

# Copyright protection of data and databases in Australia

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## INTRODUCTION

Copyright is only meant to protect the original expression of facts or ideas rather than the facts or ideas themselves. This fundamental principle of Copyright Law needs to be borne in mind more than ever with the advent of the computer age if we are to ensure that facts and ideas are not monopolized. Computers have brought with them "data" and "databases" which essentially comprise facts. Sometimes this data can be critical or involve a lot of labour to collate, but to protect it essentially grants rights in the facts or ideas themselves rather than the expression of them.

The protection of data as a literary work being a substantial part of a computer program, instructions or 'related information' within the definition of computer program or as a table will be considered in this paper. The protection of databases as compilations will also be addressed. This will entail an assessment of the law relating to originality and also alternative proposals for the protection of databases within copyright and other methods of protecting them outside copyright.

## BACKGROUND

### Apple v Computer Edge

In *Apple Computer Inc. v Computer Edge Pty Ltd* Beaumont J. at first instance in the Federal Court<sup>1</sup> and some members of the High Court on appeal<sup>2</sup> were faithful to the traditional concepts of copyright by holding that object code was not protected as a literary work. Although, contrary to Beaumont J., the High Court was prepared to grant copyright protection to the source code as a literary work. It appears that Beaumont J. considered that a literary work must be understood by humans. He quoted from the old case of *Hollingsrake v Truswell*<sup>3</sup> with approval when he said:

"...a literary work ... is something which was intended to afford 'either information or instruction or pleasure in the form of literary enjoyment'"<sup>4</sup>

Gibbs CJ agreed and for that reason held that the source code was protected as a literary work<sup>5</sup> and the object code was not. Brennan J. took a similar view<sup>6</sup> and Deane J. leant the same way by finding that at least the electrical charges in a silicon chip were not a literary work, although he did not decide whether object code in written form would be a literary work.<sup>7</sup>

### Copyright (Amendment) Act 1984

As a result of the decision of Beaumont J. the Federal Parliament bowed to significant international pressure from the software industry and passed the *Copyright (Amendment) Act 1984* which amended the *Copyright Act 1968* (Cth) to specifically include a computer program, in both source code and object code, as a literary work by amending the definitions in section 10(1) as follows:

"literary work includes:

- (a) a table, or compilation, expressed in words, figures or symbols (whether or not in visible form); and
- (b) a computer program or compilation of computer programs."

"computer program means an expression, in any language, code or notation, of a set of instructions (whether with or without related information) intended, either directly or after either or both of the following:

- (a) conversion to another language, code or notation;
- (b) reproduction in a different material form;

to cause a device having digital information processing capabilities to perform a particular function."

Section 10(1) of the *Copyright Act* was also amended to make it clear that the requirement in section 22(1) that a work be in a material form to be protected by copyright did not require that the work be visible:

"material form, in relation to a work or an adaptation of a work, includes any form (whether visible or not) of storage from which the work or adaptation, or a substantial part of the work or adaptation, can be reproduced."

## DATA AS A SUBSTANTIAL PART OF A COMPUTER PROGRAM

### Autodesk v Dyason

The first case in which the High Court considered these provisions was *Autodesk Inc. v Dyason*.<sup>8</sup> Dawson J gave the leading judgement with which the rest of the Court agreed.

Autodesk produced a computer program called AutoCAD which was used by engineers and architects to draw plans. It was sold with an AutoCAD lock that plugged into the back of the computer. Widget C was a program in AutoCAD that regularly sought a response from the AutoCAD lock and checked it against the look up table in Widget C. The program would not continue to operate unless the response was correct.

The purpose of the AutoCAD lock was to discourage copying of the AutoCAD program. Dyason produced the Auto Key lock which was intended to be substituted for the AutoCAD lock. It produced the correct response required by Widget C by reference to a look up table which was identical to the one in Widget C, rather than by calculation which was how the AutoCAD lock worked. The look up table consisted of a string of 127 bits.

Initially Dawson J rejected the possibility that data produced by the AutoCAD or Auto Key locks was protected by copyright as a computer program:

“The responses given by either the AutoCAD or the Auto Key lock do not in themselves instruct the computer at all; they merely provide some digital information which can serve as the basis for comparison. The digital information which forms the input to Widget C from the AutoCAD lock or the Auto Key lock cannot, therefore, constitute a set of instructions within the meaning of the definition of ‘computer program’”<sup>9</sup>

However, he went on to hold that “[i]t is not ... necessary that the reproduction of a substantial part of a computer program should itself be a computer program.”<sup>10</sup> This enabled him to find that the Auto Key lock infringed the Widget C program by reproducing a substantial part of it because the look up table was a “substantial, indeed essential”<sup>11</sup> part of Widget C.<sup>12</sup>

The decision of the High Court had the effect of protecting what Dawson J correctly identified as a 127 bit string of *data* as a substantial part of a literary work. The decision has been criticized by Prescott<sup>13</sup> for casting the net of copyright protection too wide on the basis that 127 bits was a miniscule part of the Widget C program and every bit in a computer program is essential to its function but cannot sensibly be viewed as a substantial part of the program.

#### **Autodesk v Dyason (No.2)**

In *Autodesk Inc. v Dyason [No.2]*<sup>14</sup> the majority of the High Court resisted the opportunity to reconsider their decision in *Autodesk v Dyason*. The respondents submitted that they had not had the opportunity to fully argue the ground upon which the High Court decided the case. In particular they submitted that the look up table was merely data and as such was not entitled to copyright protection and also that the look up table was not a substantial part of a literary work, being the computer program.

The majority<sup>15</sup> held that the respondents had a sufficient

opportunity to be heard and in any event did not consider that they would change their decision if they did hear further submissions. Deanne J. was not convinced that their previous decision was wrong but felt that it required further consideration.<sup>16</sup> Mason CJ was prepared to go further and admit that the respondents may have a good argument:

“...it is arguable that the 127 bit look up table is simply data or information... the look up table [may not] form part of the instructions or [be] a ‘substantial part’ of the protected copyright work for the purpose of determining an alleged infringement ... the act of reproducing [the look up table] may conceivably be akin to the reproduction of the material simpliciter in a table or compilation or the reproduction of something which is itself largely unoriginal”.<sup>17</sup>

#### **Data Access v Powerflex**

Fortunately the decisions regarding what constitutes a substantial part of a computer program in *Autodesk (No.1)* and (No.2) were disapproved by the majority<sup>18</sup> of the High Court in *Data Access Corporation v Powerflex Services Pty Ltd*<sup>19</sup> who said:

“The reasoning appears to come close to a ‘but for’ analysis, that is but for the look up table, the AutoCAD program would not execute and therefore the look up table was a ‘substantial part’ of the program.”<sup>20</sup>

The majority quoted Prescott’s criticism<sup>21</sup> of the decision and the argument of Mason CJ in *Autodesk (No.2)* with approval and held that “in determining whether something is a reproduction of a substantial part of a computer program, the ‘essential or material features of [the computer program] should be ascertained by considering the originality of the part allegedly taken.”<sup>22</sup>

With regard to *Autodesk* the majority concluded that “... the look up table in *Widget C* was merely data and was not capable of being a substantial part of the AutoCAD program unless the data itself had its own inherent originality.”<sup>23</sup> The majority preferred not to state their position on the

originality of the data in the look up table, probably because they did not want to expressly acknowledge that the result, as well as the reasoning, in *Autodesk* was wrong on the basis that the data was not original because it was not an expression which required substantial skill, judgement or labour to create.<sup>24</sup>

Applying this reasoning to the facts in *Powerflex* the court held that the commands or ‘reserved words’<sup>25</sup> were not sufficiently original as data to be a substantial part of a computer program.<sup>26</sup>

The court said that to be a computer program the instructions:

“...must intend to express, either directly or indirectly, an algorithmic or logical relationship between the function desired to be performed and the physical capabilities of the ‘device having digital information processing capabilities’. It follows that the originality of what was allegedly taken from a computer program must be assessed with respect to the originality with which it expresses that algorithmic or logical relationship or part thereof. ... That being so, a person who does no more than reproduce those parts of a program which are ‘data’ or ‘related information’ and which are irrelevant to its structure, choice of commands and combination and sequencing of commands will be unlikely to have reproduced a substantial part of the computer program. We say ‘unlikely’ and not ‘impossible’ because it is conceivable that the data, considered alone, could be sufficiently original to be a substantial part of the computer program.”<sup>27</sup>

#### **DATA AS INSTRUCTIONS IN A COMPUTER PROGRAM**

##### **Coogi v Hysport**

In *Coogi Australia Pty Ltd v Hysport International Pty Ltd*<sup>28</sup> the protection of data as instructions within the definition of a computer program was one of the issues before the court. Coogi claimed copyright in the ‘XYZ program’ which caused a computerized knitting machine to produce a knitted fabric. The ‘program’ comprised a ‘control

program' and a graph of data that together provided the necessary instructions to the knitting machine. Hysport contended that the information in the graph was merely data and therefore not entitled to protection while Coogi argued that the data was the set of instructions and therefore was protected.

Drummond J held that:

"...it is the entirety of the electronic signals generated by the computer embedded in the knitting machine when the XYZ program is running that makes the embedded computer perform the function of causing the knitting machine to execute the sequence of movements that are involved in knitting out the XYZ fabric: it is that group of signals that answers the description of a 'set of instructions' and an expression of those electronic signals answers the description of a 'computer program'. On the evidence here, the graph, though in one sense only data, is as much a source, and also an expression of part of these signals, as is the control program. It is both together that constitute an expression of a set of instructions and thus a 'computer program'..."<sup>29</sup>

By protecting data Drummond J effectively grants protection to the sequence of needle positions necessary to produce the fabric, or in other words the functioning of the machine, rather than the particular expression of how to instruct the knitting machine to produce the fabric. The expression of the set of instructions, or the fabric itself, may be protected by copyright but copyright is not meant to protect function, that is the province of patents.<sup>30</sup>

Drummond J criticised<sup>31</sup> the expert evidence that compared the two programs at their lowest level as a sequence of needle positions because they were indistinguishable as they had the same function, which was to produce the same fabric. However, by protecting the data he made the same mistake.

A computer program and data are indistinguishable when stored in the binary form used by computers, which

is essentially the presence or absence of electric current and can be represented as zeros and ones or "bits". Attempting to determine whether or not copyright subsists at that level is impossible.

Either the expression of the set of instructions which is understandable by humans (as suggested in *Hollingrake v Truswell*)<sup>32</sup> and any object code derivative of it, or the finished product, may be assessed for copyright protection but the intermediate data cannot. For example, words typed into a word processor are stored as bits or data that cannot be sensibly assessed for copyright protection. However the words may constitute an original expression which is entitled to copyright protection as a literary work.<sup>33</sup>

Ultimately Drummond J. held that Hysport's program did not infringe Coogi's XYZ program because it was not a reproduction or an adaptation of that program.<sup>34</sup>

#### DATA AS 'RELATED INFORMATION' IN THE DEFINITION OF COMPUTER PROGRAM

##### *Autodesk v Dyason (No.2)*

In *Autodesk (No.2)* Mason CJ raised the issue of whether the words "(whether with or without related information)" in the definition of computer program operated to extend copyright protection to information associated with a computer program which are not instructions. He did not answer that question but noted that, even if related information is protected, a substantial part must be copied before the copyright is infringed.<sup>35</sup>

Gaudron J. was the only other judge to consider this issue in *Autodesk (No.2)*. She concluded that:

"Ordinary usage and the language and context of the definition of 'computer program' in s. 10 of the Act compel the conclusion that the words 'set of instructions (whether with or without related information)' extend to comprehend information as well as commands.<sup>36</sup> There is thus no basis for an argument that the Act does not extend copyright protection to

information forming part of a set of instructions of the kind falling within the definition of 'computer program', at least if that information is a substantial part of the relevant set of instructions."<sup>37</sup>

##### *Data Access v Powerflex*

In *Powerflex* Gaudron J. went on to discuss what sort of relationship is required for 'related information' to be protected under the definition of computer program. She stated that the information would be sufficiently related if it formed part of the instructions.<sup>38</sup> However in that instance the information would not need to be protected as 'related information' because, if substantial, it would already be protected as part of the computer program itself.

She also considered that information that was irrelevant to the structure of the program, the choice of commands or the combination or sequencing of the commands was not related information within the definition of computer program and therefore was not protected.<sup>39</sup> That suggestion has merit and is consistent with the view of the majority on this issue.<sup>40</sup>

##### *Coogi v Hysport*

In *Coogi v Hysport* Drummond J held that the fact that:

"...an essential element of the Coogi XYZ program is a body of data in the form of a graph, as distinct from instructions, is no impediment to that graph and the control program together comprising a 'computer program'... The definition [of computer program] expressly envisages that a body of data [or] information, as distinct from instructions may be an integral part of a 'computer program'. The explanatory memorandum accompanying the 1984 legislation that introduced the definitions relating to 'computer programs' ... states that the intention of the expression in the definition in emphasis (sic., query substituting 'parenthesis') is to make it clear that a 'computer program' may include material other than instructions for the computer, such as 'data to be used in connection with the execution of the program'.<sup>41</sup>

PROTECTION OF DATA IN A TABLE

Data Access v Powerflex

In Data Access v Powerflex<sup>42</sup> the High Court picked up on the suggestion of Dawson J in Autodesk (No.1)<sup>43</sup> that a table could be protected as a literary work in its own right and protected a Huffman compression table in the DataFlex program on that basis.

The Huffman compression algorithm assigns shorter bit strings to more common characters, thereby reducing the amount of memory required to store data. The Powerflex program was designed to be compatible with DataFlex and therefore needed to replicate the Huffman compression table used in the DataFlex program to operate on data stored using that program.

The court noted that it was clearly the intention of Parliament to protect databases and data stored as a table as literary works, being compilations and tables respectively. They quoted from the explanatory memorandum to the Copyright Amendment Act 1984 as follows:

“By removing the requirement that tables or compilations must be in a visible form it is made clear that a computerized data bank, for example, may be treated as a compilation being a literary work. It is also important because data is often stored in a computer as a table.”<sup>44</sup>

The court observed that a work must be original to qualify for copyright protection and went on to hold that it took substantial skill and judgement to produce the Huffman compression table and therefore it was protected by copyright as a table.<sup>45</sup> This conclusion will be analyzed in more detail when originality is considered below.

COPYRIGHT AMENDMENT (DIGITAL AGENDA) ACT 2000

The main objective of the Digital Agenda Act<sup>46</sup> is to bring Australian copyright law into the digital age, primarily by introducing a technology neutral right of communication to the public.<sup>47</sup> The Act has also incidentally implemented some of the recommendations of the Copyright Law Review Committee (CLRC) from its 1994 report on Computer Software

Protection, in particular by amending the definitions of computer program, literary work, reproduction<sup>48</sup> and published edition.<sup>49</sup> Furthermore the Act has inserted section 47AB, “Meaning of computer program”, with the intention of reversing the effect of the High Court’s decision in Powerflex regarding the Huffman compression table.

Item 7 of schedule 1 of the Digital Agenda Act introduces the following definition of computer program:

“computer program means a set of statements or instructions to be used either directly or indirectly in a computer in order to bring about a certain result”

This simplified definition replicates section 101 of the US Copyright Act 1976 and implements recommendation 2.04(c) of the CLRC’s Computer Software Protection report. The new definition will not affect the current position in relation to the protection of data as a substantial part of a computer program or as instructions within the definition of a computer program. However, it appears that related information will not be protected under the new definition of computer program unless it is a set of statements or instructions that are used either directly or indirectly in a computer to bring about a certain result. Neither in the CLRC report nor in the Explanatory Memorandum is the effect of removing the words “with or without related information” considered.

Item 12 of schedule 1 of the Digital Agenda Act amends the definition of literary work so far as it relates to tables or compilations by deleting the words “(whether or not in a visible form)”. This gives effect to recommendation 2.04(a) in the CLRC’s 1994 Computer Software Protection report which was based on the finding that the words were superfluous because a work is made for the purposes of section 32(1) when it is reduced to a material form<sup>50</sup> which, pursuant to the definition of material form in section 10(1), need not be visible.

PROTECTION OF DATABASES AS COMPILATIONS

Although copyright only protects the expression of facts or ideas rather than

the facts or ideas themselves, a compilation of facts can be protected as a literary work if it is original. Protection as a compilation within the definition of literary work is the logical category for the protection of databases,<sup>51</sup> indeed that is where the CLRC considered they belonged<sup>52</sup> and the Digital Agenda Act expressly acknowledges this when it refers to “an electronic compilation, such as a database”.<sup>53</sup>

Feist v Rural Telephone Service

The protection of databases as compilations was considered by the US Supreme Court in Feist Publications Inc. v Rural Telephone Service Co Inc.<sup>54</sup> Rural claimed that Feist infringed its copyright in its white pages telephone directory. The Court stated that:

“Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.”<sup>55</sup>

The court said that original “means only that the work was independently created by the author (as opposed to copied from other works) and that it possesses at least some minimal degree of creativity.”<sup>56</sup>

The court stated that this position was consistent with the purpose of copyright:

“The primary objective of copyright is not to reward the labour of authors, but to promote the progress of science and the useful arts. ... To this end copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”<sup>57</sup>

In the course of the decision the court rejected the ‘sweat of the brow’ doctrine which stated that copyright subsisted in a collection of facts as a result of the work involved in assembling them. The only defence to infringement under the sweat of the

brow doctrine was independent assembly.

The court held that the names, towns and telephone numbers in the white pages were pre existing facts rather than original expression and therefore were not protected by the copyright subsisting in the directory as a whole (which included text and advertisements). The court also held that the arrangement of that data alphabetically was "devoid of even the slightest trace of creativity"<sup>58</sup> and therefore also lacked the originality necessary for copyright protection.

**Bellsouth v Donnelly**

The US Court of Appeal applied Feist to a yellow pages directory in *Bellsouth Advertising and Publishing Corporation v Donnelly Information Publishing Inc.*<sup>59</sup> holding that while the directory qualified for copyright protection these parts copied, such as the contact details of the businesses, were facts which were not protected by copyright.<sup>60</sup>

**Waterlow v Reed**

The decision of the UK High Court in *Waterlow Directories Ltd v Reed Information Services Ltd*<sup>61</sup> is inconsistent with the American decisions. As an interlocutory decision it is not necessarily decisive, however it relied on a number of old cases<sup>62</sup> in holding that using names and addresses in a law directory to solicit entries for a rival directory was likely to be an infringement of copyright. The first two of those old cases held that direct copying of entries in a directory was an infringement, even if they were independently verified. However, the third case held that merely using the directory to ascertain who to approach for listings was not an infringement. Aldous J noted the distinction in his decision in *Waterlow* but failed to appreciate that the defendant before the court was effectively doing precisely that.

**Telstra v Desktop Marketing Systems Pty Ltd**

The Intellectual Property Competition Review Committee observed in its report that this case, which is currently before the Federal Court, should clarify the position on the protection of Databases in Australia.<sup>63</sup> Telstra is claiming that the defendant is

infringing its copyright in the white and yellow page telephone directories by producing a CD version of them. The defendant is claiming, inter alia, that copyright does not subsist in the directories.

**ORIGINALITY**

For a work to be protected by copyright it must be "original".<sup>64</sup> The meaning of originality is twice as important after the High Court's decision in *Powerflex* that, in the context of infringement, to be a substantial part of a work the part copied must be original.<sup>65</sup>

Although not specifically referred to in *Waterlow*, that case needs to be viewed in the context of a fundamental difference between the approach of the American and Anglo-Australian courts to the concept of originality. In contrast with the American position as explained in Feist, the Anglo-Australian courts have taken the labour required to create a work into account when assessing its originality. Although not referred to as such, this amounts to the "sweat of the brow" doctrine which was rejected by the US Supreme Court in Feist.

**English Cases**

This line of authority appears to be based on the premise that "what is worth copying is prima facie worth protecting."<sup>66</sup> The starting point is the statement of Peterson J in *University of London Press v University Tutorial Press* that "...the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work - that it should originate from the author."<sup>67</sup>

The House of Lords expanded on this in *Ladbroke (Football) Ltd v William Hill (Football) Ltd*<sup>68</sup> where their Lordships agreed that originality depends on the amount of "skill, judgement or labour"<sup>69</sup> or words to that effect.<sup>70</sup> However, only some members of the House of Lords went on to specifically address what amount of "skill, judgement or labour" was required. Lord Hodson stated that it should be "more than negligible"<sup>71</sup>, while Lords Devlin and Pearce considered that it should be "substantial".<sup>72</sup>

**Australian Cases**

The Australian Courts have followed in the footsteps of this English authority so far as taking labour into account when assessing originality.<sup>73</sup> However, as Finkelstein J observed in *Autocaps*: "What is not clear is whether the skill, labour, etc must be more than negligible or whether it must be substantial."<sup>74</sup> He concludes that "some effort must be involved though it need not be great."<sup>75</sup> The CLRC noted in their 1994 report on the Protection of Computer Software that "... the standard of originality appears to be quite low under Australian law."<sup>76</sup> For example in *Interlego*<sup>77</sup> minor variations to a technical drawing were sufficient for it to be original<sup>78</sup> and in *Autocaps*<sup>79</sup> a table of spare part numbers was considered original.

In *Milwell* the court went a step further and held that all the work and skill that went into producing a copyright work should be taken into account rather than just the work and skill involved in producing the written expression. To illustrate the point, in that case the work and skill of mathematicians in calculating probabilities for a poker machine prize scale were taken into account in deciding that the table of prize scales was original.<sup>80</sup> Dalton observes that this amounts to the 'sweat of the brow' approach rejected by the US Supreme Court in Feist.<sup>81</sup> He argues convincingly that including the labour, skill and judgement that is preparatory to the expression of a work in an assessment of originality may result in the protection of facts or ideas, contrary to the fundamental idea-expression dichotomy of copyright law.

In *Autocaps* Finkelstein J considered the circumstance where the labour associated with producing a copyright work is too remote to be used in determining originality and decided that, to be included in the assessment, the production of the work must be at least "a subsidiary but important object" of the labour. On that basis he held that testing which petrol cap suited a particular vehicle could be taken into account in determining the originality of the table of suitable caps, but that manufacturing the caps could not.<sup>82</sup>

This is consistent with the discussion of the CLRC in its 1994 report on Protection of Computer Software. The CLRC distinguished between the "labour and skill ... expended in the selection and arrangement of the materials that make up a database" and the labour involved in the data entry and considered that only the former could be entitled to copyright protection "just as the work of a stenographer in typing dictation of a novel does not entitle the stenographer to co-authorship of the novel."<sup>83</sup> Note however that copyright in the published edition has the effect of protecting the labour involved in typing a document, although only for 25 years after it is published.<sup>84</sup>

**Data Access v Powerflex**

The decision of the High Court in Powerflex in relation to the Huffman compression table discussed above appears to be consistent with Milwell:

"The skill and judgement employed by DataFlex was perhaps more directed to writing the program setting out the Huffman algorithm and applying this program to a representative sample of data than to composing the bit strings in the Huffman table. Nevertheless, the standard Huffman table emanates from DataFlex as a result of substantial skill and judgement. That being so ... the standard Huffman table constituted an original literary work."<sup>85</sup>

The High Court proceeded to acknowledge that the result in relation to the Huffman compression table may extend copyright protection too far, but considered that the law dictated that result and only Parliament could change it.<sup>86</sup> While it may well be worth reconsidering whether tables and compilations should be protected as literary works, the reasoning of the High Court on this issue can be criticized on two grounds.

First, the labour involved in writing the program is akin to manufacturing the petrol cap in Autocaps and could be considered too remote,<sup>87</sup> and the work involved in actually creating the standard Huffman compression table was negligible (it was simply a matter of running the program on a sample of data). Therefore the court could have

held that the table was unoriginal and was not the subject of copyright protection.

Secondly the High Court could have taken a broader view and maintained the integrity of the copyright system by rejecting labour as a factor in assessing originality and finding that the table lacked the degree of skill or judgement required to make it original and therefore was not protected by copyright.

In any event Parliament has acted on the High Court's suggestion by inserting a new section 47AB<sup>88</sup> so that any literary work (such as a table) which is incorporated in or associated with a computer program and is essential to its effective operation may be copied for the purpose of, inter alia,<sup>89</sup> creating an interoperable product. The Intellectual Property and Competition Review Committee went further by suggesting that compression tables be specifically excluded from receiving copyright protection.<sup>90</sup> While those responses achieve the desired result it would be preferable to reach that result by applying legal principles founded on public policy rather than by an arbitrary rule.

**Conclusion on Originality**

It can be seen from the result in Powerflex and the other Anglo-Australian cases referred to that if the skill and judgement required to qualify for copyright protection is minimal, or if labour is taken into account when assessing originality, copyright will run the risk of protecting ideas, facts, information or data rather than expression.

The approach taken in the American cases in relation to excluding labour from the factors relevant to originality is preferable to the Anglo - Australian position because it maintains the fundamental idea - expression dichotomy by protecting the original expression in a compilation of facts but not the facts themselves and is thus consistent with the purpose of copyright.

Furthermore, including labour in the assessment of originality, and thereby protecting it, is not suggested by article 10(2) of the TRIPS agreement which refers to the "selection or arrangement" which causes a work to be an "intellectual creation" and

therefore deserving of copyright protection. The American position on originality is more consistent with that language.

Given the entrenched position of the Anglo - Australian courts on this issue only Parliament, or perhaps the High Court,<sup>91</sup> could make such a fundamental change to the law. In the United Kingdom the threshold for copyright protection of databases, but not any other works, has been raised in line with that in the US as a consequence of the EU Council Directive on the Legal Protection of Databases.<sup>92</sup> In response to that directive the United Kingdom parliament introduced sui generis protection for databases by inserting section 3A into the *Copyright, Designs and Patents Act 1988*. Section 3A provides that:

"...a literary work consisting of a database is original if, and only if, by reason of the selection or arrangement of the contents of the database the database constitutes the author's own intellectual creation."<sup>93</sup>

It may be that the American courts have been less inclined to use copyright to protect the fruits of one's labour because they have an unfair competition cause of action which is more directly applicable in that situation.<sup>94</sup> The High Court denied the existence of that cause of action in Australia, criticizing it as not soundly based on law.<sup>95</sup> However, it has since been suggested that the recent development of the doctrine of unjust enrichment in Australia lends itself to protection of intangible products that are not protected by the traditional laws of intellectual property.<sup>96</sup>

**PROPOSALS FOR THE LEGAL PROTECTION OF DATABASES**

In part 2 of their report on Simplification of the Copyright Act<sup>97</sup> the CLRC recommended that the categories of subject matter protected by copyright be "creations" and "productions"<sup>98</sup> and that they have the "innovation thresholds" of "significant intellectual effort"<sup>99</sup> and "the application of time, effort and resources"<sup>100</sup> respectively.<sup>101</sup> They recognized that the former innovation threshold "may be higher than the current level of originality required for

protection of works" and considered it justifiable that "material such as timetables, directories and similar compilations" would be likely to receive less protection than at present as "productions" rather than "creations".<sup>102</sup>

Christie agrees and observes that the innovation threshold for creations is consistent with the references to "intellectual creations" in the TRIPs agreement, the WIPO Copyright Treaty 1996, United Kingdom copyright legislation and various<sup>103</sup> European Community Directives.<sup>104</sup> He also notes that Ricketson considers that it probably equates with the meaning of originality adopted by the US Supreme Court in *Feist*.<sup>105</sup>

The Intellectual Property and Competition Review Committee acknowledged that the CLRC's proposal is soundly based on logic but recommended against implementing the proposal on the basis that the costs arising out of the uncertainty and attendant litigation associated with such sweeping reform would probably outweigh the benefits.<sup>106</sup>

In their 1994 report on the Protection of Computer Software the CLRC recognized<sup>107</sup> that their recommendation to extend protection of the published edition of a work to published computer databases,<sup>108</sup> which has not been implemented, would be almost as effective<sup>109</sup> as introducing *sui generis* protection for databases and much less difficult to implement. However, in part 2 of their report on Simplification of the *Copyright Act* the CLRC considered the history and policy behind the protection of public editions and concluded that it was not appropriate to extend it to the digital world.<sup>110</sup>

The new class of subject matter other than works for computer generated material which the CLRC also recommended implementing in their 1994 report on Computer Software Protection<sup>111</sup> would also encompass computer generated databases.

An alternative proposal, which is not restricted to digital or computer generated databases and which achieves the same result as the proposal of the CLRC in their report on Simplification of the *Copyright Act* within the existing copyright

framework and is therefore more likely to be implemented, is to protect databases which do not (or should not) satisfy the test of originality required for protection of compilations as literary works as a category of subject matter other than works in the same way that the labour and investment in sound recordings, films, broadcasts and published editions is protected.<sup>112</sup>

This would also make it unnecessary to identify an author<sup>113</sup> as required by section 32, which is problematic in circumstances where much of the work involved in arranging a database is carried out automatically by a computer program.<sup>114</sup>

Another issue which would need to be addressed is the potential for minor changes to give rise to a perpetual copyright, particularly in light of the decision of the Federal Court in *Interlego AG v Croner Trading Pty Ltd*<sup>115</sup> where quite minor amendments to a drawing gave rise to a new copyright.<sup>116</sup>

Whereas works are protected from reproduction, which includes copying a substantial part even if only in a qualitative sense, subject matter other than works are only protected against "verbatim copying".<sup>117</sup> That level of protection is inadequate for databases given the ease with which digital material can be manipulated. Therefore protection against reproduction such as applies to works would be more appropriate for the protection of databases as a class of subject matter other than works.

Rather than adapting copyright to protect unoriginal databases the EC made a bold move and created a *sui generis* regime with the Directive on the Legal Protection of Databases 1996. Article 7 defines the right as follows:

"Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction<sup>118</sup> and/or re-utilization<sup>119</sup> of the whole or a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database."

The Directive does not remove any copyright protection that may already subsist in a database, for example, as a compilation.<sup>120</sup> The protection granted lasts for 15 years.<sup>121</sup> Article 10(3) ties a new term of protection to a "substantial change" (which may occur through an accumulation of smaller changes) "which would result in the database being considered a substantial new investment". This is sensible given that the purpose of the right is to protect the investment in the database.

In their 1994 report on Protection of Computer Software the CLRC took a favourable view of the EC Directive on Databases and recommended that the issue be given further consideration once the form of the EC Directive was finalised.<sup>122</sup> At the start of this year only half of the EC countries had passed legislation implementing the Directive and it is due to be reviewed this year.<sup>123</sup> The US initially intended to introduce provisions dealing with the protection of databases in the *Digital Millennium Copyright Act 1998* but they were left out at the eleventh hour<sup>124</sup> and alternatives are still under consideration<sup>125</sup> such as the Collections of Information Antipiracy Act.<sup>126</sup>

The EU Council Directive addresses the protection of databases that do not deserve copyright protection as works and effectively removes the necessity to identify a human author and deals with perpetual protection and the scope of copying that should be an infringement. However, it was unnecessary to introduce a *sui generis* right. As suggested above, the same right would fit comfortably within the framework of copyright as a neighboring right where it could draw on the concepts and jurisprudence of copyright.

### PRACTICAL PROTECTION OF DATABASES

The digital provision of material is well suited to the formation of contracts setting out the terms on which material can be accessed by requiring agreement to conditions before access is granted, i.e. the so called 'clickwrap licence'. Like 'shrinkwrap licenses' the enforceability of these contracts is

subject to the principles of contract. Such contracts can provide more protection for the grantors than they are entitled to under copyright. Therefore, except where specifically prohibited under the Copyright Act,<sup>127</sup> clickwrap licenses can usurp copyright law. However, from a practical point of view it is difficult to identify breaches of the contracts in the same way that it has been difficult to prevent copying of sound recordings and computer software.

As predicted, "the answer to the machine ... lies[s] in the machine".<sup>128</sup> Technological solutions for controlling access, use and copying of digital material are becoming more prevalent. These systems can be used not only to enforce clickwrap licenses, they can make them obsolete. As such they are even more effective at usurping the traditional balance of copyright. To date these systems have been susceptible to circumvention. An early example is the "Auto Key" in *Dyason v Autodesk*. Often as soon as a new lock is invented a new key is devised to open it. As Whitelaw observed: "It is a bit like an arms race between locksmiths and safe crackers".<sup>129</sup>

If technological protection measures can be restricted to enforcing copyright then it will be the panacea for the current difficulties associated with enforcing copyright in the digital environment. To that end laws against devices which circumvent such systems are desirable. However, the systems must be restricted to preventing copyright infringement to maintain the balance of copyright, particularly if the technical protection systems become circumvention proof.<sup>130</sup>

Item 98 of the *Digital Agenda Act* inserts a new section 116A which prohibits the importation, manufacture or distribution, but not the use, of "circumvention devices"<sup>131</sup> to bypass "technological protection measures" unless detailed measures are followed to ensure that the device will be used for some<sup>132</sup> of the purposes which are exceptions to the exclusive rights of copyright owners.

The House of Representatives Standing Committee observed in their Advisory Report on the Copyright

Amendment (Digital Agenda) Bill 1999 that there are two types of technological protection measures: those which control access and those which control copying. Of the two they noted that "copy control measures are more closely allied with copyright and with the infringement of copyright."<sup>133</sup> They also observed that the definition of technological protection measure included both concepts and considered that "it may be preferable to define ... technological protection measure simply in terms of copy control measures."<sup>134</sup>

The Committee also observed in their Advisory Report that in the exposure draft all non infringing purposes were permitted purposes for the use of circumvention devices and that the narrowing of that exception in the Bill had not been explained. However they concluded that, except in a couple of areas,<sup>135</sup> "an appropriate balance between copyright owners and copyright users has been struck in specifying key non infringing uses as permitted purposes."<sup>136</sup>

To the extent that the permitted purposes for using devices to circumvent technological protection measures do not extend to all exceptions to the exclusive rights of copyright<sup>137</sup> the legislation condones such technological protection measures<sup>138</sup> rendering the carefully balanced exceptions to copyright irrelevant, apparently for no good reason. Why have exceptions to copyright if they can be avoided? If the rationale for the exceptions still exist they should be allowed to operate effectively rather than be undermined. Therefore not only should the prohibition on circumvention devices be subject to all of the exceptions of copyright but also the use of technological protection measures to override those exceptions should be prohibited.

The House of Representatives Standing Committee on Legal and Constitutional Affairs in their report titled "Cracking Down on Copycats: Enforcement of Copyright in Australia" recommended that the copyright industry "be encouraged to develop technological protection devices" and that the *Copyright Act* "be amended to provide legal

sanctions against the removal or alteration of technological protection devices".<sup>139</sup>

In contrast the Intellectual Property and Competition Review Committee "would be concerned if the use of technological locks, perhaps accompanied by greater reliance on contract were to displace or in any way limit the effectiveness of the fair dealing provisions"<sup>140</sup> and recommended that the issue be given careful consideration in the proposed review of the *Digital Agenda Act* after it has been in operation for three years.

## CONCLUSION

Unfortunately the Australian courts have concentrated on the intricacies of the definitions introduced to extend copyright protection to computer programs and in the process have granted protection, or suggested granting protection, to data as a literary work being a substantial part of a computer program,<sup>141</sup> instructions<sup>142</sup> or 'related information'<sup>143</sup> in the definition of computer program or as a table.<sup>144</sup> Also Databases may be protected as literary works being compilations.

One of the fundamental criteria for copyright protection is originality.<sup>145</sup> In the context of copyright in Australia this means that the work must originate from the author and involve sufficient "skill, judgement or labour".<sup>146</sup> By protecting labour our law runs the risk of protecting ideas, facts, information or data rather than expression.

The production of databases often involves a lot of labour or is largely performed automatically by a computer program. Either way there is little in the way of creative expression. Therefore it is appropriate to protect those databases as a category of neighboring rights rather than as literary works because neighboring rights have been developed to protect labour and investment.

There are also contractual and technical ways of protecting material in the digital environment that can be used to enforce or even usurp copyright. The rights and exceptions available under copyright have been carefully developed over time to balance the interest of an author or



investor in reward for their expression or production with the interests of society in the development of further material from the ideas, information and productions of others. Technological protection measures can serve a legitimate purpose to the extent that they are used to enforce copyright at a time when it is under attack. However, we must be vigilant to ensure that such measures are subject to the exceptions of copyright so that they are not used to destroy the balance by protecting an unfettered monopoly.

- 1 (1983) 50 ALR 581
- 2 (1986) 65 ALR 33
- 3 [1894] 3 Ch 420
- 4 (1983) 50 ALR 581 at 591
- 5 (1986) 65 ALR 33 at 38
- 6 (1986) 65 ALR 33 at 54
- 7 (1986) 65 ALR 33 at 63
- 8 (1992) 173 CLR 330
- 9 (1992) 173 CLR 330 at 343
- 10 (1992) 173 CLR 330 at 346
- 11 (1992) 173 CLR 330 at 346
- 12 Dawson J. observed that the look up table could also be protected as a table or compilation under the definition of a literary work. This line of reasoning was used in the High Court's decision in *Data Access v Powerflex* to protect a Huffman compression table. See the discussion regarding the protection of data in tables below.
- 13 Prescott, "Was AutoCAD Wrongly Decided?" [1992] 14 (6) EIPR 191
- 14 (1993) 176 CLR 300, 25 IPR 33
- 15 Brennan, Dawson and Gaudron
- 16 (1993) 176 CLR 300 at 308
- 17 (1993) 176 CLR 300 at 311
- 18 Gleeson CJ, McHugh, Gummow and Hayne JJ
- 19 (1999) 45 IPR 353
- 20 (1999) 45 IPR 353 at 372
- 21 Prescott, "Was AutoCAD Wrongly Decided?" [1992] 14 (6) EIPR 191
- 22 (1999) 45 IPR 353 at 373 quoting Mason CJ (1993) 176 CLR 300 at 305
- 23 (1999) 45 IPR 353 at 374
- 24 Gaudron J disagreed with the majority's reconsideration of Autodesk. She argued that the look up table was "part of the set of instructions constituting the computer program"<sup>24</sup> and was not simply data or information. Regardless of whether or not the look up table was part of a set of instructions within the definition of computer program, the issue was whether the look up table was a substantial part of the computer program and she failed to accept that it was not.
- 25 The 'reserved words' were ordinary English words, concatenations of English words, words commonly used as commands in computer programs, concatenations of those

words or words otherwise derived from English words

- 26 (1999) 45 IPR 353 at 375
- 27 (1999) 45 IPR 353 at 374
- 28 (1998) 41 IPR 593
- 29 (1998) 41 IPR 593 at 618-619
- 30 see Brennan J in *Computer Edge*: (1986) 65 ALR 33 at 58
- 31 (1998) 41 IPR 593 at 629
- 32 [1894] 3 Ch 420 as cited in *Apple v Computer Edge* (1983) 50 ALR 581 at 591
- 33 In which case the stored data is protected as an adaptation, being a translation, in the same way that an object code version of a computer program is a translation of the source code version and thus entitled to protection as an adaptation of the source code (*Data Access v Powerflex* [1999] 45 IPR 353 at 377 - 378).

Alternatively, as discussed below, the amendments to the definition of reproduction in the Digital Agenda Act confirm that conversion of a work to or from a digital form is a reproduction of the work. (Digital Agenda Act 2000 (Cth.) schedule 1 items 23 - 25)

- 34 Drummond J. was correct when he said: "....it will never be possible to make out a case that one program constitutes an infringement of another computer program where the purpose of the original is to control the manufacture of an object and the alleged infringer has produced its own computer program to enable it to manufacture a like object by reverse engineering the original object, that is, by analyzing it to see how it has been constructed and then by writing its own program to identify the steps that have to be gone through to make the object" ((1998) 41 IPR 593 at 626)

The last sentence in the following passage of *Megarry VC in Brigid Foley Ltd v Elliott* ([1982] RPC 433) which Brennan J referred to in *Computer Edge* ((1986) 65 ALR 33 at 57) suggests the contrary:

"... it seems to me quite plain that there is no reproduction of the words and numerals in the knitting guides in the knitted garments produced by following the instructions. The essence, I think, of a reproduction ... is that the reproduction should be some copy of or representation of the original. I do not see how anyone looking at the knitted garment could then say 'Well, that is a copy of, or a reproduction of, the words and numerals to be found in the knitting guide.' By a process of counting up the number of stitches, and so on, in the knitted garment one might be able to work back and produce the knitting instructions; but that is a very different matter from saying that the garment is a reproduction of those instructions." ([1982] RPC 433 at 434)

The first part of this statement is not disputed. It is consistent with the famous example that making a rabbit pie is not a reproduction of the recipe for the pie. (*Cuisenaire v Reed* [1963] VR 719 at 736) However to the extent that it is suggested that a set of instructions to make a product which are created by reverse engineering

the product are an infringement of the original set of instructions the approach of Drummond J is preferred because the product embodies the idea of the instructions and holding that the instructions are infringed by reverse engineering the product is tantamount to protecting the function or idea of the instructions rather than their expression. That position now has legislative support so far a reverse engineering of a computer program is concerned. (Section 47D) As Brennan J said in *Computer Edge*: "If copyright subsisted in the...ideas...rather than in the [means] by which the ideas are expressed, copyright protection would be tantamount to the protection given by the grant of a patent." ((1986) 65 ALR 33 at 58)

- 35 (1993) 176 CLR 300 at 311
- 36 That position is not necessarily as compelling as Gaudron says. On their face the words could also be interpreted as saying that "related information" does not affect the protection of the instructions, that is, with or without the related information the instructions are protected. However, as discussed shortly, Gaudron's interpretation is consistent with the intention of Parliament.
- 37 (1993) 176 CLR 300 at 329-330
- 38 (1999) 45 IPR 353 at 381 - 382
- 39 (1999) 45 IPR 353 at 381 - 382
- 40 (1999) 45 IPR 353 at 374
- 41 (1998) 41 IPR 593 at 618 quoting from paragraph 18 of the Explanatory Memorandum. He went on to say that "[r]ecognition of this intent was central to the decision in *Autodesk v Dyason* (No.1)". It can be seen from the discussion of Autodesk above that that is not correct. The High Court in *Autodesk* held that the look up table was a substantial part of the *Widget C* program which was protected as a computer program in its own right, not as 'related information'. He then refers to the passage of Gaudron J from *Autodesk* (No.2) regarding related information quoted above and states that Brennan J agreed with Gaudron J that related information such as data could be protected as part of a computer program. It can be seen from the discussion above that Brennan J was not prepared to decide that issue.
- 42 (1999) 45 IPR 353
- 43 (1992) 173 CLR 330 at 347
- 44 (1999) 45 IPR 353 at 380, quoting paragraph 26 of the explanatory memorandum
- 45 (1999) 45 IPR 353 at 381
- 46 The Act commenced operation on 4 March 2001.
- 47 Items 35 and 37 of schedule 1 repeal the rights to broadcast a work or transmit a work to subscribers to a diffusion service and replace them with the right "to communicate the work to the public". Items 81 - 83 of schedule 1 do the same in relation to sound recordings, cinematograph films and television and sound broadcasts. Item 6 of schedule 1 inserts a definition of communicate into section 10(1).

- 48 The Digital Agenda Act implements recommendation 2.04(e) of the CLRC's 1994 Computer Software Protection report by amending the interpretation of reproduction in section 21 of the Act. However the Digital Agenda Act goes beyond the recommendations of the CLRC by extending deemed reproduction to conversion of a sound recording or cinematograph film to or from a digital or other electronic machine readable form (schedule 1 item 25, new section 21(6)) and by extending deemed reproduction of a computer program to conversion between source and object code, or vice versa, by any means, rather than just by compilation, as suggested by the Chairman, Mr. Justice Sheppard at paragraph 6.83.
- Item 23 creates the right of first digitization by inserting section 21(1A) which provides that conversion of a work to or from a digital or other electronic machine-readable form is a reproduction of the work. Item 25 of schedule 1 has the same effect in relation to sound recordings and cinematograph films by inserting section 21(6). The Intellectual Property and Competition Review Committee did not support the creation of the right of first digitisation and recommended that it be reviewed during the proposed review of the Act after it has been in operation for 3 years. (Interim Report, April 2000 page 64 and Final Report September 2000 page 98) Item 24 inserts section 21(2) which extends that deeming provision to adaptations.
- Item 25 inserts section 21(5) which provides that an object code version of a computer program which is derived from the source code is a reproduction of the source code and vice versa.
- 49 Item 84 of schedule 1 implements recommendation 2.65(a) of the CLRC's 1994 report on Protection of Computer Software by amending section 88 to make it clear that scanning a document to produce a printed copy of it will infringe the copyright in the published edition of the work, that is the typesetting. However, consistent with part 2 of the CLRC's later report on Simplification of the Copyright Act (see paragraphs 7.146 to 7.153) the Digital Agenda Act does not go on to implement recommendation 2.65(b) which would have extended published edition copyright to reproduction of a work published in a computer readable format.
- 50 See section 22
- 51 This is consistent with article 10(2) of the TRIPS agreement which provides. "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."
- 52 CLRC report on the Protection of Computer Software 1994 paragraph 14.98 "...the Committee is of the opinion that the ordinary meaning of compilation is broad enough to include [computer] databases..." and therefore they recommended in paragraph 14.64 "...that no amendment is necessary to the definition of literary work to include a reference to computer databases or to define compilation."
- 53 Digital Agenda Act 2000 (Cth.) Schedule 1 item 20 which amends the definition of 'reasonable portion' by inserting a new section 10(2A)(a)
- 54 (1991) 20 IPR 129
- 55 (1991) 20 IPR 129 at 135
- 56 (1991) 20 IPR 129 at 132
- 57 (1991) 20 IPR 129 at 135
- 58 (1991) 20 IPR 129 at 142
- 59 999 F.2d 1436 (11th cir. 1993)
- 60 In a strong dissent Hatchett J. argued that a detailed analysis of the evidence led to the conclusion that Donnelly had copied original elements of Bellsouth's directory and thereby infringed copyright.
- 61 [1992] FSR 409
- 62 Kelly v Morris (1865) 1 Eq 697, Morris v Ashbee (1868) LR 7 Eq 34 and Morris v Wright (1870) LR 5Ch 279
- 63 Intellectual Property and Competition Review Committee, Final Report, September 2000 page 107.
- Editors' note:** In Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd, the Federal Court has held that there is sufficient originality in Telstra's White Pages Directories and the contents and headings used in Telstra's Yellow Pages books, for them to be protected by copyright. By making and selling its CD-ROM products, the respondents infringed Telstra's copyrights.
- 64 Copyright Act section 32
- 65 Data Access Corporation v Powerflex Services Pty Ltd (1999) 45 IPR 353 at 373
- 66 University of London Press Ltd v University Tutorial Press Ltd [1916] 2 Ch 601 at 610
- 67 [1916] 2 Ch 601 at 608
- 68 [1964] 1 All E.R. 465
- 69 [1964] 1 All E.R. 465 at 469 per Lord Reid, 473 per Lord Evershed
- 70 [1964] 1 All E.R. 465 at 475 per Lord Hodson ("work, labour and skill"), 478 per Lord Devlin ("skill, industry or experience") and 480 per Lord Pearce ("work, skill or expense" and "labour or skill or ingenuity or expense")
- 71 [1964] 1 All E.R. 465 at 476
- 72 [1964] 1 All E.R. 465 at 478 and 480 respectively.
- 73 Interlego AG v Croner Trading Pty Ltd (1992) 25 IPR 65 at 97 per Gummow J with whom Black CJ and Lockhart J agreed ("skill and labour"), Computer Edge Pty Ltd v Apple Computer Inc. (1986) 65 ALR 33 at 39 per Gibbs CJ ("skill, judgement or labour" and "skill, labour and experience") and at 46 per Mason and Wilson JJ ("skill, time and effort"), Milwell Pty Ltd v Olympic Amusements Pty Ltd (1999) 43 IPR 32 at 38 per Lee, von Doussa and Heerey JJ ("skill, judgement or labour"), Autocaps (Aust) Pty Ltd v Pro-kit Pty Ltd [1999]FCA 1315 at 14 per Finkelstein J ("labour, skill, judgement or ingenuity") and Data Access Corporation v Powerflex Services Pty Ltd (1999) 45 IPR 353 at 375 per Gleeson CJ, McHugh, Gummow and Hayne JJ ("skill or labour") and at 381 ("skill and judgement")
- 74 The CLRC recognized in part 2 of their 1999 report on Simplification of the Copyright Act "... that there is uncertainty in Australia, and in other countries including Britain, as to the level of innovation required for a work to be 'original'" (paragraph 5.38)
- 75 Autocaps (Aust) Pty Ltd v Pro-kit Pty Ltd [1999]FCA 1315 at 14
- 76 Paragraph 14.63
- 77 Interlego AG v Croner Trading Pty Ltd (1992) 25 IPR 65 at 98
- 78 In Interlego AG v Tyco Industries Ltd [1989] AC 217 the Privy Council reached the opposite conclusion on the same facts.
- 79 Autocaps (Aust) Pty Ltd v Pro-kit Pty Ltd [1999]FCA 1315 at 15
- 80 Milwell Pty Ltd v Olympic Amusements Pty Ltd (1999) 43 IPR 32 at 39 - 40.
- 81 Dalton, G. "Copyright: Protecting Original Expression or the Efforts of Authors" (2000) 11(3) AIPJ 129 at 134
- 82 Autocaps (Aust) Pty Ltd v Pro-kit Pty Ltd [1999]FCA 1315 at 15 - 16
- 83 paragraph 14.71
- 84 Copyright Act 1968 (Cth.) section 96
- 85 Data Access Corporation v Powerflex Services Pty Ltd (1999) 45 IPR 353 at 381
- 86 Data Access Corporation v Powerflex Services Pty Ltd (1999) 45 IPR 353 at 381
- 87 Note that the program is probably entitled to copyright protection in its own right.
- 88 Section 47AB is introduced by the Digital Agenda Act and reads "In this division computer program includes any literary work that is:
- (a) incorporated in, or associated with, a computer program; and
- (b) essential to the effective operation of the function of that program."
- 89 The amendment applies to the whole of Division 4A of Part III which exempts reproduction of a computer program for normal use (s.47B), back up copying (s.47C), making interoperable products (s.47D), correcting errors (s.47E) and security testing (s.47F).
- 90 Interim Report, April 2000 page 87, although it retreated from that position in its final report after a submission from IBM that compilations are necessary for the protection of databases (Page 107).
- 91 Although they have not questioned the soundness of the English approach to date, nor referred to the American approach.
- 92 Article 3(1) provides that only a database which was an author's "own intellectual creation" could be protected by copyright.
- 93 See Adams, J. "Small Earthquake in Venezuela: The Database Regulations 1997" [1998] EIPR 129 for a discussion of the UK amendments and consequential jurisdictional complexities.
- 94 International News Service v The Associated Press (1918) 248 US 215
- 95 Moorgate Tobacco Co Ltd v Philip Morris Ltd (1984) 156 CLR 415

- 96 Fitzgerald, B. & Gamertsfelder, L. "A Conceptual Framework for Protecting the Value of Informational Products through Unjust Enrichment Law" (1998) 16 Aust Bar Review 257
- 97 February 1999
- 98 paragraph 5.33
- 99 paragraph 5.40
- 100 paragraph 5.41
- 101 The CLRC also recommended (see paragraphs 2.03 and 2.04 and chapter 5) that the simplified economic rights of reproduction and dissemination apply to creations and productions, the moral rights of attribution and integrity only apply to creations, no tangible embodiment was necessary for the subsistence of copyright, and the requirement of an author be replaced with an identifiable owner. Olswang has suggested simplifying the rights attached to material protected by copyright by replacing them with an "accessright", that is a right to control access to the protected material, on the basis that access is the touchstone of the digital age. (Olswang, S. "Accessright: An Evolutionary Path for Copyright into the Digital Era?" [1995] 5 EIPR 215)
- 102 paragraphs 5.40 and 5.55
- 103 EC Directives on the Legal Protection of Databases, Computer Programs and Duration of Copyright
- 104 Christie, A. "Simplifying Australian Copyright Law – the Why and the How" [2000] 11 AJP 40 at 53 - 54
- 105 Christie, A. "Simplifying Australian Copyright Law – the Why and the How" [2000] 11 AJP 40 at 53 - 54 footnote 70
- 106 Final Report, September 2000 page 133
- 107 CLRC 1994 report on Protection of Computer Software paragraph 14.79
- 108 CLRC 1994 report on Protection of Computer Software recommendation 2.65(b)
- 109 It would only protect published databases. Note that published edition protection lasts for 25 years from publication (Copyright Act 1968 (Cth.) section 96) rather than 15 years under the EC Directive
- 110 see paragraphs 7.146 to 7.153
- 111 Recommendation 2.42. The proposed term of protection was 25 years.
- 112 See Garrigues, C. "Databases: A Subject-matter for Copyright or for a Neighboring Rights Regime?" [1997] 1 EIPR 3
- 113 See Yastreboff, N. "Copyright for Online Databases on the Internet" (1996) 9 IPLB 33 at 38 and paragraph 5.10 in part 2 of the CLRC's report on Simplification of the Copyright Act, February 1999.
- 114 The CLRC's proposal in paragraph 5.40 of part 2 of their report on Simplification of the Copyright Act also avoids this problem by removing the requirement of an author and making originality or the "innovation threshold" the sole determinant of copyright subsistence. The new class of subject matter other than works for computer generated material recommended by the CLRC in their 1994 report on Computer Software Protection has the same effect in that regard. (Recommendation 2.42)
- 115 (1992) 39 FCR 348, 25 IPR 65
- 116 Despite referring to Interlego the CLRC expressed the opinion in their report on Computer Software Protection that a substantial change was required before a new term of copyright would commence. (paragraphs 14.66 to 14.69)
- 117 See Yastreboff, N. "Copyright for Online Databases on the Internet – Part 2" (1996) 9 IPLB 56 at 60
- 118 Article 7(2)(a) provides that "extraction shall mean the permanent or temporary transfer of all or a substantial part of the contents of a database to another medium by any means or in any form"
- 119 Article 7(2)(b) provides that "re-utilization shall mean any form of making available to the public all or a substantial part of the contents of a database by the distribution of copies, by renting, by on-line or other forms of transmission. The first sale of a copy of a database within the Community by the right holder or with his consent shall exhaust the right to control resale of that copy within the Community; Public lending is not an act of extraction or re-utilization."
- 120 Article 7(4)
- 121 Article 10(1)
- 122 paragraphs 14.75 – 14.80
- 123 Hodge, G. "After the EU directive: The Impact of European database protection on stakeholder groups" Feb/Mar 2000 Vol. 26 Issue 3 Bulletin of the American Society for Information Science 25
- 124 Lim, L. "US Digital Millennium Copyright Act" vol. 2 no. 1 February 1999 Internet Law Bulletin 11
- 125 Hodge, G. "After the EU directive: The Impact of European database protection on stakeholder groups" Feb/Mar 2000 Vol. 26 Issue 3 Bulletin of the American Society for Information Science 25
- 126 Valente, D. "Database Protection in the Next Century" (June 2000) Vol. 17 Issue 6 Information Today 1,82
- 127 Such as under section 47H relating to the acts in sections 47B to 47F which are exceptions to infringement of computer programs, for example reverse engineering to make interoperable programs (s.47D)
- 128 Clark, C. "The answer to the Machine is the Machine" Proceedings of Knowright 1995 cited in Vinje, T. "A Brave New World of Technical Protection Systems: Will There Still be Room for Copyright?" [1996] 8 EIPR 431
- 129 Whitelaw, C. "Copyright and the Internet – An Appraisal of the Government's Digital Agenda Reforms Part 2" (March 2000) Vol. 12 No. 8 IPLB 81 at 86
- 130 Vinje, T. "Copyright Imperiled?" (1999) 21(4) EIPR 192 at 201
- 131 Item 4 of schedule 1 of the Digital Agenda Act inserts the following definition of circumvention device into section 10(1) of the Copyright Act:  
"circumvention device means a device (including a computer program) having only a limited commercially significant purpose, or no such purpose or use, other than the circumvention of an effective technological protection measure."
- 132 The permitted purposes are set out in s.116A(7)(b) and are: reproducing computer programs to make interoperable products, correct errors and conduct security testing (ss. 47D, 47E and 47F), library and archive exceptions (ss. 49, 50 and 51A), parliamentary libraries (s.48A), disability exceptions (Part VB) and use by the Crown (s.183).
- 133 Paragraph 4.12, page 60
- 134 Paragraph 4.19, page 62
- 135 The committee recommended that section 47F be expanded to permit a broader range of security testing and that the permitted purposes in section 116A(7)(b) be extended to include section 47B(3) which relates to studying the ideas behind a computer program and section 51A which relates to creating preservation copies of manuscripts or original artistic works. Only the last of those suggestions was enacted, however the exception relating to parliamentary libraries was also included in the Act (section 48A).
- 136 Paragraph 4.56, page 70
- 137 Notably fair dealing for the purpose of research or study (s.40), criticism or review (s.41), reporting news (s.42) and reproduction for the purpose of judicial proceedings or professional advice (s.42), amongst others, are not permitted purposes for which a circumvention device may be imported, made or sold.
- 138 Item 15B of schedule 1 of the Digital Agenda Act inserts the following definition of technological protection measure into section 10(1) of the Copyright Act:  
"technological protection measure means a device or product, or a component incorporated into a process, that is designed, in the ordinary course of its operation, to prevent or inhibit the infringement of copyright in a work or other subject matter by either or both of the following means:  
(a) by ensuring that access to the work or other subject matter is available solely by use of an access code or process (including decryption, unscrambling or other transformation of the work or other subject matter) with the authority of the owner or licensee of the copyright;  
(b) through a copy control mechanism."
- 139 Recommendation 3, paragraph 3.49, page 36
- 140 Intellectual Property and Competition Review Committee Final Report, September 2000 page 101
- 141 Autodesk v Dyason (1992) 173 CLR 330
- 142 Coogi v Hysport (1998) 41 IPR 593
- 143 Autodesk v Dyason (No.2) (1992) 25 IPR 33 and Coogi v Hysport (1998) 41 IPR 593
- 144 Autodesk v Dyason (1992) 173 CLR 330, Coogi v Hysport (1998) 41 IPR 593 and Data Access v Powerflex (1999) 45 IPR 353
- 145 As the US Supreme Court said in Feist Publications Inc. v Rural Telephone Service Inc. [1991] 20 IPR 129 at 132 "The sine qua non of copyright is originality"
- 146 Computer Edge Pty Ltd v Apple Computer Inc. (1986) 65 ALR 33 at 39 per Gibbs CJ