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Van Caenegem, William; Tréguier, Lucie

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## COPYRIGHT, ART AND ORIGINALITY: COMPARATIVE AND POLICY ISSUES

By Lucie Tréguier and William van Caenegem<sup>1</sup>

*'Nous ne saurions trop protester contre une doctrine qui pose en principe que l'art s'abaisse en s'alliant à l'industrie au lieu de reconnaître que c'est l'industrie qui s'élève en empruntant le secours de l'art'<sup>2</sup>*

### INTRODUCTION

This article reviews artistic works copyright in relation to useful articles, comparing the laws of France and of Australia, and thus common law and civilian approaches. These particular jurisdictions are selected for a number of reasons. First, familiarity with the law in each country, as both authors have worked in Australia and in France, and have undertaken comparative studies between these jurisdictions before. We are familiar with the general structure of both legal systems and with the elements of IP law in each. Further, French law has historically been considered influential in the civil law world, and is highly developed in relation to copyright and in particular applied art, with a substantial body of published cases and commentary. The Australian approach to the particular question of copyright for 'applied art' derives from earlier English principles and thus reflects more than an idiosyncratic domestic choice. Australia was also selected because of the significant change wrought by the recent *IceTV* decision in relation to originality of copyright works – a requirement we see as central to a potential revision of the traditional approach to works of applied art<sup>3</sup>. This apparent change has brought Australian law closer to the well-established civilian approach reflected in French case law and 'doctrine'.

In this article, we contrast the longstanding concept of 'indivisibility of art' in French law, with the traditional division between art and applied art in the common law world. This requires a conceptual analysis of what constitutes 'art' in today's world. We

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<sup>1</sup> Lucie Tréguier Graduate Lawyer at Herbert Smith Freehills, Paris, France; previously with Holman Webb, Sydney; IP Law Masters (Université Paris 2, Panthéon-Assas); Art History Bachelor (Université Paris-Sorbonne, Paris 4) [lucielou.treguier@gmail.com](mailto:lucielou.treguier@gmail.com); William van Caenegem Professor of Law, Bond University, Australia; Ilm, PhD (Cambridge) [wvancaen@bond.edu.au](mailto:wvancaen@bond.edu.au).

<sup>2</sup> [*'We cannot object strongly enough to a theory which maintains that art degrades itself by allying itself to industry, as opposed to recognising that it is industry that elevates itself by its alliance with art'*] Eugène Pouillet, *Traité théorique et pratique de la propriété littéraire et artistique et du droit de représentation* (Marchal, Billard et Co Imprimeurs-Editeurs, 1879) 75.

<sup>3</sup> *IceTV Pty Limited v Nine Network Australia Pty Limited* [2009] HCA 14.

conclude that in a contemporary setting what is ‘art’ extends far beyond the traditional categories of ‘artistic works’ found in the Australian *Copyright Act 1968* (Cth) (‘Copyright Act’), and is more in tune with the French approach to ‘*oeuvres de l’esprit*’, and the principle of ‘*unite de l’art*’.

As indicated above, our analysis is undertaken against the background of a significant shift in Australian copyright law, which has brought it closer to the civilian tradition. In *IceTV* the High Court effectively abandoned the old ‘sweat of the brow’ approach to the originality requirement in copyright law, instead requiring an ‘authorial imprint’ for copyright to subsist<sup>4</sup>. An artistic work must visually express a thought, concept or idea that is unique to the author. This is a well-established approach in the French tradition of ‘*droit d’auteur*’.

To attract copyright in Australia, a useful article (eg. a hand-turned ceramic vase) must qualify as a ‘work of artistic craftsmanship’. That category is exhaustively circumscribed in the Copyright Act. We argue that this legislative approach is too narrow and that any work that can be classified as ‘art’ according to the broad interpretation that term requires, should benefit from copyright protection, whether it be ‘fine art’ or ‘applied art’. In the result the Australian law (as an important example of the common law approach) would take a step towards closer alignment with the approach in France.

In terms of the practical implications of our approach, we argue that the originality requirement *IceTV* entails, sets a sufficiently high standard to prevent overprotection of functional articles by copyright and therefore, also preserves sufficient scope for the registered designs scheme to operate. In this light we consider that the category of ‘works of artistic craftsmanship’ has little continuing relevance. This is a significant conclusion in terms of the domestic law of Australia, but naturally also has implications for other common law jurisdictions that have also adopted a dualistic approach to copyright protection. We recognise that what we suggest is a major departure from tradition and established precedent, but that in itself is not sufficient reason not to tackle the question. Our conclusion is also significant because global harmonisation

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<sup>4</sup> *IceTV Pty Limited v Nine Network Australia Pty Limited* [2009] HCA 14; as to the concept of authorship in copyright, see Jane Ginsburg, ‘The Concept of authorship in comparative copyright law’ (2003) *DePaul Law Review* Vol 52, 1036.

of IP law is generally considered a priority goal; in terms of the direction such harmonisation takes, we see little conceptual merit in the dualistic approach enduring in Australia. Further, the logical implication of the shift in Australia to a higher standard of originality in copyright brings it closer to the civilian approach on that point – and we argue that the logical implication of that shift is that the division between art and applied art also becomes less tenable.

## ARTISTIC WORKS IN FRANCE AND AUSTRALIA

### *Category vs concept*

French and Australian law adopt very different approaches to subsistence of copyright in artistic works. Australian law in this regard is restrictive and categorical, while French law is liberal and conceptual. Further, Australian law applies different criteria to art and to applied art, whereas French law is based on '*Unité de l'art*' or 'indivisibility of art' – the same criteria apply to all forms of artistic expression.

To attract copyright in Australia a work must be either a literary, dramatic, musical or artistic work;<sup>5</sup> secondly, an artistic work must be one of the following:

- (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).

Something that does not fit into any of these categories is *ipso facto* excluded from copyright protection.<sup>6</sup> Admittedly, the terms have been given a liberal interpretation, and the further statutory definitions of some of the terms are inclusive rather than exhaustive. Nonetheless the category of artistic works is not 'at large'.

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<sup>5</sup> *Copyright Act 1968* (Cth) s 32.

<sup>6</sup> Although courts are sometimes less than precise in categorising a work. See for example, the categories of literary or dramatic works in *Nine Films & Television Pty Ltd v Ninox Television Ltd* [2005] FCA 1404.

By contrast French statute provides that copyright subsists in any 'work of the mind'. The author is entitled to copyright and moral rights 'by creation alone'.<sup>7</sup> A further provision expressly stipulates that all works of the mind are protected 'whatever their nature, their form of expression, their merit or use (*'destination'*)'.<sup>8</sup> Article L112-2 of the Intellectual Property Code contains a list of works of the mind, including 'works of applied art', but as it is non-exhaustive, an original work of the mind need not fit into one of these pre-ordained categories.<sup>9</sup>

However, although it is a central tenet of French law that any work which emanates from the mind of a human author attracts copyright,<sup>10</sup> the question of what is 'art' remains relevant as an article must result from an artistic and not a technical concept or idea for it to qualify for copyright protection. That is the reason why it is arguable that in France no copyright would vest in the lawn mower gear assembly which was at issue in the Australian case of *Greenfield*. The Australian held that it fell outside copyright because it was too strained to say that such a technical article (or any of its antecedents) was a sculpture or engraving as included in s 32 (a) of the Copyright Act.<sup>11</sup> Although the same conclusion followed in both jurisdictions, the technical reasoning in both jurisdictions is different – but the real issue is whether a given article can properly qualify as 'art'.

### *Indivisibility vs division between art and applied art*

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<sup>7</sup> *Code de la propriété intellectuelle* [Intellectual Property Code] (France) art L 111-1.

<sup>8</sup> *Ibid* art L112-1. Moral rights protection is a traditional area of difference between common law systems (where moral rights were generally unknown until recently, and civilian systems, where they are considered to lie at the heart of copyright; see Henry Hansmann and Marina Santilli, 'Authors' and Artists' Moral Rights: A Comparative Legal and Economic Analysis' *The Journal of Legal Studies* Vol. 26, No. 1 (January 1997), pp. 95-143; Elizabeth Adeney, *The moral rights of Authors and Performers: an International and Comparative Analysis*, OUP (2006).

<sup>9</sup> *Code de la propriété intellectuelle* [Intellectual Property Code] (France) arts L112-2, L112-10. In 2014 the Cour de Cassation rejected the protection of perfume by copyright, but nonetheless the opposing view also has strong support Christophe Caron, 'Pour la protection des fragrances de parfum par le droit d'auteur', [For the protection of perfume by copyright] *JCP G* n° 9, 25 Février 2013, 225

<sup>10</sup> 'Droit d'auteur' having two branches considered of equal importance: economic rights and moral rights.

<sup>11</sup> See *Greenfield Products Pty Ltd v Rover-Scott Bonnar Ltd* (1990) 95 ALR 275.

When it comes to useful articles, the question of ‘what is art’ crystallises around a putative distinction between, and differential treatment of, art and applied art. Whether and how copyright should extend to ‘applied art’ is a longstanding controversy. Article 2 of the Berne Convention reflects the different views – on the one hand works of applied art are expressly included within the expression “literary and artistic works” (see art 2(1)); but on the other hand, by virtue of article 2 (7) ‘*it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected*’. Member countries are thus left free to adopt an indivisibility or a dualism approach.

Since the early 20<sup>th</sup> century France has adopted ‘indivisibility of art’ (*‘Unité de l’art’*) as a basic principle: applied art (*‘art appliqué’*) is treated the same as fine art in copyright terms.<sup>12</sup> By contrast, Australia applies the traditional English policy that ‘*copyright protection was no longer to be available to what can be compendiously described as ordinary functional commercial articles*’.<sup>13</sup> However, an exception applies to ‘works of artistic craftsmanship’ which although functional, do benefit from copyright protection if they meet the statutory requirements and most significantly, if they are of ‘artistic quality’.<sup>14</sup> No other form of artistic work requires ‘artistic quality’. Thus, different standards are applied art (e.g., sculptures, paintings and engravings) and applied art.

In our view nothing is gained from this Australian dualism, and the French experience shows that there is no practical need for it. Copyright should subsist without modification if the work is ‘art’, has an identifiable author, and passes the *IceTV* originality test. In any case, the categorisation approach is unnecessarily restrictive, traditionalist and out of sync with modern art practice. It should be enough that the work be *art*, without requiring that it falls within one of the historically determined artistic work categories (see s 32, above), each associated with a specific and traditional artistic technique. For instance, where does a video installation fit within the present categories, or the kind of conceptual art constituted by Marcel Duchamp’s

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<sup>12</sup> At least in theory; we examine the consistency of this approach below – see *Unite de l’art*.

<sup>13</sup> *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [2000] ECDR 445, 452 [15].

<sup>14</sup> Below we use the term ‘fine art’ to refer to artistic works that are not also useful articles; in other words, to artistic works that have no other purpose than communicating art.

'Fountain'?<sup>15</sup> As identified in *Elwood*, the essence of art is that it concerns an expression in a form that is to be appreciated *visually* (rather than semiotically, aurally, sensorially or practically).<sup>16</sup> Nothing more should be required; and in the French and more broadly civilian tradition, nothing else *is* required.

This approach renders the question of 'what is art' more significant in legal terms than it has been. In effect, it is not a particularly relevant question in Australian copyright law at present since the determinative issue is whether the work is a drawing, sculpture, engraving, photograph etc (something listed in s 32) and not whether it is 'art'<sup>17</sup>.

In our view artistic copyright should not extend to articles that are not intended to be visually appreciated;<sup>18</sup> nor should it extend to creations that have only a practical or functional purpose, to which other intellectual property regimes apply, particularly patents or designs. Artistic copyright is concerned with an idea or concept that is actually expressed in a form that invites its visual appreciation, not with the three-dimensional expression of a technical or functional idea. If there is no artistic concept that invites visual appreciation, then we have no artistic work – as for instance with the above-mentioned mower gear assembly in *Greenfield*,<sup>19</sup> or the flexible bridge seals in *CIPEC SA* case<sup>20</sup>.

However, the fact that an article created *also* has a practical function should be of no consequence – '*[T]he whole antithesis between utility and beauty, between function and art, is a false one*'.<sup>21</sup> Take for instance fashion (an area often excluded from copyright, in whole or in part): the author creates a garment that is an original

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<sup>15</sup> In fact, it is a standard urinal, usually presented on its back. See *Marcel Duchamp Fountain* (August 2015) Tate <<http://www.tate.org.uk/art/artworks/duchamp-fountain-t07573>>.

<sup>16</sup> *Elwood Clothing Pty Ltd v Cotton Clothing Pty Ltd* (2008) 172 FCR 580. The essential character of an artistic work in Australia is that it is created by a particular artistic method and that it is to be visually appreciated, rather than semiotically or in some other way. The Full Court in *Elwood* adopted these words of the trial judge in that regard: '[There is] a body of case law, which establishes that (1) whether a work will be recognized as an artistic work such as a drawing is highly fact-specific, such that no bright-line rule can be drawn; and (2) the important principle in deciding whether the work is a "drawing" is whether the work at issue can be said to have a visual rather than "semiotic" function'. See *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd* (2008) 172 FCR 580, 590 [50].

<sup>17</sup> Art in our present context of practical articles relates to the 'visual arts', as distinct from music and literature, which are also rightly protected by copyright.

<sup>18</sup> We focus on the visual arts here, although the same applies to music or literature. *Lucasfilm v Ainsworth* [2011] UKSC 39 provides a useful analogy for this broad reference to visual appreciation, being that the item has an 'intrinsic quality of being intended to be enjoyed as a visual thing'.

<sup>19</sup> (1990) 95 ALR 275.

<sup>20</sup> *Compagnie Industrielle de Precontrainte et D'Equipment des Constructions SA v First Melbourne Securities Pty Ltd* [1999] FCA 660; 44 IPR 512.

<sup>21</sup> *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1974] 2 All ER 420, 436.

expression of an artistic idea or concept intended *to be visually appreciated*. Incidentally he or she may also use a typical technique for that kind of pursuit (e.g., the making of drawings, cutting of patterns, pinning on a model etc.). But that, and the fact that the garment is also adapted to be worn, should not have any adverse consequences in terms of protection through copyright. In the French tradition, copyright is fully applicable to fashion, and there are numerous court decisions concerned with reproductions of garments and apparel<sup>22</sup>.

But is it warranted to take a broad view centred on as contested a notion as ‘art’? Is the notion too arbitrary and diffuse to rationally serve a legal purpose? There is no doubt that art experts and philosophers have struggled to define what is art, and that the notion changes over time; we explore this tendency further below. However, a sufficiently clear definition is nonetheless possible; and importantly, a definition that is of universal application and not varying from jurisdiction to jurisdiction. Employing a test of aesthetic quality is notoriously unreliable; and focusing on the technique by which an artistic concept is expressed (e.g., by sculpting or drawing) is narrow and out of touch with evolving art practice. To adhere to the traditional set (as expressed in s 32 and the s 10 Copyright Act definition of artistic works) puts an unnecessary strain on the inclusion of new and constantly evolving forms of artistic expression within the sphere of copyright. It also tends against the inclusion of techniques that are associated with the manufacture of articles, prototypes or models of articles. Although courts also have recourse to dictionary definitions, they are not necessarily of as much assistance as courts might seek – where subtle distinctions are required relatively compact dictionary entries might provide little further guidance.

The answer to the question ‘what is art?’ can be governed by conceptual boundaries that are manageable within the copyright sphere – something that is largely demonstrated by the French tradition of copyright in artistic expression. At core the notion of ‘art’ centres on an authorial idea or concept, whose expression in a material form is intended to be appreciated visually. In the next section we further argue that although at its outer limit the notion is nebulous, it clearly has evolved towards greater participation of the observer in constituting an article as ‘art’, and a relinquishing of

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<sup>22</sup> Violet Atkinson, Viviane Azard, Marie Malaurie-Vignal, William van Caenegem ‘Comparative study of fashion and IP: Copyright and designs in France, Europe and Australia.’ *Journal of Intellectual Property Law & Practice*, Volume 11, Issue 7, 1 July 2016, 516–532.

technical standards (of aesthetics, techniques, etc.) in favour of a more conceptual, flexible and broadly inclusive approach. This relevant to an evaluation of the appropriate response of copyright to contested claims of inclusion relating to various forms of expression.

## THE EVOLVING NOTION OF 'ART'

As we acknowledged above, the concept of 'art' has evolved greatly over time and is almost as fluid as art appreciation itself.<sup>23</sup> There is no authoritative definition as today artistic expression and consumption are no longer pursuits defined by self-appointed arbiters, but are rather pervasive and omnipresent activities.<sup>24</sup> Modern means of communication and mobility have allowed art definition to escape from dominant discourses in America and Europe.<sup>25</sup> Cultural exceptionalism has receded in the face of global integration generated by the internet, mass communication and international commerce, migration and travel.<sup>26</sup> Ubiquitous technologies have popularised art creation – think e-collage, mash-ups and the like. Incidentally, in an integrated world of cumulative, shared and rapidly evolving artistic practice there is less and less room for jurisdiction-specific notions of art and artistic expression. The contemporary broad and flexible approach to the concept of art means that it is more amenable to universal application – thus tending towards harmonisation of legal systems (an established goal of IP policy) rather than fracturing on the basis of narrow and parochial views<sup>27</sup>.

In any case, even the most cursory historical investigation of art theory reveals many irreconcilable views. Aristotle's notion of art focuses on beauty. He refers to the perfected beauty of nature that human beings imitate by using mathematical notions

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<sup>23</sup> A. H. Hannay, 'Is Art Subjective?' (1947 - 1948) 48 *Proceedings of the Aristotelian Society* 29.

<sup>24</sup> Marisa Enhuber, 'Art, space and technology: how the digitisation and digitalisation of art space affect the consumption of art—a critical approach' (2015) 26(2) *Digital Creativity* 121; Francesca Polacci, 'The Google Art Project: Democratisation of art or ideology of transparency?' [2015] (2) *THEMA. La revue des Musées de la civilisation*, 73.

<sup>25</sup> Wang Furen, "'Western discourse' and contemporary Chinese culture' (2007) 1(2), *Frontiers of Literary Studies in China*, 197. This is regardless of the still current domination of Western artists in most international Biennials, see Olav Velthuis and Stefano Baia Curioni (eds), *Cosmopolitan Canvases: The Globalization of Markets for Contemporary Art* (Oxford University Press, 2015), 65.

<sup>26</sup> Homi Bhabha, *The Location of Culture* (Routledge, 1994), 37.

<sup>27</sup> Intellectual Property law is one of the most active areas of international collaboration towards harmonisation and universal standards – starting with some of the earliest international legal treaties (the Berne Convention for the Protection of Literary and Artistic Works of 1886 and the Paris Convention for the Protection of Industrial Property of 1883, the WTO/TRIPS agreement of 1995, and more recent bilateral treaties such as the Australia United States Free Trade Agreement (AUSFTA) of 2004 with its significant IP provisions, including in the field of copyright.

including symmetry, proportion and perspective in a search for perfection.<sup>28</sup> In more recent times, Kant and Schiller also referred to beauty as the aim of art.<sup>29</sup> According to Schiller, art as a source of beauty is pleasure without practical advantage. However, philosophers of aesthetics also agree that beauty depends on the perception of the observer ('beauty is in the eye of the beholder'<sup>30</sup>): it is thus an entirely subjective notion. Interestingly, Miller identified two types of beauty: '*the one, general beauty, which attracts people as the sun attracts the planet this is found chiefly in antique art and the other, individual beauty, which results from the observer himself becoming a sun attracting beauty, this is the beauty of modern art*'.<sup>31</sup>

Thus, to allocate to the concepts of beauty or aesthetics the task of triaging between art and non-art effectively relies too much on an idiosyncratic and deeply personal judgment. This can not be a judgment anchored in objective analysis. The practical effect will be to hand determination of the question to an (often self-appointed) elite.

Kant suggested that there are two different attitudes towards an object: looking at a piece of art requires spiritual distance ('disinterested observation') while looking at a mere object requires practical attitude.<sup>32</sup> The difference between art and non-art or mere objects thus relies on the observer's attitude towards the object.<sup>33</sup> Although this is a very reductionist approach, Kant's discourse can be situated in the 18<sup>th</sup> century debate opposing classical and modern art theories. This discourse resulted in a more sophisticated appreciation and understanding of 'art', and itself laid the groundwork for more modern theories. Kant introduces the notion of involving the observer in the determination of what is art, not by some quality assessment but by attitude. This involvement is of critical importance in our view – as we further explore below.

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<sup>28</sup> John S. Marshall, 'Art and Aesthetic in Aristotle' (1953) 12(2) *The Journal of Aesthetics and Art Criticism*, 228. However, it can be noted relevantly in this context that in Aristotle's work considered globally, art and craft are included in one of the five same virtue of thought: the technê, which is translated as craft or art.

<sup>29</sup> J.H. Bernard, *Kant's Critique of Judgment, translated with introduction and notes* (Macmillan, 2<sup>nd</sup> ed, 1914); Gerhard Fricke, Herbert G. Göpfert and Carl Hanser (eds), Friedrich Schiller, *Sämtliche Werke* (1959) vol 5.

<sup>30</sup> A sentiment first coined in this particular form by Margaret Wolfe Hungerford in her novel *Molly Bawn* (Tauchnitz, 1878) vol 1, but with many a philosophical antecedent.

<sup>31</sup> Leo Tolstoy and Aylmer Maude (ed), *What is art?* (New York Funk and Wagnalls Co, 1904), 25.

<sup>32</sup> Paul Gyer and Allen W Wood (eds), Immanuel Kant, *Critique of pure reason* (Cambridge University Press, 1998).

<sup>33</sup> *Ibid.*

Ruskin considered the relationship between art and reality – an important issue in the days before abstract and conceptual art became mainstream. He rejected the more traditional idea that art concerns representations of reality, in favour of emphasising that art is in fact a statement *about* reality – it must present a truth *beyond* reality.<sup>34</sup> Postmodernism then advocated a further relinquishing of restraints '*[a]nd what postmodern thinking has done is simply to have widened the boundaries of the subject of art. This can be no bad thing. For art, in one form or another, permeates our existence, or we experience its lack*'.<sup>35</sup> More recently, Danto has suggested some representation or statement, not simply understood by reference to its historical meaning (representing reality, beauty, etc) but also in an extended sense, as a statement made by the artist, a unique addition expressing the author's view, perception, effort or personality.<sup>36</sup> This refers to the important distinction between art and artefact – art as more and different from simple depiction and also as distinct from the object's self, art also as involving both artist and observer, because it requires interpretation as well as creation.

Unsurprisingly, because so reductionist in effect, neither aesthetics nor technique nor representation are placed at the centre of the debate about art by contemporary theorists. George Dickie stresses that the attempt to define art by its conditions (whether aesthetic or otherwise) is an outdated endeavour. He adopts a social approach saying that '*a work of art is an artefact which has had conferred upon it the status of candidate for appreciation by the artworld*'.<sup>37</sup> He later refined the definition to read: '*an artwork is an artefact of a kind created to be presented to an artworld public*'.<sup>38</sup> This statement highlights some important notions: emphasis on the intention of the author; that art is art because of a contextual certification of some sort; and the impossibility of a comprehensive (in the sense of all-inclusive) definition of art at any given point in time (as earlier identified by Morris Weitz).<sup>39</sup>

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<sup>34</sup> See Kenneth Clark, *John Ruskin Selected Writings* (Penguin Books, 1991) 133–34.

<sup>35</sup> Patricia Railing, 'Review of Art in Theory, 1900-2000: An anthology of changing ideas' (2004) 11(1) *The Art Book* 39.

<sup>36</sup> Arthur C. Danto, 'Art, Philosophy, and the Philosophy of Art', (1983) 4(1) *Humanities* 1.

<sup>37</sup> George Dickie, *Art and the Aesthetic: An Institutional Analysis* (Cornell University Press, 1974).

<sup>38</sup> George Dickie, 'The Institutional Theory of Art' in Noël Carroll (ed), *Theories of Art Today* (The University of Wisconsin Press, 2000), 96.

<sup>39</sup> Morris Weitz, 'The Role of Theory in Aesthetics' (1956) 15 *Journal of Aesthetics and Art Criticism* 27.

Dickie's theory includes any object as long as it is 'certified' by the artworld in the category of 'art'. When it comes to practical articles, this would include designs presented in museums, for instance. But in our view the concept of the 'artworld' should be taken more broadly, as the absence of precise definition permits.<sup>40</sup> The 'artworld' should simply be defined as those experiencing enjoyment (in the broadest sense of 'appreciation') by visual observation; and it is possible to *enjoy by observation many articles that also serve a practical purpose*. Thus, fashion garments, for instance, are presented at fashion shows, popularised by art photography in many magazines and online, and of course also observed as worn by others.<sup>41</sup> They are enjoyed practically by those who wear them *but appreciated visually by many more*. Applying Dickie's theory, such appreciation by observation would be a form of certification by an artworld, broadly defined in the modern context where almost everybody is a member of an artworld.<sup>42</sup> Conversely, fine art (art for which Australian law does not require any further evidence of 'artistic quality')<sup>43</sup> commonly performs a role *just as practical as 'applied art'*. Thus, for instance, a painting may be enjoyed purely for its own sake by the art collector, but a real estate agent may put it on an office wall to make the place more attractive to customers – this is art applied just as much to a practical purpose as is designer furniture or fashion. Here, the work is first recognised as 'art' by the artworld, then to be employed for useful purposes.<sup>44</sup>

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<sup>40</sup> 'If Danto's artworld is a world of ideas, Dickie's is a world of people, of artists and their publics' in Noël Carroll (ed), *Theories of Art Today* (University of Wisconsin Press, 2000) 14.

<sup>41</sup> For instance, Irving Penn. In the final analysis, what is required is that a product is experienced by the consumer or viewer as more than a mere thing; and the less it is only used for its practical utility, the more it is passively for its own sake, the more it is consumed as art rather than object.

<sup>42</sup> Dickie also noted that giving names to works, while this is not a prerequisite for recognition as art, is a certifying element: 'giving it a title makes clear to whomever is interested that an object is a work of art'; Most designs have titles or names, which not only helps recognise the design but crucially, as with paintings, provides an alternative identity to the object outside its practical or commercial identity; See above n 36, 432.

<sup>43</sup> For example, literary, dramatic, musical works, but also for painting, sculpture, drawing, engraving or photograph, a building or a model of a building.

<sup>44</sup> The vulgarisation of art (whether fine art to applied or applied to fine art) needs to be accepted as a fact, rather than rejected from a narrow and elitist point of view that seeks to somehow identify fine art as unconditionally deserving of copyright protection. See Hermine-Charlotte Foucher, who refers to the ideal of art reflected in some of the Revolutionary laws of the late 19<sup>th</sup> century in France as being based on a concept of art that is 'élitiste, étroite'; see Hermine-Charlotte Foucher, 'Le Concept des arts appliqués au travers de sa protection en droit français et allemand' [Hermine-Charlotte Foucher], *Les blogs pédagogiques de l'Université Paris Nanterre* (21 January 2007), I. B <<http://blogs.u-paris10.fr/content/le-concept-des-arts-appliqu%C3%A9s-au-travers-de-sa-protection-en-droit-fran%C3%A7ais-et-allemand-par->>, a conception which she stresses also influenced German law.

The 'artworld' theory further emphasises the importance of drawing observers and not only artists into the exercise of defining art.<sup>45</sup> The inference or interpretation an article elicits from the observer is essential to its classification as art. The interpretation can be passive or active (for instance, Spoerri's trapping work allows for a creative dialogue between the artist and spectator; and Piero Manzoni's 'Living Sculptures' questions the definition of art).<sup>46</sup> Even where the spectator is passive, art will always induce an emotional and mindful response: a sense of beauty, interest, or revulsion, vexation by the lack of content or complexity,<sup>47</sup> drawing on the viewer's own experience. Crucially, art invites a reaction beyond mere observation or utilisation, although that reaction may vary and be unique to every single viewer.<sup>48</sup>

Most important is that the artist cannot unilaterally determine what is art. Marcel Duchamp explained that '*The creative act takes another aspect when the spectator experiences the phenomenon of transmutation: through the change from inert matter into a work of art, an actual transubstantiation has taken place, and the role of the spectator is to determine the weight of the work on the aesthetic scale*'.<sup>49</sup> He went on to add that '*[T]he creative act is not formed by the artist alone; the spectator brings the work in contact with the external world by deciphering and interpreting its inner qualifications and thus adds his contribution to the creative act*'.

Thus, art is intrinsically concerned with *both artist and observer*. It is a concept that joins creator and spectator directly together. The appreciation by a viewer may include aesthetic enjoyment, but is not limited to that; simple evocation of a meaning or sentiment *beyond the immediate reality of the article* is sufficient. In other words, recognition by the observer of a particular object as intended to fulfil a role greater than mere representation, functionality or utility. Sometimes this message is conveyed

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<sup>45</sup> Leon Rosenstein, 'The end of art theory' (2002) XV(1) *Humanitas* 32.

<sup>46</sup> Daniel Spoerri, *Trap Picture* (1972); Piero Manzoni, *Sculture viventi* (1961).

<sup>47</sup> James Meyer, *Minimalism: Art and Polemics in the Sixties* (Yale University Press, 2001) 6.

<sup>48</sup> The viewers might interpret that differently depending on who they are, what ideas, attitudes, familiarity with art, they hold, as the story of the rubbish bag collected by a cleaner shows: see *Cleaner bins rubbish bag artwork* (27 August 2004) BBC News <<http://www.news.bbc.co.uk/2/hi/entertainment/3604278.stm>>.

<sup>49</sup> Maria Popova, *The Creative Act: Marcel Duchamp's 1957 Classic, Read by the Artist Himself* (23 August 2012) Brain Pickings <https://www.brainpickings.org/2012/08/23/the-creative-act-marcel-duchamp-1957/>.

by the thing itself but at other times only by its context: therefore, a rubbish bag can be a work of art if it is part of an installation in a museum.<sup>50</sup>

In '*What is art?*' Tolstoy examined various theories and chose to define art without relying on beauty but as an expression of a feeling or experience in such a way that the audience to whom the art is directed *can share that feeling or experience*.<sup>51</sup> More recently, Walton has also referred to the importance of the observer to the identification of categories of art. He relevantly suggested that works of art are objects with various properties but that the spectator is mostly interested in the perceptual ones (visual, audible) which are perceived as falling in one or another of the categories of artistic work.<sup>52</sup>

However, the observer participates not in something that simply exists, but that emanates from a creator, and hence the concept of art is inextricably linked with the idea of human *creativity*: the generation of something uniquely reflective of an author's creative thinking and ambition. Creativity should not be oversimplified as a straightforward binary process: aspects of creativity are present not only in the idea and the finished product but are also embedded in the manufacturing or making process. Therefore, originality can be identified not only by looking at the final product in isolation, but also by examining the making process, taking account of the intentionality, the skills, the technique and the uniqueness of the artist's expression. The skills of the creator as artist are therefore relevant but not sufficient by themselves: they must be either the method of expressing an artistic concept or closely intertwined with the process of applying creativity.<sup>53</sup> The end product is not sufficient in itself to determine what is art, and does not necessarily attract copyright per se.

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<sup>50</sup> See *Cleaner bins rubbish bag artwork* (27 August 2004) BBC News <<http://www.news.bbc.co.uk/2/hi/entertainment/3604278.stm>>.

<sup>51</sup> Leo Tolstoy and Aylmer Maude (ed), *What is art?* (New York Funk and Wagnalls Co, 1904).

<sup>52</sup> Kendall L. Walton, 'Categories of Art', (1970) 79(3) *Philosophical Review* 334, 336. Walton considers such categorisations a useful tool for the courts to determine whether a work of the mind should be protected. The use of categories does however not mean that the categories should be used to discriminate between a type of art and another.

<sup>53</sup> Roger Crisp (ed), Aristotle, *Nicomachean Ethics* (Cambridge University Press, 2000); Jean-Paul Sartre, *L'existentialisme est un humanisme* (Gallimard, 1996). Sartre stressed that the essence of a product precedes its existence.

By implication it is also not possible, in our view, to define art by focusing predominantly on the technique or method of its production (as Australian copyright presently does to a substantial extent). Art is not art because it was sculpted, drawn, photographed, engraved etc. If the contrary approach is taken, then things that are exclusively in the realm of the practical or technical might be protected by copyright. Engineering drawings that are no more than the expression of technical solutions ought not to fall within the realm of copyright merely because they have been produced by a technique of drawing lines on paper (or the digital equivalent)<sup>54</sup>. The notion of art has become something much more conceptual, evolving, interdependent and flexible, shorn of rigid technical or aesthetic standards but mediated by a stricter insistence on creative authorial input.

On a final note, what evidence might be called to establish that something *at the boundaries* is art in this broader sense? First, it must be something intended and able to be visually appreciated. Secondly, the testimony of the artist – did they intend to make art, including the artistic concept, idea, philosophy or message behind the piece. It might be appropriate to augment the evidence of the artist by expert evidence – does the artistic practice and intent that the artist testifies to, fit into known artistic practice, an artistic movement or philosophy for instance? Thirdly, evidence from observers, including but not limited to other artists, or art experts<sup>55</sup>, as to their perception of the work itself: is it perceived as art or artefact, art or article? It is worth noting here that the question cannot and should not be reduced to a simple appreciation of aesthetic merit or quality – the kind of judgment the courts commonly and rightly express reluctance to engage in because of perceived subjectivity. Evidence of observers or consumers, as submitted in trade mark litigation and submissions to Trade Mark Office Examiners, could also be relevant. Thus, we would guard against those who would retrospectively declare art work that was not genuinely or realistically intended to fit within that category.

## UNITE DE L'ART VS ARTS AND CRAFTS

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<sup>54</sup> See *Compagnie Industrielle de Précontrainte et D'Equipment des Constructions SA v First Melbourne Securities Pty Ltd* (1999) 44 IPR 512; designs registration is available, as is trade secrets protection, patenting etc.

<sup>55</sup> As for instance called upon in *Johansen v Art Gallery of NSW* [2006] NSWSC 577 about a charcoal drawing, although this was not a copyright case; as to judicial reluctance to judge what is art, see also C. Farley, 'Judging Art' (2005) 79 *Tulane Law Review* 805

What we said above defining ‘art’ as a flexible conceptually driven notion already points to the distinction between art and applied art – strong in the common law tradition – being meaningless. Nonetheless we consider the issue further below, as the distinction has played an important role in limiting the scope of copyright here, and presents such a stark contrast between French and Australian law – or more broadly between civilian and common law approaches. The way the matter has played out in detail in France tends to illustrate that concerns about overprotection resulting from a relaxation of copyright standards for ‘applied art’ in Australia are unfounded. That is in large measure because the standard of originality has now been elevated by Australian courts, bringing it more into line with the longstanding authorial focus of civilian jurisdictions<sup>56</sup>.

The *unité de l’art* (‘indivisibility of art’) approach to copyright protection is the result of a long evolution in France. Its theoretical foundation is that there is a single unified concept of art. There is no lesser art, and therefore, no categories of art to which different legal standards attach: a work of the mind should not be disqualified from copyright protection on the mere basis that it is expressed in a utilitarian form. This approach to art, and hence copyright, contrasts with the traditional common law approach which distinguishes between art and applied art (works of artistic craftsmanship), and for the latter, imposes an additional statutory requirement of ‘artistic quality’<sup>57</sup>. The ‘indivisibility of art’ approach obviously accords well with the broad, flexible and conceptual definition of ‘art’ that we advanced above.

In France, the *Decree of 19 July 1793*, regarding the property rights of authors in writings of all kinds, of composers of music, of painters and illustrators,<sup>58</sup> reflected a

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<sup>56</sup> As now also reflected in European decisions: see Case C-5/08, *Infopaq Int'l A/S v. Danske Dagblades Forening* [19 July 2009] ECR I-6569, a decision of the European Court of Justice concerning the interpretation of Directive 2001/29/EC on the harmonisation of certain aspects of copyright.

<sup>57</sup> The concept of ‘works of artistic craftsmanship’ has been one of the most difficult in the English tradition of copyright, which Australian law reflects. The latest – and controversial – judicial consideration, by the High Court of Australia is *Burge v Swarbrick* [2007] HCA 17; (2007) 232 CLR 336; see also Pila, Justine ‘Works of Artistic Craftsmanship in the High Court of Australia: The Exception as Paradigm Copyright Work’ (2008) 36(3) Federal Law Review 363.

<sup>58</sup> *Décret du 19 juillet 1793 relatif aux droits de propriété des auteurs d’écrits en tout genre, compositeurs de musique, peintres et dessinateur* [Decree of 19 July 1793].

dualist approach. It was founded on an elitist conception of fine art, and did not protect designs (or '*dessins et soyeux*') which fell within the scope of the *Law of 18 March 1806*.<sup>59</sup> The prevailing view, rooted in the political control of art exemplified by the official art exhibitions (or 'salons') of the *Academie des Beaux Arts*,<sup>60</sup> corresponded '*à un ideal, il était pur et supérieur*' ('to an ideal, [art] was pure and superior').<sup>61</sup> The Academy of Painting and Sculpture further discriminated between "acceptable" and "non-acceptable" art which, considered scandalous, should not be exhibited to the public at the Salon sponsored by the *Academie des Beaux Arts* (i.e., the French Government). This thinking prevailed during most of the 1800's until the writings of Pouillet at the turn of the century .

Pouillet elaborated a scholarly doctrine of *unité de l'art*. Neither the destination nor the use of a piece of art, nor its artistic merit should be taken into consideration in copyright terms. The only requirement to gain copyright protection was that an 'effort of the human mind'<sup>62</sup> had resulted in a creation that reflects the personality of the author. The use of the word 'personality' should not be understood literally as a reference to personality traits of the author. It is rather an open test which includes having regard to the arbitrary choices made by the particular author, and perhaps whether the author has expressed some emotional or particular aspects of their individuality. This has been confirmed by the adoption of the concept by French courts (see below). Pouillet also argued that discriminating between forms of art was unacceptable for a court of law: '*il n'existe qu'un art*' ('there is only one 'art').<sup>63</sup> He suggested that when a work of the mind is industrially reproduced, industry is elevated to the ranks of fine art, and the contrary should not hold (i.e., art being denied the quality of art by being the object of manufacturing). Pouillet argued that machinery is always used and controlled by an

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<sup>59</sup> *Loi du 18 mars 1806 création d'un conseil des prudhommes à Lyon* (Rhône) [Law of 18 March 1806].

<sup>60</sup> See also Hermine-Charlotte Foucher, 'Le Concept des arts appliqués au travers de sa protection en droit français et allemand' [Hermine-Charlotte Foucher], *Les blogs pédagogiques de l'Université Paris Nanterre* (21 January 2007) <[http://blogs.u-paris10.fr/content/le-concept-des-arts-appliqu%C3%A9s-au-travers-de-sa-protection-en-droit-fran%C3%A7ais-et-allemand-par->](http://blogs.u-paris10.fr/content/le-concept-des-arts-appliqu%C3%A9s-au-travers-de-sa-protection-en-droit-fran%C3%A7ais-et-allemand-par-).

<sup>61</sup> *Ibid*, I. A.

<sup>62</sup> Pouillet, above n 2, 38; '*l'oeuvre d'auteurs différents, ayant chacun son individualité, et mettant son nom au bras de son travail*'.

<sup>63</sup> See Hermine-Charlotte Foucher, 'Le Concept des arts appliqués au travers de sa protection en droit français et allemand' [Hermine-Charlotte Foucher], *Les blogs pédagogiques de l'Université Paris Nanterre* (21 January 2007), I. B <[http://blogs.u-paris10.fr/content/le-concept-des-arts-appliqu%C3%A9s-au-travers-de-sa-protection-en-droit-fran%C3%A7ais-et-allemand-par->](http://blogs.u-paris10.fr/content/le-concept-des-arts-appliqu%C3%A9s-au-travers-de-sa-protection-en-droit-fran%C3%A7ais-et-allemand-par-).

author, with particular skills, knowledge and artistic tastes, and that the use of machines in the manufacturing process should not result in the denial of copyright protection for a piece of art.<sup>64</sup>

Pouillet's argument appears particularly modern.<sup>65</sup> It clearly resonates with contemporary artistic practice, with the increased use of digital technology, machinery, engineering and the development of artistic workshops where the artist only plays the role of a conductor, and direct evidence of the artist's own hand often vanishes, as for instance in Warhol's 'The Factory' in New York and Xavier Veilhan's team and studio in Paris<sup>66</sup>. It also resonates with the legal uncertainty in all jurisdictions worldwide, surrounding the protection of art generated by artificial intelligence, where programmed machines sometimes override human authors<sup>67</sup>. It is in line with a more conceptual, less technical approach to what is art.

French courts adopted Pouillet's approach, accepting that the 19<sup>th</sup> century requirements to gain copyright protection were unsatisfactory and particularly that art and industry were meant to be unified in a single category of artistic expression. With the *Law of 11 March 1902* followed the statutory consecration of the theory.<sup>68</sup> Doubts however remained as this Act still referred to '*beaux arts*' or fine art.<sup>69</sup> It was not until the *Law of 11 March 1957* that the theory was fully consolidated into French law:<sup>70</sup> article 2 provides that the type, the mode of expression, the merit or the destination (i.e., use) of a work *should not be considered*. The provisions have since been applied

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<sup>64</sup> Above n 2, 82. This idea was analogous to what Lord Simon said in *Hensher* where he held that 'even though [craftsmanship] cannot be confined to handicraft, it at least presupposes special training, skill and knowledge for its production ... [it] implies a manifestation of pride in sound workmanship'.

<sup>65</sup> His approach is also implicitly recognised in Australia, with the recognition in *Coogi* that a work of artistic craftsmanship can be produced by a computerised knitting machine programmed by a skilled human operator under direction from an artistic designer: see *Coogi Australia Pty Ltd v Hysport International Pty Ltd* (1998) 86 FCR 154.

<sup>66</sup> Sherri Irvin, 'Appropriation and Authorship in Contemporary Art', (2005) 45(2) *The British Journal of Aesthetics* 123.

<sup>67</sup> Shlomit Yanisky-Ravid, 'Generating Rembrandt: Artificial Intelligence, Copyright, and Accountability in the 3A Era—the Human-Like Authors are already here—a New Model', 2017 *Mich St. L. Rev.* 659

<sup>68</sup> *Loi du 11 mars 1902 étendant aux oeuvres de sculpture l'application de la loi des 19-24 juillet 1793* [Law of 11 March 1902] *sur la propriété artistique et littéraire* [assimilates applied art and pure or fine art and accepts the former within the scope of copyright protection].

<sup>69</sup> *Ibid.*

<sup>70</sup> *Loi n° 57-298 du 11 mars 1957 sur la propriété littéraire et artistique* [Law No 57-298 of 11 March 1957].

by the courts which have found that copyright subsists in a salad spinner,<sup>71</sup> or a coat rack in the form of a dolphin,<sup>72</sup> regardless of their artistic characteristics or merit.

In light of its importance for that critical policy setting of Australian IP law,<sup>73</sup> which dictates that industrial design registration and copyright should in principle not be cumulated (see further below), it is relevant to consider in a little more detail how the overlap issue triggered by the adoption of the indivisibility theory evolved in France. Acceptance of the theory resulted in cumulative protection, with copyright and design regimes operating simultaneously in relation to the same article. The overlap became automatic and France was seen as a pioneer in dual and complete protection.<sup>74</sup> Before the implementation of the *Directive 98/71/EC Of The European Parliament And Of The Council of 13 October 1998 on the legal protection of designs* ('*Directive 98/71/EC*') in French law, the courts tended to consider that the overlap between copyright and design was total and applied art was almost automatically protected both by copyright and design registration.

However, the implementation of the *Directive 98/71/EC* in French law and the interpretation of the new implementing provisions by the *Cour de cassation* have resulted in a shift from complete overlap to partial overlap. Before the harmonisation of design laws in the European Union, the Berne Convention left its member states free to decide whether to protect industrial designs by design registration, to allow both copyright and design protection, or to protect designs by copyright only.<sup>75</sup> EU intellectual property law often tends to become aligned with the highest degree of protection of any member state (see for instance the neighbouring rights directive)<sup>76</sup>

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<sup>71</sup> Cour de cassation [French Court of Cassation], 92-91660, 2 May 1961.

<sup>72</sup> Cour Royale de Bordeaux [Bordeaux Court of Appeal], 21 January 1836.

<sup>73</sup> See further below.

<sup>74</sup> See *Standing Committee On The Law Of Trademarks, Industrial Designs And Geographical Indications*, Ninth Session (11 November to 15 November 2002).

<sup>75</sup> *Berne Convention for the Protection of Literary and Artistic Works* (9 September 1886) art 2 (7) subject to the provisions of art 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.

<sup>76</sup> *Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society* [2001] OJ L

and it is not surprising that the *Directive 98/71/EC* provides that a design registered in or in respect of a member State in accordance with the Directive shall also be eligible for protection under the law of copyright of that State (article 17). In *Flos*,<sup>77</sup> the CJEU held that for member states (in this instance, Italy) to limit copyright protection for designs that had fallen into the public domain, would be inconsistent with the principles established by article 17 of *Directive 98/71/EC* and therefore held that the member states' freedom was limited to the choice between different means of transposing the directive as per section 288 TFUE.<sup>78</sup> This interpretation is unsurprising and follows the *in favorem auctoris* principle laid down in *Infopaq*.<sup>79</sup>

The wording of article 17 provides that a registered design 'shall' also be eligible for copyright protection, which suggests that copyright protection will be automatic if the work meets the criteria for protection by designs law. However, the article further provides that 'the extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State'. This makes it clear that in reality there are two regimes with different and distinct requirements: the member states are free to decide the level of the originality test, and the standard adopted will then determine the level of coincidence between copyright and designs protection.

The *Directive 98/71/EC* was implemented in French law and codified in articles L. 511-1 to L 514-2 of the *Intellectual Property Code*. The overlap of protection is also implicitly codified at L. 513-2 of the Intellectual Property Code. A work of the mind will only be protected in French copyright law, as in Australia, if it is original, which is a subjective criterion that refers to work reflecting the author's personality (in the broad sense explained above),<sup>80</sup> regardless of artistic merit or quality. Article L. 511-2 of the Intellectual Property Code provides that the work must be novel and must have

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167/10; Jean Sylvestre Bergé and Sophie Robin-Olivier, *Droit européen, Union européenne et Conseil de l'Europe* (Thémis de droit, 2<sup>nd</sup> ed, 2011).

<sup>77</sup> (C-168/09) [2011] ECDR 8. The decision has its detractors: see eg Lionel Bently, 'The return of industrial copyright?' [2012] EIPR 654-672.

<sup>78</sup> *Treaty on European Union and the Treaty on the Functioning of the European Union* [2012] OJ L C 326/01.

<sup>79</sup> (C-5/08) [2009] ECR I-6569; Pierre-Yves Gautier, *Propriété littéraire et artistique* (PUF, 8th ed, 2012), 24, 355.

<sup>80</sup> Cour d'appel de Paris [Paris Court of Appeal], 28/1101, 28 November 2001.

individual character. Design protection will be refused if the design has been published before the priority date (*'divulgation'* destroying novelty pursuant to L. 511-6<sup>81</sup>), but the work may still attract copyright protection.

Courts now accept that the requirements for copyright and designs protection are separate and independent. The *Cour de cassation* overturned a lower court decision which had held that copyright protection resulted from compliance with design requirements,<sup>82</sup> and required that the court examine whether the work incorporated an aspect of the author's personality (i.e., novelty and originality should be examined together). The lower court had wrongly decided that in line with the indivisibility of art theory, novelty and individual character requirements are similar to the originality requirement of copyright law, and denying protection for one automatically resulted in denying protection for the other. The *Cour de cassation* has now held that design protection does not create a presumption of originality and recently reaffirmed the autonomous character of the systems.<sup>83</sup> In a decision of 29 March 2017, the *Cour de cassation* also held that the overlap system in France is not total or absolute, but should rather be understood as the possibility of a work of the mind being protected by each of the two systems if the independent and separate requirements of each are met<sup>84</sup>.

The result is that courts separately examine design and copyright protection and interestingly, more strictly assess whether works of the mind are original and therefore deserve copyright protection, which does not automatically result from compliance with the design requirements of novelty and independent character. They refuse to extend copyright to a 'banal' work.<sup>85</sup> Conversely, courts have held that the fact that copyright

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<sup>81</sup> Divulgation should be in the geographical area concerned. However, it was held by the European Union Tribunal in T-651/16 - Crocs / EUIPO - Gifi Diffusion that because the Crocs clogs were put on sale in a large number of American states, « it is thus unlikely, given the importance for the EU market of commercial trends on the US market, that it went unnoticed by the circles specialised in the sector concerned, operating within the European Union ».

<sup>82</sup> Cour de cassation [French Court of Cassation], 09-85695, 5 October 2010.

<sup>83</sup> Cour de cassation [French Court of Cassation], 13-27225, 10 February 2015.

<sup>84</sup> Cour de cassation [French Court of Cassation], 15-10885, 29 March 2017.

<sup>85</sup> Tribunal de grande instance de Paris [Paris Court of First Instance], 08-17024, 10 June 2011 (a handbag not protected by copyright); Tribunal de grande instance de Paris [Paris Court of First Instance], 15/10799, 01 September 2017, regarding Patangas shoes.

protection is denied for lack of originality does not preclude the author from arguing for design infringement.<sup>86</sup>

To take the fashion sphere as an example of ‘applied art’, the notions of ‘arbitrary (in the sense of unrestrained) choices’ and the personality of the author have often been taken into consideration by the judges when examining whether such works are original. For instance, in *SAS The Kooples et a. c/ Sté Gysele*,<sup>87</sup> addressing the question whether garments were protected by copyright, the court found that the personality of the author was expressed because of the arbitrary choices they had made.<sup>88</sup> However, the French Court of Appeal recently found that the garment at issue was not sufficiently original to deserve copyright protection: the mere fact that there were sequins on the front of the garment which distinguished the shirt from other similar shirts available on the market did not suffice to identify the author’s “creative effort”<sup>89</sup>. It is relevant to note that courts tend to look at the work as a whole; originality can result from a combination of banal elements, which, taken together represent the creative effort and intellectual input of the author<sup>90</sup>. The French Supreme Court however recently reiterated that originality must be assessed both in the general appearance of the work and in the elements of which it consists, and overruled a lower court decision which had examined only the work taken as a whole<sup>91</sup>. However, even if the combination of elements is new, i.e. it is not found in any other shoes, the Court may still deny copyright protection, on the grounds that the combination itself is banal<sup>92</sup>.

Therefore, while unity of art and multiplicity of protection have been adopted by French courts, the progressive development of independent criteria for both systems of protection has restricted the scope of copyright, or at least imposed a more careful

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<sup>86</sup> Tribunal de grande instance de Paris [Paris Court of First Instance], 09-18127, 29 March 2011.

<sup>87</sup> Cour d’appel de Paris [Paris Court of Appeal], 11/08502, 28 November 2012; Cour d’appel de Paris [Paris Court of Appeal], 11/06089, 20 February 2013.

<sup>88</sup> Cour d’appel de Paris [Paris Court of Appeal], 11/01692, 23 January 2013, regarding handbags.

<sup>89</sup> Cour d’appel de Paris [Paris Court of Appeal], 17/15470, 4 May 2018 n°17/15470

<sup>90</sup> For instance, regarding the originality of lingerie in Cour d’appel de Paris [Paris Court of Appeal], 07/3611, 21 May 2008. Courts further require that the author not only assert that the work is original but also establish in concreto how that is the case, Cour d’appel de Paris [Paris Court of Appeal], 11/08658, 24 May 2013.

<sup>91</sup> Cour de cassation, civ. 1, [Paris Supreme Court], 17-11.905, 7 March 2018

<sup>92</sup> Tribunal de grande instance de Paris [Paris Court of First Instance], 15/10799, 01 September 2017, regarding Patangas shoes.

examination of whether a work of the mind is original, based on the specific nature or category of that work.<sup>93</sup>

Considering the above reasoning, and with relevance to the debate about copyright protection for 'applied art' in Australia, the French experience shows that as broad as the indivisibility of art theory seems, copyright law requirements generally and the test of originality in particular suffice to prevent unwarranted overprotection. They also serve to draw a dividing line between the two independent and distinct regimes of copyright and designs, their conditions and enforcement. Applying the originality requirement as now established in Australia post-*IceTV* would allow, as is already the case in France and most European Union countries, to discriminate between works deserving copyright protection, whether a fashion garment, a chair or a painting, and others.

Our account of the French approach also illustrates that despite globalisation, arbitrary distinctions between artists from different countries and between categories of art persist. Nonetheless they make little sense philosophically, socially or economically; they are not based on a notion of 'art' with universal resonance or modern conceptual flexibility. They counter international efforts at harmonisation of copyright law,<sup>94</sup> as the Commonwealth Attorney-General tacitly acknowledged when he stated that Australia should pay '*careful regard to the broad international legal and economic context*' to ensure that Australia's law will '*operate efficiently within a global copyright system*'.<sup>95</sup> An additional argument in favour of adopting an 'indivisibility of art' approach here coupled with a proper post-*IceTV* application of a higher originality standard, is therefore the importance of international harmonisation to the copyright industries of all countries.

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<sup>93</sup> In the fashion area, see Cour de cassation [French Court of Cassation], 12-18518, 20 March 2014 reported in (2014) Bull civ n° 54, 53.

<sup>94</sup> From the Berne Convention, to the WIPO agreements concerning copyright, to the WTO TRIPS provisions.

<sup>95</sup> Senator George Brandis, in a speech delivered at the Opening of the Australian Digital Alliance Fair Use for the Future, Canberra, *A Practical Look at Copyright Reform Forum* (14 February 2014) <<http://www.attorneygeneral.gov.au/Speeches/Pages/2014/First%20Quarter%202014/14February2014-openingoftheAustralianDigitalAllianceForum.aspx>>.

## COPYRIGHT AND DESIGNS

Our approach to the definition of art undoubtedly results in a more liberal application of copyright to works of the mind than Australian law has adopted to date. In that context, we need to review the argument that a restrictive approach to copyright protection is justified by a policy choice favouring *design registration* for art applied to useful articles. This approach holds that there are two distinct realms: the realm of artistic practice, the art world; and the realm of commerce and manufacturing, the industrial design world.<sup>96</sup>

From this perspective, that copyright is unavailable for some forms of applied art is beneficial because designs registration is the more appropriate and effective alternative<sup>97</sup>. As it is adapted to practical objects that are sold through commercial channels, a registration model results in more efficient ordering of rights. Design rights are readily ascertainable in terms of scope and ownership. A manufacturer who adopts a design and invests in manufacture can rely on the IP Register and would be exposed to too much risk if unrecorded copyright lurked. Further, the duration of design protection (5 years renewable once) is shorter than the life of the author plus 70 years of copyright, and is arguably better adapted to a world of commercial competition and incremental design innovation. That is particularly the case where mass manufacturing is concerned, with its inherent risk and substantial upfront investment. The absence of registration in Australia (and France) also means that a work is deemed to be protected by copyright from creation: there is no *a priori* or independent examination of the originality of the work unless and until a conflict arises.

However, the real question is whether the author or maker should be *forced into* one or another regime. This is a question of alternative versus cumulative protection, the French and European approaches favouring the latter and the common law traditionally (but after *Flos* no longer in the UK)<sup>98</sup> the former.

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<sup>96</sup> Bridging this gulf is the calling of the arts and crafts movement, which intended to humanise the environment of manufacturing by engagement with craft skill and the pursuit of beauty in all things; see William Morris, *The Collected Works of William Morris* (Adamant Media Corporation, 1914), vol 22.

<sup>97</sup> For a broad overview of the complex copyright-designs relationship see Christopher Heath 'The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or Under Unfair Competition' in C Heath & A Kamperman Sanders (eds) *New Frontiers in IP Law: IP and Culture Heritage* (Hart, 2005).

<sup>98</sup> *Flos SpA v Semeraro Casa e Famiglia SpA* (C-168/09) [2011] ECDR 8.

A major problem with the Australian approach is that although on one view advantageous in theory, it becomes largely unworkable and absurd in its practical application.<sup>99</sup> The inevitably technical, obtuse and legalistic rules are counterproductive in terms of giving protection to works of the mind where it is due, and that for minimal policy benefit.<sup>100</sup> The same can probably be said of the American approach which requires ‘separation’ of artistic and non-artistic expression in a single article, often regarded as one of the most abstract and obscure nooks of copyright law.<sup>101</sup>

Here we illustrate the complexities that result from compelling reliance on designs registration by reference to the specifics of the Australian statutory approach. The Copyright Act (sections 74-77A) restricts access to copyright remedies in certain circumstances. After the 1995 Report of the Australian Law Reform Commission, which reviewed the Designs Act to modernise and simplify it and to address overlap issues, the *Design Act 2003* (Cth) was enacted and the Copyright Act consequentially amended. The relevant sections taken together lead to the following conclusions: a copyright owner who registers the three-dimensional shape of a product as a design corresponding to an artistic work will be prevented from enforcing their copyright against infringers but may rely on the design registration; a copyright owner who registers a product which reproduces a two dimensional artistic work on its surface will be able to rely both on copyright protection in the artistic work and design registration of the product; and a copyright owner who does not register their design but mass manufactures an article will be unable to rely on copyright in an underlying artistic work if the article is a three-dimensional reproduction of the artistic work.

However, if the underlying work is classified as a work of artistic craftsmanship, then the copyright owner can rely on copyright even if the article is mass produced. To be clear, if an artistic work in two dimensions is reproduced on the surface of an article,

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<sup>99</sup> See e.g., *Muscat v Le* (2003) 60 IPR 276 and the subsequent amendments. See also *Burge v Swarbrick* (2007) 232 CLR 33.

<sup>100</sup> Particularly in the context of a generally failing designs registration system: numbers of designs registrations in Australia have been stagnant. Use by Australian companies is largely static (in the context of a strong rise in use by overseas companies), and use by Australian individuals have undergone a steep decline, see Australian Government Advisory Council on Intellectual Property, *Review of the Designs System Final Report* (March 2015) <[https://www.ipaustralia.gov.au/sites/g/files/net856/f/acip\\_designs\\_final\\_report.pdf](https://www.ipaustralia.gov.au/sites/g/files/net856/f/acip_designs_final_report.pdf)>.

<sup>101</sup> See most recently, *Star Athletica, L.L.C. v Varsity Brands, Inc.*, 85 US 4139 (2017).

then the copyright owner can continue to rely on copyright in that work, even if the corresponding article is design registered or mass manufactured.<sup>102</sup>

Arguably therefore, an artist cannot fully exploit their interest in their own work because 'if they do, they run the risk of having their work freely copied and reproduced by others.'<sup>103</sup> This goes against the aim of the Copyright Act to protect creators and encourage creation. In our view this is one of those situations where apparent policy logic is impossible to implement without excessive cost, complexity, and perverse effects. Therefore, whether it is worth pursuing should be subject to very careful evaluation<sup>104</sup>. It might be much better to suffer what small detriments could result from *not* implementing the detailed overlap provisions; the detriment in this case simply being that in some limited circumstances, an applicant could call on copyright in the context of mass manufacturing.

Further we suggest that apart from their excessive complexity and their deleterious effect in certain sectors (such as fashion, to which the designs regime is ill-suited) the overlap provisions should be abandoned for a number of other reasons: in line with our analysis above, they rest on a misconception about what is art; other jurisdictions function perfectly well without them, as we have illustrated with our analysis of French law; and the post-*IceTV* standard of originality will prevent over-reliance on copyright. We pursue these issues further below.<sup>105</sup>

## WORKS OF ARTISTIC CRAFTSMANSHIP AND ORIGINALITY

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<sup>102</sup> Warwick A Rothnie, 'The Vexed Problem of Copyright/Design Overlap' [2005] (60) *Intellectual Property Forum* 33.

<sup>103</sup> Arts Law Centre of Australia, *Submission to response to the Advisory Council on Intellectual Property's (ACIP) Review of the Designs System Options Paper* (22 January 2015).

<sup>104</sup> Although the overlap provisions pursue the longstanding policy goal of limiting copyright protection in the industrial sphere (as considered in *Lucas Films v Ainsworth* [2011] UKSC 39), the real question is whether the complex provisions are an optimal way of obtaining this goal, and also as we state elsewhere, whether a new and higher standard of originality after *IceTV* already achieves that goal to a sufficient extent.

<sup>105</sup> Resting as it does on a distinction between fine and applied art, the overlap exclusion policy draws on a traditional and dated conception of art. The distinction is absurd considering the use of utilitarian objects by many contemporary artists (from Duchamp to Damien Hirst and David Jablonowski) and the fact that copyright protects neither style nor idea (for instance the idea of bringing a utilitarian object into the artworld). It is also not applied with any kind of consistency – for instance copyright applies to computer software, or plans and drawings for buildings, although they are also useful things.

In Australia, an inordinate focus has come to fall on 'works of artistic craftsmanship' because such works do not lose the benefit of copyright protection when mass produced. The intension of their first inclusion, very influenced by the Arts and Crafts movement led by William Morris, in the Copyright Act 1911 (UK), was identified by Lord Simon in the seminal case of *Hensher*.<sup>106</sup> Basically it was to ensure that practical works could also gain copyright protection under certain circumstances. Two elements were thought to be required: an element of craft skill in the making; and the expression of an artistic idea by way of such craft skill, without working to, or copying a pre-existing plan or drawing. The category has bedevilled common law courts ever since, and there have been considerable judicial fluctuations, resulting most recently in Australia in the indeterminate fact-driven approach adopted in *Burge*, essentially at odds with the leading English case of *Hensher* and some earlier Australian cases such as *Cuisenaire v Reed* (which itself was not followed in *Coogi v Hysport* on the point of 'unity of craft and concept').<sup>107</sup>

But as a condition of acquiring copyright status, the law requires that such works have 'artistic quality', a standard not applied to any other category of artistic work. In other words, a useful article cannot benefit from copyright protection, unless it has some artistic merit as ultimately determined by a judge of the court. In *Burge*, the Australian High Court illustrates the unsatisfactory practical application of the 'artistic quality' test. Because of the overlap provisions, a yacht designer was left without recourse against free-riders who deliberately copied his design without authority. Copyright protection was denied because the handcrafted full-scale model (referred to as "the Plug") of the hull and deck sections of the yacht was not considered a work of artistic craftsmanship. The Court held that whether something is a work of artistic craftsmanship 'turns on

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<sup>106</sup> '[T]he artistic works given protection were works of fine art. This accorded with the almost universal concept current in 1862: a work of art was a product of the fine arts, and primarily an easel painting. But almost from the moment of the *Fine Arts Copyright Act 1862* (UK) 25 & 26 Vict, c 68, there was a reaction which came to be known as the Arts and Crafts movement'. The essence of the arts and crafts 'ideology was that art did not mean merely, or even primarily, the fine arts': *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1976] AC 64, [1975] RPC 31, 89 (Lord Simon says the 'significant feature' of the law before 1911 was that the artistic works given copyright protection were works of fine art), see [1975] RPC 31, 90.

<sup>107</sup> *Burge v Swarbrick* (2007) 232 CLR 336; *Cuisenaire v Reed* [1963] VicRp 96; [1963] VR 719; *Coogi Australia Pty Ltd v Hysport International Pty Ltd* [1998] FCA 1059; 86 FCR 154; 157 ALR 247; (1998) AIPC 37,695; 41 IPR 593; and see also R. G. Kenny, 'Artistic Craftsmanship: The Copyright Act 1968' (1983-1984) *The University of Queensland Law Journal* Vol. 13, No.2, 206 (this article predates *Coogi*).

assessing the extent to which the particular work's artistic expression, in its form, is unconstrained by functional considerations'.<sup>108</sup> That, of course, is rather unsatisfactory as the *extent* to which the article's shape should be uncontrolled by its function is not clear. It also ignored the constraining effect of the requirement of originality, which is as much required for works of artistic craftsmanship as for any other Part III work. Admittedly, however, the standard of originality in Australia at that time was markedly lower than post-*IceTV*, and in its contemporaneous guise would have had little limiting impact.

The Court held in *Burge* that : *'[T]aken as a whole and considered objectively, the evidence, at best, shows that matters of visual and aesthetic appeal were but one of a range of considerations in the design of the Plug. Matters of visual and aesthetic appeal necessarily were subordinated to achievement of the purely functional aspects required for a successfully marketed "sports boat" and thus for the commercial objective in view.'*<sup>109</sup> In our view, the same standard should now be applied to all articles, whether functional or not: firstly is the article concerned 'art', in the broader, liberal and more conceptual sense we advocated for above; and secondly, whether the design reflects a visual concept or idea unique to the author and not exclusively determined by function<sup>110</sup>. We argue that this standard is universally applicable but should be formulated more radically: that if the form of expression is no more than the three-dimensional realisation of a technical concept or idea, it should not be protected by copyright. If the visual idea or concept in the mind of the author is not exclusively determined by function, copyright should vest if the expression is original. One implication of this view is that such things as engineering drawings whose composition

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<sup>108</sup> *Burge v Swarbrick* (2007) 232 CLR 336, 364 [83]. Relevantly, the Examiners Manual, also states that in relation to whether the work is a work of artistic craftsmanship for the purpose of section 18, 'the determination turns on assessing the extent to which the particular work's artistic expression, in its form, is unconstrained by functional considerations': see <[http://manuals.ipaustralia.gov.au/designs/examination/7\\_prior\\_art\\_base/d07.6\\_copyright\\_overlap\\_-\\_s.19.htm](http://manuals.ipaustralia.gov.au/designs/examination/7_prior_art_base/d07.6_copyright_overlap_-_s.19.htm)>. This results directly from what the High Court held in *Burge*.

<sup>109</sup> *Burge v Swarbrick* (2007) 232 CLR 336, 362 [73].

<sup>110</sup> There is of course some difficulty of degree in determining whether appearance is determined entirely by function or not – but the difficulty of the judgment does not sufficient undermine its principled adoption. The question arises also in the context of registered designs law, where courts have considered whether a design whose appearance is exclusively determined by function can in fact be considered a design at all in the statutory sense, and also in the context of registered trademarks: see Greenwood, Justice Andrew --- "Legal protection for product design" (FCA) [2009] FedJSchol 1.

is purely determined by technical requirements are not art in our sense.<sup>111</sup> In *CIPEC*,<sup>112</sup> and *Hart*,<sup>113</sup> technical drawings were held to be protected by copyright, but arguably these were works whose form was the result of the expression of a technical and not a visual concept and therefore properly outside the realm of copyright.

As to whether the work is 'art', additionally relevant is whether a work would be observed and appreciated by consumers as such: do they perceive it as something that has a certain shape only for the purpose of utility, or (also) to be *appreciated in observation*; consumed by viewing rather than only by use?<sup>114</sup>

In other words, the combination of the normal requirements of 'art' and of originality, as it now is interpreted post-*IceTV*, will have the desired triage effect in relation to products that have a functional use. It will prevent unwarranted overprotection, as experience in other jurisdictions (in particular our benchmark jurisdiction of France) suggests.

In the final analysis an artistic work concerns the mediation of a particular authorial concept or idea through its expression in a particular visual form. Nothing else is required, other than that it be original to the author, and expressed in material form by her.

## ART AND ORIGINALITY

As we have previously mentioned, with the *IceTV* decision, Australian copyright law now has adequate tools to prevent overprotection of works and a flood of speculative litigation. There are some difficulties with determining the exact test of originality *IceTV* stands for given the plurality of reasons proffered by the judges of the High Court.

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<sup>111</sup> See *Compagnie Industrielle de Précontrainte et D'Équipement des Constructions SA v First Melbourne Securities Pty Ltd* (1999) 44 IPR 512: designs is the appropriate regime – see further below.

<sup>112</sup> *Ibid.*

<sup>113</sup> *SW Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466.

<sup>114</sup> *Coogi Australia Pty Ltd v Hysport International Pty Ltd* (1998) 86 FCR 154; (1998) 41 IPR 593 it was held that the work, although created through a writing a computer program was a work of artistic craftsmanship for the purposes of copyright Act. Previous cases concerned sporting helmets, catamaran moulds, and also a bolt of fabric (of obvious relevance to the fashion world): *Coogi* for instance refers to certain elements or criteria to determine whether the work is of artistic craftsmanship by reference to *Hensher*.

Nonetheless, in our view it cannot be controverted that the decision confirms the centrality of individual human authorship in copyright law. As Alexandra George says: “[...]the High Court judgment of French CJ, Crennan and Kiefel JJ, [...] cautioned that the importance of the authorship requirement should not be underestimated because [t]he “author” of a literary work and the concept of “authorship” are central to the statutory protection given by copyright legislation”<sup>115</sup>. She points out that ‘heightened attention to the role of the author’ can also be traced in the separate reasons of Gummow, Hayne and Heydon JJ. This attention is at odds with the previous ‘sweat of the brow’ doctrine and results in a threshold test requiring an analysis of the creative process, which works hand in hand with contemporary notions of ‘art’ which place communication and reception of the artistic intent of an individual author front and centre. This approach requires a far more careful consideration of the originality issue in contemporary cases concerning useful articles. Lindsay has argued that the impact of *IceTV* is far greater than has hitherto been realised, and we tend to agree.<sup>116</sup> *IceTV* compiled electronic TV program schedules and included some of Nine’s information while being neither licenced nor authorised to do so. The question for the court was whether a substantial part of the Nine’s guide had been reproduced, because the subsistence of copyright in the broadcast schedules was agreed by the parties. The Court examined the notion of originality as being the measure of what is a ‘substantial part’ of a work in the infringement context. While the case did not concern applied art, the judges’ observation that the concept of authorship is ‘central to the statutory protection given by copyright legislation’ is of universal application to all copyright works. They stressed that the requirement of originality demands proof of some independent intellectual effort by the identifiable author(s).<sup>117</sup> French J distinguished between labour and creativity,<sup>118</sup> and concluded that despite the labour and skill brought to bear by the putative ‘author(s)’, authorial creativity must find expression in the particular form of the work. The ‘original effort of a single human author is a fundamental requirement of copyright law’ and drew a correlation between authorship

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<sup>115</sup> George, Alexandra, "Reforming Australia's Copyright Law: An Opportunity to Address the Issues of Authorship and Originality" [2014] UNSWLAWJL 34; (2014) 37(3) UNSW Law Journal 939.

<sup>116</sup> David Lindsay, 'Protection of Compilations and Databases after *IceTV*: Authorship, Originality and the Transformation of Australian Copyright Law' (2012) 38(1) *Monash University Law Review* 17, 194.

<sup>117</sup> *IceTV Pty Ltd v Nine Network Australia Pty Ltd* (2009) 239 CLR 458, 470 [22], [33].

<sup>118</sup> *Ibid*, 478 [47]-[48].

(identification of the author,<sup>119</sup> and their 'independent intellectual effort')<sup>120</sup> and originality.<sup>121</sup> Skill and labour alone are not sufficient as creative effort directed to devising a particular form of expression is required. While this higher threshold of originality has now been applied in some subsequent cases<sup>122</sup> there is considerable uncertainty as to what it means for subject matter such as compilations, works of joint authorship or computer-generated works. Lindsay (and others) have carefully examined the considerable impact of *IceTV* in relation to compilations and databases, where it arguably has very significant impact; but its impact is potentially broader.<sup>123</sup>

Thus we argue that the standard of originality as elevated by *IceTV* is an effective triage tool that fits hand in glove with the question whether a work is 'art'. While the correlation between originality and authorship is criticised by some authors as being against the English common law tradition which 'has always recognised the merits of protecting the labour and resources expended in producing 'low authorship' informational works',<sup>124</sup> in reality the notions of "author" and "originality" have correlated since at least 1911.<sup>125</sup> For instance, in *University of London Press* originality was held to mean, 'that the work should originate from the author'.<sup>126</sup> Focusing on the effort of the author does not in truth undermine an established common law system and is in line with the purpose of encouraging authorial creation, just as the High Court accepted in *Burge*. Focusing on the author is also in line with the implementation of

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<sup>119</sup> Ibid, 474 [32].

<sup>120</sup> Ibid, 474 [33].

<sup>121</sup> Ibid, 479 [48].

<sup>122</sup> For more detail see George, Alexandra --- "Reforming Australia's Copyright Law: An Opportunity to Address the Issues of Authorship and Originality" [2014] UNSWLawJI 34; (2014) 37(3) UNSW Law Journal 939; note also *Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd* [2011] FCA 362, albeit reaching a different conclusion on the facts, *Tonnex International Pty Ltd v Dynamic Supplies Pty Ltd* [2012] FCAFC 162.

<sup>123</sup> David Lindsay 'Protection of Compilations and Databases after *IceTV*: Authorship, Originality and the Transformation of Australian Copyright Law' (2012) 38(1) *Monash University Law Review* 17; Jani McCutcheon, 'The vanishing author in computer-generated works: A critical analysis of recent Australian case law' (2013) 36(3) *Melbourne University Law Review* 915.

<sup>124</sup> David Lindsay 'Protection of Compilations and Databases after *IceTV*: Authorship, Originality and the Transformation of Australian Copyright Law' (2012) 38(1) *Monash University Law Review* 17, 194.

<sup>125</sup> Justine Pila, 'Copyright and Its Categories of Original Works' (2010) 30(2) *Oxford Journal of Legal Studies* 229.

<sup>126</sup> *University of London Press v University Tutorial* [1916] 2 Ch 601, 608-609.

moral rights in Australia since 2000, which enhances the importance of the personal relationship between the author and their work.<sup>127</sup>

Further, this jurisprudential trend appears in line with the solution adopted in most other jurisdictions, for instance with the concept adopted by the CJEU in *Infopaq*.<sup>128</sup> The CJEU handed down a uniform interpretation of originality to apply throughout the European Community, adopting the *in favorem auctoris* principle.<sup>129</sup> The court held that originality refers to the author's own intellectual creation and should be examined having regard to the specific nature of the work. The Court noted that compilations consist of words or other elements which, considered in isolation, are not an intellectual creation of the author who employs them: '*It is only through the choice, sequence and combination of [...] words that the author may express his creativity in an original manner and achieve a result which is an intellectual creation*'. This independent concept of originality was confirmed and clarified in subsequent cases, including in *Eva Maria Painer*, regarding portrait photographs, where the court held that a work will be original if it is the author's own intellectual creation reflecting their personality.<sup>130</sup> That is the case if the author was able to express their creative abilities in the production of the work by making free and creative choices.<sup>131</sup> Creative choices are found not to have been exercised in sports '*which are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright*' by the CJEU.<sup>132</sup>

We illustrate the effectiveness of the originality requirement as a triage tool in the sphere of practicality with a few examples. The French courts thus rejected copyright

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<sup>127</sup> While the use of the moral right provisions in Australian courts is slow, there have been some significant decisions in the last few years: e.g. *Fernandez v Perez* [2012] NSWSC 1242; *Corby v Allen & Unwin Pty Limited* [2013] FCA 370.

<sup>128</sup> *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) [2009] ECR I-6569; also in harmony with the US approach: as expressed by the Supreme Court in *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

<sup>129</sup> Pierre-Yves Gautier, *Propriété littéraire et artistique* (PUF, 8th ed, 2012), 24.

<sup>130</sup> *Eva-Maria Painer v Standard-Verlag GmbH* (C-145/10) [2013].

<sup>131</sup> *Ibid*, 89.

<sup>132</sup> *Ibid*, 98. In France, the system is more in favour of the author as the Cour de cassation recognised a presumption of authorship (Cour de cassation [French Court of Cassation], 91-16543, 24 March 1993 reported in (1993) Bull civ n° 136, 84. which is conditioned (See Violet Atkinson, Viviane Azard, Marie Malaurie-Vignal and William van Caenegem, 'Comparative study of fashion and IP: Copyright and designs in France, Europe and Australia' (2016) 11(7) *Journal of Intellectual Property Law and Practice* 516) but sometimes argued and accepted (Cour d'appel de Paris [Paris Court of Appeal], 08/04978, 27 January 2010). While this may be relevant in the French context, this solution does not seem appropriate to Australia.

protection for a contributor of a television show despite the fact that he decided on decoration, framing, and imagery, because of insufficient original and creative effort on his part.<sup>133</sup> Similarly, and despite the sui generis protection available to software programs, the French *Cour de cassation* overturned a lower court decision that some software was protected by copyright because it provided a technical solution for the management of bailiff customer data and practices without researching whether the work was the result of an intellectual and personal effort from the creator of the software.<sup>134</sup> Regarding a coffee pods displayer, the court held that while its functional character cannot in itself deny copyright protection to the work, there was no evidence of authorial intellectual input or creative effort or the ability to make arbitrary choices: the combination of elements which all belong to common knowledge did not in itself amount to authorial input or creativity. The cases mentioned above indicate again that the originality test will more often result in the *denial of protection for technical creations of the mind*. At the same time, the strict examination of whether a work is original will obviate the need for any assessment whether the work has ‘artistic quality’, as is required for works of artistic craftsmanship in Australia.

The application of a higher originality requirement as adopted in *IceTV* and in line with most other jurisdictions to works of ‘applied art’ appears an appropriate limiting tool<sup>135</sup>. Against the apparent Australian fear of expanding the scope of copyright, denying access to legitimate users and the concern to maintain ‘a robust public domain in which further works are produced’,<sup>136</sup> we argue that logically and demonstrably the originality test is sufficient. Australian Courts have already shown, notably in the second *White Pages case*,<sup>137</sup> that they will not hesitate to deny copyright to works that do not reflect the personality of the author, or their creative effort. The application of the elevated

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<sup>133</sup> Cour de cassation [French Court of Cassation], 87-14895, 29 March 1989.

<sup>134</sup> Cour de cassation [French Court of Cassation], 11-21641, 17 October 2012.

<sup>135</sup> In the US also the standard of originality is more elevated than in the traditional common law. In *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) the United States Supreme Court held that evidence of labour or ‘sweat of the brow’ in compiling information was insufficient for a work to be protected by copyright and required that some creative effort or ‘creative spark’ was necessary. To a lesser degree in Canada, it was held in *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339, [1] 2004 SCC 13 that labour was insufficient and skill and judgment must show that the creation was not purely mechanical.

<sup>136</sup> Australian Government, *Intellectual Property Arrangements* 23 September 2016 <<https://www.pc.gov.au/inquiries/completed/intellectual-property/report>> (the latest Australian report mostly focused on users rights).

<sup>137</sup> *Telstra Corporation Limited v Phone Directories Company Pty Ltd* (2014) 107 IPR 333.

originality requirement will vary with the nature of the work, and the fact that the work is a fashion garment or a painting should be relevant in that regard only.

## CONCLUSION

The decision in *IceTV* marks a significant departure from the traditional approach to originality in copyright law in the common law tradition generally and in Australia in particular. However, in the manner in which it emphasises human authorship as correlative with originality, it is in line with well-established jurisprudence in other jurisdictions, notably France. The required focus is now on evidence of a creative process in the mind of an individual author. The full implications of this new judicial standard are still to be worked through, almost 10 years after, but in the context of artistic works, the change undermines the case for the traditional dualist approach to fine art and applied art, and for the restrictions on overlapping copyright and designs protection. This is because if the originality test in its new guise is properly applied, the effect will be that purely functional items should be denied copyright protection. There is no longer any need to deal with them as falling into a separate category of 'works of artistic craftsmanship' to which an uncertain standard of artistic quality (in effect aesthetics) is then applied. The risk of over-protection and speculative claiming will be avoided. It also enables the adoption of a more flexible approach to the protection of 'art' in the light of greater conceptual modernity and multifaceted globally integrated artistic practice. This is because the emphasis shifts to the author's notion of what is art and artistic expression, rather than some supposedly objective but in reality controversial standard concerning artistic technique or aesthetics. Contemporary art practice has long abandoned such standards to recognise a far wider field of expression as genuinely 'artistic'.