

REFORMING AUSTRALIA'S COPYRIGHT LAW: AN OPPORTUNITY TO ADDRESS THE ISSUES OF AUTHORSHIP AND ORIGINALITY

ALEXANDRA GEORGE*

I INTRODUCTION

Recent statements of the Attorney-General, Senator George Brandis, indicate that the Australian government is embarking on a comprehensive process of copyright law reform. In a speech delivered in early 2014, he observed:

There are those who would claim that technology has fundamentally changed the balance of interests in the creative economy ... It does not follow, I think, that the principles that underpin copyright are incapable of adapting. They have adapted to cinema, radio, television and personal computers, why not to technologies of which we are still to dream. ... However, this does not mean that I believe that Australia's copyright laws are not in need of reform. Quite the contrary.¹

He went on to describe the *Copyright Act 1968* (Cth) ('*Copyright Act*') as being 'overly long, unnecessarily complex, often comically outdated and all too often, in its administration, pointlessly bureaucratic', and to commit the government to 'a [thorough] and exhaustive exercise in law reform'.² In that

* Senior Lecturer, Faculty of Law, University of New South Wales. Grateful thanks to Keith Mason, Ralph Melano, Jim Sanderson, Michael Williams and the anonymous reviewers for their insightful comments and suggestions. Thank you also to participants at the 'Literary' Authorship, Commerce, & Cultural Innovation, Creativity and Authorship: Law and Changing Practices Symposium, Canberra, 17–18 December 2012 for feedback on a presentation of ideas contained in this article. Any errors or omissions of course remain the responsibility of the author.

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

2 Ibid.

speech and in a subsequent interview, he committed the government to making significant amendments to the Act during its first term in office.³

The Attorney-General identified three factors that he considered would be important in the government's review of copyright. First, the objective of making the *Copyright Act* 'shorter, simpler and easier to use and understand'; second, the objective of making the Act technology neutral; and third, paying 'careful regard to the broad international legal and economic context' to ensure that Australia's law will 'operate efficiently within a global copyright system'.⁴ The last of these considerations is likely to have added importance given that Australia is negotiating several free trade agreements with other nations that are expected to include intellectual property clauses and may require amendments to domestic copyright law.⁵

This article examines one area of copyright law, authorship, where there is a case that legislative amendments would be desirable. Although not the subject of the sort of high profile attention given to issues such as 'fair use' in light of

3 'I am also keen, as one of the achievements in the first-term of the Abbott Government, to modernise, reform and contemporise the *Copyright Act*': *ibid.* 'The Government will, during this term, be looking to make significant amendments to bring the [*Copyright Act*] up to date': Leon Byner, Interview with George Brandis, Attorney-General for Australia (Radio Interview, 24 February 2014) <<http://www.attorneygeneral.gov.au/transcripts/Pages/2014/First%20Quarter/24February2014-InterviewwithLeonByner5AA.aspx>>.

4 Brandis, above n 1.

5 Australia is currently negotiating seven trade agreements, including three bilateral agreements with international trading partners, three regional agreements, and the *Trans-Pacific Partnership Agreement* ('*TPP*'). Although leaked drafts of the *TPP* may be found online, the texts are still under discussion and drafts are not officially available, so it is not yet possible to offer informed comment as to whether the domestic legal issues discussed in this article are likely to be impacted by the agreements. The status of discussions can be followed at the website of the Department of Foreign Affairs and Trade ('*DFAT*'): *DFAT, Australia's Trade Agreements* <<http://www.dfat.gov.au/fta/>>. The *Anti-Counterfeiting Trade Agreement* ('*ACTA*') may also be relevant. However, ratification of this does not require amendments to Australian laws and is therefore unlikely to affect directly the issues discussed in this article. For further details, see House of Representatives Joint Standing Committee on Treaties, Parliament of Australia, *Review into Treaty Tabled on 1 November 2011* (2012). For the government's response, see Australian Government, *Response to the Joint Standing Committee on Treaties Report: Report 126: Review of Treaty Tabled on 21 November 2011: Anti-Counterfeiting Trade Agreement* (2012).

The likely implications of all such agreements should be included in considerations to be examined during the proposed review of Australia copyright law. This is particularly important as, historically, the structural integrity and internal balance of domestic copyright doctrines has been vulnerable to being undermined when strategic compromises are made during the political horse-trading that characterises international trade negotiations. For discussions of this tendency, see, eg, Susan Sell, *Private Power, Public Law: The Globalization of Intellectual Property Rights* (Cambridge University Press, 2003) (in the context of *TRIPS*); Peter Drahos, 'BITS and BIPS: Bilateralism in Intellectual Property' (2001) 4 *Journal of World Intellectual Property* 791. In Matthew Rimmer, 'Robbery Under Arms: Copyright Law and the Australia-United States Free Trade Agreement' (2006) 11(3) *First Monday* <http://www.firstmonday.org/issues/issue11_3/rimmer/index.html>, the author analyses this propensity in the context of negotiations towards the *Australia-United States Free Trade Agreement*, opened for signature 18 May 2004, [2005] ATS 1 (entered into force 1 January 2005).

the Australian Law Reform Commission's recent report,⁶ or ISP liability for the illegal downloads of subscribers,⁷ it is an area of copyright law that has become more difficult to navigate since the High Court of Australia delivered judgment in *IceTV Pty Ltd v Nine Network Australia Pty Ltd*.⁸

The decision in *IceTV* shifted more weight to authorship considerations when establishing copyright subsistence, and arguably raised the standard of authorship that would have to be established before copyright would be recognised to subsist in original literary works. Commentators were divided as to its likely implications. Competing views were identified by lawyer Anne Flahvin in a press report about the shifting balance brought about by recent changes in Australian copyright:

While these decisions have been welcomed by information aggregators, IT developers and others who use third party data to create new works, they are generating increasing concern on the part of owners of directories and other valuable compilations of data.⁹

As this article demonstrates, subsequent judicial application of *IceTV* authority has led to fragmentary development of the law that has created uncertainty about the prerequisites for copyright subsistence in literary works.

Against the backdrop of criticism of these developments by many practitioners,¹⁰ and disquiet raised by some judges,¹¹ there is a clear opportunity for the issue of authorship and originality to be included within the proposed review of Australian copyright laws by the government. The purpose of this article is not to recommend specific policy directions this legislative reform should take. Rather, the article analyses weaknesses in the current state of the law, identifies issues and options that might be considered during a law reform process, and builds a case that 'authorship' and 'originality' should be amongst the matters to be addressed in the forthcoming law reform initiative.

6 Australian Law Reform Commission, *Copyright and the Digital Economy*, Report No 122 (2013) 159–60, 187–8, 268, 296. Among others, the Australian Law Reform Commission recommends replacing existing 'fair dealing' exceptions to copyright infringement with flexible 'fair use' provisions; replacing some statutory licenses with voluntary licensing provisions; new orphan works provisions; and provisions concerning the preservation of copyright material by cultural institutions.

7 In response, the Attorney-General has specifically foreshadowed action on this issue: Brandis, above n 1. 8 (2009) 239 CLR 458 (*'IceTV'*).

9 Anne Flahvin, 'Court to Ponder Whether the Human Touch is Key to Copyright', *The Australian* (online), 28 January 2011 <<http://www.theaustralian.com.au/business/legal-affairs/court-to-ponder-whether-the-human-touch-is-key-to-copyright/story-e6frg97x-1225995705738>>.

10 These views are frequently found in legal bulletins, newspapers, and law firms' updates on legal developments (published for the information of clients and as marketing tools). As such views can significantly influence the shape of copyright law reform (particularly where they are representative of lobbying by firms' clients: see discussion below n 112), such publications have been cited more frequently in this article than may be common in scholarly journals.

11 See, eg, *IceTV* (2009) 239 CLR 458, 504 (Gummow, Hayne and Heydon JJ); *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* (2010) 264 ALR 617, 628 (Gordon J); *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* (2010) 194 FCR 142, 171–2 (Keane CJ).

II AUTHORSHIP IN LITERARY WORKS

Literary works are one of four types of ‘works’ recognised under part III of Australia’s *Copyright Act*, along with dramatic, musical and artistic works. Although the other part III works are also dependent on a version of the authorship principles, the focus in this article is solely on copyright law’s construction of ‘literary works’.¹²

Two requirements for a literary work are that it is the result of ‘authorship’ and that it be ‘original’. In the 1917 decision of the High Court in *Sands & McDougall Pty Ltd v Robinson*, Issacs J (with whom Gavan Duffy and Rich JJ agreed) described the relationship between the two concepts as follows:

in copyright law the two expressions ‘author’ and ‘original work’ have always been correlative; the one connotes the other, and there is no indication in the Act that the Legislature intended to depart from the accepted signification of the words as applied to the subject matter. Indeed, the circumstance of reciprocal connotation is the key to the meaning of the enactment. We find in the *Oxford Dictionary*, vol i, p 571, col 1, ‘author’ defined as ‘the person who originates or gives existence to anything’.¹³

Under the Australian *Copyright Act*, the centrality of authorship is clear from section 32(1), dealing with subsistence. With respect to unpublished works, this section specifies that ‘copyright subsists in an original literary, dramatic, musical or artistic work ... of which the *author* was a qualified person at the time when the work was made’.¹⁴ A ‘qualified person’ is defined as ‘an Australian citizen or a person resident in Australia’,¹⁵ but ‘author’ is not statutorily defined with respect to literary works.¹⁶ Further interpretation of what constitutes a ‘literary work’ is derived from the case law.

Copyright’s core idea–expression dichotomy principle limits the conferral of copyright to the manner in which facts are expressed, not to the facts

12 Although the focus of this article is on literary works, the High Court’s decision in *IceTV* is – as Kevin Lindgren notes – relevant to pleading infringement cases with respect to any type of works (ie, literary, dramatic, musical or artistic): Kevin Lindgren, ‘Icy Lessons for Pleadings of Copyright Infringement’ [2010] (82) *Intellectual Property Forum* 11, 15.

13 (1917) 23 CLR 49, 55.

14 *Copyright Act* s 32(1)(a) (emphasis added).

15 *Copyright Act* s 32(4). ‘Qualified person’ also includes someone who has first published a work in Australia: at s 32(2), or who receives reciprocal ‘qualification’ under the law of certain other jurisdictions. In practice, citizens or residents of most nations fall into the latter category by virtue of their membership of the *Berne Convention for the Protection of Literary and Artistic Works*, opened for signature 9 September 1886, 1161 UNTS 30 (entered into force 4 December 1887); *Marrakesh Agreement Establishing the World Trade Organisation*, opened for signature 15 April 1994, 1867 UNTS 3 (entered into force 1 January 1995) annex 1C (‘TRIPS’).

16 With respect to photographs, the *Copyright Act* s 10(1) specifies the ‘author’ as ‘the person who took the photograph’.

themselves.¹⁷ Distinguishing between authored expressions of facts and the facts themselves, particularly with the use of technology in the creation of works, is not always easy.

In the 300 or so years since the *Statute of Anne* ushered in modern copyright principles,¹⁸ lawmakers have deemed the notion of 'literary works' to be sufficiently flexible to capture the output of new technologies. When courts have been reluctant to make such determinations, parliaments have intervened. For example, 'computer programs' were added to the Australian statutory definition of 'literary works' in 1984.¹⁹

Despite these responses in some areas of copyright law, Parliament has left it to the courts to apply existing common law principles about authorship and originality to those new types of works. This can be contrasted with the position elsewhere. Reforms undertaken in other jurisdictions – notably the United Kingdom²⁰ – to recognise the relationship between the role of human authors and technology such as computers, have not been followed in Australia.

A The Desktop Marketing Precedent

Prior to *IceTV*, the 'originality' requirement – sometimes described as the 'innovation threshold'²¹ – had been explained in the 2002 appellate decision in *Desktop Marketing*.²² As 'originality' and 'authorship' are correlatives in copyright law,²³ the definition of 'authorship' is dependent on the meaning of 'originality'.

Desktop Marketing examined whether telephone directories could be 'literary works'. Adopting a low 'originality' threshold, the Full Court of the Federal

17 This doctrine is explained in *IceTV* (2009) 239 CLR 458, 472 (French CJ, Crennan and Kiefel JJ). See also *Blackie & Sons Ltd v The Lothian Book Publishing Co Pty Ltd* (1921) 29 CLR 396, 400 (Starke J); *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479, 497 (Latham CJ), 511 (Dixon J); *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171, 181 (Gibbs CJ). In the US Supreme Court case *Feist Publications Inc v Rural Telephone Service Co Inc*, 449 US 340, 353 (1991), O'Connor J (delivering the opinion of the Court) noted it was the 'most fundamental axiom of copyright law – that no one may copyright facts or ideas'. The principle is also enshrined in the *WIPO Copyright Treaty*, opened for signature 20 December 1996, 2186 UNTS 121 (entered into force 6 March 2002) art 2, which states that 'protection extends to expressions and not to ideas ...'.

18 1710, 8 Anne 1, c 19. Note that the High Court's decision in *IceTV* was delivered on 22 April 2009, just under 300 years after the *Statute of Anne* came into force on 10 April 1710.

19 *Copyright Amendment Act 1984* (Cth). With respect to computer programs, this amendment followed the case of *Apple Computer Inc v Computer Edge Pty Ltd* (1983) 50 ALR 581, in which the High Court held that the object code in computer programs was not a 'literary work' within the meaning of the *Copyright Act*, and was therefore not covered by copyright law.

20 *Copyright, Designs and Patents Act 1988* (UK) c 48, s 9(3).

21 See, eg, *Desktop Marketing Systems Pty Ltd v Telstra Corporation Limited* (2002) 119 FCR 491, 572 (Sackville J) ('*Desktop Marketing*').

22 *Ibid.*

23 See, eg, *Desktop Marketing* (2002) 119 FCR 491, 532 (Lindgren J); *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49.

Court of Australia held that copyright could subsist by virtue of the author's contribution of sufficient skill, judgment or knowledge in selecting material to include in the telephone directories, or in presenting or arranging it.²⁴ A factual compilation could also be 'an original literary work for copyright purposes if the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation'.²⁵ Such an approach was said to involve an 'industrious collection'²⁶ or reward 'sweat of the brow'.²⁷

In *Desktop Marketing*, Telstra had provided a telephone service and published directories containing the names, addresses and telephone numbers of its subscribers. In the White Pages directory, this was arranged alphabetically by the subscribers' names. In the Yellow Pages directory, it was grouped according to the subscribers' business activities. Desktop produced a CD-ROM containing the same information about Telstra's subscribers. Telstra sued Desktop, claiming Desktop's CD-ROM infringed Telstra's copyright in its ordering of the directory information. Desktop admitted that it had obtained information – which it said was factual information that was not covered by copyright – from Telstra's phonebooks, and it claimed to have reformatted the data and added additional information.

At first instance, Finkelstein J found that an author who makes an 'industrious collection' of facts may hold copyright in the particular form or order in which that information is arranged.²⁸ In other words, the manner of expression of facts could include the way in which those facts are arranged. Where the facts of a case indicated that the author had engaged in sufficient work or incurred sufficient expense to produce a particular original arrangement of the factual information, the product of that effort could attract copyright protection. As a substantial part of Desktop's data and headings were found to be identical to those in Telstra's phonebooks, Desktop infringed Telstra's copyright in the expression of the factual information in its directories.

On appeal, the Full Court of the Federal Court affirmed the trial judge's decision.²⁹ The appellate judges (Black CJ, Lindgren and Sackville JJ) delivered separate reasons for judgment, but agreed on key points and upheld the primary judge's decision. Justice Sackville summarised the principles on which the case was decided:

24 *Desktop Marketing* (2002) 119 FCR 491, 593 (Sackville J).

25 *Ibid* 593 (Sackville J) (emphasis altered).

26 *Ibid* 535 (Lindgren J).

27 *Ibid*. For discussions of the doctrine, see, eg, Abraham Drassinower, 'Sweat of the Brow, Creativity, and Authorship: On Originality in Canadian Copyright Law' (2003) 1 *University of Ottawa Law and Technology Journal* 105; Jordan M Blanke, 'Vincent van Gogh, "Sweat of the Brow," and Database Protection' (2002) 39 *American Business Law Journal* 645; Joellen Riley, 'Use and Abuse of Copyright: The "Sweat of the Brow" Theory Gone Mad' (2005) 30 *Alternative Law Journal* 109.

28 *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* (2001) 181 ALR 134.

29 *Desktop Marketing* (2002) 119 FCR 491.

A compilation will ordinarily be an *original* literary work for copyright purposes if the compiler has exercised skill, judgment or knowledge in selecting the material for inclusion in the compilation (as with a collection of commentaries) or in presenting or arranging the material (as with the births and deaths column in *John Fairfax*). In addition, a compilation of factual information will ordinarily be an *original* literary work for copyright purposes if the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation.³⁰

Special leave to appeal to the High Court was refused, and the authorship–originality standards established in *Desktop Marketing* seemed to be settled law until 2007,³¹ when the trial judge in the *IceTV* case introduced an additional consideration to the analysis. Since then, the law has shifted course with respect to the type of ‘originality’ and ‘skill, labour and effort’ that must be invested by ‘the author’ to create a new ‘literary work’.

B *Nine Network v IceTV Case*

IceTV was a copyright infringement case brought by television broadcaster, Nine Network Australia (‘Nine’). Nine issued weekly guides to its program schedule to licensees, which then combined the information with that of other television stations to create program guides for publication to viewers. IceTV offered its subscribers electronic guides to the scheduling of television programs. The company gave evidence that it produced the guides by viewing television broadcasts, noting what was shown and when, and entering this information into predictive software that compiled lists of likely forthcoming programming. It then corrected any errors by checking against program guides provided by Nine’s licensees.

Nine sued IceTV for copyright infringement, claiming that IceTV had copied Nine’s guide and had thus appropriated a substantial part of copyright material that was the product of Nine’s skill and labour.

At first instance, Bennett J analysed Nine’s investment of ‘skill and labour’ in producing the television guides.³² Adding an additional factor to the line of reasoning established in *Desktop Marketing*, Bennett J distinguished the ‘antecedent’ or ‘preparatory’ skill and labour undertaken by a television station in organising forthcoming programming from the subsequent skill and labour of recording this information in a material form that could be distributed to

30 Ibid 593 (emphasis in original).

31 For commentaries on these standards, see, eg, Tanya Aplin, ‘When Are Compilations Original? *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd*’ (2001) 3 *Digital Technology Law Journal* 1; Sandra Gosnell, ‘Database Protection Down Under: Would a “Sweaty” Australia be Better Off with a Northerly Change?’ (2003) 26 *University of New South Wales Law Journal* 639.

32 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* [2007] FCA 1172.

viewers.³³ As the former involved the creation of factual information, the judge concluded that only the format and presentation of any original material form in which that information was expressed could be protected by copyright. On the facts, Bennett J found that IceTV's copying of factual time and title information, where that content amounted to mere 'slivers of information', was not copyright infringement.³⁴

On appeal to the Full Court, Black CJ, Lindgren and Sackville JJ – the same judges who had heard the appellate case in *Desktop Marketing* – held that IceTV's copying of the time and title information had involved an appropriation of Nine's skill and labour.³⁵ The Court held that IceTV had copied more than a slight or immaterial portion of Nine's copyright protected material as the 'slivers of information' were a substantial part of Nine's original 'literary work'.

On further appeal, the High Court unanimously rejected the Full Court's conclusions,³⁶ and found that the originally pleaded work was not

33 Ibid [46], [55]. 'The skill and labour engaged in by Nine for the creation of the time and title information is skill and labour that is expended for the purposes of broadcasting and as preparatory skill and labour for the purposes of the compilation': at [211] (Bennett J).

34 Ibid [187], [211].

It can be said that Ice copies 'slivers' of information. Over an extended period of time, the impact of the constant updating may have both a quantitative and qualitative effect on the accuracy of the IceGuide. However, for any given day or week the information taken is not of sufficient quantitative nor qualitative significance to be characterised as a substantial part of the whole of the Nine compilation, the Weekly Schedule: at [193] (Bennett J).

Ice does take slivers of time and title information each day from the Aggregated Guides. For the reasons I have set out in detail, Ice does not reproduce a substantial part of the Weekly Schedule in so doing. It follows that Ice has not infringed Nine's copyright in the course of making and updating the IceGuide: at [249]–[250] (Bennett J).

35 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14.

36 *IceTV* (2009) 239 CLR 458.

infringed.³⁷ The guide was produced as an incident of Nine's core business of broadcasting television programs (ie, Nine's skill and labour was not directed towards producing an original copyright work but towards running a television station). The nature of the raw information in question – times and titles of scheduled programs – meant that it could only be expressed in the unoriginal format that was used by both Nine and IceTV.³⁸ Thus, the High Court reinstated

37 At trial, IceTV had made concessions regarding subsistence:

Ice accepts that copyright subsists in the Weekly Schedule by virtue of the skill and labour in the scope of selection of programs, the decision to move or replace existing programs, the adjustment of times, program changes, the mode of expression and in the arrangement of the information by Nine: *Nine Network Australia Pty Ltd v IceTV Pty Ltd* [2007] FCA 1172, [47] (Bennett J).

This was acknowledged by the Full Federal Court in *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14, [61]. It was referred to again during the special leave application hearing when the barrister for Nine stated 'Ice conceded at the trial, correctly, that the originality of Nine's weekly schedules lay, at least in part, in the skill and labour invested in the decision to screen particular programs at particular times': Transcript of Proceedings, *IceTV Pty Ltd v Nine Network Australia Pty Limited* [2008] HCATrans 308 (26 August 2008) 22.

However, in the High Court in *IceTV* (2009) 239 CLR 458, there was a difference between the findings in the judgment of French CJ, Crennan and Kiefel JJ and that of Gummow, Hayne and Heydon JJ. The judgment of French CJ, Crennan and Kiefel JJ stated '[a]s it has been conceded by IceTV and IceTV Holdings that copyright subsisted in each Weekly Schedule, it is therefore not necessary, in this appeal, to consider the question of the subsistence of copyright in those compilations': at 469 (citations omitted). By contrast, the reasoning of Gummow, Hayne and Heydon JJ was more complicated:

At trial and in the Full Court, it was accepted by Ice that copyright subsisted in each Weekly Schedule and was owned by Nine. However, there was debate in this Court as to the scope of that concession and, in particular, whether it extended to matters related to the nature of the copyright subsisting in the Weekly Schedule. It is a matter of regret that the legal issues between Nine and Ice were crystallised only in the course of oral submissions in this Court. That makes it necessary to consider the pleadings, the evidence, the findings and the general conduct of the litigation at trial, and on the intermediate appeal, more closely than is usual in a final court of appeal. ... Something should be said respecting two fundamental principles of copyright law [ie 'authorship' and the subsistence requirement 'fixation of the original work in a material form'] and their treatment in the course of the litigation. The concession by Ice of the subsistence of copyright in the Weekly Schedule appears to have distracted attention from the necessary part these principles must play in any resolution of the dispute between the parties. ... A generally expressed admission or concession by one party to an infringement action of subsistence of and title to copyright may not overcome the need for attention to these requirements when dealing with the issues immediately in dispute in that action. This litigation provides an example. The exclusive rights comprised in the copyright in an original work subsist by reason of the relevant fixation of the original work of the author in a material form. To proceed without identifying the work in suit and without informing the enquiry by identifying the author and the relevant time of making or first publication, may cause the formulation of the issues presented to the court to go awry: at 493–6 (citations omitted).

To this extent, the Gummow, Hayne and Heydon JJ approach reopened the question of subsistence, despite the concession made by IceTV at trial.

38 *IceTV* (2009) 239 CLR 458, 481 (French CJ, Crennan and Kiefel JJ) (citations omitted):

[T]he critical question is whether skill and labour was directed to the particular form of expression of the time and title information, including its chronological arrangement. The skill and labour devoted by Nine's employees to programming decisions was not directed to the originality of the particular form of expression of the time and title information. The level of skill and labour required to express the time and title information was minimal. This is not surprising, given that, as explained above, the particular form of expression of the time and title information is essentially dictated by the nature of that information.

the trial judge's original findings, thereby triggering a large scale common law revision of related copyright principles in Australian law.

Heightened attention to the role of the author can be traced to the High Court judgment of Gummow, Hayne and Heydon JJ in *IceTV*, in which they said:

The exclusive rights comprised in the copyright in an original work subsist by reason of the relevant fixation of the original work of the author in a material form. To proceed without identifying the work in suit and without *informing the enquiry by identifying the author* and the relevant time of making or first publication, may cause the formulation of the issues presented to the court to go awry.³⁹

This sentiment was echoed in the High Court judgment of French CJ, Crennan and Kiefel JJ, which 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'.⁴⁰

Although subsistence had been admitted in *IceTV* and that case concerned infringement issues, post-*IceTV* cases have intensified focus on the need to identify the author to prove subsistence. The trend was summarised by a judge in one of the post-*IceTV* cases (discussed below), who said, 'as a general proposition the need for a work to spring from the original efforts of a single human author is a fundamental requirement of copyright law'.⁴¹

III FOUR CASES ILLUSTRATING FOUR AREAS OF DIFFICULTY

Some lauded the *IceTV* case and its consequences as a welcome correction to expansive interpretations of copyright that, they claimed, had amounted in recent years to the development of a pseudo unfair competition doctrine.⁴² The decision also seemed to provide scope for an author to draw on another's compilation in

39 Ibid 496 (emphasis added).

40 Ibid 470.

41 *Acohs Pty Ltd v Ucorp Pty Ltd* [2010] FCA 577, [48] (Jessup J).

42 See, eg, Glenn McGowan, '*IceTV v Nine Network* and the Copyright in Factual Compilations in Australia' (2009) 83 *Australian Law Journal* 840. 'The use of copyright as a disguised anti-competitive tool by large corporations has been dealt a significant blow': at 848. See also Justine Pila, 'Compilation Copyright: A Matter Calling for "a Certain ... Sobriety"' (2008) 19 *Australian Intellectual Property Journal* 231. Pila's article argues that the trial judge's decision was generally correct and 'reflects an important attempt by a judge to re-orient copyright around its works, and resist the past temptation of courts to read copyright as a law of unfair competition ...': at 232.

its own work, potentially opening new commercial opportunities in some sectors.⁴³

Others voiced concerns that the decision would leave many non-traditional⁴⁴ or information based literary products unprotected by copyright, and would leave commercial organisations unable to profit from monopolies over material they had invested in creating.⁴⁵ This viewpoint was accompanied by concern that the *IceTV* jurisprudence could deter investment in certain types of Australian commercial enterprises and businesses might move their resources to more copyright friendly jurisdictions.⁴⁶

As subsequent judicial application of *IceTV* authority has refined the law in this area over the last five years, several issues – both foreseen and unexpected – have attracted new attention and concern.

The judicial emphasis on the nature and role of the author in judgments post-*IceTV* has been particularly evident in four cases:

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- 43 For example, law firm Allens Linklaters offered the following advice in a client bulletin: 'Organisations who wish to make use of existing compilations in producing their own works have greater scope to do so in light of this decision': Miriam Stiel, Amanda Andreazza and Katherine McMahon, *Copyright in Factual Compilations* (24 April 2009) Allens Linklaters <<http://www.allens.com.au/pubs/ip/foipapr09.htm#Implic>>. See also James Paterson, 'Fantastic Figures: Online Sports Competitions Post *IceTV* v *Nine*' (2009) 83 *Law Institute Journal* 30, for a discussion about how *IceTV* could open the way for use in 'fantasy football' competitions of statistics copied from football league and other private databases.
- 44 As noted in Dana Beldiman, *Functionality, Information Works, and Copyright* (Yorkhill Law Publishing, 2008) 67 (citations omitted):

works of factual and informational nature, such as directories, maps, databases, other compilations of information, etc., continue to be a challenge to modern copyright law. These works do not fit into the traditional copyright mold because they lack the creative originality normally present in fictional writings, painting and musical compositions.

Note that the terminology used to describe 'non-traditional' copyright works can be somewhat controversial. See generally Robert F Brauneis (ed), *Intellectual Property Protection of Fact-based Works: Copyright and Its Alternatives* (Edward Elgar Publishing, 2009). The problem is also addressed in Jane C Ginsburg, 'Creation and Commercial Value: Copyright Protection of Works of Information' (1990) 90 *Columbia Law Review* 1865, 1907–12, where the author refers to 'low authorship' works. The same issue was addressed in argument before the High Court in *IceTV Pty Ltd v Nine Network Australia Pty Ltd* [2008] HCATrans 358 (17 October 2008). Referring to a different category of non-traditional copyright works (computer programs), see also Lloyd Weinreb, 'Copyright for Functional Expression' (1998) 111 *Harvard Law Review* 1149, who distinguishes between 'expressive' and 'functional' copyright works.

- 45 See, eg, Jani McCutcheon, 'When Sweat Turns to Ice: The Originality Threshold for Compilations Following *IceTV* and *Phone Directories*' (2011) 22 *Australian Intellectual Property Journal* 87; Peter Knight, 'Copyright in Databases and Computer Programs: Why Is It So Hard to Understand?' (2010) 21 *Australian Intellectual Property Journal* 118; Stiel, Andreazza and McMahon, above n 43.
- 46 See, eg, Cameron Andrews, 'Copyright in Computer-Generated Work in Australia Post-*IceTV*: Time for the Commonwealth to Act' (2011) 22 *Australian Intellectual Property Journal* 29. 'Australia will be the poorer if the absence of protection for computer-generated works results in a decline in the investment in the creation of such works in Australia or a reluctance of foreign copyright owners to exploit their works in Australia': at 45.

- *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* ('Phone Directories');⁴⁷
- *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd* ('Headline');⁴⁸
- *Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd* ('Tonnex');⁴⁹ and
- *Acohs Pty Ltd v Ucorp Pty Ltd* ('Acohs').⁵⁰

Not only do these cases help to elucidate what amounts to authorship post-*IceTV*, but they also illustrate a range of difficult situations in which the current requirements of authorship and originality are unclear, and/or can lead to problematic results.

A Identifying the Author(s): Phone Directories

Identification of the authors of works can be difficult, particularly in a modern business environment, as *Phone Directories* demonstrates.⁵¹

Phone Directories was another case involving allegations of copyright infringement of Telstra's White Pages and Yellow Pages telephone directories. The way in which the phone directories were produced had evolved during the period since *Desktop Marketing*, with a different computer system being used and the directories under consideration in the latter case being largely computer generated. Whereas *Desktop Marketing* was concerned with the originality of the telephone directories, the judgment in *Phone Directories* concentrated mainly on authorship of those directories. The Federal Court distinguished *Desktop Marketing* and applied *IceTV*.⁵² Importantly, although *IceTV* had considered only infringement, the application of its 'authorship' reasoning in *Phone Directories* extended *IceTV* principles to the determination of subsistence.

Telstra claimed that directories produced by the Phone Directories Company copied original literary works from its White and Yellow Pages phonebooks. It argued that the phonebooks were 'literary works' in the form of compilations involving 'the expression, including the content, form and arrangement of

47 (2010) 264 ALR 617.

48 (2010) 189 FCR 109.

49 [2011] FCA 362.

50 [2010] FCA 577.

51 Note that in *Phone Directories*, the telephone directories were produced by Telstra's fully owned subsidiary, Sensis. The *Phone Directories* litigation discussed here was part of a larger dispute litigated in separate proceedings.

52 Note that proceedings in *Phone Directories* had been commenced on 5 April 2007, before any decisions had been handed down in *IceTV*. The parties disagreed as to whether the High Court's decision in *IceTV* resolved the issues in contention in this case. However, to the extent that it was relevant, the judge in *Phone Directories* was bound by *IceTV* (a High Court case), rather than *Desktop Marketing* (a Full Federal Court case). Justice Gordon noted this in *Phone Directories* (2010) 264 ALR 617, 633.

information in individual listings, and the overall arrangement of individual listings into the whole',⁵³ and that the Yellow Pages directories involved additional expression in the arrangement of the information under headings and with cross references.⁵⁴

Having brought on the hearing of a preliminary question of whether copyright subsisted in the claimed works, Gordon J found that none of the material was an original literary work because many unidentified people had contributed to collating the information. Citing the *IceTV* principle of 'informing the enquiry by identifying the author', Gordon J found that problems identifying the author(s) of the material meant that it could not qualify as a 'literary work' in which copyright could subsist.⁵⁵ Her Honour stated:

Authorship and originality are correlatives. The question of whether copyright subsists is concerned with the particular form of expression of the work. You must identify authors, and those authors must direct their contribution (assessed as either an 'independent intellectual effort' of a 'sufficient effort of a literary nature') to the particular form of expression of the work. Start with the work. Find its authors. They must have done something, howsoever defined, that can be considered original.⁵⁶

Furthermore, Gordon J found that the effort of these people was preparatory to the information first being put into a material form. Various workers had entered data into computers at various times, but the material form of the phonebooks was generated primarily by automated computer processes. Thus, it did not involve the 'individual intellectual effort' or 'sufficient effort of a literary nature' required by the principles set out in *IceTV*. As a result, there was no 'authorship', and literary work copyright did not arise in the phonebooks.

On appeal, the Full Court upheld the trial judge's finding that copyright did not subsist in the White and Yellow Pages telephone directories. It agreed that authors had to be identified before authorship could be recognised and a 'literary work' could subsist. Delivering separate reasons for their decisions, the appellate judges concurred with the trial judge that some human(s) applying some kind of intellectual effort in the production of a phone directory was insufficient input to

53 *Phone Directories* (2010) 264 ALR 617, 621 (Gordon J).

54 *Ibid.*

55 *Ibid.*

[T]he Applicants were unable to identify the authors of the Works (and for present purposes, ignoring that much of the Works are not the subject of human authorship). This is further exacerbated by the role that the contractors played, as outlined below ... [M]any individuals who might be considered authors are unidentified and the ownership of the intellectual property in the work they performed has not been established: at 658 (Gordon J).

56 *Ibid* 685 (Gordon J).

give rise to an original 'literary work'.⁵⁷ *Desktop Marketing* was distinguished on the basis that it had not involved questions concerning the automated authorship of compilations.⁵⁸

Telstra sought special leave to appeal to the High Court, but was refused in September 2011.

Prior to *Phone Directories*, it was commonplace to plead a case relying on assumptions that the fact that an original material form exists means that literary material has been authored by someone and/or by identifying one qualified author. Alternatively, demonstrating that the work was first published in Australia within the past 70 years would be sufficient to prove the existence of 'authorship' for copyright purposes, with any ownership issues to be resolved separately. This is because the explicit authorship requirements for subsistence set out in the *Copyright Act* are that the author be the person(s) who created the original material form and that at least one author be a 'qualified person',⁵⁹ or that the work was first published in Australia. Once this much had been established, the work would be assumed to exist, and copyright to subsist.

However, following the decision in *Phone Directories*, it appears to be necessary that the authors, and their respective creative input, be identified as a prerequisite to copyright subsisting in literary works. Justice Gordon stated:

for a work to be sufficiently original for the subsistence of copyright, 'substantial labour' and / or 'substantial expense' is not alone sufficient. More is required. What that more is will, of course, vary from case to case but must involve 'originality' by an *identified author* in an identified work.⁶⁰

Some read *Phone Directories* as requiring not only the individual identification of authors before copyright subsists, but also the identification of each individual author who contributed to the creation of the material form of a jointly authored work.⁶¹ However, there are differences of opinion as to what is required.

57 *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* (2010) 194 FCR 142, 171 (Keane CJ):

The reasons of the High Court in *IceTV* authoritatively establish that the focus of attention in relation to the subsistence of copyright is not upon a general concern to prevent misappropriation of skill and labour but upon the protection of copyright in literary works which originate from individuals. In this case copyright was said to subsist in the directories as compilations, but the directories were not compiled by individuals.

58 See *ibid* 169–70, where Keane CJ explains that the only subsistence issue considered in *Desktop Marketing* concerned the degree of intellectual effort necessary to create a compilation that was sufficiently original for copyright to subsist.

59 See *Copyright Act* s 32(1)(a) for definition of 'qualified person'.

60 *Phone Directories* (2010) 264 ALR 617, 624 (emphasis added).

61 *Ibid* 684 (Gordon J) (acknowledging that first publication in Australia was not disputed).

It is not sufficient to demonstrate the subsistence of copyright by asserting that someone (and I do not accept that such a person has been found in this matter), who may in certain broad circumstances, in an unspecified number of relevant instances, have done an act that constitutes some unknown contribution to a work in question 'no matter how unimpressive' will be enough to make good the Applicants' claim: at 685.

The confusion is due to disparities in the interpretation of Justice Gordon's statement: 'If an author or authors (within the meaning of the *Copyright Act*) cannot be identified *at all*, in contradistinction to a situation where the author's or authors' exact identity cannot be identified, copyright cannot subsist'.⁶² It is uncertain whether this means:

1. Subsistence depends on determining that particular authors existed (as opposed to a requirement that those authors be named); or
2. That each individual author must be identified personally.

On appeal, Perram J read the trial judge's comments in accordance with the first interpretation.⁶³ Chief Justice Keane seemed to read the trial judge's comments in accordance with the second interpretation, but rejected an approach requiring insistence on identification of all authors, stating:

it may be accepted, for the sake of argument, that there is force in the appellants' criticism of the trial judge's insistence on the identification of all the 'authors'. One may accept that identification by name of each and every author is not necessary in order to make out a claim that copyright subsists under s 32(2)(c): what is necessary, however, is that it be shown that the work in question originates from an individual author or authors.⁶⁴

Thus, two of the appellate judges in *Phone Directories* suggested that it is not necessary for all authors to be identified personally (the third member of the bench, Yates J, was silent on this point). However, as the case turned on a different issue,⁶⁵ those comments were arguably obiter dicta. While their opinions would be persuasive in later cases, the appellate Court did not bind the hands of future judges considering this issue. This leaves the law ambiguous on this point, and makes it difficult to predict how future cases are likely to be decided.

Adding to the uncertainty, the Full Court decision in *Phone Directories* was delivered roughly three months after Justice Bennett's decision in *Headlines* (following Justice Gordon's approach at trial in *Phone Directories*) appeared to interpret *IceTV* to mean that each author does need to be identified personally before copyright will subsist. In *Headlines*, Fairfax claimed that its employed subeditors were the authors of newspaper headlines in which it wished to assert copyright, but it did not identify those people individually. The Court held that

⁶² Ibid 630 (emphasis in original).

⁶³ *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* (2010) 194 FCR 142, 181 (Perram J):

The necessity for there to be an original work carries with it the necessity for there to be an author or authors but all that needs to be demonstrated is that such persons exist. Their identification is not legally required by the concept of an original work. The statement by Gummow, Hayne and Heydon JJ in *IceTV* that '[t]o proceed without identifying the work in suit and without informing the inquiry by identifying the author and the relevant time of making or first publication, may cause the formulation of the issues presented to the court to go awry' (at [105]) is, I think, a counsel of wisdom rather than a legal stipulation.

⁶⁴ Ibid 162.

⁶⁵ That is, the computer generated nature of the works.

copyright authorship of the headlines could not be assumed in these circumstances.⁶⁶

By contrast, in *Sanofi-Aventis Australia Pty Ltd v Apotex Pty Ltd [No 3]*, Jagot J commented in obiter that it was unnecessary to identify each author who collaborated in the making of a jointly authored product information sheet.⁶⁷ An obvious conclusion is that the post-*IceTV* cases thus fail to offer consistent guidance as to the law's requirements.

In these circumstances, it remains uncertain as to whether it is indeed necessary to identify by name all authors of a purported literary work before copyright will be found to subsist under Australian law. In the absence of clear authority on this point, this would seem to be an appropriate area to be addressed in the government's broad copyright reform process.

The current lack of certainty is further complicated by questions that have been raised about statutory presumptions. It might be thought that Telstra would have been able to rely on presumptions of subsistence and ownership that had been introduced into the *Copyright Act* to simplify the conduct of copyright proceedings.⁶⁸ A rebuttable presumption of authorship exists where the author's name (including a nickname) – or the name of an author of jointly authored material – appears on the published version of the literary work.⁶⁹ Several additional statutory presumptions operate in particular circumstances where this does not apply. For example, section 128 provides a rebuttable presumption of subsistence with respect to a literary work published in Australia within the 70 years prior to the year an action is commenced if a name purporting to be that of the publisher appeared on copies of the work as first published. Meanwhile, section 129 gives rise to a presumption of originality and the

66 *Headlines* (2010) 189 FCR 109, 130–1 (Bennett J). This was despite a situation in which – whether written individually by a journalist or subeditor, or collaboratively by a combination of these – any copyright would have been owned by Fairfax, as the employer of all those people:

the evidence adduced by Fairfax does not identify the authors of the ten selected headlines, or of the headlines in the sample editions. The presumption of originality by reason of s 129 is not available. It is Fairfax's own submission that headlines, which are generally written by sub-editors, often derive in one way or another from the content of the body of the article, which is written by the journalists. Therefore, the authorship of the ten selected headlines cannot be assumed in the absence of specific evidence. A headline that does no more than repeat a phrase from the article is not an original literary work.

67 (2011) 196 FCR 1. 'It is not the case that each and every author must be individually identified for there to be a work of joint authorship': at 106. This case was appealed to the Full Court of the Federal Court, and a special leave application was made to the High Court. However, the question of copyright subsistence was not in issue on appeal.

68 See *Copyright Act* s 126:

In an action brought by virtue of this Part: (a) copyright shall be presumed to subsist in the work or other subject-matter to which the action relates if the defendant does not put in issue the question whether copyright subsists in the work or other subject-matter; and (b) where the subsistence of the copyright is established--the plaintiff shall be presumed to be the owner of the copyright if he or she claims to be the owner of the copyright and the defendant does not put in issue the question of his or her ownership.

69 *Copyright Act* ss 127(1)–(2).

location of first publication in the case of a work that has been authored anonymously or pseudonymously.

Telstra did seek to rely on the section 128 presumption with respect to phone directories that had been created by Telstra's workers and published in Australia. In so doing, it hoped to avoid having to nominate individual joint authors and their contributions. However, Gordon J found that the presumptions were unhelpful in a situation in which an issue in question was the identity of the author(s). Her Honour held that Telstra's strategy 'falls between two stools – it seeks to rely upon evidence to establish the subsistence of copyright to a point and then when it gets too difficult (legally or factually) they resort to the presumptions'.⁷⁰ Telstra also raised the section 129 presumption concerning anonymous and pseudonymous works. However, as the works were neither anonymous nor pseudonymous – Telstra had simply failed to identify the individual authors, although it had placed evidence of authorship before the court – Gordon J rejected the arguments.

This approach has been strongly criticised by some legal commentators who suggest that her Honour erred in the application of this area of copyright law.⁷¹ Regardless of whether the Court applied the law correctly or not in this case, there is arguably a case for parliamentary intervention to eliminate the resulting confusion, to clarify the scope of the statutory presumptions, and to avoid future misunderstandings.

Luke Pallaras has suggested that a feasible solution would be to introduce a United States ('US') style 'work for hire' doctrine in relation to the section 128 and 129 presumptions. This would cover situations in which authorship is undertaken by workers and results in ownership vesting in the employer. Pallaras's claim that '[s]uch an amendment would maintain the "centrality" of the author, while also providing much needed certainty to those whose investments are tied up in vast collaborative works' seems sound.⁷² It would also address Peter Knight's concern about the arguably erroneous approach to the

⁷⁰ *Phone Directories* (2010) 264 ALR 617, 631.

⁷¹ See, eg, Knight, above n 45. '[I]t is respectfully submitted that the court in the *Phone Directories* case erred in respect of the presumptions ... There is no basis for the conclusion that the presumptions cease to operate when evidence of authorship is before the court': at 129. See also Luke Pallaras, 'Falling Between Two Stools: Presumptions under the *Copyright Act 1968* (Cth)' (2010) 21 *Australian Intellectual Property Journal* 100, 113, referring to 'Justice Gordon's tortuous reading of ss 128 and 129, which refuses to draw the reasonable inference of the existence of an author'.

⁷² Pallaras, above n 71, 114.

presumptions applied in *Phone Directories*, which he says fail to accord with legislative policy.⁷³

In the absence of reform in the nature proposed by Pallaras, it would arguably be sensible for Parliament to at least clarify the situations in which the existing presumptions do and do not apply.

B Headlines: Identifying the Independent Contributions of Joint Authors

Continuing to apply principles set down in *IceTV*, the next case in the literary works evolution addressed questions of authorship and originality in newspaper headlines.

In *Headlines*, newspaper publisher Fairfax claimed that Reed had infringed its copyright by providing abstracts of newspaper articles to subscribers. The material that Fairfax claimed was infringed included headlines of newspaper articles.

Justice Bennett identified problems with Fairfax's claim to 'literary work' copyright in its headlines, including that the author(s) of the headlines had not been identified.⁷⁴ The evidence given by Fairfax did not delineate independent contributions made by identified journalists and/or subeditors. Adopting the reasoning used by Gordon J in *Phone Directories* (which had not been departed

73 See Knight, above n 45, 128–9:

Her Honour concludes that the presumption afforded by s 128 has no application at all where 'the very fact of authorship is in dispute'. Yet there is simply no justification in s 128 for this conclusion. Even acknowledging that the language of the Act is not precise, this does not justify substituting for it some entirely different proposition. ... The interpretation of s 128 by her Honour does not accord at all with the policy of the legislators with respect to these presumptions.

74 *Headlines* [2010] FCA 984, [84].

from by the appellate court in that case), neither authorship nor joint authorship⁷⁵ was thus demonstrated.⁷⁶ No appeal was pursued in relation to this decision.

The requirement that the authors of each original contribution be identified seems unnecessarily burdensome on plaintiffs who can demonstrate that they would be the owner of copyright because, for example, the work was authored by one or more of their employees who had assigned copyright in a contract of employment. It also seems to impose onerous record keeping requirements on businesses that produce collaboratively authored works, and it may raise privacy concerns in some instances.⁷⁷

Some considerations that might be addressed if considering reform to this area of law include:

1 Record Keeping Requirements

Judicial disagreement about the authorship threshold causes commercial uncertainty for businesses that have previously created supposed copyright protected works whose subsistence may now be in doubt. Unless suitable records were kept at the time the work was made, it might now be impossible to identify the individual authors, and it may therefore be impossible to demonstrate

75 In this case, an issue before the court was whether a discrete work was formed by the combination of the news article, its headline and by-line: *Headlines* (2010) 189 FCR 109, 124 (Bennett J). The trial judge accepted Reed's argument that because 'the writing of articles and the writing of headlines are separate and distinct tasks with different authors', they were not works of joint authorship: at 134 (Bennett J).

76 Although less pertinent to the discussion in this article, the judicial application of the *IceTV* principles was also interesting from a second perspective. Justice Bennett found that, even had the author of the headlines been adequately identified, the headlines would have been too insubstantial to attract copyright under the *de minimus* principle: *ibid* 120–2. It is interesting to compare *Headlines* with the August 2011 decision of the UK High Court in *Meltwater Holdings BV v Newspaper Licensing Agency* [2011] EWCA Civ 890, which found that copyright subsisted in headlines in that jurisdiction. This finding was upheld by the Court of Appeal, and again on appeal to the Supreme Court of the UK. The trial judge, Proudman J, had been bound to apply the reasoning of the Court of Justice of the European Union in *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) [2009] ECR I-6569, which had found copyright subsistence where eleven word fragments of newspaper articles had demonstrated the author's intellectual creation. Her Honour discussed the relevance of *Headlines*, in which Bennett J left open the possibility that an individual headline could give rise to copyright subsistence in different circumstances:

In my view, to afford published headlines, as a class, copyright protection as literary works would tip the balance too far against the interest of the public in the freedom to refer or be referred to articles by their headlines. This does not exclude the possibility of establishing a basis for copyright protection of an individual headline but Fairfax has failed to prove that the ten selected headlines amount to literary works in which copyright can subsist: *Headlines* (2010) 189 FCR 109, 124.

For a discussion of the relationship between the Australian and UK lines of jurisprudence, see Justine Pila, 'An Australian Copyright Revolution and Its Relevance for UK Jurisprudence: *IceTV* in the Light of *Infopaq v Danske*' (2010) 10 *Oxford University Commonwealth Law Journal* 77.

77 Elizabeth Adeney, 'Representative Actions, Proof of Fact and Author Privacy in Copyright Law: A History and a Concern' (2013) 39 *Monash University Law Review* 106.

subsistence. Meanwhile, lawyers are advising their clients to keep detailed records to help forestall future problems.⁷⁸

If, in due course, it were to be decided by the Full Court of the Federal Court or the High Court that all authors do individually need to be identified, this could also create an impractical administrative burden for those wishing to claim copyright in collaboratively authored works. The potential difficulties are hinted at in *Headlines*, where the respondent submitted ‘the proper way [to prove authorship] would have been for the relevant authors of the headlines in the June edition to make affidavits, soon after the edition was published, detailing the work they in fact did’.⁷⁹ From a purely legal perspective, this may make sense. However, it seems unrealistic in a real world context where news articles are written to tight deadlines by employees in various roles contributing parts of a story. It seems unrealistic when employees in diverse types of businesses cope with heavy workloads or difficult workplaces, are not always as careful at keeping records as might be ideal, or are not as precise in their details as might ultimately be needed (as legal requirements may change over time, what is adequate for evidentiary purposes at one point in time may not be so several decades later).

A difficulty could also arise because many creators of literary works are unaware of the vagaries of copyright law. Many copyright issues arise when creators have not been cognisant of the law before a dispute develops. In cases in which creators have not been aware of the requirement to prove authorship, or of what is needed to be able to prove authorship, the tightening of subsistence criteria relating to authorship could result in subsistence not being demonstrated even when literary output has clearly been created, has been published in Australia within the copyright term, and would be owned by the plaintiff due to its employment of the original author(s). Despite the literary object’s existence, subsistence could be denied due to poor record keeping. Perhaps those most likely to suffer injustice as a result of the strict application of a requirement to identify all who contribute to making a literary work would be those creators who are the least educated and/or the least able to access legal advice, and thus the least able to take steps to protect their potential intellectual property.

78 See, eg, Joy Atacador and Claire Ramsay, *Six Steps to Strategic Enforcement of IP Rights in Australia* (3 June 2010) Davies Collison Cave <<http://www.davies.com.au/pub/detail/134/six-steps-to-strategic-enforcement-of-ip-rights-in-australia>>; Ally Akbarzadeh, *The Federal Court Ushers Newspapers into the IceTV Age* (8 December 2010) Davies Collison Cave <<http://www.davies.com.au/pub/detail/353/the-federal-court-ushers-newspapers-into-the-em-icetv-em-age>>; Sue Gilchrist and Philippa Bergin, *Telstra Appeal Loss over Copyright May Affect Many Businesses* (16 December 2010) Herbert Smith Freehills <<http://www.herbertsmithfreehills.com/-/media/Freehills/Telstra%20appeal%20loss%20over%20copyright%20may.PDF>>; Clayton Utz, *Goodbye to Copyright for Databases? Federal Court Finds No Copyright in Phone Directories* (11 February 2010) <http://www.claytonutz.com/publications/news/200904/22/copyright_in_compilations_under_the_spotlight_in_high_court.page>.

79 (2010) 189 FCR 109, 128 (Bennett J).

In this context, it seems unwieldy to require that evidence be provided of the contributions of all joint authors to a purported literary work.

2 *Duration*

Complicating the practical difficulties, the requirement to prove the personal identity of all joint authors seems even more unworkable in light of the 'life of the author plus 70 years' term that applies to literary works under Australian copyright law.

A few months or years after a work is created, it may still be possible to track down those who collaborated on the joint authorship of a literary output. As time passes and employees' recollections fade, and as people move jobs, retire and die, 'institutional memory' dissipates and the likelihood of obtaining affidavits to prove the various contributions of various joint authors seems increasingly remote. If an infringement action were to be brought, say, 50 years after a work was created, it might be impossible to gather evidence to prove different authors' contributions. The purported copyright holder may once have expected to be able to rely on the presumption attaching to anonymous works in such circumstances. However, authority in *Headlines* puts in doubt the availability of this presumption in conditions where the identity *could* have been demonstrated. On that view, if a person claiming copyright could have – but did not – put the identity of the authors into evidence, the person cannot profit from this omission.

The question would arise as to whether the omission to maintain adequate records when the work was made would be sufficient to deprive an employer of copyright in that material. To do so could produce harsh outcomes, but to allow reliance on the presumption of anonymity in such circumstances would be inconsistent with the refusal in *Phone Directories* to allow reliance on the presumption of anonymity where an employer failed to put in evidence which of its 'anonymous' employees had authored the work.

3 *Globalisation*

In a world that is ever more globalised, these sorts of issues seem destined to become even more complex. Many businesses that rely on copyright law to protect their literary output – such as publishers, news organisations and software companies – produce works that are jointly authored by their employees and contractors. Those people may work together in the same office in Australia, or they may be scattered around the world, working remotely but collaboratively via international communications technologies. For example, it is not unusual for an Australian author to publish a book through the New York office of a United Kingdom ('UK') headquartered publisher whose production work is carried out in India. It is not unusual for a news organisation to have a reporter in Australia write a story that is subedited at a news desk in Hong Kong and is published simultaneously in various jurisdictions by the UK or US corporate group that employed all the people who collaborated on producing the work.

Where it can be demonstrated that the operation of law and/or the contractual relationships between a company and its workers would result in the company holding copyright in literary works produced by those workers, perhaps this

should be sufficient to demonstrate that the company is entitled to hold copyright by virtue of its relationship with the work's authors – whoever those people may be.

In light of these considerations, a strong case could arguably be made that a subsistence threshold requiring that all joint authors be individually identified would be unnecessarily onerous. Proving each author's identity and contribution seems to be an unnecessary hurdle to place in the way of copyright subsistence in circumstances in which it is undisputed that the work – where it is found to meet other subsistence requirements – would be owned by the plaintiff. It is likely to produce a situation whereby some people will be deprived of copyright in what would otherwise be literary works to which they were *prima facie* entitled.

In any event, clarification of the law's requirements is called for. Even if policy makers were to disagree with the reasoning above and decide that all authors and their contributions should be individually identified, clarity about the requirement would arguably be preferable to the uncertainty that currently prevails.

C Authorship in Databases: *Tonnex*

Tonnex illustrates the continuing difficulty surrounding the protection of databases. That is, since *IceTV* shifted emphasis to the originality of the particular form of expression required in a compilation, it can be difficult to predict whether or not a particular database will meet the authorship threshold required for copyright subsistence.⁸⁰

The *Tonnex* case concerned allegations of infringement of a compilation of information made by Dynamic showing the compatibility of printers and computer consumables. Trade rival Tonnex produced its own compatibility chart, which Dynamic alleged was partly copied from the compilation made by its employee. The focus of the case was therefore on the authorship and originality of Dynamic's 'compatibility chart'.

Justice Yates found that an identifiable employee of Dynamic, Mark Campbell, had invested intellectual effort, skill and labour selecting particular information from a product database and arranging it to create the compatibility chart. Justice Yates held that Campbell's creative arrangement of the information constituted authorship, thus giving rise to copyright subsistence. His Honour also found an 'overall and compelling picture' of Tonnex having copied Dynamic's chart indicating the compatibility of printer supplies.⁸¹

80 The practitioner perspective found in Clayton Utz, *Copyright in Compilations under the Spotlight in High Court* (22 April 2009) <http://www.claytonutz.com.au/publications/news/200904/22/copyright_in_compilations_under_the_spotlight_in_high_court.page>, illustrates the difficulties. The firm informs clients that the High Court had 'suggested, without deciding, that some databases might not even meet the basic requirements for copyright protection, particularly that of authorship'.

81 *Tonnex* [2011] FCA 362, [133].

As to originality, Yates J found that the chart – as distinct from the information it contained – was original due to Campbell's authorial input.⁸² Evidence was presented that other compatibility sheets were laid out differently, indicating that the nature of the information compiled by Campbell did not dictate the form in which it was expressed in his compatibility chart. In this respect, *IceTV* (where it had been found the layout of the television guides was constrained by the limited number of ways of expressing time and date information for television programming) could be distinguished on the facts.

This decision was affirmed on appeal. The Full Court (McKerracher, Reeves and Nicholas JJ) delivered its judgment in late 2012, unanimously upholding Justice Yates's findings.⁸³

Tonnex demonstrates how *IceTV* principles may be applied to protect certain types of compilations, albeit a more limited range than may previously have been possible. *Tonnex* offers guidance as to the type and degree of such effort that will be adequate to establish subsistence in a compilation as a literary work: where it can be demonstrated that considered intellectual effort had been expended in selecting and arranging factual information in databases, this might amount to 'authorship'. The threshold for deciding whether sufficient human intellectual effort had occurred would be met when a human author had thoughtfully selected and arranged the material. It would not be met where that information had merely been copied from one database into another compilation. *Tonnex* thus provides welcome assistance as to how to assess these standards on a case by case basis, but in doing so it implicitly reinforces the view that some databases will now fail to meet the authorship–originality requirements for copyright subsistence.

Prior to *IceTV*, it was widely assumed that databases were protected in Australia as compilation literary works.⁸⁴ Post-*IceTV*, the degree of protection afforded to databases has been greatly diminished.⁸⁵ Michael Bradley and

82 Ibid [76]–[77]. Justice Yates stated:

Although the information in the file dealt with known facts about known products, it represented a collection of information brought together in a particular convenient arrangement by Mr Campbell that was designed to facilitate the searching and cross-referencing of information relating to a particular universe of products (namely, printer and computer consumables supplied by Dynamic). Although the selection of information was from a single source (namely, from the Navision database), I am satisfied that skill and judgment – intellectual effort – was brought to bear by Mr Campbell in making the selections he did.

83 *Tonnex International Pty Ltd v Dynamic Supplies Pty Ltd* [2012] FCAFC 162.

84 Michael Williams and Claire Bothwell, *Confidentiality: Surviving the Ice Age* (10 October 2010) Managing Intellectual Property <<http://www.managingip.com/Article/2677342/CONFIDENTIALITY-Surviving-the-Ice-age.html>>.

85 For discussions on this effect of *IceTV*, see McCutcheon, above n 45; Pila, above n 42; Andrews, above n 46; David Lindsay, 'Protection of Compilations and Databases after *IceTV*: Authorship, Originality and the Transformation of Australian Copyright Law' (2012) 38 *Monash University Law Review* 17; McGowan, above n 42. For a discussion of the pre-*Desktop Marketing* position, see Ann Monotti, 'Copyright Protection of Computerised Databases' (1992) 3 *Australian Intellectual Property Journal* 135.

Hannah Marshall succinctly summarised the commercial difficulty with the current position:

Often a lot of work goes into gathering information for a database. It's a problem if you can't stop people copying it just because you use a computer to compile it and give you the end product. The [*Phone Directories*] case highlights the schism between what's legal and what's commercial. It's crazy if you can't protect the product of your business's efforts in preparing a database or compilation. But the courts can only work with the legislation that's before them. That means it's up to parliament to save us now.⁸⁶

In light of such criticisms, a comprehensive review of Australian copyright law might usefully include a re-examination of this issue.

The issue of database copyright is complex and has been subjected to detailed examination.⁸⁷ Rather than reproducing arguments made elsewhere, the following points outline options that could be relevant to a review of database copyright in an Australian context. Possibilities include:

1 *Minimal Protection for Databases*

Australia is obliged by international treaty obligations to extend copyright protection to 'compilations of data or other material ... which by reason of the selection or arrangement of their contents constitute intellectual creations'.⁸⁸ It currently does so through the inclusion of 'compilations' in the *Copyright Act*'s statutory definition of 'literary work'.

While such an approach offers somewhat marginal and unpredictable protection to databases, this may be justified in the interests of preserving the idea-expression dichotomy. Explaining such a position, Sandra Gosnell has argued:

Preserving the time, labour and expense involved in collecting data for a compilation effectively extends protection to the data itself, where there is only a

86 See, eg, Michael Bradley and Hannah Marshall, *High Court Shoots Down Telstra's Copyright Claim* (23 September 2011) Marque Lawyers <http://www.marquelawyers.com.au/assets/marque-telstra-copyright-update_sept-2011.pdf>.

87 For a more detailed analysis of options, see Jani McCutcheon, 'Curing the Authorless Void: Protecting Computer-Generated Works Following *IceTV* and *Phone Directories*' (2013) 37 *Melbourne University Law Review* 46.

88 This wording is found in *TRIPS* art 10(2):

Compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself.

The wording is also found in the *WIPO Copyright Treaty*, opened for signature 20 December 1996, 2186 UNTS 121 (entered into force 6 March 2002) art 5 (citations omitted):

Compilations of data or other material, in any form, which by reason of the selection or arrangement of their contents constitute intellectual creations, are protected as such. This protection does not extend to the data or the material itself and is without prejudice to any copyright subsisting in the data or material contained in the compilation.

limited number of ways in which facts and information can be expressed in a table or compilation form.⁸⁹

Consideration of these issues in a systematic, objective policy review of copyright law could give rise to legislative provisions that expressly set out statutory requirements for any copyright subsistence to be afforded to databases under Australian law. This would arguably be preferable to the piecemeal development of this area of law that has arisen since the discussion of infringement of compilations in *IceTV*.

If Parliament were to adopt an intellectual property minimalist position, it may choose reforms that specify – in accordance with post-*IceTV* jurisprudence – that databases are to continue to be protected by Australian copyright law only where compiled in a particularly original manner. It may also decide that database copyright would have a far shorter duration than databases would currently enjoy as literary works. While this would disappoint some commercial interests, it would at least allow businesses to make plans and decisions based on an understanding of the law that will lead to more predictable outcomes.

By contrast, if lawmakers wish to adopt a more maximalist approach, the Australian Parliament could include database rights in part IV of the *Copyright Act* or introduce a sui generis law that provides for term limited protection for databases, including those compiled by computers.

2 Databases as Part IV ‘Subject Matter Other Than Works’

Perhaps the ‘literary works’ category in part III of the *Copyright Act* is not a natural home for databases and other compilations of information (as opposed to the sorts of compilations, like mashups and remixes, which recompile others’ expressive material in new material forms). Perhaps it is also artificial and impractical to try to squeeze computer programs within the current definition of ‘literary works’.⁹⁰ Perhaps a rethink of this structure is in order.

Various alternatives would arguably produce a more nuanced and effective outcome. One option would be to move databases to part IV of the *Copyright Act*. Copyright subsists in part IV works such as published editions (with which analogies to databases could be drawn) and broadcasts, which would not have attracted literary work copyright. It is not impossible to envisage the inclusion of databases in part IV, where provisions could be designed specifically with respect to the protection of databases. Like other part IV copyright material,

⁸⁹ Gosnell, above n 31, 645.

⁹⁰ While *TRIPS* art 10(1) specifies that computer programs are to be protected as literary works – ‘Computer programs, whether in source or object code, shall be protected as literary works under the *Berne Convention* (1971)’ – Member States have some flexibility about how to implement this. Delineating discrete subcategories of ‘literary works’ in the statute may be a method by which the *TRIPS* requirement could be better reconciled with the construction of literary works being developed by Australian courts.

databases could be awarded shorter copyright duration than literary works, and tailored thresholds could be established for their subsistence.

Establishing databases as ‘subject matter other than works’ in their own right might produce a workable resolution to the criticisms that have been raised.

3 *Sui Generis Database Law*

Mark Davison has argued that several features of copyright law – including its duration, its rights, its infringement test, its exceptions from infringement, and compulsory licensing issues⁹¹ – are inappropriate in the context of databases.⁹² If a formal review of copyright law were to agree with this conclusion, an alternative solution – one alluded to by the High Court in *IceTV*,⁹³ and by both the trial judge⁹⁴ and Full Court⁹⁵ in *Phone Directories* – might be to introduce a sui generis law to protect the investment behind the creation of a database. This would be in line with the approach taken by the European Union, which has also been incorporated into UK law (which has a similar copyright framework to Australia).

The 1996 *Directive of the European Parliament and of the Council on the Protection of Databases* protects the ‘substantial investment’ of a human or computer database maker in the European Union.⁹⁶ This was included in UK

91 Mark J Davison, ‘Sui Generis or Too Generous: Legislative Protection of Databases, Its Implications for Australia and Some Suggestions for Reform’ (1998) 21 *University of New South Wales Law Journal* 729, 749.

92 See *ibid* 748, where Davison argues that:

the line between obtaining copyright protection and failing to obtain it at all is a fine one in that it is difficult to detect if and when a database is subject to copyright and, when it is, what is the scope of that protection. ... Consequently, the best way to proceed may be to excise all databases from copyright protection altogether and provide sui generis protection for them in circumstances where a substantial investment has been made in their creation.

93 (2009) 239 CLR 458. ‘In the absence of implementation of laws analogous to the kind described in the Directive, the matters now in issue cannot be resolved by concluding, as did the Full Court (180) that Ice appropriated “the fruits of Nine’s skill and labour”’: at 504 (Gummow, Hayne and Heydon JJ).

94 *Phone Directories* (2010) 264 ALR 617, 628 (Gordon J):

As the High Court observes, there is no counterpart [to a sui generis database right] in Australian law. It is not open to me to ignore the express words of the *Copyright Act* to expand protection consistent with that set out in the Directive as summarised by the High Court. That is a matter for Parliament and, in my view, a matter which they should address without delay.

95 *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* (2010) 194 FCR 142, 171–2 (Keane CJ): In *IceTV* the High Court recognised, at [52] and [135]–[139], that this focus may give rise to a perception of injustice on the part of those whose skill and labour has been appropriated. Whether or not that means that legislative reform of the kind adopted in the European Union by the Directive of the European Parliament and of the Council on the Legal Protection of Databases is warranted is a matter for the legislature. This court can give effect to the statutory monopoly conferred by the Act only in conformity with the terms of the Act.

96 *Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases* [1996] OJ L 77/20.

law through the *Copyright and Rights in Databases Regulations 1997*,⁹⁷ which amended the *Copyright Designs and Patents Act 1988* (UK) c 48 to provide for a 15-year database right. It protects the 'substantial investment in obtaining, verifying or presenting the contents of' an original database (as opposed to the material contained in the database, which may itself be separately covered by copyright).⁹⁸

Proposals for sui generis database laws are not without their critics.⁹⁹ The European legal framework concerning databases has drawn significant criticism,¹⁰⁰ and its scope has been narrowed by decisions of the European Court of Justice ('ECJ').¹⁰¹ Problems experienced abroad should be taken into careful consideration if a law reform process were to recommend a sui generis database law suited to Australian conditions.

Would the introduction of distinct database rights be advisable? Such measures would probably produce more sophisticated outcomes than can be obtained by trying to define such material as 'literary works'. However, policy decisions about the scope of such rights could prove contentious. Copyright minimalists would no doubt oppose the creation of yet another branch of Australian intellectual property law. And maximalists may disagree over the

97 (UK) SI 1997/3032.

98 *Copyright and Rights in Databases Regulations 1997* (UK) SI 1997/3032 c 48, r 13.

99 See, eg, Knight, above n 45. The 'siren call [of sui generis database rights] should not be heeded. The creation of sui generis legislation ... has tended to have but two results: to deepen confusion and to disadvantage copyright owners': at 133.

100 The European Commission itself evaluated the degree to which the Database Directive has been successful in meeting its policy objectives in providing harmonised legal protection for a wide range of databases throughout Europe. See Commission of the European Communities, 'DG Internal Market and Services Working Paper: First Evaluation of Directive 96/9/EC on the Legal Protection of Databases' (Working Paper, 12 December 2005) <http://ec.europa.eu/internal_market/copyright/docs/databases/evaluation_report_en.pdf>. The report identified difficulties in the operation of the law and questioned the economic value of the sui generis right. It proposed several policy options: repeal the Database Directive, repeal or amend the sui generis right, or maintain the status quo. For analysis and critique of the European Database Directive, see also Daniel J Gervais, 'The Protection of Databases' (2007) 82 *Chicago-Kent Law Review* 1109; Miriam Bitton, 'Exploring European Union Copyright Policy through the Lens of the Database Directive' (2008) 23 *Berkeley Technology Law Journal* 1411; Andrea Annamaria Chis, 'Protection of Databases – The Sui Generis Right' (2009) 3 *SUBB Iurisprudentia* 61; Philip J Cardinale, 'Sui Generis Database Protection: Second Thoughts in the European Union and What It Means for the United States' (2007) 6 *Chicago-Kent Journal of Intellectual Property* 157; Deepu Jacob Thomas and Prasan Dhar, 'Of Square Pegs and Round Holes: Towards a New Paradigm of Database Protection' (2008) 4 *Indian Journal of Law and Technology* 34; John Edwards, 'Has the Dreaded Data Doomsday Arrived?: Past, Present and Future Effects of the European Union's Database Directive on Database and Information Availability in the European Union' (2004) 39 *Georgia Law Review* 215.

101 Four Court of Justice of the European Union cases in November 2004 significantly narrowed the scope of protection afforded to databases that lack authorial originality: *Fixtures Marketing Ltd v Oy Veikkaus Ab* (C-46/02) [2004] ECR I-10396; *The British Horseracing Board and Others v William Hill Organisation Ltd* (C-203/02) [2004] ECR I-10461; *Fixtures Marketing Limited v Svenska Spel Ab* (C-338/02) [2004] ECR I-10532; *Fixtures Marketing Ltd v Organismos Prognostikon Agonon Podosfairou AE (OPAP)* (C-444/02) [2004] ECR I-10590.

scope of the proposed laws. For example, would database rights cover the factual content of the compilation? Or would they only cover the arrangement of the data? And, how long should such rights last? These would be questions that could be debated through law reform processes, and then addressed directly – whether in part IV, in a *sui generis* provision developed specifically to protect databases, or via some other approach.

A key benefit of including database copyright in a comprehensive review of Australian copyright law and policy may be that a variety of opinions could systematically be sought, considered and debated, with the prospect of designing bespoke database law for an Australian context. With large dataset collections (known as ‘big data’) increasingly central to many businesses, this would offer greater clarity and predictability in the operation of Australian database law. In a rapidly changing digital environment, such a development would arguably be preferable to an evolving position reached incrementally as contentious cases gradually reach the courts and legal principles are refined over time.

D Authorship in Computer Generated Works: *Acohs*

Acohs illustrates a fourth area of continuing uncertainty – proof of authorship and originality in computer generated works.

The case involved a claim of copyright infringement of documents and a database created by *Acohs*, where there was use of computers in the creation process. Both *Acohs* and *Ucorp* created documents known as Material Safety Data Sheets, which are legally required to be provided to those supplied with dangerous or hazardous substances in Australia. Both companies produced the documents on behalf of suppliers of such substances and provided electronic databases of such data sheets. *Acohs*’ database consisted of raw information about various substances that would then be collated by a computer to produce a data sheet when required. *Ucorp*’s database was comprised of pre-written data sheets. The dispute arose after an *Acohs* customer moved to *Ucorp*, which was subsequently accused of providing the customer with data sheets that had been created by *Acohs*.

The trial judge found that copying had occurred, but that copyright had not been infringed. Subsistence of copyright in the data sheets as literary works was a contentious issue in the case. *Acohs* had programmed a computer system to produce source code that could then be converted into data sheets. However, a

copyright subsistence problem arose as the sheets were computer generated rather than having been written by a human author,¹⁰² or joint authors.¹⁰³

On appeal, the Full Court (Jacobson, Nicholas and Yates JJ) upheld the trial judge's decisions on copyright subsistence matters. Ucorp sought special leave to appeal to the High Court but was refused in March 2013.

Acohs demonstrates how difficult it may be to establish subsistence in computer generated works in light of post-*IceTV* judicial interpretations of authorship requirements. In the absence of a statutory definition of 'author' with respect to such works, lawyers are advising clients that automating authorship may lead to the resulting material being denied copyright protection.¹⁰⁴ Given the prevalence of the use of computers in the creation process, there remains doubt about the extent to which a human creator will be denied recognition of authorship by using a computer in the creation process.

Protection of databases is difficult in any event; it is more problematic when a compilation has been computer generated.¹⁰⁵ As one law firm noted in a client bulletin: 'Due to the current state of the law, there is no clear way of protecting your computer generated compilations and databases'.¹⁰⁶ While this article has focused on 'literary works', the wider implications of such law for computer generated artistic works (such as maps and technical drawings) are potentially

102 Ibid [50] (Jessup J).

In short, the respective contributions of the programmers and the authors/transcribers to the source code for a particular [data sheet] were separate each from the other along the axes of communication, time, expertise and content. Only by a quite artificial straining of the language to meet the needs of *Acohs* in the present litigation might those contributions be regarded as a matter of collaboration in the statutory sense. I do not consider that the source code for any of the [data sheets] on which *Acohs* sues was a work of joint authorship: at 59.

103 The *Copyright Act* s 10(1) states: "work of joint authorship" means 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'. In *Acohs* [2010] FCA 577, [60], Jessup J stated '[s]ince the source code ... was not the work of any one human author, and was not a work of joint authorship, that code cannot be regarded as an original literary work within the meaning of the Copyright Act'.

104 Atacador and Ramsay, above n 78; Akbarzadeh, above n 78; Gilchrist and Bergin, above n 78; Clayton Utz, above n 78.

105 The problems associated with claiming copyright in computer generated works have been recognised for some time: see, eg, Pamela Samuelson, 'Allocating Ownership Rights in Computer-Generated Works' (1986) 47 *University of Pittsburgh Law Review* 1185; Christos P Badavas, 'MIDI Files: Copyright Protection for Computer-Generated Works' (1994) 35 *William and Mary Law Review* 1135; Darin Glasser, 'Copyrights In Computer-Generated Works: Whom, if Anyone, Do We Reward?' [2001] *Duke Law & Technology Review* <<http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1023&context=dltr>>. For a more detailed discussion of the Australian context, and for related law reform suggestions, see Jani McCutcheon, 'The Vanishing Author In Computer-Generated Works: A Critical Analysis of Recent Australian Case Law' (2013) 36 *Melbourne University Law Review* 915.

106 Rebecca Sandel and Michael Montgomery, *Databases and Compilations – Protecting Your Data* (1 August 2011) HWL Ebsworth Lawyers <<http://www.hwlebsworth.com.au/latest-news-a-publications/publications/intellectual-property-and-trade-marks/item/263-databases-and-compilations-protecting-your-data.html>>.

dramatic as well.¹⁰⁷ For businesses that invest in such products, the implications of the *IceTV* jurisprudence may be commercially devastating.

Computers now generate many works that would once have been compiled by human hands. Following the recent cases, these computer generated works may be denied copyright protection where the human contribution has been confined to inputting raw data rather than creatively producing the ‘material form’ in which that data subsequently appears.

The copyright problem lies in identifying the author of literary material that has been generated by a computer. While section 129A of the *Copyright Act* contains presumptions about the authorship of computer programs, the statute does not address directly the question of who is considered to be the author of material that those computer programs generate. By contrast, section 9(3) of the *Copyright, Designs and Patents Act 1988* (UK) states that, with respect to ‘a literary, dramatic, musical or artistic work which is computer generated, the author shall be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken’. In Australia, the issue is left to the common law.

The relevant question in such cases is whether the original literary work is itself the result of human skill and judgment directed at the expression of the idea.¹⁰⁸ If not – for example, if the relevant human effort was preparatory to the generation of the end product by a computer, as in *IceTV* and *Acohs* – literary copyright will not arise.

Thus, although the *Copyright Act* recognises copyright in compilations, and although the principle of joint authorship recognises that works can be authored collaboratively, the law has produced a situation in which a database might not qualify as a literary work because it is computer generated. This seems capricious in cases in which an identical object would qualify as a literary work if the work done by computers had instead been undertaken manually by humans.

Anne Fitzgerald and Tim Seidenspinner have mounted a strong criticism of the current position on additional grounds:

If copyright law is to continue to play a role in fostering the production of new creative and informational works, it must align with the realities of how materials are created and used in the digital environment. From this perspective, the exclusion of computer generated materials from copyright protection appears arbitrary and is difficult to justify. Not only does it deprive Australian creators of copyright protection for works that attract copyright protection under the copyright laws of Australia’s trading partners, but it discriminates against

¹⁰⁷ See, eg, Flahvin, above n 9.

¹⁰⁸ See also application of this principle by Stone J in *Primary Health Care Ltd v Federal Commissioner of Taxation* (2010) 186 FCR 301.

materials on the basis of their form of expression and the means used to produce them.¹⁰⁹

In light of such considerations, the issue of computer generated copyright would seem to be another appropriate target for attention during a comprehensive review of Australian copyright laws.

IV CONCLUDING COMMENTS

IceTV and subsequent cases have revised the threshold that creators must meet to establish copyright subsistence in literary works. In addition to requiring more detailed information before authorship will be recognised, the courts have made it more difficult to establish copyright subsistence in compilations, particularly when they have been created collaboratively or have been computer generated. This creates significant uncertainty as to when copyright is and is not likely to be found to subsist. Legislative clarification of these points could address these problems.

Recent cases have raised questions about the identity of the author of a literary work that might previously have been taken for granted. In a shift from earlier interpretations of copyright law's requirements, they demand consideration of whether it is necessary to identify every author who contributed to the creation of the material form.¹¹⁰ If so, what are the implications for proving authorship of collaborative works? Must the authors be human? Must *all* the authors be human? And what does this mean for databases and computer generated works?

These are important issues in a society in which the creation of written material is frequently collaborative in nature and is increasingly generated by computers. They are issues with significant commercial implications – especially in the era of ‘big data’, where the product may be a function of the work of many authors using computers in a collaborative way – and with respect to which legislative clarification may be advisable in forthcoming copyright law reform activity.

109 Anne Fitzgerald and Tim Seidenspinner, ‘Copyright and Computer-Generated Materials – Is it Time to Reboot the Discussion about Authorship?’ (2013) 3 *Victoria University Law and Justice Journal* 47, 63–4 (citations omitted).

110 Interestingly, these questions echo questions asked by the trial judge in *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* (2001) 181 ALR 134, long before the current uncertainty arose.

Although these issues were not in contention in that case, Finkelstein J had observed:

There are literally hundreds of appropriately trained or qualified employees who make some contribution towards the production of a telephone directory. When the nature of the work they do is described, there arise three relevant questions to the subsistence of copyright: (a) Must a copyright work have an author? (b) Does a telephone directory have an author? (c) Is every employee who contributes to the final product a joint author of the directory? These are difficult questions for which there are no ready answers: at 1.

As Anne Flahvin observes: 'In many cases, compilations, which have cost millions of dollars to create, have been left without protection'.¹¹¹ The implications are obvious for the value of businesses (and their share prices, and investors) whose commercial activities involve the compilation of databases. When such concerns can result in industry groups placing pressure on the government to enact legislative amendments,¹¹² it is surely preferable for any revision of the copyright statute to emerge from a transparent law reform process that encourages input from all interested parties.

Businesses relying on obtaining factual data from secondary sources, such as websites and other databases, to repackaging in new formats, may also feel insecure about the current state of the law.¹¹³ In the post-*IceTV* era, it is arguably less easy to predict whether something in which someone invested creative input might be covered by copyright.¹¹⁴ With the increased authorship standards that have to be met to establish subsistence in literary works post-*IceTV*, but little way – other than through litigation – of a third-party discovering whether those standards have been met, businesses are advised to remain very cautious about using information from others' databases or compilations without a license.¹¹⁵ The result can be a 'chilling effect', whereby people are too wary or scared to act

111 Flahvin, above n 9.

112 There is plenty of evidence of industry groups lobbying government on copyright issues. For example, in a recent radio interview, the Attorney-General agreed with the interviewer that his office is incessantly lobbied by the creative industries about copyright issues (in that context, internet piracy): Byner, above n 3. In an address to the Australian Digital Alliance, the Attorney-General reiterated this point: 'Some stakeholders have sought the introduction of laws aimed squarely at the scourge of online piracy' and indicated interest in 'examining new measures that will cut rates of online piracy in Australia': Brandis, above n 1. With respect to authorship of computer generated works, practitioners Sue Gilchrist and Philippa Bergin, above n 78, have also highlighted the likelihood of industry lobbying and the call for parliamentary reform:

This full court judgment in *Telstra v Phone Directories* hinges on the precise wording of the legislation which requires a human author of the copyright work. Given this, it is likely that the Federal Government will now come under additional pressure from lobby and industry groups to amend the Copyright Act to remedy this perceived deficiency in the Act. The trial judge in *Telstra v Phone Directories* called for Parliament to address the issue of database protection 'without delay'.

113 BRR Media, Interview with Wayne Condon, Principal & National Practice Leader, Griffith Hack IP Law Group (Radio Interview, 27 April 2009) <<http://www.brr.com.au/event/57209/icetv-high-court-victory>>.

114 Practical difficulties raised by this uncertainty are illustrated by the analysis offered by Amanda Andreazza:

For organisations that wish to make use of existing compilations the *IceTV* case is good news. However, care should be taken in relying on this decision for all future reproductions of the facts contained in organisations' compilations as *IceTV* does not provide a complete answer to a number of relevant questions. Most importantly, while the court seemed to signal a shift more towards the US position on originality which requires some kind of creative spark, the court in *IceTV* left open the question of what level of creativity, if any, is required for a factual compilation to be sufficiently original for copyright purposes: Amanda Andreazza, *The Latest Word on Copyright in Factual Compilations* (30 June 2009) Arts Law Centre of Australia <<http://www.artslaw.com.au/articles/entry/the-latest-word-on-copyright-in-factual-compilations/-sthash.LdUsOymL.dpuf>>.

115 Ibid.

for fear of being sued in an uncertain environment. Viewed in this way, the *IceTV* line of jurisprudence has done little to wind back the scope of copyright in a way that is useful to those who would like to utilise greater access to others' compilations and databases.

Given the Attorney-General's commitment to comprehensive improvement in this area of law,¹¹⁶ it is to be hoped that 'authorship' and 'originality' will be amongst the issues to be addressed in the forthcoming process of 'reform and modernisation of Australia's copyright law'.¹¹⁷

116 Brandis, above n 1.

117 Attorney-General George Brandis, 'Address to the Australian Directors Guild Conference' (Speech delivered at the Australian Directors Guild Conference, 7 November 2013) <<http://www.attorneygeneral.gov.au/Speeches/Pages/7November2013-AddresstotheAustralianDirectorsGuildConference.aspx>>.