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Originality, joint authorship and databases post-*IceTV*

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Copyright in compilations produced by corporate employees is now more difficult to obtain.

Introduction

In *IceTV* the High Court effectively substituted the “intellectual activity” test for the old “sweat of the brow” approach to originality, abandoning the “industrious collection” test for compilation copyright.² The Court also recast the requirements for subsistence of copyright in a work of joint authorship.

It will take some time for the decision’s implications for the full range of copyright materials to become apparent. For instance, the courts have yet to consider in depth its effect on copyright subsistence in design drawings and articles.³

But its impact in the area of databases and computer generated material has already been felt. Some years prior to *IceTV*, the Full Court in *Desktop Marketing* had held that copyright subsists in white pages of a telephone directory.⁴ However, post-*IceTV* the Federal Court reversed that finding in *Phone Directories*.⁵

Take away tips for lawyers

- Before *IceTV* the sweat of the brow/industrious collection approach to originality in copyright predominated in Australia.
- But in *IceTV* the High Court confirmed that copyright is an author’s right and not an investor’s right.⁶
- Since *IceTV* the intellectual activity test is applied. The particular work in which copyright is claimed must reflect some intellectual activity of an individual author.
- This change has made it more difficult for companies to rely on copyright in the broad realm of database protection.⁷
- The post-*IceTV* approach to works of joint authorship has also made it difficult to obtain copyright where employees have separately contributed to producing material, rather than closely collaborating on creating a particular work.

- For these reasons there have been calls to introduce statutory rights in non-original databases, perhaps along European lines. It is worth noting, however, that that system has received very mixed reviews.

Phone Directories

The trial Court applied the higher *IceTV* standard of originality.⁸ Effort and investment in collecting data, or setting up and operating a computer system that produces a directory on command was not sufficient in itself. Proof was required that human intellectual activity was involved in creating the particular directory in which copyright was claimed to subsist. The Full Court confirmed that where a computer system generates the final product from stored data without further human intervention, the requisite authorial intellectual activity in expressing the work in a particular form is absent.

Keane CJ in his judgment also agreed with the trial judge concerning joint authorship, saying that the contributions made by various individuals were precursors to, rather than the actual making of the compilation itself. Although the work of these individuals was organized to facilitate production of the directory, it did not amount to collaboration in the statutory sense, as the contribution of each was made quite separately.⁹ The implications for databases are considerable, since they are commonly made by numerous employees fulfilling distinct and separate tasks.

The statutory definition of a work of joint authorship is “a work that has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of the other authors”.¹⁰ Jonathan Parker LJ in the Court of Appeal of England and Wales defined collaboration as “joint labouring in furtherance of a common design”.¹¹ Considering *Olympic Amusements*,¹² where copyright was held to subsist in prize scales, Bennett J in *Fairfax* dismissed any suggestion that there may be joint authorship even though contributions are separate. Her Honour stressed

that the Full Court had found that the prize scales resulted from the “joint efforts” of the mathematicians and employees involved. *Milwell* was not authority “for the proposition that there can be joint authorship when the contributions of the joint authors are separate and distinct and not the result of collaboration.”¹³

Acohs

Thus there will be no copyright unless the creators engage in combined intellectual activity to create a particular work. Performing separate preparatory tasks in accordance with an organized plan ultimately to produce a work is not collaboration. The effect of this approach is quite restrictive and is further illustrated by *Acohs*.¹⁴ In this case Jessup J dismissed the idea that those who wrote the program code and the authors and transcribers who used it to produce a particular Materials Safety Data Sheet (MSDS) for a client firm were joint authors.

Acohs’ counsel pressed the point that: “a work of joint authorship might well be created by two or more people, each of whom contributed a particular component of the ultimate work, and none of whom need have any appreciation — or even awareness — of the detailed contributions of his or her fellows.”¹⁵ However, his Honour considered it too artificial to say that the programmers collaborated with the authors/transcribers in the writing of the material Ucorp was said to have copied. They made their contributions quite separately. Once they had written the source code which could be used to generate a particular MSDS, they made no further contribution to its particular form and content: “In no realistic sense did the programmers collaborate with every author and transcriber whose efforts directly led to the creation or transcription of an MSDS”.¹⁶ The authors also did not know or understand anything of what the programmers did to produce the operative source code.

Tonnex

Contrast *Acohs* with *Tonnex*, where although all the contents derived from the claimant’s database, the fact that an identified human author could be shown to have compiled it in a particular form in which copyright was claimed meant that copyright was found to subsist.¹⁷ Dynamic collected information concerning all the products it supplied (mostly consumables for use in printers of various brands) in a database or computer system known as the “Navision system”. For each product this system maintained an “item card” which contained fields of information concerning each product, continuously updated and maintained. The information for each

data card had to be entered manually rather than pasted in, and was sourced from many sources including manufacturers but also by Google searching for the required data.

Dynamic then conceived of the idea of having “searchable compatibility information in a simple form” on its website.¹⁸ A named employee, Mr Campbell created a compatibility chart, which had columns with particular information fields concerning such aspects as product code; manufacturer; product description; printer model etc. A website visitor could search this table, for instance by manufacturer (brand) so that information “would be filtered to produce only results for the selected [manufacturer]”.¹⁹ Mr Campbell decided which information from the Navision database would be excluded from or included in the chart, ie the information that he considered core to customer needs.

This chart was uploaded to the Dynamic website as a CSV file representing nine columns containing certain information (vendor code, vendor information, product, product models etc respectively). A CSV file is a simple text format in which each value is separated by a comma; in effect it represents a rough presentation of information which can then be “accessed in its entirety or searched to obtain specific information within the file”.²⁰

The critical distinction between *Tonnex* and *Acohs* is that the information was expressed by Mr Campbell in a complete and fixed table which was stored as such, even though in a relatively rough form. That the table could be retrieved and presented in a more user-friendly format, for instance by the application of the Microsoft Excel program, did not detract from the fact that it existed as such. In fact Mr Campbell saved the text file as an Excel file and as a CSV file before uploading the particular CSV file to the Dynamic website.²¹

The information in the CSV file came from a single source, the Navision database, but according to the Court “sufficient skill and judgment — intellectual effort — was brought to bear by Mr Campbell in making the selections he did”.²² The information in the CSV file was “a collection of information brought together in a particular convenient arrangement [...] that was designed to facilitate the searching and cross-referencing of information relating to a particular universe of products (namely, printer and computer consumable supplied by Dynamic)”.²³

Concluding in *Ladbroke* terms, the court said that “Whilst negligible skill and labour will not suffice to sustain a claim of originality, I am satisfied in the present case that, cumulatively, the skill and labour employed by Mr Campbell in creating the compatibility chart in the form of the March 2008 CSV file was more than negligible and that that work was, accordingly, an

original literary work for copyright purposes”.²⁴ The court also pointed out that there was “nothing in the product descriptions or compatibility information that required that information to be expressed in the particular form in which it was expressed [...]. Fact and expression were not coextensive”.²⁵ This distinguished this case also from *IceTV* where the program time and title information “given the context in which [it] was to be expressed” could only be expressed in a limited form — fact and expression were co-extensive.²⁶

Thus Mr Campbell had made sufficient intellectual judgments, choices and selections to give rise to an original work, even though all his source material came from the single database source (the Navision system). The CSV file was the relevant work, it was in a fixed pre-existing form which resulted from human intellectual activity.

In terms of the question of joint authorship *Tonnex* was distinguishable from *Phone Directories*. The Court found on the facts that although some other named employees were involved with inputting material into the underlying Navision database, Mr Campbell was the sole author of the compatibility chart. The creation of the underlying database was rather analogous to what happened in *Phone Directories*, as this quote illustrates: “Insofar as the changes to the database were concerned, each person making a change was carrying out his or her own separate work in that regard, albeit sometimes in accordance with conventions he or she was instructed to observe, against the background knowledge that some of this information would likely be used in the compatibility chart that Mr Campbell was compiling. But none was an author of the compatibility chart or, more specifically, of the March 2008 CSV file, which was created solely by Mr Campbell”.²⁷

In the final analysis *Tonnex* was thus not a case of anonymous backroom workers inputting material into a computer system which then upon command disgorged a document without any further intellectual activity from a human author. Rather, an identified person selected and used information from a database to author a particular literary work which was stored as such, and could then be accessed and read by means of a computer program. The chart as a CSV file could also be “read” without being transmogrified by a computer program such as Excel. *Tonnex* illustrates the importance of a careful choice of the material in which copyright is claimed to vest.

The separate contribution approach

The point made in *Phone Directories* that no joint copyright vests where a number of people have separately made or added a contribution is also illustrated by *Primary Healthcare*.²⁸ In this case patient notes devel-

oped over time by consecutive GP’s adding clinical information to an initial document did not amount to a work of joint authorship, and thus no copyright vested at all in something that in other respects was a literary work.

This illustrates an unusual result of the present approach concerning works of joint authorship: where one person expresses information in documentary form (the initial GP’s notes), there may well be, in the result, a literary work in which copyright subsists; but if others add to that work separately at a later time, the thus transformed work may fail to attract copyright at all, because since there is no collaboration and only separate contributions, no work of joint authorship results!

Naturally that is only the case if the later contribution is of authorial quality. Take the example of what is sometimes referred to as a collective novel: one author writes the first chapter, another quite independently the next and so on. On the present approach the result would arguably not benefit from copyright, since it would have to be considered as a work of joint authorship, but each chapter represents a separate contribution. Each individual chapter would attract copyright vesting in its own author, but the end result, although a seamless work, would not.

A further difficulty is caused by the differential quality of contributions. If the contributions have the quality of authorship, ie result from sufficient intellectual activity, there may be joint-authorship. However, if the contribution is made separately, this will then mean there is no copyright since no work of joint authorship can result from separate contributions.

So, for instance, if two contributions reach the standard of authorship, but are separately made, copyright will not vest. But on the other hand, if only one of the separate contributions reaches the standard of authorship, and all the rest are too minor or technical, then there is no problem and copyright will subsist in the totality!

An alternative approach?

An alternative approach is to examine the claimed copyright work itself and ask whether the part of a joint work emanating from a particular author can be identified and functionally separated from the rest. A distinction which implicitly recognizes this approach is often made in the textbooks between works of joint authorship and collective works, such as for instance an opera or song.²⁹ In the latter the reason that there is no work of joint authorship is that the lyrics and the score are separable and independent works.

As to this view it is interesting to note what was said by the lower court in *Beckingham*,³⁰ an English musical copyright case: “Finally there is the negative requirement: non-separateness. A work will not be a work of joint authorship if the contribution of the co-authors is separate. The example often given is a literary work where separate authors contribute specific chapters, but there are other examples where the distinction made in the section may not be so easy to apply. I do not believe that a contribution to the arrangement of a song of the kind I am concerned with in this case is “separate” in the sense in which that word is used in the section. The added part is heavily dependent on what is there already. Stripped of the voices and other instruments, the violin part would sound odd, and lose meaning. The final musical expression — what the audience will hear — is a joint one”.

The Court here asks not whether contributions to the song were made separately, but whether the contribution of the particular putative co-author appears as something separate or separable in the final work. Hence the Court’s point that the final work appears as a seamless whole and that if the part of the co-author were subtracted nothing sensible or communicative would remain. This seems a more sensible and less restrictive test.

On a final note, the present approach seems to result in a distinct overlap between the requirements of collaboration and non-separateness of contribution. What now is the real difference between saying: you must have really collaborated; and “you must not have worked separately”?

Fairfax and hyperlinks

Fairfax v Reed further compounds the bad case of the copyright blues of database owners or compilers.³¹ The court had to consider whether copyright subsisted in individual titles of articles published in *The Australian Financial Review*. They had been reproduced by the defendant’s compilation and abstraction service. The Court found that the authors of the body or text of each article (journalists) did not produce works of joint authorship with those who separately devised the titles (sub-editors). They did not collaborate: rather, the journalist wrote the text and then quite separately and independently, sub-editors devised a suitable title, in accordance with their own particular parameters.

Nor were the titles taken by themselves copyright works because they were too small (insubstantial) and insufficient proof of skill and effort in their production could be provided, according to the court. This was in

line with the earlier decision in *Pacific Technologies* where the phrase “Help-Help-Driver-in-Danger-Call-Police-Ph.000” was held to lack sufficient originality to attract copyright.³²

Applying the intellectual activity test

But did the approach taken in *Reed* properly accord with the intellectual activity-test which *IceTV* now prescribes? Surely if a title is witty, smart and not commonplace, this evidences intellectual activity on the author’s part: don’t we value exactly that in popular authors? Going back to the pre-*IceTV* “sufficient effort” focus and language is arguably not appropriate: the High Court has made it quite clear that copyright is not about protecting effort and investment, but intellectual activity of an authorial kind.³³

Given that, if the *Reed* approach is correct, it is unlikely that had the journalist written article and title, copying only the latter would amount to reproduction of a substantial part (one reflecting a sufficient level of “originality” ie intellectual activity), it appears that there is little that can be done to stop competitors using titles of others’ works as hyperlinks, whether to that material or some other material. This would have to be attacked, if at all, on some other basis than copyright, for instance by recourse to the Trade Practices Act/Consumer Law, as was done in the battle between Luxottica/Budget Eyewear and Specsavers in 2010.³⁴

OPSM and Specsavers

However, in that matter copyright was also pleaded, as one party accused the other of the infringing reproduction of some advertising phrases or slogans.³⁵

Budget Eyewear initiated an advertising campaign (print and radio) in which it offered to replace broken glasses originating from its competitor OPSM with a replacement Specsavers sourced pair for free under certain conditions.

OPSM retaliated by making the same offer in very similar terms that it admitted sourcing from the Specsavers ads. The critical part of the ads consisted of about 5 phrases conveying the idea of bringing in a pair of the competitor’s glasses for a free replacement and thus coming to the rescue of the shopper. Were these simple phrases “designed to express a simple series of concepts”; were they a string of “four ordinary and commonplace sentences”; or had “a degree of care and skill [...] been exercised in order to convey simple ideas effectively in an advertisement [where] various means could have been taken to express the concept”?³⁶

Commonplace words and considered phrases

The Court considered that the fact that the words were commonplace did not matter — what counted was

whether the words and phrases were chosen carefully and “put together in a particular considered way”.³⁷ Elsewhere, in the context of infringement the Court points out that “various means could have been used to express the concept”.³⁸ The arrangement of words chosen by the applicant was not “obvious and prosaic”.³⁹ In adopting this approach *Budget Eyewear* is more in line with the reasoning in *IceTV*, and casts a different light on *Reed*: arguably the witty titles which were denied copyright there were also “chosen carefully and put together in a particularly considered way”!

Specsavers was not concerned with a single simple phrase, but with a number of them. It does beg the question as to where the line is to be drawn: no to one phrase even if witty and eye-catching (*Reed*) but yes to 4 phrases, which were arguably a rather prosaic expression of something which might well have been a rather cunning underlying marketing ploy. For purposes of comparison it is worth considering the permissive approach adopted by the European Court of Justice in *Infopaq*.⁴⁰ In New Zealand as well, a court has accepted copyright in a short sentence:⁴¹ “Field Friendly — the best choice for fieldwork”.

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Footnotes

1. Professor of Law, Bond University, Queensland.
2. *IceTV Pty Ltd v Nine Network Australia Pty Ltd* (2009) 239 CLR 458; 254 ALR 386; [2009] HCA 14; BC200902942.
3. Notwithstanding the consideration given to the matter in *Vawdrey Australia Pty Ltd v Krueger Transport Equipment Pty Ltd* (2009) 261 ALR 269; 83 IPR 1; [2009] FCAFC 156; BC200910100.
4. *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 119 FCR 491; 192 ALR 433; [2002] FCAFC 112; BC200202458. The High Court at that time refused special leave: see *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* M85/2002 [2003] HCATrans 796 (insufficient prospects of success).
5. *Telstra Corporation Ltd v Phone Directories Co Pty Ltd* (2010) 194 FCR 142; 273 ALR 725; [2010] FCAFC 149; BC201009581.
6. As Gummow J said: “In the absence of implementation of laws analogous to the kind described in the [European Database] Directive, the matters now in issue cannot be resolved by concluding, as did the Full Court [162], that *IceTV* appropriated “the fruits of Nine’s skill and labour””, see above n1, at HCA [139].
7. Material in Europe sometimes protected as non-original databases under the Directive of the European Parliament and of the Council on the Legal Protection of Databases Directive 96/9/EC of 11 March 1996, OJ No L77.
8. *Telstra Corp Ltd v Desktop Marketing Systems Pty Ltd* (2001) 181 ALR 134; 51 IPR 257; [2001] FCA 612; BC200102732.
9. Above n3 at FCAFC [92].
10. See s 10(1) of the Copyright Act 1968 (Cth).
11. Quoting Keating LJ in *Levy v Rutley* (1871) LR 6 CP 523 at p 529; see *Beckingham v Hodgens* [2003] EMLR 18; [2003] EWCA Civ 143 at [51].
12. *Olympic Amusements Pty Ltd v Milwell Pty Ltd* (1998) 81 FCR 403; 162 ALR 199; 40 IPR 180; BC9800466.
13. *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd* (2010) 189 FCR 109; 272 ALR 547; [2010] FCA 984; BC201006524 at [99].
14. *Acohs Pty Ltd v Ucorp Pty Ltd* (2010) 86 IPR 492; [2010] FCA 577; BC201003888.
15. *Ibid* at FCA [56].
16. *Ibid*.
17. *Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd* (2011) 91 IPR 488; [2011] FCA 362; BC201102048.
18. *Ibid* at [32].
19. *Ibid* at [34].
20. *Ibid* at [12].
21. *Ibid* at [43].
22. *Ibid* at [77].
23. *Ibid* at [76].
24. *Ibid* at [84].
25. *Ibid* at [81].
26. *Ibid* at [80].
27. *Ibid* at [75].
28. *Primary Health Care Ltd v Commissioner of Taxation* (2010) 186 FCR 301; 267 ALR 648; [2010] FCA 419; BC201003082.
29. Also see the examples given by Jessup J in *Acohs* at FCA [56].
30. *Beckingham v Hodgens* [2002] EWHC 2143 (Ch) at [46].
31. *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd* (2010) 189 FCR 109; 272 ALR 547; [2010] FCA 984; BC201006524.
32. *Victoria v Pacific Technologies (Australia) Pty Ltd* (2009) 177 FCR 61; 81 IPR 525; [2009] FCA 737; BC200905926.
33. This leaves aside the separate question whether the work was too insubstantial to attract copyright.
34. See the numerous decisions concerning comparative advertising between the two in the FCA.
35. See *Budget Eyewear Australia Pty Ltd v Specsavers Pty Ltd* (2010) 86 IPR 479; [2010] FCA 507; BC201003477.
36. *Ibid* at [14] and [15].
37. *Ibid* at [17].
38. *Ibid* at [21]. This was an interlocutory application only so the question did not have to be resolved, but the evidence to be considered was rather straightforward.
39. French CJ, Crennan and Kiefel JJ’s terms in *IceTV*, see above n1 at HCA [43].

40. *Infopaq v Danske Dagblades Forening* C-5/08, 16 July 2009.
There are interesting analogies between this case and *Reed v Fairfax*.
41. See *Sunlec International v Electropar* (High Court of New Zealand, Wylie J, 24 September 2008).