

*Intellectual Property: Commentary and Materials* by M. L. Blakeney and J. McKeough. (The Law Book Company Limited, Sydney, 1987) pages 1–741. Price \$80.00 (hardback) \$59.50 (soft cover). ISBN 0 455 20694 5 (hardback) ISBN 0 455 20695 3 (soft cover).

The importance of intellectual property in the curricula of Australian Law Schools has increased enormously in the past 15 years. At the beginning of this period, it was taught in only three faculties: A.N.U., Sydney and Monash; it is now offered, in one form or another, in almost all. The numbers of students taking the subject have also grown dramatically. This year, at Melbourne alone, nearly 160 students are enrolled. In its early stages, teaching was not easy as there was a complete lack of adequate student texts and other teaching materials. This was also the case in the United Kingdom where the teaching and academic study of the subject was more firmly established. Starting with the publication of authoritative textbooks by Professors Lahore and Cornish<sup>1</sup> in the late 1970s, this situation has steadily changed and the appearance of the first Australian casebook on the subject represents the culmination of this process of development.

The authors, Michael Blakeney and Jill McKeough, are well qualified for the task they have undertaken. They have jointly taught intellectual property in the University of New South Wales for several years and have made some notable contributions to the academic literature, notably in the areas of passing off and Part V of the Trade Practices Act 1974. In their preface, they describe their book as the 'first attempt in this country to organise for students a collection of the cases and materials which provide the foundations for industrial and intellectual property protection'. They allude to the difficulties of this task, in view of the 'gargantuan proportions' of many of the increasing number of cases in this area, and state, therefore, that one of their aims has been 'to make the relevant extracts of cases available to students in digestible quantities'. In doing this, they make clear their preference for modern authorities rather than ancient ones, particularly where the former review the established principles and earlier cases. They have also sought to include statutory extracts where appropriate so as to have all the relevant materials readily available in the space of one volume. On the other hand, they make it clear that they have dealt only with the administrative details of the various intellectual property regimes insofar as is necessary to explain the basis of legal reputation.

Before attempting an evaluation of this book, it is appropriate to say something about casebooks in general and the philosophy underlying them. In my view, the preparation of a casebook is one of the most difficult tasks that a legal academic can undertake, particularly if the cases are wedded (as in this instance) to some form of commentary. The casebook is predicated on a particular method of teaching, namely the Socratic or discussion method in which the essential feature is the interaction between teacher and student on the basis of the material contained in the casebook. It therefore follows that the teacher will be concerned with the following matters when considering the appropriateness of a particular casebook for his or her subject: the arrangement of subject-matter; the selection of extracts and the kind of extracts; the suitability of the linking commentary; and appropriate questions and problems for class discussion. The relative importance of these components will obviously differ from subject to subject. In some, the subject-matter itself will dictate the order in which it is to be presented; in others, there may be a wide variety of ways in which this can be done. Again, there may only be a need for minimal commentary in some subjects; in others, far more may be required if any sense is to be made of the extracts which have been selected. Finally, it must be said that, in judging a casebook, due allowance must be made for the personal preference of the particular teacher; inevitably, there will be some aspects of even the best casebook, whether it be in the arrangement or selection of material, the commentary or questions, that an experienced teacher will disagree with.

How does Blakeney and McKeough's book deal with the various matters listed above? If we take the question of arrangement first, there is little to criticize here. The authors begin with a general chapter on 'the dimensions of Industrial and Intellectual Property' in which they discuss the definition

<sup>1</sup> Lahore, J. C., *Intellectual Property in Australia: Copyright* (1977); Cornish, W. R., *Intellectual Property Patents, Copyright, Trademarks and Allied Rights* (1981). More recently, see Ricketson, S., *The Law of Intellectual Property* (1984) and Phillips, J., *Introduction to Intellectual Property* (1986).

of the subject-matter, its scope and justifications for protection. They then deal, in succeeding chapters, with each of the principal fields of intellectual property: copyright, industrial designs, protection of business reputation (passing off, Part V of the Trade Practices Act and other relevant torts), trade marks, patents and trade secrets. They conclude with a chapter on remedies and enforcement. This last chapter might better have come after the first, as these matters are largely common to each of the principal intellectual property regimes. For ease of teaching, it is therefore preferable to deal with the general principles governing the grant of injunctions, accounts of profits and *Anton Piller* orders at the start of a general intellectual property course. On the other hand, it is more appropriate to deal with the matter of damages separately under each regime, as the principles affecting the award of damages and their assessment differ markedly in each instance (most notably in the case of copyright). The authors also state, in their preface, that they had intended to include a general chapter on the international aspects of intellectual property protection, but this was omitted due to constraints of space. The necessity for such a decision is highly regrettable, although, as with damages, the need for a separate chapter on this subject may be questioned: on the whole, international questions are best dealt with separately in relation to each individual intellectual property right. As a matter of fact, the authors do this in the chapters dealing with trade marks and designs, where they have inserted brief sections dealing with international protection. Nothing further, however, is to be found in any of the other chapters. On the other hand, the book seems incomplete without some distinct chapter or section that deals with the relationship between intellectual property rights and the provisions of Part IV of the Trade Practices Act. Only the briefest reference is made to these matters, but a separate chapter would have been fully justified.

Subject to these reservations, the overall arrangement of subject-matter in the book is satisfactory, but I have more doubts about the arrangement of material within the chapters themselves. The copyright chapter contains a good general framework, but there are some significant gaps. For example, while there are separate headings for broadcasting, diffusion and adaptation, there is no material given under any of these headings apart from the barest statutory references. There is no separate heading for the important issue of moral rights, and the absence of any material on international copyright, as mentioned above, gives a one-dimensional view of the subject-matter. Furthermore, it seems strange that the section on civil remedies deals with damages for infringement of copyright, while damages for conversion (a remedy peculiar to copyright) is dealt with in the final chapter on remedies and enforcement. The chapter on industrial designs also suffers from a major structural defect: the question of overlap with copyright protection is dealt with before the material on the design system itself. In teaching students, however, personal experience indicates that it is usually necessary to adopt the reverse order as it is otherwise difficult to elucidate the difficult area of overlap in the absence of some prior appreciation of the workings and requirements of the designs system.

The ordering of the material in the chapters on passing off and trade marks is well suited for teaching purposes, but again there are some gaps. Under passing off, there is no heading for the question of damage, although a case that is relevant to this issue (*Henderson v. Radio Corporation*)<sup>2</sup> is dealt with under the heading of 'Damages'. There is also no separate treatment of any of the cases that deal with extensions to passing off and the possible development of a general tort of unfair competition. While the '*Advocaat*'<sup>3</sup> and '*Pub Squash*'<sup>4</sup> cases are extracted in the section dealing with the elements of the action, the wider implications of these cases are not drawn out, nor is there any reference back to *Moorgate v. Philip Morris*<sup>5</sup> which is extracted in the first chapter. These points can certainly be referred to in class discussion by a teacher, but there is little, if anything, in the book to suggest how this should be done.

The arrangement of the chapter on patents is also defective in some respects. It includes several of the leading cases on prior claiming under the general heading of novelty without some explanation as to why this unusual classification has been adopted. In addition, the reason for separate headings for 'Inutility, False Suggestion and Fair Claiming' and 'Complete Specification' is far from clear and

<sup>2</sup> [1960] S.R. (N.S.W.) 576.

<sup>3</sup> *Erven Warninck Besloten Venootschap v. J. Townend & Sons* [1979] A.C. 731.

<sup>4</sup> *Cadbury-Schweppes Pty Ltd v. The Pub-Squash Ltd* [1980] 2 N.S.W.L.R. 865.

<sup>5</sup> *Moorgate Tobacco Co. Ltd v. Philip Morris Ltd (No. 2)* (1984) 156 C.L.R. 414.

could lead to confusion. As for the chapter on trade secrets, as with the chapter on designs, the order in which the material is presented can give rise to problems for the teacher. While this may largely be a matter of personal preference, it seems easier to teach the elements of the action before examining the nature of the interest protected. In other words, students need to know what the action does before they can really begin to discuss the vexed question of its jurisdictional basis in any meaningful way.

None of the criticisms made above are in themselves major, but they will create certain difficulties for teachers. Reference to additional materials will be necessary in some instances; in other cases, it will be necessary to use the material in the book in a different sequence to that which is given by the authors.

As regards the selection of the material, this raises different concerns. The choice of suitable extracts for teaching purposes is often a matter of personal preference; in many instances, one case will serve equally as well as another to illustrate a particular point or principle and there can be no ground for complaint here if a favourite case is omitted in favour of another. In general, the case selection by Blakeney and McKeough is good. There is only one instance where I would directly question their choice and this is the curious decision of Brinsden J. in *Rodney Keft & Kemalda v. Commissioner of Police (W.A.)*<sup>6</sup> concerning works of artistic craftsmanship. Apart from this, my reservations relate more to the number of cases extracted on particular points and the authors' concentration on case extracts to the virtual exclusion of other material. Thus, the authors have often preferred to give extracts from a number of cases dealing with a topic rather than concentrating on one or two principal cases which can be elaborated upon by commentary. This is particularly so in the chapter on passing off, where there are some 27 pages of extracts dealing with the *locus* of protectable reputation alone. By contrast, there are some headings which have little or no material extracted under them: for example, broadcasting, diffusion and adaptation in chapter 2 on copyright, acts not constituting infringement in chapter 5 on trade marks, and making, using, vending and exercising an invention in chapter 6. In none of these cases, is it really possible to plead constraints of space by way of justification for these omissions, as deletions could readily have been made elsewhere. In the patents and designs chapters, it is also a pity that the authors did not include drawings or illustrations where these were available, as some cases in these areas are very difficult to understand in the absence of some visual representation of the subject-matter concerned. As for the kinds of extracts chosen, for the most part these are cases but there are some sizeable slabs of statutory materials, particularly in chapter 7 on patents (pages 507-27). The need to include such material must be questioned as students should have the text of each principal Act themselves. Furthermore, the provisions themselves are constantly subject to amendment and the provisions extracted in the casebook will, therefore, soon become outdated. On the other hand, there is a dearth of other relevant material, such as extracts from government reports, committees of inquiry and reform proposals. Such material provides a useful basis for discussion and there is no shortage of it both in this country and overseas. Again, extracts from other secondary sources, such as articles and monographs, could have been utilized in a number of places where there is a shortage of case law or where such material is not really relevant. This is particularly so in the chapter on copyright, where the only place in which an extract of this kind is used by the authors is the interesting account of collecting societies by Brett Cottle. More material of this kind, however, could have been used to illuminate such areas as broadcasting and diffusion, particularly in relation to technical matters such as satellite transmission. Again, in chapter 1, extracts from some of the articles that are referred to in the commentary and notes could have provided a stimulating basis for class discussion.

As regards connecting commentary, this is another matter which is largely a question of personal preference. Wide differences in the *quantum* of commentary are to be found in many of the established Australian casebooks. In some notable instances, such as Sackville and Neave's *Property Law Cases and Materials*,<sup>7</sup> there is almost as much text as extracted material. On the other hand, the commentary which is provided by Blakeney and McKeough, though often perceptive, seems too sparse and tends too often to pass over important questions, with nothing more than a reference to some appropriate secondary source. All of these references are pertinent and useful, but, again, one

<sup>6</sup> (1985) A.I.P.C. 90-236.

<sup>7</sup> Sackville, R. and Neave, M., *Property Law Cases and Materials* (3rd ed. 1981).

wishes that something more by way of explanation and exposition appeared in the commentary itself. This is particularly so in the case of the bare headings referred to above; in the absence of suitable extracts, brief textual comments would have served to elucidate the difficult issues involved in such areas as broadcasting, satellite transmission and so on.

The fourth component suggested above for a good casebook was the inclusion of suitable questions. In many respects, these can give life and form to the extracted materials and commentary, providing the focus for discussion in class as well as a stimulus to private thought by students. They can draw out salient points and furnish an opportunity for students and teachers to attempt an overview of a particular area. Longer problems with detailed fact situations can also serve as an appropriate introduction or conclusion to a particular topic: what student of criminal law will ever forget the opening problem dealing with the case of *Dudley v. Stevens*<sup>8</sup> in chapter 1 of Brett and Waller's *Criminal Law Cases and Text*?<sup>9</sup> In this regard, however, Blakeney and McKeough offer relatively little stimulus by way of questions and this is to be regretted, particularly from the point of view of a teacher who is new to the subject.

Two further comments need to be made about the layout and presentation of this book. First, the table of contents could well have been expanded, taking as a model the format adopted in other casebooks, such as Sackville and Neave's *Property Law Cases and Materials*, in which the table of contents also lists the principal cases and materials extracted. Such a presentation makes it easier for the reader to gain a general overview of the material covered in each chapter. Secondly, the layout of some of the commentary sections is not always clear: within these, there are often further passages which are quoted and it is sometimes difficult to be sure where the quoted passage and the authors' comments begin and end (for example, pages 225-7).

While the preceding comments may sound negative in tone, their effect should not be exaggerated: there can be no doubt that Blakeney and McKeough have provided a valuable collection of materials for teaching purposes. In particular, they must be commended for their inclusion of important New Zealand decisions, the relevance of which might otherwise be overlooked by Australian lawyers. Moreover, the regular bibliographical notes throughout the book are extremely useful. The matters that I have mentioned can be easily rectified in the preparation of a second edition, when, it is to be hoped, more space and time are allowed for this task by the publisher. The present casebook, however, will still be of the greatest use to those teachers who are commencing to offer the subject of intellectual property in their Law Schools. It will also be a useful reference for teachers and students of those courses which are already established.

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<sup>8</sup> 14 Q.B.D. 273; [1881-5] All E.R. Rep. 61.

<sup>9</sup> Brett, P., and Waller, P. L., *Criminal Law Cases and Text* (3rd ed. 1971) 67.

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