PROTECTION OF COMPILATIONS AND DATABASES AFTER *ICETV*: AUTHORSHIP, ORIGINALITY AND THE TRANSFORMATION OF AUSTRALIAN COPYRIGHT LAW

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In IceTV Pty Ltd v Nine Network Australia Pty Ltd, the High Court transformed Australian copyright law, by placing a new emphasis on the role of an author or authors in producing original works. The centrality now required to be given to authorship has focused attention on important subsidiary questions, which have yet to be satisfactorily resolved in the case law. These questions include: What is needed to establish that a work originates from an author? When will the use of computers in producing a work result in a denial of copyright on the basis that there is insufficient human authorship? And what conditions must be satisfied for multiple human contributors to qualify as joint authors? Resolving these issues is especially important in determining the extent to which the new Australian copyright law protects informational works, such as directories. In examining these issues, this article critically analyses the reasoning in IceTV and its progeny, concluding that a failure to sufficiently engage with Anglo-Australian precedent has created avoidable uncertainties and ambiguities in central legal doctrines of Australian copyright law. The article also identifies internal contradictions in the reasoning in the judgments in IceTV, which have further compromised the coherency of the law. The article concludes that greater consistency and coherency in Australian copyright law can only be achieved by frankly acknowledging both the extent to which IceTV departed from precedent and the flaws in the reasoning of the plurality judgments in that landmark case.

I INTRODUCTION

In 1858, in *MacLean v Moody,*[1] the complainers claimed that copyright in *The Clyde Bill of Entry and Shipping List,* which consisted of a regular digest of customs and shipping information for the Clyde River, had been infringed by Andrew Moody, who had systematically copied and re-published the most important information from the complainers' compilations. In defence, Moody claimed that copyright did not subsist in the publications because the complainers were not the authors of the compilations, nor had they sufficiently identified the authors. Lord Deas in the Scottish Court of Session rejected the respondent's case,

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1 (1858) 20 Sess Cas 1154.

describing the arguments as 'ingenious' but 'unsound'.[2] Subsequently, *MacLean v Moody* was endorsed by Lord Halsbury LC in *Walter v Lane*,[3] where the House of Lords held that reporters were the authors of verbatim transcripts of speeches delivered by Lord Rosebery.

While the decision in *Walter v Lane* remains controversial,[4] English courts have never questioned the principle derived from *MacLean v Moody*, that copyright can subsist in a work such as a directory without the need to specifically identify an author or authors. Following the landmark decision of the High Court in *IceTV Pty Ltd v Nine Network Australia Pty Ltd*,[5] however, Australian copyright law has been transformed, with a new centrality given to the role of an author or authors in originating works.

This has given rise to significant new questions about the role of authorship in Australian copyright law. First, there are questions about what is needed to establish that a work originates from an author, including whether it is now necessary to specifically identify an author or authors. Secondly, the importance given to human authorship has directed attention to the use of computers in producing works, and when protectable expression can be attributed to humans and when to a computer program. Thirdly, as works such as directories are usually produced by many contributors, there are questions about when multiple contributors are joint authors.

The new centrality of authorship, which is the focus of this article, is but one instance of a broader transformation of Australian copyright law wrought by *IceTV*. As the reasoning in that case has implications for most aspects of copyright subsistence and infringement, this article cannot hope to do justice to all of the complex issues raised by the case. In particular, the article does not deal with important parts of the reasoning relating to the principle that copyright protects expression and not facts (known as the 'fact/expression dichotomy') and the role of statutory presumptions relating to authorship, especially the presumption that applies when a publisher, but not an author, is identified.[6] In order to deal satisfactorily with the reasoning relating to authorship, however, the article also necessarily critically analyses the treatment of originality, which is the concomitant of authorship, in both the contexts of subsistence and of infringement.

The main argument of this article is that, especially in the treatment of authorship of compilations, such as directories and databases, the transformation of Australian copyright law by *IceTV* and its progeny has been made with insufficient regard to precedent. The article also claims that the reasoning of both of the judgments delivered in *IceTV* is marred by internal inconsistencies, which have resulted in

2 Ibid 1163.

3 [1900] AC 539, 548.

4 See, eg, Nigel P Gravells, 'Authorship and Originality: The Persistent Influence of *Walter v Lane*' [2007] *Intellectual Property Quarterly* 267; Justine Pila, 'An Intentional View of the Copyright Work' (2008) 71(4) *Modern Law Review* 535; William Cornish, 'Conserving Culture and Copyright: A Partial History' (2009) 13(1) *Edinburgh Law Review* 8.

5 (2009) 239 CLR 458 ('*IceTV*').

6 *Copyright Act 1968* (Cth) s 128.

unnecessary uncertainties, and some incoherence, in Australian copyright law. The difficulties associated with the reasoning are disappointing in a decision that has substantially removed copyright protection for many informational works, especially directories and databases, which were previously thought to be protected. To be clear, however, the article is not concerned with the complex policy issues relating to whether or not works, such as directories and databases, should be protected by copyright and, if so, how. The more modest objectives of the article are to explain how the reasoning in *IceTV* and its progeny is out of step with established precedent, identify some of the problems with the reasoning in *IceTV* and its progeny, and suggest that a better understanding of precedent might lead to greater certainty and coherence in this important area of the law.

The article has three main parts. The first part explains the reasoning of both plurality judgments of the High Court in *IceTV,* critically analysing the complex treatment of the related concepts of authorship and originality. The second part examines how the issues arising from the new approach to authorship and originality were dealt with in the main case to address these issues since *IceTV*, the decision of the Full Federal Court ('FFC') in *Telstra Corporation Ltd v Phone Directories Co Pty Ltd*.[7] The third part explains how the reasoning in *IceTV* and its progeny is at odds with long established precedent relating to the protection of works such as directories, especially given the new understanding of originality, authorship and joint authorship. The article concludes with some observations about the reasoning in *IceTV* and its progeny, and how an insufficient regard for precedent has left the law in an unsatisfactory state.

II AUTHORSHIP AND ORIGINALITY IN *ICETV*

Shortly before the US Supreme Court decision in *Feist Publications Inc v Rural Telephone Service Co*,[8] Jane Ginsburg pointed out that the coherence of copyright law was undermined by the extent to which it protects both 'high authorship' works, in which the personal imprint of an author is clearly discernible, and 'low authorship' works, meaning informational works such as directories, in which it is difficult to detect an authorial presence but which, nevertheless, require the expenditure of considerable labour and resources.[9] As Ginsburg went on to explain, copyright cases in the 18th and early 19th centuries were predominantly concerned with informational works, such as maps, primers and calendars,[10] and not with the sorts of 'creative' works more commonly associated with individual authorship. It was only in the 19th century, partly under the influence of the Romantic movement, that some common law courts began to adopt a view of

7 (2010) 194 FCR 142 ('*PDC*').

8 499 US 340 (1991) ('*Feist*').

9 Jane C Ginsburg, 'Creation and Commercial Value: Copyright Protection of Works of Information' (1990) 90 *Columbia Law Review* 1865.

10 See, eg, *Sayre v Moore* (1785) 1 East 361n, 102 ER 139n; *Cary v Kearsley* (1802) 4 Esp 168, 170 ER 679; *Mathewson v Stockdale* (1806) 12 Ves Jr 270, 33 ER 103; *Longman v Winchester* (1809) 16 Ves Jr 269, 33 ER 987.

the copyright work as the embodiment of the personality of an author, thereby creating significant internal tensions within doctrinal copyright law.[11] The distinction between the 'high authorship' and 'low authorship' paradigms was most glaring in the different approaches adopted to the originality threshold for compilations of factual material, with some courts applying a lower 'sweat of the brow' or 'industriousness' standard, which would protect labour expended in the collection of material to include in a compilation, and other courts applying a higher 'creativity' standard.[12]

The tension between the protection of the labour and resources expended in producing informational works, on the one hand, and the protection of creative expression, on the other, came to a head in the US in the 1991 *Feist* decision, which concerned copyright in a white pages telephone directory. In that case, the US Supreme Court reached an accommodation, of sorts, between the two views of copyright by interpreting the originality threshold as requiring that, in addition to not being copied, an original work must possess a minimal degree of creativity, or 'creative spark'.[13] Although Ginsburg subsequently claimed that *Feist* endorsed a 'high authorship' view of copyright,[14] in practice this means little more than that, under US law, informational works, such as directories and databases, can be protected only to the extent they embody independent arrangement or selection.[15]

A similar, but different, accommodation was reached under Canadian law. Initially, in a case concerning copyright in a yellow pages directory, *Tele-Direct (Publications) Inc v American Business Information Inc*,[16] the Federal Court of Appeal adopted the *Feist* 'minimal creativity' standard. Subsequently, however, in *CCH Canadian Ltd v Law Society of Upper Canada*,[17] the Canadian Supreme Court rejected a 'creativity' standard in favour of requiring a minimum amount of 'skill and judgment' (as opposed to labour).[18] By rejecting both an 'industrious labour' standard, on the one hand, and a 'creativity' standard, on the other, the Court attempted to walk a middle path. In practice, however, the *CCH* standard,

11 The classic example of the Romantic theory of authorship is Edward Young, *Conjectures on Original Composition* (Scolar Press, 1759). For the influence of the Romantic authorship paradigm on copyright law see Martha Woodmansee, 'The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the "Author"' (1984) 17 *Eighteenth Century Studies* 425; Peter Jaszi, 'Toward a Theory of Copyright: The Metamorphoses of "Authorship"' [1991] *Duke Law Journal* 455; Mark A Lemley, 'Romantic Authorship and the Rhetoric of Property' (1997) 75 *Texas Law Review* 873.

12 Abraham Drassinower, 'Sweat of the Brow, Creativity, and Authorship: On Originality in Canadian Copyright Law' (2004) 1 *University of Ottawa Law & Technology Journal* 105; Carys J Craig, 'The Evolution of Originality in Canadian Copyright Law: Authorship, Reward and the Public Interest' (2005) 2 *University of Ottawa Law & Technology Journal* 425; Miriam Bitton, 'Trends in Protection for Informational Works under Copyright Law during the 19th and 20th Centuries' (2006) 13 *Michigan Telecommunications and Technology Law Review* 115.

13 *Feist,* 499 US 340, 345–6 (1991).

14 Jane C Ginsburg, 'No "Sweat"? Copyright and Other Protection of Works of Information after *Feist v Rural Telephone'* (1992) 92 *Columbia Law Review* 338, 341.

15 Ibid 348.

16 [1998] 2 FC 22 ('*Tele-Direct*').

17 (2004) 236 DLR (4th) 395 (Supreme Court of Canada) ('*CCH*').

18 Ibid 412 [24].

much like *Feist*, means that compilations will be protected only if they display a minimum degree of arrangement or selection.

Despite the different formulations adopted in the US and Canada, in both legal systems the extent of protection of compilations of predominantly factual material has been formulated mainly through the lens of the 'originality' threshold: a minimum amount of 'creativity' (in the US) or a minimum amount of 'skill and judgment' (in Canada). In *IceTV,* however, the Australian High Court reached a more ambiguous accommodation between the two copyright paradigms. And it did so not through the lens of the originality threshold, but by emphasising that copyright protects the original expression of *authors,* primarily meaning 'creative authors'. In order to understand the extent to which the law has been changed by *IceTV* and its progeny, it is first necessary to explain the Anglo-Australian law on authorship and originality as it was prior to *IceTV.*

A *Authorship and Originality before* IceTV

Prior to *IceTV,* Anglo-Australian law on originality comprised two related principles: a principle that material must originate from an author, in the sense that it is not copied (known as the 'not copied/originating from the putative author' test);[19] and a threshold establishing a minimum authorial contribution, below which copyright would not subsist (known as the 'originality threshold').[20] The formulation of the principles can be traced to the influential 1845 judgment of Story J in *Emerson v Davies*,[21] which effectively synthesised the existing English case law.

That case concerned an allegation of infringement of copyright in an elementary arithmetic text, with the defendant claiming that the text was insufficiently original. Story J first turned to the 'not copied/originating from the putative author' test, stating that:

> The book of the plaintiff is, in my judgment, new and original, in the sense in which those words are to be understood in cases of copy-right. The question is not, whether the materials which are used are entirely new, and have never been used before; or even that they have never been used before for the same purpose. The true question is, whether the same plan, arrangement and combination of materials have been used before for the same purpose or for any other purpose. If they have not, then the plaintiff is entitled to a copy-right …[22]

19 *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 119 FCR 491, 517 [87].

20 These two principles, or 'component parts', are recognised in the academic literature cited in *IceTV*: see, eg, Michael Birnhack, 'The Dead Sea Scrolls Case: Who is an Author?' (2001) 23 *European Intellectual Property Review* 128; Ronan Deazley, 'Copyright in the House of Lords: Recent Cases, Judicial Reasoning and Academic Writing' [2004] *Intellectual Property Quarterly* 121.

21 8 F Cas 615 (Mass CC, 1845).

22 Ibid 618–19.

After originality became a statutory requirement under the *Copyright Act 1911* (UK) the test was adopted by Peterson J in *University of London Press Ltd v University Tutorial Press Ltd*,[23] and authoritatively approved by the High Court in *Sands & McDougall Pty Ltd v Robinson*.[24]

The first principle leaves unanswered the characterisation of the authorial contribution required for copyright to subsist. Turning to this, and relying on English precedent,[25] Story J explained the second principle as follows:

> He, in short, who by his own skill, judgment and labor, writes a new work, and does not merely copy that of another, is entitled to a copy-right therein; if the variations are not merely formal and shadowy, from existing works.[26]

This formulation of the originality threshold was effectively adopted by the Privy Council in *Macmillan & Co Ltd v Cooper*, with Lord Atkinson formulating it in the following terms:

> It will be observed that it is the product of the labour, skill, and capital of one man which must not be appropriated by another, not the elements, the raw material, if one may use the expression, upon which the labour and skill and capital of the first have been expended.[27]

Following from this, his Lordship turned to the amount and kinds of skill and labour required, stating:

> What is the precise amount of the knowledge, labour, judgment, or literary skill or taste which the author of any book or other compilation must bestow upon its composition in order to acquire copyright in it within … cannot be defined in precise terms. In every case it must depend largely on the special facts of that case, and must in each case be very much a question of degree …[28]

These issues were taken up in subsequent English cases, which were concerned with works with borderline levels of originality. In *GA Cramp & Sons v Frank Smythson*,[29] the House of Lords was required to consider the subsistence of copyright in a commonplace selection of informational material included in the preliminary pages of a pocket diary. As part of a unanimous decision that the selection lacked originality, Lord Porter stated that 'if the work, labour and skill required to make the selection and to compile the tables which form its items is negligible, then no copyright can subsist …'[30]

23 [1916] 2 Ch 601, 608–9.

24 (1917) 23 CLR 49, 56 (Isaacs J expressly endorsing Story J's 'reasoned judgment').

25 *Matthewson v Stockdale* (1806) 12 Ves 270; 33 ER 103; *Wilkins v Aikin* (1810) 17 Ves 422; 34 ER 163.

26 *Emerson v Davies* 8 F Cas 615, 619 (Mass CC, 1845).

27 (1924) 93 LJPC 113, 117–8. Lord Atkinson went on to state that: 'This distinction is well brought out in the judgment of that profound and accomplished lawyer and great and distinguished judge, Story J, in the case of *Emerson v Davies* decided in the United States': at 118.

28 Ibid 121.

29 [1944] AC 329 ('*Cramp*').

30 Ibid 340.

Subsequently, in *Ladbroke (Football) Ltd v William Hill (Football) Ltd*,[31] a case concerning a fixed odds football betting coupon, the members of the House of Lords adopted different formulations of the threshold. First, Lord Hodson extrapolated from the judgment in *Cramp* to require a 'more than negligible' amount of skill and labour.[32] On the other hand, Lord Devlin appeared to support the higher threshold of a 'substantial degree of skill, industry or experience …'[33]

While the courts agreed that the quantum of skill and labour was a matter of fact and degree to be determined in each case, the more significant issue for the protection of informational works was not how much, but the kind of authorial contribution that would confer originality. In particular, the key question was whether labour alone, or 'industrious collection' of facts, was sufficient, or whether some other form of contribution, such as skill and judgment in arrangement or selection of the facts, was required. On this, there is absolutely no room for doubt that traditional English copyright law adopted a low threshold of originality, which accepted that sufficient 'industrious collection' or 'sweat of the brow' could, without more, ground originality. Prior to *Feist,* this was accepted by many United States courts in cases such as the Second Circuit decision in *Jeweler's Circular Pub Co v Keystone Pub Co*,[34] which concerned a directory of trade marks of firms in the jewellery business, and which relied heavily on English precedent. Similarly, before *CCH,* many Canadian courts adopted the low 'industriousness' threshold.[35]

In separate judgments in *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd*,[36] a case that, like *Feist* and *Tele-Direct,* was concerned with telephone directories, Lindgren and Sackville JJ carefully reviewed English and Australian precedent relating to the originality threshold. Given their thorough and comprehensive treatment of the case law, it is not surprising that the FFC in that case concluded that Anglo-Australian law recognised 'industrious collection' as sufficient to establish originality. Sackville J, for example, distinguishing 'labour', on the one hand, from 'skill and judgment', on the other, stated:

> the course of authority in the United Kingdom and Australia recognises that originality in a factual compilation may lie in the labour and expense involved in collecting the information recorded in the work, as distinct

31 [1964] 1 WLR 273 ('*Ladbroke*').

32 Ibid 285, 287.

33 Ibid 289.

34 281 F 83 (2nd Cir, 1922). A headnote to the case states: 'The right to copyright a book on which one has expended labor does not depend on whether the materials which he has collected consist of matters which are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection'. See also Bitton, above n 12.

35 (2004) 236 DLR (4th) 395, 410 [21] (Supreme Court of Canada). See, eg, *U&R Tax Services Ltd v H&R Block Canada Inc* (1995) 62 CPR (3d) 257, in which Richard J of the Canadian Federal Court stated that: 'Industriousness ("sweat of the brow") as opposed to creativity is enough to give a work sufficient originality to make it copyrightable': at 264.

36 (2002) 119 FCR 491 ('*Desktop*').

> from the 'creative' exercise of skill or judgment, or the application of intellectual effort.[37]

Once this was established, the FFC was forced to acknowledge that an increase in the originality threshold, similar to the rejection of 'industrious collection' by the United States and Canadian Supreme Courts, could be accomplished only by the High Court.[38] The status quo was evidently endorsed when the High Court rejected Desktop's application for special leave to appeal.[39]

In *IceTV,* however, although on quite different facts to the telephone directory cases, the High Court transformed Australian law relating to copyright in compilations, but in much more complex ways than the rejection of the 'industriousness' standard by the US and Canadian Supreme Courts. The following sections of this article explain some of the complexities in this transformation.

B *IceTV*

IceTV was concerned with whether the use of time and title information of broadcast programs in an electronic program guide produced by IceTV amounted to a reproduction of a substantial part of any copyright that subsisted in Channel Nine's weekly schedule of television broadcasts. Although the High Court unanimously held that there was no substantial reproduction, it is impossible to completely reconcile the reasoning in the two plurality judgments — one delivered by French CJ, Crennan and Kiefel JJ (the 'French judgment') and the other delivered by Gummow, Heydon and Hayne JJ (the 'Gummow judgment').

Apart from the considerable differences in the reasoning in the plurality judgments, *IceTV* is a difficult decision, at least in part because of the way in which it came before the High Court. First, copyright in the broadcast schedules was conceded, meaning that argument necessarily focused on the substantiality of the time and title information, and not on the subsistence of copyright in the schedules. Secondly, there was confusion concerning the precise identification of the works in suit, with the works being first identified as the weekly program schedules, then, before the High Court, with copyright being claimed in the Nine Database of program information.[40] A third source of difficulty was that the case did not concern a compilation that was produced by 'industrious collection', but was concerned with the 'selection' of program titles and broadcast times included in the program schedules. Although these difficulties contributed to the complexities of the judgments, a notable feature of the reasoning in both judgments is that neither shied away from making sweeping statements about

37 Ibid 592 [407]. See also Lindgren J at 533–4.

38 Ibid 546 [217], as Lindgren J put it: 'The United States and Canadian cases mentioned do not persuade me that this Court, at the intermediate appellate level, should depart from the long course of Anglo-Australian authority referred to earlier. If that is to be done, it must be done by the High Court.'

39 Transcript of Proceedings, *Desktop* [2003] HCATrans 796 (20 June 2003).

40 *IceTV* (2009) 239 CLR 458, 467–9 (French judgment), 506–7 (Gummow judgment).

copyright law, including the law on subsistence, which have subsequently been adopted and applied by the courts.

Despite the considerable differences in the reasoning in the *IceTV* judgments, both at least agree that traditional copyright law, as embodied in Part III of the *Copyright Act 1968* (Cth) ('*Copyright Act*'), fundamentally protects authorship. As explained immediately below, however, there are significant differences in how the judgments understand authorship.

C *The French Judgment*

The analysis in the French judgment commences with the statement that: 'The "author" of a literary work and the concept of "authorship" are central to the statutory protection given by copyright legislation, including the Act.'[41]

After a frankly unhistorical treatment of authorship,[42] which seems to adopt the model of the individual 'Romantic' author, and incorrectly implies that collective authorship is a purely modern phenomenon, the judgment makes a series of generalisations about the fact/expression dichotomy. For example, the judgment cites *Macmillan and Co Ltd v Cooper*,[43] for the proposition that '[c]opyright is not given to reward work distinct from the production of a particular form of expression.'[44]

It is all very well to say that Part III copyright protects the original expression of authors, but, without more, this simply begs all of the important questions: What is meant by an 'author'? What is meant by 'originality'? What is meant by 'fact' and what is meant by 'expression'? And what is meant by a 'particular form of expression'? To understand the approach adopted by the judgment to these questions, it is necessary to examine how these issues are treated in the analysis of whether the time and title information was a substantial part of Nine's works. The analysis reveals a degree of confusion arising from a lack of precision in the way the judgment approaches each of these fundamental issues.

The starting point in the French judgment is the principle that, where less than the whole of a work is copied, the originality of the part that is taken is relevant in determining whether or not that part is a substantial part of the work.[45] Although the principle has been adopted by the High Court,[46] it is of comparatively recent

41 Ibid 470 [22].

42 The judgment links the 'classical notion of an individual author' to the invention of printing: *IceTV* (2009) 239 CLR 458, 470 [23]. There were clearly individual authors before the invention of the printing press. What is more important, however, is that copyright is associated with the emergence of the concept of the author as the proprietor of his work, which occurred long after the introduction of the printing press to England: see, eg, Mark Rose, 'The Author as Proprietor: *Donaldson v Becket* and the Genealogy of Modern Authorship' (1988) 23 *Representations* 51.

43 (1923) 93 LJPC 113.

44 *IceTV* (2009) 239 CLR 458, 472 [28].

45 Ibid 474.

46 See especially *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1.

provenance, seemingly being traceable to the following test proposed by Lord Reid in *Ladbroke:*

> One test may be whether the part which he has taken is novel or striking, or is merely a commonplace arrangement of ordinary words or well-known data. So it may sometimes be a convenient short cut to ask whether the part taken could by itself be the subject of copyright.[47]

While, as his Lordship went on to carefully point out, it is important not to conflate the analysis of infringement with the analysis of subsistence, as copyright in works protects original expression only, it is perfectly logical and acceptable to look to the originality of a part that has been copied in assessing its substantiality.

Unfortunately, the French judgment complicates this simple proposition by bifurcating its analysis to give separate treatment to originality in the context of subsistence and in the context of infringement. It also confusingly bifurcates its analysis of the two principles that have historically comprised originality, the 'not copied/originating from the putative author' test and the originality threshold.

In relation to originality in the context of subsistence, the judgment first applies the 'not copied/originating from the putative author' test.[48] The judgment, however, goes on to distinguish this from originality in the context of infringement, stating that in analysing the substantiality of a part of a work that has been copied, originality has 'a broader aspect'.[49] It is worth examining how this analysis is applied to the broadcast time and title information that was copied by *IceTV* in order to explain some of the confusion potentially engendered by this approach. First, as the time and title information was produced by employees of Channel Nine, the French judgment states that 'it cannot be said that the part reproduced did not originate with the author or authors of the works in suit'.[50]

This proposition that the originators of the time and title information might be authors raises a number of questions. First, is the time and title information 'fact' or 'expression'? Secondly, if the information is 'fact', as copyright protects only expression, how can the originators be authors?[51] Thirdly, if the judgment is suggesting that there can be an author or authors of factual material, is it suggesting that copyright may subsist in what has been termed 'created facts', meaning facts that are not discovered but are created by humans?[52] Fourthly, if the judgment is suggesting that the originators of the time and title information are authors of 'expression' (not 'facts'), what precisely does the 'expression' of the time and title information consist of? None of this is clear.

47 [1964] 1 WLR 273, 276–7.

48 *IceTV* (2009) 239 CLR 458, 474.

49 Ibid 475 [38].

50 Ibid 475 [37].

51 As O'Connor J stated in *Feist* 499 US 340, 347 (1991), 'facts do not owe their origin to an act of authorship'.

52 According to Justin Hughes, 'created facts' or 'authored facts' are 'human facts that result from an act that was the intentional creation of information qua information through the intentional creation of expression qua expression': Justin Hughes, 'Created Facts and the Flawed Ontology of Copyright Law' (2007) 83 *Notre Dame Law Review* 43, 59.

Following from this, the judgment purports to identify what is meant by the 'broader aspect' that distinguishes originality in the context of infringement from originality in the context of subsistence. This part of the judgment begins with the relatively simple proposition that merely because a part of a work that has been copied is original does not necessarily mean that it is a substantial part.[53] The problem that arises from this is not because the judgment focuses on the originality of the copied information, but because it identifies what is important in the analysis of infringement as 'the degree of originality in the *expression* of the part of the work reproduced'.[54] This leads the judgment to conclude that the Nine program schedule was sufficiently original for copyright to subsist in the schedule as a whole — consisting of 'both information and creative material' — but that there was insufficient *expression* in the time and title information for this to be a substantial part of the work. As the judgment put it, 'the expression of the time and title information, in respect of each programme, is not a form of expression which requires particular mental effort or exertion'.[55]

The fundamental concern underpinning the French judgment's analysis of substantiality is clearly that the time and title information is more in the nature of fact or information, and that any minimal expression associated with that information is insufficient for it to be protected. An odd feature of this analysis derives from the bifurcation of originality in the contexts of subsistence and infringement. As suggested above, in relation to subsistence, the judgment appears to require only that material originate from a person or persons, and does not overtly distinguish expression from non-expression. In relation to infringement, however, the judgment emphasises the degree of expression that is taken. It is therefore possible for the judgment to be read as if originality of *expression* is to be taken into account only in the context of infringement, which would essentially mean that originality for the purpose of subsistence is a completely different *concept* to originality for the purpose of infringement.

A better, and clearer, approach would have been to focus not on the degree of expression in the infringement analysis, but on the originality threshold, or the degree of effort involved in producing the material that is copied. This would lead to the same conclusion, but on the grounds that there was insufficient relevant effort in the production of the time and title information for this to amount to a substantial part of the work. This would also avoid the possibility that expression might not be regarded as important in assessing originality for the purpose of subsistence, as clearly it should be.

The problems arising from the bifurcated treatment of the 'not copied/originating from the putative author' test are amplified by the bifurcated treatment of the originality threshold, with the judgment separating skill and labour in the context of subsistence from skill and labour in the context of infringement. As explained

53 The case that is relied upon for this proposition, *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1 is, however, concerned with the very specific issues relating to the originality of computer programs.

54 *IceTV* (2009) 239 CLR 458, 476 [40] (emphasis in original).

55 Ibid 477 [42].

above, the debate in the common law world has focused on whether 'industrious collection' can be taken into account in assessing the originality of informational works, or whether some 'creativity' is required. In addressing skill and labour in the context of subsistence, the French judgment simply denies that the distinction between labour and creativity is relevant. In this respect, the judgment states:

> A complex compilation or a narrative history will almost certainly require considerable skill and labour, which involve both 'industrious collection' and 'creativity', in the sense of requiring original productive thought to produce the expression, including selection and arrangement, of the material.[56]

The judgment then goes on to re-cast the originality threshold as requiring 'some independent intellectual effort',[57] rather than skill, judgment or labour. In effect, the judgment is implying that, by formulating the originality threshold in terms that exclude 'industrious collection', the highest courts in the United States and Canada, as well as a long tradition of academic commentary, have been misguided. That this is not self-evidently the case, however, is illustrated by compilations that exhibit almost no creativity, but involve the expenditure of significant resources in collecting the information. The classic example is the white pages telephone directory, where there is very little choice in either the arrangement (alphabetical order) or selection ('whole-of-universe') of the material for inclusion, no doubt explaining why these directories have been so heavily litigated.

One explanation for the approach adopted by the French judgment is that questions of 'industrious collection' were simply not raised on the facts in *IceTV:* the claim was that the time and title information was original because of the effort expended in selecting the broadcast times and titles. Moreover, as the judgment points out, as subsistence was conceded, originality in the context of subsistence was not directly at issue. Nevertheless, by avoiding the single most important issue relating to the subsistence of copyright in factual material, the judgment results in the unsatisfactory outcome that 'industrious collection' may be taken into account in determining whether a compilation is original, at least provided it is combined with 'creativity', but whether or not 'industrious collection' alone can confer originality is left unclear.

While the judgment denies that the kind of skill and labour expended is relevant in determining whether copyright subsists, applying the bifurcated analysis, it concludes that, in the context of infringement, 'it is always necessary to focus on the nature of the skill and labour, and in particular to ask whether it is directed to the originality of the particular form of expression'.[58] For our purposes, there are two related issues raised by the judgment's treatment of the originality threshold in the context of infringement: what is meant by, first, the 'nature of the skill and labour' and, secondly, the 'particular form of expression'?

56 Ibid 478–9 [47] (citations omitted).

57 Ibid 479 [48].

58 Ibid 479 [49] (citations omitted).

On the first issue, although the judgment states that the 'nature of the skill and labour' must be taken into account, it does not expressly differentiate between efforts directed at the arrangement, selection or collection, respectively, of factual material. The approach adopted to the kind of effort that is relevant is only apparent from the treatment given to precedent and, in particular, to the judgments of the House of Lords in *Ladbroke*. In that case, which, as mentioned above, concerned fixed odds football betting coupons, the majority of the House held that the skill and judgment in selecting the wagers to be offered could be taken into account both in determining the originality of the coupons and in assessing the substantiality of the material that was copied.[59] Of the members of the House, only Lord Evershed emphasised the appropriation of the *arrangement* of the material in the coupons over the preliminary skill and judgment exercised in *selecting* the wagers.[60] The French judgment expressly prefers Lord Evershed's judgment, discounting the reasoning of the other members of the House as being based on the widely discredited aphorism of Peterson J in *University of London Press v University Tutorial Press Ltd*, that 'what is worth copying is prima facie worth protecting'.[61] By effectively avoiding the issue of whether copying a selection of facts can ever amount to a reproduction of a substantial part of a compilation, the French judgment focused entirely on the arrangement of the time and title information, thereby elucidating what is meant by the 'particular form of expression'.

The French judgment essentially concluded that, while there was substantial effort expended in producing the broadcast time and title information, this effort was not directed at the 'form of expression' of the information. In doing so, the judgment effectively equated expression with arrangement, apparently ruling out the extent to which a selection of material might amount to expression. As there is only one logical arrangement of broadcast time and title information — chronological — the effort expended in that arrangement is obviously minimal, meaning that the time and title information could not constitute a substantial part of Nine's schedule. In reaching this conclusion, the judgment could easily have decided that the considerable effort expended by Nine's employees in selecting the programs to broadcast and the times to broadcast the programs was directed at Nine's business and not at producing a copyright work. This approach, however, appears to be disavowed,[62] and, in any case, would require some analysis of when preliminary effort that is not directly involved in reducing a work to material form

59 As Lord Hodson put it: 'The selection of and the arrangements of these lists of bets with their footnotes are, to my mind, the essential feature of the plaintiffs' coupon …': *Ladbroke* [1964] 1 WLR 273, 288. See also David Lindsay, 'Copyright Protection of Broadcast Program Schedules: *IceTV* before the High Court' (2008) 19 *Australian Intellectual Property Journal* 196.

60 In this respect, Lord Evershed stated: 'when all the hard work has been done in deciding upon the wagers to be offered, there still remains the further distinct task, requiring considerable skill, labour and judgment … in the way in which the chosen wagers are expressed and presented to the eye of the customer': *Ladbroke* [1964] 1 WLR 273, 281.

61 [1916] 2 Ch 601, 610.

62 The judgment states that: 'The fact that business considerations inform the decision to adopt a particular form of expression will not necessarily detract from the originality of that form of expression': *IceTV* (2009) 239 CLR 458, 481 [53].

can be taken into account, and when it cannot.[63] The French judgment therefore appears to imply that, in dealing with compilations of factual material, there can only be an infringement if, first, the arrangement of the material is copied and, secondly, there has been sufficient effort expended in producing the arrangement.

The analysis undertaken in the French judgment therefore raises a considerable number of questions, without giving much guidance as to how these should be answered. First, it appears that a person or persons who originate 'facts' may be regarded as authors of original works. However, we cannot be sure about this, because surely originality for the purposes of subsistence means originality of expression, and not unprotected facts? Secondly, it seems that the originality of the *expression* of a part of a work that has been copied is especially relevant in determining whether there has been an infringement, raising the possibility that originality has a different meaning in the context of infringement to its meaning in the context of subsistence. Again, we cannot be sure about this, as the judgment may simply be suggesting that the degree of originality of material that has been copied is relevant to the analysis of whether it is a substantial part. Thirdly, for the purposes of subsistence, no hard and fast distinction should be drawn under Australian law between 'industrious collection' and 'creativity', as both may be relevant in determining whether the work is original. Yet it is unclear whether or not 'industrious collection' alone, or when combined with only minimal 'creativity', would be sufficient (although, admittedly, the tenor of the judgment suggests that it is probably not). Fourthly, for the purposes of infringement, it is only skill and labour directed at the 'particular form of expression' that is relevant. Again, this can be read as implying that 'expression' in the context of subsistence somehow differs from 'expression' in the context of infringement — a decidedly odd result, given that copyright protects only original expression. Moreover, it is also implied that the only form of expression that is relevant in the infringement analysis is the arrangement of material in a compilation. The conclusion, then, is that although effort expended in producing informational works may confer copyright protection, the protection is meaningless unless the effort is directed at the arrangement of the material.

D *The Gummow Judgment*

The Gummow judgment is more difficult than the French judgment, both because the reasoning is more complex and because of the fragmented way in which it addresses some of the key legal issues. Like the French judgment, the Gummow judgment emphasises the absolute centrality of authorship to the protection of Part III works, identifying it as one of 'two fundamental principles of copyright law'[64] on the grounds that 'the essential source of original works remains the activities of authors.'[65]

63 This was a key issue in the *Ladbroke* case.

64 *IceTV* (2009) 239 CLR 458, 493 [95].

65 Ibid [96].

The judgment takes a different approach to authorship from that of the French judgment, however, the difference deriving mainly from its analysis of the relationship between authorship and the second fundamental principle, that copyright comes into subsistence only once the work is reduced to some material form. Importantly, the judgment endorses the description of an 'author' from the first edition of Laddie as 'the person who brings the copyright work into existence in its material form'.[66] Combining the two principles, the judgment extols the virtues of identifying both the author and the point in time at which a work is first reduced to material form, stating:

> The exclusive rights comprised in the copyright in an original work subsist by reason of the relevant fixation of the original work of the author in a material form. To proceed without identifying the work in suit and without informing the enquiry by identifying the author and the relevant time of making or first publication, may cause the formulation of the issues presented to the court to go awry.[67]

In addition to its concern with precisely identifying the author of a work, the Gummow judgment points to special considerations that apply in relation to the authorship of compilations, especially where there are multiple contributors. First, the judgment relies on the second edition of Laddie for the proposition that the author, or authors, of a compilation are 'those who gather or organise the collection of material and who select, order or arrange its fixation in material form'.[68] Secondly, where the production of a compilation is a collective effort, the judgment points out that the work must fall within the definition of a 'work of joint authorship' ('WoJA'), which is defined as:

> a work that has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of the other authors.[69]

As explained later, the case law does distinguish authorship of compilations from authorship of other works, but not at all in the way suggested by the Gummow judgment. At this point, however, the approach taken to authorship by the judgment can be further understood by reviewing how it deals with the evidence of the process of producing Nine's program schedule.

Reflecting the extensive trial evidence, the judgment divides the production of Nine's program schedule by its employees into seven distinct steps, with the first steps comprising the determination of the time and title information, the intermediate steps comprising the recording of that information and its collation

66 Hugh Laddie, Peter Prescott and Mary Vitoria, *The Modern Law of Copyright* (Butterworths, 1980) 243; *IceTV* (2009) 239 CLR 458, 493 [98].

67 *IceTV* (2009) 239 CLR 458, 496 [105].

68 Ibid 494–5 [99]. The statement from Laddie actually states that 'the author of such a work is the person who gathers or organises the collection of material and who selects, orders and arranges it': Hugh Laddie, Peter Prescott and Mary Vitoria, *The Modern Law of Copyright and Designs* (Butterworths, 2nd ed, 1995) 550. The Gummow judgment combines this with the earlier description of an author by adding 'fixation in material form'.

69 *Copyright Act 1968* (Cth) s 10(1).

with additional information, including program synopses, and the final step involving the communication of late program changes to the aggregators of broadcast program schedules.[70] The judgment places particular emphasis on what were identified as steps five and six, which consisted of the 'dumping' of all relevant information into the Nine Database (after it had first been manually entered) and the production (with necessary modifications) of the weekly schedule, in 'Excel' and 'text' formats, from the database.[71] Like the French judgment, the analysis of authorship in the Gummow judgment depends upon an appreciation of the approach taken to assessing originality, which involves piecing together, and interpreting, distinct parts of the judgment that ostensibly address separate issues.

To begin with, the Gummow judgment characterises the 1996 *European Database Directive*,[72] which fundamentally altered the protection of compilations and databases under UK law, as 'significant' because 'Australian legislation has no counterpart.'[73] The Directive separates the copyright protection of databases, which subsists by reason of the selection and arrangement of material by an author, from the sui generis protection of databases, which is conferred on the 'maker' of a database as a result of investment in producing the database, including investment in collecting material.[74] The judgment appears to conclude, solely from the evidence of the adoption of the European Directive in the UK, that traditional copyright protection of compilations 'was carefully confined and fixed upon the effort that went into the selection and arrangement in a compilation'.[75] The judgment therefore appears to reject the entire history of 'industrious collection' under Anglo-Australian law, without engaging with the case law. This interpretation, however, apparently contradicts the judgment's reliance on Laddie's description of the authors of a compilation, which envisages that the gathering and collection, not just selection or arrangement, may contribute to authorship.

Once the judgment determines that the originality of a compilation subsists only (or mainly) in the selection or arrangement of material, it turns to the production of the Nine Database. While the early steps (one through four) in the production of the database included the selection of the time and title information by Nine's employees, the Gummow judgment agreed with the trial judge that this was directed to the conduct of Nine's broadcast business, and not at the creation of the copyright work.[76] Like the French judgment, then, the Gummow judgment avoids

70 *IceTV* (2009) 239 CLR 458, 497–500 [109]–[121].

71 Ibid 498–9 [115]–[120].

72 *Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases* [1996] OJ L77/20, as implemented in the *Copyright and Rights in Databases Regulations 1997* (UK) SI 1997/3032.

73 *IceTV* (2009) 239 CLR 458, 504 [135].

74 *Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases* [1996] OJ L77/20; Ibid [137]–[138].

75 *IceTV* (2009) 239 CLR 458, 504 [136].

76 Ibid 511 [167].

precisely addressing if, or when, effort that is preliminary to the reduction of a work to material form can be taken into account in assessing originality.

Once the preliminary effort in producing the time and title information was ruled out, the originality of Nine's database necessarily rested on the selection and arrangement of material *in the database*. In dealing with this issue, the Gummow judgment refers to Davison's work, *The Legal Protection of Databases*,[77] which makes the point that, in some cases, there may be difficulties in identifying the authors of a database, especially where the arrangement of material is determined by the database program, and where there is no selection of material included in the database, such as where it is a whole-of-universe database.[78] As the Nine Database was not a whole-of-universe database, it could be argued that authorship could consist in the *selection* of material for inclusion in the database. But, as the judgment rules out the selection of the time and title information, and there was no evidence about who was responsible for the selection of the elements included in the database, this was impossible.

Like the French judgment, then, the analysis of original expression in the Gummow judgment focused on the *arrangement* of the material. Here, the judgment held that there was no evidence about who was responsible for determining the arrangement of the material in the database and, moreover, referring to the introduction in the UK of a provision dealing with authorship of a 'computer-generated work',[79] raises the prospect that the expression may have originated from the database program, not from a human author.[80] From this, and given the emphasis of the judgment on human authorship, it can be inferred that there can be no copyright, under Australian law, in a computer-generated work. In any case, the Gummow judgment concluded that, in the absence of any evidence of any human contribution to the relevant selection or arrangement of material in the database, the author or authors of Nine's work were 'unknown'.[81] Furthermore, in the absence of any relevant evidence of the contribution of Nine's employees to the *expression* of Nine's work, the judgment held that it was impossible to determine whether or not Nine's program schedule was a WoJA.[82]

At this point, it is instructive to review how the plurality judgments in *IceTV* differ in their analysis of authorship. As explained above, a perplexing feature of the French judgment is that it acknowledges that originating the time and title information might amount to authorship. As further explained, this is related to the central difficulty in the judgment: the apparently inconsistent treatment of *expression* in the contexts of subsistence and infringement. For example, if, as the judgment suggests, the skill and labour in determining the time and title

77 Mark Davison, *The Legal Protection of Databases* (Cambridge University Press, 2003).

78 Ibid 22–3.

79 *Copyright, Designs and Patents Act 1988* (UK) c 48, s 9(3) provides that '[i]n the case of a … work which is computer-generated, the author shall be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken.'

80 *IceTV* (2009) 239 CLR 458, 507–8 [149]–[151].

81 Ibid 508 [151].

82 Ibid.

information was directed at Nine's business and not at the *particular form of expression* of Nine's work, it is difficult to see how those who originated this information can be authors. The Gummow judgment, on the other hand, while also discounting the effort in determining the time and title information as being directed to Nine's business, focuses squarely on the effort expended in 'dumping' information into Nine's database and producing hard copy program schedules, which it identifies as steps five and six.[83] Having excluded 'industrious collection' as having any relevance to originality, the judgment focuses on the effort involved in the selection, but more specifically, the arrangement, of material in the database, to conclude that it was impossible to identify a human author or authors, either because the relevant expression was contributed by the database program, or that there was insufficient evidence of human authorship.

The Gummow judgment's approach to authorship can be further understood by analysing its treatment of originality in the context of infringement. The judgment first acknowledges that the central issue in the appeal — whether or not the time and title information is a substantial part — can be resolved without identifying the author or authors of Nine's program schedule. The judgment then goes on, applying the analysis explained above, to identify the originality of the schedule as lying 'not in the provision of time and title information, but in the selection and presentation of that information together with additional programme information and synopses, to produce a composite whole.'[84]

Turning first to originality in the context of subsistence, as explained above, the Gummow judgment, without expressly addressing precedent, apparently rejected 'industrious collection' as a basis for originality. While, given the concession made on subsistence, the judgment is properly cautious about conclusively determining this issue, the views of the plurality seem clear by the response to a submission made by the Australian Digital Alliance ('ADA'), as amicus curiae. The ADA submitted that the High Court should take the opportunity to establish a higher originality threshold than that accepted by the *Desktop* court, such as the 'creative spark' standard (*Feist*) or the 'skill and judgment' standard (*CCH*).[85] In response to this, the Gummow judgment stated:

> It is by no means apparent that the law even before the 1911 Act was to any different effect … It may be that the reasoning in *Desktop Marketing* with respect to compilations is out of line with the understanding of copyright law over many years.[86]

These statements represent not only a breath-taking reinvention of legal history, but they differ from the approach of the French judgment and the approval of Laddie's description of authorship of a compilation, both of which accept that 'industrious collection' may, at least, be relevant to the originality of a complex compilation.

83 Ibid 511 [168].
84 Ibid 508 [152].
85 Ibid 463.
86 Ibid 516 [188].

If the contradictory treatment of copyright expression in the French judgment is perplexing so too is the Gummow judgment's analysis of originality in the context of infringement. As explained above, from at least the *Ladbroke* decision, it has been accepted that the originality of a part of a work that has been copied is relevant in determining whether or not it is a substantial part. In *Newspaper Licensing Agency Ltd v Marks & Spencer plc*,[87] Lord Hoffman, after referring to *Ladbroke,* stated, in relation to what amounts to a substantial part:

> That question … must be answered by reference to the reason why the work is given copyright protection. In literary copyright, for example, copyright is conferred (irrespective of literary merit) upon an original literary work. It follows that the quality relevant for the purposes of substantiality is the literary originality of that which has been copied.[88]

In an article written soon after that decision, Deazley criticised Lord Hoffman's reasoning on the apparent basis that taking originality into account in determining substantiality fundamentally confuses the analysis of infringement with the analysis of subsistence. In addition, Deazley argued that the treatment of substantiality by the House of Lords in *NLA* and *Designers Guild v Russell Williams (Textiles) Ltd,*[89] applies an 'ideological framework' that tilts the copyright balance too far in favour of owners. Thus, the article goes on to state, referring to Lord Reid's suggestion in *Ladbroke* that looking to the originality of the part taken may be a 'convenient short-cut', that:

> To adopt it is to alter fundamentally the nature of the inquiry with which the substantiality threshold is concerned. What begins as a consideration of one of the statutory methods by which the rights of the copyright owner are held in check, in the interests of the user, is otherwise transformed into a meditation upon the virtues of protecting virtually any identifiable level of investment of skill and labour upon the part of the copyright author. And yet, is it not implicit that in making use of a less than substantial amount of another's copyright work, this will inevitably involve some measure of legitimate appropriation of the original author's skill and effort?[90]

The influence of Deazley's article on the Gummow judgment, in addition to its influence on the language used, is clear from the following important paragraph:

> The proposition that in a case such as the present one looks to the literary originality of what IceTV copied, rather than to the Weekly Schedule as a whole, in answering the question whether IceTV reproduced a substantial part of the Weekly Schedule, shifts consideration to an extraneous issue. This is whether what the primary judge called the 'slivers' of information may themselves be classified as original literary works. The issue requiring the comparison between what was taken and the whole of the work in suit may be distorted by a meditation, inspired by *Desktop Marketing,* upon

87 [2003] 1 AC 551 ('*NLA*').

88 Ibid 559.

89 [2000] 1 WLR 2416.

90 Deazley, above n 20, 130.

> the protection given by the Act against misappropriation of any investment of skill and labour by the author. In the present case, the temptation then is to classify the slivers each as original literary works. An important proposition may be overlooked. This is that the statutory requirement that the part of a work taken must be substantial assumes there may be some measure of legitimate appropriation of that investment.[91]

There are three problems with this reasoning. First, the issue in *IceTV* was not whether each individual piece of time and title information was a substantial part of Nine's weekly schedule, but whether the selection of the time and title information *as a whole* amounted to a substantial part. The two are quite distinct inquiries. Secondly, contrary to the argument made by Deazley, and accepted by the Gummow plurality, the judicious application of originality in the context of infringement does not necessarily result in over-protection. As pointed out above, as copyright in works protects original expression, there is nothing exceptional, where a part of a work has been copied, in looking at the originality of that part to assist in the analysis of substantiality. As is abundantly clear from Lord Reid's judgment in *Ladbroke,* there is no risk of confusing the inquiry into subsistence — where the question is whether or not the work *as a whole* is original — with the inquiry into infringement — where the question is whether a part taken amounts to a substantial part, with useful guidance from whether the part consists of original expression. The dangers of over-protection are avoided if, as apparently accepted by the French judgment, it is not automatically assumed that any original expression is a substantial part, but that the *degree of originality* of a part that has been taken may provide *guidance* as to its substantiality. Thirdly, while expressly disavowing the use of originality, the Gummow judgment actually resorts to an examination of the relevant 'skill and labour', or originality, as part of its conclusion that the time and title information was not a substantial part.

A fundamental theme of both judgments in *IceTV* is that copyright does not protect against the misappropriation of anything of value, but protects only original expression. For example, the Gummow judgment states that '[t]he Act does not provide for any general doctrine of "misappropriation" and does not afford protection to skill and labour alone.'[92]

Subsequently however, as explained above, the judgment identifies the originality of the program schedule as consisting of 'the selection and presentation of … [the time and title] information together with additional programme information and synopses, to produce a composite whole'.[93] Then, following the apparent endorsement of Deazley's criticism of the use of originality in the context of infringement, the judgment returns to the question of the relevance of the skill and labour in producing the time and title information to the substantiality analysis, stating that:

91 *IceTV* (2009) 239 CLR 458, 509 [157] (citations omitted).

92 Ibid 502–3 [131] (citations omitted).

93 Ibid 508 [152].

> The primary judge approached the issue of substantiality correctly when she stressed that the detailed and lengthy preparatory work involved in what are identified in these reasons as steps one through to four [which includes the production of the time and title information] was directed to the conduct of the business of the Nine Network in broadcasting programmes …
>
> There remained what the Full Court accepted was "the extremely modest skill and labour" in setting down the programmes already selected and in taking what may now be identified as steps five and six.[94]

Therefore, like the French judgment, the Gummow judgment first shows a willingness to take into account the effort involved in producing the time and title information in determining whether Nine's compilation *as a whole* was original but, inconsistently, rejects the relevance of this effort in assessing the substantiality of the information. However, the effort in producing the time and title information is either relevant or it is not. Over and above this inconsistency, the Gummow judgment first rejects, as a matter of principle, the relevance of originality to the substantiality inquiry, then approves the view that only the 'modest skill and labour' in 'dumping' information into the database and producing the program schedule in hard copy is relevant in determining what amounts to a substantial part.[95] This last inconsistency points to a key weakness in the Deazley argument, and in its uncritical adoption by the Gummow plurality, which is that, given the relatively amorphous nature of the concept of a 'substantial part', there is a need for judicial tests to assist in guiding the inquiry and, to fill this need, it is logical to take into account the originality of the copied part. The fact that the Gummow judgment, in applying the law on substantiality to the facts of the case, ultimately resorts to an analysis of the relevant skill and labour merely illustrates these points.

As with the French judgment, the Gummow judgment leaves important questions unanswered. First, in relation to originality in the context of subsistence, like the French judgment, the Gummow judgment is ambiguous about the extent to which 'industrious collection' can contribute to originality. Over and above this, the qualified approval of the 'creative spark' or 'skill and judgment' standards, without, it should be added, any consideration of the potential differences between the US and Canadian tests, strongly implies that there is no role whatsoever for 'industrious collection'.

Secondly, the need for the identification of an author or authors, and specification of the time at which a work is reduced to a material form are emphasised, but the meaning and practical implications of these principles are scarcely explored. For example, the identification by name of each contributor to a complex compilation obviously raises evidentiary difficulties and, as explained in Part IV, would be contrary to established precedent. Furthermore, the emphasis given to the two related principles leaves it open to be argued that only efforts directly related

94 Ibid 511 [167]–[168] (citations omitted).

95 Ibid 509 [157]–[158], 511 [168].

to the fixation of a work in material form can amount to authorship. Thus, the judgment rejects the relevance of the efforts involved in producing the time and title information, focusing entirely upon the efforts directly involved in producing the Nine Database and the weekly schedule in hard copy formats. If this interpretation of the judgment is correct, it represents a considerable narrowing of what counts as authorship, with attention being directed to the more mechanical tasks of recording a work and not the more complex endeavours in conceiving works such as compilations. As the judgment appears to rule out the efforts involved in producing the time and title information on the basis that they were directed to Nine's broadcast business, and not the production of Nine's work, the extent to which the judgment is intended to confine the general concept of authorship is not entirely clear. Like the French judgment, however, there is an absence of precision in the treatment given to the relevance of preliminary efforts in determining the originality of a copyright work.

Thirdly, the judgment leaves the relevance of the originality of a part of a work that has been copied to the substantiality inquiry completely uncertain, as it first rejects the legitimacy of looking to the originality of the copied part then, inconsistently, relies upon an analysis of the relevant skill and labour to deny that the time and title information was a substantial part.

The ambiguities and unresolved issues arising from the two judgments in *IceTV* have naturally created considerable difficulties for courts attempting to apply the new law in subsequent cases. The next section of the article explains and analyses the way in which issues relating to authorship and originality were dealt with in the main case to address these issues since *IceTV,* the decision of the FFC in *PDC*.

III AUTHORSHIP AND ORIGINALITY IN *PDC*

As explained above, the facts in *IceTV* presented difficulties for the resolution of fundamental issues involving copyright protection of factual compilations, not least because the case did not directly concern 'industrious collection'. Nevertheless, the severe criticism of the reasoning in *Desktop* by both plurality judgments, as well as the expansive reasoning, presented the opportunity for a major overhaul of the law relating to subsistence of copyright in compilations. Given international experience, and the nature of the subject matter, it was not surprising that copyright protection of telephone directories again came before the court in *PDC,* which concerned subsistence of copyright in both the White and Yellow Pages directories.

In *PDC,* Telstra claimed that copyright subsisted in its White Pages directories on the basis of the listings, enhancement of listings and arrangement of listings, and in its Yellow Pages directories on the basis of the listings, headings, enhancement of listings and arrangement of listings under headings.[96] In support of the claims,

96 (2010) 264 ALR 617, 621 [3]. A claim in relation to the list of headings in the Telstra Headings Book was abandoned.

Telstra submitted a substantial amount of evidence to the trial judge, Gordon J, concerning the processes leading to the production of the directories from a sophisticated electronic database. As summarised by Perram J in the FFC, the production of the directories essentially consisted of three stages: the Collection Phase, which consisted of the maintenance, updating and editing of the database; the Extraction Phase, which consisted of the extraction from the database of the information for each directory and its arrangement in an electronic form (also referred to as the Book Extract stage); and the Production Phase, which consisted of the typesetting and physical production of the directories (also referred to as the Book Production stage).[97] The production of the directories was facilitated by a highly functional database program, known as the Genesis Computer System ('GCS').

Gordon J applied a 'strong' version of the reasoning in *IceTV,* and especially the reasoning in the Gummow judgment, to conclude that copyright did not subsist in the directories on each of the following bases:

- the authors of the work were not, and could not be, identified;
- even if the authors could be identified, copyright did not subsist as there was insufficient independent authorial contribution, or any authorial contribution was anterior to the reduction of the works to a material form, or the relevant contribution was made by a computer program and not by human authors; and
- the works did not satisfy the originality threshold.[98]

In an appeal to the FFC, Telstra argued that, where a work has been first published in Australia and the work is clearly original, it was unnecessary to separately identify the authors, and that, notwithstanding the use of the GCS, there was sufficient human authorial contribution for the directories to be original works. In unanimously confirming that copyright did not subsist, the FFC was required to reach conclusions on the following three related matters: the originality of compilations; authorship of compilations; and joint authorship of compilations. While unanimous in its conclusions, there were important differences of emphasis in the judgments of the members of the Court, which consisted of Keane CJ, Perram and Yates JJ.

Before turning to the analysis of the particular issues in the appeal, it is important to point out that each of the members of the FFC acknowledged the extent to which the reasoning in *IceTV* represented a departure from established Anglo-Australian law on copyright in compilations. In addition, the FFC was unanimous in concluding that copyright did not subsist in the directories on the basis that protectable expression originated from the GCS program, and not from any human author or authors. An application by Telstra for special leave to appeal to

97 *PDC* (2010) 194 FCR 142, 173 [102].

98 *PDC* (2010) 264 ALR 617, 621–2 [4].

the High Court was dismissed,[99] leaving the FFC decision as the highest authority on subsistence of copyright in compilations such as directories.

A *Originality*

As explained above, under Anglo-Australian law, originality consists of two principles: the 'not copied/originating from the putative author' test and the originality threshold. As further explained, in relation to the originality threshold, while both judgments in *IceTV* rejected 'industrious collection' as the sole basis for establishing originality, they are both ambiguous about whether or not it can be taken into account. This appears to explain the reluctance to choose between the 'skill, judgment and labour' (*Ladbroke*) and 'skill and judgment' (*CCH*) formulations of the originality threshold, and the preference for a more neutral formulation. As Gordon J explained, at first instance in *PDC,*[100] the new formulation of the originality threshold following *IceTV* is either some 'independent intellectual effort' (per the French judgment)[101] or 'sufficient effort of a literary nature' (per the Gummow judgment).[102]

After acknowledging the different formulations of the originality threshold, and raising the possibility of a 'creative spark' or 'skill and labour' standard, Gordon J concluded that following *IceTV,* 'substantial labour' or 'substantial expense' were *not alone* sufficient.[103] On this basis, her Honour held that, even though there was significant effort involved in the production of the directories, it did not consist of the relevant kind of effort, especially as the form of expression of the directories was essentially dictated by the GCS program.[104]

Before the FFC, Telstra argued that the Laddie formula for authorship of a compilation — those 'who gather or organise the collection of material and who select, order or arrange its fixation in material form' — should be read disjunctively, meaning that, as accepted in *Desktop,* 'industrious collection' alone would be sufficient. The FFC unanimously rejected this submission, although with differences in the reasoning in the three judgments.

Keane CJ pointed out that, while the Laddie description recognised the 'number of tasks' involved in authoring a compilation, 'the mere collection of data cannot be sensibly regarded as compilation'.[105] Furthermore, after reviewing the line of authorities supporting 'industrious collection', his Honour acknowledged the significant changes to the law made by *IceTV,* observing that the reasoning of the judgments 'requires a revision of the relevance of skill and labour to the

99 Transcript of Proceedings, *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2011] HCATrans 248 (2 September 2011).

100 (2010) 264 ALR 617, 624 [20].

101 (2009) 239 CLR 458, 474 [33], 479 [48].

102 Ibid 494 [99].

103 *PDC* (2010) 264 ALR 617, 624 [20].

104 Ibid 684–5 [340]–[344].

105 *PDC* (2010) 194 FCR 142, 166 [71].

subsistence of copyright'.[106] The judgment then summarises the reasoning in the *IceTV* judgments leading to rejection of 'industrious collection' in the following terms:

> The dicta in *IceTV* shift the focus of inquiry away from a concern with the protection of the interests of a party who has contributed labour and expense to the production of a work, to the 'particular form of expression' which is said to constitute an original literary work, and to the requirement of the Act 'that the work originates with an author or joint authors from some independent intellectual effort'.[107]

Finally, the judgment confronts a fundamental dilemma facing the Court, in the form of an argument presented by Telstra that, in order to find against subsistence, the authorities collected in *Desktop* supporting 'industrious collection' would need to be held to have been wrongly decided on the basis only of obiter statements from the High Court. On this, the judgment simply evades the issue by observing that the 'industrious collection' cases, including *Desktop,* did not involve automated compilation by means of a computer program.[108]

Perram J also held that the Laddie formulation could not be read disjunctively but, in doing so, applied different reasoning to that of Keane CJ. The overarching emphasis of the Perram J judgment is on the principle that the relevant effort must be directed at reducing a work to material form.[109] In this respect, the judgment states:

> Whatever else might be said of the kind of efforts required of an author, they must be efforts which result in the material form of the work. The important creative steps which involve the fashioning of the ideas on which a literary work's ultimate form rests are not actions which the Act counts as authorial and this is because what is protected by the copyright monopoly is the form of a work and not the ideas which presage or prefigure it.[110]

This approach, which rules out taking into account the effort involved in the Collection Phase, raises the question of how to apply the section of the Laddie formulation that specifically treats collecting as an authorial activity. Perram J deals with this problem in two ways. First, his Honour points out that, in *IceTV,* the Gummow judgment modified the Laddie description by adding that the relevant activities must be directed at 'fixation in material form'.[111] Secondly, Perram J held that the reference to the collecting of information is relevant only to the 'not copied/originating from the putative author' test, and not to the originality threshold.[112]

106 Ibid 168 [79].
107 Ibid 169 [82].
108 Ibid 170 [86].
109 Ibid 172–4 [101]–[112].
110 Ibid 173–174 [104].
111 Ibid 175 [109].
112 Ibid 176 [111]–[112].

By interpreting the antecedent effort involved in the collection of material as not being directed at the reduction of the work to a material form, the Perram J judgment is more definitive in its rejection of 'industrious collection' than the other judgments in *PDC*. The reasoning in the judgment, however, clearly creates the possibility of an inconsistency in the approach to the two principles of originality similar to that which compromises the French judgment in *IceTV*.

The consideration of originality, and of the Laddie description of authorship of a compilation, in the judgment of Yates J, begins with the same emphasis as that of Perram J on activities directed at fixation of the work.[113] In applying this principle to the production of the directories, however, Yates J differs substantially from the approach adopted by Perram J. In particular, Yates J rejects the submission of the respondents, which had been accepted by Perram J, that the compilations were made solely at the Extraction Phase.

Referring to the Laddie formulation, Yates J first accepts that gathering and collecting material are necessarily the acts of authors.[114] His Honour then rejects the proposition that the collection of material can be rejected as merely antecedent to fixation in a material form, stating that,'[i]n this sense it can be seen that those activities contributed to the making of each claimed copyright work.'[115]

Nevertheless, like Keane CJ, Yates J apparently held that originality could not be based on 'industrious collection' alone, as the judgment essentially concluded that, given that the selection, ordering and arrangement of information in the works was generated by the GCS, the directories were not original.[116]

Therefore, while the judgments in the FFC agree that the Telstra directories are not original, the reasoning is not consistent. Both Keane CJ and Yates J appear to agree that 'industrious collection' may be taken into account in determining originality, but that it is not sufficient, as the Laddie formulation must be read conjunctively. While all of the judgments, and especially the judgments of Perram and Yates JJ, emphasise that the relevant activities must be directed at the fixation of a work, Perram J denies that the antecedent effort in gathering or collecting information can be taken into account, whereas Yates J held that it could be taken into account. The judgment of Keane CJ on this point appears ambiguous as, despite accepting the Laddie formulation, his Honour held that the actions of recording information could not amount to authorship, as this results in the production of facts and not protectable expression.[117] Consequently, the ambiguities and inconsistencies arising from the plurality judgments in *IceTV* have, unsurprisingly, led to similar ambiguities and inconsistencies in the approaches adopted by the FFC to subsistence of copyright in compilations.

113 Ibid 183 [138]–[140].
114 Ibid 183 [140], 189–190 [164]–[165].
115 Ibid 190 [166].
116 Ibid 190–1 [166]–[169].
117 Ibid 163 [59].

B *Authorship*

At first instance in *PDC*, Gordon J explained the relationship between authorship and originality following *IceTV,* in the following terms:

> Authorship and originality are correlatives. The question of whether copyright subsists is concerned with the particular form of expression of the work. You must identify authors, and those authors must direct their contribution … to the particular form of expression of the work. Start with the work. Find its authors.[118]

On appeal, the members of the FFC also emphasised the fundamental importance of authorship. For example, Keane CJ states that:

> The reasons of the High Court in *IceTV* for the determination of the present case indicate authoritatively that too much emphasis on protecting another's skill and labour is apt to skew the enquiry as to the subsistence of copyright away from the centrality of authorship.[119]

The main argument made by Telstra in the appeal was based on the territorial connecting factor, in s 32(2)(c) of the *Copyright Act*, which establishes that copyright subsists in an original work provided it is first published in Australia. The territorial connecting factor must be distinguished from the personal connecting factor, which requires the identification of an author as a 'qualified person'.[120] Following from this, Telstra argued that copyright would subsist in its directories provided only that it could be established they were original, without any additional need to identify an author or authors, authorship effectively being inferred from originality.

Prior to *IceTV,* the most important Australian authority on the relationship between originality and authorship was the High Court decision in *Sands & McDougall Pty Ltd v Robinson*,[121] which, as pointed out above, rejected the contention that the introduction of a statutory requirement of originality imputed something additional to authorship, such as 'inventive' originality. In doing so, Isaacs J held that the change did not impose double conditions for subsistence of copyright, but that 'author' and 'original work' had 'always been correlative'.[122]

Significantly, his Honour then went on to explain the scheme of the Act as follows:

> All literary works are protected if 'original.' That is the *only condition* — apart, of course, from certain disentitling considerations … The protection is called 'copyright,' and the *owner* of the copyright, whoever he may be, is the person who can enforce it. The 'owner of the copyright' is then designated. *Prima facie* it is the 'author' … who is referred to, not

118 (2010) 264 ALR 617, 685 [344].

119 *PDC* (2010) 194 FCR 142, 169–70 [84]; see also 184 [143] (Yates J).

120 *Copyright Act 1968* (Cth) ss 32(2)(d)–(e).

121 (1917) 23 CLR 49.

122 Ibid 55.

> as an additional condition of copyright, but as the owner of the copyright already fully declared.[123]

Comparing this statement with the statement of the relationship between originality and authorship in the judgment of Gordon J extracted above, the change in emphasis effected by *IceTV* becomes clear: although correlative, authorship, not originality, assumes primary importance.

The centrality of authorship following *IceTV* gives rise to two important issues arising from the Gummow judgment: the need to identify an author or authors; and the need for human authors. On the first issue, in rejecting the main argument made by Telstra, Gordon J stated:

> To suggest that copyright does not require the identification of authors where a work is sufficiently original (howsoever that question of originality is to be answered) puts the cart before the horse. It ignores the fact that it is the original work of an author or authors who contribute to the particular form of expression of the work and reduce the work to a material form that is the act giving rise to the statutory protection of copyright.[124]

From this, the identification of authors, not the originality of the work, becomes the primary focus in the analysis of subsistence.

Evidential difficulties, however, clearly arise in the identification of the authors of industrial-scale compilations, such as directories, involving contributions from multiple individuals. For example, before Gordon J, Telstra filed 91 affidavits relating to those involved in producing the directories. Gordon J, however, held that the affidavits were deficient, first, because they did not identify all of those who made an authorial contribution (partly because the records did not exist) and because they identified some who were not authors.[125] Secondly, her Honour held that substantial parts of the directories did not have human authors, but were the result of the GCS program.[126]

Before the FFC, Telstra argued that Gordon J had erred in treating the identification of authors as a separate pre-condition for copyright. A problem with the emphasis given to the identification of authors in the Gummow judgment in *IceTV* is that if this requires the identification, by name, of each and every author of a complex compilation, as seemingly required by Gordon J, this makes it onerous or impossible to establish copyright in such works. In the FFC, both Keane CJ and Perram J take up this issue, concluding that it is not necessary to identify *by name* each and every author where s 32(2)(c) is relied upon, with Perram J concluding that the statement in the Gummow judgment in *IceTV* apparently to the contrary is 'a counsel of wisdom rather than a legal stipulation.'[127] That said, all of the

123 Ibid 57 (emphasis altered).

124 *PDC* (2010) 264 ALR 617, 628–9 [35].

125 Ibid 683 [334].

126 Ibid 683–4 [335].

127 *PDC* (2010) 194 FCR 142, 181 [127]; see also 162 [57] (Keane CJ).

judgments of the FFC in *PDC* accept that it is necessary to establish that the work originates from an author or authors.

As explained above, the Gummow judgment in *IceTV* pointed out that, absent specific protection of computer-generated works, copyright could not subsist where the relevant expression was generated by a computer program and, therefore, did not originate from human authors. On appeal, Telstra argued that the directories were not computer-generated, as the relevant employees used the GCS program as a tool. As with other elements of the reasoning in the FFC, while the judgments concur in the outcome, there are differences of emphasis. Nevertheless, in reaching the conclusion that the relevant expression was computer-generated, each of the judgments was required to dismiss the human efforts involved in establishing the parameters of the GCS program, as well as the human efforts in using the program for activities such as manual error correction and verification of entries.

The judgments of the members of the FFC on this issue are each highly dependent on the finding that the relevant expression in the directories was fixed in a material form with the production of a computer file known as the 'galley file', which contained the full listings of each directory. This file was produced in the Extraction Phase from the GCS database, but was not, itself, a part of the database. As a result of this finding, Keane CJ ruled out the antecedent effort in establishing the GCS database because, as his Honour emphasised, there was no separate claim for copyright in the database.[128] Keane CJ also dismissed the efforts of a considerable number of Telstra employees involved in manually ensuring the accuracy of the directory listings, largely on the basis that these activities were purely mechanical, and dictated by the GCS program.[129] In this respect, his Honour drew an analogy with the editorial correction of errors in a text, which does not constitute authorship.[130]

The judgment of Perram J more directly confronts the argument that the GCS program was a mere tool used by human authors in the production of the directories. Focusing on the galley file, his Honour identified the relevant activities in producing it as involving the application of the internal rules about the directories, the extraction of the relevant customer entries from the database of all customers and the sorting of the material into relevant formats.[131] On this, his Honour held that, if these activities had been undertaken by humans, then the directories would have been original.[132] But, although the evidence indicated that humans were responsible for operating the GCS program to generate the galley file, Perram J held that they were not authors, as their efforts did not shape or direct the material form of the directories. In this respect, his Honour stated:

128 Ibid 145 [4], 162 [56].
129 Ibid 153–4 [30]–[34], 162–3 [58]–[59].
130 Ibid 165–6 [71] .
131 Ibid 176–7 [113].
132 Ibid.

> So long as the person controlling the program can be seen as directing or fashioning the material form of the work there is no particular danger in viewing that person as the work's author. But there will be cases where the person operating a program is not controlling the nature of the material form produced by it and in those cases that person will not contribute sufficient independent intellectual effort or sufficient effort of a literary nature to the creation of that form to constitute that person as its author …[133]

While accepting that the relevant works were reduced to a material form with the production of the galley file, Yates J also emphasised that copyright was claimed only in specific components of the directories, such as the listings, enhancement of listings and arrangement of listings in the White Pages directories. As noted previously, however, unlike the other members of the FFC, his Honour was prepared to consider activities antecedent to the extraction of the galley file as relevant to the originality of the claimed works. However, like the other judges, Yates J held that the key activities of selecting, ordering and arranging the listings in the galley file were undertaken by the GCS program, and not by human authors. In addition, Yates J went on to consider whether the human supervision of the computer system — in terms of selecting, customising and maintaining the computer programs — could be regarded as authorial. On this, his Honour analogised those activities to supervising human employees who selected, ordered or arranged material, pointing out that these supervisory activities were not authorship.[134]

Consequently, despite some clarification of the new principles relating to authorship in the judgments in *PDC,* there remain important ambiguities and uncertainties. First, while the majority of the FFC accepted that it may not be strictly necessary to identify each and every author of a compilation by name, there remain important questions about the sort of evidence needed to establish that a compilation originates from human authors. Furthermore, by concluding that copyright did not subsist in the directories as the relevant expression was computer-generated, the judgments in *PDC* raise questions about the degree of human decision-making or supervision that may be needed, when a highly functional computer program is used to produce works, in order for there to be human authorship. The suspicion is that the conclusion that the directories were computer-generated provided an opportunity for the FFC to avoid resolving difficult issues arising from the alternative bases for Gordon J's conclusion that copyright did not subsist.

C *Joint Authorship*

If more than one person is involved in producing a work, then the work must be a WoJA. The emphasis given to authorship following *IceTV* has resulted in a new

133 Ibid 178–179 [118].

134 Ibid 190–1 [168]. As his Honour put it: '[t]hose activities are akin to educating, training or instructing individuals … to carry out the discrete activities of selecting, ordering and arranging material to create the individual compilations.'

focus on the definition of a WoJA, which is set out above.[135] From this definition, two requirements must be satisfied for a work to qualify as a WoJA: there must be sufficient collaboration between the alleged authors; and the contribution of each author must not be separate from the contributions of the other authors.

At first instance in *PDC,* Gordon J held that there were serious questions about whether the directories were WoJAs, on the bases that there may not have been sufficient collaboration between the relevant Telstra employees, and that their contributions may have been separate.[136] As her Honour held that Telstra had not sufficiently identified the alleged authors, however, the issue was not pursued. Before the FFC, only Keane CJ addressed this issue. Referring to the segmentation of the process for producing the directories, his Honour held that the directories did not qualify as the production process 'was not collaboration of the kind contemplated by the definition of joint authorship, and the contribution of each of the groups … was made quite separately.'[137]

Since *IceTV,* the need to establish that a compilation allegedly produced by multiple authors is a WoJA has, in a series of cases, been singularly important in determining whether or not copyright subsists. Some cases have strictly applied the definition to find that, where contributions are at all separable, there can be no copyright. In *Primary Health Care Ltd v Commissioner of Taxation*,[138] for example, copyright was claimed in doctors' patient records, which included handwritten consultation notes and health records contributed by multiple people, including medical practitioners and reception staff. Stone J held that, where the consultation notes were contributed by different doctors, there was insufficient collaboration, and the contributions were too separate, for the records to be WoJAs. Similarly, in *Acohs Pty Ltd v Ucorp Pty Ltd*,[139] copyright was denied in the source code for the generation of documents known as material safety data sheets, which were necessary for regulatory approval for hazardous substances. The documents were produced by Acohs' employees who entered information in response to prompts from a computer program, known as the Infosafe System. Acohs argued that the programmers responsible for the Infosafe System and the employees who used the program were joint authors. At first instance, Jessup J held that the source code was not a WoJA on the grounds that:

> the respective contributions of the programmers and the authors/transcribers to the source code for a particular MSDS were separate each from the other along the axes of communication, time, expertise and content. Only by a quite artificial straining of the language to meet

135 Part IID.

136 (2010) 264 ALR 617, 684.

137 *PDC* (2010) 194 FCR 142, 171 [92].

138 (2010) 186 FCR 301.

139 (2010) 86 IPR 492.

> the needs of Acohs in the present litigation might those contributions be regarded as a matter of collaboration in the statutory sense.[140]

Other cases seem to have adopted a more relaxed approach. In *Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd*,[141] copyright was claimed in a compatibility chart for printers, which consisted of a computer file with product information in the form of a chart. The information in the chart was extracted from a database, known as the Navision database, to which a number of people contributed. The applicants claimed that the person mainly responsible for the database, and the person who extracted the information and arranged it in the chart, were joint authors. In addressing this claim, Yates J acknowledged that the meaning of the limit imposed by the requirement that the relevant contributions must be 'not separate' is 'not clear'.[142] In the result, his Honour was able to avoid the joint authorship issue by finding that the person who selected material from the database to include in the chart, and arranged the chart, was the sole author.[143] Finally, in *Sanofi-Aventus Australia Pty Ltd v Apotex Pty Ltd [No 3]*,[144] the applicant claimed copyright in product information documents that were submitted for regulatory approval under the *Therapeutic Goods Act 1989* (Cth). The information in the documents was contributed by a group of employees, and the respondent argued that copyright did not subsist, as the documents were not WoJAs. Referring to the FFC decision in *PDC,* Jagot J held that, although it was impossible to individually identify each and every person who was a potential author, the documents were WoJAs. In reaching this conclusion, her Honour stated:

> it cannot be said that the documents are the result of individual and separate efforts rather than collaboration as required by the definition of 'work of joint authorship'. The works … are not analogous to a series of individual patient notes written by different healthcare professionals as in *Primary Health Care*. Nor are they analogous to the individual contributions of programmers necessary to create material safety data sheets in *Acohs*.[145]

The need to identify authors, coupled with confusion surrounding the elements of the definition of a WoJA, creates considerable uncertainty about the protection of works that result from the contributions of multiple people. As in *PDC,* a company responsible for a complex informational work may present a substantial amount of evidence concerning those involved in producing the work, yet copyright may be denied on the grounds that the work is not a WoJA. Yet, as explained in the next section of the article, this new questioning of collaborative works is completely at odds with the approach historically adopted by English and Australian courts to the protection of collaborative informational works.

140 Ibid 514.This finding was not challenged in an appeal to the FFC, in which the appellant claimed that the programmers were authors of the source code. On appeal, the FFC held that the source code of each document was not an original literary work as it was generated by a computer program and not by human authors: *Acohs Pty Ltd v Ucorp Pty Ltd* [2012] FCAFC 16, [57]–[58].

141 (2011) 91 IPR 488 ('*Tonnex*').

142 Ibid 501.

143 Ibid 504–5.

144 (2011) 196 FCR 1.

145 Ibid [355].

IV THE TRUE HISTORY OF THE PROTECTION OF INFORMATIONAL WORKS

As pointed out by Ginsburg, early copyright disputes commonly involved informational works, such as maps and directories, which required the expenditure of resources, but embodied minimal personal creativity. This section of the article explains the traditional approaches of English and Australian courts to originality, authorship and joint authorship, and how, as opposed to the new author-centric paradigm adopted by the High Court in *IceTV,* these approaches favoured the protection of informational works resulting from the collective efforts of multiple contributors.

A *Originality*

In a long line of authorities, recounted at length in the separate judgments of Lindgren J and Sackville J in *Desktop,* English and Australian courts accepted that 'industrious collection' alone could establish that an informational work was original. The best known of the English 'industrious collection' cases are probably the three 'Morris cases', which each involved claims by the producers of directories against the use of information copied from the directories in rival directories.

In *Kelly v Morris*,[146] it was claimed that the defendant had infringed copyright in the *Post Office London Directory.* The directory, which was a 19th century analogue to the Yellow Pages, essentially comprised an alphabetical list of names, occupations and addresses of traders in London. The compilation of the information in the directory involved a large number of people, with names and addresses being recorded on slips by employees of the Post Office, the information being collated by sub-sorters in the Inland Department, the information being checked by letter-carriers on their rounds, and re-sorting being undertaken at Kelly's offices in Boswell Court.[147] As Norton recounts, the additional work imposed on Post Office employees led to considerable unrest directed against Kelly, who had purchased the copyright, leading, in 1847, to the transfer of much of the sorting work to Boswell Court, and the employment of private agents to collect the information.[148] The defendant, JCS Morris, who published a rival directory, used his own canvassers but, where information was missing, copied it from other directories, including Kelly's. Page Wood V-C granted an injunction, on the basis that:

> a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road-book, he must count the milestones for himself.[149]

146 (1866) LR 1 Eq 697.

147 See J E Norton, 'The Post Office London Directory' (1966) 21(4) *The Library* 293.

148 Ibid 299.

149 *Kelly v Morris* (1866) LR 1 Eq 697, 701.

In the second Morris case, *Morris v Ashbee*,[150] the defendant in the first case brought an action for infringement in its own traders' directory. The defendants used slips cut from the plaintiff's directory to guide them to potential advertisers in their rival directory but, in doing so, copied entries from the plaintiff's directory. In awarding an injunction, Giffard V-C summarised the 'industrious collection' principle as follows:

> in a case such as this no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road.[151]

Morris v Wright,[152] the third Morris case, was an appeal from a decision to dissolve an injunction restraining the defendants from using the information in the Morris directory to direct them to potential advertisers. As the defendants used the information, but did not copy it, Giffard LJ affirmed the decision dissolving the injunction. In doing so, however, His Lordship endorsed the 'industrious collection' principle established in the first two Morris cases.

A decision to reject 'industrious collection' as a ground for originality must not only address the reasoning in directory cases, such as the Morris cases, but must also confront the reasoning of the majority of the House of Lords in *Walter v Lane*,[153] in which the majority held that the labour expended in transcribing Lord Rosebery's speeches was sufficient to confer originality. In that case, even Lord James, who considered that the reporters' contributions went beyond mere mechanical transcription, confirmed that:

> The compilation of a street directory, the reports of proceedings in courts of law, and the tables of the times of running of certain railway trains have been held to bring the producers within the word 'author'; and yet in one sense no original matter can be found in such publications.[154]

Yet, apart from criticism of the reasoning of the FFC in *Desktop,* both judgments in *IceTV* singularly failed to engage with the 'industrious compilation' line of cases, including both the directory cases and *Walter v Lane.* Moreover, in *PDC,* on facts that more directly raised 'industrious collection', only Keane CJ referred to the directory cases, and then only in the context of concluding that the reasoning in *IceTV* required 'revision' of the originality threshold.[155]

While the rejection of 'industrious compilation' by the US and Canadian Supreme Courts, in *Feist* and *CCH,* respectively, resulted in a relatively coherent originality threshold in both jurisdictions, the failure of the Australian courts to seriously address the 'industrious collection' precedents has resulted in uncertain and

150 (1868) LR 7 Eq 34.
151 Ibid 40–1.
152 (1870) LR 5 Ch App 279.
153 [1900] AC 539.
154 Ibid 554.
155 (2010) 194 FCR 142, 168 [79].

inconsistent law. For example, in both the French and Gummow judgments, the extent to which 'industrious collection' can be taken into account in determining whether copyright subsists is at least ambiguous. In the French judgment, it seems that effort expended in originating facts may satisfy the 'not copied/originating from the putative author' principle and, when mixed with a degree of 'creative' effort, may satisfy the originality threshold. Nevertheless as, according to the judgment, labour expended in producing facts cannot be taken into account in assessing the originality, and therefore the substantiality, of material that has been copied, there is no practical reason for permitting 'industrious collection' to be taken into account for the purpose of subsistence. The Gummow judgment is similarly ambivalent about the extent to which 'industrious collection' can be taken into account for the purpose of subsistence, with the adoption of the Laddie formulation of authorship suggesting that it is relevant, while other statements suggest that only the selection and presentation of information can be considered.[156]

The uncertainties surrounding originality following *IceTV* could easily have been avoided, as the High Court could have applied a more conventional analysis to reach the same conclusion. For example, applying the reasoning in cases such as *Leslie v J Young & Sons*,[157] *Cramp* and *Macmillan v Cooper,* the Court could have decided that the skill involved in selecting the time and title information was not sufficient to be a substantial part. Alternatively, the Court could have rested its decision solely on the ground that the skill in selecting the information was directed to Nine's business, and was preliminary to the production of the work which, admittedly, would have required greater attention to when it is permissible to take into account antecedent effort. That the Court adopted neither of these paths suggests that it chose the opportunity to reshape the law on the protection of information works. Unfortunately, it did so in overly complex ways, and with a cavalier approach to precedent. As the next section explains, this also characterises the approach to authorship of informational works in *IceTV* and its progeny.

B *Authorship*

In *IceTV* and its progeny, Australian courts have effectively adopted a 'high authorship' paradigm. As explained above,[158] the new centrality of authorship has given rise to questions involving the identification of the authors of a work and the need for human authorship.

The Gummow judgment in *IceTV* expressly stated that, among other matters, a failure to adequately identify the author of a work 'may cause the formulation of the issues presented to the court to go awry.'[159] The considerable practical

156 *IceTV* (2009) 239 CLR 458, 508.

157 [1894] AC 335.

158 Part IIIB.

159 (2009) 239 CLR 458, 496.

difficulties that would arise from a literal application of this injunction to complex compilations involving multiple contributors were apparently recognised by members of the FFC in *PDC*. Accordingly, as explained above, Keane CJ held that copyright could subsist in such a work without identifying each and every author by name, and Perram J concluded that the statement in the Gummow judgment was merely 'a counsel of wisdom'.[160]

Long established case law, overlooked by the Gummow judgment, suggests that the caution expressed by the FFC is justified. As the statements in cases such as the Morris cases illustrate, 19th century courts traditionally protected the labour and resources expended in producing informational works. To require the identification of each and every potential author of such works to be identified would effectively defeat this objective. Consequently, while a substantial labour force was involved in producing works such as the *Post Office London Directory,* in cases such as the Morris cases, there were no disputes about whether or not a plaintiff responsible for coordinating the production of the work was entitled to copyright.

Furthermore, it is not the case that arguments about the identification of the authors of a compilation did not arise in early copyright cases. Under both the *Statute of Anne*,[161] and the *Copyright Act 1842* (UK),[162] copyright generally vested in the author of a book. The relaxed approach to authorship of a composite work under the *Statute of Anne* is probably best captured by the statements of Sir John Leach V-C in *Barfield v Nicholson*:

> I am of opinion, that, … the person who forms the plan, and who embarks in the speculation of a work, and who employs various persons to compose different parts of it, … — that he, the person who so forms the plan and scheme of the work, and pays different artists of his own selection who upon certain conditions contribute to it, is the author and proprietor of the work, if not within the literal expression, at least within the equitable meaning of the statute of Anne, which, being a remedial law, is to be construed liberally.[163]

That a similarly liberal attitude was applied under the 1842 Act is clear from *Scott v Stanford*,[164] which involved a claim for infringement in statistical returns showing the quantity of coal imported into London, that were published by the registrar of the Coal Market of the City of London. Although the plaintiff was assisted in the production of the statistics, Page Wood V-C held that this did not prevent him from being the author, stating that:

> It appears to me quite immaterial whether he has been assisted in the compilation by his own clerks, or by those of the Corporation. A great

160 *PDC* (2010) 194 FCR 142, 181 [127].

161 *Copyright Act 1709*, 8 Anne, c 19.

162 5&6 Vict, c 45.

163 (1824) 2 LJ (OS) Ch 90, 102; 57 ER 245, cited with approval in *Shepherd v Conquest* (1856) 139 ER 1140, *Hatton v Kean* (1859) 141 ER 819 and *Aflalo v Lawrence & Bullen* [1903] 1 Ch 318, 331.

164 (1867) LR 3 Eq 718.

> deal of time and labour must have been spent in this compilation, more, indeed, than in the case of a directory or guide; and there can be no doubt that he is entitled to be protected in the fruits of his labour.[165]

The argument that copyright cannot subsist in a compilation unless the authors are identified was specifically rejected in *MacLean v Moody*.[166] In that case, the complainers had exclusive access to customs information for the Clyde River. To protect their publication, the complainers registered themselves at Stationers' Hall as proprietors and publishers of the shipping list, but not as authors. In their defence against a claim for infringement, the main argument of the respondents, which is expressed in almost identical terms to the authorship principles adopted in the Gummow judgment in *IceTV,* was summarised as follows by Lord Deas:

> the object of statute was to encourage literary merit, — that intellectual labour, constituting authorship, is alone thereby protected, — that there can be no authorship without an author, — and that, here, there is no author, — at least, that the complainers are not the authors …[167]

Given the history of the protection of informational works, it is unsurprising that Lord Deas rejected the respondent's arguments. First, his Lordship pointed out that copyright was not confined to works of literary merit, but that 'mere compilation and arrangement, as in a Court calendar, or an almanack, — the mere results of inquiry, as in a road-book or guide-book, — and so on, may be the subjects of copyright'.[168] Secondly, Lord Deas addressed the argument, apparently accepted in *IceTV* and its progeny in relation to the *Copyright Act*, that the structure of the 1842 Act, and especially the reference to the life of the author as a criterion for duration, demands identification of an author. In rejecting this, his Lordship pointed out that provisions of the 1842 Act seemed to assume that the first publisher was the owner 'although no author has been or can be named upon either side.'[169] Similarly, it could be argued that specific sections of the *Copyright Act* — the provision for copyright to subsist on first publication in Australia,[170] provision for duration of protection in anonymous works,[171] and the statutory presumption of ownership where the name of a publisher appears on copies of a work[172] — recognise the possibility of copyright subsisting in a work, despite the author or authors being unidentified. Thirdly, Lord Deas dismissed an argument that the assistants employed by the complainers to arrange and organise the information were the authors of the works, and not the complainers, essentially on the grounds that the complainers controlled the process and owned the information.

165 Ibid 723.

166 (1858) 20 Sess Cas 1154.

167 Ibid 1163.

168 Ibid. Note the distinction drawn between compilation and arrangement on the one hand, and the results of inquiry on the other.

169 Ibid.

170 *Copyright Act 1968* (Cth) s 32(2)(c).

171 Ibid s 34.

172 Ibid s 128.

The entire reasoning in *MacLean v Moody* is therefore completely contrary to the approach to authorship of compilations adopted by the Gummow judgment in *IceTV*. Yet, it is not as if *MacLean v Moody* was an exceptional or unknown case. Despite Cornish dismissing Lord Deas' judgment as 'one signpost to a path down the incline',[173] the reasoning in the case is, in fact, perfectly consistent with the approach to authorship in all prior cases involving informational works that addressed the issue, including *Barfield v Nicholson* and *Scott v Stanford*. Furthermore, the report of the case itself cites two prior Scottish decisions, *Walford v Johnstone*,[174] which had held that copyright subsisted in the *Clyde Shipping List*, and *Atlas Company v Fullarton & Sons*,[175] in which copyright was held to subsist in maps, despite the difficulties in attributing authorship to any given individual. Furthermore, the case is cited without qualification as good authority on copyright in compilations in most early copyright texts.[176]

The only acceptable conclusion from these cases is that informational works, such as directories, were regarded as having a logic of their own in which, once it was established that sufficient relevant effort had been expended, an inability to specifically identify an individual author or authors was not considered fatal to the subsistence of copyright.

Although the courts did not insist on the identification of individual authors of informational works, it remained the case that the works had to originate from the efforts of human authors. The natural concomitant of this is that if a work does not have a human author or authors, copyright will not subsist. This only really became an issue with the development of functional computer programs, which were capable of generating expression relatively independently of humans. The problem was first addressed in the UK by the 1977 Whitford Committee, which concluded that there was no need for special treatment as the correct approach was to regard a computer merely as a tool used by human creators.[177] Nevertheless, as pointed out in the Gummow judgment in *IceTV*, the *Copyright, Designs and Patents Act 1988* (UK) introduced a specific provision identifying the author of a computer-generated work as 'the person by whom the arrangements necessary for the creation of the work are undertaken'.[178] In Australia, the issue was first seriously canvassed in the 1995 Copyright Law Review Committee ('CLRC')

173 Cornish, above n 4, 17. Cornish also anachronistically refers to the decision in *Walter v Lane* as the 'pit floor', despite the decision of the House of Lords in that case being generally welcomed at the time: see, eg, 'Note' (1901) 17 *Law Quarterly Review* 1; J Andrew Strahan, 'The Reporter and the Law of Copyright' (1901) 26 *Law Magazine and Review Quarterly* 35.

174 (1846) 20 Sess Cas 1160.

175 I M Duncan, *Report of the Trial at the Instance of Atlas Company of Scotland against A Fullarton and Company, Publishers, Edinburgh and London* (1853).

176 See, eg, Walter Arthur Copinger, *The Law of Copyright in Works of Literature and Art* (Stevens and Haynes, 1st ed, 1870) 22; Walter Arthur Copinger, *The Law of Copyright in Works of Literature and Art* (Stevens and Haynes, 2nd ed, 1881) 41, 130; Charles Palmer Phillips, *The Law of Copyright in Works of Literature and Art and in the Application of Designs* (1863) 54–5.

177 *Copyright and Designs Law: Report of the Committee to consider the Law on Copyright and Designs*, Cmnd 6732 (1977) [513]–[516]. See also Department of Trade and Industry (UK), *Intellectual Property and Innovation,* Cmnd 9712 (1986) [9.6]–[9.8].

178 *Copyright, Designs and Patents Act 1988* (UK), s 9(3).

Report on *Computer Software Protection,* which recommended introducing a new category of Part IV protection for 'computer-generated material'.[179]

As is clear from the CLRC report, in the absence of specific protection, the key issue in determining whether copyright subsists in a work produced by the use of a computer is whether the work has been created with the assistance of a computer program, in which case the program can be regarded as a tool of a human author or authors, or whether the work has been created by a computer program, in which case copyright will not subsist. The distinction is not always easy to draw. In the one English case to consider the position, *Express Newspapers plc v Liverpool Daily Post & Echo plc*,[180] Whitford J held that a program used to generate a series of numbers in grids as part of a newspaper puzzle was used as a tool of a human author, such that the work was computer-assisted, not computer-generated. By way of contrast, the CLRC report suggested that images automatically generated by remote sensor satellites and printed out at the press of a button were archetypal examples of computer-generated works.[181]

As Davison explains, there often may be complexities in identifying a human author or authors of electronic databases, with it being possible, nonetheless, to claim that the authors are either those responsible for deciding the form or scheme of material stored in a database or, by virtue of selecting the software, choosing the operations to be performed on the data.[182] Moreover, from the decision of the FFC in *PDC*, it is clear that much may depend upon the evidence presented concerning the work in suit and the putative authors. Thus, in that case, confining the works in suit to the listings and arrangement of listings in the directories in hard copy form, led the Court to focus the analysis of authorship on those responsible for the production of the work in that particular material form. As the humans operating the GCS to produce the directories were essentially entering data in response to computer-generated prompts, it is unsurprising that their contributions were considered insufficiently authorial. Yet, if Telstra had claimed copyright in the GCS database instead, and if we accept the logic suggested by Davison, it may well have been possible to identify human authors responsible for selecting and organising material stored in the database. That said, the rejection of 'industrious collection' as a basis for the protection of informational works in *IceTV* and its progeny would render any finding of copyright in the database pyrrhic as, applying the logic of both judgments in *IceTV,* the listings in the directories could not amount to a substantial part of any copyright subsisting in the database.

179 Copyright Law Review Committee, *Computer Software Protection* (1995) 15 [2.42].

180 [1985] 3 All ER 680. For the position under South African law see *Haupt v Brewers Marketing Intelligence (Pty) Ltd* [2006] SCA 39 (RSA), holding that a database was not a 'computer generated work' as computer programs used in the creation of databases were mere tools.

181 Copyright Law Review Committee, above n 179, 245 [13.11].

182 Davison, above n 77, 22–3.

C *Joint Authorship*

As explained above,[183] the new emphasis on authorship following *IceTV* raises questions about the subsistence of copyright in works produced by multiple contributors, especially by courts adopting a relatively literal application of the definition of a WoJA. Yet, as with the treatment of authorship of informational works, this approach to WoJAs is out of line with the historical treatment of works produced by more than one author.

The statutory construct of a WoJA was first introduced in the *Copyright Act 1911* (UK), which defined a WoJA as:

> a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors.[184]

Prior to this, the concept of joint authorship was developed by the common law.

The principal common law authority on joint authorship is *Levy v Rutley*.[185] In that case, the plaintiff hired a dramatist to write a play, but later independently made alterations and additions, including adding one full scene. An action brought by Levy under the *Dramatic Copyright Act 1833*,[186] could not be sustained unless he could establish he was a joint author. In concluding that the plaintiff was not a joint author, the Court held that there had been no cooperation in the production of the play as part of a common design, with Keating J stating the test in the following terms:

> if two persons undertake jointly to write a play, agreeing in the general outline and design, and sharing the labour of working it out, each would be contributing to the whole production, and they might be said to be joint authors of it.[187]

From the common law, then, it seems clear that there will be sufficient collaboration between contributors when a work is produced as part of a common design, but not when contributions are made that are not part of that design. This would not seem to create many difficulties for the production of informational works subject to centralised coordination, such as within the one corporation, and without, for example, ad hoc additions. Nevertheless, this leaves outstanding the meaning of the second element of the statutory definition, namely that the contributions of the collaborators must not be 'distinct' (1911 UK Act) or 'not separate' (the current *Copyright Act*). Even Yates J, in the *Tonnex* case, held that the meaning of this additional limit is not entirely clear.[188]

183 Part IIIC.
184 *Copyright Act 1911* (UK), s 16(3).
185 (1871) LR 6 CP 523.
186 3&4 Will 4, c 15.
187 (1871) LR 6 CP 523, 529.
188 (2011) 91 IPR 488, 501.

The intended meaning of the second element of the definition of a WoJA can be explained, however, by a closer examination of the 1911 UK Act. In particular, it must be understood that the 1911 Act protected two kinds of works resulting from multiple contributions: WoJAs and 'collective works'. The Act defined a 'collective work' to mean:

(a) an encyclopaedia, dictionary, year book, or similar work;

(b) a newspaper, review, magazine, or similar periodical; and

(c) any work written in distinct parts by different authors, or in which works or parts of works of different authors are incorporated.[189]

The key distinction between the two kinds of work was that, in the case of a collective work, there were separate copyrights in the distinct works contributed to the collection, as well as in the collective work considered as a whole. In relation to the collective work as a whole, the author was considered to be the person who edited the work, or arranged for its production.[190]

When the 1911 definitions of a WoJA and a collective work are compared, it is clear that while, on the one hand, the contributions to a collective work were distinct, in the sense that the author retained copyright in the distinct part contributed, the contributions to a WoJA were not distinct, in the sense that the authors shared in the only copyright subsisting in the work. This distinction is retained under US copyright law, which defines a collective work as:

> a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.[191]

The interpretation of the second element of the definition of a WoJA as meaning only that the contributions are not separate, in the sense that the contributors would be entitled to a separate copyright in the contributions, is supported by comments of the 1952 UK Gregory Committee, which distinguished a WoJA from 'a case such as the production of Encyclopedia Britannica, where the individual articles or chapters can be, and are, separate and distinguishable contributions from different hands'.[192] Unfortunately, the Gregory Committee did not seem to appreciate the link between the definition of a WoJA and a collective work, as it effectively concluded that the concept of a collective work no longer served a useful purpose and, consequently, the definition could be dispensed with.[193] This recommendation was implemented in the *Copyright Act 1956* (UK), and subsequently followed in Australia in the current *Copyright Act*, paving the way for the considerable current confusion experienced concerning the interpretation of the definition of a WoJA.

189 *Copyright Act 1911* (UK), s 35(1).

190 See, eg, F E Skone James, *Copinger on the Law of Copyright* (Sweet & Maxwell, 7th ed, 1936) 183.

191 17 USC § 101.

192 United Kingdom, *Report of the Committee on the Law of Copyright*, Cmd 8662 (1952) [25] ('*Gregory Committee Report*').

193 Ibid [37].

If the above account is accepted, then the two elements of the definition of a WoJA should be interpreted to mean no more than that the authors must collaborate in producing the work as part of a common design, and that the contributions must not be distinct or separate, in the way in which contributions of authors to a collective work, such as an encyclopedia, were formerly regarded as distinct. An interpretation firmly based on an understanding of the history of the definition therefore removes much of the uncertainty that has resulted in recent Australian decisions, which artificially segregate the contributions of those participating in the production of an informational work as part of a common design.

V CONCLUSION

The English common law tradition has always recognised the merits of protecting the labour and resources expended in producing 'low authorship' informational works, as well as the creative efforts expended in producing 'high authorship' works. In doing so, the courts clearly adapted legal doctrines to the distinct natures of the two sorts of works. Thus, with informational works, such as directories, Anglo-Australian courts traditionally regarded 'industrious collection' as sufficient to ground originality. Moreover, provided originality could be established, the courts were prepared to infer authorship, and specifically rejected arguments that each and every putative author of a complex compilation must be identified. Over and above this, 19th century courts were apparently prepared to attribute authorship to those responsible for coordinating a complex production process. Finally, the fact that there may have been multiple contributors involved in the production of a directory was never accepted as a basis for rejecting copyright. The focus of the English common law tradition was on whether the work was such as deserved protection against copying, and not on whether it embodied the personal imprint of an author or authors.

The adoption of the 'high authorship' paradigm in *IceTV* and its progeny, in so far as it regards copyright as protecting creative authors and not necessarily deserving works, therefore flies in the face of the common law tradition. The transformation of copyright law effected by *IceTV* moves Australian law towards a civil law, 'authors' rights' model, and away from the common law tradition. That this is so can be seen from the comments of Décary JA in the *Tele-Direct* case who, in drawing a connection between the creativity standard adopted in that case and the protection of 'high authorship', stated that:

> The use of the word 'copyright' in the English version of the Act has obscured the fact that what the Act fundamentally seeks to protect is '*le droit d'auteur*'. While not defined in the Act, the word 'author' conveys a sense of creativity and ingenuity.[194]

All of this said, however, it may be that protection of informational works, such as directories, is ill-suited to Part III of the *Copyright Act*. In this, it should be

194 [1998] 2 FC 22, 37.

borne in mind that the 19th century English directory cases were decided before the introduction of protection for more mechanical productions, such as sound recordings and films, which are protected under Part IV of the *Copyright Act*. A sub-text of the judgments in *IceTV,* and especially the Gummow judgment, is not that complex informational works compilations do not merit some protection, but that they do not fit easily within the Part III paradigm. In a similar vein, after referring to the *European Database Directive*, Gordon J in *PDC* observed that protection of databases is a matter that Parliament 'should address without delay'.[195]

This article is therefore not criticising the judgments of the High Court in *IceTV* for raising the originality threshold under Australian law, nor for the conclusions on the facts in that case. Neither does the article criticise the outcome in *PDC,* which is, in broad terms, similar (but not identical) to the conclusions reached under United States and Canadian law. It is quite reasonable for the complex policy issues involved with the protection of information works and databases to be dealt with by the legislature and not the courts.

What the article does criticise, however, are important elements of the reasoning in the judgments in *IceTV* and its progeny. First, as explained in Part IV of the article, the reasoning does not engage with Anglo-Australian precedent on any but the most superficial level. For such a major change in the law, it should be expected that the courts will accurately identify relevant precedent, and clearly explain how and why a judgment departs from that precedent. Secondly, and relatedly, the reasoning in the judgments in *IceTV* is unnecessarily convoluted, with both judgments being compromised by internal contradictions. This has created avoidable uncertainties and ambiguities in central legal doctrines in copyright law, which the lower courts have been unable to satisfactorily resolve. The unfortunate legacy of *IceTV* and its progeny is a lack of doctrinal clarity in the law relating to both subsistence and infringement. This cannot be rectified by a lazy acceptance of the new doctrines, but only by diligently attempting to restore consistency and coherence to the law, which requires a frank acknowledgement of the state of the law prior to *IceTV,* and the weaknesses of the plurality judgments in that case.

195 (2010) 264 ALR 617, 628.