficient 'authorship' may be demonstrated.

Walter v Lane (1900) UK HL:

Facts

- Between 1896 and 1898 the Earl of Rosebery delivers a series of public addresses on matters of public interest
- Among the audience members are reporters employed by *The Times* for the purpose of reporting on the occasions
 - These reporters jot down the speeches in shorthand notation, then correct, revise and punctuate the reports for publication in *The Times*
 - The resulting publication is essentially a verbatim copy of what was delivered by Lord Rosebery on each occasion
- In 1899, Lane publishes a book entitled *Appreciations and Addresses: Lord Rosebery*
 - The book contains each of the five speeches recorded by *The Times'* reporters, followed by a short explanation of the circumstances of each address
 - Lane concedes that these speeches 'were taken (substantially verbatim)' from *The Times'* own reports
- *The Times'* reporters assign copyright to Walter, their employer
 - It is not in dispute that *The Times*, as employer, should hold copyright in all these articles
- Walter commences proceedings, seeking a declaration that *The Times* holds copyright in the articles and an injunction restraining publication of Lane's book, along with damages
- Lord Rosebery does not participate in the action

Issues

- Does *The Times*, through its reporters, hold copyright in its reports of the speeches?
- That is, can it hold copyright notwithstanding that the reports contain no new ideas, merely being a verbatim record of what was said by Lord Rosebery?
- More specifically, can a work arise from the efforts of a person who is not the original 'author' of the words comprising it?

Reasoning

- North J: copyright subsists in *The Times'* reports
- Court of Appeal: no copyright subsists in the reports because they are not original works of authorship
- Halsbury LC: reporters are authors of their writings, regardless of effort or skill required
 - Copyright means simply 'the right to multiply copies'
 - The argument that *The Times'* reports are not protected because the reporters are not 'authors' within the meaning of the *Copyright Act* rests upon 'a too narrow and misleading use of the word "author"' (at 545)
 - 'The language of the Court of Appeal is: "Each man who himself makes a directory, &c, and publishes it, is the author of what he publishes. The reporter of a speech is not." With great respect to the Court of Appeal, this is allegation, not argument.' (at 546)
 - Each reporter is an author of their reports on the speeches delivered by Lord Rosebery; the notion of authorship is not limited by any notion of novelty or even effort

- The objections do not pose a difficulty
 - ‘It is said that in the view I have suggested there would be as many copyrights as reporters. I do not see the difficulty. Each reporter is entitled to report, and each undoubtedly would have a copyright in his own published report; but where is the difficulty? Suppose a favourite view — a dozen artists take, each independently, his own representation of it. Is there any reason why each should not have his own copyright? Or even a photograph, where each photograph, if taken from the same point and in the same state of the light, would be identical in all respects. There is of course no copyright in the view itself [an idea], but in the supposed picture or photograph there is.’ (at 449)
 - ‘And in truth there is a confusion of thought between the difficulty of proof of the piracy and the existence of piracy. Here, as I have said before, no such difficulty arises, since it is admitted that the report of these speeches is not the result of independent labour, but is simply taken from *The Times*.’ (at 449–50)
- *The Times* owns copyright in the reports and is entitled to succeed; the judgment of the Court of Appeal should be overturned
- Lord Davey: reporters are authors of their writings, regardless of how little skill is involved
 - ‘Copyright is the right of multiplying copies of a published writing’
 - ‘There is no copyright in a speech although delivered on a public occasion’
 - ‘Now, what has the respondent done? He [Lane] has admittedly copied and republished for his own profit certain sheets of letterpress forming parts of *The Times* newspaper. A sheet of letterpress is a book within the meaning of the Act. ... Prima facie, therefore, the respondent has infringed the appellants’ copyright in their newspaper.’
 - Lane claims that Lord Rosebery was the author of his speech, so that nobody else could claim to be the author of a report of that speech
 - ‘The reporter, they say (with a pardonable jingle), is the reproducer and not the producer of the speech.’
 - ‘That is true in a sense, and if *The Times* were claiming a property in the speech itself and seeking to prevent anybody else from publishing any other report of it, the argument would be cogent. But the appellants’ claim is of a more modest description. They seek only to prevent the respondent from multiplying copies of their own report of the speech and availing himself for his own profit of the skill, labour and expense by means of which that report was produced and published.’
 - ‘In my opinion the reporter is the author of his own report’
 - ‘He it was who brought into existence in the form of a writing the piece of letterpress which the respondent has copied’
 - ‘I think also that he and he alone composed his report.’
 - The fact that not much skill and judgment are required to author the report are irrelevant:
 - ‘Owing to the perfection which the art of short-hand writing has attained in recent years, memory and judgment bear a less important part in the composition of a report of a speech than was formerly the case. But the question whether the composer has copyright in his report does not seem to me to vary inversely with or to depend on his skill in stenography.’
 - The reporters are authors of the reports, regardless of how easy it was for them to compile them
- Lord James: skill and effort is the yardstick of authorship

- Walter could not claim copyright in the speech itself, for it is the authorship of Lord Rosebery
- However, Walter does not claim copyright in the speech
- Whether the reporters are ‘authors’ depends upon a proper construction of the meaning of the word ‘author’ in the *Copyright Act*
 - ‘A mere copyist of written matter is not an “author” within the Act, but a translator from one language to another would be so’
 - ‘A person to whom words are dictated for the purpose of being written down is not an “author.” He is the mere agent or clerk of the person dictating, and requires to possess no art beyond that of knowing how to write. The person dictating takes a share in seeing that the person writing follows the dictation, and makes it his care to give time for the writing to be made. But an ‘author’ may come into existence without producing any original matter of his own.’
 - The distinguishing characteristic seems to be the amount of effort or skill involved: in the former case, the clerk is a ‘mere scribe’
 - In the latter case, it is ‘an art requiring considerable training, and does not come within the knowledge of ordinary persons’
 - Certainly, reports obtained under difficult circumstances (eg, covert meetings, listening to speakers talking rapidly in Parliament) may be works of authorship
- A reporter of a speech is therefore ‘the meritorious producer of something necessary to constitute him an “author” within the meaning of the *Copyright Act*’
- Lord Brampton: the statute does not restrict authorship to works new in substance
 - Copyright in the reports is separate to copyright in the speech they record
 - ‘A speech and the report of it are two different things, and the author of the one and the author of the other are presumably two different persons. The author of a speech is the author of language orally uttered by himself. The author of the report of a speech is the author of a writing containing the substance or the words of that speech. The speech must precede the report of it. The oral speech is not a “book,” the written report is. The book is the subject of copyright ... and the property in such copyright ... is in *its* author.’ (emphasis in original)
 - ‘Of course, if no reporters had been present, or if though present none had taken down his Lordship’s utterances, those utterances must have remained unrecorded, and no question of copyright could have arisen, for there would have been no subject of copyright in existence.’
 - Authorship does not depend upon literary quality or skill
 - ‘It is obvious that the preparation of [the reports] involved considerable intellectual skill and brain labour beyond the mere mechanical operation of writing.’
 - However, ‘I do not agree that the question of the authorship of a book depends upon the literary quality of it.’ (at 558)
 - ‘If a person chooses (*and many do*) to compose and write a volume devoid of the faintest spark of literary or other merit, I see no legal reason why he should not, if he desires, become the first publisher of it and register his copyright, worthless and insignificant as it would be.’ (emphasis added)
 - ‘True it is that the reporter was not the author of the speech; but he was the composer and author of the book. Without his brain and handiwork the book would never have had existence, and the words of Lord Rosebery would have remained unrecorded save in the memories of the comparatively few who were present on those occasions.’

- This handiwork is sufficient for authorship of the *book* (ie, the reports) to be attributed to its reporters
 - The proprietors of *The Times* therefore have copyright in the reports
 - Lord Robertson (dissenting): mere transcription of another's words is not authorship
 - 'The case before your Lordships is a case of shorthand reporting pure and simple.'
 - '[T]he contribution which education enables the good reporter to make to the speech is of a purely negative kind: he does not interfere, but faithfully acts as conduit. In fact, the merit of the reports now before your Lordships is that they present the speaker's thoughts untinged by the slightest trace of colour of the reporter's mind.'
 - 'The next stage, copying out the notes, is purely clerical work. Now I recognise the skill of the stenographer. ... But I fail entirely to see how, in the widest sense of the term "author," we are in the region of authorship.'
 - 'The appellants think that if the owner of a phonograph publishes the speech as taken down by the phonograph he is the author of the report and entitled to copyright. I should have thought (and think) this a reduction ad absurdum of the whole argument of the appellants'
 - [With great respect to his Lordship, no: this is not a *reduction ad absurdum*. In that case, as here, the phonographer would be the author of a work that is a recording of the speech. The only difference between that case and the present is the amount of skill and labour involved in producing the recording. There are two implicit claims being made by Lord Robertson: first, that *some* skill is necessary for there to be authorship — this is similar to the 'mere scribe' counter-example of Lord James; second, that producing a phonogram does not entail skill. The second of these assumptions is clearly wrong: the creation of a recording necessarily involves technical skill and broader initiative — being there to capture the sounds and properly storing and disposing of the recording later. The first assumption is less easy to displace, but ultimately irrelevant to the example posed by Lord Robertson. So long as the phonographer has in fact produced the phonogram, what has been created is a work of authorship — a recording (literary or musical work). The phonographer is the author of that recording. Subject to the other subsistence requirements, I can see no barrier to its protection]
 - The word 'author' represents 'a criterion consistent with the widest application for the Act to all who can claim as embodying their own thought, whether humble or lofty, the letterpress or which they assert the authorship.'
 - What is relevant is 'the intellectual relation of the reporter to the words of the speech'
 - It is inappropriate to confer upon a stenography the reward of protection for recording something 'which has no relation whatever to his art'

Decision

- (4:1) Yes, *The Times* holds copyright in the reports and can restrain Lane from publishing the book, which would infringe Walter's copyright
- (4:1) *The Times* does not hold copyright in the speeches themselves, but they do hold copyright in their reports of the speeches, even though they are identical to the speeches; the difference is that the reports are a book, whereas the speeches are not
- Lord-Chancellor Halsbury and Lord Davey: skill and effort are irrelevant and not criteria of authorship; an author will be such even if his creation requires no effort at all
- Lord James: an author must be a 'meritorious producer'; they must use skill and effort
- Lord Brampton: the notion of authorship does not depend upon skill, but instead upon the

- mere handiwork and initiative to create the work (regardless of its quality)
- Lord Robertson (dissenting): authorship entails some original, novel thought; transcription is insufficient because this does not involve originality

Although it is difficult to draw any clear statement of principle from *Walter v Lane*, the following at least seems clear:

A person who commits to material form something thought up by another is entitled to copyright in their record of that thing. It does not matter that they have not thought up the substance of the creation, or that their form of it contains nothing novel. It is sufficient authorship merely to record the thing in that manner. This does not confer copyright in the thing itself — only in the person's recording of it, such as to prevent others from misusing the recording. However, it will not prevent third parties from independently producing identical records of the thing themselves.

1 *Authorship and computer-generated works*

By way of aside, it should be noted that the issue of computer-generated works raises peculiar issues of authorship.

Two categories of computer-generated material may be identified. The first concerns works created by a human with the aid of a computer, such as tables and diagrams, or the output of a computer program. In this situation, the computer serves the role of a tool or utility. Existing principles are clearly capable of dealing with such a scenario: the computer is a mere amanuensis and will not be an author of the work. The human controlling it will be.

So much was affirmed in *Express Newspapers plc v Liverpool Daily Post & Echo plc*, where computer-generated bingo numbers were held to comprise an original literary work. The computer was an amanuensis employed by the author, in whom the copyright will vest upon reduction to a material form. A more modern example might consist in the use of a computer to aggregate or store data based on a fixed set of criteria provided by the user; here, again, the computer system performing the aggregation is acting at the behest of its user, who must be considered the author of any resulting output.

The second category of computer-generated works is more controversial. These are works where no human author is immediately involved in the creation of the form of expression in which copyright is alleged to subsist. Examples:

- Satellite imagery collected automatically by remote sensors;
- Computer-generated art and music;
- Reports and graphs generated at periodic intervals by a web server;
- Fractals and other randomly-generated data; and
- Computer-aided software engineering (automatically-generated computer programs).

Who are the authors of these works? They were not specifically programmed or even requested by anyone. No interactivity between a human and a computer caused them to be produced, yet such expressions are of increasingly vital importance in online data exchange and electronic commerce.

Because of the complex issues of authorship raised by these examples, the Copyright Law Reform Committee has recommended the creation of a separate category of works: 'computer-generated material'. It is suggested that the courts or legislature will eventually be forced to expand protection to recognise authorship in these expressions as lying in the programmer or user responsible for or instrumental in their creation.

C Originality

1 Definition

A requirement of originality is imported into the subsistence criteria for copyright in works by virtue of *Copyright Act* s 32:

Copyright Act 1968 (Cth) s 32:

- (1) ... copyright subsists in an original literary, dramatic, musical or artistic work that is unpublished ...
- (2) ... where an original literary, dramatic, musical or artistic work has been published ... copyright subsists in the work ...

No definition of 'original' may be found within the *Copyright Act*. However, it has a long and distinguished (which is to say, convoluted) judicial pedigree.

2 Originality is not novelty

Originality does not mean that novelty is required. It only means that some degree of skill is necessary to produce the work (*Walter v Lane*). Although judges disagree about the precise threshold of skill that is required, it is generally regarded as a low standard of originality.

Walter v Lane (1900) HL:

Reasoning

- Majority: copyright protects the effort or industry of those who compile informational goods, regardless of whether those goods are 'new'
- Halsbury LC:
 - Paramount concern: unfair competition – taking the industry of *The Times* ('sweat of the brow')
 - 'The question here is solely whether this book ... can be copied by some one else than the producers of it ... by those who have not produced it themselves but have simply copied that which others have laboured to create by their own skill and expenditure.' (at 547)
 - Map & directory analogies
 - 'And I observe that it is said Lord Rosebery had no copyright in his speech, and although he could have acquired copyright in it by putting it into writing and printing and publishing it, he did not do so. Here, again, the implied proposition is that the only person who could gain copyright in his speech is the person who spoke it, and that the word "original" must by construction be read into the statute — that the true analogy is the true and first inventor of the patent laws. ... I think the analogy is a false one. I do not find the word "original" in the statute, or any word which imports it ...' (at 548)

- Reward for preservation of spoken words
 - '[Copyright], in my view, is given by the statute to the first producer of a book, whether that book be wise or foolish, accurate or inaccurate, of literary merit or of no merit whatever'
 - In the same way, the skill and accuracy of the producer of the written book is not insisted upon by the Act
- Distinction between transcript and speech akin to that between a painting and its scene (idea/expression?)
- Lord Davey:
 - The reports do not need to be original compositions in order to be protected by copyright
 - 'Nor, as it appears to me, does [sic] the fact that the subject-matter of the report had been made public property, or that no originality or literary skill was demanded for the composition of the report, have anything to do with the matter.'
 - The ease of compilation does not weigh on the issue of originality
 - 'Again, it is said that the lucidity of diction and perfection of expression which characterise the eminent person named render an exact reproduction of his words a comparatively easy and almost mechanical task. But is it argued that the reporter of the hesitating or half-completed utterances of an inferior speaker might have copyright, though the reporter of Lord Rosebery may not? or does the question of copyright in the report depend on the clearness of thought and speech of the orator? In my opinion the question must be decided on general considerations, and not on any grounds which are personal either to the orator or to the reporter.'
 - Lord Davey appears to suggest that copyright will subsist in a factual compilation regardless of how little skill is required to compile it (subject to the erosion of any normative justifications for copyright protection)
 - 'Copyright has nothing to do with the originality or literary merits of the author or composer. It may exist in the information given by a street directory ... or by a list of deeds of arrangement ... or in a list of advertisements. ... I think those cases right ...'
 - Protection of the industry of *The Times* is necessary to protect its efforts and dissuade unfair competition
 - 'It was of course open to any other reporter to compose his own report of Lord Rosebery's speech, and to any other newspaper or book to publish that report; but it is a sound principle that a man shall not avail himself of another's skill, labour and expense by copying the written product thereof'
 - 'For the purposes of their own profit [the respondents] desire to reap where they have not sown, and to take advantage of the labour and expenditure of the plaintiffs in procuring [the content of the speeches] for the purpose of saving labour and expense to themselves.'
- Lord James:
 - Street directories and timetables are protected because there is something separate from original creativity that required protection
 - 'A reporter's art represents more than mere transcribing or writing from dictation. To follow so as to take down the words of an ordinary speaker, and certainly of a rapid speaker, is an art requiring considerable training, and does not come within the knowledge of ordinary persons.'
 - A person dictated to does not own copyright (it belongs to the dictator)

- However, *The Times*' reporters had on their own initiative chosen to preserve the speeches; as such, they were not dictated to
- Lord Brampton:
 - Emphasises the utility of the information product produced by the *Times* reporter
 - Reporters were not the authors of the speeches but were the composers of the report
 - Without their effort, the speeches would have remained unrecorded save in the memories of those who were present
 - By transcribing the speeches, the reporters permitted the readers of *The Times* to be 'truthfully and accurately informed of those intellectual and interesting utterances of Lord Rosebery which they had not been privileged to hear'
- Lord Robertson (dissenting):
 - The contribution which education enables the good reporter to make to the speech is of a purely negative kind: he does not interfere, but faithfully acts as a conduit
 - Rival of a good stenographer is the phonograph
 - Note these fighting words: 'I should have thought (and think) this a reductio ad absurdum of the whole argument of the appellants'
 - 'I think that the recording by stenography the words of another [sic] is in a different region from the making up a [sic] time-table. I do not say it is lower or higher, but in a different plane, because there is no construction.'
 - Legal relativism?
 - Time tables, directories etc differ as there has been structure/arrangement by the maker
 - Perfect transcription of speech leaves no choice for such construction

Decision

- (4:1) Although the reports contain no new words or ideas, the form of their expression is original and not copied from elsewhere, which is enough
- The reports therefore have sufficient originality to be protected by copyright

Walter v Lane reflects a view of protection that rewards industrious labour rather than creativity of expression. Though the reports be devoid of any original form of words, the fact that their authors (the reporters) had the initiative and skill to commit those words to material form reflects sufficient industry to imbue them with originality.

An interesting contrast may be drawn between *Walter v Lane* and *Victoria Park Racing Co v Taylor*, which concerned largely the same situation as *Walter v Lane* (observing and recording a spectacle) but with the opposite result (no protection).

The argument could be made that copyright law should not reward the good luck and happenstance that led *The Times*' reporters to be present and to record the Earl of Rosebery's speeches, since that would fail to provide an effective incentive deliberately to create useful works. This argument would be both factually and economically unsound. It would be factually unsound because the reporters in *Walter v Lane* were sent specifically to record the speeches for the purposes of publication. It would be economically unsound because *The Times* may not have done this had it thought the resulting reports would not be granted copyright protection, which would deprive society of the benefit of having a printed record of his Lordship's lucid words.

(Note, however, that had *The Times*' reporters merely transcribed a copy of speeches given by the Earl of Rosebery from his own written notes, there would arguably be copyright infringement

as against the Earl of Rosebery, since copyright would subsist in the speech itself, and it would be substantially reproduced in a material form by the journalists.)

3 Broad themes in originality jurisprudence

In *Sands & McDougall Pty Ltd v Robinson*, the High Court of Australia accepted the *Walter v Lane* test of originality. The Court held that the insertion of the requirement of 'originality' into the Australian *Copyright Act* did not add an additional criterion of protection. Instead, it is equivalent to the existing requirement of 'authorship' under the *Copyright Act 1842* (UK).

According to the High Court, originality has two limbs:

- **The expression must 'originate' with the author**
It must not be copied from another work, or be the product of an author who acts as a 'mere conduit' (as in *Cummins v Bond*) or amanuensis (as in *Donoghue v Allied Newspapers*) — the journalists in *Walter v Lane* were not conduits for Lord Rosebery's speeches but were in fact the originators of their written form; and
- **The expression must be a product of its author's skill, labour or expertise**
This is a question of degree. The expression must involve either 'more than negligible work, labour or skill', 'considerable skill, labour and judgment' or 'substantial skill, industry or experience' (*Ladbroke (Football) Ltd v William Hill (Football) Ltd*). That is, there must be some labour expended in the creation of the expression (*University of London Press*).

Several further themes emerge from the case law. First, originality does not require novelty. A work will be original notwithstanding that it is comprised entirely of information in the public domain. (This is unlike patent protection.) *Walter v Lane* is one example of this. *University of London Press Ltd v University Tutorial Press Ltd* provides another:

***University of London Press Ltd v University Tutorial Press Ltd* (1916) UK Ch:**

Issue

- Are examination papers 'original' such as to enable the subsistence of copyright in them?

Reasoning (Peterson J)

- A work can be original even if it lacks any novel ideas or thoughts:
 - 'The word "original" does not in this connection mean that the work must be the expression of original or inventive thought. *Copyright Acts* are not concerned with the originality of ideas, but with the expression of thought. ... 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.'
- Originality involves some threshold of labour; the expression of the work must involve some minimum amount of effort
- However, this effort is not to be measured by the quantum of time taken to complete the work:
 - 'If time expended is to be the test, the rapidity of an author like Lord Byron in producing a short poem might be an impediment in the way of acquiring copyright, and, the completer his mastery of his subject, the smaller would be the prospect of the author's success in maintaining his copyright.' (at 609)
- '[T]here remains the rough practical test that what is worth copying is *prima facie* worth

protecting.’ (at 609)

Decision

- ‘So in the present case the defendant could not take a single line of the plaintiff’s directory for the purpose of saving himself labour and trouble in getting his information.’ (at 702)
- Copyright subsists in the street directory; originality appears to have been (implicitly) accepted

University of London Press was applied by the High Court of Australia in *Sands & McDougall Pty Ltd v Robinson* to find that a map was original even though it was prepared from the common stock of general cartographic knowledge and required no independent intellectual effort, judgment or discrimination to be produced. It originated from the author and required labour and expertise to create, which was held to amount to sufficient originality for copyright to subsist.

Second, originality does not depend upon literary or artistic merit or skill. Although ‘literary skill and taste’ (*Ladbroke (Football) Ltd v William Hill (Football) Ltd* per Lord Atkinson) may be indicative of originality, it is not required. A work can be completely devoid of literary or artistic merit yet still be original. Consider, for example, Finkelstein J’s amusing comments in *Telstra Corp Ltd v Desktop Marketing Systems Ltd* (at [44]):

It cannot be doubted that if an author brings to bear intellectual labour in the production of his work, and does not copy that work, that will be sufficient to satisfy the requirement of originality. ... [However,] whether the intellectual effort has resulted in a work of aesthetic merit, is not relevant, as copyright does not depend upon a judgment based on taste. *Thus, copyright will subsist in the black paintings of the abstract expressionist Ad Reinhardt (all square, five feet by five, with a cross that divides the surface into nine equal squares which can barely be made out) whether or not a judge thinks them to be entirely meaningless ...* (emphasis added)

4 Partially copied works

The third requirement implicit in ‘originality’ is that a work must not be copied in its entirety from another work. This requirement is often used to define the notion of originality negatively, as occurred in *University of London Press*. If a work is partially copied, it may still be an adaptation of another work, providing that sufficient additions or changes are made to render the form of the expression original in the sense in which that word is here understood. Even if the later work infringes copyright in its predecessor, it may still be original — at least in Australia (the United Kingdom appears to have taken a different view).

Interlego AG v Croner Trading Pty Ltd provides such an example. In this case, the Privy Council denied copyright protection to a drawing that had been partially copied from another drawing because the drawing for which protection was claimed was visually indistinguishable from the earlier drawing. However, the Federal Court of Australia expressly rejected this finding, holding that originality does not require novelty of expression — only that the expression ‘originates’ from its author (per Gummow J). Thus, despite the fact that the expression visually reproduced the earlier work (and may even infringe it), the later drawing is original because of the skill, labour and expertise that went into drawing it.

Four situations may therefore be identified:

- **Complete authorial novelty**
The new work borrows nothing from any previous works and is created solely by its

author; this is clearly original;

- **Partial copying**
Providing that the new work involves some skill, labour and expertise originating from its author, it maintains originality;
- **Skilled forgery**
In the case of an exact replica or forgery, copyright would still appear to subsist if the creation of the forgery involves skill, labour and expertise (*Interlego AG*);
- **Unskilled forgery**
In the case of a wholesale duplication of an earlier work, the subsequent replica would not be original since it would fail to involve the expenditure of sufficient effort (*University of London Press*).

In all these cases, therefore, the copied work will be original if it meets the requisite threshold of labour. Although the precise content of this threshold is unclear, it does not appear to be especially demanding.

Note that, even if a work is created that infringes copyright in another, earlier work, this later work is still entitled to protection. For example, in *A-One Accessory Imports Pty Ltd v Off Road Imports Pty Ltd*, the applicant's database infringed copyright owned by a third party. However, because the database's creation still involved labour, skill and expertise, it was still entitled to protection from copying by the respondent.

Because an infringing work may itself be protected by copyright, this means that both the owner of the original copyright and the owner of copyright in the new, infringing work may have actions against a third person who infringes the new work.

5 Compilations

Another way of understanding *Walter v Lane* is as affording protection to the authors of a factual compilation. *The Times'* reporters had, in a sense, industriously compiled and published a series of reports whose facts were public (the speeches of Lord Rosebery), but which nevertheless had sufficient originality by virtue of the industry involved in their preparation. In a more modern context, it might analogously be asked whether copyright in the content of Google News would subsist in Google, even though it was simply compiled from publicly available information.

The issue here is whether compilations of existing facts, information or data can have sufficient originality to be considered a 'work' under s 32 of the *Copyright Act*.

It is trite to say that the compilation must not be an exact copy of another source. However, simply not being copied is insufficient for originality: something more is required. Courts throughout the western copyright jurisdictions have oscillated between two further indicia of originality when assessing the eligibility of compilations for copyright protection:

- **Not copied**
The work in which copyright is alleged to subsist must not itself have been copied from another source such as to deprive it of originality; and
- **Sweat of the brow**
Originality depends on the author engaging in sufficient work or incurring sufficient

expense during the process of compilation, regardless of how ‘dry’ or uncreative the result; or

- **Selection or arrangement**

Originality depends on intellectual effort and creativity in the selection or arrangement of the data comprising the compilation.

All jurisdictions appear to accept the proposition that originality requires that the work be not copied directly from another source. All jurisdictions further agree that factual compilations *can be* original, but that *something more* is required to make them original. However, whether this additional element is found in an economic or intellectual indicium is a matter of disagreement.

The first of these two competing indicia may be termed the ‘sweat of the brow’ doctrine, which accepts the originality of any compilation that is the product of sufficient effort. This has been adopted in the United Kingdom, and rejected in the United States and Canada.

The second approach is the ‘selection or arrangement’ doctrine, which accepts the originality of compilations exceeding some threshold of intellectual or creative endeavour. This has also been applied in the United Kingdom, and is the sole criterion in the United States and Canada.

In Australia, a hybrid approach is adopted. The antipodean test treats either as sufficient to create originality; that is, either effort or intellectual selection — or, perhaps more simplistically, intellectual or economic effort — may be shown. This is the approach that is currently accepted in Australia (*Telstra Corp Ltd v Desktop Marketing Systems Pty Ltd*).

(a) *The United Kingdom position*

The overwhelming majority of English case law accepts that there can be copyright in a factual compilation. Many of the cases emphasise 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 (*Kelly v Morris*):

Kelly v Morris (1866) UK Ch:

Facts

- Kelly claims copyright in a street directory alleged to have been copied by Morris

Issue

- Can there be copyright in a street directory?

Reasoning (Sir Wood V-C)

- ‘The defendant has been most completely mistaken in what he assumes to be his right to deal with the labour and property of others. In the case of a dictionary, map, guide-book, or directory, when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In the case of a road-book, he must count the milestones for himself ...’
- ‘[G]enerally, he is not entitled to take one word of the information previously published without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and the only use he can legitimately make of a previous publication is to verify his own calculations and results when obtained.’ (at 701–2)

- [Strictly speaking, this position is now modified by the requirement in s 14(1) that a substantial part of the work be taken, rather than a single atomic element]

Decision

- ‘So in the present case the defendant could not take a single line of the plaintiff’s directory for the purpose of saving himself labour and trouble in getting his information.’ (at 702)
- Copyright subsists in the street directory; originality appears to have been (implicitly) accepted

Because there is no copyright in the information underlying such a directory, others would be free to produce a competing product. All that *Kelly v Morris* requires of such competitors is that they obtain the data or information independently. This appears to be a concession to inefficient duplicity for the sake of normative authority and, ironically, the suffusion of incentive to create informational goods efficiently. To this extent, the concession represents a balance towards consumptive efficiency, at the expense of productive efficiency.

The *Kelly v Morris* approach to originality was confirmed in *Morris v Ashbee*, a case involving the same defendant (Morris) from the earlier decision, who — with some irony — apparently sought to invoke the same copyright protection he denied to exist in Kelly’s directory in order to protect his own; this protection was recognised, and he was successful:

***Morris v Ashbee* (1868) UK Ch:**

Facts

- Morris produces a trade directory comprising an alphabetical list of names and occupations of merchants and traders carrying on business in London
- Morris is now a plaintiff seeking an injunction to prevent that directory

Issue

- Is Morris entitled to copyright in the trade directory?

Reasoning (Giffard V-C)

- ‘The plaintiff incurred the labour and expense first of getting the necessary information for the arrangement and compilation of the names as they stood in his directory, and then of making the actual compilation and arrangement.’
- ‘[I]n a case such as this no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road. If this was not so, there would be practically no copyright in such a work as a directory.’ (at 40–1)

Decision

- By virtue of the labour expended and expense incurred by Morris, his directory is original and hence a copyright work

Apparently, Morris was acquiring quite a taste for this newfangled ‘copyright’: just two years later, he was yet again before Chancery pleading for another injunction in similar circumstances:

Morris v Wright (1870) UK Ch:Reasoning (Giffard V-C)

- Referring to his Lordship's earlier decision in *Morris v Ashbee*, Giffard V-C observed:
 - 'If this passage [at 40–1] goes further than what I take it to mean, I cannot doubt that it goes beyond what the law authorises. ... It does not mean that he does not look into the book for the purpose of ascertaining where a particular person lived, and for the purpose of ascertaining whether it was worth his while to call upon that person or not; but it means that he may take that particular slip and shew that to the person and get his authority as to putting that particular slip in.
- This appears to be saying that, in compiling a new trade directory, a rival is not prohibited from *using* an existing trade directory (to determine upon whom to call; ie, whose details to include), but the specifics of those details must be obtained independently

This line of authorities shows that, at least in England, originality can be demonstrated in the absence of intellectual endeavour. The *Kelly* and *Morris* decisions hold copyright to subsist purely on the basis that the plaintiff 'expended time and labour in gathering information for the compilation' (*Telstra Corp Ltd v Desktop Marketing Systems Pty Ltd* per Finkelstein J) — that the compilations were their 'sweat of the brow'.

However, where there is neither sweat of the brow nor intellectual effort, there is authority in England for the proposition that copyright does not subsist in such a compilation at all (*Hotten v Arthur*).

Hotten v Arthur (1863) UK Ch:Facts

- The plaintiff is a bookseller who claims copyright in a catalogue of his stock
- The catalogue contains the name, price and a short description of each book's contents

Issue

- Is there copyright in the catalogue?

Reasoning (Wood V-C)

- I cannot conceive on what principle it is suggested that there is no copyright in a catalogue such as this. This is not a mere dry list of names, like a personal directory, court guide, or anything of that sort, which must be substantially the same by whatever number of persons issued and however independently compiled.'
- [This latter dictum has been the subject of extensive criticism, and seems to be inconsistent with the decisions in *Kelly* and *Morris*, which would protect 'dry' compilations that would be substantially the same even when independently compiled — providing those compilations, though dry, involve sufficient effort]

Decision

- There is copyright in the catalogue

The *ratio* in *Hotten v Arthur* is not completely consistent with the accepted approach to originality (how interesting the subject matter is, after all, hardly a mater relevant to determining its originality; were it otherwise, this author suspects that a great many more legal documents would be denied copyright protection). However, the result in *Hotten v Arthur* can be explained as a

situation in which neither effort nor creativity were present, as a result of which the compilation lacked originality.

In summary, for originality to be proven it is necessary, in England, to show the following:

- That the work has not simply been copied or adapted from another; and
- In the case of a work involving some intellectual or creative contribution from its author, the simple fact of that authorship; or
- In the case of a factual compilation involving no additional contribution from its compiler, either:
 - Intellectual effort in the selection or arrangement of those facts; or
 - Expended time and labour in gathering those facts.

Naturally, the compiler is not granted a copyright monopoly over the facts themselves. Instead, he or she is granted copyright in the *form* of the compilation, which is to say, the compiled record of those facts. This means that there can be no infringement if a third party independently compiles the same facts.

(b) *The United States position*

The Supreme Court of the United States has conclusively rejected the ‘sweat of the brow’ theory of originality. An author must engage in intellectual effort of creativity and so produce an expression in order for copyright to subsist in that expression. Mere effort or labour is insufficient (*Feist Publications Inc v Rural Telephone Service Co Inc*).

Feist Publications Inc v Rural Telephone Service Co Inc (1991) SCOTUS:

Facts

- Rural is a public utility that provides telephone services in Kansas; in connection with this role, it produces white and yellow pages telephone directories for the area
- The white pages directory simply contains an alphabetical listing of the name, address and telephone number of each subscriber
- Feist publishes competing telephone directories for areas encompassing areas of Kansas
- Because Feist does not have access to the subscriber information itself, it requests permission from Rural to use its directory information
- Rural refuses permission; Feist goes ahead and uses the subscriber information anyway
- Rural sues Feist for breach of copyright

Issue

- Does copyright subsist in the white pages telephone directory?

Reasoning (O’Connor J)

- This case highlights the tension between the notion that facts are not copyrightable, but that compilations of facts are copyrightable
- The difference is that facts are not original but compilations of facts are (or, to obtain copyright protection, must be) original
- ‘Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other words), and that it possesses at least some minimal degree of creativity.’ (at 345)
- A factual compilation will be original if:
 - the selection of facts to be included is made ‘independently’ and ‘entail[s] a

- minimal degree of creativity'; or
 - the arrangement of those facts is made 'independently' and entails a degree of creativity: at 348
- The 'sweat of the brow' doctrine should be rejected because it comes dangerously close to protecting ideas:
 - If compilations of facts are copyrightable without any creativity in their selection or arrangement, then copyright creates a monopoly of public domain materials without the justification of protecting and encouraging the creation of 'writings' by 'authors'
 - [Although O'Connor J is here referring to the *United States Constitution*, art 1§8 cl 8, which grants Congress the legislative power to 'secur[e] for limited times to authors ... the exclusive right to their respective writings', this clause was, as Finkelstein J noted in *Telstra*, probably 'taken from the preamble to the *Statute of Anne*', and in any case has close parallels to the rationale for copyright protection in Australia]
- Most compilations will be original, since they will inherently involve independent and creative selections and arrangements of facts
 - However, '[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.' (at 359)
 - Thus, 'the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever' (at 362)
 - Copyright will not subsist in these compilations (or, perhaps 'mere dry lists') because they cannot be described as 'original'
- On the facts, Rural's compilation is unoriginal:
 - **[362]** Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden variety white pages directory, devoid of even the slightest trace of creativity.'
 - 'Rural's selection of listings could not be more obvious: It publishes the most basic information — name, town, and telephone number — about each person who applies to it for telephone service. This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression.'

Decision

- Rural's white pages directory lacks creative and independent selection or arrangement, and is therefore unoriginal and as such unprotected by copyright
- Therefore, as no copyright subsists in Rural's white pages, it cannot maintain an action in infringement

(c) *The Canadian position*

Shortly after the decision in *Feist*, the Canadian Federal Court of Appeal handed down *Tele-Direct (Publications) Inc v American Business Information Inc*. *Tele-Direct* follows *Feist* in rejecting the 'sweat of the brow' doctrine. Copyright will only subsist in factual compilations in Canada if they represent an original intellectual creation.

***Tele-Direct (Publications) Inc v American Business Information Inc (1997)*
Canada Fed CA:**

Facts

- The plaintiff claims, *inter alia*, copyright in the arrangement of information into a directory, which copyright it alleges has been infringed by the defendant

Issue

- Is there copyright in the directory?

Reasoning

- Décarý JA:
 - The English cases refer to ‘skill, judgment or labour’
 - By this the judges really mean ‘skill, judgment and labour’; ‘or’ is being used in a conjunctive sense
 - Authors must demonstrate both skill, and judgment, and labour in the creation of a compilation, for it to be original

Decision

- Copyright does not subsist in the directory because the publisher exercises only a minimal degree of skill or judgment in the overall arrangement of the publication
- This is insufficient originality for copyright to subsist

(d) *Current law of Australia*

The latest authority concerning the issue of originality in copyright law is *Telstra Corp Ltd v Desktop Marketing Systems Pty Ltd*. In this case, the Federal Court of Australia held that copyright subsists in Telstra’s YellowPages and WhitePages directories because their compilation involved sufficient labour and expense to make them original. The case reflects a hybrid approach to originality: either intellectual or creative effort, or ‘sweat of the brow’ (here termed ‘industrious collection’) will be adequate.

Telstra Corp Ltd v Desktop Marketing Systems Pty Ltd (2001) FCA:

Facts

- Telstra is a telecommunications company with a licence to provide telephone services in Australia
- A condition of that licence is the publication of telephone directories — lists, sorted by geographical location, of the names, addresses and telephone numbers of all subscribers to the analogue telephone network
- Desktop Marketing Systems produces a computer program called *Marketing Pro*, which is a CD-ROM database of ‘yellow and white pages listings data’; it is primarily used by businesses to conduct direct marketing activities
- Desktop Marketing concedes that the data in its computer programs was copied from Telstra’s YellowPages and WhitePages directories
- Telstra also argues (and it is not seriously disputed) that the headings (structure and layout) of its directories is also reproduced in Desktop Marketing’s products
- Telstra commences proceedings for copyright infringement
- Desktop Marketing responds by denying copyright, arguing that no copyright subsists in

Telstra's directories because they are not 'original ... work[s]'

Issue

- Are the Telstra WhitePages and YellowPages directories protected by copyright?
- That is, do they satisfy the requirement of originality imported by the *Copyright Act*?

Reasoning (Finkelstein J)

- Except for the issue of originality, it is clear that copyright subsists in the directories:
 - [The following introductory paragraphs are reproduced as, respectfully, a good example of how to apply the provisions of the *Copyright Act*]
 - 'In Australia copyright is conferred by the *Copyright Act 1968* (Cth). By s 32(2) copyright subsists in "an original literary, dramatic, musical or artistic work" that is unpublished if the author was a qualified person when the work was made or, if the making of the work extended over a period, was a qualified person for a substantial part of that period. For the purposes of the *Copyright Act* a literary work includes "a table, or compilation, expressed in words, figures or symbols": see the definition of "literary work" in s 10'
 - 'The white pages directories and the yellow pages directories have been published. Copyright in them is claimed under s 32(2). There are also books described as "headings books". ... They are unpublished. Copyright in the headings books is claimed under s 32(1). Telstra says that each directory and headings book is a literary work, being a compilation.'
- There is disagreement over the meaning of 'originality' in copyright law:
 - '[8] ... On the one hand there are those who say that copyright will only protect intellectual effort, and unless there is at least some intellectual labour in the creation of a work, it cannot be "original".'
 - '[9] On the other hand there is a school that argues that at least in respect of a compilation, the originality requirement will be satisfied if there has been some effort expended in producing the work, especially effort in gathering or collecting the factual data that is reproduced, though there be no ingenuity in the arrangement of presentation of that data.'
 - '[42] In precisely what sense a work must be original is not clear, and the resolution of that question lies at the heart of this case.'
 - '**A work will lack originality if it is copied or adapted from another. This does not mean that the subject matter of copyright must be new or novel, as is the case of an invention the subject of patent protection. To the contrary, much of what is found in literature, drama or music is not new, but nevertheless it is proper subject matter for copyright.**'
 - '[43] Originality means, at least, that the work has been created by the author. But it is not sufficient merely to establish that the work has not been copied. More must be shown to justify the grant of the statutory monopoly. But more of what? Must the author expend some intellectual effort to obtain protection? Or is it sufficient for the author to exert labour or incur expense in the production of the work?'
 - '[44] It cannot be doubted that if an author brings to bear intellectual labour in the production of his work, and does not copy that work, that will be sufficient to satisfy the requirement of originality. Thus the great body of literary works, such as novels, poems and plays, most musical works, and much that is regarded as part of the fine arts, would qualify for copyright without question. The value of the originality involved, that is whether the intellectual effort has resulted in a work of aesthetic merit, is not relevant, as copyright does not depend upon a judgment based on taste. Thus, copyright will subsist in the black paintings of the abstract expressionist Ad Reinhardt (all square, five feet by five, with a cross

that divides the surface into nine equal squares which can barely be made out whether or not a judge thinks them to be entirely meaningless.’ (emphasis added!)

- However, the requirement of originality differs when applied to a compilation
 - **[45]** ... Here we are dealing with a claim for copyright in a compilation of facts: the names, addresses and telephone numbers of thousands of individuals and businesses. At issue is whether the industrious gathering and listing of that data qualifies the work as original, or whether some additional element, such as selection or arrangement, is necessary.’

- Finkelstein J examines the English authorities, concluding as follows:
 - Clearly, where the author adds their intellectual labour, the result is original
 - Even where the author has ‘added nothing of his own to the data’, originality can consist of the ‘selection or arrangement involved’ (at [47])
 - Selection of poetry for an anthology: *Mason v Murray*
 - Selection of recipes for a ‘book on cookery’: *Rundell v Murray*
 - ‘The result in these cases can be justified because inherent in the process of selection and arrangement is some degree of creativity on the part of the author’
 - Further, even where there is no creativity in selecting or arrangement, originality can still consist of the work and expense involved in gathering the data
 - East India calendar or directory: *Matthewson v Stockdale* ([‘the work] cost [the author] a considerable expense and labour’)
 - Street directory: *Kelly v Morris* (see above)
 - Trade directory: *Morris v Ashbee* (see above)
 - Recording and writing out speeches: *Walter v Lane* (the mere industrious collection of the information was sufficient for originality)
 - Mr Scrutton has said of *Walter v Lane* that: ‘The case decides that it is not necessary that the work in which copyright is claimed should be “original” in the sense that its “author” should have invented or supplied either a single word or idea of the book, or of the arrangement of the words. He may have copied the literary composition of another from that other’s recitation without adding anything but the written reproduction of the spoken words.’
 - **[64]** I take the effect of the English authorities to be as follows. The author of a book that records facts, whether it be an encyclopedia [sic], a map, a directory or some other factual compilation, does not acquire copyright in the facts that have been published. So much is trite. But the author may have copyright in the form in which he has published the facts. Copyright will subsist if there has been sufficient intellectual effort in the selection or arrangement of the facts. It will also subsist if the author has engaged in sufficient work or incurred sufficient expense in gathering the facts. The cases have not defined with any precision what amount of intellectual effort, labour, etc, is required to justify copyright. “In each case it must depend largely on the special facts of that case, and must in each case be very much a question of degree”: *Macmillan & Co Ltd v Cooper ...*’
 - **[64]** When copyright does subsist in a compilation of facts, any person who wishes to publish the same facts is free to do so. But he must collect the facts himself. He cannot copy them from the first work.’

- Finkelstein J then examines and rejects the United States and Canadian authorities:
 - Rejects *Feist*: the requirement of originality includes ‘hard work, effort and industry’, even when the ‘modicum of creativity’ required in *Feist* is lacking
 - Cases like *Feist* (and *Hotten v Arthur*) are especially problematic where the amount of data involved is small in number: in such a case, there will, necessarily, be little selection; there may also be few choices in how to arrange

such data

- ‘So also if the volume of data that is selected is small, for the doctrine of *de minimis non curat lex* may apply.’
 - ‘*Feist* would seem to deny originality to obvious methods of grouping or listing data, such as alphabetically, chronologically, or sequentially’
 - Finkelstein J seems to be alluding to the fact that copyright is not concerned with the novelty of an idea, so this approach — premised upon novelty under the mask of creativity — must be incorrect
 - **[83]** There are policy reasons both for an against the result in *Feist and Tele-Direct (Publishers) Inc.* On the one hand, the ability to prevent others from appropriating information in a compilation of facts will severely limit the ability of later authors to build upon the earlier works. This may impair progress in both the sciences and the arts. ... On the other hand, there are those who argue that the abandonment of the “sweat of the brow” theory has threatened the progress of information. The argument is that the collection of factual material is essential to the economy. Databases provide a wealth of information to business people, professionals, scientists and consumers. If copyright protection is not given, the investment of the time and money that is required to produce these compilations will not be forthcoming’
 - **[84]** Quite apart from matters of policy, it might be said that the very nature of copyright requires the work to be the product of creative thought. The first copyright statute was enacted “for the Encouragement of learned Men to compose and write useful Books”. These books were necessarily the result of the author’s intellectual effort. That was also true of other works (engravings, sculptures, dramatic works and the like) that were given copyright protection by the early statutes. *But a compilation is of a different character from a work of art or literature.* The English cases seem implicitly to accept this proposition, because the originality requirement for a compilation could not be the same as for other works. More particularly, when it was held that copyright could subsist in a work such as a chemist’s stock list (*Collis v Cater*), the preparation of which involved no intellectual effort, it was apparent that a work could be original in the absence of creativity. The old view of originality had disappeared.’ (emphasis added)
 - **‘So, copyright protection could be claimed by a person who brought out a directory in consequence of an expensive, complicated and well-organised venture, even if there was no creativity in the selection or arrangement of the data.’**
- In Australia, the meaning of originality is different when compilations are involved, as opposed to works of art or literature
 - *Victoria Park*: for a work to be original ‘it must originate with the author and be more than a copy of other material’ (Dixon J at 511)
 - However, the work need not be novel or inventive, and ‘need show no literary or other skill or judgment’ (at 511)
 - *Data Access Corp*: does not reject the ‘industrious collection’ case law
 - The Court said: ‘Even if the skill and labour involved in devising each individual reserved word is combine and consideration given to the total skill and labour, there may still be a real question as to whether there is sufficient originality for copyright to subsist in the combination.’
 - Desktop Marketing argues that this comment is a rejection of the ‘industrious collection’ cases
 - ‘To the contrary, the High Court appears to accept that a compilation made up of words that are arranged in a particular order may be copyright if there is some sense to the order in which the words are placed.’

- Thus, all the comment means is that, on the facts in *Data Access Corp*, not much effort appears to have been expended in selecting and arranging the keywords, so that, if they are to be protected as original works, their originality must be proven on another basis; in fact, this statement implicitly accepts the validity of the proposition that originality can be based upon effort
- Application to the facts
 - The Telstra directories and the headings in those directories are compilations
 - 'But this is not how the question of copyright must be determined in relation to a complete word. The correct approach is to look at the whole work and inquire whether it is protected by copyright.' (at 159)
 - See *Ladbroke (Football) Ltd*: start by asking 'whether the plaintiff's work as a whole is "original" and protected by copyright, and then ... inquire whether the part taken by the defendant is substantial. ... To my mind, it does not follow that, because the fragments taken separately would not be copyright, therefore the whole cannot be. Indeed, it has often been recognised that if sufficient skill and judgment have been exercised in devising the arrangements of the whole work, that can be an important or even decisive element in deciding whether the whole as a whole is protected by copyright.' (emphasis added)
 - '[90] When each directory is considered as a whole it will be seen to be original. If skill is required, sufficient skill has been employed in its creation. In this connection reference need only be made to the information pages, which comprise partly a listing of data and partly important information written in prose, such as one might find in an encyclopedia [sic] of facts.'
 - Given that copyright subsists in the directories, Desktop Marketing has infringed that copyright
 - It has reproduced the being the contents of the directory and most of its headings
 - The right to 'reproduce the ... work in a material form' is an exclusive right of the copyright owner, Telstra, under s 31(1)
 - 'The effect of s 14 is that there will be copyright infringement if the reproduction is of the whole work or "a substantial part of the work". Whether a part is substantial must be decided by its quality.'
 - What is a substantial part is determined by looking at 'the importance which the taken portion bears in relation to the work as a whole' and by asking 'is it an "essential" or "material" part of the work?' (*Autodesk [No 2]* per Mason CJ)
 - Here, the directory portion of the white pages directories, the directory portion of and headings in the yellow pages directories and the headings books 'are original and essential features of the respective works'
 - 'It would be otherwise if the "industrious collection" view of originality were rejected' (at [93]) because the both the headings and the directories' contents are 'garden-variety' without 'even the slightest trace of creativity', so that, since no intellectual effort is involved, Telstra 'cannot claim copyright protection for their efforts' (this is, of course, if the 'industrious collection' or 'sweat of the brow' theory of originality was rejected, which it isn't)
 - Finkelstein J appears to be making an alternative finding of fact in the event that his Honour's construction of originality is overturned on appeal
 - Although Desktop marketing's products are arranged very differently from Telstra's products, 'the differences ... are in the detail' and 'the significant recorded facts (name, address, telephone number and the relevant type of business) are the same, or substantially the same [some

minor changes had been made: eg, 'Rd' to 'Road'], as they appear in Telstra's works.'

- '[109] As regards the headings, it is true that they appear once only in each yellow pages directory and that the heading appears with each business entry in the CD-ROMs. This difference is immaterial. All the headings have been taken, as have all the listings beneath those headings. The appearance of the headings and the listings in the CD-ROMs is sufficiently similar to constitute a reproduction.'

Decision

- The directories and headings books are sufficiently original to be the subject of copyright
- This is because their compilation required enough labour and expense to justify protection under the 'sweat of the brow' or 'industrious collection' doctrine
- Because Desktop Marketing has reproduced in a material form a substantial part of those works, it has infringed Telstra's copyright

Justice Finkelstein's comments about *Data Access Corp* (below) are interesting. If a work is simply the compilation of individual words, what does this say about books and other literary works? Each word is, after all, a generic fact — *publici juris* and presenting no difficulty to gather or collate. Surely, in such a case, originality depends only upon the selection of such words and the order in which they are placed — this is the difference between *Hamlet* and *The Da Vinci Code*: the order and selection of words. What, then, does this say about factual compilations whose atomic units are not so easily acquired as dictionary words? Nothing. It is entirely possible that the skill or effort required to gather the units of a compilation will equally provide a basis on which to protect the originality of the resulting database as would the effort (of an entirely different, intellectual kind) in selecting, arranging or presenting those units.

As a result of *Desktop Marketing Systems v Telstra*, several propositions may be stated summarily about the nature of originality in Australian copyright law:

- (a) For a work to be original, it must not have been entirely copied or adapted from another work;
- (b) A work of the ordinary kind will be original if it involves some creative or intellectual input by its author;
- (c) If a work is simply the compilation of facts, a different test applies, so that creative or intellectual input may be demonstrated by the manner in which the facts are selected or arranged; however
- (d) Even if there is no creativity or intellectual effort demonstrated by such a selection or arrangement, the work may still be original if the compilation is the product of an expensive, complicated and well-organised venture;
- (e) Therefore, databases can be protected as original works in which copyright subsists if their contents were especially selected or arranged, or if their gathering exceeded some undefined threshold of labour.

According to the Copyright Law Reform Committee, this standard of originality is 'fairly low', and it seems likely that most databases would attract copyright protection.

D Material Form

1 Works and material form

Copyright cannot subsist in works until they have been expressed in 'a material form'. A work is created at the moment when it finds tangible existence in such a form:

Copyright Act 1968 (Cth) s 22 — Provisions relating to the making of a work or other subject-matter:

- (1) A reference ... to the time when ... a literary, dramatic, musical or artistic 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.

For the purposes of the Act, then, a work does not exist until it has 'first [been] reduced to writing or to some other material form': s 22(1).

For completeness, the definition of 'writing' is included:

Copyright Act 1968 (Cth) s 10(1):

writing means a mode of representing or reproducing words, figures or symbols in a visible form.

Specific deeming provisions in s 22 apply in relation to other types of works and subject matter. For example, a work that consists of sounds is deemed to be reduced to a material form when those sounds are embodied (recorded) in an article, such as a cassette tape:

Copyright Act 1968 (Cth) s 22 — Provisions relating to the making of a work or other subject-matter:

- (2) ... a literary, 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.

However, note that not all subject matter under the Act must exist in this form; broadcasts, for example, need not be reduced to material form: s 22(5). The specific requirements for pt IV subject matter are dealt with separately below in section IV.

2 The meaning of 'material form'

The phrase 'material form' is defined in s 10(1):

Copyright Act 1968 (Cth) s 10(1):

material form, in relation to a work ..., includes any form (whether visible or not) of storage of the work ..., or a substantial part of the work ..., (whether or not the work ..., or a substantial part of [it] can be reproduced).

The current definition of 'material form' is the result of recent amendments to the *Copyright Act* brought about by the Australia–United States Free Trade Agreement. The new definition is far more expansive than its predecessor, which required that the work be capable of being reproduced from the form of storage:

Copyright Act 1968 (Cth) s 10 [repealed]:

material form in relation to a work includes any form (whether visible or not) of storage from which the work can be reproduced ...

As a result of this amendment, many more forms of storage may be considered 'material'. As Ricketson pithily remarks, even the gestation of a work as an idea in the human brain may now be considered a 'material form', since neurons need not be visible, and need not be capable of reproducing the work. Less metaphysically, a form of computer storage that is strongly encrypted may also be a material form, despite the fact that the encryption may be impossible to break.

Regardless of this expansion, however, some form of storage is required. Thus, the spectacle in *Victoria Park Racing Co v Taylor*, for example, would still fail to receive copyright protection unless recorded in some way. On the face of the new definition, the scorecard that was displayed and spied by the defendants would probably amount to a literary work, which came into existence at the point when it was reduced to writing. However, as Latham CJ and Rich J noted in that case, the scorecard lacked any originality: it was a compilation of facts lacking in ingenuity or effort, and was not treated as a literary work for that reason.

Doubtless, however, the impermanence of the exhibition also weighed upon the Court's characterisation of the work as unoriginal, suggesting that material form may have a broader role to play in determinations of subsistence — or, at least, a role beyond that which its comparatively undemanding form would presently suggest.

3 *The rationale of requiring 'material form'*

The requirement that an expression be stored in a material form begins to make sense when it is remembered that the exclusive rights comprising copyright would be wholly illusory if the subject to which they attached was lost, or not actually *capable* of being copied, published or communicated. Material form serves to preclude fleeting or ephemeral expressions from receiving protection.

The material form requirement serves four further purposes. First, it acts as a kind of *de minimis* threshold, preventing copyright from subsisting in trivial or temporary reproductions, such as

electrical circuits within a computer memory. Although copying may occur in such contexts, it would be unduly oppressive to users to extend protection to purely transient, abstract signals.

Second, the material form requirement reflects the idea–expression dichotomy, explored above. Ideas and information cannot receive copyright protection until they are expressed in some concrete fashion — that is, in a material form. This is consistent with the notion that copyright attaches not to the idea or information itself, but to the form in which it is expressed. By requiring that form to be material, copyright law is essentially requiring there to be a sufficiently identifiable instance of an expression.

Third, it serves an evidentiary purpose, as noted by Ricketson. For the author of a work to be properly identified, that work must be capable of identification with sufficient precision after the fact: if a mere utterance could constitute a work, then it would be forensically very difficult to establish its provenance.

Finally, the material form requirement harmonises the criteria for subsistence with those of infringement. Because any infringing copy of a work must also exist ‘in a material form’, it makes sense to require the same of the original.

E Substantiality

The final subsistence requirement for works is that the work be something more than merely trivial. That is, copyright will not attach to expressions that are so small or insignificant as to lack the quality of a ‘work’.

1 Source of the requirement

This requirement is implicit in a proper construction of the text of *Copyright Act* s 32, which states that copyright will subsist in ‘works’ that meet the preceding requirements. It is derived as follows. The word ‘work’ must be construed in accordance with the principles of statutory interpretation, both under the *Acts Interpretation Act 1901* (Cth) and at common law. At common law, a cardinal principle of statutory interpretation is the maxim *de minimis non curat lex* (‘the law does not concern itself with trifling matters’). This expression has application to statutes as importing an implied limitation upon all statutory requirements that the consequence prescribed by a statute will not take place where those statutory requirements are satisfied ‘only to a very small extent’.²

Applying this principle to the definition of the word ‘works’ entails that, even where the express subsequence requirements are met, no relevant work will exist where it meets those requirements in only a trivial way. The ‘applicability or otherwise of the maxim depends upon the context in which it falls to be considered’ (*Farnell Electronic Components Pty Ltd v Collector of Customs*), so that substantiality may be less of an issue where an apparently insubstantial work of fine art is created, as distinct from mindless jottings, shapes or lines. Certainly, this contextual approach has immunised the inscrutable works of Ad Reinhardt from Finkelstein J’s apparent irreverence for minimalist art.

The only context in which substantiality is ever really an issue is where copyright is claimed over works comprising a single word or symbol (such as a letter, line or circle). Courts have expressed understandable reluctance to grant copyright protection to such words.

² *Halsbury’s Laws of England* (4th ed) 44(1), [1441].

2 Examples of application

One example of a work that fails to meet the threshold of substantiality is provided by *Exxon Corporation v Exxon Insurance Consultants International Ltd*. In this case, copyright was denied in the single word 'Exxon' — not on the basis of the *de minimis* maxim (though the result could also be justified on this basis), but rather because it failed to meet the requirement of 'coherency' entailed by the phrase 'literary work'.

The precise kind of coherency said to be required will vary with the kind of work for which protection is sought. In the case of a literary work, it must afford 'information, instruction or pleasure in the form of literary enjoyment'. At least one of these three factors was said to be inherent in the notion of an 'original literary work'.

As regards other kinds of work, the requirements will vary. In *Green v Broadcasting Corporation of New Zealand*, for example, the Privy Council held that catchphrases on a game show were not amenable to copyright protection because 'a dramatic work must have sufficient unity capable of performance', and those phrases lacked such unity.

Exxon Corporation v Exxon Insurance Consultants International Ltd (1982) **UK CA:**

Facts

- Exxon Corp claims, *inter alia*, copyright in the single invented word 'Exxon', which they claim to be an original literary work

Issue

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

Reasoning (Stephenson LJ)

- The word 'Exxon' is original because it is the product of labour, skill and expertise
- The word 'Exxon' 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 trade mark
 - The Court of Appeal approves the comments of the trial judge, Graham J
 - Graham J compared 'Exxon' to 'jabberwocky', a word invented by Lewis Carroll
 - The word 'jabberwocky' may be protected as part of a larger work, such as the poem 'Jabberwocky', but 'the word itself and by itself cannot be considered a literary *work*' (emphasis in original)
- '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 therefore 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
 - It is therefore not a work

Decision

- No copyright subsists in 'Exxon'

Issues of statutory construction aside, two policy considerations seem to underlie this result. First is that the protection of a raw word — the building blocks of other works and now commonly understood to provide the foundation for thought itself — would effectively be protecting a fact or an idea. There is only one possible expression of a word. Copyright protection in single words would therefore sit uneasily with the notion of a dichotomy between idea and expression.

The second policy issue is that, in affording such protection, copyright may be seen to be intruding too far into the sphere of the trade mark regime, which already places clear limits on the intellectual property rights associated with individual trade signifiers. If copyright were to protect these words independently, such limitations — and the careful balance between freedom of expression and industrial protection that they represent — would be rendered all but illusory.

III Works: Categories of Protection

A Literary Works

1 Definition of 'literary'

Section 10(1) of the *Copyright Act* defines 'literary work' as encompassing both textual materials and computer programs:

Copyright Act 1968 (Cth) s 10(1):

literary work includes:

- (a) a table, or compilation, expressed in words, figures or symbols; and
- (b) a computer program or compilation of computer programs.

Because each limb raises substantially different issues of fact, they are dealt with separately.

2 Tables and compilations expressed in words, figures or symbols

The scope of this first limb of the definition of 'literary work' is extremely broad. It encompasses potentially any written, printed or textual matter.

(a) Literary merit not required

A work does not need to exhibit literary merit before it will be treated as a literary work. Thus, while their literary merit is open to question, the following have all been classified as 'literary works':

- A catalogue of furniture (*Maple and Co v Junior Army and Navy Stores*);
- A list of bills of sale (*Trade Auxilliary Co v Middlesborough and District Tradesmen's Protection Association*);
- A chemist's catalogue (*Collis v Cater, Stoffel and Fortt Ltd*);
- A list of solicitors and their addresses (*Waterlow Directories Ltd v Reed*);
- A football betting coupon (*Ladbroke (Football) Ltd v William Hill (Football) Ltd*);
- A computer compression table (*Data Access Corporation v Powerflex Services Pty Ltd*); and
- A collection of recipes, charts and menus (*Skybase Nominees Pty Ltd v Fortuity Pty Ltd*).

'Literary', then, simply means 'literature'. It refers to any 'written or printed matter'. This is a neutral description and does not import any requirement of quality or merit.

That this is so was confirmed in *University of London Press*:

University of London Press Ltd v University Tutorial Press Ltd (1916) UK Ch:

Reasoning (Petersen J)

- ‘In my view the words “literary work” cover work which is expressed in print or writing irrespective of the question of whether the quality or style is high. The word “literary” seems to be used in a sense somewhat similar to the word “literature” in political or electioneering literature and refers to written or printed matter.’
- ‘Papers set by examiners are, in my opinion, “literary work” within the meaning of the present Act.’

(b) *Alphanumeric representation not required*

Because a literary work may be ‘expressed in words, figures or symbols’ (s 10(1)), it need not be represented in alphanumeric characters, such as words.

Literary work therefore includes such tables or compilations as:

- Blank billing forms (*Kalamazoo (Australia) Pty Ltd v Compact Business Systems Pty Ltd*); and
- Lists of newspaper bingo numbers (*Express Newspapers plc v Liverpool Daily Post and Echo plc*).

(c) *Information, instruction or pleasure required*

The preceding two sub-headings have set out negative requirements that attest to the breadth and flexibility of the notion of a ‘literary work’. What, then, is its positive content?

Hollinrake v Truswell (1894) UK Ch:

Facts

- The plaintiff claims, *inter alia*, copyright in a piece of cardboard shaped like a woman’s arm; printed on the cardboard are several words and figures;

Issue

- Is the sleeve chart a literary work?

Reasoning (Davey LJ)

- ‘Now, a literary work is intended to afford either information and instruction, or pleasure, in the form of literary enjoyment. The sleeve chart before us gives no information or instruction. It does not add to the stock of human knowledge or give .. any instruction by way of description or otherwise; it is certainly not calculated to afford literary enjoyment or pleasure. It is a representation of the shape of lady’s arm, or more probably of a sleeve designed for a lady’s arm, with certain scales for measurement upon it. It is intended, not for the purposes of giving information or pleasure, but for the practical use in the art of dress making.’ (at 428).

Decision

- The sleeve chart is not a literary work

Works held to afford 'information and instruction, or pleasure, in the form of literary enjoyment' include:

- Text codes consisting of foreign or invented words (*DP Anderson and Co Ltd v Lieber Code Co*); and
- Computer source code (*Computer Edge Pty Ltd v Apple Computer Inc*).

Works that have been said not to meet these requirements include:

- A sleeve chart for practical use in dress making (*Hollinrake v Truswell*); and
- A single invented commercial trade mark (*Exxon Corporation*).

This suggests that a relatively broad view of information, instruction and literary enjoyment will be taken, and that text with purely commercial purposes may be less likely to afford enjoyment.

Computer Edge Pty Ltd v Apple Computer (1986) HCA:

Issue

- Is the object code of a computer program (machine-code consisting purely of 0s and 1s) a literary work?

Reasoning

- Beaumont J (trial judge):
 - No, the object code cannot afford information, instruction or literary pleasure and therefore cannot be considered a literary work
- Full Court of the Federal Court: issue not raised
- High Court of Australia: (2:2) split on whether object code is a literary work
 - Gibbs CJ:
 - 'It seems to me a complete distortion of meaning to describe electrical impulses which cannot be perceived by the senses and are not intended to convey any message to a human being and which do not represent words, letters, figures, letters, figures or symbols, as a literary work; still less can a pattern of circuits be so described.' (at 184)
 - Thus, to be a literary work, there must be something conveyed to a human being out of the representation
 - Mason and Wilson JJ:
 - The 'information, instruction and literary enjoyment' formulation is not 'comprehensive or exhaustive'
 - Works may be literary works even if they do not meet any of the three criteria identified by Davey LJ in *Hollinrake v Truswell*
 - 'It is not correct to describe an object program as *merely* a sequence of electrical impulses within the computer. Electrical impulses there are, but these impulses serve to identify a set of instructions in machine readable language designed to guide the machine in its basic operations.' (at 194)
 - For this reason, those impulses are a form of representation that will amount to a literary work
 - [Arguably, though, this still fits within the '*Hollinrake trifecta*' as affording instruction to the computer, if not the reader]

Largely as a result of this decision, amendments to the *Copyright Act* were introduced in the following year to provide interim protection to computer programs under a second limb to the definition of 'literary work'.

Note that simply being in digital form is no barrier to protection of text as a literary work (*A-One Accessory Imports Pty Ltd v Off Road Imports Pty Ltd*, holding online catalogues to be literary works).

'What's worth copying is worth protecting' (*dicta*)

Note High Court's refutation of this dictum: [*Network Ten Pty Ltd v TCN Channel Nine*].

3 Computer programs

Section 10(1) defines 'computer program' in a very general fashion, by reference to instructions:

Copyright Act 1968 (Cth) s 10(1):

computer program means a set of statements or instructions to be used directly or indirectly in a computer to bring about a certain result ...

Despite its brevity, this definition is actually quite narrow. It only protects the source code of a computer program, and excludes from the definition data used by the program or the look and feel of the program. Although copyright may subsist in these elements, if it is to do so it must be because they fall within another category of protected subject matter.

All works and subject matter are ultimately produced with the intention to be perceived by a human, except computer programs. For this reason, was suggested, when the issue was a live one in the late 1980s, that their protection should be *sui generis*. However, this debate was ultimately silenced by the prescription of protection in the form of a 'literary work' by the *Agreement on TRIPS*.

In *Data Access Corp v Powerflex Services Pty Ltd*, the High Court of Australia observed that an item must meet three requirements to be classified as a computer program:

- **Expression of a relationship to byte code**
The item must express an algorithmic or logical relationship to a computer's low-level functions. For example, it may be intended to be capable of translation by means of a compiler into something understood and able to be executed by the computer. The qualification 'intended' is used so that programming errors ('more commonly known as "bugs"', observes the Court) do not affect the subsistence of copyright, even if they prevent a program *actually* being so compiled;
- **Expression of a set of instructions**
The itself item must contain a set of instructions in a language of some description; and

- **Functional design**

The item must be intended to achieve a particular function.

On the facts, the Court held that individual reserved words could not individually amount to 'set[s]' of instructions. This was because they did not express a relationship to the underlying executable code: the keywords could be substituted for any other words and yet still carry out the same function. Similarly, a simple list of the reserved words is not a computer program because it is not intended to carry out any function. It then follows that the set of reserved words cannot be a 'compilation of computer programs', those words not, individually, being computer programs.

Data Access Corp v Powerflex Services Pty Ltd (1999) HCA:

Facts

- Data Access owns the copyright in a database-generation program called Dataflex
- Powerflex owns a competing program called PFXplus
- Powerflex wants to ensure that its software is compatible with Dataflex, so it reproduces 192 of the constructors employed in Dataflex
- These constructors consist of reserved words ('SAVE', 'DRIVE', 'DIRECT', 'EDIT', 'BOX', 'RETAIN', 'ENTAGAIN', 'KEYPROC') that are used to generate program source code performing associated functions in precompiled object code
- Data Access argues that copyright subsists in these reserved words either:
 - (i) individually as computer programs; or
 - (ii) collectively, as a collection of computer programs
- There are 254 keywords utilised by Data Access; of these, some 192 are reproduced by Powerflex
- Data Access argues that copyright will protect the 'meaning and syntax of the word or command in question'

Issues

- Can copyright subsist in the reserved words used in a high-level programming language as computer programs, or compilations of computer programs, under s 10(1)?
- Will it protect 'meaning and syntax' as Data Access argues?
- If so, does Powerflex's use of the reserved words constitute infringement?

Reasoning

- Jenkinson J (trial judge):
 - Each reserved word is a computer program under the 1984 definition
 - They are translations of the set of instructions that cause the computer to perform the assigned function
- Full Court of the Federal Court of Australia:
 - The words are not themselves an expression of the set of instructions that performed these associated functions
 - The words are simply mere 'triggers'; the analogy is drawn to the 'start' button on a washing machine; it is not the button that causes the clothes to be washed; rather, it activates some internal process to perform that associated function
 - 'Mere trigger[s]', it is said, do not attract copyright protection (though precisely why is not stated)
- High Court of Australia: Gleeson CJ, McHugh, Gummow and Hayne JJ —
 - Subsistence:
 - No, the individual words are not computer programs; yes, the set of words are a computer program when considered collectively

- Definition of computer program:
 - For an item in a particular language to be a computer program, it must express an algorithmic or logical relationship between the function desired to be performed and the physical capabilities of the computer
 - '[S]omething is not a "computer program" within the meaning of the definition in s 10(1) unless it is intended to express, either directly or indirectly, an algorithmic or logical relationship between the function desired to be performed and the physical capabilities of the "device having digital processing capabilities". Thus, in the sense employed by the definition, a program in object code causes a device to perform a particular function "directly" when executed. A program in source code does so "after ... conversion to another language, code or notation".'
 - '[58] It is the ability to express in a computer language an algorithmic or logical relationship between an identifiable function which is desired to be performed and the physical capabilities of the computer, which is the true skill of the programmer. This remains true even if the programmer is working via the medium of a high level language and is unaware of the physical capabilities of the computer. It is the expression of this skill which is intended to be protected by the Act.'
 - Whether an expression is a computer program depends on the specific language of each expression (at [61])
- The reserved words do not express an algorithmic or logical relationship that causes the computer to function
 - This is because they do not themselves express the associated instructions
 - Further, they are not a translation (conversion) of such a relationship
- Meaning and syntax: no, copyright will not protect the function that will be executed by a particular keyword
 - The nature of this function depends entirely on the code underlying the reserved word
- The meaning and syntax of the words *per se* are not a relevant copyright 'expression'
 - However, the underlying *sets* of instructions associated with the reserved words is protected as an expression

Decision

- No copyright subsists in the reserved words themselves, and certainly not in their underlying referenced functions
- This is because the keywords do not instruct the computer to do anything — they depend for their effect on the underlying code; consequently, they are not used 'directly or indirectly' by the computer

Note that *Data Access Corp* was decided in light of an old definition of 'computer program', which protected underlying 'relevant data'. However, this inclusion does not appear to have affected the result, with the effect that the narrower definition presently in use would be likely to yield the same outcome.

One interesting comment made in *Data Access Corp* concerns the interaction between the scope of a computer program and the assessment of its originality. Originality, it is said, must be assessed only with respect to such part of a work as constitutes the protected computer program. Because the reserved words were individual words (and hence lacking in substantiality) comprised largely of English words or concatenations thereof, even if the reserved words were computer programs, they would be insufficiently original to qualify for protection.

B Dramatic Works

1 Scope of 'dramatic'

Whereas literary works are intended to be read by humans, dramatic works are intended to be performed to humans. The typical mode of consumption of a dramatic work is therefore by watching it, though some dramatic works — such as lyrics or screenplays — may also be read.

Dramatic works are given an inclusive definition by the *Copyright Act*:

Copyright Act 1968 (Cth) s 10(1):

dramatic work includes:

- (a) a choreographic show or other dumb show; and
- (b) a scenario or script for a cinematograph film;

but does not include a cinematograph film as distinct from the scenario or script for a cinematograph film.

The current definition of 'dramatic work' is less explicit than its predecessor in the *Copyright Act 1905* (UK). Section 4 of that Act set out dramatic work in terms of 'any tragedy, comedy, play, drama, farce, burlesque, libretto of an opera, entertainment or other work of like nature, whether set to music or other scenic or dramatic composition'. Presumably, by removing this exhaustive list, the legislature intended to broaden the definition of 'dramatic work'.

What constitutes a dramatic work is generally uncontroversial — especially where the work involves the traditional categories of drama, like those previously the subject of statutory enumeration. However, several problematic situations can arise; these are now considered. Taken collectively, they illustrate several properties about the nature of dramatic works to which the s 10(1) definition no longer makes express reference.

2 Script elements and television formats

In order to constitute a dramatic work, there must be something that can be described with certainty or 'unity' that is sufficient to enable repeat performances (*Green v Broadcasting Corporation of New Zealand*).

Typically this will be by way of a full script. More generic structural elements will not be capable of giving rise to a dramatic work unless they exhibit that unity (ie, are amenable to repeat performance). Instead, such elements will usually be mere 'accessories' to the *actual* dramatic performance, lacking in sufficient 'unity'. On the facts in *Green*, simply identifying catch phrases and certain events was too exiguous to give rise to a dramatic work.

Green v Broadcasting Corporation of New Zealand (1988) PC:Facts

- Green is the presenter of an English television show entitled *Opportunity Knocks*, a talent search, which is aired between 1956 and 1978
- In 1975 and 1978, BCNZ broadcasts a show under the same title in New Zealand
- Green commences proceedings, arguing (*inter alia*) that BCNZ has infringed copyright in the 'scripts and dramatic format' of *Opportunity Knocks*
- Green does not adduce any evidence of a script from the English show

Issue

- In the absence of any evidence of scripts, can the 'dramatic format' of the show give rise to a dramatic work in which copyright subsists?

Reasoning (Lord Bridge)

- Ongley J (trial judge):
 - 'There was really no evidence that any part of the show was reduced to a written text which could properly be called a script'
 - 'No writing has been produced in evidence in this action in which, in my view, copyright could subsist'
- Court of Appeal of New Zealand:
 - Accepts evidence establishing the existence of written scripts
 - Evidence of their contents is, however, 'exiguous in the extreme'
 - Evidence is led that the show always ends with the words 'Make your mind up time', involves the use of a 'clapometer', and the selection of five contestants
 - Therefore, the scripts 'did not themselves do more than express a general idea or concept for a talent quest and hence were not the subject of copyright'
- Privy Council:
 - 'In the absence of precise evidence as to what the scripts contained, their Lordships are quite unable to dissent from this view.'
 - 'Dramatic format' refers to 'those characteristic features of the show which were repeated in each performance'
 - These are:
 - The title of the show
 - The use of the phrase 'For [name of competitor] Opportunity Knocks'
 - The use of the phrase "This is your show folks, and I do mean you", etc
 - The notion that a number of 'allegedly distinctive features' may be extracted from successive performances of a television show and 'identified as an "original dramatic work"' is an issue of 'difficulty' (at 25)
 - To be protected, a dramatic format must be described with certainty; *Opportunity Knocks* is 'conspicuously lacking in certainty'
 - 'Moreover, it seems to their Lordships that a dramatic work must have sufficient unity to be capable of performance and that 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.' (at 26)

Decision

- Appeal dismissed; the dramatic format was insufficiently precise and lacked unity

See now *Nine Films & Television Pty Ltd v Ninox Television Ltd*, which does not discount the possibility of copyright subsisting in a dramatic format *per se* work, but which emphasises the need for a direct comparison between the dramatic work comprising each performance of a television show and the show that is alleged to infringe it.

Clearly, the script of a television show is ‘capable of performance’ in the fashion required by *Green*. The fact that a script may require performance by ‘characters’ rather than human beings does not appear to be relevant. However, repetition of the performance is important — a random or unpredictable process cannot be a dramatic work, especially if it lacks a plot (*Aristocrat Leisure Industries Pty Ltd v Pacific Gaming Pty Ltd*).

Aristocrat Leisure Industries Pty Ltd v Pacific Gaming Pty Ltd (2000) FCA:

Issue

- Does copyright subsist in a written description of the circumstances in which a digital poker machine would display a video racing match allowing the player to win money, as a dramatic work?

Reasoning (Tamberlin J)

- The poker machine descriptions ‘lack the element of *performance* by characters, and are insufficiently predetermined.’
- ‘There is no apparent “plot”, nor is there any choreography, script, characterisation or interaction between characters and there is a strong element of unpredictability and randomness. None of these elements are essential or individually determine the question, but, weighing them cumulative, I am led to the conclusion that the specifications do not give rise to any dramatic work.’ (at 44)

Decision

- No dramatic work subsists in the written specification

3 *Scenes*

Photographic scene secretly photographed by tabloid with telescopic lens — published prior to release of album — arrangement of items around swimming pool argued to be a dramatic work (among other things).

Creation v News Group: ‘inherently static’ nature of the scene and constituent objects; therefore not protected. However, interlocutory relief granted for breach of confidence.

Creation Records Ltd v News Group Newspapers Ltd (1997) UK Ch:Facts

- To produce the cover of an upcoming album, the band Oasis assembles several objects in the yard of a hotel in Hertfordshire
- The scene is arranged by Gallagher, the band's lead guitarist, and includes such objects as a swimming pool (in which a Rolls Royce is seemingly emerged), the rear of the Hotel, a wooded area, the members of the band, a scooter, and various other objects:



- This scene is photographed and becomes the cover image of the album *Be Here Now*
- Although members of the public are permitted to view and photograph the scene prior to the photographic shoot, the area is cordoned off during the shoot, and photography is limited to band members rather than the yard arrangement
- Seeburg is a photographer employed by *The Sun*, a tabloid newspaper operated by the defendant
- Seeburg visits the set and obtains covert photographs of the shoot, which are subsequently published in *The Sun*
- Creation Records, which has a licence from the band's publisher to deal with its recordings in the United Kingdom, seeks an interlocutory injunction restraining further publication of the photographs
- The plaintiffs argue that publication infringes copyright subsisting in the photographs as (*inter alia*) dramatic works

Issue

- Can the arrangement and composition of the scene be considered to be a dramatic work in which copyright subsists?

Reasoning (Lloyd J)

- No, the scene is 'inherently static'; it has no movement, story or action, and therefore cannot be considered a dramatic work
 - '[4] [Counsel] argued faintly that [the scene] was a dramatic work.'

- '[4] Since the scene is inherently static, having no movement, story or action, I cannot accept [that it is a dramatic work].'
- The scene does not fall within any of the other categories of work
 - Sculpture: no element had been carved, modelled or made, so the scene is not protected as a sculpture
 - Artistic craftsmanship: it is merely an assembly of '*objets trouvés*', so there is no craftsmanship
 - Collage: the scene does not involve 'sticking ... two or more things together', so the arrangement of 'such random, unrelated and unfixed elements' cannot be considered to be a collage
 - Photograph: Seeburg did not copy *from* the plaintiffs' own copy of the photograph, so there is no derivational infringement on this basis, even though the pictures look identical
- Copyright subsists in *The Sun* photograph separately, held initially by Seeburg and assigned or imputed to the defendant as employer

Decision

- Therefore, the scene is not protected by copyright and this does not disclose a basis for an injunction
- However, in light of the security measures deployed to prevent public access to the scene and 'the nature of the operation', the information comprising the scene is confidential
- Further, since Seeburg must have taken a covert photograph in a restricted area, he must have known that the circumstances imported an obligation of confidence
- Therefore, a prima facie case may be made that publication is in breach of confidence and an interlocutory injunction is granted

In *Creation Records*, Lloyd J proposed several indicia of a dramatic work:

- Dynamic (not static);
- Movement; and
- Story or action.

These factors are consistent with the view that a dramatic work involves an expression taking place, at a minimum, across a chronological continuum: whereas a scene or arrangement occupies an infinitely short amount of time, poetry, lyrics, moving displays, plays, scripts or lyrics direct attention for the duration of their performance. Consequently, a scene that embodied a temporal dimension — for example, a multimedia display telling a story of some kind — may well be protected as a dramatic work.

4 *Public events*

If a public event is scripted or choreographed in some fashion, it may be that the script of choreography qualifies as a dramatic work.

One important quality of a dramatic work is that 'the action must be staged, contrived or directed and not simply recorded' (*Australian Olympic Committee Inc v Big Fights Inc* per Lindgren J). In that case, films of sporting events from the 1956 Melbourne Olympic Games were held not to be dramatic works because they lacked these qualities of staging, contrivance and directorship. These requirements bear especial resemblance to the notion of 'unity' and capability for repeat performance identified by the Privy Council in *Green*.

However, it is, of course, crucial that the public events be reduced to material form. The difficulty of doing so proved fatal for the applicant in *Nine Network Australia Pty Ltd v Australian Broadcasting Corporation*.

***Nine Network Australia Pty Ltd v Australian Broadcasting Corporation* (1999) FCA:**

Facts

- Channel Nine provides money to the Council of the City of Sydney for the purpose of a New Year's Eve fireworks celebration of the new millennium
- Nine Network seeks to restrain the ABC from broadcasting the fireworks display, which is fully choreographed and timed, but not yet performed or recorded

Issues

- Can the fireworks display and associated lantern parade be considered a dramatic work?
- If so, can a *prima facie* case be made that broadcasting by the ABC would amount to infringement?

Reasoning (Hill J)

- Nine Network's argument that the event constitutes a dramatic work is not strong
- The choreography for the fireworks display is not a work because its reduction to material form is not guaranteed: timing errors or rocket misfiring may prevent the schedule from ever being followed precisely
- Consequently, the fireworks that would be displayed would have no counterpart in material form, and would never become a work of any kind
- 'At the heart of the problem may well be that copyright is a monopolistic right existing not to protect ideas as such but the physical manifestation of some ... work'
- In any event, broadcasting by the ABC would probably be fair dealing for the purpose of reporting news

Decision

- Although full argument could not be heard, it is unlikely that the fireworks display would constitute a dramatic work, since it would be neither reproducible nor set down in material form with sufficient precision
- The injunction is not granted

5 Poetry

Poetry is a grey area; if spoken, it may potentially be a dramatic work. However, it may also be a literary work. Certainly, if poetry exists in a purely written form, the tendency is to treat it as a literary work. However, as a script for performance, it may also be considered a dramatic work. The precise classification is immaterial, however, since the same rights attach to each form of expression. Indeed, it is entirely possible that a given sheet of poetry might comprise both literary and dramatic works.

6 Music

Similarly, music consists of both a musical work (the notes, such as the melody, harmony, rhythm, and so on) and a separate *dramatic* work in the form of the lyrics. Those lyrics would probably be a dramatic rather than a literary work, since they form

C Musical Works

1 Definition

The *Copyright Act* does not define the phrase ‘musical work’. However, like ‘dramatic work’, it was previously defined in the *Copyright Act 1905* (Cth). That definition was couched in terms of ‘any combination of melody and harmony, or either of them’: s 4. Presumably, the removal of this qualification was, as in the case of dramatic works, intended to broaden rather than to confine the category. Electronic and synthesised music without discernable melody or harmony may now be protected as musical works, for example.

The term ‘musical’ almost certainly refers to the method of production, rather than to an aesthetic quality (melody) that the resulting work is required to possess. Musical works might exist in the form of scores. They may also comprise other works, such as dramatic or literary works (lyrics, staging, choreography, and so on).

Like the notion of a ‘dramatic work’, a musical work is generally intended not to be read by human beings, but rather heard by an audience of human beings. Its *raison d'être* consists in its performance and aural reception. However, to define the concept of ‘music’ with precision is — like its counterpart definitional problem in the realm of the visual arts — a matter of great difficulty.

2 Cover songs and remixes

Issues of particular difficulty are associated with the comparison of two allegedly musical works, such as where a remix or ‘cover’ version of an existing song is created. In the context of copyright infringement, below, it will be seen that courts often resort to the mantra that ‘the ear is the best guise’ when determining whether a musical work has been infringed.

There are three issues in these cases:

- (i) **Subsistence of the remix**
Is the remix sufficiently original to qualify for independent protection as a musical work?
- (ii) **Infringement of the original**
If the plaintiff is the owner of the original work: is the remix an adaptation (such as to infringe the plaintiff’s exclusive right to make an adaptation) or does it reproduce a substantial part of the original?
- (iii) **Infringement of the remix**
If the plaintiff is the owner of the remix: does the third party defendant infringe the remix? That is, do they take a substantial part of what makes the remix original?

CBS Records Australia Ltd v Guy Gross concerns such a dispute. The adaptation was held to be an original work largely because of the new instrumental backing, which involved sufficient application of skill and labour to satisfy the requirement of originality. By contrast, simply arranging an existing musical work to suit a particular singer’s vocal capabilities would not involve sufficient skill and labour to create an original work. Nevertheless, here the adaptation was not infringed because, having regard to its original aspects, it could not be said that a substantial part of *those* aspects (as distinct from the musical work as a whole) was taken by the applicants.

CBS Records Australia Ltd v Guy Gross (1989) FCA:Facts

- Gross is the manager and boyfriend of Collette, a country singer
- CBS owns copyright in 'Ring My Bell', a popular Anita Ward song from the 1979
- In 1988, Gross and Collette write and record a cover (remix) version of 'Ring My Bell' at Trackdown studios ('the Trackdown version')
- CBS likes the song and offers Collette a contract to sing another version of 'Ring My Bell' ('the CBS cover version'); CBS intends to cut Gross out of the picture
- Collette accepts this offer and this new version becomes a hit single
- Gross argues that he is coauthor of and owner of copyright in the Trackdown version
- Gross further alleges that CBS has infringed copyright in the Trackdown version by copying and performing the work in the form of the CBS cover version
- CBS argues that copyright does not subsist in the Trackdown version, alternatively that Gross is not the owner of copyright in the Trackdown version, and that in any case the CBS cover version does not infringe copyright
- [Note the role played by the statutory licensing scheme here: the owner of a musical work, once published, loses the right to exclude others from the work and instead gains a right to exact compulsory revenues. That is, a lyricist or artist can make a cover version of any work, providing that they pay the imposed statutory royalties to do so]
 - The Trackdown version was at all times unpublished, so CBS could not simply make use of the statutory licensing system

Issue

- Is there a separate musical work comprised in the Trackdown version, independent of the original Knight 1979 version?
- If so, is Gross a coauthor and hence co-owner of the copyright in the Trackdown version?
- If he is, does the 1989 CBS cover version infringe Gross' copyright?

Reasoning (Davies J)

- Copyright does subsist in the Trackdown version
 - For copyright to subsist in an arrangement, the differences must be such that a new original work can be identified (at 392)
 - Originality depends on a work being 'the product of the labour, skill, and capital' of its author; that labour, skill and capital should be sufficient 'to impart to the product some quality or character which the raw material did not possess, and which differentiates the product from the rare material' (*Interlego AG [Privy Council]* per Lord Oliver at 190)
 - The 'precise amount of the knowledge, labour, judgment or literary skill or taste which the author of any book or other compilation must bestow upon its composition in order to acquire copyright in it ... cannot be defined in precise terms. In every case it must depend largely on the special facts of that case, and must in each case be very much a question of degree.' (*Interlego AG [Privy Council]* per Lord Oliver at 190)
 - UK: an exact reproduction in three dimensions of a two-dimensional work is not necessarily protected 'simply because the process of copying it involves the application of skill and labour'
 - *Contra Interlego AG [FCA]*: Gummow J expressly rejects this approach: skill and labour is always sufficient [???
 - [393] When an arrangement is copied or imitated as closely as possible by another performer ... the conclusion may ... be readily drawn that there is copyright in the arrangement and that that copyright has been

infringed: the first because “what is worth copying is *prima facie* worth protecting” ... and the second because the whole of the arrangement has been taken.’

- Differences resulting from ‘mere interpretation’, particular differences in arrangement so as to suit the qualities of a particular singer’s voice, do not result in the creation of an original work’
- The issue is essentially one of originality
- Here, the Trackdown version, considered in its entirety, is the product of ‘sufficient original skill and creative labour’ to sustain copyright
 - The basic melody line is repeated
 - However, the embellishments — ‘which call for a higher level of rhythmic subtlety, pitching skills, and for a wide vocal compass’ — are not emulated in the Trackdown version
 - Collette sings the basic melody only
 - Both use the same four-by-four 16-bar structures
 - Both make use of anacrusis and a similar melodic compass
 - The original contained a range of 23 semitones (large tonal range)
 - The Trackdown version and CBS version have a harmonic range of only 10 semitones
 - This is because Collette has a limited vocal range: ‘this is what every less qualified singer does when singing a song performed by a singer whose range is greater. To take such a step is not to create a new musical work but simply to interpret an existing work having regard to the singer’s capability.’
 - Collette transcribed the song aurally, and made a mistake in the first two words of the song
 - Gross developed the instrumental backing using a Kurzweil synthesiser
 - **[392]** I am left with the impression that, in so far as Collette’s vocal lines were concerned, they did not flow from a new composition of which Guy was the author but resulted from the fact that Collette sang ‘Ring My Bell’ as best she could having regard to her style of singing, her limited range, the qualities of her voice and her experience.’
 - **[394]** My impression is that the Trackdown version, if considered in its entirety, is the product of sufficient original skill and creative labour to sustain copyright. It is not just a copy of the [original] version. Independent was applied to its creation. Original composition was required for the development of the instrumental backing so as to reflect principal elements of the [original] version yet to match the backing with Collette’s style of singing. Were the Trackdown version to be faithfully copied or imitated by other performers, I would find it difficult to say that an original work was not infringed.’
- Gross may be a co-owner of copyright in the Trackdown version
 - At most he is a joint proprietor of copyright with Collette
- However, the CBS cover version does not infringe copyright in the Trackdown version
 - If a work is entirely original, the reproduction or performance of a very small but important part thereof may constitute infringement
 - Here, however, originality was not contained in any ‘particular element; of the Trackdown version since it was an adaptation of a previous copyright work
 - **[394]** But this is not a case where a particular feature stands out, where an opera score has been rewritten for piano or where important new harmonisations have been composed. In the present case, I am unable to identify any such element. Copyright does not subsist in having a singer of Collette’s style perform the song, for Collette’s voice is not so

unusual that its mere use in the song creates an original musical work. ... Nor does copyright lie in the development of a present day sound. ... The originality lies in a myriad of differences, rather than any specific feature, and therefore in the performance as a whole and not in any special or particular feature thereof.'

- Instead, originality consists of the sum of the 'myriad of differences' that exist between the two works
- Therefore, to prove infringement, Gross must establish that a substantial part of *those differences* have been taken
 - '[395] [I]nfringement occurs if a substantial part of a work is reproduced, performed, etc. These provisions must be applied in the light of the musical work to be protected. If a work is entirely original, the reproduction or performance of a very small but important part thereof may constitute infringement. ... But in the present case, originality does not subsist in a particular element of the Trackdown version, which was itself a cover of the [original] version, but in the multitude of differences which exists between those two works.'
 - 'Infringement must be considered accordingly. To prove infringement it is not sufficient to establish that some of those differences are repeated in the allegedly infringing work. As Lord Pearce said in *Ladbroke* ...: "Whether a part is substantial must be decided by its quality rather than its quantity. The reproduction of a part which by itself has no originality will not normally be a substantial part of the copyright and therefore will not be protected. For that which would not attract copyright except by reason of its collocation will, when robbed of that collocation, not be a substantial part of the copyright and therefore the courts will not hold its reproduction to be an infringement. It is this, I think, which is meant by one or two judicial observations that 'there is no copyright' in some unoriginal part of a whole that is copyright.'"
 - [Presumably, however, reproduction of those unoriginal portions of an adaptation may still amount to a substantial part of the original work, and so infringe that work from which the adaptation was made.]
- It is not enough to show that some of the differences are repeated in the CBS cover version
 - '[395] I am satisfied that CBS did not infringe the copyright.'
 - This is because the CBS version does not duplicate the instrumental backing, which is what made the Trackdown version original
 - The only similarity is superficial: the style of Collette's voice and the contemporaneous production of the CBS version; however, these elements are insufficient to infringe copyright in the Trackdown version
- Davies J also notes the significance of the fact that Gross did not make a claim for infringement until three months after the release of the CBS original; the infringement claim was 'a late thought'

Decision

- Gross is unsuccessful; no copyright infringement can be shown
- CBS is entitled to a declaration that Gross' accusations are unsustainable
- Gross' cross-claim for payment of an invoice for services rendered to Collette is dismissed; there was no agreement express or implied for payment to be made

D Artistic Works

1 Scope of 'artistic'

'Artistic work' is given an exhaustive definition in s 10(1) of the *Copyright Act*.

Copyright Act 1968 (Cth) s 10(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 within the meaning of the *Circuit Layouts Act 1989*.

The first two categories of artistic works (paragraphs (a) and (b)) do not require that the works have artistic quality. Thus, they can be mundane, bad, of a purely functional (non-artistic) or technical nature, or otherwise. By express exclusion, no requirement of artistry applies to these categories of artistic work. However, the third category (paragraph (c)) entails artistry.

Note that as a result of recent amendments to the Act, a work can be both a work of artistic craftsmanship but also fall into a category mentioned in paragraph (a) or (b). This is because of the phrase 'whether or not mentioned in ...' in paragraph (c) of the definition. Presumably, this explanation was added to confirm that paragraph (c) is not to be confined by reference to a desire to minimise overlap between the categories. To the contrary, there will be significant overlap between the three paragraphs. Consider, for example, a hand-crafted sculpture depicting a building.

Fewer rights attach to artistic works than to other works. In this regard, copyright owned by visual artists is 'thinner' — they have fewer exclusive rights — than that owned by their musical, literary and dramatic brethren.

Note: pay very careful attention to the words of the definition in the *Copyright Act*. Although a great deal of case law exists, and is often instructive of its meaning, such case law is always subordinate and was often decided before recent amendments came into force. Legislation is of primary importance; it should be regarded as paramount and given close reading.

With this in mind, the following analysis of artistic works under the *Copyright Act* proceeds by reference to the three categories outlined in the definition.

2 Paragraph (a) artistic works: defined visual expressions

(a) Paintings

A painting is an object with paint upon its surface in a permanent arrangement. Whether a given object is a painting is a question of fact (*Merchandising Corp of America Inc v Harpbond Ltd*).

- Face paint is not a painting because the human skin is not a surface with a fixed, permanent form (*Merchandising Corp of America Inc v Harpbond Ltd*); and
- A sand sculpture held between two sheets of perspex is not a painting, again because it lacks permanency (*Komesaroff v Mickle*).

(b) Sculptures and engravings

Both the term 'sculpture' and the term 'engraving' are given non-exhaustive definitions in s 10(1) of the *Copyright Act*:

Copyright Act 1968 (Cth) s 10(1):

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.

An artistic work under paragraph (a) does not require artistry. The issue therefore arises whether industrial sculptures (such as models) and engravings (such as moulds and dies) are capable of giving rise to artistic works.

In New Zealand, industrial models and moulds are protected as sculptures and engravings, respectively (*Wham-O Manufacturing Co v Lincoln Industries Ltd*).

Wham-O manufacturing Co v Lincoln Industries Ltd (1984) NZ CA:Issue

- Is a Frisbee (an aerodynamic flying disc made of plastic) a sculpture?

Reasoning

- A Frisbee is manufactured by first drawing the design, then making models, moulds and dies, and then casting the finished product from such a die
- A Frisbee is therefore a reproduction of a metal engraving from which Frisbees were moulded
- The model is a sculpture
- The moulds and dies are engravings
- The Frisbee is a print from an engraving

Decision

- The Frisbee is therefore protected as an artistic work

However, this approach was rejected in *Greenfield Products Pty Ltd v Rover-Scott Bonnar Ltd* as an interpretation of the terms 'straining the English language'. Although no artistry is required, an industrial model cannot be considered a sculpture; similarly, an industrial mould cannot be considered an engraving.

Greenfield Products Pty Ltd v Rover-Scott Bonnar Ltd (1990) FCA:

Reasoning

- *Lincoln Industries* should not be followed
- 'Sculpture' should be defined by properly construing the terms of the statute
- 'Engraving' must not be defined in a way that is 'straining the English language' (at 427)

Decision

- The drive mechanism for a ride-on mower is not protected by copyright because it is not a sculpture; the moulds used to produce it are not engravings

Recalling *Creation Records Ltd*, above, it will be noted that an arrangement of unrelated objects in a scene does not amount to a sculpture because nothing has been carved or modelled in the composition.

Creation Records Ltd v News Group Newspapers Ltd (1997) UK Ch:

Reasoning (Lloyd J)

- '[4] I do not see how the process of assembling these disparate objects together ... can be regarded as having anything in common with sculpture. ... No element in the composition has been carved, modelled or made in any of the other ways in which sculpture is made ...'

Decision

- The arrangement of discrete and unmodified chattels to form a scene is not a sculpture within the meaning of the *Copyright Act*

Creation Records Ltd and *Greenfield*, taken in combination, suggest that what is meant by sculpture is an object that has been shaped in some way by human hands. It cannot have been the result of a mere industrial process, but must have been modelled by a human with a view to creating a sculpture. Given the extensive design protection available under the *Designs Act 1995* (Cth), this seems a sensible construction of the provision.

(c) *Drawings*

The *Copyright Act* does not limit the definition of drawing, instead defining it to include various visual articles often considered to be of a more technical nature:

Copyright Act 1968 (Cth) s 10(1):

drawing includes a diagram, map, chart or plan.

This definition would appear to include practically any two-dimensional object (except paintings and photographs, which must be treated as separate and non-overlapping categories of protection under paragraph (a)).

Given that protection is agreed to be so broad, the primary issue arising in the context of artistic works is whether a transliteration of a drawing in three dimensions can be considered to amount to infringement of the two-dimensional drawing. Similarly, if someone reverse engineers and reproduces a three-dimensional object (such as a mass-produced product of some kind) then the copy will infringe copyright in the two-dimensional design drawings for the product. Effectively, this allows the owners of mass-produced products to invoke copyright in order to prevent unauthorised duplication of those products.

However, there are some limits on the protection of drawings. These limits are imposed by necessary implication from the idea-expression dichotomy. Namely, where the idea of a drawing has only a small number of possible expressions, copyright will be denied to any expression that partakes of one such possible form (see, eg, *FAI Insurance Ltd v Advance Bank Australia*, which concerned electoral ballots).

(d) *Photographs*

'Photograph' is defined exhaustively in s 10(1):

Copyright Act 1968 (Cth) s 10(1):

photograph means 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 ...

This definition excludes, for example, the negatives used in a cinematograph film. The concept of photography is defined by reference to a process, being a photographic or similar process. Presumably this is broad enough to encompass both analogue and digital processes. The meaning of 'product' in the phrase 'a product of photography' is unclear: on the one hand, it may suggest that unfinished or interim results in photography, such as negatives, are unprotected; on the other hand, it may be taken to include all products, including negatives, darkroom samples and digitally stored images.

The author of a photograph is the person who captures it. Like the other items listed in paragraph (a) of the definition of 'artistic work', it need not exhibit artistic merit.

Because of the requirement of derivation, an identical or similar photograph taken by another person will never infringe copyright in the first, because there is no causally-derived copying.

3 *Paragraph (b) artistic works: buildings and models thereof*

The definition of building in s 10(1) of the *Copyright Act* is broad and inclusive:

Copyright Act 1968 (Cth) s 10(1):

building includes a structure of any kind.

'Structure' entails 'something which is of some substance, and is usually erected upon or constructed upon or in the 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*).

Buildings have been held to include:

- A miniature tennis court (*Half Court Tennis Pty Ltd v Seymour*); and
- A fibreglass swimming pool (*Darwin Fibreglass Pty Ltd v Kruhse Enterprises Pty Ltd*).

4 *Paragraph (c) artistic works: works of artistic craftsmanship*

A work of artistic craftsmanship must satisfy both aesthetic and procedural criteria. Unlike paragraphs (a) and (b), artistic merit is relevant, and is assessed objectively as an aesthetic criterion. The procedural criterion relates to the process of craftsmanship used to produce the article: there must have been some skill involved in producing the work.

Coogi Australia Pty Ltd v Hysport International Pty Ltd (1998) FCA:Reasoning (Drummond J)

- 'The phrase "works of artistic craftsmanship" is a composite phrase that must be construed as a whole'
- A 'work of artistic craftsmanship' entails two features:
 - Objective aesthetic quality
 - This is determined objectively
 - The creator's subjective intention is not determinative
 - The Court cannot 'avoid the task of making a judgment, on the evidence before it, whether the work has a sufficient level of aesthetic appeal' (at 603)
 - Work of craftsmanship
 - This will be 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 though the creator has used a highly sophisticated computer-controlled machine to produce it, if nevertheless it is a manifestation of the creator's skill with computer-controlled machinery, knowledge of materials and pride in workmanship' (at 606)

Decision

- The Coogi fabric is a 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

By contrast, where there is no craftsmanship, the work cannot be considered a work of artistic craftsmanship — even if the end result is of aesthetic appeal (*Creation Records Ltd*).

Creation Records Ltd v News Group Newspapers Ltd (1997) UK Ch:

Reasoning (Lloyd J)

- ‘No element of the composition has been carved, modelled or made in any of the other ways in which sculpture is made ... nor does it seem to me to be the result of the exercise of any craftsmanship’

Decision

- The scene is not a work of artistic craftsmanship

On the other hand, if the object over which protection is claimed has no aesthetic appeal, then it cannot be a work of artistic craftsmanship — regardless of how much skill went into producing it.

In assessing whether a work is of aesthetic appeal, the article is to be judged without reference to how it might be used. Instead, the article is examined in isolation; do not look at the article as if it was being used or applied in its intended context (*Merlet v Mothercare plc*).

Merlet v Mothercare plc (1984) UK Ch:

Facts

- Merlet claims copyright in its ‘Raincosy’, a prototype of a baby’s cape, as a work of artistic craftsmanship
- Mothercare produces a competing product called the ‘CarryCape’, which Merlet alleges infringes copyright in the Raincosy

Issue

- Is the Raincosy a work of artistic craftsmanship?

Reasoning

- No, the object has no artistic appeal in itself
- Even though the Raincosy may be aesthetically appealing when it has a baby and a parent attached to it, it must be judged ‘on its own merits without reference to what might be thought to be its natural place in the order of things’
- **[463]** You judge the decanter without reference to its possible contents; you judge the knives and forks as such, without reference to any possible meal in whose consumption they may possible assist; and you are to judge a baby cape as a baby cape.’

Decision

- The baby cape is not a work of artistic craftsmanship

This approach suggests that the court will make an objective judgment about the aesthetic appeal of the article by looking at the article alone, in isolation from its possible uses or applications.

In *Muscat v Le* ...

Muscat v Le (2003) FCA:Facts

- In 1996, Muscat creates the 'Mytiko' pants, a design with a low v-shaped waistband and flared leggings made from stretch fabric
- In 2002, Le begins selling 'the cross-over pants', which are similar to the Mytiko pants except that the lines of the v-shaped waistband form an 'x'-shaped cross
- Muscat commences proceedings, arguing that Le has infringed copyright in the design sketches of the Mytiko pants design

Issue

- Are the design sketches of the Mytiko pants 'work[s] of artistic craftsmanship'?

Reasoning (Finkelstein J)

- The test to be applied is as follows:
 - Is the item made by hand by a craftsperson who is applying some skill in order for the final product to have aesthetic appeal to its audience?
 - Aesthetic appeal
 - '[44] A work will only qualify as a work of artistic craftsmanship if it has an element of genuine artistic quality that "[appeals] to the aesthetic tastes of those who observe it" even if such an article "be utilitarian": *Cuisenaire v Reed*
 - 'The level of artistic appeal required is greater than mere visual appeal: *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd*
 - 'A court will determine the level of aesthetic appeal ... objectively and on the basis of the evidence ...; evidence that the create intended to make an article possessing aesthetic qualities is "important, although not essential": *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd*
 - Aesthetic appeal entails more than merely being 'a transient fad' that is accepted by some consumers as 'look[ing] nice'; '[b]ut looking nice appears ... to fall considerably short of having artistic appeal.'
 - Aesthetic appeal is objective
 - Craftsmanship
 - '[45] [T]he question is ... whether a sample can be a work of craftsmanship.'
 - In *Cuisenaire v Reed*, copyright in a set of coloured rods for teaching arithmetic to students was denied on the basis that producing the rods did not involve craftsmanship:
 - 'The Shorter Oxford Dictionary defines a "craft" as a "Calling requiring special skill and knowledge especially a manual art — a handicraft", and "craftsman" as a "man who practices a handicraft — an artisan".'
 - No special skill or training required to cut strips of wood into the rods lengths and colour them differently, so no craftsmanship was involved in their production
 - In *Hensher*, the House of Lords observed (per Lord Reid) that:
 - 'A word of craftsmanship suggests ... a durable useful handmade object and a work of artistic craftsmanship suggests something, whether of practical utility or not, which its owner values because of its artistic character. It appears to me to be difficult to bring within the terms or the intention of the statute an object which, however artistic it might appear to be, is only intended to be used as a step in a commercial operation and has no value in itself.' (at 77)

- In *Guild v Eskander*, the plaintiff claimed that a sample shirt, sweater and cardigan were works of artistic craftsmanship; they were inspired by ‘ethnic’ and ‘peasant’ dresses, received critical acclaim and were featured in a fashion exhibition at the Victoria and Albert Museum
 - The garments must be assessed in the simplicity of their unworn state (or perhaps on a mannequin)
 - The sample garments were machine made and garments ‘than which few can come simpler’
 - There is no evidence that the plaintiff intended to create works of art; she did not say so, for example
 - She instead must be inferred to have chosen ‘to design and market garments of this particular style because it appealed to her and she considered it would also appeal ... to ... the buying public’
 - Therefore they cannot be regarded as works of craftsmanship
 - Therefore, the purpose for which the article was created is relevant in assessing craftsmanship
 - This appears to make the (objectively ascertained) intention of the creator determinative of the article’s classification as a work of craftsmanship
 - Note, however, that classification as a work of aesthetic appeal (ie, a work of *artistic* craftsmanship) is still objective and will not be determined by the intention of its creator
- Application to the facts
 - The prototypes were never meant to have aesthetic appeal
 - They ‘were not created as works of art’
 - ‘They came into existence for the purpose of determining how the design would look and to enable Ms Muscat to decide whether any changes should be made before production commenced’
 - The intention of Muscat when making the draft sketches was simply to see how the fabric looked with a view to mass producing the garments
 - They were just a preparatory, functional step, and not intended to be worn or enjoyed of themselves

Decision

- The sample garments were not intended to be works of art and therefore they cannot be regarded as works of craftsmanship
- Consequently, regardless of whether they have aesthetic appeal, the prototypes are not works of artistic craftsmanship

There is an apparent tension between the approaches in *Coogi* and *Muscat v Le*: in *Coogi*, the subjective intention of the creator was emphatically stated not to be relevant to the issue of aesthetic appeal, which is assessed objectively. In *Muscat v Le*, Finkelstein J appears to have used the creator’s intention to infer that the sample garments cannot have been works of artistic craftsmanship. This tension may be resolved by observing that Finkelstein J was engaged in a consideration of craftsmanship, rather than artistic merit. Subjective intention (as inferred from the evidence) is to be treated as negatively determinative of the issue of craftsmanship, but will not determine aesthetic merit.

Thus, the test of artistic craftsmanship may be stated in the following terms:

- (a) **Is there craftsmanship?**
 - (i) **Did the creator intend to create a work of art?**
If no, what they did cannot be regarded as craftsmanship (*Guild; Muscat*)
 - (ii) **If so, did they also apply some special skill or knowledge?**
If yes, there will be craftsmanship, especially if handiwork is involved (*Cuisenaire*); however, there can still be skill where the article is made by a machine programmed by the creator (*Coogi*).
- (b) **Assuming there is craftsmanship, is the work of aesthetic appeal?**
Assess the work objectively (*Coogi; Hensher*) and in isolation (*Merlet*); and
- (c) If yes, then the work is a work of artistic craftsmanship.

Note that law reform bodies involved in the drafting of this provision in the *Copyright Act* have stated that works of artistic craftsmanship should include 'items crafted from silver, pottery, wood and embroidery'. The rationale behind protecting these three-dimensional objects is that, being mass-produced items, they would otherwise lose copyright protection entirely by virtue of s 77 of the *Copyright Act*. (Section 77 removes copyright protection for three-dimensional artistic works upon the meeting of certain conditions. It is designed to encourage the creators of such works to apply for design protection under the *Designs Act 1995* (Cth), but does not apply to works of artistic craftsmanship. Thus, three-dimensional works of artistic craftsmanship may be manufactured indefinitely without losing copyright protection. Of course, it seems difficult to conceive of an item that could easily be mass-produced whilst still involving enough skill to be classified as exhibiting craftsmanship.)

Correspondingly, the definition of 'work of artistic craftsmanship' is confined to exclude many three-dimensional objects that are capable of mass-production or which serve utilitarian purposes (eg, furniture). The rationale is to prevent copyright from subsisting in prototypes of such items, since that protection is the function of the designs regime, as provided for by s 77. Thus, where design protection applies, copyright protection does not.

IV *Subject Matter other than Works*

A *Subsistence Criteria*

1 *Originality*

There is no direct analogue of the ‘originality’ criteria upon which the subsistence of pt III works is made contingent. However, although there is no express originality requirement, it seems that, at a minimum, subsistence of pt IV subject matter depends on that subject matter not having been literally copied from a third party’s corresponding pt IV subject matter, as Ricketson and Creswell have suggested.

At most it may be conjectured that a literal copy of a pt IV subject matter, such as a film that is a copy of another film, would be unlikely to obtain freestanding copyright protection under either Part.

2 *Material form*

The definitions of ‘sound recording’ and ‘cinematograph film’ in s 10(1) require them to be ‘embodied in an article or thing’. This may be viewed as tantamount to requiring material form in that a relevant subject matter does not arise until the point at which such embodiment occurs.

Similarly, material form is inherent in the notion of a ‘published edition’, which must be published. Publication necessarily entails a matter being recorded in some fashion.

However, there is no material form requirement for television and sound broadcasts.

B *Sound Recordings*

Copyright subsists in a sound recording by virtue of s 89 of the *Copyright Act*. A sound recording is the collection of sounds contained in a recording, as defined in s 10(1) of the Act:

Copyright Act 1968 (Cth) s 10(1):

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.

1 *Records*

This is a broad definition. Record is defined broadly, with a few examples of given of ‘device[s] in which sounds are embodied’, but with the potential to extend the types of devices included within that category as technology develops. It therefore seems beyond question that such devices as a DAT tape, DVD, SACD, iPod or mobile phone would be capable of being viewed as ‘other device[s] in which sounds are embodied’, assuming such devices to have had sounds embodied in their respective forms of storage. In this sense, the definition is technology neutral.

The only real limitation upon the definition of ‘record’ is that it must be capable of emitting a performance of the sound recording. That is, the sound recording must be able to be played: s 23(2).

Copyright Act 1968 (Cth) s 23 — Sound recordings and records:

(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.

2 *Sound recordings*

This section accords protection to the actual sounds in a recording, rather than (broad) the form of those sounds, or (narrow) just the embodiment of those sounds in the specific record. Thus, for example, the sounds present in an MP3 file stored on a hard disk would be a ‘sound recording’, since there is a ‘record’ (an ‘other device in which sounds are embodied’) and therefore copyright attaches to the sounds contained within that file — as distinct from, say, the specific (compressed) instructions required to emit those sounds from a computer.

The definition is not tied to the scope of ‘musical work’. It may therefore include the sounds of matters that would not qualify for protection as a musical work, and is broader. For practical reasons, however, music represents the most abundant class of sound recording, owing largely to its commercial value. This is not to say that other recordings (even mundane ones) will not still attract copyright protection.

Section 23(1) excludes soundtracks from protection as sound recordings. This is because they already have protection as part of a cinematograph film. This provision operates by deeming a soundtrack not to be a sound recording:

Copyright Act 1968 (Cth) s 23 — Sound recordings and records:

(a) ... sounds embodied in a sound-track associated with visual images forming part of cinematograph film shall be deemed not to be a sound recording.

3 *No non-literal protection*

Despite this broad definition, the fact that it is tied to the actual sounds in a recording renders non-literal infringement of a sound recording nigh on impossible.

Part IV subject matter is ‘thin’. This means that it attaches to less material and affords fewer protections to that material. As Professor Brennan has observed: ‘The thinner the copyright, the more literal a taking has to be in order to infringe’. Thus, a sound recording cannot be infringed by making a ‘sound-alike’ the recording; the only way to infringe is literally to copy the sounds of the recording.

As Bowen CJ observed in *CBS Records Australia Ltd v Telmak Teleproducts (Australia) Pty Ltd* (a case concerning alleged infringement by a ‘sound-alike’ recording), s 89 only protects the actual sounds in a sound recording, and not the musical works comprising those sounds. For this

reason, it will be difficult to establish infringement of a sound recording unless it has been literally copied without authorisation.

4 Policy issues

The rationale for protecting sound recordings lies predominantly in the high degree of artistic and technical skill required to make them. Copyright, it is said, should protect the skill of the sound engineer of a recording independently from the distributor of that recording. This is consistent with the extension of protection to include industrial and entrepreneurial forms of endeavour.

Interesting issue: could a recording of John Cage's 4'33" of *silence* qualify for protection as a sound recording? There would, presumably, be a record. However, does protection subsist only in the 'sounds' embodied in that record (and not in the intervening silence), or is silence a part of the sound waves embodied in the record? This is an interesting area for further research.

The nature of copyright in a sound recording is quite different to that of copyright in a work. Here, the protection does not attach to the product of a human mind or intellectual endeavour. Instead, it protects a technical product of an automatic process, though it is a process requiring technical skill on the part of its controller, the author. Because of these differences, the interests that arise for protection are different to those involved in the protection of works.

D Cinematograph Films

Copyright subsists in cinematograph films under pt IV: *Copyright Act* s 90. 'Cinematograph film' is given an exhaustive definition in s 10(1) of the Act:

Copyright Act 1968 (Cth) s 10(1):

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.

...

sound-track, in relation to visual images forming part of a cinematograph film, means:

- (a) the part of any article or thing, being an article or thing in which those visual images are embodied, in which sounds are embodied; or
- (b) a disc, tape or other device in which sounds are embodied and which is made available by the maker of the film for use in conjunction with the article or thing in which those visual images are embodied.

Section 90 creates separate copyright in cinematograph films (which is to say, 'motion pictures') from the literary, dramatic, musical and artistic works that comprise such films. The copyright subsists in the actual visuals and sounds of the film record.

For something to qualify as a film under s 10(1), it must:

- Be embodied in an 'article or thing'; and
- Be able to show a 'moving picture' either directly or indirectly.

1 Embodiment

The essence of embodiment is reproduction. That is, for some matter to be embodied in an 'article or thing', it must be possible to reproduce that matter from the article or thing: *Copyright Act s 24*.

Copyright Act 1968 (Cth) s 24 — References to sounds and visual images embodied in an article:

... sounds or visual images shall be taken to have been embodied in an article or thing if ... those sounds or visual images are capable, with or without the aid of some other device, of being reproduced from the article or thing.

To some extent, this requirement is already implicit in the s 10(1) definition itself, which requires that the 'article or thing' in which the film is embodied must be 'capable by the use of that article or thing' of producing a moving picture in some fashion. The s 24 requirement that a moving picture be able to be reproduced directly or indirectly from the article or thing is, then, tautological.

2 'Moving picture'

The phrase 'a moving picture' refers to a visual effect presented to viewers that gives the illusion of movement. It does not advert to how the moving picture is created, or whether it follows a static sequence. The effect may be created by means of frames, pixels or otherwise. For this reason, it is possible to protect video games as films, because the game discs or cartridges embody and are capable of producing an effect that may be described as a moving picture (*Sega Enterprises Ltd v Galaxy Electronics Pty Ltd*).

Sega Enterprises Ltd v Galaxy Electronics Pty Ltd (1996) FCA:

Facts

- Sega is the manufacturer of the 'Virtua Cop' and 'Daytona USA' arcade video games
- Galaxy is the importer of game machines containing Sega's game circuitry, by means of which the games could be played
- Sega argues that, *inter alia*, copyright subsists in these games as cinematograph films, and that Galaxy has therefore infringed copyright by importing them
- Galaxy argues that the games could not be cinematograph films because they followed no stable script or image sequence, instead changing every time they were played in response to user input and random variables

- Because no two 'screenings' of the games could ever be alike, it was argued, the games could not possibly be films, which require a fixed expression
- Sega responds that because the controlling parameter (the game programming code) is fixed and this determines the course of gameplay, the resulting article is sufficiently stable to be classified as a film

Issues

- Clearly, video games are not a literary work (what about a computer program?)
- Nor are they paintings or photographs (works of artistic craftsmanship?)
- Should a video game be given protection as a cinematograph film?

Reasoning (Burchett J)

- In the absence of a specific 'interactive multimedia' work or separate pt IV category, the Court is prepared to give a broad interpretation to the cinematograph film subject matter
- Such an interpretation is suggested by s 24, which only requires the images to be capable of reproduction from the device
 - Embodied means that the images and sounds are held in a form in which they could have continued existence and use
- There is no reason to confine the term 'embodied' to require the visual image to consist of a frame in which the on-screen action takes place; this is a limiting concept not suggested by the language of the Act
 - 'A cinematograph film is "shown as a moving picture". That is how it speaks to the viewer. But the means by which the effect is produced are not the effect, and it may be accepted that the frames involved in the original technology may not be essential to the production of the effect by other technologies, such as computer graphics. The argument is as if, in construing a building contract, we were to say that pouring concrete could not refer to pumping it through a pipe because pouring it is doing so bucket by bucket. It was once. And moving pictures were once achieved only frame by frame; but now or in the future the motion may pour across the video screen in pixels.' (at 525)
- A liberal approach should be taken when interpreting the *Copyright Act*, since the legislative history shows that Parliament intended to take a broad and technology-neutral view of what constitutes a cinematograph film
- On the facts, the variations in visual imagery and sounds permitted by the game's execution were limited by fixed parameters in the program source code
- The game machines all possible alternative images and sounds, and could reproduce those images to form a moving picture
 - For this reason, the game machines are cinematograph films

Decision

- The video games are each cinematograph films

3 'Sound-track'

Every cinematograph film with a soundtrack involves a sound recording. To prevent the considerable overlap that would arise between sound recordings and films, 'sound track' sounds are deemed not to be a sound recording: s 23(1) (see above).

What, then, is encompassed by the term 'sound-track'? Section 10(1) identifies two kinds of sound tracks: the audio track to a film, and audio devices released by the film's creator to be used alongside the film. Presumably this second category deals with the situation where separate sound tracks are made available to analogue cinemas for simultaneous playback alongside the

projected film. Does it also encompass soundtrack CDs released to the general public in isolation from the film? [???

As a result of s 23, unauthorised reproduction of a soundtrack will infringe copyright in the film rather than copyright in the sound recording. However, pre-existing sound recordings that are later incorporated into a soundtrack will continue to have copyright as independent sound recordings (*Phonographic Performance Co of Australia Ltd v Federation of Commercial Television Stations*). That is to say, incorporation into a soundtrack does not have the effect of merging existing copyright in the sound recording into that subsisting in the soundtrack.

Phonographic Performance Co of Australia Ltd v Federation of Australian Commercial Television Stations (1998) HCA:

Facts

- This case concerns the *The Big Steel*, a film which incorporates into its sound track a sound recording of a commercial piece of music
- The PPCA collects recordings from broadcasting stations who play sound recordings on commercial television stations
- It wants to collect royalties from stations broadcasting *The Big Steel*, since they were also broadcasting the sound recording as part of the cinematograph film
- The stations argue that, on the basis of s 23(1), the soundtrack is not a sound recording, so that no royalties are payable on the individual sound recordings it might otherwise comprise

Issue

- Where a pre-existing recording is incorporated into a film soundtrack, does any independent copyright continue to subsist in the recording itself?

Reasoning

- Yes, section 23(1) is just an anti-overlap provision
- It refers to sounds recorded contemporaneously with images, not sounds (which existed prior to the cinematograph film) dubbed into the film later
- If there is a sound recording that has a prior existence, which is dubbed into a soundtrack, then that dubbed portion retains its identity as a sound recording notwithstanding that it is also part of a soundtrack
- Consequently, the anti-overlap provision doesn't exempt the broadcasters from paying royalties for broadcasting the sound recording embodied in the film's audio

Decision

- Independent copyright continues to subsist in sound recordings that are subsequently incorporated into a film soundtrack
- The respondents must pay royalties to the plaintiff

As a result of the decision in *Phonographic Performance Co*, it seems clear that anyone wishing to deal with a film containing a sound recording made before the film will need to obtain the appropriate permissions, pay royalties to the owner of copyright, or risk infringing that sound recording.

E *Sound and Television Broadcasts*

Section 91 of the *Copyright Act* provides that copyright will subsist in television or sound broadcasts made from within Australia by certain entities. A broadcast is a type of communication delivered to the public by means of transmission. It is defined exhaustively in s 10(1) of the *Copyright Act* to encompass communications 'delivered by a broadcasting service' made 'to the public', subject to certain limitations:

Copyright Act 1968 (Cth) s 10(1):

broadcast means a communication to the public delivered by a broadcasting service within the meaning of the *Broadcasting Services Act 1992*.

Note: A broadcasting service does not include the following:

- (a) a service (including a teletext service) that provides only data or only text (with or without associated images); or
- (b) a service that makes programs available on demand on a point-to-point basis, including a dial-up service.

...

sound broadcast means sounds broadcast otherwise than as part of a television broadcast.

...

television broadcast means visual images broadcast by way of television, together with any sounds broadcast for reception along with those images.

Television broadcasts encompass any images or sounds broadcast 'by way of television'. A sound broadcast is any other kind of broadcast: s 10(1).

Broadcast is noted to exclude data and on-demand services, such as teletext, internet access, video on demand, and so on. In this way, 'broadcast' includes only the traditional mainstay of public communication: images and sounds.

1 *'Broadcast'*

'Broadcast' is defined as including only those communications made by a 'broadcasting service' under the *Broadcasting Services Act 1992* (Cth) (*'Broadcasting Act'*), such as free-to-air television networks, radio stations and cable television channels: *Copyright Act* s 91.

The *Broadcasting Act*, in turn, defines 'broadcasting service' as follows:

Broadcasting Services Act 1992 (Cth) s 6(1):

broadcasting service means a service that delivers television programs or radio programs to persons having equipment appropriate for receiving that service ... but does not include:

- (a) a service that provides no more than data or no more than text (with or without associated still images); or

- (b) a service that makes programs available on demand; or
- (c) a service that the Minister determines not to fall within this definition.

In September 2000, a determination was made pursuant to s 6(1)(c) of the *Broadcasting Services Act 1992* (Cth) that 'the Internet' is excluded from the definition of 'broadcasting service'.

2 Scope of copyright in television broadcasts

An issue arises whether copyright in a television broadcast subsists in the aggregate of the visuals and sounds it contains — like a film — or in any given part of that. If the latter, how substantial must the broadcast be? Will a single frame suffice? This issue was canvassed by the Full Court of the Federal Court of Australia in *TCN Channel Nine Pty Ltd v Network Ten Pty Ltd* ('*The Panel Case*').

Note that the decision of the Full Federal Court was later reversed by the High Court of Australia.

***TCN Channel Nine Pty Ltd v Network Ten Pty Ltd* (2002) Full FCA:**

Facts

- Network Ten ('Ten') broadcasts a weekly satire programme entitled *The Panel*
- As part of this show, short segments of broadcasts made by competing networks are shown and made the subject of frequently-humorous, sometimes degrading comments
- Some of these segments come from broadcasts made by TCN Channel Nine ('Nine')
- Nine argues that Ten has infringed copyright by broadcasting these segments

Issue

- Has Ten infringed copyright in Nine's television broadcasts by rebroadcasting snippets from them?

Reasoning

- Subject to any defence of fair dealing (see below), any unauthorised rebroadcasting — however brief — will infringe copyright in that broadcast
- 'Here the interest protected by copyright is the visual images broadcast by way of television and any accompanying sound. ... The interest protected is not defined in terms of some larger 'whole' of which the visual images and sounds broadcast are but a part. The ephemeral nature of a broadcast, and the fact that copyright protection is conferred by reference to a broadcaster's output, rather than by reference to the originality of what is broadcast, may also help to explain why the interest protected is defined in this way.' (at 129 per Hely J)
- This is unlike copyright in a film, which is defined as the 'aggregate' of images and sounds embodied in the record
- That definition suggests that the copyright is in the whole of those sounds
- In the absence of a corresponding definition in relation to a television broadcast, copyright must be taken to subsist in any of the visual images broadcast by way of television

Decision

- Ten has *prima facie* infringed copyright in Nine's broadcast

The High Court, by a (3:2) majority, overturned this decision. The Court held that copyright subsists in broadcasts as a whole, and that a single 'broadcast' extends to everything identified within 'discrete periods of broadcasting and promoted by a title'. Consequently, simply showing an individual snippet or frame from a broadcast will not *necessarily* infringe copyright in the parent broadcast: what must be assessed is whether that snippet constitutes a substantial part of the whole (*Network Ten Pty Ltd v TCN Channel Nine Pty Ltd*).

Network Ten Pty Ltd v TCN Channel Nine Pty Ltd (2005) HCA:

Reasoning

- McHugh ACJ, Gummow and Hayne JJ:
 - '[T]here can be no absolute precision as to what in any of an infinite possibility of circumstances will constitute a "television broadcast"'
 - In general, however, 'television broadcast' means something 'put out to the public, the object of the activity of broadcasting, as discrete periods of broadcasting identified and promoted by a title'
 - By another name, these 'discrete periods' might be described as 'programmes', much as might appear in a television guide listing
 - This is a pragmatic definition
 - Application
 - A television broadcast is therefore generally a programme as a whole
 - Individual advertisements are each discrete broadcasts: at 19–21
 - 'Segments' in a news broadcast were by themselves probably not television broadcasts
 - A programme that consists purely of separate shows might encounter difficulty under this definition; presumably, if identified by a single title and identified as a single unity of shows, then the programme as a whole would be a single broadcast (see, eg, SBS' *Eat Carpet*)
- Kirby and Callinan JJ (dissenting)

Decision

- The decision of the Full Federal Court is reversed; a single image broadcast is not necessarily a television broadcast in which copyright will subsist

3 *Meaning of 'to the public'*

The s 10(1) definition of broadcasting requires that it be 'to the public'. This phrase is the subject of its own definition in s 10(1):

Copyright Act 1968 (Cth) s 10(1):

to the public means to the public within or outside Australia.

Unhelpful for its circularity, this definition simply extends the notion of 'the public' to encompass international audiences.

The 'public' is interpreted as the 'copyright owner's public' (*Telstra Corp Ltd v APRA*). That is, the audience need not be the public at large; it can be some subsection of the public to whom the broadcaster intended to communicate their broadcast.

What constitutes the relevant section of the public will be determined having regard to:

- The nature of the transmission;
- The broadcaster's intent in so transmitting; and
- The characteristics of the audience.

In *Telstra Corp Ltd v APRA*, the issue concerned music played to users of mobile telephones while they are waiting 'on hold' during a telephone call. This was held to amount to a broadcast 'to the public', even though only one person would hear any given broadcast.

The issue in cases such as this is whether what is being done is 'broadcasting' or 'narrowcasting'. In the former case, the transmission is made 'to the public' (being a defined sub-section thereof), whereas in the latter, the transmission is intended only to be received by specified users. Examples of narrowcasting include short-wave radio and wireless internet access points. In any event, such transmissions would not be made by an authorised provider under the 1992 Act.

F *First Edition of Published Works*

The final category of pt IV subject matter concerns published editions of works. Section 92(1) provides that copyright will protect a 'published edition' of a work from pt III. '[P]ublished edition' refers to the typographical arrangement and presentation of the publication.

Copyright Act 1968 (Cth) s 92 — Published editions of works in which copyright subsists:

- (1) ... copyright subsists in a published edition of a literary, dramatic, musical or artistic work, or of 2 or more [works] ...
- (2) The last preceding subsection does not apply to an edition that reproduces a previous edition of the same work or works.

In practice, this protection may rightly be termed 'first edition of published works' protection, since by s 92(2) it only applies to the first edition of a publication. Subsequent revisions are not protected in this way, in order to prevent never-ending copyright being held by publishers who simply make minor revisions to the published edition (similar to the theory, if not the practice, of evergreening in patent law).

The *Copyright Act* does not define what is meant by a 'published edition', and no guidance is provided as to the scope of what is protected. However, case law has interpreted the phrase to mean that copyright protects the 'product of skill, labour and judgment in presenting material in an edition'. This product includes headlines, page layout, the layout of text and photographs, typography, type size, colour and other matters of 'presentation' that are embodied in an edition (*Nationwide News Pty Ltd v Copyright Agency Ltd*).

Nationwide News Pty Ltd v Copyright Agency Ltd (1996) Full FCA:Facts

- Journalists author certain articles that are later published in newspapers and magazines
- Those publications, as employers, acquire copyright in the works upon their publication
- The publications later attempt to copy extracts from the newspapers and magazines for delivery to a press clipping service
- However, the publishers of the publications claim that this infringes their separate copyright in the 'published edition' of each newspaper and magazine

Issue

- Does copyright subsist in the layout of newspaper and magazine editions?

Reasoning

- 'Published edition copyright protects the presentation embodied in the edition. This form of copyright, as the legislative history shows, protects such matters as typographical layout. However, it also protects other aspects of presentation, such as juxtaposition of text and photographs and use of headlines.'
- 'In the present case, a considerable volume of evidence was adduced on the importance of layout and presentation to magazines and newspapers. In modern times, the work of typesetters is shared among subeditors, layout artists or designers and production editors. It is clear that layout is often extremely important in attracting readers to read a particular story or magazine. It is also clear that the choice of layout, type size, headings and colour is a skilled operation.'
- 'Published edition copyright thus protects the product of skill, labour and judgment in presenting material in an edition'
- On the facts, however, the copying of a single article by the publications does not reproduce a substantial part of the published edition of which such an article forms part

Decision

- Yes, as published editions of works, copyright subsists in the layout of the newspaper and magazines
- However, copying a single article does not amount to infringement

The Court's reference to a published edition as being 'the product of skill, labour and judgment' is interesting in that it suggests an implied requirement of originality beyond that which might attach to other pt IV subject matter. If, for example, typeface and layout were automatically generated by a computer without any advertence to such matters by the publisher, it might be argued that there is no 'product of skill, labour and judgment' in which published edition copyright could subsist.

Assuming sufficient skill, labour and judgment to have been expended, however, it now seems clear that published edition copyright extends to all aspects of the published edition's presentation.

In an age where unauthorised reproduction of website designs are rapidly increasing, Parliament might rightly be called upon to expand further the scope of published edition protection, to clarify that digital publications may also be protected, and that editing a digital page does not amount to 'reproduc[ti]on of a previous edition of the same work' (cf *Copyright Act* s 92(2)).

Table 2: Economic rights conferred by copyright

Nature of the Work	Reproduction or Copying	Publication	Performance	Communication	Adaptation	Adaptation rights	Rental Arrangement
Literary	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:
Dramatic	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:
Musical	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:	Yes:
Artistic	Yes:	Yes:	No	Yes:	No	No	No
Sound recording	Yes:	No	Yes:	Yes:	No	No	Yes:
Cinematograph film	Yes:	No	Yes:	Yes:	No	No	No
Broadcast	Yes:	No	No	Yes:	No	No	No
Published edition	Yes:	No	No	No	No	No	No

VI *Hypothetical*

A *Lecture Three*

1 *Possible subject matter: subsistence thereof*

- Stories
 - Dramatic works
 - Material form?
 - Video tape: storage
 - Just as if written or recorded
 - Satisfied
 - Need not be able to reproduce from storage
 - Thus, the fact that it's stored on an inoperable video cassette does not matter
 - Originality?
 - Author commissioned reduction to material form
 - Recorder is a mere amanuensis
 - Not a public performance; cf *Walter v Lane*
 - Here there is a relationship between recorder and performer, unlike *Lane*, where there was no pre-existing relationship between Lord Rosebery and the Reporters
 - Therefore, RH is the author and not the camera man
 - Reduction done with consent of RH
 - Otherwise, originality would be BTV's
 - Need to make connection between camera man and RH, through BTV
 - Otherwise, camera man would be the author and BTV would have copyright
 - A dramatic work?
 - 'Format' (*Green*) difficult to establish
 - Need underlying authorial expression
 - Cf *Zeccola*
 - No script, no work, not fully developed
 - Just a format idea
 - 'Compilation' of works
 - I.e., a literary work
- Original song by King
 - Musical work
- Lyrics to the song
 - A literary or dramatic work
- New arrangement of the song
 - Musical work
 - Sufficient originality
 - Labour, skill and effort?
 - May infringe copyright in the King version
 - Same as for stories, unless reduced to notes or score
- Stylised performance of the song
 - Dramatic work
 - Need material form: choreography or script
 - Must be sufficient for reproduction

- Cartoon
 - Material form?
 - Drawing, ink, paper
 - Reduced by author (RH)
 - Clearly original: drawn by RH; author is therefore RH
 - May copy the photograph
 - But still original: *Interlego AG* (AU)
 - Source of idea is irrelevant: just an idea (no impact on copyright)
 - An artistic work (drawing)
 - Copyright assigned to an audience member
- Effigy
 - Material form?
 - Not an issue
 - Once made, capable of being reproduced
 - Video tape is evidence of that
 - Originality is satisfied
 - Video tape is a two-dimensional reproduction of the three-dimensional object
 - Probably not a sculpture because insufficient permanence
 - Not concrete enough
 - Metal of sand
 - Sand between perspex case
 - Coauthorship with audience?
 - If copyright subsists, held jointly
- Tape of the show
 - Comprises:
 - Cinematograph film; and
 - Sound recording
 - Sound recording is excluded by virtue of s 23
 - Unless RH's performance incorporated a prior 'recording'
 - Eg, of the King song
 - TV broadcast?
 - No, not copied from a broadcast
 - Need literal and derivational copying
 - Though it may form the basis of one
- Whole show
 - Dramatic work
 - Same issues as above

2 *Exploitation and infringement*

- Current ownership of copyright in the video
 - 1974: copyright assigned to BTV
 - May infringe copyright in the drawing, arrangement, and so on
 - But consent was provided
 - Moral rights?
 - 1988: property in chattel vested in enthusiast, but not IP (*Pacific Films*)
 - 2002: property vested in Max, but not IP
 - Therefore, BTV still owns copyright
 - Reverse engineer the obsolete format?
 - If assigned by BTV: Max, otherwise BTV