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On clarifying the role of originality and fair
use in 19th century UK jurisprudence:
appreciating “the humble grey which emerges
as the result of long controversy”

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Abstract

Understanding nineteenth century precedent is one of the more difficult tasks in copyright today. This paper considers why the nineteenth century cases and treatises failed to clearly identify what the author owns of “right” and the implications for the criterion of originality and for determining infringement today.

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ABSTRACT

Understanding nineteenth century precedent is one of the more difficult tasks in copyright today. This paper considers why the nineteenth century cases and treatises failed to clearly identify what the author owns of “right” and the implications for the criterion of originality and for determining infringement today.

“The question of Copyright, like most questions of civil prudence, is neither black nor white, but grey”. (Macaulay’s Speeches, p110) ...we have through all the storm to bear in mind that the truth is not the black or white...but the humble grey which emerges as the result of long controversy.

Sir Thomas Edward Scrutton, *The Laws of Copyright*¹

Introduction

When the first treatises on copyright began to emerge in the mid-late nineteenth century, writers were only too aware of the polarised opinions that raged over “the absolute right of the author to the fruits of his labour”. There were strong condemnations of “monopoly”, of the ‘unworthiness’ of great authors trafficking with “dirty booksellers”, as well denunciation of the “pernicious communism” of limited literary property rights.²

Scrutton’s treatise sought to rise above this fray with recourse to a scientific approach to law, justified by an Austinian Utilitarianism:

Utilitarianism is the groundwork of the science and art of legislation, and that therefore the justification of any particular law, the reason which justifies its enactment, is the ultimate benefit to result to the community from its conformity to such a law.³

This led to his conclusion that,

The Fundamental Question of Copyright Law is:-

Is it desirable in the interests of the community that the State should create and protect property in literary productions or the results of intellectual labour?⁴

* This is an edited version of a forthcoming chapter in (ed) Lionel Bently et al, *The Common Law of Intellectual Property: Essays In Honour Of Prof David Vaver*, (Oxford University Press). With thanks to Catherine Bond, Lionel Bently, Michael Handler and Brad Sherman.

¹ Sir Thomas Edward Scrutton, *The Laws of Copyright: an examination of the principles which regulate literary and artistic property in England and other Countries*, (London: J. Murray, 1883), §1, p1-2.

² Scrutton, §1, p2.

³ Scrutton, §4 p4.

⁴ Scrutton, §5. p5. (his italics).

By way of contrast, Copinger's earlier treatise had began,

Copyright may be defined as the sole and exclusive liberty of multiplying copies of an original work or composition.

...What property can be more emphatically a man's own than his literary works?⁵

However even Copinger, a most ardent advocate for the common law right of the author,⁶ goes on to acknowledge that,

In order to acquire a copyright in a work it is necessary that it should be original...(However) Over this vast *field it is impossible to erect an unvarying general rule*, which can be fitted to all cases and capable of determining whether a particular work exhibits the degree of originality necessary to a valid copyright.⁷

Copinger retreats from his opening 'black and white' statement of absolute rights in original works to a safer shade of grey. For example, he suggests that rules about originality should be capable of adaptation to the objects of their labours,⁸ and, with regard to what constitutes piracy he concludes, "In many cases the line of demarcation is so loosely and indifferently drawn, that arrival at a just conclusion is a matter of difficulty."⁹

Despite very different politics and jurisprudence that lead to marked distinctions in approach to the subject of copyright and to legal reasoning, both eminent authors¹⁰ are unwilling to deduce clear principles that clarify legal boundaries with regard to what was actually protected by the "author's right" and what constitutes an infringement.

This article considers where we are now in relation to this history.

The key questions considered are:

- why do the nineteenth century cases and treatises fail to clearly identify what the author owns of "right"?
- what does this mean for the criterion of originality and for determining infringement?

This leads to a deeper consideration of what Macaulay and Scrutton meant by referring to copyright as a "grey subject". It should be noted that grey is not just a neutral tone that comes from mixing black and white, and thus an allusion to the balancing of rights. It is clear however, that this is what Macaulay meant.¹¹

⁵ Walter Arthur Copinger, *The law of copyright in works of literature and art* (London: Stevens and Haynes, 1870), p1, 5.

⁶ See Ronan Deazley, *Rethinking Copyright*, (Cheltenham: Edward Elgar, 2006) pp75-8.

⁷ Copinger, p20. (my italics)

⁸ Copinger, p21.

⁹ Copinger, p84.

¹⁰ Copinger's treatise was in its second edition by 1881, growing from an original 437pp to 956pp. Scrutton's text of 353pp was awarded the Yorke Prize Essay of the University of Cambridge in 1882.

¹¹ He went on to say, "The system of copyright has great advantages, and great disadvantages; and it is our business to ascertain what these are, and then to make arrangement under which the advantages may be as far as possible secured; and the disadvantages as far as possible excluded". *Speeches of the Honourable T.B. Macaulay M.P.*, (London: Longman, Brown, Green and Longmans, 1854), p232.

We also refer to our brains as ‘grey matter’ and associate the colour grey with the wisdom that is supposed to come with age, experience and the passing of time. My broader motivation in reflecting upon the “humble grey that emerges from long controversy” is to try and bring into the light the wisdom of nineteenth century copyright law and its potential relevance to the controversy over originality, compilations and copyright’s limits today.¹²

Appreciating the complexity of this history matters because it has, of late, become common to refer to nineteenth century positions in order to authorise very contemporary readings of the scope of protection awarded to original compilations in copyright. In the nineteenth century the notion of fair use had a much larger role to play, leading to a relative consideration of the original efforts and corresponding markets of the plaintiff and defendant. Further as Scrutton infers, consideration of the good served by our laws and, co-relatively, determining the wrong of “piracy”, involved an assessment of benefit to the community in conferring protection. By invoking history today, whilst ignoring these key points, we erase the wisdom of nineteenth century considerations of the need for ‘balance’.

There is nothing to suggest that a ‘loss’ of consideration of the public interest was ever intended. Rather it has come about as a consequence of codification and legislative drafting enacted with quite different reasons in mind. This raises complex questions about the use precedent in copyright, given that,

To be a lawyer in Australia is, in a sense, to be a legal historian. It is an escapable feature of the common law that we live our lives in the presence of the great legal spirits of the past and their cases.¹³

Some reservations dismissed

It could be considered that debate about the historical justification for copyright, the status of the common law right and its more limited positive expression in eighteenth and nineteenth century law is currently so conflicted and politicised¹⁴ that making authoritative reference to the law’s origins and purpose is fraught with difficulty. It could also be that the nineteenth century legislation was so deficient, and decisions were so inconsistent or incoherent, that it is possible to read the law in support of any manner of contrary propositions. Judicial technique in discerning and applying ‘legal principles’ could have been so poorly applied or used methodologies so many and varied that *drawing any universal conclusions about the reason and logic of nineteenth century law may be unwise.*

But if any of the above propositions are true, this raises fundamental questions affecting *all and any use of precedent* in copyright law today. At what point

¹² *IceTV Pty Ltd & Anor v Nine Network Australia Pty Limited* [2008] HCATrans 308.

¹³ Justice Michael Kirby, “Living with Legal History in the Courts”, [2003] 7(1) AJLH 17

¹⁴ See Ronan Deazley, *On the Origin of the Right to Copy*, (Oxford: Hart Publishing, 2004); Jane Ginsburg, “‘Une Chose Publique’? The Author’s Domain and the Public Domain in Early British, French and US Copyright Law,” 65 *Cambridge Law Journal* (2006), 636-670; Kathy Bowrey & Natalie Fowell, “Digging up fragments and building IP franchises”, Primary Sources on Copyright (1450-1900) Conference, Stationers Hall, London, 19-20 March 2008.

can one confidently presume that an authoritative path was established and clear principles (either black or white), were crystallised? If this is taken to have occurred, when did that come to pass? How was it justified, and with reference to what kind or form of legal reasoning or other authority? A longstanding judicial (and scholarly) failure to doubt the relevance and authority of precedent for well over a century suggests we need to consider the role and lessons of nineteenth century case law differently.

Can we minimise potential problems in reading the common law by adopting a utilitarian Austinian approach, as Scrutton desired? This would suggest discerning the logic of copyright law by recourse to the community interest as defined by the State.

The problem with this approach is that the Anglo and Australian Acts are too poverty-stricken as resources to be of much assistance. There is scant reference to legislative objective, principle or public purpose(s) in all our copyright legislation. Putting to one side the ‘pre-modern’¹⁵ matrix of subject-specific seventeenth and eighteenth century legislation and confining our consideration to the modern legislation, none of this law - from the *Copyright Act 1905* (Cth), *Copyright Act 1911* (UK), *Copyright Act 1912* (Cth) to the *Copyright Act 1968* (Cth) - purports to set a new path for determining the nature and scope of literary copyright. Legislative reform was not claimed as necessary to “resolve” past confusion about the fundamental nature and scope of the rights, or to inscribe significantly new precepts or legal principles in relation to the old subject matter.¹⁶ Rather justifications for the new laws have been far more conservative and primarily confined to redressing the past pre-modern organisation of the law through codification.¹⁷ To the extent that Commissions identified disagreement as to copyright’s purpose and scope, State wisdom was to leave it unchanged. As such, a utilitarian reading of positive law only returns you to the case law and judicial interpretation of “State” or “community interest”.

It is true that the *Berne Convention for the Protection of Literary and Artistic Works* (1884) and Berlin Convention of 1908¹⁸ provided some impetus to reconsider the rights awarded. These instruments influenced the drafting of the

¹⁵ As described by Brad Sherman & Lionel Bently, *The Making of Modern Intellectual Property Law*, (Cambridge: Cambridge University Press, 1999).

¹⁶ Of course the provisions regarding the new technologies and subject matter poses a somewhat different case. See also *Copyright Owners Reproduction Society Ltd v EMI (Australia) Pty Ltd* [1958] HCA 54; (1958) 100 CLR 597.

¹⁷ For example, the Royal Commission Report of 1878 begins, “The first observation which a study of the existing law suggests is that its form, as distinguished from its substance is bad. The law is wholly destitute of any sort of arrangement, incomplete, often obscure, and even when it is intelligible upon long study, it is in many parts so ill-expressed that no one who does not give such study to it can expect to understand it”. See Royal Commissioners' Report (1878), Primary Sources on Copyright (1450-1900), eds L. Bently & M. Kretschmer, Available at <www.copyrighthistory.org>.

¹⁸ The Convention for the Protection of Literary and Artistic Works (Berlin Act, 1908) extended the Berne Convention in recognising new subject matter such as photography, film and sound recordings, and also rights of translation, adaption and arrangement of music.

1905 Act (Cth) to a minor degree¹⁹ and the UK 1911 Act especially in relation to translations. However the text of the 1911 Act was crafted with a view to fostering uniformity amongst the Empire, affirming UK law and requiring minimal changes to the domestic law across the Commonwealth.²⁰ In Australia²¹ the Berne Convention has only been considered as requiring reconsideration of the scope of our traditional rights extremely minimally, and for most of the twentieth century, very inconsistently.²² Whilst it is noted in Parliamentary debates,²³ there is very little regard to the Berne Convention as a relevant source of Australian law to be found in our cases.²⁴ The influence of the Berne Convention on statutory interpretation of the 1911 Act (UK) is noted in *Sands & McDougall Pty Ltd v Robinson* [1917]. While Isaacs J notes “the international origin of the (1911) Act affords considerable aid in understanding it”²⁵ he then goes on to affirm the signatories were not attempting to affect pre-1911 UK law in regard to key concepts such as originality.²⁶ It is also worth noting that when there is debate about Australia’s international obligations it has become common to refer to the external affairs power s51(xxix) as the authority for the necessary reform, not to the power to make laws with respect to the copyright (as informed by the Berne Convention) under s51(xviii).²⁷ When it comes to discussing the origin of Australian copyright law, we have primarily looked to the UK common law not to international law, and accessed international obligation through the legacy of Empire.

¹⁹ Compare for example, Article 5 of the revised 1896 Berne Convention and section 30 of the *Copyright Act 1905* (Cth). Thanks to Catherine Bond for this point.

²⁰ As was noted in the House of Commons Debates, “the delegates were very emphatic on the line of uniformity of Copyright throughout the Empire...The basis of the Imperial Conference, and the Bill founded on its deliberations is that while we leave to the self governing Dominions liberty to legislate for themselves, we offer them the greatest possible inducement to accept the Imperial Act as a model, and to differ from it as little as possible, by offering reciprocal advantages”. Mr Buxton, The debate on the Second Reading, House Of Commons Debates, XXIII, p2594. See also L.C.F. Oldfield, *The Law of Copyright*, (London, Sydney, Calcutta: Butterworth & Co, 1912), Part 1.

²¹ Australia was bound by Berne from 1887 as it was declared to apply to the colonies. We became signatories in our own right in 1928.

²² For example, the Copyright Law Review Committee, *Report on Moral Rights* (1988) debated whether we were Berne compliant, and the Minority report considered whether moral rights were an “alien concept” to the Australian system of property rights. See also Sam Ricketson, “Australia and International Copyright Protection”, in (ed) MP Ellinghaus, AJ Bradbrook, AJ Duggan, *The Emergence of Australian Law* (Sydney: Butterworths, 1989); Sam Ricketson, “The Berne Convention: The Continued Relevance of an Ancient Text”, in David Vaver and Lionel Bently (eds), *Intellectual Property In The New Millennium: Essays In Honour Of William R. Cornish*, (Cambridge: Cambridge University Press, 2004), pp217-33.

²³ For example, whilst the Berne Convention is introduced as the motivation behind the 1911 Act (UK), “The first principle laid down by the British Act is that copyright is an Imperial matter...The majority of the countries of Europe...are in the Berne Convention, and the protection of this Act would extend to our authors and artists in all of the countries which are in the Convention...we have the power of the British Empire behind us when we ask for anything which is just and fair from another country”, See Senator McGregor, Second Reading Speech of the Copyright Bill, 1912, *Hansard* 1912 Vol LXIV pp1334-5.

²⁴ See *Grain Pool of WA v Commonwealth* [2000] HCA 14; 202 CLR 479; 170 ALR 111; 74 ALJR 648.

²⁵ *Sands & McDougall Pty Ltd v Robinson* [1917] 23 CLR 49 at 54.

²⁶ This is discussed further at p12.

²⁷ Thanks to Catherine Bond for these points.

Understanding nineteenth century UK case law is fundamental to understanding the long history of controversies surrounding copyright. Grappling with the difficulty of the state of the law of this time cannot really be avoided, unless Australian copyright is to instead step out with a radically new form of justification and rationale underlying the law's principles.

The 19th century cases

Creativity distinguished from originality

If the question asked was: 'Are certain kinds of factual or informational works, that lack creative inputs, altogether excluded from copyright protection?'; the courts usually answered that such works qualify for protection. Wood V.C. sums the rationale up well,

Copyright was considered for the highest purposes of society in every country as necessary to be secured to those who contributed to civilisation, refinement, or instruction of mankind, and extended in this country, if not elsewhere, to every description of work, however humble it might be, even to the mere collection of the abodes of persons and to streets and places; and labour having been employed upon subjects even of that class, no one had a right to avail himself of it.²⁸

To answer otherwise would be to endorse "reaping without sowing".

For example, in *Collis v Cater* the defendant conceded copying but argued that a "dry list" of products for sale comprised in a chemist's catalogue, was not protected. North J. noted:

The question is whether a man has a right to appropriate to himself without payment or recognition in any way what it has cost his neighbour expense and trouble to make out. In my opinion, he has not.²⁹

Other commonly cited cases that express this view include *Matthewson v Stockdale* 33 Eng Rep 103 [Ch 1806]; *Roworth v Wilkes* 107 Eng Rep 889 [KB 1807]; *Jarrod v Houlston* [1857] 3 K7J 708; *Scott v Stanford* (1867) L. R. 3 Eq. 718; *Walter v Steinkopff* [1892] 3 Ch. 489; *Leslie v Young* [1894] A.C. 335 H.L.. However it is wrong to conclude from this that the plaintiff had any absolute right to protection of skill and labour. Piracy was not determined by a finding of copying alone. Large and unacknowledged takings were inherently suspect, but even that was not necessarily sufficient to determine the wrong because notwithstanding the taking, the use may have been considered as fair.

There is a strong endorsement of an absolutist 'reaping without sowing' position in *Kelly v Morris* [1866]. This case involved a postal directory, where the defendant used the entries from the plaintiff's work as the basis of his own directory. He hired clerks to independently verify names and addresses were correct, but acknowledged that clerks sent to verify entries had been negligent and simply ticked as correct the plaintiff's entries instead and these were then cut and pasted by the defendant into his work. In finding a copyright infringement had occurred Sir W. Page Wood V.C. said,

²⁸ *Spiers v Brown* [1858] Ch. 6 W.R. 352 at 352.

²⁹ 78 LT 613 [Ch 1898] at 615.

He must map the milestones for himself. He is not entitled to take one word of the information previously published without independently working out the matter for himself.³⁰

However the view that “he must not take one word” is very much at odds with the weight of 19th century case law.

While *Kelly v Morris* was supported in *Morris v Ashbee* [1868] 7 Eq 34, both of these decisions were substantially pared down in *Morris v Wright* [1870]. Of the opinion in *Kelly v Morris* that “the Defendant could not take a single line of the Plaintiff’s directory for the purpose of saving himself labour and trouble in getting this information”, Giffard LJ says

I cannot doubt that (this passage) goes beyond what the law authorizes, and beyond the decision of the Lord Chancellor and myself in the late case of *Pike v Nicholas*.³¹

Sir Giffard LJ went on to say that the defendant is not precluded from using the plaintiff’s work as the reference point to start the defendant’s work. It is perfectly legitimate to use that as a guide and then compile another work with reference to the original work. However the relevant inquiry is not about the effort or input by the plaintiff in creating the first work and protecting that, but is directed to assessing the legitimacy of the use of the work by the defendant.

Unprotected works

There is also a line of authority that suggests some works do not qualify for protection at all for want of originality. For example, in *Leslie v Young & Sons* Lord Herschell suggests,

The mere publication in any particular order of the time-tables which are to be found in railway guides and the publications of the different railway companies could not be claimed as a subject-matter of copyright. Proceedings could not be taken against a person who merely published that information which it was open to all the world to publish and to obtain from the same source.³²

This view was endorsed *Cramp Ltd v Frank Smythson Ltd* [1944] with Viscount Simon suggesting that,

There would, indeed, as it seems to me, be considerable difficulty in successfully contending that ordinary tables which can be got from, or checked by, the postal guide or the Nautical Almanac are a subject of copyright as being an original literary work. One of the essential qualities of such tables is that they should be accurate, so that there is no question of variation in what is stated. The sun does in fact rise, and the moon set, at times which have been calculated...There is so far no room for taste or judgment. ...There was no feature of them which could be pointed out as novel or specially meritorious or ingenious from the point of view of the judgment or skill of the compiler.³³

With *Leslie v Young* [1894] the discussion went to an assessment of the independent labour of the plaintiff and the defendant, with an emphasis that in these kinds of compilation cases there would need to be a substantial

³⁰ *Kelly v Morris* [1866] L.R. Vol 1 697 at 701.

³¹ *Morris v Wright* [1870] L.R. Vol 5 279 at 285.

³² *Leslie v Young & Sons* [1894] A.C. 335 (H.L.) at 340.

³³ [1944] A.C. 329 at 336.

appropriation to justify proceedings. However in *Cramp & Sons v Smythson* [1944], referring to the principles of the 1911 Act, and endorsing the need to consider the “fact and degree” of originality, both Viscount Simon L.C. and Lord Macmillan suggest that commonplace and factual information would be exceedingly difficult to protect, notwithstanding how convenient or useful the information may be.³⁴

Arguably the Australian case *Victoria Park Racing v Recreation Grounds Co Ltd v Taylor* (1937) follows this line of authority. Protection was denied to the compilation of horse racing details written on a display board on the grounds. Dixon J argued,

some original result must be produced. This does not mean that new or inventive ideas must be contributed. The work need show no literary or other skill or judgment. But ... the material for the board consists in the actual allotment of places and other arrangements made by the plaintiff’s company’s officers in respect of the horses. To fit in on the notice board the names and figures which will display this information for a short time does not appear to me to make an original literary work.³⁵

Likewise Latham CJ, said,

The law of copyright does not operate to give any person an exclusive right to state or to describe particular facts. A person cannot by first announcing that a man fell off a bus or that a particular horse won a race prevent other people from stating those facts.³⁶

In *Victoria Park* the creation of the facts does not give rise to proprietary rights to that information. Similar cases that deny protection range from simple lists of competitors, to more complex ‘facts’ such as starting prices and betting odds.³⁷

Notwithstanding these decisions³⁸ awarding some level of protection to very pedestrian subject matter does not trouble the majority of nineteenth century cases. The more important and controversial question was what level of protection is deserved?

Abridgements

Abridgements were accepted as legitimate in the eighteenth century because they were ‘stand alone’ works of benefit to readers,

*The design of an abridgment is to benefit mankind by facilitating the attainment of knowledge...*³⁹

³⁴ In support they cite *Macmillan & Co. Ltd v K&J Cooper* (1923) L.R. 51 Ind. App. 109; 93 L.J. (P.C.) 113.

³⁵ (1937) 58 CLR 479 at 511.

³⁶ (1937) 58 CLR 479 at 498.

³⁷ See Staniforth Ricketson, *The Law of Intellectual Property*, (Sydney: Law Book Co, 1984) at [5.19], *infra* *Chilton v Progress Printing & Publishing Co* [1895] 2 Ch. 28 (C.A.); *Smith’s Newspapers Ltd v The Labour Daily* (1925) 25 S.R. (NSW) 593; *Greyhound Racing Association Ltd v Shallis* [1923-28] MacG. Cop. Cas. 370 (Ch. D); *Odham Press Ltd v London & Provincial Sporting News Agency (192) Ltd*, [1935] Ch. 672.

³⁸ There are additional nineteenth century UK examples available.

³⁹ Samuel Johnson as cited in David Vaver, “Abridgements and Abstracts: Copyright Implications”, [1995] 5 EIPR 225; Ricketson, (1984) at [5.57].

This position was refined in the nineteenth century, with Vaver noting that “the mantle of ‘benefactor to mankind, by assisting in the diffusion of knowledge’ (having) largely slipped off the abridger’s shoulders.”⁴⁰ With non-infringing abridgements being confined to published literary and dramatic works, the question resolved to whether the abridgement was a merely colourable piracy or ‘fair’.

Fair use

The majority of nineteenth century cases were not ungenerous in awarding protection to original works, but the bulk of the inquiry turns on what is “fair use” and a “legitimate taking”.

Formulations of this test include:

In relation to road maps:

That part of the work of one auther (sic) is found in another, is not of itself piracy, or sufficient to support an action; a man may fairly adopt part of the work of another : he may so make use of another’s labours for the promotion of science, and the benefit of the public: but having done so, the question will be, Was the matter taken used fairly with that view (to the promotion of science and benefit of the public) and without what I may term the animus furandi?⁴¹

With respect to descriptions of antiquity:

The question upon the whole is, whether this is a legitimate use of the Plaintiff’s publication in the fair exercise of a mental operation, deserving the character of an original work.⁴²

In a case involving appropriation of coal statistics:

The general principles guiding the Court in cases of this description could hardly be found better stated than in the works of Mr Justice Story in *Folsom v Marsh*, cited in Mr *Palmer Phillips’* Treatise on Copyright:- “In short, we must, in deciding questions of this sort, look to the nature and objects of the selections made, and the degree to which the use may prejudice the sale, or diminish the profits, or supercede the objects, of the original work.”⁴³

The earliest expression of “fair use” is probably in *Sayres v Moore* 102 Eng Rep 139n [KB 1785]. Apart from the other above mentioned cases, other formulations stressing the significance attached to producing a new work include *Carnan v Bowles* 29 Eng Rep 45 [Ch 1786]; *Mawman v Tegg* [1826] 2 Russ 385; *Martin v Wright* 58 Eng Rep 605 (Ch 1833); *D’Alamaine v Boosey* 160 Eng Rep 117 [Ex 1835]; *Spiers v Brown* [1858] 6 W.R. 352; *Leslie v Young & Sons* [1894] A.C. 335 H.L.; *Hanfstaengl v Baines* [1895] A.C. 20; *McCrum v Eisner* [1918] 87 LJ Ch 99.

⁴⁰ Vaver, citing *Tinsley v Lace* [1864] 1 H. & M. 747, 754 at 226.

⁴¹ *Cary v Kearsley* 170 Eng. Rep. 679 [KB 1802].

⁴² *Wilkins v Aiken* [1810] 17 Ves. Jun. 424 at 426. Cited as authority in *Bramwell v Halcomb* [1836] 3 My & Cr 736.

⁴³ *Scott v Stanford* [1867] L.R. Vol 3 718 at 722. Citations omitted.

Recently some authors have suggested that the fair use defence was created by the courts and then confined throughout the latter course of the nineteenth century.⁴⁴ However given the bounty of references to its role throughout the entire century, there is little evidence in support of there having been a significant policy shift away from fair use. Copinger for example, says of the “Principles by which piracy is judged”,

The inquiry in most cases, is not, whether the defendant has used the thoughts, conceptions, information and discoveries promulgated by the original, but whether his composition may be considered a *new work*, requiring invention, learning and judgment, or only a mere transcript of the whole or parts of the original, with mere colourable variations.⁴⁵

His second edition restates this original formulation also adding,

The main point must always be what effects will the extracts have on the original work-how far will they supply its place or injure its sale.⁴⁶

Scrutton finds the principle regulating infringement to be this:

Whenever a substantial part of an author’s copyright work is reproduced without his authority, whether alone or in conjunction with new matter, whether by the same or a different channel to the original, so as to damage the sale of such original work, and thus lessen the original author’s return for his work, such reproduction is an infringement of copyright.⁴⁷

There does not appear to be any critical reference to “fair use” in these treatises at all. There is however confirmation that the relevant inquiry is into a comparison of the market for the two works.

With fair use there was more involved than simply equating “originality” with the plaintiff’s effort and protecting that contribution. A finding of ‘piracy’ was reserved for the cases where there was no public interest being served by the defendant’s taking. The pirate was one whose copying fails to bring forth a “new work”. As the servile copy would generally be sold for cheaper than the plaintiff’s work, with a significant part of the associated labour costs having been paid for by the plaintiff, it imperilled access to new works, by providing a disincentive for further investment in such productions. For servile copies, there was little benefit to the public to be gained from re-publication by another source. But where the defendant had produced more than a servile copy, the assessment was far more complicated. This is why so many of the nineteenth century cases discuss the effect of the alleged piracy on the market for the original work. If the works were in competition, it was highly likely that the copying would be deemed unfair. But if there was another purpose in play, the defendant’s taking may have been excused.⁴⁸

⁴⁴ See Robert Burrell and Alison Coleman, *Copyright Exceptions: The Digital Impact* (Cambridge: Cambridge University Press, 2005) pp253-5.

⁴⁵ Copinger, 1870, p87. (his italics).

⁴⁶ Walter Arthur Copinger, *The law of copyright in works of literature and art*. (2nd ed. London: Stevens & Haynes, 1881) p173.

⁴⁷ Scrutton, 1883 §52, pp52-3.

⁴⁸ See eg. *Roworth v Wilkes* [1807] 1 CAMP. 94 (notion of ‘substitute work’); *Mawman v Tegg* [1826] 2 Russ 358 (distinction between a new work and robbing the former author); *D’Almaine and Another v Boosey* [1835] 1 Y.& C. Ex 297 (adaptation of music); *Bell v Whitehead* [1839] Ch. 8 L.J. (N.S.) Ch 141 (taking justified as criticism); *Scott v Stanford* [1867] L.R. Vol 3. 718

In the nineteenth century the copyright balance between protection and access was not seen as simply a case of arbitrating between competing private rights. It was not simply a matter of determining if a substantial part had been taken. When sensitivity to private property claims might be expected to be uppermost in judicial minds, it was not axiomatic that protection of original effort or investment would be the paramount concern. Deciding what was to be protected, and what use of another's work was permitted, involved broad considerations into the social purpose served by copyright. These policy factors influenced how the line between protection and legitimate use was drawn.

The importance of reference to the public interest in assessing the nature of the right and wrong can be seen from *Walter v Lane* [1900]. This case is particularly important because, as a consequence of its unusual facts, the central issue in the case was, *Is intellectual effort a prerequisite for copyright protection of a work?*

The case involved whether copyright could subsist in a speech given by Lord Rosebery, where the speaker had not sought to protect his oratory. A journalist from *The Times* newspaper had transcribed Lord Rosebery's speech. *The Times* claimed to own copyright in the speech by virtue of a copyright arising from the act of transcribing it. They sought to restrain another publisher from copying 'their' text. Unlike the usual circumstance of competition between an originator of an expression and an alleged copier, here the issue is that of bare subsistence of copyright. If the transcription of another's speech gives rise to a copyright, the defendant has no legal excuse for copying it verbatim.

Walter v Lane [1900] has been recently interpreted as supporting the proposition "the view of the majority of the Lords shows that intellectual effort was not regarded as a requirement for copyright".⁴⁹ However drawing this conclusion from the case is problematic.

Lord Halsbury reasoned that the particular words of the *Copyright Act* 1842 (5 & 6 Vict. c. 45) awarded protection to the producer of a written composition. The statute was not interested in "the proprietary right of every man to his own literary compositions". If copyright was not about "authors" and their natural entitlements, it did not matter that the reporters simply recorded another's speech.⁵⁰ Lord Halsbury and Lord Davey then agreed that, by way of analogy to other copyright cases, if a person who compiled a street directory could be an author, so could a reporter. To find otherwise would sanction 'reaping without sowing'.

Lord James of Hereford thought something more than "mere mechanical transcribing" was necessary for protection, but through the art of shorthand an

(prejudice to sales); *Spiers v Brown* [1857] CH. 6 W. R 352 (unacknowledged taking but different result achieved and alterations not colourably made).

⁴⁹ *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* [2001] FCA 612 at para 55.

⁵⁰ *Walter v Lane* [1900] A.C. 539 (H.L.) at 547-8. Hereafter *Walter*.

intellectual component had been present in the reporter's copy of the speech. The reporter was more than a mere scribe and so his work protected. Lord Brampton also agreed that the reporter's skill went beyond the mere mechanical operation of writing. Lord Robertson however, thought there had been little more than accurate transcribing in this case and that this was insufficient to protect the reporter's work.

In terms of addressing the principle of whether an intellectual input was necessary in copyright or not, three of the five judges (2 majority, 1 minority view) actually thought intellectual effort was required in copyright. This was noted by Isaac J in *Sands & McDougall Pty Ltd v Robinson* [1917].⁵¹ In discussing the significance of *Walter*, his Honour rejects the defendant's contention that "inventive skill" in terms of requiring novel and distinctive features was now required as a consequence of acceding to the Berne Convention.

Walter also addressed the various policy objectives of copyright law. Halsbury LC noted that in addition to the "grievous injustice" that would follow if the defendant were permitted to appropriate "what has been produced by the skill, labour and capital of another"⁵² that,

An importer of a foreign inventor is for the purpose of patent laws an inventor, and, as Lord Broughton said in *re Berry's patent*, there were 'two species of public benefactors – the one, those who benefit the public by their ingenuity, industry, and science and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the appropriation of the results of foreign inventions. Now the latter is a benefit to the public incontestably'... I might paraphrase Lord Broughton's language by asking whether those who preserve the memory of spoken words, which are assumed to be of value to the public, are not entitled to a merit analogous to that which Lord Broughton attributes to the importer of foreign inventions?⁵³

Lord Brampton also felt a copyright was justified so that the wisdom of Lord Rosebery, who had chosen not to publish his own speech, would be made available to the public.

Here the text deserves protection, as of natural right flowing from *The Times'* expenditure of labour, but also because such protection supports the public interest, as determined by the conventions of that time.⁵⁴ "Appropriations" are legally sanctioned or not, depending upon the status of the source of the work and the public benefits that flow from the appropriation. In this case, *The Times* is to be rewarded for recording for posterity "speeches being of great interest to the public".⁵⁵

⁵¹ [1917] 23 CLR 49 at 54.

⁵² *Walter*, at 545.

⁵³ *Walter*, at 549.

⁵⁴ For a lengthier discussion see Kathy Bowrey, Chapter 6, "The judicial construction of author as owner", *Don't fence me in: the many histories of copyright*, (SJD thesis, University of Sydney, 1994).

⁵⁵ Lord James of Hereford, *Walter*, at 553.

Thus the decision to protect the author's private right or not remained largely a matter of public policy. Protection was justified in the name of the national economic and social good served. It is this sense of 'balance', measured with respect to an assessment of how the public interest is best served, that has largely been lost in the retelling of the nineteenth century law today.

Why the confusion over case law principles?

Most of the nineteenth century case law revolves around claims for injunctive relief.⁵⁶ Decisions do not usually clearly separate out statements of law and findings of fact. Whilst the question of infringement frequently entailed a balanced consideration of the original efforts of both parties in a marketplace for informational works, the facts were often incomplete. In many of the cases it was felt that the available evidence did not permit award of an injunction or sustain maintaining the original injunction because there had been no clear identification of the exact extent and context of the taking. As more was often needed to succeed than simply averting to the presence of some taking of the plaintiff's work in the work of the defendant's, and because it was commonly argued that there should be no enjoining of publication of the parts that were the defendant's original work, the matter was very often sent for arbitration or to common law juries.⁵⁷ From that point on legal records do not reveal how matters were ultimately resolved.

These factors make appreciating the subtlety of the nineteenth century court difficult. However the problems are compounded when these cases are approached with twentieth century jurisprudential constructions in mind. It is no wonder that the older cases appear confusing or uncertain about the role of originality once originality comes to be constructed as *primarily* a "subsistence" issue and infringement is dissociated from consideration of the defendant's originality.

The unanticipated change effected through legislative drafting

One of the biggest changes to the role of originality comes about as a consequence of the rewriting of the *Copyright Act 1911* (UK.) As noted above, this codification was not heralded as bringing any substantial change to the law. However in the new legislation, originality came to be considered as a requirement in its own right: Copyright subsists in every *original* literary work. This formulation explicitly directs the question of originality to the plaintiff's efforts alone.

The 1911 Act's shift from fair use to enumerated fair dealing rights compounds the problem. Whilst Burrell notes that the evidence of what the 1911 fair dealing provisions were supposed to achieve is limited, "the evidence that is available suggests that Parliament did not intend the introduction of the fair

⁵⁶ For an interesting discussion of the historical role of injunctions in literary property see, Tomas Gomez-Arostegui, "What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-At-Law Requirement" *Southern California Law Review*, September 2008.

⁵⁷ See for example, *Mawman v Tegg* [1826] 2 Russ 358; *Jarrold v Houston* [1857] Ch. 3 Kay & J. 707.

dealing provision to mark the start of a more restrictive or less flexible approach to the copyright exceptions.”⁵⁸ It was supposed to be a codification of existing law, and not a strategic reorganization of basic precepts that shifted the copyright balance. But the outcome of these legislative reforms was that, as a matter of statutory interpretation, the originality requirement slowly came to be read as a question of subsistence of right and as a reference to the plaintiff’s work alone, and then there is a separate consideration as to whether the defendant had any available ‘defences’.

We now understand originality as primarily a requirement of the plaintiff and no longer see it as involving the relational issues of the past. Further our test has come to be much more narrowly defined:

The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work - that it should originate from the author.⁵⁹

In keeping with the move toward a more positivistic and objective approach to law, the attempt was to define originality without reference to the original work’s value in scientific or aesthetic terms. The answer which suggested itself to the judge was to focus on the ‘material fact’ of the creation of an expression by the plaintiff, drawing on the significance of the act of making the writing, and not tying that to a requirement for any special manner of writing. That in this case the exam papers drew on the common stock of knowledge and were commonplace did not mean they were not protected. The plaintiffs had not copied them from anywhere, but had written them themselves. Thus they were entitled to protection of an original literary work. Originality is now largely dispensed with as a question of subsistence of copyright, judged without reference to the significance or intrinsic value of the plaintiff’s expression to the world at large. This approach means that ‘originality’ ends up being a reference mainly to what it is not. It does not require inventiveness, novelty, creativity and so on.

The historic significance of originality as a relational concept and as involving questions of public policy begins to be lost from this point. Consideration of the defendant’s work now only appears in the context of defences to infringement- in relation to whether or not an alleged taking of the plaintiff’s work is “substantial”, given the changes that the defendant may have made to that work. It also comes to be accepted that the originality of the defendant in creating a new work is no obstacle to a finding of infringement.⁶⁰

The statutory construction of the plaintiff’s rights and copyright ‘exceptions’ in the 1911 Act has placed the defendant at a much greater disadvantage than in the nineteenth century. However there is nothing to suggest that this was considered to be a likely or desired outcome of the codification.

⁵⁸ “All that is done here is to make a plain declaration of what the law is and to put all copyright works under the same wording”. Hansard, HL 1911, Vol. X, Col. 117 Burrell 2005, p257.

⁵⁹ *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601.

⁶⁰ *A-One Accessory Imports Pty Ltd v Off Road Imports Ltd* (1996) 34 IPR 306.

An additional level of disadvantage to the defendant was then imposed by the Copyright Act 1956 (UK) and followed by the Copyright Act 1968 (Cth). It was negatively commented on by the Spicer Committee 1959⁶¹ that, compared with the Copyright Act 1911 (UK), (in force in Australia by virtue of the Copyright Act 1912 (Cth)), the drafting of the 1956 Act had created an unprecedented focus on the enumerated “exclusive rights” of the owner. This drafting change “directs the mind to the infringer—to the things which must not be done without the owners’ consent—rather than to the owner and what is comprised in his ownership”.⁶²

Subsequently in calculating the merits of awarding protection, the formulation of originality from *University of London Press Ltd v University Tutorial Press Ltd* [1916] has come to take on a quite different policy implication. The phrase “that the work must not be copied from another work - that it should originate from the author” has now come to be read not only in terms of assessing the subsistence of copyright in the plaintiff’s work. It has come to influence consideration of the status of the defendant’s work. This leads to the endorsement of the *University of London* test in *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] that,

As regards infringement... I think there is much wisdom in the reference by Peterson J to the ‘rough practical test that what is worth copyright is prima facie worth protecting’.⁶³

This development sounds the arrival of, historically speaking, a very significant change in copyright policy. What started out in *University of London Press* as a definition of originality that primarily addressed the status of the plaintiff’s original work, has ended up literally framing the defendant’s effort. This shift signifies a revival of the previously discredited position of *Kelly v Morris* [1886]. It is worth noting that the High Court recently strongly criticised this development.⁶⁴

Notwithstanding that, originality is now mainly considered in terms of assessing the plaintiff’s work, and in terms of a far more limited inquiry than would have occurred in the nineteenth century. This was not a consequence of a deliberate policy shift behind the legislation concerning the comparative weight to be accorded to the defendant’s efforts. It was not the case that the originality of the plaintiff was to be considered as a more important issue than the defendant’s originality. It comes from the logic produced by the structure of the twentieth century statutes, combined with judicial anxiety in assessing the respective ‘worth’ of the plaintiff’s and the defendant’s product. The reason we need to better appreciate the legal history of the nineteenth century is to remain

⁶¹ Copyright Law Review Committee, Report to Consider what Alterations are Desirable in Copyright Law of the Commonwealth. (Commonwealth of Australia, 1959).

⁶² *Spicer Committee*, Para 24.

⁶³ *University of London Press Ltd v University Tutorial Press Ltd* [1916] quoted with approval in *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 at 279 (Lord Reid), 288 (Lord Hodson), 293–294 (Lord Pearce).

⁶⁴ *Network Ten Pty Ltd v Channel Nine Pty Ltd* [2004] HCA 14; 27 TCL 16/3; 218 CLR 273; 205 ALR 1; 78 ALJR 585 at Para 14-17.

alert to the implications of what probably seemed like relatively innocuous changes to the wording of legislation engineered by copyright functionalities, with no political authority to transform the fundamental character of the law.

Some Implications

When originality and infringement used to be appear together as a matter of the legal inquiry, policy considerations in drawing the balance either way were transparent. The originality of one party was generally considered in light of the originality of the other. The worth of both efforts were considered in relation to each other, and reference to the community interest often explicitly informed that evaluation. With the new reordering and apparent separation into originality then infringement in the twentieth century, there is a policy shift in support of the plaintiff's often meagre claims to originality, at the expense of an equal consideration of the defendant's claim.

Of even greater consequence than this unaccountable weighting in favour of one of two competing private rights, is the loss of a space for a proper judicial consideration of the public interest in drawing the balance between protection and access. A fair consideration of the pre-eminent policy issue in copyright, the public interest in creating the rights, is pre-empted by the presumption of the public good in protecting the plaintiff's effort under the auspices of "originality". In this context it is difficult to address broader justifications for accessing and reproducing part of a plaintiff's work in terms beyond the specifics of the actions of the defendant and the narrow confines of our fair dealing provisions.

This major shift in the politics of the law remains obscured by the continuing emphasis on the requirement that originality be tested as a matter of "fact and degree". By using this empirical explanation for decisions, past cases can continue to be explained and differentiated with reference to their specific facts, rather than having to confront their different politics. Further the suggestion remains that some works may still be rejected because of the minimal effort involved, when this is most unlikely to be the case.

It is possible to dress up the most unlikely contributions as meaningful in copyright terms, because of the failure to set a benchmark against which the plaintiff's contributions can be assessed. For example in *Kalamazoo*, Thomas J says of accounting forms, which until recently had never been considered in the industry as worthy of protection:

... whilst I refuse to find that the authors showed great skill, I do find that their preparation required a degree of concentration, care, analysis, comparison, and a certain facility in using and adapting the altered forms to a composite one-write system. In each use, some awareness of contemporary developments and the marketability of such forms played a part in their creation. Looking at each system as expressed, there is sufficient originality of expression, shape and content to comprise an original literary work.⁶⁵

⁶⁵ *Kalamazoo(Australia) Pty Ltd v. Compact Business Systems Pty Ltd* (1985) 5 IPR 213 at 237.

If identifying a market, initiating product development and overseeing a very pedestrian execution of the stages essential for manufacturing the particular product can form a significant part of the “originality” of the compilation work and hence justify its protection, it is hard to think how any commodity could fail the test, outside of apparent negligence in design. If the test really were one of “fact and degree” the benchmark would refer to the ordinary practice in that industry. But even in *Kalamazoo*, Thomas J sought to bolster the merits of protection by claiming that these blank accounting forms,

in the end, . . . have their own character, their own form of expression, and in a sense tell their own story to the user.⁶⁶

Uncertain that something so pedestrian really deserved protection, he resorted to a rather incredulous assertion that blank forms inherently conveyed meaningful expression.

Conclusion

It has become common for judges and copyright scholars alike to delve into the past and claim nineteenth century precedent in support of contemporary readings of originality criterion.⁶⁷ References to the 19th century law are used by academics to justify 21st century rejections of fair use doctrine,⁶⁸ and to ground claims about the erosion of the public domain.⁶⁹ This reflection on the nineteenth century case law suggests that unless significant care is taken, use of nineteenth century precedent will only lead to obfuscation, hiding a significant legal transformation that has taken place in copyright across the twentieth century.

The ‘humble grey’ of the nineteenth century was much more wise and reflective about the issues at stake in copyright that we now are. They were much more willing to confront the relativity of interests, the balance to be struck and most importantly, to consider the community interest to be served by protection and in gaining access to new works and products. Losing this discourse was, it would seem, something no-one deliberately sought to bring about in the twentieth century. Thus what remains to be considered now, is our ability and responsibility to redress this unwelcome political development today.

⁶⁶ *Kalamazoo* at 238. See also Kathy Bowrey, “The Outer Limits of Copyright Law” *Law and Critique*, (2001) Vol 12:1, pp1-24.

⁶⁷ *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* [2002] FCAFC 112; *Nine Network Australia Limited v IceTV Pty Limited* [2007] FCA 1172; [2008] FCAFC 71.

⁶⁸ Robert Burrell & Allison Coleman, *Copyright Exceptions. The Digital Impact*, (Cambridge UP, 2005) p253ff.

⁶⁹ Deazley, (2005).