

H. C. OF A. 1916. provision in sec. 21AA that no appeal shall lie from the decision of the single Justice is an exception within the meaning of sec. 73 of the Constitution. On that question I reserve my judgment.

FEDERATED  
ENGINE  
DRIVERS'  
AND  
FIREMEN'S  
ASSOCIATION  
OF AUSTRAL-  
ASIA

*Declaration that sec. 21AA is valid. Order that  
the case be remitted.*

v.  
COLONIAL  
SUGAR  
REFINING  
CO. LTD.

Solicitor for the claimants, *H. Hoare.*

Solicitors for the respondents, *Blake & Riggall; Derham, Robert-  
son & Derham; Fink, Best & Hall.*

Solicitor for the Commonwealth, *Gordon H. Castle*, Crown Solicitor  
for the Commonwealth.

B. L.

*Aff  
Sands &  
McDougall Pty  
Ltd v  
Robinson  
(1917) 23  
CLR 49*

*Appl  
Desktop  
Marketing v  
Telstra Corp  
(2002) 55 IPR*

[HIGH COURT OF AUSTRALIA.]

ROBINSON . . . . . PLAINTIFF;

AND

SANDS & McDOUGALL PROPRIETARY }  
LIMITED . . . . . DEFENDANTS.

H. C. OF A. 1916. *Copyright—Infringement—Original literary work—Map—Exemption from liability  
to pay damages—Knowledge of existence of copyright—Name of author on map  
—Copyright Act 1912 (No. 20 of 1912), Schedule—Copyright Act 1911 (1 & 2  
Geo. V. c. 46), secs. 1, 2, 5, 6, 7, 8, 31, 35.*

SYDNEY,  
Aug. 29, 30,  
31; Sept. 1.

MELBOURNE,

Sept. 14.

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The word "original" in sec. 1 (1) of the *Copyright Act 1911* means "not  
copied," "not imitated."

*Held*, therefore, that a map which is produced by a cartographer applying  
his faculties to the best sources of information within his reach, and which  
is in no sense a copy but presents points of difference from previous maps  
according to the use to which he purposes to apply it, is an original literary  
work within the meaning of sec. 1 (1), and entitled to copyright.



If a name purporting to be that of the plaintiff as author appears upon a published map the defendant in an action for infringement, although not otherwise aware that copyright subsists in the map, is not relieved from liability in damages and accounts by sec. 8 of the Act.

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#### HEARING of action.

The plaintiff, Herbert Edward Cooper Robinson, a resident of Sydney in New South Wales, brought an action in the High Court against Sands & McDougall Proprietary Ltd., a company registered in Victoria and carrying on business at Melbourne in that State, for infringement of his copyright in a map.

The action was heard before *Barton J.*, and the material facts and arguments appear in his judgment hereunder.

*Flannery*, for the plaintiff.

*Schutt* and *Bavin*, for the defendants.

*Cur. adv. vult.*

BARTON J. read the following judgment:—This is an action in which the plaintiff sued the defendants for infringement of his copyright in a map first published by him. He claims an injunction, delivery up of all infringing publications in the defendants' possession, an inquiry as to damages, and an account of profits. Of course, he cannot have both the inquiry and the account. The defence puts the plaintiff to proof of his copyright, denies the alleged infringement, and pleads that at the date of the publication by them the defendants were not aware that copyright subsisted in the plaintiff's map.

Sept. 14.

The Commonwealth *Copyright Act* No. 20 of 1912 adopts, with some alterations not material to this case, and with machinery provisions adapting it to Australia, the Act of the United Kingdom 1 & 2 Geo. V. c. 46, known as the *Copyright Act* 1911. This Act is the Schedule to the Australian Act.

Its provisions, so far as they are material to this case, are shortly as follows:—

Sec. 1 (1)—“Subject to the provisions of this Act, copyright shall subsist throughout the parts of His Majesty's dominions to which this Act extends . . . in every original literary



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dramatic musical and artistic work, if (a) in the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid."

By sec. 35, "literary work" includes maps, charts, plans, tables and compilations.

Sec. 1 (2)—"For the purposes of this Act, 'copyright' means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatsoever," &c.

Sec. 1 (3)—"For the purposes of this Act, publication, in relation to any work, means the issue of copies of the work to the public."

Sec. 2 (1)—"Copyright in a work shall be deemed to be infringed by any person who, without the consent of the owner of the copyright, does anything the sole right to do which is by this Act conferred on the owner of the copyright: Provided that the following acts shall not constitute an infringement of copyright:—

(I.) Any fair dealing with any work for the purposes of private study, research, criticism, review, or newspaper summary:

(IV.) The publication in a collection, mainly composed of non-copyright matter, *bonâ fide* intended for the use of schools, and so described in the title and in any advertisements issued by the publisher, of short passages from published literary works not themselves published for the use of schools in which copyright subsists."

Sec. 5 (1)—"Subject to the provisions of this Act, the author of a work shall be the first owner of the copyright therein."

Sec. 6 (1)—"Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise provided by this Act, be entitled to all such remedies by way of injunction or interdict, damages, accounts, and otherwise, as are or may be conferred by law for the infringement of a right."

Sec. 6 (3)—Where the defendant puts in issue the existence of the copyright, then—

"(a) if a name purporting to be that of the author . . . is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or



indicated shall, unless the contrary is proved, be presumed to be the author of the work ;

“(b) if . . . a name purporting to be that of the publisher or proprietor . . . is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the owner of the copyright in the work for the purposes of proceedings in respect of the infringement of copyright therein.”

Sec. 7—“All infringing copies of any work in which copyright subsists, or of any substantial part thereof, and all plates used or intended to be used for the production of such infringing copies, shall be deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery of the possession thereof or in respect of the conversion thereof.”

I take it that such proceedings have properly been included in the claim now before the Court.

Sec. 8—“Where . . . the defendant in his defence alleges that he was not aware of the existence of the copyright in the work, the plaintiff shall not be entitled to any remedy other than an injunction or interdict . . . if the defendant proves that at the date of the infringement he was not aware and had no reasonable ground for suspecting that copyright subsisted in the work.”

Sec. 31—“No person shall be entitled to copyright or any similar right in any literary, dramatic, musical, or artistic work . . . otherwise than under and in accordance with the provisions of this Act, or of any other statutory enactment for the time being in force, . . .”

The points to be specially borne in mind are: first, that the work must be “original” in the sense of sec. 1 (1); secondly, that it must have been first published in Australia; thirdly, that a person who without the consent of the owner of the copyright reproduces the work or any substantial part of it in any material form infringes the copyright; fourthly, that a name appearing on the work, as published, as the name of the author or publisher is *prima facie* proof of the authorship or ownership as the case

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may be; and, fifthly, that a defendant relying on sec. 8 has the burden of proof that he was not aware of and had no reasonable ground for suspecting the existence of copyright, and if he fails he is liable to all the ordinary consequences of the infringement of the right.

An interesting argument was raised for the defence as to the meaning of the word "original" in sec. 1 (1). I will deal with this presently.

The plaintiff is a draughtsman who has been compiling, publishing and selling maps in Sydney since 1882, and has issued a large number of them.

The defendant Company, which is admitted to be correctly sued as named in these proceedings, carries on business in Melbourne and elsewhere as a general publisher. Its principal place of business is in Melbourne. Thus the parties are residents of different States. The plaintiff's map was first published in Sydney in December 1913. It was prepared and intended for use in schools and, of course, for purposes of general utility. Its compilation was begun in 1911. The plaintiff and his witnesses described the whole course of preparation. Numerous sources of information were consulted, such as *Mills's Geography*, the text-book for the medium classes of New South Wales Public Schools, and other text-books. Separate maps of authority as well as a number of atlases were the subject of discrimination and selection for the purpose of determining the places and features to be shown on a map which was to be distinctive from its predecessors. Officers of the Education Department were applied to for information, which they furnished. The projection and scale had both to be selected and adapted so as to allow of the giving of the best selection of information within the plaintiff's power on a map of the intended size, namely 35in. by 40in. The work involved considerable exercise of the cartographic faculty and art. Authorities such as *Chambers's Gazetteer*, the *Shipping Register*, the *World's Year Book*, and the *Journals of the Royal Geographical Society*, were consulted for the attainment of accuracy as well as for the winnowing out of such material as might impair the object of securing clearness while retaining educational value. When the map was sufficiently advanced for



the purpose it was submitted to the Education Department, and it elicited suggestions, most of which were adopted. The plaintiff himself not only did a great deal of the artistic, but all the intellectual work involved. The manual work not done by himself was carried out by his staff under his instructions; it was upon his judgment the names and features were chosen or rejected, the result being a map differing in many respects from any previously produced, importing much useful, and rejecting much useless or only slightly useful, information, regard being had to the main object of suitability for use in Public Schools. The plaintiff's map as published contained in large letters the words "by H. E. C. Robinson" following its title. The plaintiff's authorship was therefore to be presumed: sec. 6 (3) (a). It was produced by photo-lithography. The word "copyright" does not appear on it.

It appears that on the outbreak of war the defendants, foreseeing the public demand for a sheet-map showing the various seats of war of that time, determined to produce such a map on paper at a popular price—a shilling or thereabouts. The matter was in the hands of Mr. Western, the retail manager of the defendant Company, who had held that position for twelve years. During that time he had not had any experience in the production of maps, but was versed in the buying and selling of them, maps of Europe included. Desiring to produce a good sheet for his own Company he sent the head salesman out with instructions to obtain a copy of a map from which the cheaper production could be made. The salesman came back with a copy of the plaintiff's map. It was selling at £1 10s. a copy to the public, and £1 2s. 6d. to the trade; but the Education Department, which bought many copies, paid 15s. each for them. The manager says that he observed the plaintiff's name on the map, and that he also observed that nothing about copyright appeared on it. Upon his instructions the defendants' first map was published within a few days. At that time, he says, he was not aware that there was any copyright in the plaintiff's map, and had no other information than the map itself on that subject; nor had he any until his Company received a letter from the plaintiff dated 17th August 1914, complaining that the war map

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published by the defendants was a piracy of his map of Europe published in the previous year, and stating that he would demand "the proceeds" (not the "profits") of the sale of the defendant Company's map and damages for the infringement of his copy-right. At that time, the defendant Company had in fact published and were selling two maps; the first of which was published on the 7th August and the other a little later. The plaintiff published on the 10th August a war map made by himself. In its preparation he used the information in his possession, including his own school map. The latter continued to be sold, and the war map was in competition with the defendants' maps. Afterwards, as will be seen, they published a third. After the receipt of the letter just mentioned, Mr. Western says, no copies of either of the Company's first-mentioned maps were produced or sold by the Company themselves, but copies were in the hands of persons in the trade who had bought them before its receipt. The defendant Company replied to that letter on 22nd August 1914 by a denial that their map of the seat of war was a piracy of the plaintiff's map. They had finished another, almost identical with their previous maps, but containing an inset map, on the 18th August. The Company sold copies of this to the public till about the middle of September, when they were sold out. All of the defendant Company's maps were sold in Sydney, Melbourne and its suburbs, Ballarat, Geelong, and elsewhere. Both by the oral evidence and by comparison of the plaintiff's map with the alleged infringements it is established beyond doubt that the defendant Company's productions were in far the greater part copied from the plaintiff's. In fact the defendant Company's manager said on cross-examination "the work consisted of transferring the whole of plaintiff's work (on the area covered) and adding what we did. We took the whole and added." Before this was said the proof of copying was so strong that the admission could do but little to confirm it. The defendant Company purchased various maps about the time they contemplated issuing those that are now challenged. They compared them with the plaintiff's map, which was the first they had bought. The plaintiff's map was found to suit them best. Their maps were on a 30in. by 40in.



sheet, for they found they could get the portion showing the seat of war on to the smaller sheet, adopting the same scale, but, of course, leaving out portions of the plaintiff's map. This accounts for the omission from the defendant Company's maps of many names which appear on the plaintiff's map, and accounts also for compression in some cases and altered direction in other cases of names which, nevertheless, are found like most of the other names to appear in the same lettering as those on the plaintiff's map. But it is beyond all possible question that there was wholesale piracy.

In one portion the defendants' map was an improvement on the plaintiff's. When the latter was published the Balkan Wars were in progress, and it was difficult in Australia to say what were the new boundaries or what they would be at the close of hostilities. The plaintiff inserted the old boundaries. They were not then correct, but it was scarcely possible to give them correctly for the reasons stated. On the other hand, in August 1914, when the infringements were published, the boundaries as ascertained at the close of the second war were known here, and the defendant Company's manager procured a map of the Balkans on the basis of which the new and correct boundaries were incorporated in Sands & McDougall's maps.

I come now to the argument founded upon the occurrence in sec. 1 (1) of the word "original" as applied to the various works in which copyright is to subsist. Originality was not expressly required by the English Act of 1842. It was argued that under the Act of 1911 a map, to be "original," must be so novel and striking in the method of its presentation of geographical facts as to differ substantially from any presentation previously adopted, so that besides authorship in the sense of the previous law an added quality of originality must be apparent to the eye. It was immaterial that the work was not a copy from something previously existing; the scheme or plan must be visibly so novel as to imply that some novel principle was conceived and followed.

In many of the old cases the word "original" was used as applying to new productions. As an instance, in *Matthewson v. Stockdale* (1), decided by Lord *Erskine* in 1806, the infringing

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work was described as “not original compilation, but a mere copy, with colourable variations.” Here it is clear that the word “original” was not used in the sense which Mr. *Schutt* would ascribe to it as conveyed by the new Act. For, in the sense for which he contends, a compilation could scarcely be “original” although compilations often are and have been the subject of copyright. That Act includes compilations amongst “literary works,” and they may be the subjects of copyright if they are original *as compilations*. In *Graves’ Case* (1) it was contended that a photograph of an engraving was not an original production within the meaning of that word in the *Artistic Copyright Act* of 1862. “The distinction between an original painting and its copy is well understood,” said *Blackburn J.* (2), “but it is difficult to say what can be meant by an original photograph. All photographs are copies of some object, such as a painting or a statue. And it seems to me that a photograph taken from a picture is an original photograph, in so far that to copy it is an infringement of this Statute.” No doubt a photograph copied from the original photograph could not claim copyright, but that stands on a different footing from the original photograph. In *Dicks v. Yates* (3) the defendant had published a novel with the title of “*Splendid Misery*.” The plaintiff had previously published a novel with the same title, but long before that there had been another novel of the same name. The injunction for which the plaintiff asked was refused by the Court of Appeal, *Jessel M.R.* and *Lush L.J.* pointing out, if not indeed resting their judgments on, the lack of originality in the title for which the plaintiff claimed copyright. The former asked (4): “How can the title ‘*Splendid Misery*’ be said to be original, when the very same words for the very same purpose were used nearly eighty years ago?” The Master of the Rolls further said (5) that “no authority binding on us has been produced to show that there can be copyright in such a title as this,” and *James L.J.* concurred in that view. But it seems to me that the meaning that was there attached to the word “original” was that which *Webster’s Unabridged Dictionary* gives as a secondary meaning, namely, “not

(1) L.R. 4 Q.B., 715.

(2) L.R. 4 Q.B., at p. 723.

(3) 18 Ch. D., 76.

(4) 18 Ch. D., at p. 89.

(5) 18 Ch. D., at p. 90.



copied, not imitated." See also the *Oxford Dictionary*, vol. VII., 203, B. 4. It is in this sense that I think that the term is used in the Act of 1911.

It is true that practically everything conveyed in the plaintiff's map was in existence before its publication in sources from which everything presented in the map had been derived. No man can invent a map, the office of which is to present things ascertained, and in a sense it is difficult, if not impossible, to say that any fresh map is original. But it would be a long step to say that therefore no map could be the subject of copyright. Nor is it necessary to produce something which will be striking to the eye. But if a cartographer, applying his faculties to the best sources of information within his reach, produces a map which is in no sense a copy but presents points of difference from previous maps, according to the use to which he purposes to apply it, such a map can, I think, clearly be the subject of copyright, and I think plaintiff's map has the copyright which he claims for it. It is original in the requisite sense.

Mr. *Schutt* relied strongly upon the case of *Walter v. Lane* (1). It is true that in that case Lord *Halsbury* pointed out that the word "original," or any word of the same import, was not to be found in the Statute then in force as a condition precedent. The Statute did not make originality of thought or idea necessary to the right. But neither, I think, does the Act of 1911, if the production is not a copy, if it is original as a compilation. Speaking of the old law, Lord *Halsbury* said (2) that copyright "is given by the Statute to the first producer of a book, whether that book be wise or foolish, accurate or inaccurate, of literary merit or of no merit whatever." And so under the new Statute a stupid or inaccurate book or one devoid of literary merit may still be the subject of copyright because it may be an original work in the sense in which the new Statute uses the word. In reading the report of *Walter v. Lane* it is important to distinguish between the senses of the word "original." For instance, Lord *Rosebery's* speech was original as the expression of his thoughts and ideas, and in that sense the reporter's work was not original, because he used only Lord *Rosebery's* thoughts and ideas.

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(1) (1900) A.C., 539.

(2) (1900) A.C., at p. 549.



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Otherwise the production would not have deserved the name of a report. But, as a report, which could not be original in thought and idea, the subject of copyright was original. Its author used his skill and labour to produce in writing that which previously existed only as spoken words, and I think his report would have been as fully entitled to copyright under the new law as it was under the old. I do not think the new law has overruled the decision of the House of Lords. A work which is new in the sense that it is not a mere copy of some previous publication is original in that sense, and may be the subject of copyright now as of old. Novelty or originality in any other sense is not, I think, essential. As the learned editor of *Copinger's* book says, "the reports of Lord Rosebery's speeches were not original in the sense that the words and sentiments were new, but they were original in the sense that, without the aid of the reporter, the report would have had no existence" (5th ed., p. 52).

Mr. *Schutt* urged that the case of *H. Blacklock & Co. Ltd. v. C. Arthur Pearson Ltd.* (1) did not militate against his contention. To my mind that case shows clearly that such a compilation as the index to *Bradshaw's Guide* for 1914 was, as an index to a new work, entitled to copyright, and that the publication and sale of the matter copied from the index was an infringement, and this notwithstanding the word "original" as used in the new Act. It is true that learned counsel for the defendant do not appear to have mentioned the argument on which Mr. *Schutt* insists. But they attacked the *Guide* as not being the subject matter of copyright inasmuch as that right could not subsist in what they called the reprinting of bundles of time-tables, even with the addition of mileage and cross references; and the case they relied on for that argument, namely, *Leslie v. J. Young & Sons* (2), was decided before the Act of 1911. It seems to have been taken for granted that the law had not been altered by the importation of the word "original," and *Joyce J.* said (3):—"Under the present *Copyright Act*, copyright subsists in every original 'literary work,' which term includes compilations; so that I suppose the list of

(1) (1915) 2 Ch., 376.

(3) (1915) 2 Ch., at p. 381.

(2) (1894) A.C., 335.



names which forms or is contained in the index to *Bradshaw* is entitled to copyright as much as any other part of the publication"; so that it is clear that his Lordship thought that the work was as much entitled to copyright after 1911 as it would have been if published before that year. He said further (1):—"At all events it appears to me that the defendants took a substantial portion of the list of names contained in the index to the plaintiffs' publication, thus without any exertion of their own getting the benefit of the labour and expense expended in compiling the list which formed the index to *Bradshaw*. This they did not for their own personal use, but for the purpose of reproduction by publication at a profit." I think it is clear that there is copyright in the map of the plaintiff, and that the maps of the defendants are infringements of his right. In the case of *Byrne v. Statist Co.* (2) *Bailhache J.* was unquestionably of the opinion I have expressed as to the meaning of "original literary work."

I come to the defence that the defendants were not aware of the existence of the copyright. I have already quoted sec. 8, under which, in order to escape consequences other than an injunction, the defendant must prove that at the date of the infringement he was not aware, and had no reasonable ground for suspecting, that copyright subsisted in the work. I have stated the evidence on this point, save that I should add that the plaintiff's previous maps had all been marked "copyright." He says, and I believe him, that the word was omitted from the new map by oversight. When it was completed, registration had ceased to be necessary. The defendant Company's manager, however, did not know the plaintiff's previous practice when he published the infringing maps; he did not know it until he received the letter of 17th August, so that he could not found any inference on the difference in this respect between that and the plaintiff's earlier maps. But he saw the plaintiff's name on the map and the word "by" which preceded it, and the map therefore not only bore evidence under sec. 6 (3) (a) that the plaintiff was *prima facie* the author of the work, but it conveyed an intimation of its authorship to any ordinary observer. He saw and disregarded the intimation.

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(1) (1915) 2 Ch., at p. 383.

(2) (1914) 1 K.B., 622, at p. 627.



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It is not enough for him to swear that he was “not aware” that copyright existed, since from the face of the map he could hardly help suspecting its existence. The defence in question was really not supported by evidence at all, and as a matter of fact I find against it. See *per Bailhache J.* in *Byrne v. Statist Co.* (1).

In the result I think the plaintiff has substantiated his claim, and I grant the first, second, and third of his prayers, namely, an injunction, delivery up of all copies of infringing maps, and an account of profits. The plaintiff will have his costs, including the costs of the summons for directions which were reserved to the hearing. Further consideration and costs reserved. Liberty to apply.

*Judgment for the plaintiff accordingly.*

Solicitor for the plaintiff, *P. J. O'Donnell.*

Solicitors for the defendants, *Malleson, Stewart, Stawell & Nankivell*, Melbourne, by *Macnamara & Smith.*

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(1) (1914) 1 K.B., 622.

Appl  
Chanel Ltd v  
Chronogem  
Ltd 19 IPR 21

Appl  
Midas  
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40 IPR 129

Appl  
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[HIGH COURT OF AUSTRALIA.]

DON . . . . . APPELLANT;  
OPONENT,  
  
AND  
  
BURLEY . . . . . RESPONDENT.  
APPLICANT,

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MELBOURNE,  
Sept. 19, 20.  
Griffith C.J.,  
Barton and  
Rich JJ.

*Trade Mark—Registration—Similarity to registered mark—Likelihood of deception—Condition—Trade Marks Act 1905-1912 (No. 20 of 1905—No. 19 of 1912), secs. 16, 25, 28, 114.*

A trade mark of which registration was sought consisted substantially of a black swan, with the name “Burley” in white letters upon it, on a white ground of the shape of the continent of Australia. The application was