

[HIGH COURT OF AUSTRALIA.]

SANDS & McDOUGALL PROPRIETARY
LIMITED

DEFENDANTS,

APPELLANTS ;

AND

ROBINSON

PLAINTIFF,

RESPONDENT.

Copyright—Infringement—Original literary work—Author—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, 5-8, 31, 35.

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SYDNEY,
April 2, 3, 26.

The word “ original ” in sec. 1 (1) of the *Copyright Act* 1911 (1 & 2 Geo. V. c. 46) (Schedule to the *Copyright Act* 1912) does not imply inventive originality : the expression “ original work ” has there the meaning which is connoted by the word “ author ” in sec. 5.

The respondent, taking the common stock of information in Australia and applying to it personal, that is, independent, intellectual effort in the exercise of judgment and discrimination, produced a map which was new in the sense that, in respect of its size and outlines, its contents and arrangement and its general appearance, it presented both in its totality and in specific parts distinct differences from other existing maps.

Held, that the respondent's map was an original literary work within the meaning of sec. 1 (1) and entitled to copyright, and that the appellants, whose map was not a mere copy in the ordinary sense of the respondent's map but was clearly a reproduction in a substantial part of the respondent's map, had infringed the copyright.

Walter v. Lane, (1900) A.C., 539, explained.

Held, also, on the evidence, that the appellants had not proved that at the date of the infringement they were not aware and had no reasonable ground for suspecting that copyright subsisted in the respondent's map, and, therefore, that the respondent's remedy was not limited to an injunction as provided by sec. 8.

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Quære, whether the provisions of sec. 6 (3) apply except to proceedings in an action.

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Decision of *Barton J.*: *Robinson v. Sands & McDougall Proprietary Ltd.*,
22 C.L.R., 124, affirmed.

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APPEAL from *Barton J.*

This was an appeal by the defendants from the decision of *Barton J.* in *Robinson v. Sands & McDougall Proprietary Ltd* (1), where the material facts are fully stated.

By the order as drawn up it was ordered (*inter alia*) that the defendants their servants and agents be restrained from producing and reproducing the whole or any substantial part of the map of Europe first published by the plaintiff in Sydney and from otherwise infringing the plaintiff's copyright in the said map; that all copies of maps infringing the plaintiff's copyright in the possession of the defendant company or their agents be delivered up to the plaintiff; and that it be referred to the District Registrar of the High Court to take an account of the number of maps infringing the plaintiff's copyright published and sold by the defendant company or their agents "and of the receipts and profits derived from such sales."

Schutt (with him *Bavin*), for the appellants. There was no copyright in the respondent's map. Under the law as it existed prior to the *Copyright Act* 1911, all that was necessary to entitle a person to copyright in a map was that he should be the "author" of it, and the term "author" did not connote originality (*Walter v. Lane* (2)). In *Dicks v. Yates* (3) it has held that for a person to be an author his work must involve originality, that is, the exercise of inventive skill, but in *Walter v. Lane* the contrary was decided. The effect of the introduction into sec. 1 of the *Copyright Act* 1911 of the word "original" is that, in order to entitle a person to copyright, in addition to his being the author of the work the work itself must be original in the sense used in patent law—that is, it must have novel or distinctive features which distinguish it from previous works. [He also referred to *University of London Press Ltd. v. University*

(1) 22 C.L.R., 124.

(3) 18 Ch. D., 76.

(2) (1900) A.C., 539.

Tutorial Press Ltd. (1); *H. Blacklock & Co. Ltd. v. C. Arthur Pearson Ltd.* (2); *Macgillivray on the Copyright Act 1911*, p. 3; *Copinger on Copyright*, 5th ed., p. 51; *Oldfield's Law of Copyright*, p. 13.] Even if the respondent's map was entitled to copyright, the appellants were entitled to make use of it and to make alterations and improvements in it and bring it up to date as they have done. The provision in sec. 1 (2) that defines copyright as the sole right to reproduce a work or any substantial part of it does not deprive another person of the right to take a substantial part of it and alter and improve it (*Matthewson v. Stockdale* (3)).

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[ISAACS J. referred to *Bradbury v. Hotten* (4).]

That case shows that you must regard the object in view in the case of an alleged infringement as compared with that in the case of original publication. The respondent's map was intended and adapted for use in schools and for educational purposes, but the appellants' map is not. The appellants had no reasonable ground for suspecting that copyright existed in the respondent's map, and therefore under sec. 8 the respondent's only remedy is an injunction. There is no claim for damages for conversion, but only a claim for damages for infringement. The Court should adapt the order to the circumstances of the case, and in this case a small amount should have been fixed because no real damage was occasioned to the respondent, inasmuch as the appellants' map did not enter into competition with his. The damages should, at any rate, be limited to the amount of the actual net profits.

[Counsel also referred to *Kelly v. Morris* (5); *Weatherby & Sons v. International Horse Agency and Exchange Ltd.* (6).]

Flannery (with him *McTiernan*), for the respondents. The words "author" and "original" in the Act are correlative, and the word "original" refers only to that kind of originality which in *Walter v. Lane* (7) was said to be necessary to constitute a person an author. The respondent has framed his action under sec. 7 of the Act and

(1) (1916) 2 Ch., 601.

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

(3) 12 Ves., 270, at pp. 273-275.

(4) L.R. 8 Ex., 1.

(5) L.R. 1 Eq., 697, at p. 701.

(6) (1910) 2 Ch., 297, at p. 305.

(7) (1900) A.C., 539.

H. C. OF A. is entitled to damages for conversion, and such damages are not
 1917. limited to net profits (*Muddock v. Blackwood* (1)).

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The following judgments were read :—

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ISAACS J. This is an appeal from the judgment of *Barton J.* The respondent has consented to a modification of the curial order by making the direction for delivery of unsold copies, the delivery for their destruction. This relieves us of the necessity of deciding whether sec. 7 of the Act justified the order in its wider form. Apart from this particular direction, as to which I therefore express no opinion, the judgment appealed from is clearly right, and should be affirmed. My learned brother *Barton* has so fully stated the facts that they need not be recapitulated.

There can be no doubt that in one sense, and in the only sense that was necessary under the copyright law prior to July 1912, the map was an “original” work and the respondent was the “author.” He had unquestionably prepared it by taking the common stock of information in Australia and, by applying to it personal, that is, independent, intellectual effort in the exercise of judgment and discrimination, had produced a map that was new in the sense that, in respect of its size and outlines, its contents and arrangement and its general appearance, it presented both in its totality and in specific parts distinct differences from other existing maps.

It is true that the appellants changed the colours of the political divisions, corrected the Balkan boundaries, introduced some places that had then acquired recent prominence, and cut out some places that were interfered with by some further features of arrangement of their own map. Their map was not a mere copy in the ordinary sense of the term, but it was clearly a reproduction of a substantial part of the respondent’s map in a material form, which necessarily violated the respondent’s copyright if his work be protected by the Act. Notwithstanding all the differences referred to, there still remained in respect of size, of draftsmanship, of style, of printing

type, and geographical selection and general appearance, a manifest wholesale adoption of the individual work which the respondent had bestowed upon his map, and which had given to it its distinct characteristics and individuality.

The appellants, however, contend that even taking these facts to be established, the respondent's map is not within the protection of the recent Commonwealth *Copyright Act*, No. 20 of 1912, which adopts with certain modifications the English Act of 1911. The contention is based on the argument that the word "original" in sec. 1 of the English Act introduces a new legal requisite for protection which the appellants say the respondent's map does not possess. That suggested requisite is that a work must now be original in the same sense that an invention must be novel. The view presented is that since the Act in sec. 1 gives protection only to an "original work," and in sec. 5 says that the "author" is to be the first owner of the copyright (subject to named exceptions), the legislative provision must be read as conferring protection upon an "author," and then only in respect of such of his works as are "original" in the sense of sec. 1; and that inasmuch as "author" has always connoted some amount of originality in the sense used in the older cases, the express use of the word "original" must carry with it some additional meaning which, having regard to the case of *Walter v. Lane* (1), must necessarily and in all cases be inventive originality. It is said that *Walter v. Lane* decides that originality in an inventive sense was not in any case necessary in the then existing state of the law, and that it was sufficient for a person to be an "author" with whatever originality that word includes. The change suggested would be revolutionary.

The whole subject of copyright now depends on the Act of 1912, which came into force on 1st July of that year. The English Act of 1911, which is scheduled to the Australian Act, has been adopted with some modifications, which are immaterial to the present question. The matter is so circumstanced as to impel me to state my own reasons for rejecting the contention so forcibly presented on behalf of the appellants. The Act scheduled is part of the international arrangement constituted by the Berlin Convention of 1908, to which

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

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Great Britain was a party, and by which she undertook, by the second article, to make provision for the protection of literary and artistic works as there defined. The English Act of 1911 was passed in fulfilment of this obligation, and its adoption by Australia is part of the Imperial scheme for effectuating the international arrangement. It is evident that, not only because of its inter-Imperial application but also by reason of its international significance, any interpretation of the new Act demands the closest consideration. The question raised by this appeal is crucial. The international origin of the enactment does more than create an unusual importance: it affords considerable aid in understanding it. The Imperial Parliament necessarily had the terms of the Convention before it, was acquainted with the language of that document, and was carrying out the promise it contained. This has special reference to the argument addressed to us on behalf of the appellants and already referred to.

I shall first consider the matter apart from the language of the Convention. In *Walter v. Lane* (1) it certainly was held that originality in respect of the ideas expressed or in the composition recorded in the report which was the subject of their Lordships' consideration was not necessary to constitute the reporter the "author" of his report. But, on the other hand, the personal skill of the reporter as well as his labour and expense were considered to be material considerations, and, as these resulted in the production of a material and visible representation of what had been said, I think it can be collected from the case that that representation was regarded itself as an original production. The reporter was certainly decided to be an "author" as to the report; and, as no such thing existed previously, he created, that is "originated," the report. In that sense the report was necessarily "original," and I find nothing in any of the observations of the learned Lords opposed to that view. Lord *James* of Hereford, says (2): "An 'author' may come into existence without producing any original matter of his own." He proceeds to give instances, such as street directories, law reports and railway time tables, and adds: "yet in one sense no original matter can be found in such publications." Further on the learned Lord asks:—"Now, what is it that a reporter does? Is he a mere scribe?"

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

(2) (1900) A.C., at p. 554.

Does he produce original matter or does he *produce the something* I have mentioned which entitles him to be regarded as an ‘author’ within the Act? ” He thought the reporter was a “*producer of the something necessary* to constitute him an ‘author.’” (In these extracts the italics are mine.) Lord *Brampton* summed up the matter in four lines (1):—“True it is that the reporter was not the author of the speech; but he was the composer and author of the book . . . Without his brain and handiwork the book would never have had existence.” If my view of that case is correct (and since writing the above I am confirmed in that view by reading the observations of the present Lord Justice *Scrutton* in his work on *Copyright*, pp. 119 and 120), the basis of the appellants’ argument on the first point is gone. But in any case the Act does not depend on any strict examination of the language of *Walter v. Lane* (2).

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The Act certainly makes some radical changes in the law of literary property. It entirely abolishes, by sec. 31, the common law right of an author analogous to copyright in unpublished works—though preserving the personal right where a trust or confidence exists; and of course leaving untouched questions of fraud and passing off. It substitutes for the common law right referred to, the statutory right mentioned in sec. 1. But if the argument advanced be correct, the statutory right—that is, the only such right—in respect of unpublished works would not arise unless the work were “original” in the inventive sense.

But, in addition, that argument overlooks the obvious fact that in copyright law the two expressions “author” and “original work” have always been correlative; the one connotes the other, and there is no indication in the Act that the Legislature intended to depart from the accepted signification of the words as applied to the subject matter. Indeed, the circumstance of reciprocal connotation is the key to the meaning of the enactment. We find in the *Oxford Dictionary*, vol. i., p. 571, col. 1, “author” defined as “the person who originates or gives existence to anything.”

“Original work” in the Act is, in my opinion, used in the same

(1) (1900) A.C., at p. 559.

(2) (1900) A.C., 539.

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sense as the phrase was used by Lord *Eldon* in *Wilkins v. Aikin* (1), where he speaks of "a mental operation deserving the character of an original work." So per Lord *Kenyon* in *Trusler v. Murray* (2); and the phrase "original composition" by Lord *Watson* in *Caird v. Sime* (3), cited by Lord *Davey* in *Walter v. Lane* (4); and per Lord *Herschell* in *Leslie v. J. Young & Sons* (5). As to this I agree with *Joyce J.* in *H. Blacklock & Co. Ltd. v. C. Arthur Pearson Ltd.* (6) and *Peterson J.* in *University of London Press Ltd. v. University Tutorial Press Ltd.* (7).

In *Chitty's Statutes*, 2nd ed., vol. 1., p. 749, note (d), published in 1851, the learned authors say: "Copyright is the exclusive right of multiplying copies of an original work or composition." I would also refer to the reasoned judgment of *Story J.* in *Emerson v. Davies* (8).

Turning now to the Convention, which was the public bargain Parliament was carrying into effect, we find in various articles (e.g., 2, 8, 11, 12 and 14) the expression "original work." I apprehend that the signatories in employing that term were not attempting to affect *Walter v. Lane* (9), but, except where the context contrasts "original" with translations or reproductions, were using a time-honoured and universal phrase then current and well understood in all countries in relation to copyright.

By art. 1 the contracting States are constituted into a Union for the protection of the rights of authors over their literary and artistic works. Art. 2 is specially important. It first defines "literary and artistic works," then it says that translations, &c., shall be protected as "original works without prejudice to the rights of the author of the original work." Here we have two senses of the word "original," the first in the sense relevant to this case; but neither assists the appellants. Then the article declares: "The contracting countries shall be bound to make provision for the protection of the above-mentioned works." This fact, by affording a distinct reason for the use of the expression, greatly adds to the

(1) 17 Ves., 422, at p. 426.

(2) 1 East, 363 n.

(3) 12 App. Cas., 326, at p. 343.

(4) (1900) A.C., at p. 550.

(5) (1894) A.C., 335, at p. 341.

(6) (1915) 2 Ch., at p. 381.

(7) (1916) 2 Ch., at p. 608.

(8) 3 Story, 768, at pp. 778-779.

(9) (1900) A.C., 539.

improbability of the Imperial Parliament intending by a subtle implication to attach a new meaning to the word "original," a meaning which would undoubtedly cut down the rights of foreign authors, in whose countries *Walter v. Lane* was not an authority.

I pass to another branch of the contention, namely, that the Act itself by its own words requires the double condition "author" and "original work." The scheme of protection, as I read the Act, is this: All literary works are protected if "original." That is the only condition—apart, of course, from certain disentitling considerations, as immorality and other disqualifications implicitly recognized by the law. The protection is called "copyright," and the *owner* of the copyright, whoever he may be, is the person who can enforce it. The "owner of the copyright" is then designated. *Primâ facie* it is the "author" (sec. 5) who is referred to, not as an additional condition of copyright, but as the owner of the copyright already fully declared. The word "original" connotes the "authorship," and the author is the first person considered. But the author may not be even the first owner, and where the provisoes to sub-sec. 1 of sec. 5 apply he is not.

So that by no process of reasoning can the proposition advanced as to the word "original" be maintained. The main point fails.

It was urged, on the second part of the case, that under the concluding words of sec. 8 the appellants were, in the circumstances, not liable except to an injunction. I agree with my learned brother *Barton* that the facts fall short of the exculpation required by the section. But what I desire to say is that I arrive at that conclusion on the facts alone. I am not prepared to say that sec. 6, sub-sec. 3, applies except to proceedings in the action. This provision was apparently inserted in view of art. 15 of the Convention. Its application here is not necessary to the respondent's success, and I leave the full consideration of the provision for another occasion.

The appeal should be dismissed with costs.

GAVAN DUFFY AND RICH JJ. We have read the judgment of our brother *Isaacs*, and concur in it.

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H. C. OF A. We agree that the appeal should be dismissed with costs.
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Appeal dismissed with costs.

ROBINSON. Solicitors for the appellants, *Malleson, Stewart, Stawell & Nankivell*, Melbourne, by *Macnamara & Smith*.
Solicitor for the respondent, *P. J. O'Donnell*.

B. L.

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of (NT) v
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THE AUSTRALIAN SUGAR PRODUCERS' }
ASSOCIATION LIMITED } APPELLANTS;
PROSECUTORS,

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Nov. 27; Dec.
7, 8, 22.

Griffith C.J.,
Barton, Isaacs,
Gavan Duffy
and Rich JJ.

ON APPEAL FROM THE SUPREME COURT OF
QUEENSLAND.

Practice—High Court—Extra-judicial opinion—Public urgency.

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MELBOURNE, *Employer and Employee—Award—Validity—Retrospective award—"Industrial matters"—Food for employees—Jurisdiction—Severability—Industrial Peace Act 1912 (Qd.) (3 Geo. V. No. 19), secs. 3, 6, 7, 13, 16, 31—Industrial Arbitration Act 1916 (Qd.) (7 Geo. V. No. 16), secs. 3, 8.*
Jan. 3, 4, 5,
11.

Griffith C.J.,
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Higgins, Powers
and Rich JJ.

Per Griffith C.J.—The High Court should not refrain from expressing an extra-judicial opinion in a case in which a formal error in procedure may