

**IN THE HIGH COURT OF AUSTRALIA
SYDNEY REGISTRY**

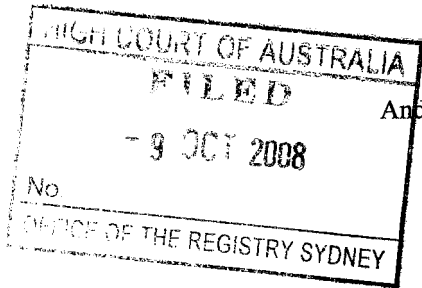
No. S415 of 2008

Between:

ICETV PTY LIMITED
First Appellant

ICETV HOLDINGS LIMITED
Second Appellant

NINE NETWORK AUSTRALIA PTY LTD
Respondent



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SUBMISSIONS OF AUSTRALIAN DIGITAL ALLIANCE

1. The Australian Digital Alliance Limited (“ADA”) seeks leave to make submissions as amicus curiae in the appeal¹.
2. The ADA is a non-profit organisation formed to promote balanced copyright law and to provide an effective voice for a public interest perspective in copyright debates for its members.² The list of the current members of the ADA is Annexure “A” to these submissions. ADA members include universities, libraries, archives and technology companies. ADA members have a particular interest in access to knowledge, innovation and competition, each of which are likely to be impacted greatly by the outcome of this appeal.

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REASONS WHY LEAVE SHOULD BE GIVEN

3. The *Copyright Act* embodies a balance of conflicting public interests, broadly identified as involving owners of intellectual property on the one hand and users of their intellectual works on the other. The establishment and maintenance of a desirable balance is an issue of great importance in the intellectual life of the Australian community, and operates in an international or global context. The operation of the law in relation to the varied interests of the education, research and technology communities extends far beyond the commercial interests of the parties in the present proceeding. The ADA seeks to put submissions in relation to the legal issues raised as they affect the broader interests of the ADA's membership and the large body of individuals who benefit from the activities of the institutions concerned.

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¹ Summons filed 23 September 2008.

² Affidavit Laura Simes made 23 September 2008, para 4.

4. In 2004 Deazley observed:

*“Time and again, whenever the courts are faced with those contested interfaces within the area of copyright, for example the question of substantiality, or the chimerical border between ideas and the expression of those ideas, or whether or not a given use amounts to fair dealing, judges will, often necessarily, fall back upon the fact that each case presents its own peculiarities and problems and that when all is said and done the answer ‘must be a matter of impression’”.*³

and suggested that:

10 *“amongst the factors that necessarily influence whether an individual considers one work to infringe another, whether explicit or not, one such factor will be the particular conception that the individual holds regarding the (proper) function of the copyright regime in general.”*⁴

5. As Deazley observed, copyright is concerned with *“striking an appropriate and effective balance between the rights of authors and the wider public interest”*⁵. He was referring to the public interest in the free and full circulation of the ideas embedded in original works as a resource.

6. The importance of that balance is perhaps most critical in the case of compilations. Particularly so in the modern digital environment in which technology facilitates the proliferation of compilations as a means to the holding and circulation of information. In 2003 the Royal Society of the United Kingdom, in its report *“Keeping Science Open”*⁶ expressed concerns about the impact of copyright law and related sui generis database rights upon access to scientific databases and scientific information.⁷

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7. In Australia, of course, databases are compilations within the definition of literary work in s.10(1) of the *Copyright Act 1968*. As one commentator has observed

³ Deazley, R. "Copyright in the House of Lords: Recent Cases, Judicial Reasoning and Academic Writing", I.P.Q. 2004, 2, 121-137 at 134.

⁴ Deazley, R. "Copyright in the House of Lords: Recent Cases, Judicial Reasoning and Academic Writing", I.P.Q. 2004, 2, 121-137 at 134.

⁵ Deazley, R. "Copyright in the House of Lords: Recent Cases, Judicial Reasoning and Academic Writing", I.P.Q. 2004, 2, 121-137 at 135.

⁶ The Royal Society, *Keeping Science Open: The Effects of Intellectual Property Policy on the Conduct of Science*, Royal Society, London, April 2003, <http://royalsociety.org/displaypagedoc.asp?id=11403>

⁷ At page 23, it observed: *“Databases – collections of data organised in a systematic way – play an important role in scientific research. It is an increasing role: for example, developments in the last decade have made databases essential for much biomedical research. Databases are of many kinds. They can be traditional encyclopaedias, books of data or some teaching materials, through to electronic databases available on the Internet. The access to data and the ability to extract and re-utilise those data have always played an important part in the scientific process. As in copyright, digitisation and the potential for instant low-cost global communication have opened up tremendous opportunities for the dissemination and use of scientific and technical databases. There has more recently been a proliferation of both public and private database, which has started to create tensions between free access and economic models. As always in IP law, it is a question of achieving a balance between a sufficient incentive and adequate protection of investment to encourage the creation of new databases which are necessary and useful to researchers, and the rights of scientific users to access those databases on reasonable terms and to advance scientific knowledge.*

"Information and databases are critical to science, the legal system itself, education and all aspects of life that are improved by them".⁸

8. In the judgment below, at [90]⁹, the Full Court referred to its earlier decision, *Desktop Marketing*¹⁰, noting that it had held:

"... as a matter of authority and policy, the concept of originality in copyright should be understood as embracing a compilation that is the product of substantial labour and expense, provided it is not merely copied from other works ..."

9. At [92]¹¹ it distinguished *Desktop Marketing* saying that unlike it:

10 *"... the present case does not involve a compilation of existing facts. No one outside Nine would have been able to compile the precise programming recorded in the weekly schedules in advance of their creation and dissemination."*

This observation by the Full Court anticipated its later finding, namely that the "preparatory work" undertaken within Nine was relevant to an assessment of whether its weekly schedules were original and, therefore, whether IceTV had infringed them.

10. The ADA seeks to submit that the Full Court erred:

(a) in *Desktop Marketing*, in concluding that "industrious collection" or "sweat of the brow" was sufficient for a work to be original;

20 (b) in finding that the time and title information were not existing fact; and that preparatory work, antecedent to authorial expression, is relevant to the questions of originality and substantiality.

11. Each of these errors involves a failure to recognise, in Deazley's terms, an appropriate and effective balance between the rights of authors and the wider public interest. Each, including the error in *Desktop Marketing*, affected the Court's finding that IceTV's electronic guides infringed. Infringement, of course, involves the reproduction of a "substantial part" of a copyright work. Whether a part is substantial depends upon its quality, not merely its quantity. The quality of the part concerned is determined by reference to the originality of the part copied. If mere labour confers originality, the universe of acts regarded as infringing is broadened considerably.

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12. Further each of them results in an inappropriate limitation on the public interests in the access to and use of information in compilations.

13. At first instance, and before the Full Court, the appellant did not challenge the correctness of *Desktop Marketing*.

⁸ Davison, *The Legal Protection of Databases*, Cambridge: Cambridge University Press, 2003 at page 1.

⁹ FC AB:10 4637 [90].

¹⁰ *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 119 FCR 491 at 532 [160], per Lindgren J; 597 [423], per Sackville J.

¹¹ FC AB:10 4368 [92].

14. The ADA has been actively involved in the policy debates which preceded the enactment of the *Copyright Amendment (Digital Agenda) Act 2000* (Cth) (“the *Digital Agenda Act*”). In the Full Court in *Sony v Stevens*, Lindgren J made specific reference to the submissions made by the ADA to the House of Representatives Standing Committee on Legal and Constitutional Affairs.¹² Given the purpose for which it was established, the interests of its members and its activities in relation to the on-going public and political processes with respect to the development of copyright law in a digital environment, the ADA has:
- 10 (a) a legitimate interest in making submissions in relation to the statutory construction issues in this appeal, particularly in the context of the special nature of the *Copyright Act*, and in the particular context of the novel anti-circumvention provisions;
- (b) special knowledge and expertise relevant to the issues the subject of appeal;
- (c) an interest in the subject of litigation greater than a mere desire to have the law declared in particular terms;¹³
- (d) an ability to make submissions which the Court might consider that it “*should have to assist it to reach a correct determination*”,¹⁴ and
- 20 (e) an ability to make submissions which both differ from those of the parties and are likely to “*assist the Court in a way in which the Court would not otherwise have been assisted*”.¹⁵

ARGUMENT

Originality

15. In *Network Ten v. TCN Channel Nine* (2004)¹⁶ the Court referred to the statement of Peterson J in *University of London Press v. University Tutorial Press* that “what is worth copying is worth protecting”¹⁷, decrying it as based on the rhetoric of misappropriation.
16. Originality is a threshold requirement for the subsistence of copyright and an important element in the way that copyright establishes the balance between the interest of creators and the public interest in access to ideas and information.
- 30 17. The standard of originality preferred by the Full Court in *Desktop Marketing*, which requires only that work “originate” with an author in the sense of being the result of the author’s skill, judgment *or* labour (“sweat of the brow”), has not been considered or endorsed by the Court.

¹² *Kabushiki Kaisha Sony Computer Entertainment v Stevens* (2003) 132 FCR 31 at [161]: AB 69(45). The work of the Committee is known as “the Andrews Report”.

¹³ *Kruger v Commonwealth of Australia* (1996) 3 Leg Rep 14 per Brennan CJ.

¹⁴ *Levy v State of Victoria* (1997) 189 CLR 579 per Brennan CJ at 603.

¹⁵ *Ibid* at 604.

¹⁶ *Network Ten Pty Limited v TCN Channel Nine Pty Limited* (2004) 218 CLR 273 at [14].

¹⁷ *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 610.

18. In *Desktop Marketing* the Full Court supported its decision by reference to a series of mostly United Kingdom authorities commencing in the 19th century prior to the commencement of the 1911 Act. In his judgment, Lindgren J collected and summarised many of them. Sackville J referred to them more selectively.
19. Professor Bowrey has provided a reading of the 19th century cases which exposes a significant and unintended “legal transformation” which occurred as a result of the introduction of the *Copyright Act* 1911 (UK).¹⁸ Great care has to be exercised when looking back to the 19th century cases now through the prism of the 20th century legislation.
- 10 20. As Professor Bowrey observes, prior to the 1911 Act, subsistence and infringement were questions which fell to be considered together. The question of “originality” involved a balance “measured with respect to an assessment of how the public interest was best served”¹⁹ including by reference to the defendant’s work. She says:
- “In the nineteenth century the copyright balance between protection and access was not seen simply as a case of arbitrating between competing private rights. It was not simply a matter of determining if a substantial part had been taken. When sensitivity to private property claims might be expected to be uppermost in judicial minds, it was not axiomatic that protection of original effort or investment would be the paramount concern. Deciding what was to be protected, and what use of another’s work was permitted, involved broad considerations into the social purpose served by copyright. These policy factors influenced how the line between protection and legitimate use was drawn.”*²⁰
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21. The effect of this unintended transformation is that when looking back at the 19th century decisions now, sight often is lost of the public interest consideration which survives within the requirement that a plaintiff’s work be original.
22. The 1911 Act, when introduced, was not regarded as effecting any substantial change to the law. However, because of its arrangement originality became largely confined to the question of the subsistence of copyright “without reference to the significance or intrinsic value of the plaintiff’s expression to the world at large”.²¹ Similarly, the defendant’s work has only received attention in the context of the infringement question, ie. in relation to whether or not an alleged taking of the plaintiff’s work is “substantial”.
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23. The pitfall of an incautious approach to the early authorities can be illustrated by reference to *Walter v Lane* (1900)²², which concerned the report of Lord Roseberry’s speech. The decision was regarded by the primary judge in *Desktop Marketing* as

¹⁸ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 17.

¹⁹ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 13.

²⁰ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 11.

²¹ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 14.

²² *Walter v Lane* [1900] AC 539.

supporting the proposition that “intellectual effort was not regarded as a requirement for copyright”²³. In the Full Court it was regarded in the same way by both Lindgren J and Sackville J.²⁴

24. In fact, as Professor Bowrey points out, three of the five judges thought intellectual effort was required for copyright.²⁵ Further the public interest was determinative. Setting out a passage from the judgment of Halsbury LC, she notes:

10 *“Here the text deserves protection, as a natural right flowing from The Times’, expenditure of labour, but also because such protection supports the public interest as determined by the conventions of that time. ‘Appropriations’ are legally sanctioned or not, depending upon the status of the source of the work and the public benefits that flow from the appropriation. In this case, The Times is to be rewarded for recording the posterity ‘speeches being of great interest to the public’.”*²⁶

25. Because the 19th century cases considered originality and infringement together as a matter of legal enquiry and with a more clear-sighted concern with the public interest, little assistance is to be garnered from a close analysis of them including, in particular, of their disparate use of the phrases “labour, skill or judgment”, “labour, skill and judgment”, “work, labour and skill”, “skill industry or experience”, “labour or skill or ingenuity or expense”, “labour, skill and capital”, and the like. The focus of the enquiry was simply not upon precise analysis of the authorial effort which was sufficient to justify the treatment of a work as original. Bentley and Sherman note that the disjunctive phrase “labour, skill or judgment” and the conjunctive phrase “labour, skill and judgment” have been used without great precision historically.²⁷ Further, as these authors suggest,²⁸ in reading the older cases on compilations, it is important to take into account the broader legal and technological context in which they were decided.

26. There is another reason why the 19th century cases provide a dangerous foundation for the consideration, particularly, of compilations. The copyright standard of originality is concerned not with the nature of that output – the final work – but with the authorship of it, and in particular, the nature and standard of the author’s contribution to the output. An author’s contribution to a compilation or schedule in the 19th or early 20th century was arguably quite different to – and arguably more skilled than – the author’s contribution in the age of computers and mass and automated data collection. Even it were appropriate to recognise the skill and labour of compilers in the pre-computer age, and even if it were necessary for copyright to encourage such activity, it is much less clear that it is appropriate or necessary now.

27. The protection of mere labour is not consistent with the basic purpose of copyright, namely to encourage the creation of new products of the mind. The Berne

²³ *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* [2001] FCA 612 at [55].

²⁴ Lindgren J at [70] and Sackville J at [355].

²⁵ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 10.

²⁶ Bowrey, K. " On clarifying the role of originality and fair use in 19th century UK jurisprudence: appreciating 'the humble grey which emerges as the result of long controversy'", [2008] UNSWLRS 58 at page 12.

²⁷ Lionel Bentley & Brad Sherman, *Intellectual Property Law*, Second Ed, OUP at page 90

²⁸ At page 91.

Convention²⁹ was intended to protect an author's "intellectual creations". Setting the bar lower, as Professor Ricketson observes³⁰, is contrary to the spirit if not the letter of the Convention. To protect work and investment alone is not the role of copyright law.

28. It is important that the Court identify the content of the requirement for originality in a way which gives real guidance as to the balance between the interests of the author and the public interest. It is necessary to eliminate any scope for individual conceptions as to the proper function of copyright in judicial decision making.³¹
- 10 29. That guidance ought involve a rejection of the "sweat of the brow" approach in *Desktop Marketing*. It was rejected by the US Supreme Court in *Feist Publications v. Rural Telephone Service Company* (1990)³² and by the Supreme Court of Canada in *CCH Canada Ltd v. Law Society of Upper Canada* (2004)³³.
30. It is submitted that the extra requirement for a work to be original is that it be the product of a "creative spark" as found by *Feist* or, alternatively (and recognising there is a question as to whether the requirements are different), that it be the product of "skill and judgment" as determined in *CCH*. Each of these judgments is considered below. The insistence on such a requirement involves an appropriate balance between the author's and the public interest.

The US and the Feist Decision

- 20 31. In *Feist Publications, Inc. v. Rural Telephone Service Company*, 499 U.S. 340, a unanimous Supreme Court per O'Connor, J., offered clearly articulated rationales both for a minimal requirement of original authorship and for why the "sweat of the brow" approach does not meet that requirement.
- 30 32. The *Feist* decision rested on two grounds: (1) the U.S. Constitutional provision in Article I, section, clause 8, and (2) the statutory definition of compilation in the U.S. Copyright Act. Both grounds are, however, in turn based on fundamental principles of copyright law shared by common law. Justice Lindgren was correct in observing in *Desktop Marketing* that the legislative provisions ought be discounted.³⁴ Key to understanding the *Feist* opinion is its construction of the term "author." In the 19th century, the Supreme Court had defined an author as "he to whom anything owes its origin; originator; maker." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). From this definition, *Feist* concluded:

"facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its

²⁹ *The Berne Convention for the Protection of Literary and Artistic Works*, opened for signature on 9 September 1886, 828 UNTS 221 (entered into force 5 December 1887).

³⁰ Ricketson, Sam. *The Berne Convention for the protection of literary and artistic works: 1886-1986* London : Centre for Commercial Law Studies, Queen Mary College, 1987, p.900-901.

³¹ See paragraph 3 above.

³² *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

³³ *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339.

³⁴ (2002) 119 FCR 491 at 543, [204].

*existence. To borrow from Burrow-Giles, one who discovers a fact is not its “maker” or “originator.”*³⁵

33. William Patry, a commentator whose writings were relied on in *Feist* has since noted that under this view of authors:

10 *“authors are determined not by who they are but by what they do: Authors are those who create original works. In this respect, it should be noted that the Constitution uses the terms “writings” and “authors;” “originality” is not used. Yet the Supreme Court has repeatedly construed all three terms in relation to one another and perhaps has collapsed them into a single concept. In Feist, Justice O’Connor wrote, “[f]or a particular work to be classified ‘under the head of writings of authors,’ ... ‘originality is required.’” The originality requirement, the Court stressed, is constitutionally required and consists of independent creation plus a modicum of creativity. Writings are what authors create, but for one to be an author, the writing has to be original. “Writings” and “authors” are thus not independent concepts but are instead subsumed within originality.”*³⁶

- 20 34. One cannot originate facts and therefore cannot be the author of them. At the same time, the Court in *Feist* recognised there could be compilations of facts, which, by virtue of their selection, coordination, or arrangement, might evidence the requisite originality on the question of law. How a compilation might satisfy the standard of originality, the Court said as follows:

*“This case concerns the interaction of two well-established propositions. The first is that facts are not copyrightable; the other, that compilations of facts generally are. There is an undeniable tension between these two propositions. Many compilations consist of nothing but raw data- i.e., wholly factual information not accompanied by any original written expression. On what basis may one claim a copyright in such a work? Common sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place.”*³⁷

- 30 35. The Court then solved the identified tension by reference to originality:

*“The key to resolving the tension lies in understanding why facts are not copyrightable. The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. 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 works), and that it possesses at least some minimal degree of creativity.”*³⁸

36. Facts are not themselves copyrightable since they do not originate with one purporting to be the author; as a result, the requisite creativity must be sought

³⁵ 499 U.S. at 347.

³⁶ William Patry, 1 *Patry on Copyright*, section 3:20 (Thomson/West 2006, 2008 supplement).

³⁷ 499 U.S. at 344-345.

³⁸ 499 U.S. at 345.

elsewhere, in the compiler's selection, coordination, or arrangement of facts. Under U.S. law, the originality principle is both a general standard: independent creation plus a modicum of creativity effort – and a tool to be utilized according to the particular work in question. Originality in a novel, for example, will be governed by the same general standard as applies to compilations, but originality in a novel will be found based on the author's expressive writing and language. For compilations, by contrast, originality will be found, if at all, in the manner in which compiled material are selected, coordinated or arranged. As a consequence, the infringement analysis for a compilation will be based solely on whether defendant has appropriated the compiler's original selection, coordination or arrangement.

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37. The requirement of a minimal level of creativity for compilations applies regardless of what material is being compiled: although *Feist* involved a compilation of facts (white page telephone entries), the principles of originality enunciated in *Feist* apply to all subject matter, included all types of compiled subject matter and is not limited to “whole of universe cases”.³⁹ For example, in *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003), the court denied protection to a sculptural work that consisted of compiled elements.

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38. Limiting copyright in a compilation to the compiler's original selection, coordination, or arrangement – and permitting the copying of facts from original compilations – is inextricably linked to *Feist*'s rejection of "sweat of the brow" as a theory for protection and infringement. "Sweat of the brow" is based on a distinctly non-copyright labour theory of property which was rejected long before *Feist*. In *International News Service v. Associated Press*, 248 U.S. 215, 246 (1918), Justice Oliver Wendell Holmes, Jr. wrote in his concurring opinion:

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“When an uncopyrighted combination of words is published there is no general right to forbid other people repeating them—in other words there is no property in the combination or in the thoughts or facts that the words express. Property, a creation of law, does not arise from value, although exchangeable—a matter of fact. Many exchangeable values may be destroyed intentionally without compensation. Property depends upon exclusion by law from interference, and a person is not excluded from using any combination of words merely because someone has used it before, even if it took labor and genius to make it.”⁴⁰

39. In *Feist* the Court held that the subsequent "sweat of the brow" cases “[w]ithout a doubt ... flouted basic copyright principles.” *Feist*, 499 U.S. at 354. Those principles included promoting learning and the creation of new works, principles that are inconsistent with giving ownership of facts via the backdoor of protecting the labor. In rejecting the backdoor effort to protect facts, the *Feist* Court rejected the unfair competition basis for it saying:

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“It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed,

³⁹ See the numerous examples given in *Patry on Copyright*, supra, Section 3:65 (listing musical works, pictorial and graphic works, computer screen displays, user interfaces, web page designs, PowerPoint presentations, and motion pictures).

⁴⁰ *International News Service v Associated Press*, 248 U.S. 215, 246 (1918) per Justice Oliver Wendell Holmes, Jr.

however, this is not “some unforeseen byproduct of a statutory scheme.” *Harper & Row*, 471 U.S., at 589 (dissenting opinion). It is, rather, “the essence of copyright,” *ibid.*, and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.” Art. I, § 8, cl. 8. ... To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. *Harper & Row*, *supra*, 471 U.S., at 556-557. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.”⁴¹

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40. Cases after *Feist* have followed the Supreme Court’s rejection of labor as an element of originality. See e.g., *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 711-712 (6th Cir. 2005); *J. Thomas Distributors, Inc. v. Greenline Distributors, Inc.*, 100 F.3d 956 (6th Cir. 1996). In one case, *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1268 (10th Cir. June 17, 2008), the court found computer added designs of cars were not protectable based on the tight parameters within which those designs had to operate:

“We do not for a moment seek to downplay the considerable amount of time, effort, and skill that went into making *Meshwerks*' digital wire-frame models. But, in assessing the originality of a work for which copyright protection is sought, we look only at the final product, not the process, and the fact that intensive, skillful, and even creative labor is invested in the process of creating a product does not guarantee its copyrightability.”

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41. This is contrary to the view of the Full Federal Court that the effort that went to the development of the time and title information can somehow be counted towards the weekly schedule compilations. Under U.S. law, the courts would look at the final product in which protection is claimed; say a compilation schedule of programming times and determine whether that compilation *by itself* evidenced sufficient originality. In this analysis, it would be irrelevant whether the programs were original or the manner in which the programs were sequenced during the day was original. Second, even if such a compilation schedule was, as a whole protectable, the courts would then examine whether what was taken was protectable; facts or other unprotectable elements can be and freely copied even from an otherwise original work, as *Feist* held.

Canada and the CCH Decision

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42. In *CCH Canadian Ltd. v. Law Society of Upper Canada*,⁴² the Canadian legal publishers brought a legal action against the Law Society of Upper Canada, claiming that the professional body infringed copyright in eleven works (three reported judicial decisions; the three headnotes preceding these decisions; the annotated

⁴¹ 499 U.S. at 349-350.

⁴² *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13.

Martin's Ontario Criminal Practice 1999; a case summary; a topical index; the textbook *Economic Negligence* (1989); and the monograph "Dental Evidence", being chapter 13 in *Forensic Evidence in Canada* (1991)) through making free-standing photocopiers available in the Great Library at Osgoode Hall, and providing a document delivery service to lawyers and law firms in Ontario.

43. The Law Society contended that the headnotes, case summary, topical index and reported judicial decisions were not "original" within the meaning of Canadian copyright law and, therefore, were not covered by copyright.
- 10 44. Applying a standard of "skill and judgment", the Supreme Court held that "the headnotes, case summary, topical index and compilation of reported judicial decisions are all works that have originated from their authors and are not mere copies".⁴³ In the leading judgment, McLachlin CJ held that the legal materials were "the product of the exercise of skill and judgment that is not trivial" and "as such, they are all 'original' works in which copyright subsists".⁴⁴
45. In its unanimous decision, the Supreme Court's rejection of the "sweat of the brow" approach to originality was unequivocal.⁴⁵ In the lead judgment, McLachlin CJ held:
- 20 *"The 'sweat of the brow' approach to originality is too low a standard. It shifts the balance of copyright protection too far in favour of the owner's rights, and fails to allow copyright to protect the public's interest in maximizing the production and dissemination of intellectual works."*⁴⁶
46. The Supreme Court of Canada rejected the "sweat of the brow" standard for originality under copyright law for six main reasons. McLachlin CJ had regard to (1) the plain meaning of "original"; (2) the history of copyright law; (3) academic commentary; (4) recent North American jurisprudence; (5) the purpose of the *Copyright Act*; and (6) the workability and fairness of a standard of originality.
47. In relation to the second of these she emphasised the importance of the idea of "intellectual creation" implicit in the notion of literary or artistic work under the *Berne Convention for the Protection of Literary and Artistic Works*⁴⁷ referring with approval to the view of Ricketson, already referred to.⁴⁸
- 30 48. She was of the view that it was necessary to rearticulate the doctrine of originality, so that it was compatible with the language of the *Berne Convention for the Protection of Literary and Artistic Works*.
49. As to the third, academic writing, the judgment of McLachlin J referred inter alia to the work of Emeritus Professor David Vaver in a number of respects.⁴⁹ Vaver has been critical of the "sweat of the brow" approach, observing: "While a low threshold test of originality may protect artists in their livelihood, it does not carry over well

⁴³ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13, [36].

⁴⁴ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13, [36].

⁴⁵ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13.

⁴⁶ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [24].

⁴⁷ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [19].

⁴⁸ See paragraph 27 above.

⁴⁹ Vaver, David. *Copyright Law*. Toronto: Irwin Law, 2000.

into the world of commerce.”⁵⁰ He comments upon the problems faced by judges in setting the threshold of originality:

*“The problem with originality therefore starts from its own internal incoherence. Although all concur that the author has to exercise some skill, ingenuity, judgment, labour, or expense (or some combination of these) in making the work, the type and amount effort is left unclear. Courts often fudge matters by saying that it is as a question of degree and facts; that quality matters more than quantity; and that what qualifies as original for one class of work (say, compilations) is not the same as for another (say painting).”*⁵¹

- 10 50. Vaver worries that “decisions about originality seem to be the adventures of judges’ souls in the realm of literary and artistic work”.⁵² This echoes the view of Deazley.⁵³
51. In her consideration of US authority, McLachlin CJ was ambivalent about the course taken in *Feist*⁵⁴ although sympathetic in part with the predicament of her American colleagues: “O’Connor’s J. concerns about the ‘sweat of the brow’ doctrine’s improper extension of copyright over facts also resonate in Canada.”⁵⁵ However, McLachlin maintained that the creativity standard of originality was too high: “A creativity standard implies that something must be novel or non-obvious - concepts more properly associated with patent law than copyright law.”⁵⁶
- 20 52. McLachlin CJ emphasized that the standard of originality should reflect the underlying purpose of copyright law, as articulated in earlier judgments of the Supreme Court.⁵⁷ In *Théberge v. Galerie d’Art du Petit Champlain Inc.*, Binnie J, also of the Supreme Court, observes:

“The Copyright Act is usually presented as a balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator (or, more accurately, to prevent someone other than the creator from appropriating whatever benefits may be generated)... The proper balance among these and other public policy objectives lies not only in recognizing the creator’s rights but in giving due weight to their limited nature. In crassly economic terms it would be as inefficient to overcompensate artists and authors for the right of reproduction as it would be self-defeating to undercompensate them. Once an authorized copy of a work is sold to a member of the public, it is generally for the purchaser, not the author, to determine what happens to it. Excessive control by holders of copyrights and other forms of intellectual property may unduly limit the ability of the public domain to incorporate and embellish creative

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⁵⁰ Ibid., p. 60.

⁵¹ Ibid., p. 61.

⁵² Ibid., p. 63.

⁵³ Paragraph 4 above.

⁵⁴ *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); and *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [22].

⁵⁵ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [22].

⁵⁶ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [24].

⁵⁷ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [23].

innovation in the long-term interests of society as a whole, or create practical obstacles to proper utilization.”⁵⁸

53. McLachlin J emphasized that the requirement for skill and knowledge “helps ensure that there is room for the public domain to flourish as others are able to produce new works by building on the ideas and information contained in the works of others”.⁵⁹
54. In conclusion, the Supreme Court maintained that the standard of originality should be set at the intermediate level of “skill and judgment”. McLachlin CJ provides a clear explication of this threshold:

10 *“For a work to be 'original' within the meaning of the Copyright Act, it must be more than a mere copy of another work. At the same time, it need not be creative, in the sense of being novel or unique. What is required to attract copyright protection in the expression of an idea is an exercise of skill and judgment. By skill, I mean the use of one's knowledge, developed aptitude or practised ability in producing the work. By judgment, I mean the use of one's capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. This exercise of skill and judgment will necessarily involve intellectual effort. The exercise of skill and judgment required to produce the work must not be so trivial that it could be characterized as a purely mechanical exercise. For example, any skill and judgment that might be involved in simply changing the font of a work to produce 'another' work would be too trivial to merit copyright protection as an 'original' work.”*⁶⁰

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55. McLachlin CJ maintains that this is a fair and workable standard. She suggests that “a standard requiring the exercise of skill and judgment in the production of a work avoids these difficulties and provides a workable and appropriate standard for copyright protection that is consistent with the policy objectives of the Copyright Act.”⁶¹

After CCH. "Creative spark" and "skill and judgment".

- 30 56. The decision in *CCH* has been highly influential in Canadian jurisprudence, being cited in thirty-three Canadian decisions.⁶²
57. Professor Gervais has emphasized that it is one of a trilogy of key rulings on the purpose of Canadian copyright law.⁶³ He comments:

“In CCH, the Supreme Court ostensibly opted for a notion of originality which blends American, British and also, though not explicitly, Continental

⁵⁸ *Théberge v. Galerie d'Art du Petit Champlain Inc.*, 2002 SCC 34 (CanLII).

⁵⁹ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [23].

⁶⁰ *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339 at [16].

⁶¹ *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339 at [24].

⁶² Most importantly, the Supreme Court of Canada decision in *Robertson v. Thomson Corp.*, [2006] 2 S.C.R. 363, 2006 SCC 43 considers the question of originality in the context of electronic databases of newspaper articles.

⁶³ Gervais, D. “The Purpose of Copyright Law in Canada” (2005) 2 (2) *The University of Ottawa Law and Technology Journal* 315-356.

precedents. The net result is a concept of originality based on the effort, skill and labour of an author, with the important proviso that that effort and labour must be neither mechanical nor trivial. That notion of originality is obviously of extreme significance for the protection of works whose level of originality is marginal at best (compilations of data, telephone directories, forms, etc.). It forms part of our analysis to the extent that it answers not the question to what extent should works be protected, but which works deserve protection in the first place. A balanced approach to copyright aiming to achieve an optimal level of creation and dissemination of, and access to, knowledge must not protect facts or ideas. It is the “original” contribution of the author which deserves to be “incentivized” and rewarded. That, at least, seems to be the reasoning that informed the Court’s approach.”⁶⁴

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58. Elsewhere,⁶⁵ Professor Gervais and Elizabeth Judge suggest that the Canadian standard of “skill and judgment” has only superficial differences from the United States standard of a “creative spark”:

“It seems that the Supreme Court chose a ‘middle path’ only in appearance. Canada instead has taken on a standard essentially identical to those of our American neighbours and to those of our American neighbours and to the Continental systems.”⁶⁶

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59. They also note: “The *Feist* standard of originality is in fact a ‘test’ that is both easy to use and objective” because “it consists of measuring the creative choices of the author”.⁶⁷ The pair observe: “In short, the standard established in *Feist*, itself similar to the current one in France and elsewhere in the world with regard to more technical works, is essentially identical to the ‘new’ Canadian standard, in spite of the apparent effort made by the Supreme Court to differentiate itself from foreign jurisprudence.”⁶⁸ Gervais and Judge conclude: “This originality standard is premised on the author’s creativity, defined here as non-mechanical and non-trivial effort, skill and labour.”⁶⁹

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60. Dr Teresa Scassa of the University of Ottawa observes of the decision: “While it reflects a positive trend by the Court towards a more balanced approach to interpreting the Copyright Act and a welcome concern for the public domain, it is questionable whether the attempt to be distinctly ‘Canadian’ in our approach to originality has led us to our own distinct set of interpretive problems and issues”.⁷⁰ She suggests that the Supreme Court overstates and misrepresents the threshold of originality required under United States law:

⁶⁴ Ibid. p. 321.

⁶⁵ Judge, Elizabeth and Daniel Gervais. *Intellectual Property: The Law in Canada*. Toronto: Thomas Carswell Limited, 2005.

⁶⁶ Ibid., p. 23.

⁶⁷ Ibid., p. 23.

⁶⁸ Ibid., p. 25.

⁶⁹ Ibid., p. 25.

⁷⁰ Scassa, T. “Recalibrating Copyright Law?: A Comment on the Supreme Court of Canada’s Decision in *CCH Canadian Limited et al. v. Law Society of Upper Canada*” (2004) 3 *Canadian Journal of Law and Technology* 89-100 at 92, http://cjlt.dal.ca/vol3_no2/pdfarticles/scassa.pdf

“Although the Court in *CCH Canadian* is unequivocal about the new standard for originality in Canadian copyright law, the standard chosen by the Court leaves room for its own interpretive issues. The standard set by the U.S. Supreme Court in *Feist* has been referred to by the Federal Court of Appeal and the Supreme Court of Canada as that of ‘creativity’, although in reality, the U.S. Supreme Court required only a ‘spark’ or a ‘modicum’ of creativity. In rejecting this standard, McLachlin C.J.’s critique of the U.S. standard is not that it is too ambiguous or difficult to interpret on a case-by-case; rather, her critique appears to be that it sets too high a threshold for originality. In her view, the Canadian standard of ‘skill and judgment’ requires something less than a ‘modicum’ or ‘spark’ of creativity. She argued: ‘A creativity standard implies that something ‘sweat of the brow’ standard of originality in Canada, must be novel or non-obvious — concepts more properly associated with patent law than copyright law.’ Yet this critique is overstated. While it might be true of a standard of ‘creativity’ simpliciter, it is much less true of standard that requires only a ‘minimal level’ or ‘spark’ of creativity.”⁷¹

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61. In recent times, this Court has found Canadian copyright law to be a useful point of comparison in its deliberations over Australian copyright law. In *Network Ten Pty Ltd v TCN Channel Nine*, it referred to *Théberge v. Galerie d'Art du Petit Champlain inc.*⁷²
62. *CCH* highlights the relevance of the threshold of originality under copyright law to the operation of libraries – particularly research libraries, such as the Great Library of Osgoode Hall.
63. The judgment of McLachlin J in *CCH* is useful in that it provides a clear expression of the justifications and rationales of copyright law, particularly, her view that the requirement for skill and knowledge “helps ensure that there is room for the public domain to flourish as others are able to produce new works by building on the ideas and information contained in the works of others”.⁷³
64. However, it is submitted that her criticism⁷⁴ that the *Feist* standard of originality under copyright law is equivalent to the standards of novelty and inventive step under patent law is misplaced. Quite clearly, the requirements of novelty and inventive step under patent law are a much more demanding standard than the

⁷¹ *Ibid.*, p. 90-91.

⁷² *Network Ten Pty Ltd v TCN Channel Nine* (2004 218 CLR 273 [2004] HCA 14.

⁷³ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [23].

⁷⁴ *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13 [24].

threshold of originality in copyright law. This is particularly borne out by the recent Supreme Court of the United States decision on non-obviousness in *KSR v. Teleflex*.⁷⁵

65. If the Court does not adopt the *Feist* standard of originality, it is submitted in the alternative that the *CCH Canadian Ltd. v. Law Society of Upper Canada* standard of “skill and judgment” should be adopted instead.

Substantiality

- 10 66. The Full Court correctly identified that under Australian copyright law, infringement may occur through the copying of a ‘substantial part’ of a copyright work.⁷⁶ Whether a part is substantial depends most importantly on the quality of the part copied from the copyright owner’s work. The ‘quality’ of the copied part is determined, according to this Court, by reference to the originality of the part copied.⁷⁷ In making this assessment, courts often consider whether the part of the work which has been copied is an ‘essential’ or ‘material’ part.⁷⁸ The Full Federal Court relied on this approach, specifically relying on the finding that ‘Nine’s time and title information ... had great value as an essential component in a larger compilation’ FC AB10: 4642 [102] & 4643 [105].
- 20 67. However, this Court has emphasised that whether a part is ‘essential’ or ‘material’ must be understood having regard to the nature of the copyright work, and the interest sought to be protected by recognition of copyright in that kind of work.⁷⁹ That is particularly so in the case of functional works such as computer programs, or works not protected as ends in themselves, but means to an end – such as compilations. In *Autodesk (No 2)*, Mason CJ (in a dissenting judgment) recognised that in the case of computer programs, the interest protected by copyright is the original expression of instructions for causing a device to perform a function – not the function itself. Assessing whether the 127-bit Look Up Table was ‘substantial’ by reference to whether it was ‘essential to the operation’ of the program was inappropriate, as it “seeks to re-introduce by another avenue an emphasis upon the copyright work’s function”.⁸⁰ Mason CJ’s approach was recognised to be correct in *Data Access Corporation v Powerflex Services Pty Ltd*.⁸¹
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⁷⁵ Indeed, note the comments of Kennedy J in *KSR v. Teleflex* 82 U.S.P.Q.2d 1385 (2007) on the heightened standard of non-obviousness in United States patent law: “We build and create by bringing to the tangible and palpable reality around us new works based on instinct, simple logic, ordinary inferences, extraordinary ideas, and sometimes even genius. These advances, once part of our shared knowledge, define a new threshold from which innovation starts once more. And as progress beginning from higher levels of achievement is expected in the normal course, the results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U. S. Const., Art. I, §8, cl. 8.”

⁷⁶ Copyright Act 1968 (Cth) s 14(1).

⁷⁷ *SW Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466 at 472; *Data Access Corporation v Powerflex Services Ltd* (1999) 202 CLR 1 at 32; *Autodesk Inc v Dyason (No 2)* (1993) 176 CLR 300 at 305, [9] – [11]; *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 218 CLR 273, at [46]–[49].

⁷⁸ *Autodesk v Dyason (No 2)* (1993) 176 CLR 300 at 305, per Mason CJ.

⁷⁹ See eg *The Panel* High Court decision at 599; *Data Access Corporation v Powerflex Services Pty Ltd* (1999), see also *Nationwide News Pty Ltd v Copyright Agency Ltd* (1996) 65 FCR 399, 418 (Federal Court; Sackville J).

⁸⁰ *Autodesk v Dyason (No 2)* (1993) 176 CLR 300 at 305, per Mason CJ.

⁸¹ *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 166 ALR 228 at 248

68. In this case the Full Court has erred by failing to assess substantiality by reference to the interest protected by the relevant copyright, namely the interest in compilations *qua* compilations – as collocations of materials.⁸² As recognised by the Full Federal Court in *Desktop Marketing*, the purpose of copyright in compilations is not to offer protection to facts or information, nor to the interest in the production of the facts or events which make up the contents of a database.⁸³ The *collocation* is essential, as recognised in *Ladbroke*, where Lord Pearce stated that "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."⁸⁴ Assessing substantiality of a part of a compilation by reference only to whether it is 'material' or 'essential' in the compilation re-introduces, by another means, protection for facts and information.
69. In this case, the information about the title of a program to be broadcast at a particular time is a fact, and when the Full Federal Court found infringement, the result was to protect a set of facts.⁸⁵ That any particular piece of time and title information might not exist until generated by a decision within Nine does not alter its character as information.⁸⁶ An illustration of this is to be found in *Littlewoods*.⁸⁷ There, at 652, UpJohn J agreed the plaintiff could not have a "statutory monopoly (that is, copyright) in the mere publication of the predetermination of future events when such events are and must necessarily be of (its) own creation."⁸⁸ The monopoly, if any, depends on the special representation of the information; its collocation with other pieces of information in a single compilation. The Full Court failed to clearly preserve the distinction between the time and title information and the literary compilation in which it was included.

Preparatory Work

70. The Full Court erred in finding that the preparatory work of deciding the time of broadcast of each television program was relevant to the assessment of the originality of the weekly schedules (FC AB10:4642 [104]). In this aspect, too, the Full Court lost sight of the fact that Nine sued for infringement of specific compilations, the weekly schedules, and spoke compendiously of the time and title information as the "centrepiece" of each of them without attention to the fact that much of it was not

⁸² In referring to the 'interest protected by copyright' as relevant to determining how substantiality is to be addressed, Chief Justice Mason in *Autodesk*, Justice Sackville in *Nationwide News* and this Court in *The Panel* were focusing on the nature of the interest protected by the type of copyright subject matter: *not* the commercial interests of the particular party in the case before them. Both the Full Federal Court in its judgment, and Nine in its submissions to this court, blur this distinction.

⁸³ *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 119 FCR 491 at [93].

⁸⁴ *Ladbroke* at [1964] 1 All ER 465 at 479 per Lord Pearce.

⁸⁵ In their submissions, Nine appears to argue at [24] that the time and title information is itself a kind of 'compilation' – an 'association' of program title with time. By this reasoning, however, the 'association' between an individual name and phone number is also more than a mere fact (and, indeed, a 'creation' of the relevant telephone company). A person's phone number would universally be considered a fact. The difficulty with this reasoning is that it fails to take account of the fact that copyright is offered to the compilation, *not* individual associations within a compilation.

⁸⁶ It may also be noted that as a matter of fact it was not correct to say, as the Full Federal Court did at FC AB10:4639[92], that the Weekly Schedule did not record pre-existing facts. At the time each weekly schedule was created, save for last minute adjustments of the type referred to at FC AB10:4630[67], the time and title information had been determined and committed to other compilations.

⁸⁷ *Football League Ltd v Littlewoods Pools Ltd* [1959] All ER 546.

⁸⁸ *Football League Ltd v Littlewoods Pools Ltd* [1959] All ER 546 at 552.

selected in the making of the weekly schedules but was carried over from earlier compilations, particularly the grids (FC AB10:4614[17]) and the database (FC AB10:4615 [20]). It may be that the fine adjustment of time and title information at the time the weekly schedules were made (FC AB10:4628 [61]) was sufficient, qualitatively and quantitatively as a selection, to be substantial for the purposes of infringement, but the full court did not approach the matter that way. Rather it focused on the entirety of the time and title information in each schedule because of its particular interest to potential viewers as information (FC AB10:4644 [109]) and because it regarded the totality of that information as the qualitatively significant part of each (FC AB10:4646 [116]).

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71. This Court should provide guidance on when and to what extent ‘preparatory work’ – that is, work, skill and judgment beyond the direct act of formulating and recording the expression of a copyright work – is relevant to determining what constitutes a substantial part of a work. Despite the artificiality of any test, it is clear that there must be some line between ‘relevant’ and ‘irrelevant’ work. Market research, for example, commissioned with a view to designing a new video game is not ‘preparatory work’ for the video game, no matter how extension or skilful.⁸⁹ The question is where the line is to be drawn. It is submitted that the interest protected by copyright in compilations is relevant to this question. The purpose of compilation copyright is not to protect Nine’s broadcasting choices, nor a store’s choices of what goods to offer.⁹⁰

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72. The legal test used by the Full Court to determine that the preparatory work is relevant in this case is not clear. The Full Court acknowledges that in some cases preparatory work will not be relevant, but states that ‘[t]hat, however, is not this case’ (FC AB10:4642 [103]). The judgment refers to the production of the Weekly Schedule as “one object of the process” engaged in by the employees (FC AB10:4642 [102]); but also suggests that ‘Nine engaged in the so-called preliminary work precisely in order to create the compilation’. The court also states that it does not matter that the skill and labour was “not primarily expended for the purpose of producing a compilation”. The better view is perhaps that the Full Court has adopted a test similar to that suggested by the Federal Court in *Autocaps v Pro-Kit*,⁹¹ that it is sufficient that production of a compilation is ‘a subsidiary but important object of the work’.⁹² As Ricketson and Creswell point out, this test goes further even than *Ladbroke’s* case.⁹³

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73. The effect of the Full Court approach is to protect work that has nothing to do with the activities that copyright protects: artistic, literary, and other creative expression. This occurs owing to the effect of ‘counting’ preparatory work (or skill, or judgment) at later stages in the analysis when the court considers ‘substantial part’. When the court analyses such work as making parts of a compilation ‘original’, and then

⁸⁹ Note that authorship of a work is ordinarily defined by reference to the making of an ‘original contribution’ to the copyright work: *Tate v Thomas* [1921] 1 Ch 503; *Cala Homes (South) Limited and Others v. Alfred McAlpine Homes East Limited* [1995] FSR 818.

⁹⁰ *Purefoy Engineering Co. Ltd. v. Sykes Boxall & Co. Ltd.* (1955) 72 R.P.C. 89. See similarly the judgment of Lord Diplock in *William Hill (Football) Limited v. Ladbroke (Football) Limited* [1980] RPC 539.

⁹¹ *Autocaps (Aust) Pty Ltd v Pro-Kit* [1999] FCA 1315; (1999) 46 IPR 259.

⁹² 46 IPR 259 at [42].

⁹³ See Ricketson and Creswell, *The law of intellectual property: copyright, designs & confidential information* (Looseleaf, LBC), [7.95]. One judge in *Ladbroke* goes that far: Lord Devlin.

analyses substantiality by reference to the 'originality' of the part taken, the end result is to extend the protection of copyright to non-authorial work (such as, in the instant case, the selection of what shows to broadcast when). This leads to results quite inappropriate to copyright. The skill and judgment exercised by the Nine employees was not skill and judgment of the kind copyright is meant to protect. If a researcher conducts 2 years of scientific experiments, with a view to (a) producing a result and (b) publishing it in a scientific journal, and much of the results of that work are embodied in one table in the research paper – is noting down some of those results copyright infringement – since those results reflect a significant part of the researcher's 'preparatory work'? This could give rise to overlap with areas covered by patent.

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74. Further, such a test raises difficult questions of co-authorship. Authorship of a work is ordinarily defined by reference to the making of an 'original contribution' to the copyright work.⁹⁴ Enormous amounts of effort go into the selection of the Australian Olympic Team – is the AOC to have copyright in the final list?⁹⁵ Would all the subsidiary organizations involved in selection, as 'contributors' to the 'originality' of this compilation, be co-authors?

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75. The best way to do this is to confine the relevance of preparatory contributions to those which have as their dominant or main purpose the creation of a copyright subject matter, and which contribute to the 'expression' embodied in the work.⁹⁶

76. This approach is reflected in the minority decision of Diplock LJ in the Court of Appeal in *Ladbroke* where he accepts the choice of wagers is a "selection" but not a selection relevant to the assessment of the originality of the contribution.⁹⁷

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77. The cases relied on by the Full Federal Court did not provide a sound foundation for its finding that the preparatory work of selecting time slots for programmes. In *Littlewoods Pools* the author, Mr Sutcliffe, was engaged solely in what the Trial Judge described as a single indivisible endeavour i.e., the task of making the copyright fixture list and the skill he exercised in arranging the fixtures he recorded was an integral aspect of that authorial work. So too *Ladbroke*, which involved selection (of wagers for the coupon). That activity specifically undertaken for the purpose of creating the document and was thus indivisible from the authorial expression. As already observed⁹⁸ the Full Federal Court has travelled beyond the earlier decisions.

78. Each of *Littlewoods Pools* and *Ladbroke* shows the effects of reliance on the 19th century authority without proper regard to the balance that was being undertaken between the interests of the author and the public already discussed⁹⁹.

⁹⁴ *Tate v Thomas* [1921] 1 Ch 503; *Cala Homes (South) Limited and Others v. Alfred McAlpine Homes East Limited* [1995] FSR 818.

⁹⁵ Further, would all the subsidiary organizations involved in selection, as 'contributors' to the 'originality' of this compilation, be co-authors?

⁹⁶ See also *Purefoy Engineering v Sykes Boxall* (1955) 72 RPC 89. Such a test has the advantage too of consistency with questions of authorship and co-authorship.

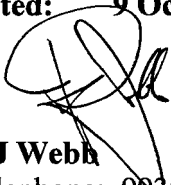
⁹⁷ *William Hill (Football) Limited v Ladbroke (Football) Limited* [1980] RPC 539 at 551 line 45.

⁹⁸ Paragraph 72 above.

⁹⁹ Paragraphs 19-25 above.

79. Further, it is apparent that in *Littlewoods Pools* and *Ladbroke* the courts were not entirely comfortable with the question of the extent to which preparatory work might be relevant to the questions of originality and substantiality. In *Littlewoods Pools* that is evident in Upjohn J's finding that if he was wrong on that aspect he nevertheless thought that the compilation was a literary copyright.¹⁰⁰
80. In *Ladbroke* some of the Lords exhibited an unease with the case which was regarded as on the borderline.¹⁰¹ Various of them were influenced to resolve the matter in favour of William Hill through resort to the approach of Peterson J that "what is worth copying is worth protecting".¹⁰²
- 10 81. From a comparative perspective, the approach adopted by the Full Federal Court is out of step with that of other important jurisdictions. Under US law, copyright in compilations has come to be termed "thin" copyright, and the copying of facts or information from a compilation is not infringement. In the European Union, and, by extension, in the United Kingdom, interpretation of the *sui generis* database protection has *not* been granted for the investment in the creation of materials which make up the contents of a database.¹⁰³

Dated: 9 October, 2008



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¹⁰⁰ *Football League Ltd v Littlewoods Pools Ltd* [1959] All ER 546 at 556.

¹⁰¹ *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 per Lord Evershed at 471, 474.

¹⁰² *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 per Lord Reid at 470; Lord Hodson at 489.

¹⁰³ Judgment of 9th November 2004 (Case C-203/02, [2005] RPC 260); applied in *The British Horseracing Board Limited v William Hill Organization Limited* [2005] EWCA (Civ) 863.

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