

# Men at Work

## case illustrates importance of IP due diligence

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The recent copyright decision surrounding the Men at Work hit, *'Down Under'*, emphasises the importance of ensuring a clear chain of title to intellectual property.

The Federal Court handed down its judgment on the preliminary issue of copyright ownership last month after Larrikin Music Publishing Pty Ltd (**Larrikin**) instituted proceedings against EMI Songs Australia Pty Limited (**EMI**).

Larrikin had claimed that the flute riff in *'Down Under'* infringes copyright in the classic children's tune 'Kookaburra sits in the old gum tree' (**Kookaburra song**).

Before the issue of copyright infringement could be considered, the court had to first consider whether Larrikin was in fact the owner of the copyright in the Kookaburra song.

The Kookaburra song was authored by Marion Sinclair in 1934 and was the winner of a Victorian Girl Guides competition in the same year. One of the rules for entry into the competition was that 'All matter entered to become the property of the Guide Association'.

EMI contended that by virtue of its entry into the competition copyright in the Kookaburra song was assigned to the Guide Association thereby depriving Larrikin of the ownership of copyright in the song and its subsequent right to sue EMI for infringement.

On this point the court found that various circumstances surrounding Ms Sinclair's entry of the song into the competition:

- did not indicate an intention of Ms Sinclair to assign copyright in the song to the Guides, and
- that Ms Sinclair had not entered into a contract binding her to the terms of entry of the competition.

Given that no assignment of copyright was found, the question of whether such an assignment was in writing and signed by the Author as is required under the *Copyright Act 1968* (Cth) and its predecessor, did not need to be finally decided. However, the Judge did comment that Ms Sinclair signing the manuscript for the Kookaburra song before submitting it for the competition did not satisfy the requirement for writing and merely acted as a means to identify her work.

As Ms Sinclair retained the copyright in the Kookaburra song and there was no assignment to the Guides association it needed to be determined whether Larrikin was the owner of the copyright.

While Larrikin had obtained an assignment of the copyright in the Kookaburra song from the Public Trustee to whom Ms Sinclair had bequeathed her estate, a subsequent issue as to ownership arose.

Before her death Ms Sinclair donated amongst other things an adaptation of the Song to the Libraries Board of South Australia. When donating the manuscript Ms Sinclair signed a document which contained a term vesting the copyright in the manuscript to the library upon her death.

Upon finding out about the Libraries Board's interest in the Kookaburra song, the three parties, Larrikin, the Public Trustee and the Libraries Board entered into a deed whereby the parties agreed that the Libraries Board obtained the copyright on the death of Ms Sinclair and that such copyright was assigned to Larrikin. The parties later confirmed this position by entering into a Deed of Confirmation.

Without coming to a conclusion about the competing rights of the Libraries Board and the Public Trustee, the court found that copyright was owned by one of the parties, and both parties had subsequently assigned the copyright in the Kookaburra song to Larrikin. The result being that Larrikin was held to be the owner of the copyright in the Kookaburra song.

This case comes as a timely reminder of the importance of clearly documenting the chain of title in relation to intellectual property rights.

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establish proprietary rights.

Also highlighted by this case is the importance of conducting a thorough due diligence. If acquiring intellectual property rights it is

important to determine that the party the intellectual property rights are being acquired from actually has the right and ability to grant those rights.

The importance of documenting the transfer of any rights in intellectual property is certainly made clear by this case.

It is also crucial to understand conducting a due diligence before acquiring any intellectual property rights may save issues such as those demonstrated in this case arising at a later and possibly more critical time, such as at a time when trying to enforce those rights. ↓

## Hugh Macken joins legalsuper Board

Hugh Macken, the Law Society of New South Wales' 2008 President, had been appointed to its Board on the nomination of the Law Society of New South Wales.

Mr Macken replaced outgoing Board member, Robert Laurie.

Mr David Miles, legalsuper Chairman, said Mr Macken's appointment maintained the strong bond between legalsuper and the Australian legal sector.

legalsuper was established by legal professionals to serve the

interests of the legal sector, interests that Mr Macken has supported throughout his long career within the profession.

During his seven years with the Law Society, including a year as its President, Mr Macken chaired numerous committees and worked tirelessly with other members to promote justice and law reform, and tackle issues relevant to the legal profession.

Mr Macken has worked in private legal practice for over 20 years and is a partner at Sydney law firm, Beston Macken McManis.

He has extensive experience in industrial relations matters, dispute resolution and litigation and is an Accredited Specialist in personal injury law and has a Master of Laws from the University of Technology, Sydney.

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