An Australian Copyright Revolution and its Relevance for UK Jurisprudence: IceTV in the light of Infopaq v Danske

Justine Pila, University of Oxford

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1. Introduction

In April 2009, the scope of copyright protection conferred by Australian law was significantly restricted by the decision of the High Court of Australia in *IceTV Pty v Nine Network Pty Ltd.* Relying heavily on English jurisprudence, the Court redefined two central concepts of Anglo-Australian copyright legislation—‘originality’ and ‘substantial part’—neither of which has extensive High Court jurisprudence. The centrality of the first of these

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* University Lecturer in Intellectual Property Law, University of Oxford; Official Fellow and Senior Law Tutor, St Catherine’s College, Oxford.

1 [2009] HCA 14 (*IceTV*). For evidence of the revolutionary effect of the High Court’s decision see the cases cited in n 50.

2 The most important High Court cases on those concepts have been *Robinson v Sands & McDougall Pty Ltd* (1916) 22 CLR 124; *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49; *Blackie & Sons Ltd v The Lothian Book Publishing Co Pty Ltd* (1921) 29
An Australian Copyright Revoluation and its Relevance for UK Jurisprudence: IceTV in the light of Infopaq v Danske

concepts derives from the restriction of literary, dramatic, musical and artistic (‘LDMA’) copyright subsistence to original LDMA works.\(^3\) The centrality of the second derives from the restriction of the rights in all copyright works to their exercise in respect of the whole, or a \textit{substantial part}, of the work.\(^4\)

At the time of the decision in \textit{IceTV}, EU and UK copyright law seemed on the brink of a corresponding revolution. The reason was the opinion of the European Court of Justice (‘ECJ’) that was pending in \textit{Infopaq International A/S v Danske Dagblades Forening}\(^5\) on the scope of the EU reproduction right, relevantly defined in Directive 2001/29 as follows:

\begin{quote}
[Article 2.] Member States shall provide for the exclusive right to authorize or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part: (a) for authors, of their works; …\(^6\)
\end{quote}

At first instance in \textit{Infopaq}, this Article was interpreted as covering the reproduction of one or more eleven-word sequences from a newspaper article.\(^7\) That the appeal would be important for UK law was clear from \textit{Nova Productions Ltd v Mazooma Games Ltd}\(^8\) and \textit{Football Association Premier League Ltd v QC Leisure (No 2)},\(^9\) which

\begin{itemize}
\item CLR 396; \textit{Victoria Park Racing and Recreation Grounds Co Ltd v Taylor} (1937) 58 CLR 479;
\item Computer Edge Pty Ltd v Apple Computer Inc (1986) 161 CLR 171;
\item Autodesk Inc v Dyason (1992) 173 CLR 330;
\item Autodesk Inc v Dyason [No 21] (1993) 176 CLR 300;
\item \textit{Data Access Co v Powerflex Services Pty Ltd} (1999) 202 CLR 1.
\end{itemize}

\begin{itemize}
\item See Copyright Act 1968 (Cth) s 32; Copyright, Designs and Patents Act 1988 (UK) (‘CDPA’) s 1(1)(a).
\item See Copyright Act 1968 (Cth) s 14(1); CDPA s 16(3)(a).
\item See Opinion of Advocate General Trstenjak, 12 February 2009 [59]–[62].
\item \textit{[2007] EWCA Civ 219 (‘\textit{Nova Productions}’)} [27].
\item \textit{[2008] EWHC 1411 (‘\textit{Football Association}’)} [219].
\end{itemize}
confirmed the effect of *Marleasing SA v La Comercial Internacional de Alimentacion SA*\(^\text{10}\) in requiring that UK copyright be interpreted consistently with Article 2(a) above. Among other things, this means that understandings of what constitutes a *substantial part of a work* must reflect the Article 2(a) concept of a *work in part*.

In July 2009, the ECJ’s decision in *Infopaq* was published.\(^\text{11}\) According to early academic appraisals, its effect was indeed a revolutionary one. For example, one commentator described it as ‘clarifying’ that the ‘copyright work’ is a concept for the ECJ to define.\(^\text{12}\) Another described it as harmonising one aspect of that concept, by interpreting Article 2(a) as covering the reproduction of any elements of a work which ‘could be characterised as original’, and defining originality in respect of all Article 2(a) works as ‘the expression of the intellectual creation of their author’.\(^\text{13}\) Both implied that an amendment of UK law will be required.\(^\text{14}\)

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11 *Infopaq* (n 5).
12 See Christian Handig, ‘*Infopaq International A/S v Danske Dagblades Forening* (C–5/08): is the term “work” of the CDPA 1988 in line with the European Directive?’ (2010) 32 Eur Intellectual Property Rev 53, 54–55. The basis for this appraisal is the ECJ’s statement in *Infopaq* (n 5) at [27] ‘that the need for uniform application of Community law and the principle of equality require that where provisions of Community law make no express reference to the law of the Member States for the purpose of determining their meaning and scope, as is the case with Article 2 of Directive 2001/29, they must normally be given an autonomous and uniform interpretation throughout the Community’. See also Christian Handig, ‘The Copyright Term “Work”—European Harmonisation at an Unknown Level’ (2009) 40 Intl Rev of Intellectual Property and Competition L 665, 670 (defining the EU conception of ‘work’ as requiring an author’s own intellectual creation, consistent with a view of ‘original works’ and ‘authors’ as correlative concepts).
The purpose of this article is to consider the High Court of Australia’s decision in IceTV and its relevance for UK copyright jurisprudence, taking account of the decision in Infopaq. The starting point for that consideration is the principle expressed in R v Higgs, that UK courts may rely on the reasoning of Australian and other foreign decisions when the logic of those decisions makes them applicable. According to Higgs, this is so even in an era of harmonisation, and in respect of principles and statutory provisions subject to EU regulation, including by Directive 2001/29 itself.

On its face, IceTV seems an important decision, and a likely source of future reasoning for UK courts. Among other things, this is because of the similarity between and
shared origins of Australian and UK copyright legislation,\(^\text{17}\) the high degree of cross-fertilisation which exists between Australian and UK copyright jurisprudence,\(^\text{18}\) and the centrality of the latter to the four *IceTV* judgments. Further, it is possible to extract from the High Court’s decision six unanimous copyright propositions, and two approaches to determining substantial part, including one which reflects the reading of *Infopaq* above.

On closer analysis, however, it is submitted that *IceTV* is likely to have less impact on UK jurisprudence than might at first be thought. This is because the views of the High Court on certain issues are difficult to reconcile with UK jurisprudence, and unlikely to be accepted by a

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\(^{17}\) Until the introduction of its current Copyright Act in 1968, the basis for Australian copyright law was the Copyright Act 1911 (Imp), which mirrored the Copyright Act (UK) 1911. The provisions of the Copyright Act 1968 (Cth) are derived largely from the Copyright Act 1956 (UK). To the extent that differences exist between the 1968 Act and the CDPA, they are largely the result of EU harmonisation.

\(^{18}\) Examples of UK courts adopting the reasoning of Australian courts in copyright cases abound, and include several of the cases discussed in this comment, including *Higgs* (n 15); *Football Association* (n 9) [228] (Kitchin J, citing *Australian Video Retailers Association Ltd v Warner Home Video Pty Ltd* (2001) 53 IPR 242 (Federal Court of Australia (FCA)) in support of his finding (discussed below) that copied fragments of a film cannot be considered cumulatively when determining infringement); *Newspaper Licensing Agency v Marks & Spencer Plc* [2001] UKHL 38 (‘Newspaper Licensing Agency’) [24] (Lord Hoffmann, citing *Nationwide News Pty Ltd v Copyright Agency Ltd* (1996) 136 ALR 273 (Full Court of the Federal Court of Australia (FCFCA)) (‘Nationwide News’) in support of his analysis of substantial part, discussed below). See also *Newspaper Licensing Agency v Marks and Spencer Plc* [2001] Ch 257 (CA) (‘Newspaper Licensing Agency (CA)’) (also citing *Nationwide News*, but placing greater emphasis on the first instance decision of Wilcox J in *Nationwide News Pty Ltd v Copyright Agency Ltd* (1995) 128 ALR 285 (FCA)).
UK court. Further, this is true notwithstanding Infopaq, the meaning of which early commentators may have misread.

2. The Facts and Judgments of IceTV

(a) The material facts

IceTV involved a copyright suit by an Australian broadcasting company, Nine Network, whose business is to buy, select and schedule programmes for broadcast by free-to-air television stations within its national network. To support its business, Nine creates weekly schedules (‘Schedules’): compilations of information about its broadcast schedule for a given week. These Schedules include programme ‘time and title’ information, synopses of programmes, and other broadcast-related material. Approximately 17 days before each broadcast week, Nine distributes its Schedules to third-party aggregators (‘Aggregators’). Those Aggregators combine them with schedules from other broadcasters, and publish the resulting information in aggregated television guides.

The defendant was another Australian company, IceTV, which creates and distributes a subscription-based electronic television guide containing the broadcast schedules for all Australian free-to-air television stations for the coming six to eight days. To create its guide, IceTV begins with its own independently-created template of broadcast time and title information. It then compares that template with the aggregated guides, and resolves the majority of discrepancies between them by amending the template to reflect the guides. Doing so involves repeated copying of small amounts of time and title information from the aggregated guides, and through them from the Schedules.

Hence the suit by Nine for infringement of copyright in those Schedules. In response to that suit, IceTV conceded copyright subsistence and indirect copying, but

19 For a more detailed account of the material facts see Nine Network Australia Pty Ltd v IceTV Pty Ltd [2007] FCA 1172 (‘IceTV (FCA)’) [1]–[26].
denied that the information it had copied was a ‘substantial part’ of the Schedules.

(b) The Federal Court decisions

At first instance, the case was heard by Bennett J of the Federal Court of Australia.\(^{20}\) In her judgment, whether the ‘slivers’\(^{21}\) of time and title information copied by IceTV were a substantial part of the Schedules depended on their importance to the Schedules as compilations; namely, as selections and arrangements of material the originality of which lay in the interrelations of their component parts.\(^{22}\) Bennett J accepted that IceTV’s copying involved a misappropriation of the skill and labour invested in making Nine’s broadcast decisions, but regarded that as insufficient to infringe copyright in the Schedules. This was because the skill and labour was not directed to creating the Schedules, and was therefore not protected by Nine’s copyright.\(^{23}\)

There remained the effect of the Full Federal Court’s decision in Desktop Marketing Systems Pty Ltd v Telstra Corp Ltd.\(^ {24}\) In that case, the Court affirmed the subsistence of literary copyright in local area telephone directories on the basis of the labour and expense invested in their creation, and the protection by that copyright of the directories’ information. According to Bennett J, to the extent that DMS supported Nine’s suit in IceTV, it was distinguishable as involving a different type of compilation; namely, a ‘whole of universe’ compilation, the originality of which lay in the

\(^{20}\) IceTV (FCA) (n 19).

\(^{21}\) The word ‘slivers’ in this context is from Bennett J’s judgment; see IceTV (FCA) (n 19) [187]. Use of the word was criticised by the Full Federal Court, but adopted by the High Court.

\(^{22}\) IceTV (FCA) (n 19) [43], [52], [199].

\(^{23}\) IceTV (FCA) (n 19) [208].

\(^{24}\) [2002] FCAFC 112 (‘DMS’).
accuracy and exhaustiveness of its information rather than the interrelations of its component parts.  

Nine appealed Bennett J’s decision to the Full Federal Court. Its appeal was heard by the same three Judges who had earlier decided DMS: Black CJ, Sackville J and Lindgren J. In a joint judgment, their Honours held that the time and title information copied by IceTV was the ‘foundation’ of the Schedules, being the product of substantial skill and labour by Nine, including in making its broadcast decisions. The commercial importance of those decisions, and the value of Nine’s investment in creating the Schedules, defined the interest which copyright in the Schedules protected. The result was that even small amounts of time and title information were a substantial part of the Schedules. The repeated copying of that information by IceTV from successive Schedules involved a misappropriation of Nine’s skill and labour sufficient to infringe its literary copyright.

(c) The High Court decision

IceTV appealed the Full Federal Court’s decision to the High Court. Its appeal was heard by six Judges, who unanimously agreed that the appeal should be allowed, but split into two groups of three to write their judgments. In one group were French CJ Crennan and Kiefel JJ, and in the other Gummow, Hayne and Heydon JJ. Read together, their judgments can be seen to address four central questions. First, what is the purpose of copyright, and does it protect against misappropriations of skill and labour? Second, what is a work, and was the skill and labour in making Nine’s broadcast decisions directed to creating the Schedules as works? Third, was the time and title information copied by IceTV a substantial part of the

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25 *IceTV (FCA)* (n 19) [246].
26 For the report of the Full Court’s decision see *Nine Network Australia Pty Limited v IceTV Pty Limited* [2008] FCAFC 71 (‘IceTV (FCAFC)’).
27 *IceTV (FCAFC)* (n 26) [113].
28 *IceTV (FCAFC)* (n 26) [109]–[111].
29 *IceTV (FCAFC)* (n 26) [113]–[115].
Schedules? And fourth, what is the status of DMS, and the line of English cases on which it was based?

With respect to the first question, the High Court described the purpose of Anglo-Australian copyright legislation as unchanged since the Statute of Anne 1709, and as being to balance the interests of authors and the public for certain social and democratic ends. According to French CJ et al:

Copyright legislation strikes a balance of competing interests and competing policy considerations. Relevantly, it is concerned with rewarding authors of original literary works with commercial benefits having regard to the fact that literary works in turn benefit the reading public.\(^{30}\)

Similarly for Gummow J et al:

[T]he purpose of a copyright law respecting original works is to balance the public interest in promoting the encouragement of ‘literary’, ‘dramatic’, ‘musical’ and ‘artistic works’, as defined, by providing a just reward for the creator, with the public interest in maintaining a robust public domain in which further works are produced.\(^{31}\)

Consistent with this, their Honours emphasised that copyright does not support ‘any general doctrine of “misappropriation” [nor] afford protection to skill and labour alone’, and criticised the Federal Courts’ focus on the fact of IceTV’s misappropriation of Nine’s skill and

\(^{30}\) IceTV (n 1) [24] (footnotes omitted). See also [25]: ‘In both its title and opening recitals, the Statute of Anne of 1709 echoed explicitly the emphasis on the practical or utilitarian importance that certain seventeenth century philosophers attached to knowledge and its encouragement in the scheme of human progress. The “social contract” envisaged by the Statute of Anne, and still underlying the present Act, was that an author could obtain a monopoly, limited in time, in return for making a work available to the reading public’.

\(^{31}\) IceTV (n 1) [71] (footnotes omitted).
labour.\textsuperscript{32} For French CJ et al, that focus distracted the Courts from the statutory enquiry; namely, whether the skill and labour misappropriated by IceTV was directed to the form of expression of the part of the work that was copied.\textsuperscript{33} Gummow J et al agreed, describing the Federal Courts’ focus as grounded in a longstanding and pervasive misconception regarding the nature and purpose of copyright legislation, encouraged by its conceptual underpinnings as a property right.\textsuperscript{34} As evidence of that misconception they referred to the persistent judicial use of agricultural metaphors such as ‘reaping and sowing’,\textsuperscript{35} giving this statement from \textit{Designers Guild Ltd v Russell Williams (Textiles) Ltd} as an example:

The law of copyright rests on a very clear principle: that anyone who by his or her own skill and labour creates an original work of whatever character shall, for a limited period, enjoy an exclusive right to copy that work. No one else may for a season reap what the copyright owner has sown.\textsuperscript{36}

Gummow J et al also criticised interest-based analyses of substantial part. In their Honours’ view, such analyses invite processes of reasoning at such a level of abstraction that ideas and information—rather than fixed forms of expression—risk being protected, as reflected (they suggested) in \textit{DMS} itself.\textsuperscript{37}

With respect to the second question, the Court defined LDMA works as forms of LDMA expression ‘emanating’ from an author.\textsuperscript{38} Further, they agreed that an ‘author’ is a person who invests independent intellectual effort in creating a work\textsuperscript{39} or, as expressed by Gummow J et al, a ‘person who brings [a] copyright work into existence

\begin{itemize}
\item \textsuperscript{32} \textit{IceTV} (n 1) [131] (footnote omitted).
\item \textsuperscript{33} \textit{IceTV} (n 1) [52].
\item \textsuperscript{34} \textit{IceTV} (n 1) [69].
\item \textsuperscript{35} \textit{IceTV} (n 1) [69].
\item \textsuperscript{36} [2000] 1 WLR 2416 (HL) (‘Designers Guild’) 2418 (Lord Bingham), cited in \textit{IceTV} (n 1) [70].
\item \textsuperscript{37} \textit{IceTV} (n 1) [157], [160]–[161].
\item \textsuperscript{38} \textit{IceTV} (n 1) [96], [26].
\item \textsuperscript{39} \textit{IceTV} (n 1) [33].
\end{itemize}
in its material form’\textsuperscript{40} by exercise of ‘sufficient effort of a literary [dramatic, musical or artistic] nature’.\textsuperscript{41} The Court also agreed that IceTV’s misappropriation of Nine’s skill and labour in deciding its broadcast weeks could not infringe copyright in the Schedules. For French CJ et al, this was because the skill and labour was not ‘directed to the particular form of expression of the time and title information’.\textsuperscript{42} For Gummow J et al it was for the reason given by Bennett J at first instance; namely, the nature of the Schedules as works the originality of which ‘lay not in the provision of time and title information, but in the selection and presentation of that information with additional programme information and synopses, to produce a composite whole’.\textsuperscript{43}

With respect to the third question, the Court decided that the information copied by IceTV was not a substantial part of the Schedules, and that Nine’s suit ought therefore to fail. For French CJ et al, this was because the expression of the copied information involved insufficient originality in the sense of independent intellectual effort to be substantial.\textsuperscript{44} This was unsurprising, they said, as its form was ‘essentially dictated by [its] nature’.\textsuperscript{45} Gummow J et al also emphasised the minimal skill and labour involved in expressing the information, and the inseparability of its form from its content.\textsuperscript{46} However, they rejected the relevance of its originality as such, and criticised originality-based tests of substantial part as: (a) shifting attention to an extraneous issue (\textit{viz}, whether the

\textsuperscript{40} IceTV (n 1) [98] (footnote omitted, quoting Hugh Laddie, Peter Prescott and Mary Vitoria, \textit{The Modern Law of Copyright} (Butterworths, London 1980) 243).

\textsuperscript{41} IceTV (n 1) [99].

\textsuperscript{42} IceTV (n 1) [54].

\textsuperscript{43} IceTV (n 1) [152].

\textsuperscript{44} IceTV (n 1) [54].

\textsuperscript{45} IceTV (n 1) [54].

\textsuperscript{46} IceTV (n 1) [168], [170].
part is itself a copyright work); (b) inviting a ‘meditation’ on misappropriation; and (c) overlooking the important implication of the substantial part requirement, that not all appropriations of an author’s skill and labour are illegitimate. By implication of their reasoning, the question that ought to have been asked by the Courts was whether the copied information was a substantial part of the Schedules properly conceived, and whether its copying was undertaken with animus furandi.

This leaves the fourth and final question, which concerns the status in law of DMS. Because copyright subsistence was conceded by IceTV, the High Court was unable to overrule the decision of the Full Federal Court. Nonetheless, their Honours clearly rejected its ‘labour and expense’ view of originality, as well as the nineteenth century cases on which it was based. Those decisions include Kelly v Morris, Scott v Stanford, Cox v Land & Water Journal Co, Ager v Peninsular & Oriental Steam Navigation Co, and Collis v Cater, all of which were decided under pre-1911 legislation and culminated in the decision in Walter v Lane. There, the House of Lords

47 *IceTV* (n 1) [157].
48 *IceTV* (n 1) [169]–[170].
49 *IceTV* (n 1) [171]; compare [55].
50 *IceTV* (n 1) [33], [52], [98]–[99], [133]–[134], [157], [187]–[188].
This has now been confirmed by the Federal Court: see *Telstra Corporation Ltd v Phone Directories Company Pty Ltd* [2010] FCA 44 (deciding that as a result of the High Court’s decision in *IceTV*, copyright no longer subsists in local area telephone directories, and that DMS (n 24) no longer represents Australian law); *Primary Health Care Ltd v Commissioner of Taxation* [2010] FCA 419 (applying *IceTV* to find that copyright does not subsist in medical records).

51 See *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* [2001] FCA 612 (‘DMS (FCA)’).
52 (1866) LR 1 Eq 697 (Ch).
53 (1867) LR 3 Eq 718 (Ch).
54 (1869) LR 9 Eq 324 (Ch).
55 (1884) LR 26 ChD 637 (Ch).
56 (1898) 78 LT 613 (Ch).
57 Copyright Act 1842 (UK).
58 Walter v Lane [1900] AC 539 (HL).
 affirmed the finding of North J that literary copyright subsisted in verbatim records of another’s speeches, on the principle of the *Kelly v Morris* line of cases

... that one man may publish a directory, and another man may publish another, but he must not take it from the first. He must have recourse to the means which the first man adopted, and he may then make a second of his own.\(^{59}\)

Another inclusion in the *Kelly v Morris* line of cases is *Cate v Devon & Exeter Constitutional Newspaper Company*.\(^{60}\) There, North J held that systematic copying of small amounts of different works is capable of infringing copyright on the basis of the cumulative effect of the copying.\(^{61}\) In *IceTV*, French CJ et al expressly rejected this proposition, and stated: ‘To the extent that there are nineteenth century cases to the contrary, they should not be followed’.\(^{62}\) This is unsurprising given the basis of *Cate v Devon* in the misappropriation theory criticised by the Court.\(^{63}\) Further, it underlines the significance of their

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59 [1899] 2 Ch 749 (CA) 759.
60 (1889) 40 Ch D 500 (Ch) (‘*Cate v Devon*’).
61 *Cate v Devon* (n 60) 507.
62 *IceTV* (n 1) [21] (footnotes omitted).
63 See further *Collis v Cater* (n 56) 615, where North J deployed the metaphorical language criticised by Gummow J et al to describe the principle of copyright, as follows: ‘[One must not for] their own profit ... reap where they have not sown, and ... take advantage of the labour and expenditure of [others] in procuring news for the purpose of saving labour and expense to themselves’. For a detailed discussion of these cases and their significance see Justine Pila, ‘Compilation Copyright: a Matter Calling for “A Certain ... Sobriety”’ (2008) 19 Australian Intellectual Property J 231, 233–9. For an alternative perspective see Kathy Bowrey, ‘On Clarifying the Role of Originality and Fair Use in 19th Century UK Jurisprudence: Appreciating “The Humble Grey Which Emerges As The Result of Long Controversy”’ in Lionel Bently, Catherine Ng and Pina D’Agostino (eds), *The Common Law of Intellectual Property: Essays*
Honours’ rejection of *Cate v Devon* in confirming what Gummow J et al also made clear; namely, that neither DMS nor its underlying cases are valid. That Gummow J et al affirmed the relevance of *animus furandi* nonetheless is puzzling, given the roots of that principle in the same line of cases.\(^64\)

In conclusion, the High Court of Australia’s judgments in *IceTV* proceed from similar understandings of the purpose and scope of copyright, but differ on the concept of ‘substantial part’. For French CJ et al, that concept limits protection to expressions of sufficient value, assessed in the same way as for works when determining subsistence. For Gummow J et al, it limits protection to the substance of a work when properly conceived as a copyright work. That this difference is substantive can be seen from considering an anthology of poems.\(^65\) On the approach of Gummow J et al, an anthology is such that a single poem will never be a substantial part of it. By contrast, on the approach of French CJ et al, it will be a substantial part if it reflects sufficient independent intellectual effort of the author, which it will do if the author of the anthology is also the author of the poem. This underlines the difference between the Judges, which is that French CJ et al anchored their assessment of the part to the author, whereas Gummow J et al anchored theirs to the copyright work.

3. The Relevance of *IceTV* for UK and EU jurisprudence

Copyright decisions of the Australian Federal and High Courts are frequently relied on by UK courts, either to support a similar result on similar facts,\(^66\) or as a source of reasoning in respect of similar principles and provisions.

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\(^{64}\) See, eg, *Cary v Kearsley* (1801) 4 Esp 168, 170, 170 ER 679 (KB) 680; *Scott v Stanford* (n 53); *Kelly v Morris* (n 52).

\(^{65}\) A similar example was considered by Mummery LJ in *Baigent v Random House Group Ltd* [2007] EWCA Civ 247 (*Baigent*) [142].

\(^{66}\) See, eg, *Newspaper Licensing Agency (CA)* (n 18).
including provisions derived from international conventions and/or subject to EU legislation.\textsuperscript{67}

Were IceTV to come before a UK court, it would almost certainly involve a claim to \textit{sui generis} database rights,\textsuperscript{68} in addition to literary copyright.\textsuperscript{69} It is unlikely to, however, because of the statutory license requiring television broadcasters to make programme information available to any publisher subject to the settlement of terms by the Copyright Tribunal.\textsuperscript{70} Nonetheless, similar facts might arise, and were they to do so IceTV could be used to support the implication of Goff J in \textit{Harman Pictures v Osborne},\textsuperscript{71} affirming the principles of \textit{Jarrold v Houston},\textsuperscript{72} that the use of a non-fictional literary work to check the accuracy or completeness of an otherwise independently-created work is not an infringement of copyright subsisting in the former.\textsuperscript{73} Further, IceTV may also be of relevance in the second way, as a source of applicable reasoning from Australia’s highest court. In this regard, it would seem to offer unanimous support for six propositions, as well as (non-unanimous) support for two approaches to determining substantial part.

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\textsuperscript{67} See, \textit{eg}, Higgs (n 15).

\textsuperscript{68} See the Copyright and Rights in Databases Regulations 1997, implementing Council Directive (EC) 96/9 on the legal protection of databases [1996] OJ L77/20. The absence of equivalent protection in Australian law was remarked upon by Gummow J et al in IceTV (n 1) [135]–[139].

\textsuperscript{69} Under the CDPA, literary copyright subsists in original compilations and databases, notwithstanding the availability of \textit{sui generis} protection: see CDPA s 3(1)(a), (d); s 3A.

\textsuperscript{70} See Broadcasting Act 1990 (UK) s 176.

\textsuperscript{71} [1967] 1 WLR 723 (Ch) 730–1.

\textsuperscript{72} (1857) 3 K&J 708 (Ch) 714.

\textsuperscript{73} See also \textit{Cantor Fitzgerald v Tradition} [2000] RPC 95 (Ch).
(a) Proposition 1: The purpose of copyright

The first IceTV proposition is that copyright legislation must be interpreted to support its purpose of promoting certain social and democratic ends, and in particular, to balance the interests of authors and the public, and prevent its use as a misappropriation doctrine. This seems inconsistent with the implication of Infopaq, that the UK law of infringement must henceforth be interpreted to reflect the aim of Directive 2001/29 ‘to introduce a high level of protection ... for authors’. It is also inconsistent with the University of London Press v University Tutorial Press75 aphorism—affirmed by the House of Lords in Ladbrooke v William Hill (Football) Ltd76—that ‘what is worth copying is prima facie worth protecting’, as well as with associated tests of infringement. Such tests include those in Macmillan & Co Ltd v Cooper77 (‘the defendant is not at liberty to use or avail himself of the labour which the plaintiff has been at for the purpose of producing his work’)78 and Ibos Computers Ltd v Barclays Mercantile Highland Finance Ltd79 (‘a good guide is the notion of over-borrowing of the skill, labour and judgment which went into the copyright work’)80, the first of which was described in Electronic Techniques (Anglia) Ltd v Critchley Components Ltd81 as ‘little more than an elaborate version of the [University of London Press] statement’.82 On the other hand, the IceTV

74 Infopaq (n 5) [40]; but compare Jorge Reinbothe’s account of the original intent of the Directive, as reported in Jorge Reinbothe, ‘Die EG-Richtlinie zum Urheberrecht in der Informationsgesellschaft’ (2001) GRUR Int: Gewerblicher Rechtsschutz und Urheberrecht, Internationaler Teil 733, 736.
75 [1916] 2 Ch 601 (‘University of London Press’) 610 (Peterson J).
76 [1964] 1 WLR 273 (HL) (‘Ladbrooke’).
77 (1924) 93 LJ PC 113 (PC) (‘Macmillan v Cooper’).
78 Macmillan v Cooper (n 77) (Lord Atkinson, quoting Hogg v Scott (1874) LR 18 Eq 444, 458 (Hall VC)).
79 [1994] FSR 275 (Ch) (‘Ibos’).
80 Ibos (n 79) 302 (Jacob J).
81 [1997] FSR 401 (Ch) (‘Electronic Techniques’).
82 Electronic Techniques (n 81) 409 (Laddie J). For more recent evidence of that statement’s continued acceptance, one might refer to its description in the third edition of Laddie, Prescott
proposition finds support in various UK *dicta*. They include the statements of Pumfrey J in *Navitaire v EasyJet Airline Co*83 that ‘[i]t is not sufficient to say that the purpose of the act is to protect original skill and labour’,84 and of Jacob LJ in *Nova Productions* that copyright must be construed in light of its purpose to provide an ‘incentive for creation’, and to prevent its use as an ‘instrument of oppression’.85

(b) Proposition 2: The correlative nature of works and authors

The second *IceTV* proposition is that ‘work’ and ‘author’ are correlative concepts, such that the existence of one implies the existence of the other; and in particular, the existence of an LDMA work implies an act of independent (personal) LDMA expression.86 This is consistent with the approach of post-1911 UK courts, which have always required skill and judgement or LDMA effort in the

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83 *Navitaire* (n 83) [80].
84 *Navitaire* (n 83) [80].
85 *Nova Productions* (n 8) [55]. The reference to copyright’s use as an ‘instrument of oppression’ is from Lindley LJ’s judgment in *Hanfstaengl v Empire Palace* [1894] 3 Ch 109 (CA) 128, quoted also in *British Leyland Motor Corp Ltd v Armstrong Patents Co Ltd* [1986] AC 577 (HL) 649; *Hawkes & Son (London) Ltd v Paramount Film Service Ltd* [1934] Ch 593 (CA) 602; and *Joy Music Ltd v Sunday Pictorial Newspapers (1920) Ltd* [1960] 2 QB 60, 69.
86 The point was made expressly by French CJ et al; see *IceTV* (n 1) [34] (footnotes omitted): ‘There has been a long held assumption in copyright law that “authorship” and “original work” are correlative; the legislation does not impose double conditions’. More recently see *Football Dataco Ltd v Stan James (Abingdon) Ltd* [2010] EWHC 841 (‘Football Dataco’) [86] (emphasising that it is ‘the author [who] must have exercised judgment, taste or discretion’ in creating the work).
creation of a work,\(^87\) even as they have supported Walter v Lane,\(^88\) and notwithstanding contrary assertions from other jurisdictions.\(^89\) It is also consistent with the terms of Directive 2001/29,\(^90\) and the premise of the decision in Infopaq, that LDMA copyright subsists in certain categories of authorial works; viz, certain LDMA ‘expression[s] of the intellectual creation of [a person]’.\(^91\)

A question that arises in this context is whether a UK court might or ought to adopt either of the IceTV definitions of ‘author’. There are strong reasons against it doing so. One is that both definitions presume the existence of a work, notwithstanding that ‘work’ and ‘author’ correlate. Another is that Gummow J et al’s definition of an author as a person who first records a work contradicts section 3(3) of the CDPA, and the well-established principle of UK law that LDM works exist independent of the ‘fact and form’ of their material fixation.\(^92\) Further, while both judgments emphasise that copyright does not extend to a work’s ideas or information, neither clarifies whether a corresponding distinction between expressive and pre-expressive authorial acts is to be drawn when determining

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87 See Pila (n 63) 239–52.
88 See, eg, Sawkins v Hyperion Records [2005] EWCA Civ 56; compare Robertson v Lewis [1976] RPC 169 (Ch) (doubting the authority of Walter v Lane (n 58)).
89 See, eg, CCH Canadian Ltd v Law Society of Upper Canada [2004] 1 SCR 339 (Supreme Court of Canada) [15], [19] (McLachlin CJ, describing the UK as supporting a ‘sweat of the brow’ standard of originality, and University of London Press (n 75) as consistent with that standard); DMS (FCA) (n 51) [74] (Finkelstein J, describing English law as supporting copyright subsistence on the basis of ‘work or … expense in gathering … facts’).
90 See Art 2(a) (requiring that Member States provide for the reproduction right ‘for authors, of their works’).
91 Infopaq (n 5) [39]. See also Football Dataco (n 86), where Floyd J proceeded from the same premise, and expressly distinguished the work at issue from ‘mere “sweat of the brow”, by which I mean the application of rigid criteria to the processing of data’, adding: ‘It is quite unlike the compiling of a telephone directory, in that at each stage there is scope for the application of judgment and skill’ ([43]).
originality for the purpose of copyright subsistence. In the UK, such a distinction would be contrary to the principle of *Ladbroke v William Hill (Football) Ltd*,\(^93\) that works must not be dissected into their protectable and non-protectable aspects at the point of determining copyright subsistence.\(^94\)

(c) Proposition 3: The importance of boundaries

The principle of *Ladbroke* underlines the importance of the third *IceTV* proposition, which is that the first step in determining any copyright dispute is to identify clearly and precisely the nature and boundaries of the work in issue and the authorial process by which it was created, in order to determine copyright ownership and scope of protection. Again, this proposition is consistent with the approach of modern UK courts. For example, on the importance of identifying the boundaries of the work there are the decisions in *Green v Broadcasting Co of NZ*\(^95\) for dramatic works, *IPC Media v Highbury-Pleasure Publishing*\(^96\) for artistic works, and *Coffey v Warner/Chappell Music Ltd*\(^97\) for musical works. On the importance of identifying the boundaries of the authorial process there are the analyses in *Navitaire, Baigent, Newspaper Licensing Agency*, and *Infopaq* itself.\(^98\) The issues are well-illustrated by the first of

\(^{93}\) *Ladbroke* (n 76).

\(^{94}\) See *Baigent* (n 65) [131]–[132] (Mummery LJ, describing the principle as ‘so fundamental to the proper conduct of copyright litigation that it needs to be spelt out’); *Football Dataco* (n 86) [82] (deciding that while it is necessary when determining the originality of a database ‘to focus on skill and labour which is actually concerned with selection and arrangement, and to exclude that which is not’, such selection and arrangement ‘is not confined to selection or arrangement performed after the data is finally created’).

\(^{95}\) [1989] 2 All ER 1056 (PC).

\(^{96}\) [2004] EWHC 2985.

\(^{97}\) [2006] EWHC 449.

\(^{98}\) See also *Football Dataco* (n 86) [82] (see n 94), [91].
these cases. There, Pumfrey J reasoned from an analogy between computer programs and pudding recipes to find that the labour, skill and judgement in inventing a new method of operating a computer is not part of the labour, skill and judgement directed to creating a program implementing that method, and therefore not part of the labour, skill and judgement protected by the copyright subsisting in that programme.\(^9\) While the analogy itself may be questionable,\(^10\) his Lordship’s approach is not; a point confirmed by the reasoning of Mummery LJ in \(\text{Baigent}\), who further emphasised that whether part of a work is a substantial part does not depend on the ‘time, effort and skill’ invested in its conception.\(^11\) Rather, and as the decisions in \(\text{Electronic Techniques}\) and \(\text{Newspaper Licensing Agency}\) make clear, it depends on the importance of the part to the protected subject matter when properly conceived as a copyright work.

(d) Proposition 4: The \(\text{Cate v Devon}\) Line of Cases

The fourth proposition is that any principle or result which depends for its legitimacy on the \(\text{Cate v Devon}\) line of cases has a dubious basis in UK law, and ought therefore to be rejected. These include a ‘labour and expense’ view of originality or authorship, a ‘commercial interest’ test of substantial part, a ‘cumulative copying’ or ‘little and often’ principle of infringement, and, notwithstanding the decision of Gummow J et al, a principle of \textit{animus furandi}. In supporting this proposition, the High Court has responded to Laddie J’s suggestion in \(\text{Electronic Techniques}\) that ‘the time has come when a senior court should look more carefully at the principles underlying \(\text{Cate v Devon}\)’.\(^12\) Further, the implications of its response for UK law are potentially far-reaching. For example, it suggests that Laddie J was right in \(\text{Electronic Techniques}\) to doubt that

\(^9\) \(\text{Navitaire (n 83) [127]}.\)

\(^10\) See, eg, the passages of Martin Howe QC’s skeleton argument in \(\text{Nova Productions (n 8)}\) quoted by Jacob LJ at [48].

\(^11\) \(\text{Baigent (n 65) [155]}.\)

\(^12\) \(\text{Electronic Techniques (n 81) 410}.\)
copyright in a set of documents is infringed by ‘taking small regular helpings’ from them.\textsuperscript{103} Similarly, it suggests that Kitchin J was right in \textit{Football Association} to decide that copied fragments of a film cannot be considered cumulatively when determining infringement,\textsuperscript{104} and that the law does not support a principle of infringement by ‘little and often’ copying\textsuperscript{105} (notwithstanding suggestions to the contrary in \textit{Higgs} and \textit{Sony v Ball}\textsuperscript{106}). Third, it suggests that Lloyd J was wrong in \textit{Sweeney v Macmillan Publishers Ltd}\textsuperscript{107} to find that the small number of lines which had been copied from the Rosenbach manuscript of Ulysses were a substantial part of that manuscript on the basis of their (commercial) value in restoring previously unpublished lines to published versions of Joyce’s work, but that he (Lloyd LJ) was right in \textit{Baigent} to describe the principle of \textit{animus furandi} as a ‘red herring in modern English copyright law’.\textsuperscript{108} And finally, it suggests that the post-1911 UK courts have been right not to support a ‘labour and expense’ view of originality or authorship, and that the plaintiffs were ill-advised in the \textit{Waterlow} cases\textsuperscript{109} to concede copyright subsistence in the belief that that view was the law.

\textsuperscript{103} \textit{Electronic Techniques} (n 81) 407–9.
\textsuperscript{104} \textit{Football Association} (n 9) [227].
\textsuperscript{105} The expression is from \textit{Gilham} (n 82).
\textsuperscript{106} [2004] EWHC 1738. For a recent discussion of these cases and the issue see \textit{Gilham} (n 82) [23].
\textsuperscript{107} [2001] EWHC 460.
\textsuperscript{108} \textit{Baigent} (n 65) [97] (Lloyd LJ).
\textsuperscript{109} \textit{Waterlow Publishers Ltd v Rose} [1995] FSR 207 (CA); \textit{Waterlow Directories Ltd v Reed Information Services Ltd} [1993] ECC 174 (Ch).
(e) Proposition 5: The Legitimacy of (Limited) Reproduction

This leads to the fifth IceTV proposition, which is that the substantial part requirement reflects the legitimacy of a degree of copying, notwithstanding that such copying involves a misappropriation of the author’s labour and skill. This is also what Laddie J said in Electronic Techniques,\textsuperscript{110} and is consistent with the premise of Infopaq. That premise arises from the ECJ’s definition of ‘reproduction … in part’ as any reproduction of elements of a work that ‘share the originality of the whole work’.\textsuperscript{111} According to the Court, this definition, in combination with the nature of literary works (as original expressions of a person’s creativity ‘through the choice, sequence and combination of … words’\textsuperscript{112}), has the result that ‘[w]ords as such do not … constitute elements covered by the protection’,\textsuperscript{113} such words being analogous to the poem in my example above.\textsuperscript{114}

(f) Proposition 6: The Idea/Expression Distinction

The sixth and last IceTV proposition is that the theoretical underpinnings of Anglo-Australian copyright legislation are unchanged since 1709, and support a strict application of the idea/expression distinction, restricting LDMA copyright to forms of (materially-fixed) expression. It is submitted that whatever the historical position, this is not consistent with contemporary UK jurisprudence. For a start, it would be disingenuous to describe the theoretical underpinnings of UK law as unchanged by the effects of

\textsuperscript{110} Electronic Techniques (n 81) 409.
\textsuperscript{111} Infopaq (n 5) [38].
\textsuperscript{112} Infopaq (n 5) [45].
\textsuperscript{113} Infopaq (n 5) [46].
\textsuperscript{114} See Football Dataco (n 86) [88], where Floyd J described the Court in Infopaq as ‘distinguishing between the common currency of the words used, which do not in themselves attract copyright and their combination through choice, sequence and combination into an expression of the creativity of the author, which does’.
Europeanisation. Further, to the extent that the UK courts have supported a strict application of the idea/expression distinction, it has been in the limited context of computer programs, consistent with the provisions of Directive 91/250. This reflects a view of computer programmes in general as a special type of work subject to a more rigorous, policy-driven test of infringement than that which applies in respect of other LDMA works; a view which finds support in the reasoning of Gummow J et al. For such other types of works, the authoritative approach in the UK is that of Lord Hoffmann in Designers Guild—consistent with Electronic Techniques, Baigent, and Infopaq—that the idea/expression distinction has no significance in contemporary law independent of the substantial part requirement. Thus, and as Lord Hoffmann made clear, while the qualitative nature of the substantial part requirement means that the reproduction of ideas, information and unoriginal content is unlikely ever to infringe copyright, whether it does or not must ultimately depend on the facts of the case, and the importance of that which has been copied to the protected work when properly conceived qua copyright work. Further, such conceptions must reflect the reason why the work is a copyright work, which is because it is an original

115 This is consistent with Floyd J’s description of the ‘purpose of copyright’ in Football Dataco (n 86) as being ‘to provide encouragement for creative endeavour’ ([80]); a description which, given the context of that case, can be read as a response to the Infopaq description (see n 74 and accompanying text).


117 See IceTV (n 1) [158]–[159]; compare [38]–[40].

118 Designers Guild (n 36) 2422–3.

119 See also Electronic Techniques (n 81) 414 (emphasising the need when considering a claim of literary copyright to properly conceive the subject matter, ‘qua literary work’).
LDMA (or other statutory type of) work.\textsuperscript{120} Of note in this regard is the exposition by Lord Hoffmann of a corresponding principle in the patent law context, when considering the concept of novelty in \textit{Merrell Dow Pharmaceuticals Inc v HB Norton \& Co Ltd}.\textsuperscript{121}

A question that then arises is what would be the result of amending UK law to reflect the sixth \textit{IceTV} proposition? The test of infringement would go from being whether what was copied was a substantial part of the work, to whether what was copied was a substantial part of the \textit{protectable aspects} of the work (on Gummow J et al’s approach), or whether the \textit{protectable aspects of what was copied} were substantial (on French CJ et al’s approach), where the protectable aspects of the relevant work/part would need to be conceived as its materially-fixed form of expression (on Gummow J et al’s approach) or its form of expression (on French CJ et al’s approach). Aside from supporting a strict application of the idea/expression distinction, and a policy-driven conception of substantial part,\textsuperscript{122} this approach places a greater emphasis on the expressive form of a work when determining infringement than that supported by contemporary UK courts.\textsuperscript{123}

\begin{footnotesize}
\begin{enumerate}
\item\textsuperscript{120} Designers Guild (n 36) 2422–3. In Baigent (n 65) [145] et seq, Mummery LJ suggested similarly when considering ‘the necessary and sufficient conditions for characterizing the parts copied from the original work as “a substantial part” of the original work’.
\item\textsuperscript{121} [1996] RPC 76 (HL), especially [36], [40]–[42].
\item\textsuperscript{122} On the appropriateness of such tests see \textit{Electronic Techniques} (n 81) 410: ‘Furthermore Mr Prescott argued that, in the circumstances of \textit{Cate v Decon}, justice demanded that the court should find a way of granting relief to the plaintiff. Even if that is so, it may be that the solution is not for the court to change what amounts to a substantial part depending on whether it approves or disapproves of the defendant but to treat the plaintiff’s serial output as a single work which has been published in instalments. Furthermore, in some cases the court may feel justified that the defendant’s separate acts of copying should be viewed as a single act, spread over time, of copying’.
\item\textsuperscript{123} Examples of cases supporting a non-formalistic conception of the work include Designers Guild (n 36); Baigent (n 65); LucasFilm \textit{Ltd v Ainsworth} [2009] EWCA Civ 1328.
\end{enumerate}
\end{footnotesize}
approach of Gummow J et al, and as noted above, it also conflates the work with its material fixations.

(g) The IceTV Approaches to Determining Substantial Part

This returns me to the two IceTV approaches to determining substantial part. It is submitted that neither reflects the UK approach. Of the two, Gummow J et al’s comes closest, by combining a Designers Guild/Newspaper Licensing Agency sensitivity to the proper conception of works with a Nova Productions concern with limiting the scope of protection to prevent the exclusion of the public from ideas and information. By contrast, French CJ et al’s approach—which is focused on the originality of the expression of the part which is copied considered in isolation from the protected work—finds little support in UK law. On the contrary, it was expressly rejected in Baigent,124 is inconsistent with Designers Guild, and also contradicts the Newspaper Licensing Agency principle that ‘substantial part’ is a qualitative concept in respect even of categories of non-original works. I would also respectfully disagree with the suggestion of Gummow J et al that it is supported by the following comments from the last of these cases:

The House of Lords decided in Ladbroke ... that the question of substantiality is a matter of quality rather than quantity. The relevant passages are too well known to require citation ... But what quality is one looking for? That question, as it seems to me, must be answered by reference to the reason why the work is given copyright protection. In literary copyright, for example, copyright is conferred (irrespective of literary merit) upon an original literary work. It follows that the quality relevant for the purposes of substantiality is the literary originality of that which has been copied. In the case of an artistic work, it is the artistic originality of that which has been copied. So, in the recent case of

124 See Baigent (n 65) [62], [63], [94] (Lloyd LJ), [127], [136] (Mummery LJ).
Designers Guild ... the House decided that although not the smallest part of a fabric design had been reproduced with anything approaching photographic fidelity, the copying of certain of the ideas expressed in that design which, in their conjoined expression, had involved original artistic skill and labour, constituted the copying of a substantial part of the artistic work.\textsuperscript{125}

According to Gummow J et al, this passage supports a test of substantial part focused on the originality of the relevant part, assessed independent of the copyright work, as though the issue being determined were copyright subsistence.\textsuperscript{126} When read in context, however, it does not have this meaning. Rather, what Lord Hoffmann was emphasising is the necessity when determining infringement of assessing the importance of the copied part to the work when properly conceived \textit{qua} copyright work; \textit{viz}, as an expressive artefact the substance of which derives from its original LDMA nature and content. The same can be said of the corresponding \textit{Infopaq} statement, that elements of a work will be the work ‘in part’ if they ‘are the expression of the intellectual creation of their author’.\textsuperscript{127} While it is true that this assumes a correlation between LDMA works and LDMA authors, the same assumption is expressed in Article 2(a) itself, through its reference to ‘authors, of their works’. Further, its assumption that such works are expressions of a person’s intellectual creation is merely a restatement of the UK conception of an author, as the creator of a (bounded) expressive artefact.\textsuperscript{128}

Of course, this analysis leaves many issues unresolved, including the proper conception of a work \textit{qua} copyright work.\textsuperscript{129} Nonetheless, the point for present purposes remains that \textit{Newspaper Licensing Agency} does not support a test of infringement focused on the originality of

\textsuperscript{125} \textit{Newspaper Licensing Agency} (n 18) [19].
\textsuperscript{126} \textit{IceTV} (n 1) [62], [155]–[157].
\textsuperscript{127} \textit{Infopaq} (n 5) [51]. See also n 13.
\textsuperscript{128} See Pila (n 63) 233–4, 242, 245.
\textsuperscript{129} For a detailed discussion of this issue see Justine Pila, ‘Copyright and its Categories of Original Works’ (2010) 30 Oxford J of Legal Studies 229.
that which was copied from the work, and nor, it is submitted, does Infopaq. Rather, they support a test focused on whether what was copied is a sufficiently substantial part of the work when properly conceived qua copyright work.\textsuperscript{130} This explains the ECJ’s requirement (for an infringing reproduction) that what was copied ‘share the originality of the whole work’,\textsuperscript{131} so as to ‘reflect’ sufficiently that which constitutes the work qua copyright work.\textsuperscript{132} Further, it suggests that Infopaq is consistent with UK law, notwithstanding the early appraisals above, which may have been premature, if not unfounded.