

INTELLECTUAL PROPERTY LAW

SUMMARY

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SAMPLE ONLY

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- **SMOT** – subject matter other than works
- **CR** – copyright
- **CA** – *Copyright Act 1968 (Cth)*
- **TM** – trade mark
- **Anticipation:** lack of novelty. Where an invention has been anticipated (i.e. in some way foreshadowed or revealed) it will no longer be considered to be novel and hence patentable. In deciding whether there has been an anticipating you follow through the various tests for novelty laid down in the Act.

- **Obviousness:** reference to the inventiveness requirement. Obviousness is the converse of inventiveness. Where person has only done what was obvious, that person has not been inventive, or has not taken an 'inventive step' and hence the 'invention' will not be patentable. Again when deciding whether there is obviousness present you follows through the various tests for inventive step laid down in the Act.
- **Integers:** are features of the invention, eg the fact that a spring is coiled clockwise rather than anticlockwise. Sometimes these integers are considered **essential** for the invention; but if they are of minor importance they will be dubbed **inessential integers**.
- **Workshop variations/adjustments or improvements or just variants:** which normally arise with questions of inventiveness. The words are used to indicate changes to the 'invention' which have not involved an inventive step. **Workshop improvements** are said to come about through ordinary methods of trial and error. They are similar to the substitution of a mechanical equivalent which again does not require any inventiveness to carry out. (Usually discussed when it is novelty which is being discussed and indicates which changes will not be taken into account when it is being decided)
- **Subject matter:** for the grant of a patent. This means that there is no patentable invention on the basis that nothing has been invented.
- **Combination patents:** comprised of integers, some or all of which are known but which a in combination produce a new and better result through the interaction of the integers.
- **Mere collection of known integers:** if the integers do not interact in this way but simply continue to perform their known functions, usually being denied registration.

1. Copyright

1.1. Overview and Policy of Copyright Law

- Copyright is the right to reproduce or copy (and to pursue related rights concerning) an original expression of an idea. The central object of copyright law was to encourage creation and publication – thereby sharing knowledge and ideas – with the incentive of retaining control over the right to copy and, therefore, a royalty stream in exchange for permission to copy.
- Australian copyright law is governed almost completely by the *Copyright Act 1968* (Cth) ('CA'). There is no common law copyright in Australia.
- Copyright is a form of personal property: s 96 CA. Copyright is transmissible by assignment, by will (can be bequeathed by testator/testatrix) and by devolution by operation of law (situation of bankruptcy/liquidation).
- Do not confuse copyright with a chattel. Copyright is incorporeal. It is immaterial and not a *thing*.

***Pacific Film Laboratories v Federal Commissioner of Taxation* (1970) (High Court)**

Facts:

- The Commissioner applied sales tax to the photographic prints developed by Pacific Film and paid for by its customers.
- Pacific Film objected to the assessment on the basis that the customer owned the copyright in the film negatives, that Pacific Film was authorised by the customer to reproduce prints from these negatives, that Pacific Film had no property right in these prints and therefore was not selling anything to the customer which might be taxed.

Held:

- The High Court held that Pacific Film was confused between the chattel right in the print (owned by Pacific Film) and the copyright in the negative (owned by the customer). The customer had authorised Pacific Film to reproduce negatives but the chattel produced in the process of this reproduction was owned by Pacific Film.
- Property in a chattel may be held by one person, and copyright held by another.

- Pacific Film had the general property in the print or duplicate which it manufactured out of its own materials and none the less so because the copyright in the negative or transparency was in some other person. Sales tax applied to the prints as chattels. The print was made with the authority of the owner, there was no infringement.

1.2 Copyright Protects the Expression of an Idea, Not the Idea Itself

- Copyright protection is give to the **form of expression** of an idea or information, not the idea or information itself.
- Is it an *expression* or an *idea*?
 - Individuality of expression connects the material in question with a particular person or author. If the material has no identifiable individuality of expression, then there will be nothing in it which is capable of copyright protection.
 - Ideas are public property and cannot be monopolised through copyright. An idea may consist of scientific truths or the ‘methods of an art’: *Baker v Selden*
 - Idea/expression dichotomy – can copyright an expression of an idea (ownership rights) but not an idea (freedom of speech and creation)

1.3 Requirement for Copyright to Subsist in a Work

1. **Remember copyright protection is give to the form of expression of an idea or information, not the idea or information itself.**
2. **The work or subject matter other than work must be in material form (s 10 CA), except in the case of broadcasts**
3. **No formal requirements or registration system: s 10 CA.**
 - The Berne Convention requires copyright be protected without formalities (Art 5)
 - If copyright is to attach to a particular work it will do so immediately the work has been created.

4. Connecting Factors Must be Satisfied

- There are jurisdictional limits to the application of the CA. The works and SMOTW will only be protected in Australia if the connecting factors exist.
- Connecting factors connect the subject matter and/or its author/maker/publisher with Australia.
 - a. The author/publisher/maker is a ‘qualified person’ (i.e. their nationality or residence must be in Australia) in order for the CA to apply (works: s 32(4) CA, SMOTW: s 84 CA); or
 - i. For SMOTW the definition of ‘qualified person’ is extended to include author/publisher/maker is a body corporate incorporated under a law of the Cth or of a State.
 - b. The *first publication* of the work must be in Australia in order for the CA to apply (works: s 32(4) CA, SMOTW: s 84 CA)
 - i. A work is deemed to be published if:
 - Reproductions of the work have been supplied (whether by sale or otherwise) to the public: s 29(1)(a) CA
 - Reproductions of the work are done in such quantities as to meet demand: s 29(4) CA
 - It is sufficient to satisfy *first* publication if publication occurs in Australia within 30 days of publication elsewhere: s 29(5) CA
 - ii. Publication is not (s 29(3) CA):
 - The performance of a dramatic or musical work;
 - The exhibition of artistic work;
 - The construction of a building or a model of a building;
 - The supplying (whether by sale or otherwise) to the public of photographs or engravings of a building, or a model of a building or of a sculpture;
 - The supplying (whether by sale or otherwise) to the public of records (e.g. disc, tape, paper, electronic file: s 10(1) CA) of a literary, dramatic or musical work

1.4 Copyright Subject Matter

- Two broad categories of the subject matter that can be copyrighted are identified in the CA:
 1. Works (s 32 CA)
 - a. Is it a work?
 - b. Is it sufficiently original?
 2. SMOTW (Part V ss 89-92 CA)

Original Works (s 32 CA)

- The term 'work' has been defined to mean 'a thing, structure or result produced by the operation, action or labour of a person or other agent':
Desktop Marketing
- Copyright only subsists in *original* literary, dramatic, musical and artistic published or unpublished works: s 32 CA.
- To be original, the expression of the idea must be original, meaning it must:
 - Not be copied
 - The product of skill, labour, expense, judgment
 - Low threshold test for originality - does not require expression of novel or new idea: *Sands and McDougall v Robinson* (1917)
 - Depends on the special facts of each case: *Victoria Park Racing*

1) Original Literary Works

- Literally works include (but not limited to):
 - a. a table, or compilation, expressed in words, figures or symbols (s 10 CA); and
 - b. a computer program or compilation of computer programs (s 10 CA).
- 'Literary work' covers work which is expressed in print or writing (regardless of quality). s 22(2) CA extends the definition to include work 'embodied in material form' – published or unpublished books, stored on computer discs, hard drives or other memory devices: *Roland Corporation v Lorenzo*.
- Must be literary work and sufficiently original: *Uni of London Press*

(a) **IS IT A LITERARY WORK?**

i. Books

- Published and unpublished books sit at the core of copyright, and are clearly literary works: *In re Dickens*

ii. Tables and Compilations

- The following can constitute literary works:
 - Telephone directories: *Desktop Marketing Systems v Telstra Corporation* (2002)
 - Advertising catalogues or motorcycle parts: *A-One Accessory Imports v Off Road Imports* (1996)
 - Listings of the names of horses and weights carried in races: *Canterbury Park Race Course v Hopkins* (1931)
 - Betting forms: *Ladbroke (Football) v William Hill (Football)* [1964]
 - Business and accounting blank forms: *Kalamazoo v Compact Business Systems* (1985)

iii. Single words, names and titles

- Titles of books are not likely to gain independence in their own right.
- Not be literary works on the basis of not imparting information, instruction or pleasure: *Exxon Corporation*

iv. Translations

- A translation falls under the definition of an *adaptation* of a work: s 10(1).
- Whether or not the author of the translation is in breach of the owner's copyright, he will be considered the author of the translation: *Byrne v Statist* [1914]

v. Computer programs

- Computer program is defined as 'a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result': s 10 CA
- Subsequent amendments to the definition of a computer program now put beyond doubt the fact that copyright can subsist in object code as a literary work. i.e. a computer program in object code.

(b) IS IT SUFFICIENTLY ORIGINAL?

- To be original there is no requirement of literary quality. The quality or the originality of the idea itself is irrelevant. It is a question of whether the idea is expressed originally.

(i) Translations

- A translation will be an original literary work on the basis of the skill, judgment, and labour that has gone into the choice of words and sentence structures.

(ii) Compilations

- The key case in Australia concerning copyright in compilations as literary works involves the originality of telephone directories.

Desktop Marketing v Telstra Corporation (2002)

Facts:

- Telstra published telephone directories, known as *The White Pages* and *The Yellow Pages*, listing the names, addresses and telephone numbers of individuals and businesses respectively.
- Desktop produced searchable CD-Rom telephone directories using Telstra's directories as the primary data source.
- Desktop Marketing argued that copyright did not subsist in Telstra's telephone directories because they were not original literary works.
- The appellant's submission was that the mere industrious collection and arrangement in a trite format of publicly available information as distinct from an intellectual contribution in terms of selection or arrangement of a compilation could not satisfy the requirement of originality.

Held:

- The court rejected the appellant's argument. Sackville J held that 'given a compilation may constitute an original literary work if the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation, there is no difficulty in concluding that Telstra had copyright in the *White Pages* and *Yellow Pages* directories.'



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