Intellectual Property Law Cram Notes

2011 1st Edition

UniCramNotes.com
# Table of Contents

## 1. Introduction ......................................................................................... 5
   A. How to use Cram Notes ........................................................................ 5
   B. Abbreviations ..................................................................................... 5

## 2. Is there a Breach of Copyright? .......................................................... 5
   A. Does copyright exist (subsistence of copyright) .................................. 5
      i. Is it "works"? .................................................................................... 5
         1) Literary ......................................................................................... 5
         2) Artistic .......................................................................................... 6
         3) Musical .......................................................................................... 7
         4) Dramatic ........................................................................................ 7
      ii. Is it recorded in a material form? ..................................................... 7
      iii. Is it original? .................................................................................. 7
      iv. Is it "subject matter other than works"? .......................................... 9
   B. Is the author eligible to hold copyright? ............................................ 10
      i. Duration .......................................................................................... 10
      ii. Qualification & connecting factors .................................................. 10
   C. Exploitation of Copyright .................................................................... 10
      i. Ownership ...................................................................................... 11
         1) Who is the owner of any copyright subsisting in the work? .......... 11
         2) In what circumstances will someone other than the author have copyright ownership? .................................................. 11
   D. Infringement of Copyright .................................................................. 11
      i. Direct Infringement ......................................................................... 11
         1) What is not a substantial part? ..................................................... 12
         2) Has a substantial part of the work been reproduced? .................. 12
         3) Is there a causal connection between the original and the reproduction? .................................................. 12
      ii. Indirect infringement ..................................................................... 13
      iii. Authorisation of infringement ...................................................... 13
   E. Defences to infringement ..................................................................... 14
      i. Has there been a fair dealing with the work? .................................... 14
         1) Definition ...................................................................................... 14
         2) Research and study ..................................................................... 14
         3) Criticism or review ...................................................................... 14
         4) Reporting news ........................................................................... 15
      ii. Has sufficient acknowledgement been made? ............................... 15
   F. Were the author’s moral rights breached? .......................................... 15
      i. Right of attribution ......................................................................... 15
      ii. False attribution ........................................................................... 16
      iii. Integrity of authorship ................................................................. 16

## 3. Is there a Breach of a Trademark? ....................................................... 16
   A. Has the trademark been properly registered? ..................................... 17
      i. Registration formalities (examination of trademark) ....................... 17
         1) Is it a sign? ................................................................................... 17
         2) Ownership ................................................................................... 17
         3) Is there use or an intent to use? .................................................... 17
         4) Is there a graphical representation? ............................................. 17
         5) Nomination of classes .................................................................. 17
B. Are there grounds for refusal of registration? ................................................................. 19
   i. Not capable of distinguishing.................................................................................. 19
   ii. Conflicts with existing trademark ......................................................................... 20
       1) Substantially identical.................................................................................. 20
       2) Deceptive similarity.................................................................................... 20
   iii. Scandalous or contrary to law .......................................................................... 21
   iv. Deceptive or confusing.................................................................................... 22
C. Are there grounds for opposition of registration? ....................................................... 22
D. Are there grounds for revocation of the trademark? .................................................. 22
E. Has the trademark been infringed? ............................................................................ 22
   i. Substantially identical/deceptively similar....................................................... 23
F. Defences.................................................................................................................. 23

4. **IS THE PATENT REGISTRABLE?** ............................................................................. 23
A. Is the invention patentable? .................................................................................... 23
   i. Examination of application .............................................................................. 23
   ii. Patentable subject matter ............................................................................. 25
   iii. Novelty........................................................................................................... 25
       1) Prior art base............................................................................................ 26
       2) Anticipation............................................................................................... 26
       3) Exceptions................................................................................................. 27
   iv. Inventive step................................................................................................ 27
       1) How is Inventive Step Assessed? ............................................................ 27
       2) Who is the ‘person skilled in the relevant art’? .......................................... 27
       3) Common general knowledge .................................................................... 28
   v. Innovative step.................................................................................................. 28
       1) What Constitutes an Innovative Step?....................................................... 28
       2) How is Innovative Step Assessed? ............................................................ 28
B. Is the patent open to revocation of its registration? ..................................................... 29
   i. Utility.............................................................................................................. 29
   ii. Secret use....................................................................................................... 30

5. **IS THERE A CASE FOR PASSING OFF?** ............................................................... 30
A. Elements of passing off .......................................................................................... 30
B. Is there a misrepresentation? ................................................................................... 31
   i. Goodwill......................................................................................................... 31
   ii. Indicia of reputation ....................................................................................... 31
C. Was the misrepresentation made in the course of trade? ...................................... 31
   i. Intention .......................................................................................................... 32
   ii. Made to consumers ......................................................................................... 32
D. Was there damage? ................................................................................................ 32
   i. Profits ............................................................................................................. 32
   ii. Damage to reputation ..................................................................................... 33
E. Consider breach of s 52 of the *Trade Practices Act* ............................................. 33

6. **IS THERE BREACH OF SECTION 52 OF THE TRADE PRACTICES ACT?** .... 33
A. Similarity to passing off ........................................................................................ 33
B. Was there breach by a corporation engaged in trade or commerce? ................. 33
C. Is it misleading and deceptive? .......................................................... 34

7. **Is there a breach of a design?** .......................................................... 34
   A. Have the formalities been met? .......................................................... 34
   B. Examination of design ................................................................. 34
      i. Is it a design? ........................................................................... 34
      ii. Is the design new? ............................................................... 35
      iii. Is the design distinctive? .................................................. 35
         1) Substantial similarity ....................................................... 35
   C. Ownership .................................................................................. 35
   D. Has the design been infringed? ................................................... 35
   E. Defences .................................................................................... 35

8. **Is there a breach of confidence?** ................................................... 35
   A. Was it information? ..................................................................... 35
   B. Did the necessary level of confidence exist? .............................. 36
   C. Was there an obligation of confidence? .................................... 36
      i. Circumstances ....................................................................... 36
      ii. Nature of relationship ........................................................ 36
      iii. Employees .......................................................................... 36
      iv. Third parties ......................................................................... 37
   D. Was the information used without authorisation? ................. 37
   E. Will the use of the information cause detriment? .................... 37
1. **INTRODUCTION**

A. **HOW TO USE Cram NOTES**

The Intellectual Property Law Cram Notes are formatted into a step-by-step guide, which you can use as a checklist in your exams to ensure that every element of the exam question is answered. You may find the Table of Contents to be a quick and useful overview of the law to be applied.

You should also answer the exam question using the ILAC method, which will ensure your answer is comprehensive.

<table>
<thead>
<tr>
<th>Issue</th>
<th>Law</th>
<th>Analysis</th>
<th>Conclusion</th>
</tr>
</thead>
<tbody>
<tr>
<td>State the legal issue relevant to the problem</td>
<td>Identify the relevant case law and legislation</td>
<td>Analyse and apply the law to the legal issue. This is the most important part, so ensure your legal analysis is very thorough.</td>
<td>Form a conclusion based on your analysis and application of the law, giving some practical advice to the hypothetical client.</td>
</tr>
</tbody>
</table>

It is very important to spend time perfecting your analysis section, as this is the part that examiners are most interested in. Do not worry if you reach the correct conclusion (there often isn’t one clear answer) – examiners will give more weight to your legal analysis, and sometimes may even reward answers that propose an innovative and unconventional answer!

B. **ABBREVIATIONS**

The Intellectual Property Law Cram Notes will refer frequently to the High Court of Australia as the HCA and the Federal Court of Australia as the FCA.

2. **IS THERE A BREACH OF COPYRIGHT?**

A. **DOES COPYRIGHT EXIST (SUBSISTENCE OF COPYRIGHT)**

1. **IS IT “WORKS”?**

There are four main types of ‘works’ (literary, artistic, musical, dramatic). These are often referred to as ‘primary’ works.

1) **Literary**

Literary works are works expressed in print or writing including a table, compilation, computer program, preparatory design material for a computer program, or database *(Copyright Act 1968, s 10(1))*

- expressed in print or writing, irrespective of the question whether the quality or style is high *(University of London Press Ltd v University Tutorial Press Ltd [1916]*)
- intended to afford either information and instruction, or pleasure, in the form of literary enjoyment *(Hollinrake v Truswell [1894]*)
- that are the result of an exercise of knowledge, judgment, labour or skill. *(Express Newspapers v Liverpool Daily Post [1985] ; Ladbroke (Football) Ltd v William Hill (Football) Ltd [1964]*)
Papers set by examiners are "literary work" within the meaning of the present Act
(University of London Press Ltd v University Tutorial Press Ltd [1916])

What are not literary works?
- Single words, names and titles are not likely to be literary works. (Francis Day & Hunter v Twentieth Century Fox [1940])
- A single made up word ('EXXON') is unlikely to be a literary work (Exxon Corporation v Exxon Insurance Consultants International Ltd [1982])
- A compilation of pre-existing material will not be a literary work unless the author has exercised skill and judgment to make the compilation more than a mere copy of other material. (Kalamazoo (Australia) Pty Ltd v Compact Business Systems Pty Ltd [1985])
  - A phone directory is not a literary work as substantial parts of the directory does not have human authors and much of their contribution was not "independent intellectual effort" or "substantial effort of a literary nature".
- Although computer program in source code is a literary work, the object code which were not intended to be capable by themselves of conveying a meaning that could be understood by humans was not a literary work. (Computer Edge Pty Ltd v Apple Computer Inc [1986]; Data Access Corporation v Powerflex Services Pty Ltd [1999])

2) Artistic

Artistic works include a graphic work, painting, drawing, engraving, photograph, sculpture, collage irrespective of artistic quality; or a work of architecture; or a work of artistic craftsmanship, which requires artistic quality (Copyright Act 1968, s 10(1)).
- Drawing includes a diagram, map, chart or plan. (Copyright Act 1968, s 10(1))
- Sculpture includes a cast or model made for purposes of sculpture. (Copyright Act 1968, s 10(1))
- Engraving includes an etching, lithograph, product of photogravure, woodcut, print or similar work, not being a photograph. (Copyright Act 1968, s 10(1))
- The Act does not define a work of artistic craftsmanship.
  - A work will qualify as one of artistic craftsmanship only if it has an element of real aesthetic quality, whether or not it is a utilitarian article. The level of aesthetic appeal required for a work of artistic craftsmanship is higher than mere visual appeal. Because the test is an objective, evidence that the creator intended to make an article possessing aesthetic quality is important but not essential nor conclusive. Artistic craftsmanship only applies to the first creation of the design/article, not every industrially produced application of it afterwards. (Coogi Australia Pty Ltd v Hysport International Pty Ltd [1998])
  - Determining whether a work is a work of artistic craftsmanship turns on assessing the extent to which the particular work's artistic expression, in its form, was unconstrained by functional considerations. (Burge v Swarbrick [2007])

What are not artistic works?
- Face painting does not constitute a 'painting' within the meaning of the Act. (Merchandising Corporation of America v Harpbond Ltd [1983])
- Although moulds and dies based on a model frisbee were found to be engravings by a New Zealand case (Lincoln Industries Ltd v Wham-O Manufacturing Co [1984]) an Australian case found that such an approach to defining 'sculpture' and 'engravings' strained the English language. (Greenfield Products v Rover Scott Bonnar [1990]).
3) Musical
A musical work consists of music intended to be performed, sung or spoken with the music. The musical work must be considered as a whole and not as isolated notes and features. (Coffey v Warner/Chappell Music [2005])

4) Dramatic
Dramatic work includes a choreographic show or other dumb show and a scenario or script for a cinematograph film but does not include a cinematograph film as distinct from the scenario or script for a cinematograph film. (Copyright Act 1968, s 10(1))
- A dramatic work must have sufficient unity to be capable of performance. (Green v Broadcasting Corporation of NZ [1988])

What is not a dramatic work?
- A planned fireworks display and lantern procession does not have a sufficiently strict schedule to constitute a dramatic work. (Nine Network Australia Pty Ltd v ABC [1999])
- Performers’ rights are different to copyright in a dramatic work. Performers’ rights gives performers limited civil rights to sue for infringement and is governed by Part XIA of the Copyright Act 1968. In summary, a performer’s consent is required for the recording or broadcast of a live performance with exceptions such as for purposes of news reporting; criticism/review; educational-private-domestic use; and scientific purposes.

ii. Is it recorded in a material form?
Copyright cannot subsist in an idea or in ideas. Copyright can only subsist in an expression, that is, a ‘material form’. It is not until an idea is reduced into writing or into some tangible form and expression such as a picture, that there is any copyright. Copyright belongs to the person who has clothed the idea in form, whether by means of a picture, a play, or a book, and the owner of the idea has no rights in that product. (Donoghue v Allied Newspapers, Limited [1936])

Therefore, consider whether there has been publication under s 29 of the Copyright Act:
(1)(a) a literary, dramatic, musical or artistic work, or an edition of such a work, shall be deemed to have been published if, but only if, reproductions of the work or edition have been supplied (whether by sale or otherwise) to the public.

iii. Is it original?
A work is original if:
- the author has exercised real skill, labour and judgment and the work is not a mere copy of another. (A-One Accessory Imports Pty Ltd and Others v Off Road Imports Pty Ltd [1996])
  o a work derived from an earlier copyrighted work can still be an original work if it involves qualitatively significant changes to the copied material. (A-One Accessory Imports Pty Ltd and Others v Off Road Imports Pty Ltd [1996])

We hope you have enjoyed this short preview of the Intellectual Property Law Cram Notes.

Don’t forget to check out the Law Study Tips we have on our website at www.UniCramNotes.com!