

HIGH COURT OF AUSTRALIA

FRENCH CJ,
GUMMOW, HAYNE, HEYDON, CRENNAN AND KIEFEL JJ

ICETV PTY LIMITED & ANOR

APPELLANTS

AND

NINE NETWORK AUSTRALIA PTY LIMITED

RESPONDENT

IceTV Pty Limited v Nine Network Australia Pty Limited [2009] HCA 14
22 April 2009
S415/2008

ORDER

1. *Appeal allowed with costs.*
2. *Set aside the order of the Full Court of the Federal Court of Australia made on 8 May 2008, as varied on 20 August 2008, and in place thereof order that the appeal to that Court be dismissed with costs.*

On appeal from the Federal Court of Australia

Representation

J M Ireland QC with S C G Burley SC and J S Cooke for the appellants
(instructed by Bartier Perry)

A J L Bannon SC with R Cobden SC and J M Hennessy for the respondent
(instructed by Gilbert & Tobin)

D K Catterns QC with A J Ryan and S M Rebikoff intervening as amicus curiae
on behalf of Telstra Corporation Limited (instructed by Mallesons Stephen
Jaques)

R J Webb SC intervening as amicus curiae on behalf of Australian Digital
Alliance Limited (instructed by Baker & McKenzie)

Notice: This copy of the Court's Reasons for Judgment is subject to
formal revision prior to publication in the Commonwealth Law Reports.

CATCHWORDS

IceTV Pty Limited v Nine Network Australia Pty Limited

Intellectual property – Copyright – Literary work – Compilation – Infringement – Production by employees of Nine Network Australia Pty Limited ("Nine") of weekly schedules of television programmes to be broadcast on television stations within Nine Network ("Weekly Schedules") – Information from Weekly Schedules used by third parties, with licence from Nine, to produce "Aggregated Guides" containing programme schedules for various television stations – Production by employees of IceTV Pty Limited of electronic programme guide for television using information from Aggregated Guides – Subsistence of copyright in each Weekly Schedule admitted – Alleged infringement of copyright by reproduction of substantial part of Weekly Schedules – Whether reproduction of "substantial part" – Quality of part reproduced – Originality – Information/expression dichotomy – Appropriation of "skill and labour" – Relevance of skill and labour devoted to programming decisions – Relevance of competing interests and policy considerations – *Animus furandi*.

Intellectual property – Copyright – Literary work – Compilation – Subsistence – Need to identify author, and time of making or first publication, of work – Originality – Kind of skill and labour required – "Sweat of the brow" and "industrious collection" compared with "creativity".

Intellectual property – Copyright – Literary work – Compilation – Subsistence – Weekly Schedules produced using computer database – Whether database also work in suit – Whether Weekly Schedules same work.

Words and phrases – "*animus furandi*", "author", "compilation", "information/expression dichotomy", "originality", "skill and labour", "substantial part".

Copyright Act 1968 (Cth), ss 9(3), 10(1), 14(1), 21, 22, 29, 31, 32, 33, 34, 35, 36, Pt III Div 9, Pt III.

Copyright Act 1911 (Imp), ss 1(1), 35(1).

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

Copyright Act 1976, 17 USC §§101, 102.

Copyright Act RSC 1985, ch C-42, s 2.

Introduction

1 The respondent, Nine Network Australia Pty Limited ("Nine"), is engaged in the business of acquiring, distributing, selecting and scheduling programmes to be broadcast by various free-to-air television stations within the "Nine Network". The scheduling of programmes to be broadcast involves the use of a database on Nine's computer network ("the Nine Database"). Approximately two weeks prior to the commencement of each week of broadcasting, an employee of Nine supplies certain third parties known as "Aggregators" with a schedule of programmes to be broadcast on Nine Network stations in that week (a "Weekly Schedule"). Each Weekly Schedule is produced from the Nine Database.

2 Each Weekly Schedule contains various elements, including particulars of the time and title of programmes to be broadcast ("time and title information"). The Aggregators use the Weekly Schedule, together with comparable material provided by other Australian television broadcasters and independently obtained material, to produce "Aggregated Guides", which are schedules of programmes to be broadcast on various television stations, for publication in various media.

3 The first appellant, IceTV Pty Limited ("IceTV"), commenced trading in 2005. It is a wholly owned subsidiary of the second appellant, IceTV Holdings Limited ("IceTV Holdings"). They are not broadcasters.

4 The primary business of IceTV is the provision, via the Internet, of a subscription-based electronic programme guide for television known as the "IceGuide". When downloaded onto certain devices, which are available for purchase by consumers in Australia, the IceGuide displays details of programmes scheduled to be broadcast by free-to-air television stations for the coming six to eight days, including stations in the Nine Network.

5 Over the period relevant to this appeal, when preparing the information to be included in the IceGuide for a given day, employees of IceTV used information included in the IceGuide for a previous day¹ and then compared this with published Aggregated Guides. Where there was a discrepancy as to the time and title information, the IceGuide was amended to reflect the Aggregated Guides in almost all cases. It is this use of the Aggregated Guides that is in issue in this appeal.

1 As to the creation of the original IceGuide schedules, see [19].

The proceedings

6 This appeal arises out of proceedings brought by Nine in the Federal Court of Australia against IceTV and IceTV Holdings for infringement of copyright. Although Nine's case at trial was broader in several respects, relevantly to this appeal Nine alleged at trial, on appeal to a Full Court of the Federal Court of Australia ("the Full Court") and on the first day of hearing in this Court that: each Weekly Schedule was a "compilation" and therefore a "literary work", within the meaning of s 10(1) of the *Copyright Act* 1968 (Cth) ("the Act"); each was an "original" literary work, in which copyright subsisted, within the meaning of s 32 of the Act; Nine was the owner of that copyright; and IceTV infringed that copyright by taking part of the time and title information from the Aggregated Guides and including it in the IceGuide, as this constituted a reproduction (albeit an "indirect reproduction") in a material form of a "substantial part" of the copyright work, within the meaning of s 14(1)(b) of the Act. The claims involved alleged reproduction of time and title information week by week. Nine sought declaratory and injunctive relief against IceTV and IceTV Holdings, as well as damages or an account of profits and additional damages pursuant to s 115(4) of the Act.

7 For their part, IceTV and IceTV Holdings accepted that copyright subsisted in each Weekly Schedule as an original literary work. However, they denied that IceTV had reproduced, in a material form, a substantial part of any Weekly Schedule in issue and denied that reproduction from any Aggregated Guide was a reproduction of any Weekly Schedule.

8 Accordingly, both the primary judge (Bennett J)² and the Full Court (Black CJ, Lindgren and Sackville JJ)³ dealt with this matter on the basis that the subsistence of copyright in the Weekly Schedules was admitted. The dispute was treated below as one to be resolved, first, by a determination of whether the time and title information which was reproduced constituted a "substantial part" of the Weekly Schedules and, secondly, by consideration of the "indirect reproduction" issue. Both the primary judge and the Full Court essentially approached the question of whether IceTV had reproduced a substantial part of any Weekly Schedule by identifying the "skill and labour" which was expended on creating the Weekly Schedules, then asking whether IceTV had "appropriated" Nine's skill and labour. The primary judge and the Full Court reached opposite

2 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2007) 73 IPR 99 at 107 [31].

3 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14 at 15 [1], 29 [56].

3.

conclusions on the point essentially because of different approaches to identifying the relevant skill and labour in question: the primary judge considered that skill and labour in making programming decisions was not relevant and that there was not a reproduction of a substantial part; the Full Court considered that this skill and labour was relevant and that there was a reproduction of a substantial part.

9 There was a change in direction on the second day of hearing in this Court. Nine sought to recharacterise the relevant original literary works as the "Nine Database", a matter explained by Gummow, Hayne and Heydon JJ⁴. IceTV and IceTV Holdings contested that recharacterisation.

10 We agree with Gummow, Hayne and Heydon JJ that the appeal should be allowed. In the light of the reasons which follow, it is unnecessary for us to consider the "indirect reproduction" issue. The facts and the relevant legislation have all been set out in the reasons of Gummow, Hayne and Heydon JJ. They do not need to be repeated here except as necessary to explain our reasons.

Question

11 The principal question raised by this appeal is whether Nine can obtain relief for copyright infringement arising from the reproduction of individual items of information, part of the time and title information, in respect of various programmes contained in the Weekly Schedules. If this question is answered affirmatively, this would effectively restrain IceTV from selling its products in the derivative or secondary market of weekly television guides without a licence or authorisation from Nine.

The works in suit

12 *The Weekly Schedules.* As noted above, the works in suit were identified, at first, as each of the Weekly Schedules over the relevant period in which it was said that copyright infringement occurred. There were two formats of the Weekly Schedule in evidence. The primary judge described the Weekly Schedule, in either format, as follows⁵:

4 See reasons of Gummow, Hayne and Heydon JJ at [141]-[142].

5 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2007) 73 IPR 99 at 107-108 [34]-[35]. See also reasons of Gummow, Hayne and Heydon JJ at [118]-[119].

"The weekly schedule contains the time and title information for a 7-day broadcast week. It gives program starting times, program titles and, where relevant, episode titles for each day. The weekly schedule also contains additional program information, including whether the program or episode is a repeat or live, format information (for example, 'WS' for widescreen and 'HD' for high definition), the classification (for example, 'PG' for parental guidance, 'M' for mature), consumer advice information (for example, 'Frequent Co[a]rse Language [L]') and program or episode synopses. The synopses have a literary element.

The information included in the weekly schedule is set out in columns for each day ... The first two columns comprise program time and title information. The third and fourth columns comprise additional program information. The fifth and final column contains the synopses. The arrangement of the weekly schedule is in a particular way:

- as a broadcast week from Sunday to Saturday under each 'day';
- as a day, from 6 am to 5.59 am the next day;
- in tabular form; and
- in columns, with each column containing certain information as described above."

13 *The Nine Database*. As detailed in the reasons of Gummow, Hayne and Heydon JJ⁶, on the second day of hearing in this Court, Nine submitted, for the first time, that the work in suit was the Nine Database (presumably from week to week) and that each Weekly Schedule was but a form of that work.

14 It is difficult to accept this contention. As explained in the reasons of Gummow, Hayne and Heydon JJ⁷, associated with each timeslot in the Nine Database were pieces of information not associated with that timeslot in the Weekly Schedule, such as a catalogue code. Further, as explained by the primary judge⁸, other documents which differ substantially from the Weekly Schedule were also produced from the Nine Database. Assuming the Nine Database is a

6 At [141]-[142].

7 At [147].

8 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2007) 73 IPR 99 at 105 [22].

5.

compilation, it therefore appears to be a different compilation from the Weekly Schedule. No real argument was addressed on this point by counsel for Nine.

15 It needs to be observed that in copyright cases, it is essential that the plaintiff identify precisely the work or works in which copyright is said to subsist and to have been infringed⁹.

16 However, it is not necessary to resolve this issue, as in our view nothing turns in this appeal on the correctness of Nine's contention. It may be assumed that copyright subsisted in the Nine Database from week to week as an original literary work, it being a compilation. As it has been conceded by IceTV and IceTV Holdings that copyright subsisted in each Weekly Schedule, it is therefore not necessary, in this appeal, to consider the question of the subsistence of copyright in those compilations¹⁰.

The allegedly infringing conduct

17 The conduct alleged to infringe copyright arises in the following way.

18 As noted above, subscribers to IceTV's services could program compatible devices to connect over the Internet to a database maintained by IceTV and download the latest version of the IceGuide for an upcoming six to eight-day period. The precise visual appearance of the IceGuide varied between devices and was not determined or influenced by IceTV or IceTV Holdings. Indeed, at the user's choice, the IceGuide could be displayed on a device in different visual formats containing different information.

19 The initial information to be included in the IceGuide was generated by an employee of IceTV watching television over a period of time, obtaining information about programmes from the Internet and reviewing published Aggregated Guides. In this appeal, no complaint is made by Nine about this process.

9 See, albeit in a slightly different context, *Tate v Fullbrook* [1908] 1 KB 821 at 832-833 per Farwell LJ: "The Act creates a monopoly, and in such a case there must be certainty in the subject-matter of such monopoly in order to avoid injustice to the rest of the world"; approved by the Privy Council in *Green v Broadcasting Corporation of New Zealand* [1989] 2 All ER 1056 at 1058 per Lord Bridge of Harwich.

10 Cf *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 119 FCR 491.

20 Nine's complaint concerns the process by which each day's IceGuide schedule had been created since April 2005. In essence, an employee of IceTV would use an IceGuide schedule from a previous day, compare it to a number of Aggregated Guides and, in almost all cases where there was a difference as to the time and title information, amend the IceGuide schedule accordingly. It is alleged that this reproduction of time and title information, to be included in the IceGuide, constituted a reproduction of a substantial part of the Weekly Schedule (or the Nine Database) which was the source of the information. The alleged reproduction involved the use of the words, figures and symbols, and the chronological arrangement, in which the time and title information was expressed.

21 Assuming copyright subsists in the Weekly Schedule (as admitted by IceTV and IceTV Holdings) and in the Nine Database, each Weekly Schedule (and each week's version of the Nine Database) is accepted by Nine in this Court to be a separate copyright work. If there were no reproduction of a substantial part from any of the individual works, the conclusion must be that there was no infringement of copyright in any of the works. The fact that there was "systematic copying" of time and title information over a period of time, from many of the individual works, does not alter that conclusion¹¹. To the extent that there are nineteenth century cases to the contrary¹², they should not be followed. It is sufficient for the purposes of discussing infringement in this appeal to focus on a single Weekly Schedule (or a single week's version of the Nine Database), as what is said will apply to all of them.

11 *Newspaper Licensing Agency Ltd v Marks and Spencer plc* [2001] Ch 257 at 269 [30] per Peter Gibson LJ: "I do not understand how in logic what is an insubstantial part of a work can when aggregated to another insubstantial part of another work become a substantial part of the combined work". See also *Electronic Techniques (Anglia) Ltd v Critchley Components Ltd* [1997] FSR 401 at 409-410 per Laddie J; *PCR Ltd v Dow Jones Telerate Ltd* [1998] FSR 170 at 183 per Lloyd J. Cf systematic or repeated copying from the one work: see, eg, *Football League Ltd v Littlewoods Pools Ltd* [1959] Ch 637 ("Littlewoods"). See further Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 389-391 [7-29].

12 See, eg, *Trade Auxiliary Co v Middlesborough and District Tradesmen's Protection Association* (1888) 40 Ch D 425; *Cate v Devon and Exeter Constitutional Newspaper Co* (1889) 40 Ch D 500.

"Author" and "authorship" and the information/expression dichotomy

22 The "author" of a literary work and the concept of "authorship" are central to the statutory protection given by copyright legislation, including the Act.

23 Undoubtedly, the classical notion of an individual author was linked to the invention of printing and the technical possibilities thereafter for the production of texts otherwise than by collective efforts, such as those made in mediaeval monasteries. The technological developments of today throw up new challenges in relation to the paradigm of an individual author. A "work of joint authorship", as recognised under the Act, requires that the literary work in question "has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of the other authors"¹³. As in other cases where the facts resemble those under consideration here¹⁴, the Weekly Schedules (and the Nine Database) were the result of both a collaborative effort and an evolutionary process of development, involving in this instance both manpower and the use of computers. However, nothing in these reasons turns on any conclusion as to the precise identity of the author or authors of those works.

24 In assessing the centrality of an author and authorship to the overall scheme of the Act, it is worth recollecting the longstanding theoretical underpinnings of copyright legislation. Copyright legislation strikes a balance of competing interests and competing policy considerations¹⁵. Relevantly, it is concerned with rewarding authors of original literary works with commercial benefits having regard to the fact that literary works in turn benefit the reading public.

25 In both its title¹⁶ and opening recitals¹⁷, the Statute of Anne of 1709¹⁸ echoed explicitly the emphasis on the practical or utilitarian importance that

13 Section 10(1). See *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd* [1995] FSR 818 for the position in the United Kingdom.

14 See, eg, *British Broadcasting Co v Wireless League Gazette Publishing Co* [1926] Ch 433; *Independent Television Publications Ltd v Time Out Ltd* [1984] FSR 64.

15 See also Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 14 [1-33], 27 [2-05].

16 "An Act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned."

certain seventeenth century philosophers attached to knowledge and its encouragement in the scheme of human progress¹⁹. The "social contract" envisaged by the Statute of Anne, and still underlying the present Act, was that an author could obtain a monopoly, limited in time, in return for making a work available to the reading public.

26 Whilst judicial²⁰ and academic²¹ writers may differ on the precise nature of the balance struck in copyright legislation in different places, there can be no doubt that copyright is given in respect of "the particular form of expression in which an author convey[s] ideas or information to the world"²².

27 The particular form of expression here was the Weekly Schedule (or the Nine Database). The balance spoken of above is important in the present context

17 "Whereas printers, booksellers, and other persons have of late frequently taken the liberty of printing, reprinting, and publishing, or causing to be printed, reprinted, and published books, and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families: For preventing therefore such practices for the future, and for the encouragement of learned men to compose and write useful books".

18 8 Anne c 19.

19 For example, Sir Francis Bacon (1561-1626) and John Locke (1632-1704).

20 See, eg, *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991). In this case the Supreme Court of the United States leaned in favour of the social utility of copyright legislation. See also *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339.

21 See, eg, Ginsburg, "No 'Sweat'? Copyright and Other Protection of Works of Information after *Feist v Rural Telephone*", (1992) 92 *Columbia Law Review* 338; Deazley, "The Myth of Copyright at Common Law", (2003) 62 *Cambridge Law Journal* 106; Scassa, "Recalibrating Copyright Law?: A Comment on the Supreme Court of Canada's Decision in *CCH Canadian Limited et al v Law Society of Upper Canada*", (2004) 3 *Canadian Journal of Law and Technology* 89; Longdin, "Copyright Protection for Business Systems and Surveys: Disentangling Fact, Form and Function", (2005) 11 *New Zealand Business Law Quarterly* 161; Sims, "Copyright's Protection of Facts and Information", (2006) 12 *New Zealand Business Law Quarterly* 360.

22 *Hollinrake v Truswell* [1894] 3 Ch 420 at 424 per Lord Herschell LC.

because, generally speaking, no copyright could be claimed in a programme title alone²³ and the time at which a programme will be broadcast is a single item of quotidian information.

28 Copyright does not protect facts or information²⁴. Copyright protects the particular form of expression of the information, namely the words, figures and symbols in which the pieces of information are expressed²⁵, and the selection and arrangement of that information²⁶. That facts are not protected is a crucial part of the balancing of competing policy considerations in copyright legislation. The information/expression dichotomy, in copyright law, is rooted in considerations of social utility. Copyright, being an exception to the law's general abhorrence of

23 See the cases cited in Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 61-62 [3-16]. See also *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 at 277 per Lord Reid; [1964] 1 All ER 465 at 469 ("*Ladbroke*").

24 See, eg, *Blackie & Sons Ltd v The Lothian Book Publishing Co Pty Ltd* (1921) 29 CLR 396 at 400 per Starke J; [1921] HCA 27; *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479 at 497 per Latham CJ, 511 per Dixon J; [1937] HCA 45; *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171 at 181 per Gibbs CJ; [1986] HCA 19. See also *Walter v Steinkopff* [1892] 3 Ch 489; *Chilton v Progress Printing and Publishing Co* [1895] 2 Ch 29; *Odhams Press Ltd v London and Provincial Sporting News Agency (1929) Ltd* [1936] Ch 357 at 364 per Lord Wright MR; *Littlewoods* [1959] Ch 637 at 651-652 per Upjohn J; *Fraser v Evans* [1969] 1 QB 349 at 362 per Lord Denning MR; *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd* [1979] FSR 46 at 52 per Goff LJ; *Sawkins v Hyperion Records Ltd* [2005] 1 WLR 3281 at 3289 [29] per Mummery LJ; [2005] 3 All ER 636 at 642-643.

25 *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171 at 181 per Gibbs CJ; the definitions of "literary work" and "writing" in s 10(1) of the Act.

26 A feature of a work, such as the "selection" or "arrangement" of its components, is capable of constituting a part of the work which has been reproduced and which is substantial: *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/as Washington DC)* [2000] 1 WLR 2416 at 2422 per Lord Hoffmann; [2001] 1 All ER 700 at 706. See, eg, *MacMillan & Co Ltd v K & J Cooper* (1923) 93 LJPC 113 at 119 per Lord Atkinson (selection); *Ladbroke* [1964] 1 WLR 273 at 276-278 per Lord Reid, 282-283 per Lord Evershed, 286, 288 per Lord Hodson, 289 per Lord Devlin, 292 per Lord Pearce; [1964] 1 All ER 465 at 469-470, 473, 475-476, 477, 478, 480 (arrangement).

monopolies²⁷, does not confer a monopoly on facts or information because to do so would impede the reading public's access to and use of facts and information. Copyright is not given to reward work distinct from the production of a particular form of expression²⁸.

- 29 These concepts are relevant to the determination, called for by the Act, of whether a part reproduced is a "substantial part" of a work in which copyright subsists.

Substantial part

- 30 So as to indicate that the time and title information alleged to have been reproduced did not form a large part of a Weekly Schedule, the primary judge referred to the copying of "slivers of information"²⁹. However, in order to assess whether material copied is a substantial part of an original literary work, it is necessary to consider not only the extent of what is copied: the quality of what is copied is critical³⁰.

27 See, eg, Coke, 3 *Inst* at 181: "monopolies are against the ancient and fundamental laws of the realm". See generally Heydon, *The Restraint of Trade Doctrine*, 3rd ed (2008), ch 1.

28 "[I]t is the product of the labour, skill and capital of one man which must not be appropriated by another, not the elements, the raw material ... upon which the labour and skill and capital of the first have been expended": *MacMillan & Co Ltd v K & J Cooper* (1923) 93 LJPC 113 at 117-118 per Lord Atkinson.

29 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2007) 73 IPR 99 at 143 [190], 144 [193], 148-149 [211], 156 [249].

30 *Ladbroke* [1964] 1 WLR 273 at 276 per Lord Reid, 288 per Lord Hodson, 293 per Lord Pearce; [1964] 1 All ER 465 at 469, 477, 481; *S W Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466 at 474 per Gibbs CJ; [1985] HCA 59; *Autodesk Inc v Dyason [No 2]* (1993) 176 CLR 300 at 305 per Mason CJ (in dissent); [1993] HCA 6 ("*Autodesk [No 2]*"); *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1 at 32-33 [83]-[84] per Gleeson CJ, McHugh, Gummow and Hayne JJ; [1999] HCA 49 ("*Data Access*"). Quality is also critical for works other than literary works: see, eg, *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/as Washington DC)* [2000] 1 WLR 2416; [2001] 1 All ER 700 (artistic work); *Hawkes & Son (London) Ltd v Paramount Film Service Ltd* ("the *Colonel Bogey Case*") [1934] Ch 593 (musical work).

31 This principle has a long provenance³¹ and it is particularly apposite when considering a compilation. Some compilations are no more than a selection or arrangement of facts or information already in the public domain. When the particular form of expression contains facts and information, it is not helpful to refer to "the rough practical test that what is worth copying is prima facie worth protecting"³². To take an example, facts are obviously worth copying for purposes such as a narrative work of history which depends on secondary sources³³. It is equally unhelpful to refer to the "commercial value" of the information, because that directs attention to the information itself rather than to the particular form of expression.

32 It is often said that questions of whether a substantial part has been copied are questions of fact and degree³⁴. However, a factor critical to the assessment of the quality of what is copied is the "originality" of the part which is copied³⁵.

31 The principle goes back to the nineteenth century: see, eg, *Scott v Stanford* (1867) LR 3 Eq 718 at 723, 724 per Page Wood VC; *Bradbury v Hotten* (1872) LR 8 Exch 1 at 7 per Pigott B; *Trade Auxiliary Co v Middlesborough and District Tradesmen's Protection Association* (1888) 40 Ch D 425 at 429 per Chitty J; *Leslie v Young & Sons* [1894] AC 335 at 341 per Lord Herschell LC; *Cooper v Stephens* [1895] 1 Ch 567 at 572 per Romer J. However, as the "substantial part" test was expressly introduced for the first time only with the passage of the *Copyright Act 1911* (Imp), the actual focus of the nineteenth century cases was not on this point: see further Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 383 [7-26].

32 *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 610 per Peterson J, discussed in *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 218 CLR 273 at 281-282 [14]-[17] per McHugh ACJ, Gummow and Hayne JJ; [2004] HCA 14. See also *Baigent v Random House Group Ltd* (2007) 72 IPR 195 at 222 [97] per Lloyd LJ. Though Peterson J's statement was made in the context of his discussion of the subsistence of copyright, it has subsequently been applied as a test of substantiality in the context of infringement: see, eg, *Ladbroke* [1964] 1 WLR 273 at 279 per Lord Reid, 288 per Lord Hodson, 293-294 per Lord Pearce; [1964] 1 All ER 465 at 471, 477-478, 481.

33 For example, John Julius Norwich, *A History of Venice*, (1982).

34 See, eg, *Ladbroke* [1964] 1 WLR 273 at 283 per Lord Evershed; [1964] 1 All ER 465 at 473.

35 *Autodesk [No 2]* (1993) 176 CLR 300 at 305 per Mason CJ (in dissent); *Data Access* (1999) 202 CLR 1 at 32-33 [83]-[84] per Gleeson CJ, McHugh, Gummow
(Footnote continues on next page)

Originality in the context of subsistence of copyright

33

The requirement for copyright subsistence that a literary work be "original" was first introduced into the *Copyright Act 1911* (Imp)³⁶, although it had already been recognised at common law³⁷. Originality for this purpose requires that the literary work in question *originated* with the author and that it was not merely copied from another work³⁸. It is the author or joint authors who bring into existence the work protected by the Act. In that context, originality means that the creation (ie the production) of the work required some independent intellectual effort³⁹, but neither literary merit⁴⁰ nor novelty or inventiveness as required in patent law⁴¹.

and Hayne JJ. See also *Newspaper Licensing Agency Ltd v Marks & Spencer plc* [2003] 1 AC 551 at 559-560 [19] per Lord Hoffmann.

36 Section 1(1), applied in Australia pursuant to the *Copyright Act 1912* (Cth). Now see the Act, s 32(1).

37 *Walter v Lane* [1900] AC 539, discussed in *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49; [1917] HCA 14.

38 *Robinson v Sands & McDougall Pty Ltd* (1916) 22 CLR 124 at 132-133 per Barton J; [1916] HCA 51; *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 at 52 per Isaacs J; *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479 at 511 per Dixon J; *Autodesk Inc v Dyason* (1992) 173 CLR 330 at 347 per Dawson J; [1992] HCA 2; *Data Access* (1999) 202 CLR 1 at 16 [22], 41 [122] per Gleeson CJ, McHugh, Gummow and Hayne JJ. See also the classic statement in *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 608-609 per Peterson J. This approach was recently confirmed by the English Court of Appeal in *Sawkins v Hyperion Records Ltd* [2005] 1 WLR 3281; [2005] 3 All ER 636.

39 *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 at 52 per Isaacs J.

40 *Littlewoods* [1959] Ch 637 at 651 per Upjohn J.

41 *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 608-609 per Peterson J; *Interlego AG v Croner Trading Pty Ltd* (1992) 39 FCR 348 at 379 per Gummow J.

13.

34 There has been a long held assumption in copyright law that "authorship" and "original work" are correlatives⁴²; the legislation does not impose double conditions⁴³.

Originality in the context of infringement

35 In this appeal, the question of "originality" arises not in the context of subsistence, but in the context of infringement, in particular the determination of the quality of the part of the Weekly Schedules (or the Nine Database) alleged to have been reproduced.

36 A Weekly Schedule (and the Nine Database) contains both "information" and "creative" material⁴⁴. The material may have been confidential before being provided to the Aggregators or released to the public. For the purposes of copyright law, that confidentiality does not matter⁴⁵. In terms of the distinction between information and creative material, the time and title information is information about Nine's intended future conduct. It is, however, contained within a whole, a collocation (ie the Weekly Schedule or the Nine Database), which also contains creative material such as the synopses of programmes to be broadcast.

37 In *Ladbroke (Football) Ltd v William Hill (Football) Ltd* ("*Ladbroke*")⁴⁶, Lord Pearce spoke of the situation where reproduction of an unoriginal part of an original whole will not be an infringement when he said:

42 *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 at 55 per Isaacs J.

43 *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 608 per Peterson J.

44 A distinction between works intended to convey "information" and works of "literary enjoyment" is drawn in *Hollinrake v Truswell* [1894] 3 Ch 420 at 428 per Davey LJ. The distinction was referred to in *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171 at 182 per Gibbs CJ, 192 per Mason and Wilson JJ, 201 per Brennan J.

45 *Littlewoods* [1959] Ch 637 at 651-652 per Upjohn J.

46 [1964] 1 WLR 273 at 293; [1964] 1 All ER 465 at 481. The statement of Lord Pearce has been approved by this Court: *Autodesk [No 2]* (1993) 176 CLR 300 at 305 per Mason CJ (in dissent); *Data Access* (1999) 202 CLR 1 at 32-33 [83]-[84] per Gleeson CJ, McHugh, Gummow and Hayne JJ.

"The reproduction of a part which by itself has no originality will not normally be a substantial part of the copyright and therefore will not be protected. For that which would not attract copyright except by reason of its collocation will, when robbed of that collocation, not be a substantial part of the copyright and therefore the courts will not hold its reproduction to be an infringement." (emphasis added)

This means that where the part reproduced did not originate with the author, so that the author would not have copyright in the part standing alone, the part reproduced will not be a substantial part⁴⁷. Here, however, the predetermination of future broadcasts was done by employees of Nine, at least some of whom may be the authors of the works in suit. For that reason, it cannot be said that the part reproduced did not originate with the author or authors of the works in suit.

38 However, the fact that a part reproduced originates from the author (as here) does not, of itself, mean that it is necessarily a substantial part of the whole work⁴⁸. Originality in the context of infringement has a broader aspect. The point was pursued in *Autodesk v Dyason [No 2]* ("*Autodesk [No 2]*")⁴⁹ and *Data Access Corporation v Powerflex Services Pty Ltd* ("*Data Access*")⁵⁰. In *Autodesk [No 2]*, though the whole of a computer program originated from the author⁵¹, Mason CJ (in dissent) considered that reproducing part of the program containing data may not be reproduction of a substantial part because it⁵²:

"may conceivably be akin to the reproduction of the material simpliciter in a table or compilation or the reproduction of something that is itself largely unoriginal" (footnote omitted).

47 See, eg, *Cambridge University Press v University Tutorial Press* (1928) 45 RPC 335 at 343-344 per Maugham J; *Warwick Film Productions Ltd v Eisinger* [1969] 1 Ch 508 at 525ff, esp 533-534 per Plowman J. See also *Baigent v Random House Group Ltd* (2007) 72 IPR 195 at 230 [142] per Mummery LJ.

48 *Data Access* (1999) 202 CLR 1 at 31 [80] per Gleeson CJ, McHugh, Gummow and Hayne JJ.

49 (1993) 176 CLR 300.

50 (1999) 202 CLR 1.

51 *Autodesk Inc v Dyason* (1992) 173 CLR 330 at 347 per Dawson J.

52 *Autodesk [No 2]* (1993) 176 CLR 300 at 306.

39 In *Data Access*, Gleeson CJ, McHugh, Gummow and Hayne JJ approved Mason CJ's view and said that, in the case of a computer program, "the originality of what was allegedly taken from a computer program must be assessed with respect to the originality with which it expresses [the] algorithmic or logical relationship [between the function desired to be performed by a device and the device] or part thereof"⁵³ and its "inherent originality"⁵⁴. Their Honours concluded that the "Reserved Words" under consideration, which were user inputs associated in the program with certain functions, were not a substantial part of the computer program. This was, first, because the Reserved Words were "irrelevant to the structure, choice of commands and combination and sequencing of the commands in source code"⁵⁵. Secondly, since the Reserved Words consisted of ordinary English words suggestive of their function or words common in other computer languages (or combinations thereof), "they d[id] not possess sufficient originality as data to constitute a substantial part of the computer program"⁵⁶.

40 These cases direct attention to the degree of originality in the *expression* of the part of the work reproduced. The same point is made in the current edition of *Copinger and Skone James on Copyright*⁵⁷:

"[T]he more simple or lacking in substantial originality the copyright work, the greater the degree of taking will be needed before the substantial part test is satisfied."

53 *Data Access* (1999) 202 CLR 1 at 33 [85].

54 *Data Access* (1999) 202 CLR 1 at 33-34 [87].

55 *Data Access* (1999) 202 CLR 1 at 34 [88].

56 *Data Access* (1999) 202 CLR 1 at 34 [92].

57 Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 385 [7-27(d)]; see also at 385 [7-27(c)]. See, eg, *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99 at 102-104, as explained in *British Leyland Motor Corporation Ltd v Armstrong Patents Co Ltd* (1984) 3 IPR 32 at 45 per Oliver LJ; *Dixon Investments Pty Ltd v Hall* (1990) 18 IPR 490 at 496 per Lockhart, Spender and Ryan JJ; *Ibcos Computers Ltd v Barclays Mercantile Highland Finance Ltd* (1994) 29 IPR 25 at 38 per Jacob J; *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/as Washington DC)* [2000] 1 WLR 2416 at 2423 per Lord Hoffmann; [2001] 1 All ER 700 at 706.

41 The Weekly Schedule (and the Nine Database) as a whole involves orderly arrangement of its various elements and the evidence showed choices were made about what programmes were included or excluded. As a whole, it is an original (ie not copied) collocation of both information and creative material.

42 However, the expression of the time and title information, in respect of each programme, is not a form of expression which requires particular mental effort or exertion. The way in which the information can be conveyed is very limited⁵⁸. Expressing a title of a programme to be broadcast merely requires knowledge of the title, generally bestowed by the producer of the programme rather than by a broadcaster of it. Expressing the time at which a programme is broadcast, for public consumption, can only practically be done in words or figures relating to a 12 or 24-hour time cycle for a day. The authors of the Weekly Schedule (or the Nine Database) had little, if any, choice in the particular form of expression adopted, as that expression was essentially dictated by the nature of the information. That expression lacks the requisite originality (in the sense explained) for the part to constitute a substantial part.

43 Counsel for Nine sought to place importance upon the reproduction not only of time and title information in respect of each programme, but also of the chronological arrangement of the time and title information for various programmes. Whether a selection or arrangement of elements constitutes a substantial part of a work depends on the degree of originality of that selection or arrangement⁵⁹. In this case, a chronological arrangement of times at which programmes will be broadcast is obvious and prosaic, and plainly lacks the requisite originality.

44 These considerations lead to the conclusion that the part of the Weekly Schedule (or the Nine Database) alleged to have been reproduced was not a substantial part. Something must be said, then, of the relevance of "skill and labour" to this question and how it may lead to error.

58 See, eg, *FAI Insurances Ltd v Advance Bank Australia Ltd* (1986) 68 ALR 133 at 141 per Pincus J.

59 See, eg, *Ravenscroft v Herbert* [1980] RPC 193 at 204-205 per Brightman J. See also, albeit in the context of subsistence, the comments in *MacMillan & Co Ltd v K & J Cooper* (1923) 93 LJPC 113 at 117 per Lord Atkinson.

Skill and labour in the context of subsistence

45 Not every piece of printing or writing which conveys information will be subject to copyright. For a long time, and precisely because compilations often contain facts, it has been commonplace to enquire what skill and labour was required in the preparation of a compilation⁶⁰. That question has arisen in the context of considering whether copyright subsists at all in a compilation as well as being relevant to a later inquiry as to the "quality" of any material taken from a copyrighted work.

46 In *Feist Publications Inc v Rural Telephone Service Co Inc*⁶¹ the Supreme Court of the United States considered the compatibility of two propositions: first, that compilations of facts are generally copyrightable, and secondly, that facts were not copyrightable. This case involves the same tension between those two propositions. "Originality" was a constitutional requirement that was the source of Congress's power to "secur[e] for limited Times to Authors ... the exclusive Right to their respective Writings"⁶². It was recognised, however, that copyright in a factual compilation is necessarily "thin"⁶³ because the standard for originality should not be such that copyright owners have a monopoly on facts or information. Ultimately the decision turned in a significant degree on the view that "[t]he primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.'"⁶⁴ The exclusion of

60 See, eg, *MacMillan & Co Ltd v K & J Cooper* (1923) 93 LJPC 113 at 117-118, 121 per Lord Atkinson; *G A Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329 at 335 per Viscount Simon LC; *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171 at 182-183 per Gibbs CJ; *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 260-261 per Lord Oliver of Aylmerton.

61 499 US 340 (1991).

62 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 at 346 (1991) per O'Connor J, quoting the Constitution of the United States of America, Art I, §8, cl 8.

63 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 at 349 (1991) per O'Connor J.

64 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 at 349 (1991) per O'Connor J, quoting the Constitution of the United States of America, Art I, §8, cl 8.

ideas and information from copyright protection has been codified in the United States⁶⁵.

47 Much has been written about differing standards of originality in the context of the degree or kind of "skill and labour" said to be required before a work can be considered an "original" work in which copyright will subsist⁶⁶. "Industrious collection" or "sweat of the brow", on the one hand, and "creativity", on the other, have been treated as antinomies in some sort of mutually exclusive relationship in the mental processes of an author or joint authors. They are, however, kindred aspects of a mental process which produces an object, a literary work, a particular form of expression which copyright protects. A complex compilation or a narrative history will almost certainly require considerable skill and labour, which involve both "industrious collection" and "creativity", in the sense of requiring original productive thought to produce the expression, including selection and arrangement, of the material⁶⁷.

48 It may be that too much has been made, in the context of subsistence, of the kind of skill and labour which must be expended by an author for a work to be an "original" work. The requirement of the Act is only that the work originates with an author or joint authors from some independent intellectual effort. Be that as it may, as noted previously, since the subsistence of copyright need not be considered in this appeal, the relevance of skill and labour to that inquiry need not be considered further.

Skill and labour in the context of infringement

49 In the context of infringement, in particular the determination of whether a part reproduced is a "substantial part", a matter often referred to is whether there

65 *Copyright Act 1976 (US)*, §102(b), codified as 17 USC §102(b):

"In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."

See *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 at 354-356 (1991) per O'Connor J.

66 See the articles cited in footnote 21.

67 This does not mean creative in the literary sense, or novel or inventive.

has been an "appropriation" of the author's skill and labour⁶⁸. As already noted, both the primary judge and the Full Court adopted that approach in this case. However, it is always necessary to focus on the nature of the skill and labour, and in particular to ask whether it is directed to the originality of the particular form of expression⁶⁹.

50 Nine relied on *British Broadcasting Co v Wireless League Gazette Publishing Co* ("Wireless")⁷⁰, *Football League Ltd v Littlewoods Pools Ltd* ("Littlewoods")⁷¹, *Ladbroke*⁷² and *Independent Television Publications Ltd v Time Out Ltd* ("Time Out")⁷³ for the proposition that it does not matter if the skill and labour is directed to matters other than a particular form of expression for the purposes of assessing the substantiality of the part reproduced.

51 However, in *Wireless*, there was no real analysis of the question of infringement, which appears to have been treated as bound up with a "fair dealing" defence abandoned by the defendant⁷⁴. In *Littlewoods*, importance was attached to the reproduction of not only the information, but also its arrangement,

68 See, eg, *Ladbroke* [1964] 1 WLR 273 at 288 per Lord Hodson; [1964] 1 All ER 465 at 477; *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/as Washington DC)* [2000] 1 WLR 2416 at 2431 per Lord Scott of Foscote; [2001] 1 All ER 700 at 714.

69 "The essence of literary copyright is proprietary protection (in the form of exclusive rights to do acts restricted by the copyright in the work) for a literary work in recognition of the investment of effort, time and skill *in reducing it into material form*, such as words, signs and symbols" (emphasis added): *Baigent v Random House Group Ltd* (2007) 72 IPR 195 at 230 [141] per Mummery LJ, see also at 232 [155]-[156] per Mummery LJ. See also *Bowater Windows Ltd v Aspen Windows Ltd* [1999] FSR 759 at 781-782 per Rimer J; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] FSR 121 at 131 [20] per Morritt LJ; Garnett, Davies and Harbottle, *Copinger and Skone James on Copyright*, 15th ed (2005), vol 1 at 29 [2-06].

70 [1926] Ch 433.

71 [1959] Ch 637.

72 [1964] 1 WLR 273; [1964] 1 All ER 465.

73 [1984] FSR 64.

74 [1926] Ch 433 at 443 per Astbury J.

and to the fact that essentially the whole of the work in suit had been reproduced⁷⁵. In *Ladbroke*, Lord Evershed expressly rested his decision as to infringement upon the aspects of expression of the betting coupon in question, not the skill and labour in deciding what bets to offer⁷⁶. The other members of the House of Lords (except for Lord Devlin, who did not discuss infringement) relied on the aphorism, referred to above, that "what is worth copying is prima facie worth protecting"⁷⁷; but it is significant that the reproduction was more extensive than in this case and included reproduction of aspects of arrangement. In *Time Out*, appropriation of skill and labour was not mentioned in the context of infringement. The focus was instead on the commercial value of the information alleged to have been reproduced from the broadcasting schedule in question, in that it concerned peak viewing times and omitted references to programmes which would be known by viewers to be broadcast at fixed times⁷⁸. With respect, that focus was upon the information itself, rather than the particular form in which it was expressed.

52 Rewarding skill and labour in respect of compilations without any real consideration of the productive effort directed to coming up with a particular form of expression of information can lead to error⁷⁹. The error is of a kind which might enable copyright law to be employed to achieve anti-competitive behaviour of a sort not contemplated by the balance struck in the Act between the rights of authors and the entitlements of the reading public⁸⁰. The Act mandates an inquiry into the substantiality of the part of the work which is reproduced. A critical question is the degree of originality of the particular form of expression of the part. Consideration of the skill and labour expended by the author of a work may assist in addressing that question: that the creation of a work required skill and labour may indicate that the particular form of expression adopted was

75 [1959] Ch 637 at 657 per Upjohn J.

76 [1964] 1 WLR 273 at 283-284; [1964] 1 All ER 465 at 473-474.

77 [1964] 1 WLR 273 at 279 per Lord Reid, 288 per Lord Hodson, 293-294 per Lord Pearce; [1964] 1 All ER 465 at 471, 477-478, 481.

78 [1984] FSR 64 at 73-74 per Whitford J.

79 See also *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 223 per Buckley LJ, quoted in *S W Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466 at 483 per Wilson J, 494 per Deane J; *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 265 per Lord Oliver.

80 *Skybase Nominees Pty Ltd v Fortuity Pty Ltd* (1996) 36 IPR 529 at 531 per Hill J.

highly original. However, focussing on the "appropriation" of the author's skill and labour must not be allowed to distract from the inquiry mandated by the Act. To put aside the particular form of expression can cause difficulties, as evidenced by *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd*⁸¹.

53 It is not seriously in dispute that skill and labour was expended on producing the Weekly Schedules (and the Nine Database). The evidence disclosed considerable skill and labour involved in programming decisions. There was a contest about whether it mattered if some of the skill and labour expended was directed to business considerations⁸². Plainly, the skill and labour was highly relevant to matters such as advertising revenue. It is not difficult to understand that questions of the timing of particular broadcasts are crucial for advertising revenues. The fact that business considerations inform the decision to adopt a particular form of expression will not necessarily detract from the originality of that form of expression.

54 However, the critical question is whether skill and labour was directed to the particular form of expression of the time and title information, including its chronological arrangement. The skill and labour devoted by Nine's employees to programming decisions was not directed to the originality of the particular form of expression of the time and title information. The level of skill and labour required to express the time and title information was minimal⁸³. That is not surprising, given that, as explained above, the particular form of expression of the time and title information is essentially dictated by the nature of that information.

Animus furandi

55 In the light of these reasons, it is not necessary to consider the relevance of any *animus furandi* on the part of IceTV or IceTV Holdings⁸⁴.

81 (2002) 119 FCR 491 at 547-554 [218]-[254] per Lindgren J, 600-601 [437]-[446] per Sackville J.

82 *Ladbroke* [1964] 1 WLR 273 at 290 per Lord Devlin; [1964] 1 All ER 465 at 478-479.

83 See also *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14 at 41 [111] per Black CJ, Lindgren and Sackville JJ ("extremely modest").

84 Reasons of Gummow, Hayne and Heydon JJ at [171]ff. Cf *Baigent v Random House Group Ltd* (2007) 72 IPR 195 at 222 [95]-[97] per Lloyd LJ; Garnett, (Footnote continues on next page)

French CJ
Crennan J
Kiefel J

22.

Conclusion

56 Any reproduction of the time and title information in the IceGuide was not a reproduction of a substantial part of any of the Weekly Schedules (or the Nine Database). We agree with the orders proposed by Gummow, Hayne and Heydon JJ.

57 GUMMOW, HAYNE AND HEYDON JJ. These reasons in favour of allowing the appeal are organised as follows:

Introduction	[58]-[64]
The construction of Pt III of the Act	[65]-[71]
Compilations and "substantial part"	[72]-[76]
The Spicer Committee	[77]-[78]
The transition to digital television	[79]-[83]
The IceGuide	[84]-[90]
The litigation	[91]-[94]
Authorship and material form	[95]-[106]
The pleadings and the evidence	[107]-[121]
The holdings of the primary judge and the Full Court	[122]-[129]
Misappropriation of skill and labour "of Nine"	[130]-[134]
The EU Database Directive	[135]-[139]
The submissions on "substantial part"	[140]-[153]
Treatment of "substantial part" by the Full Court	[154]-[171]
"Prediction" of time and title information	[172]-[184]
Conclusions	[185]-[188]
Orders	[189]

Introduction

58 The commercial interest which has given rise to this appeal is the control sought by the respondent ("Nine") over the use of the programme schedules for television transmissions by its network ("the Nine Network"). The appellants (together "Ice") challenge the decision on 8 May 2008 of the Full Court of the Federal Court (Black CJ, Lindgren and Sackville JJ)⁸⁵ that there has been reproduction of a "substantial part" of original literary works in which copyright subsisted under the *Copyright Act* 1968 (Cth) ("the Act"). These works were compilations represented by the television programme schedules for the Nine Network. The "substantial part" was the programme title, date and time of broadcast, including the episode title where relevant ("time and title information").

59 The primary judge (Bennett J) dismissed the action brought by Nine⁸⁶ and so made no finding as to whether the second appellant ("Ice Holdings") was jointly liable for any infringement by the first appellant ("IceTV"). In a

85 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14.

86 *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2007) 73 IPR 99.

supplementary judgment⁸⁷ delivered on 20 August 2008 the Full Court indicated that among the issues remitted to the primary judge was that of infringement by Ice Holdings.

60 This Court granted leave to Telstra Corporation Limited and to Australian Digital Alliance Limited ("the Digital Alliance") to appear each as amicus curiae.

61 Ice seeks the reinstatement of its success at first instance in the Federal Court. Bennett J held that there had been no reproduction of a substantial part of the compilations. For the reasons which follow, her Honour reached the correct result and her decision should not have been set aside in the Full Court.

62 A critical passage in the reasoning of the Full Court appears under the heading "Principles"⁸⁸. This includes two propositions as follows. The first is that "[t]he quality of what is taken must be assessed by reference to the interest protected by the copyright". The second is that "[i]n the case of a literary work, including a compilation, the quality relevant for the purpose of substantiality is the literary originality of what has been copied". Both propositions draw upon the speech of Lord Hoffmann in a case decided under the *Copyright, Designs and Patents Act 1988* (UK) ("the 1988 UK Act"), *Newspaper Licensing Agency Ltd v Marks & Spencer plc*⁸⁹, although, with respect to the first proposition, Lord Hoffmann relied⁹⁰ upon what had been said by Sackville J in *Nationwide News Pty Ltd v Copyright Agency Ltd*⁹¹.

63 Ice submits that, if an "interest analysis" be adopted, then the "interest" protected by the copyright in the Nine programme schedules lies in the particular form of their final expression rather than, as the Full Court indicated⁹², in large measure in antecedent or preparatory work to fix programming schedules. Ice contends that the Full Court thus adopted an inappropriate focus for determination of the issue of reproduction of a "substantial part" of the schedules.

87 *Nine Network Australia Pty Ltd v IceTV Pty Ltd (No 2)* [2008] FCAFC 154.

88 (2008) 168 FCR 14 at 36-37.

89 [2003] 1 AC 551 at 559-561.

90 [2003] 1 AC 551 at 561.

91 (1996) 65 FCR 399 at 418.

92 (2008) 168 FCR 14 at 37.

64 It will be necessary to consider later in these reasons the correctness and utility of the two propositions drawn from *Newspaper Licensing*. At this stage it is sufficient to indicate that the criticism by Ice of the reasoning of the Full Court is well based and to turn to the relevant provisions of the Act.

The construction of Pt III of the Act

65 Part III (ss 31-83) of the Act provides for the subsistence of copyright in "works", including "literary works", which are "original". Copyright is "personal property" (s 196(1)). Subject to the provisions of s 196, copyright is transmissible by assignment, by will and by devolution by operation of law. Copyright in the case of a literary work includes the exclusive right to reproduce the work in a material form (s 31(1)(a)(i)). This is to be read as including reproduction of "a substantial part of the work" (s 14(1)(a)). Copyright in a literary work is infringed by a person who, not being the owner and not having the licence of the owner, does in Australia, or authorises the doing in Australia of, any act comprised in the copyright (s 36(1)).

66 The term "literary work" includes a "compilation, expressed in words, figures or symbols" (s 10(1)). The statutory forerunner of the definition in the Act of "literary work" was found in s 35(1) of the *Copyright Act 1911* (Imp) ("the 1911 Act"). This also included "compilations", but the 1911 Act descended no further into detail. On the other hand, the separate definition of "compilation" in §101 of the United States *Copyright Act* of 1976⁹³ speaks of:

"a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship".

The Congress enacted that provision to make it plain that the requirement of originality applies "with full force" to works "containing preexisting material"⁹⁴. In Canada, a "compilation" is relevantly defined as "a work resulting from the selection or arrangement of literary ... works or of parts thereof" and as "a work resulting from the selection or arrangement of data"⁹⁵.

93 17 USC, ch 1.

94 See *Feist Publications, Inc v Rural Telephone Service Co, Inc* 499 US 340 at 357 (1991).

95 *Copyright Act* RSC 1985, ch C-42, s 2.

67 The development of the law in the United States was much influenced by the judgment of Story J in *Emerson v Davies*⁹⁶ and reference was made to it by Isaacs J in *Sands & McDougall Pty Ltd v Robinson*⁹⁷. Story J, perhaps oddly to the modern reader, drew from analogies in patent law. He likened the inventor of a new combination of old integers to the author of a compilation drawn from existing works by the employment of research and skill, and the copyright infringer whose unauthorised taking was "substantial" to the patent infringer who took by "subterfuge" what later would be called the "pith and marrow" of the invention⁹⁸.

68 The present significance of *Emerson* lies not in an immediate analogy between contemporary copyright and patent law. Rather, the detailed reasons given by Story J direct attention to the competing interests involved in the conferral by intellectual property laws of rights of statutory monopoly, and the imprecision of criteria devised by legislatures to strike a balance between those competing interests.

69 That imprecision is apparent not only in the terms "compilation" and "substantial part", but extends to what have been seen in the case law as the conceptual underpinnings of the protection by the Act of original literary, dramatic, musical and artistic works. The importance attached in the nineteenth century to the protection by injunction of legal rights, provided they were proprietary in nature⁹⁹, encouraged the treatment by the courts of copyright as the reward for productive labour; hence the use in some of the cases of the agricultural metaphor of sowing and reaping. That metaphor also relieved the courts from the perceived hazards involved in adjudicating upon aesthetic qualities of literary and other works. (But there remained the difficulties associated with the expression "a work of artistic craftsmanship"¹⁰⁰.)

96 8 Fed Cas 615 (1845).

97 (1917) 23 CLR 49 at 56; [1917] HCA 14.

98 See *Commonwealth Industrial Gases Ltd v MWA Holdings Pty Ltd* (1970) 180 CLR 160 at 167-168; [1970] HCA 38.

99 See, eg, *Edelsten v Edelsten* (1863) 1 De G J & S 185 at 199-200 [46 ER 72 at 78].

100 *Burge v Swarbrick* (2007) 232 CLR 336; [2007] HCA 17.

70 The agricultural metaphor is still encountered in the case law. For example, in *Designers Guild Ltd v Russell Williams (Textiles) Ltd*¹⁰¹ Lord Bingham of Cornhill said:

"The law of copyright rests on a very clear principle: that anyone who by his or her own skill and labour creates an original work of whatever character shall, for a limited period, enjoy an exclusive right to copy that work. No one else may for a season reap what the copyright owner has sown."

But, as Morritt LJ had emphasised when that litigation had been in the English Court of Appeal¹⁰²:

"the object of the law of copyright is to protect the product of the skill and labour of the maker not to confer on him a monopoly in the idea it may express".

Further, Morritt LJ stressed, and, with respect, properly so, that this latter consideration is important when determining whether a "substantial part" of a work has been reproduced by a defendant. That consideration also is important in resisting the deceptive simplicity of the formula repeated by Lord Reid in *Ladbroke (Football) Ltd v William Hill (Football) Ltd*¹⁰³ that "what is worth copying is prima facie worth protecting"¹⁰⁴. However, as will appear later in these reasons, the rhetoric of "misappropriation" appears to have influenced the outcome in the Full Court¹⁰⁵.

71 A safer, if necessarily incomplete, guide when construing Pt III of the Act is the proposition that the purpose of a copyright law respecting original works is to balance the public interest in promoting the encouragement of "literary", "dramatic", "musical" and "artistic works", as defined, by providing a just reward

101 [2000] 1 WLR 2416 at 2418; [2001] 1 All ER 700 at 701.

102 *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] FSR 121 at 131.

103 [1964] 1 WLR 273 at 279; [1964] 1 All ER 465 at 471.

104 *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 at 610.

105 See [130]-[134].

for the creator, with the public interest in maintaining a robust public domain in which further works are produced¹⁰⁶.

Compilations and "substantial part"

72 As in Australia the statutory texts in the United Kingdom with respect to the protection of a "compilation" are sparse. This led Diplock LJ to say¹⁰⁷:

"The derivation of 'compile' is from the Latin 'compilatio' or plunder, and, following the *Shorter Oxford Dictionary*, I should regard its natural meaning as being to gather together material from various sources, and a 'compilation' as a product of such an activity." (italics added)

73 The 1911 Act was preceded by the Berne Convention for the Protection of Literary and Artistic Works of 1886 ("the Berne Convention"). One of the three "strong" and "urgent" reasons advanced to the House of Commons by the President of the Board of Trade¹⁰⁸ for the adoption of the 1911 Act was the need to bring domestic law into harmony with recent changes to the Berne Convention¹⁰⁹. Upon its revision in 1908¹¹⁰ the Berne Convention now spoke of affording protection to "collections of different works" (Art 2(2)) and, following further revision in 1948¹¹¹:

"[c]ollections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations".

106 See the remarks of McLachlin CJ in *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339 at 355-356.

107 *William Hill (Football) Ltd v Ladbroke (Football) Ltd* [1980] RPC 539 at 550. The case was decided in 1962.

108 Mr S C Buxton, later Earl Buxton.

109 United Kingdom, House of Commons, *Parliamentary Debates*, 5th series, vol 23, 7 April 1911 at 2587-2593. The other two reasons given were the need to replace some 22 statutes beginning in 1735, and to achieve uniformity throughout the Empire.

110 By the Berlin Act, Art 2(2).

111 By the Brussels Act, Art 2. This is now reflected in the terms of Art 2(5) of the Berne Convention.

The phrase "intellectual creations" may be compared with the distinction drawn by Barton J in *Robinson v Sands & McDougall Pty Ltd*¹¹² between the "intellectual work" and the "manual work" involved in compiling the map in dispute in that case. The emphasis in the Berne Convention on "selection and arrangement" is preserved in Art 10(2) of the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights, which provides:

"Compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself."

74 The United Kingdom authorities concerning compilations which preceded the 1911 Act¹¹³ had followed upon the enactment of the *Copyright Act* 1842 (Imp)¹¹⁴. In *Leslie v Young & Sons*¹¹⁵, the House of Lords accepted that information derived from timetables issued to the public by railway companies, and selected, condensed, and arranged "in a compilation or abstract involving independent labour", could be entitled to protection; a subsequent compiler of objects of information had to set about doing what the first compiler had done.

75 The notion of substantial appropriation as sufficient to constitute infringement is found also in the pre-1911 case law¹¹⁶. It is illustrated by the statement of Lord Herschell LC in *Leslie v Young & Sons*¹¹⁷:

112 (1916) 22 CLR 124 at 129; [1916] HCA 51.

113 See *Halsbury's Laws of England*, 1st ed (1909), vol 8 at 145-146 [353].

114 5 & 6 Vict, c 45. This defined (in s 2) "Copyright" as including "the sole and exclusive Liberty of printing or otherwise multiplying Copies" of any "Book"; and "Book" included "every Volume, Part or Division of a Volume, Pamphlet, Sheet of Letterpress, Sheet of Music, Map, Chart, or Plan separately published".

115 [1894] AC 335.

116 *Bradbury v Hotten* (1872) LR 8 Exch 1 at 7; *Cooper v Stephens* [1895] 1 Ch 567 at 572.

117 [1894] AC 335 at 341.

"The real truth is, that although it is not to be disputed that there may be copyright in a compilation or abstract involving independent labour, yet when you come to such a subject-matter as that with which we are dealing, it ought to be clearly established that, looking at these tables as a whole, there has been a substantial appropriation by the one party of the independent labour of the other, before any proceeding on the ground of copyright can be justified."

76 The use by the Lord Chancellor of the phrases "such a subject-matter as that with which we are dealing", "clearly established", and "can be justified", set the stage for various submissions respecting the term "compilation" which were presented by Ice on this appeal and are considered later in these reasons. However, one further point concerning the provenance of the Act should be made immediately.

The Spicer Committee

77 The Act was introduced following the presentation of a report by a Committee ("the Spicer Committee") appointed by the Attorney-General of the Commonwealth¹¹⁸. With respect to the term "compilation" the Spicer Committee did not accept a submission that copyright should exist in the lists prepared by football bodies and showing the names of players and their identification numbers. In pars 483 and 484 of the Report, the Spicer Committee wrote¹¹⁹:

"It is said that the sale of football publications is the means of adding to the revenue of football clubs and the prior publication of such lists by, for example, newspapers would deprive them of the major part of such revenue. We are unable to see how copyright can be conferred merely in respect of the name of a player associated with his football number. It has been held that copyright may exist in various compilations such as an alphabetical list of railway stations, a list of fox-hounds and hunting dogs and lists of stock exchange prices and football fixtures. In all these cases the question whether copyright exists depends to a large extent on the amount of labour, capital or skill expended in making the compilation. We think that the law in this regard should not be changed.

118 Copyright Law Review Committee, *Report of the Committee Appointed by the Attorney-General of the Commonwealth to Consider what Alterations are Desirable in The Copyright Law of the Commonwealth*, (1959) ("the Report").

119 At 89.

It seems that the football clubs may have copyright in the lists they prepare as published in the various football publications¹²⁰. Such copyright, however, does not prevent a person making his own list by attending a match. In the field of copyright there is not, in our view, any way to legislate against this. Indeed, no proposal on how this could be achieved was submitted to us. We, therefore, reject the submissions in this regard."

78 This litigation is placed in a different commercial setting, where recent developments in technology are of considerable importance. But much of the area of legal debate is laid out in the above remarks by the Spicer Committee nearly 50 years ago.

The transition to digital television

79 The dispute between Nine and Ice arose against the background of change in the analogue television broadcasting system introduced in 1956. This change was given legislative force in amendments made to the *Broadcasting Services Act* 1992 (Cth) ("the Broadcasting Act") in 1998¹²¹ and concerns the mandatory transition from analogue to digital television. In the second reading speech on the Bill for the 1998 Amending Act, the Minister recorded what was said to be a commitment to ensuring that viewers be able to enjoy the benefits of digital "free to air" broadcasting. The Minister explained¹²²:

"The digital television era provides a quantum leap in television technology. Viewers will have the option of viewing high definition pictures of startling clarity and with CD quality surround sound ... Digital transmissions will enable a host of new information services, including interactive services, to be provided along with the main television programming.

...

120 See *Football League Ltd v Littlewoods Pools Ltd* [1959] Ch 637.

121 *Television Broadcasting Services (Digital Conversion) Act* 1998 (Cth) ("the 1998 Amending Act").

122 Australia, House of Representatives, *Parliamentary Debates* (Hansard), 8 April 1998 at 2830-2831.

Digital broadcasts will commence on 1 January 2001 in metropolitan areas and from that date in regional areas such that all areas have digital services by 1 January 2004 ...

Broadcasters will be required to simulcast the same programs in both the new digital channel and their current analog channel for a period of at least eight years from the commencement date."

80 Members of the Nine Network operate free to air television stations, including TCN-9 Sydney, GTV-9 Melbourne, and QTQ-9 Brisbane. They hold commercial television broadcasting licences issued under the Broadcasting Act. Stations within the Nine Network are required to transmit their signal in analogue and digital format throughout the transition period. The transition continues to be subject to legislative refinement¹²³.

81 The advantages of digital television derive from the better quality of signal; signals broadcast in digital format comprise a single, high speed bit stream of information expressed in binary code and this is both less vulnerable to electrical interference, and more efficient, than the analogue signal. Receipt of the digital signal requires the fitting of analogue televisions with a signal converter (known as a "digital set top box") or use of a fully integrated digital television or digital television compatible personal computer.

82 One significant advantage of the digital signal is that it facilitates better quality recordings of television programmes. New technologies such as "personal video recorders" ("PVRs") permit the making and storing for later viewing of near perfect reproductions of television programmes broadcast in digital signal. Recording and storage of programmes in digital format is also possible by use of digital television compatible personal computers, known as "Media Centres".

83 Digital recording technology was first made available to pay television subscribers in Australia in February 2005 under the "Foxtel IQ" brand PVR. However, the application of the technology is not limited to pay television. Other brands of PVRs and Media Centres compatible with digital free to air television are available for purchase from various retailers.

123 See, eg, *Broadcasting Services Amendment (Digital Television and Datacasting) Act 2000* (Cth).

The IceGuide

84 In April 2005 the first appellant, IceTV, introduced an "electronic program guide" ("EPG") for use in conjunction with digital recording devices and it was styled "the IceGuide". Its basic features appear in the prospectus issued by the second appellant, Ice Holdings, on 29 March 2006. This states:

"IceGuide is [a] subscription based EPG available for the majority of the population who watch digital [f]ree-to-air TV in Australia ...

IceGuide is typically used with compatible Media Centres or set-top-box based [PVRs] ... IceGuide liberates consumers from the programming schedules imposed on them by the [f]ree-to-air television networks.

The [IceGuide] is an independently compiled list of all shows on television for the upcoming week, including episode descriptions and movie synopses. IceTV editorial staff write the descriptions appearing in IceGuide for the major stations. Descriptions for programming on ABC and SBS are provided direct to [IceTV].

With IceGuide, [s]ubscribers can schedule a week's viewing in advance, enabling them to watch their favourite shows at a time that most suits them. This concept of 'time-shifting' (ie watching shows when it suits you) frees consumers from network schedules. A 30 second skip facility available on many Media Centres and [PVRs] means that viewers can watch their chosen programme avoiding other unwanted content.

Recording a programme with IceGuide is very easy with its 'point and click' design. Viewers simply use their remote control to move an on-screen cursor to their chosen programme and press 'record' ... The programme will then be recorded to an internal hard drive, making tapes and complicated timer settings a thing of the past. A library of recorded programmes is created, which allows viewing at a later date." (emphasis added)

85 The majority of the revenue of the Nine Network is currently derived from advertisements broadcast during television programmes. The commercial interest of Nine in the litigation was said by counsel to be directly related to the loss of revenue that might be occasioned by the "skipping" of advertisements. Reference also was made in submissions to the possibility of unauthorised distribution of recorded programmes on the internet. There is no allegation in the litigation that, by facilitation of the recording of television broadcasts and the skipping of advertisements, IceTV has contravened any provision of the Broadcasting Act or otherwise engaged in unlawful conduct. Nor is there any

allegation that IceTV has infringed the copyright subsisting in any television broadcast (Pt IV of the Act) or television programme (Pt III of the Act)¹²⁴.

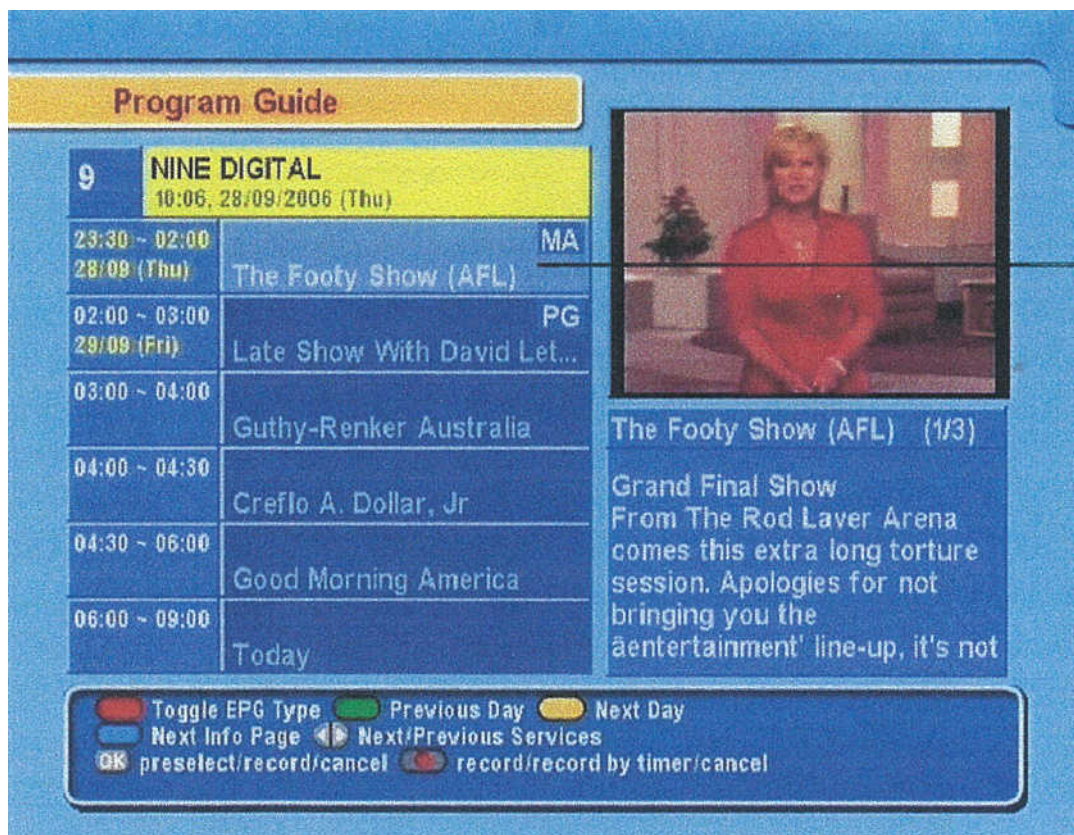
86

Rather, the dispute between Nine and Ice relates to that part of the prospectus which describes the IceGuide as an "independently compiled list of all shows on television for the upcoming week". Upon payment of a subscription fee¹²⁵, a subscriber's PVR or Media Centre can be programmed regularly to connect to the internet and download the IceGuide. Once uploaded onto the subscriber's device, the IceGuide displays on the television or computer screen information regarding the television programmes proposed to be broadcast by free to air television stations, including stations within the Nine Network, for the coming six, seven or eight days. The IceGuide display format varies depending on the brand of device used, but may be illustrated sufficiently for present purposes by reference to the display appearing with use of a "Topfield" brand PVR in "single channel" format. This appears as follows:

124 See now s 111 of the Act and also *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 218 CLR 273 at 287-288 [31]; [2004] HCA 14.

125 Subscription fees are approximately \$3 per week, \$13 per month, \$39 per quarter or \$146 per annum.

35.



Bennett J explained¹²⁶ that the display includes:

- " • Channel number (9) and channel name (NINE DIGITAL).
- Current time, date and day of the week (10:06, 28/09/2006 (Thu)).
- The current program title (*The Footy Show (AFL)*) together with start and end times (23:30–02:00) and the date and day (28/09 (Thu)).
- Start and end times for the 5 programs scheduled to be broadcast directly after the program currently screening.
- A television inset ('picture-in-picture', or 'PIP') moving image of the program currently screening on the channel."

¹²⁶ (2007) 73 IPR 99 at 122-123.

Her Honour continued¹²⁷:

"Using the Topfield PVR's remote control, the user can scroll down the boxes containing the program titles or times. As the user continues to scroll, additional boxes, containing the program title and time of successive programs proposed to be broadcast, will appear.

Underneath the 'PIP' inset is a separate blue text box containing the name of the program, sometimes an episode name (for example, *Grand Final Show*) and the synopsis ... The full synopsis can be viewed by selecting the program."

87 Programmes may be selected for recording onto a hard drive within the PVR device by highlighting a particular programme on-screen and pressing a button on the remote control. Viewers are able to view a list of recorded programmes and retrieve those programmes for viewing by further use of the remote control.

88 IceTV obtains the dates, times and titles of programmes proposed to be broadcast by the ABC and SBS from those stations for inclusion in the IceGuide. However, the approaches of IceTV towards other free to air networks for licences to obtain like information failed. In the result, for these stations, including the Nine Network, IceTV developed "templates" and software to facilitate what it calls "prediction" of the date, time and title of programmes proposed to be broadcast.

89 The process of "prediction" will be further discussed later in these reasons¹²⁸. It is founded on the proposition that the daily content of commercial broadcasters for a particular day in any given week is likely to be substantially replicated on the same day of the following week. However, IceTV checks its "predictions" against publicly available television programme guides. These have been identified as the "Aggregated Guides". They include the magazine *TV Week* and online services such as the website *YourTV Guide* ("the YourTV Guide"), and are prepared with the cooperation of Nine. Where a discrepancy appears in the time and title information as "predicted", the IceGuide generally is amended to reflect the Aggregated Guides. It is these acts, in particular, of "check and change" of time and title information that Nine seeks to prevent by reliance upon its rights under the copyright law.

¹²⁷ (2007) 73 IPR 99 at 123.

¹²⁸ See [172]-[184].

90 The Full Court held that Ice had used the time and title information of Nine, reproduced in the Aggregated Guides, as "an important resource" in producing the IceGuide and had thus reproduced a substantial part of Nine's copyright work¹²⁹.

The litigation

91 Nine alleged infringement by IceTV of copyright subsisting in television programme schedules produced by Nine for each day and week since the commencement of its operations in 1956. Five acts of infringement by IceTV were propounded at the trial. Ice Holdings was said to be jointly liable for each act of infringement. The first act of infringement was identified in the reproduction by IceTV of a "substantial part" of Nine's programme schedules in the course of making and updating each IceGuide. The litigation was conducted on the footing that unless this allegation be made out, the application should be dismissed.

92 The works in suit were identified in the amended statement of claim as "the Nine Program Schedules" and pleaded as original literary works in which copyright subsisted and was owned by Nine. By its amended defence, Ice denied infringement. However, Ice admitted Nine had prepared and distributed a "weekly television program guide" since 2001 and that each such guide was an original literary work by way of "compilation" within the meaning of the Act. This document was referred to in the reasons of the primary judge and the Full Court as "the Weekly Schedule" and was produced by Nine in "Excel" and "text" format.

93 At trial and in the Full Court, it was accepted by Ice that copyright subsisted in each Weekly Schedule and was owned by Nine. However, there was debate in this Court as to the scope of that concession and, in particular, whether it extended to matters related to the nature of the copyright subsisting in the Weekly Schedule¹³⁰.

94 It is a matter of regret that the legal issues between Nine and Ice were crystallised only in the course of oral submissions in this Court. That makes it necessary to consider the pleadings, the evidence, the findings and the general conduct of the litigation at trial, and on the intermediate appeal, more closely than is usual in a final court of appeal.

129 (2008) 168 FCR 14 at 45.

130 cf (2008) 168 FCR 14 at 30.

Authorship and material form

95 Something should be said respecting two fundamental principles of copyright law and their treatment in the course of the litigation. The concession by Ice of the subsistence of copyright in the Weekly Schedule appears to have distracted attention from the necessary part these principles must play in any resolution of the dispute between the parties.

96 The first principle concerns the significance of "authorship". The subject matter of the Act now extends well beyond the traditional categories of original works of authorship¹³¹, but the essential source of original works remains the activities of authors. While, by assignment or by other operation of law, a party other than the author may be owner of the copyright from time to time, original works emanate from authors¹³². So it was that in *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor*¹³³, Dixon J observed:

"Perhaps from the facts a presumption arises that the plaintiff company is the owner of the copyright but, as corporations must enlist human agencies to compose literary, dramatic, musical and artistic works, it cannot found its title on authorship. No proof was offered that the author or authors was or were in the employment of the company under a contract of service and that the book was compiled or written in the course of such employment."

97 Key provisions of Pt III of the Act fix on "the author". Examples include the requirement for the author of unpublished works to be a "qualified person"¹³⁴ for copyright to subsist (s 32(1)), the fixing of copyright duration by reference to

131 *Stevens v Kabushiki Kaisha Sony Computer Entertainment* (2005) 224 CLR 193 at 199-200 [2]-[3]; [2005] HCA 58.

132 *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 at 53; *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1 at 16 [22]; [1999] HCA 49. See also Ginsburg, "The Concept of Authorship in Comparative Copyright Law", (2003) 52 *DePaul Law Review* 1063; Birnhack, "The Dead Sea Scrolls Case: Who is an Author?", (2001) 23 *European Intellectual Property Review* 128.

133 (1937) 58 CLR 479 at 510; [1937] HCA 45.

134 Defined by s 32(4) to include an Australian citizen or a person resident in Australia.

the death of the author (s 33), and the conferral of copyright upon the author subject to the terms of employment or contractual arrangements under which the author labours (s 35). In the latter respect, s 35(6) relevantly provides:

"Where a literary ... work ... is made by the author in pursuance of the terms of his or her employment by another person under a contract of service or apprenticeship, that other person is the owner of any copyright subsisting in the work by virtue of this Part."

98 Like the *Copyright Act 1956* (UK) ("the 1956 Act") in its original form, the Act does not define the term "author" beyond the statement that in relation to a photograph it is the person who took that photograph. As a result of changes made by the 1988 UK Act, in relation to a work "author" means the person "who creates it"; in the case of a "computer-generated" work this is taken to be "the person by whom the arrangements necessary for the creation of the work are undertaken"¹³⁵. No such provision is made in the Australian statute, but the notion of "creation" conveys the earlier understanding of an "author" as "the person who brings the copyright work into existence in its material form"¹³⁶.

99 Where a literary work is brought into such existence by the efforts of more than one individual, it will be a question of fact and degree which one or more of them have expended sufficient effort of a literary nature to be considered an author of that work within the meaning of the Act. If the work be protected as a "compilation", the author or authors will be those who gather or organise the collection of material and who select, order or arrange its fixation in material form¹³⁷. May there be joint authors of the one original work, rather than several authors each of a distinct work?

100 While the Act speaks of "the author", the Act affords protection to works of joint authorship by force of Div 9 of Pt III (ss 78-83). The expression "work of joint authorship" means (s 10(1)):

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

135 1988 UK Act, s 9(3).

136 Laddie, Prescott and Vitoria, *The Modern Law of Copyright*, (1980) at 243 [6.6].

137 Laddie, Prescott and Vitoria, *The Modern Law of Copyright and Designs*, 2nd ed (1995), vol 1 at 550 [11.11].

101 In the present case, the primary judge and the Full Court each recorded in their reasons that there was no dispute that "the authors" of the Weekly Schedule were "qualified persons". However, neither at trial nor in the Full Court was there any finding of the identity of those persons or any finding that the Weekly Schedule was a "work of joint authorship" within the meaning of the Act.

102 The second principle is related to the first and concerns the requirement for the subsistence of copyright of "fixation" of the original work in a material form. It is well established that copyright does not subsist in a work unless and until the work takes some material form, so that protection¹³⁸:

"does not extend to the ideas or information contained in the work and a balance is struck between the interests of authors and those of society in free and open communication¹³⁹".

103 Section 32 lays down the requirement for identifying the original work of the author. This relevantly provides for copyright to subsist in unpublished works where the author was a qualified person "at the time when the work was made" (s 32(1)(a)) and for copyright to subsist in published works where the "first publication" took place in Australia (s 32(2)(c)). In the case of the former, the time of making means the first reduction to "writing" or "some other material form" (s 22(1)) while "publication" occurs by supply of reproductions of the work to the public (s 29(1)). Publication may be done anonymously (s 34) and special provision is made for the copyright duration in respect of such works (s 34(1)). However, this has no application if the identity of the author of the work is generally known or can be obtained by reasonable inquiry (s 34(2)).

104 The definitions of "material form" and "writing" are (s 10(1)):

"**material form**, in relation to a work or an adaptation of a work, includes any form (whether visible or not) of storage of the work or adaptation, or a substantial part of the work or adaptation, (whether or not the work or

138 *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 218 CLR 273 at 294 [51].

139 *Copinger and Skone James on Copyright*, 14th ed (1999), vol 1 at 101 [3.74]. See also *Campomar Sociedad, Limitada v Nike International Ltd* (2000) 202 CLR 45 at 67 [45]-[46]; [2000] HCA 12; *Théberge v Galerie d'Art du Petit Champlain Inc* [2002] 2 SCR 336 at 353-354, 397-398; Loughlan, "Copyright Law, Free Speech and Self-Fulfilment", (2002) 24 *Sydney Law Review* 427 at 428-431.

adaptation, or a substantial part of the work or adaptation, can be reproduced).

...

writing means a mode of representing or reproducing words, figures or symbols in a visible form ..."

105 A generally expressed admission or concession by one party to an infringement action of subsistence of and title to copyright may not overcome the need for attention to these requirements when dealing with the issues immediately in dispute in that action. This litigation provides an example. The exclusive rights comprised in the copyright in an original work subsist by reason of the relevant fixation of the original work of the author in a material form. To proceed without identifying the work in suit and without informing the enquiry by identifying the author and the relevant time of making or first publication, may cause the formulation of the issues presented to the court to go awry.

106 It may be noted that the presence or absence of evidence on these matters has been held significant in several of the leading authorities on compilations. These include *G A Cramp & Sons Ltd v Frank Smythson Ltd*¹⁴⁰, where the original compiler of the 1933 diary was dead and there was a consequent lacuna in the case of the unsuccessful plaintiff, and *Football League Ltd v Littlewoods Pools Ltd*¹⁴¹, where evidence respecting the role of Mr Harold Sutcliffe in settling the league fixtures was given great weight by Upjohn J. In *Robinson v Sands & McDougall Pty Ltd*¹⁴², the primary judge (Barton J) said that the plaintiff and his witnesses had described "the whole course of preparation" of his map and gave details of that evidence.

The pleadings and the evidence

107 The amended statement of claim pleaded "subsistence and ownership" by Nine of copyright in three categories of "Nine Program Schedules". Each of these was said to be made, created and revised by unidentified qualified persons acting under a contract of service with Nine. "[O]ne or more" of the Nine Program Schedules was also said to have been "first published [anonymously] in Australia shortly prior to the date on which the applicable schedule commenced".

¹⁴⁰ [1944] AC 329 at 336, 338.

¹⁴¹ [1959] Ch 637 at 646-649.

¹⁴² (1916) 22 CLR 124 at 128-129.

108 The three categories of Nine Program Schedules were:

- (1) Nine Program Schedules consisting only of details of the dates, titles, and intended starting and finishing times for the transmission of the television programmes broadcast by TCN-9 Sydney and, for the most part, other stations in the Nine Network for each day and week (ie, the "time and title information", save for episode titles);
- (2) Nine Program Schedules consisting of time and title information, including episode titles, together with "additional program detail information" such as episode numbers, currency information (eg, whether a programme is a "repeat" ("Rpt"), "live", a "series return", or "all new"), programme format (eg, "Widescreen (WS)" or "High Definition (HD)"), closed captioning for the hearing impaired ("S"), classification information (eg, "C", "G", "PG", "M", "MA", "AV") and consumer advice (eg, "Some Violence [V]", "Sexual References [S]", "Adult Themes [A]", "Coarse Language [L]"); and
- (3) Nine Program Schedules consisting of the information in (1) and (2) together with short descriptive information about individual television programmes, or "synopses".

109 While the pleading did not distinguish the categories of Nine Program Schedules by identification of the relevant time of first making or first publication, the evidence showed a sequence of seven steps whereby information of the kind just described was progressively reduced into a variety of material forms in the period before each "broadcast week". A "broadcast week" commenced on a Sunday and ended on the following Saturday.

110 The evidence established that Nine's Director of Programming, Mr Michael Healy, commenced the sequence and first wrote by hand the programme name (or an abbreviation) for programmes proposed to be broadcast during "prime time" (6:00 pm to 10:30 pm) into a notebook called the "Paper Programming Grid". Each page of the notebook represented a separate week of the year, divided into the seven days and half hour timeslots, and was populated by Mr Healy with programme and sometimes episode titles up to six to nine months in advance of broadcast. A pencil was used for this task, so that the time and title information so recorded could readily be revised as changes were made to the programme line-up for commercial reasons.

111 Step two appeared from the evidence of Program Executive Ms Penny Wieland. This involved her recording time and title information for programmes proposed to be broadcast in the daytime (6:00 am to 6:00 pm) and

off-peak (10:30 pm to 6:00 am) timeslots. Programme and sometimes episode titles and numbers were inserted by her into an Excel "spreadsheet" she maintained on her computer, again divided into weeks, days and timeslots and populated well in advance of broadcast. Ms Wieland also populated her spreadsheet with time and title information for prime time programmes, which she derived from discussions with Mr Healy or her own knowledge of Nine's programming.

112 Step three occurred three to four weeks prior to each broadcast week and involved another Nine employee, Mr Heath Forrest. He transposed by hand the time and title information for that week from Mr Healy's grid and Ms Wieland's spreadsheet into a further paper document called "the Master Paper Grid". A separate Master Paper Grid was prepared by Mr Forrest for each broadcast week. He completed the grid by adding further episode titles and certain other "additional program detail information" such as currency information. However, other "additional program detail information", such as classification and consumer advice, does not appear to have been included in Mr Forrest's Master Paper Grid.

113 Step four commenced once Mr Forrest had completed transposition of the information from the grid and the spreadsheet into the Master Paper Grid. This involved the commencement of manual entry by Mr Forrest of that information into a customised programme database located on Nine's computer network ("the Nine Database"). The evidence was largely silent as to the structure of the Nine Database or the manner of its operation.

114 The evidence showed that, while these steps were taking place, other staff at Nine were responsible for collating other of the "additional program detail information" and the synopses. Mr Brian Feeney and Mr Richard Lyle of the Programming Department prepared classification information for programmes proposed to be broadcast in accordance with the Commercial Television Industry Code of Practice. Synopses were also drafted by Mr Justin Holman, Mr Forrest and occasionally Mr Healy, or obtained from Nine staff known as the "Genre Heads" and "Production Officers", or outside producers or distributors. The evidence did not reveal who was responsible for entering the classification and consumer information into the Nine Database, but did explain the entry by Mr Holman of the synopses.

115 Steps five and six assumed particular importance in the development of Nine's argument in oral submissions in this Court¹⁴³.

143 See [141].

116 The key actor in step five again was Mr Forrest. Upon completion of entry of all available information for the relevant broadcast week into the Nine Program Schedule, the evidence was that he "dumped" that information into the Nine Database thereby granting access to persons who worked outside the Programming Department but within, or in affiliation with, Nine. Those within Nine who were given this access could then view the proposed programme schedule on the internal computer network at Nine. Access allowed Nine's marketing, publicity and sales departments to plan their sales and marketing strategies. It also permitted stations other than TCN-9 Sydney, GTV-9 Melbourne and QTQ-9 Brisbane to access and amend the Nine Database to include local material or make changes for their individual stations.

117 Step six, the penultimate step, occurred 17 to 14 days ahead of each broadcast week. It comprised the production of the document referred to by the primary judge and the Full Court in their reasons as the "Weekly Schedule". This was done by Mr Holman. He generated the Weekly Schedule from the Nine Database in both the "Excel" and "text" format and emailed that document to three third parties, identified as "the Aggregators".

118 The information recorded in a material form in the Weekly Schedule appears from the first page of the "Excel" format disseminated to the publishers of the Aggregated Guides ("the Aggregators") for the broadcast week commencing Sunday, 11 June 2006¹⁴⁴. This read:

144 It was not suggested that the "Excel" and "text" format of the Weekly Schedule were different as to form or content in any relevant respect.

45.

TCN Channel 9 Program Guide
Copyright 2001 Nine Network Australia Pty Ltd
SUNDAY June 11, 2006

06.00	MAKE WAY FOR NODDY Policeman for a Day	Rpt	G (S)	Animated series featuring the beloved Noddy.
06.20	LITTLE RED TRACTOR Lucky Day	Rpt	G (S) WS	Stan is not a great believer in luck; however, after a day of bizarre mishaps and lucky escapes both he and Little Red Tractor have cause to reconsider - could it be the lucky Penny, and the four leaf clover they have picked up along the way are really bringing them luck?
06.30	BARNEY & FRIENDS Squares, Squares Everywhere	Rpt	G (S)	Nick's homework is to find as many squares as he can. It's great fun when Barney and the kids help!
07.00	[HOT] SOURCE	Rpt	C (S) WS	Join your hosts David Whitehill, Miranda Deakin, Tristan Kurz and Asha Kuerten as they present the very latest in children's stories, entertainment reviews, news, music clips and celebrity interviews.
07.30	BUSINESS SUCCESS		G WS	Business Success will answer the many questions that arise when starting up a small business, with business legends offering advice that they may wish someone had been able to offer them!
08.00	BUSINESS SUNDAY	#Live#	NA (S) HD WS	Ali Moore hosts Business Sunday featuring regular profiles on important industries, major corporations and innovative small businesses. This show features a highly respected and influential team of financial and political analysts, including Ross Greenwood and Adam Shand.
09.00	SUNDAY		NA (S) HD WS	Jana Wendt leads a team of highly successful respected reporters including, Ross Coulthart, Sarah Ferguson and Graham Davis. Sunday topics include the Laurie Oakes interview, as well as coverage of the arts, including Peter Thompson's film review.
11.00	THE SUNDAY FOOTY SHOW	#Live#	G HD WS	Join Paul Vautin, Peter Sterling, Jim Smith and Matty Johns on The Sunday Footy Show for all the latest news and reviews from on and off the footyfield as well as a bumper season preview featuring each of the teams.
12.00	SUNDAY ROAST	#Live#	PG HD WS	The Sunday Roast is a LIVE panel show tearing into the controversies and characters of Rugby League. Hosted by Andrew Voss, the panel includes "enforcers" Mark Geyer and Matthew Johns.
01.00	WIDE WORLD OF SPORTS NINE'S SUNDAY FOOTBALL LIVE Port Adelaide v Hawthorn	#Live#	NA WS	Wide World Of Sports presents Nine's Sunday Football Live, Port Adelaide v Hawthorn, from AAMI Stadium. Join your expert commentary team including Dennis Cometti, Wayne Russell, Garry Lyon and Dermott Brereton for all the action.
04.00	WIDE WORLD OF SPORTS NINE'S SUNDAY FOOTBALL Parramatta Eels v Melbourne Storm		NA WS	Wide World Of Sports presents Nine's Sunday Football, Parramatta Eels v Melbourne Storm, from Parramatta Stadium. Join your expert commentary team including Ray Warren, Peter Sterling, Phil Gould and Matty Johns with sideline commentary from Andrew Voss.
06.00	NATIONAL NINE NEWS SUNDAY		NA (S) WS	National Nine Weekend News presented by Mike Munro.

As can be seen, the five columns of the Weekly Schedule included time and title information (columns 1 and 2), additional programme information (columns 3 and 4), and the synopses (column 5). It is not readily apparent that

any one or more of the items treated above as "title information" (column 2) would qualify as an original literary work by itself. The same must be so of the time information of column 1. The synopses in column 5 may have had that character, but they were not reproduced in the IceGuide.

120 Before turning to the seventh and final step, attention should be given to the role of the Aggregators as recipients of the Weekly Schedule. The primary judge found that the purpose of the Weekly Schedule was to impart the totality of the information therein to the Aggregators. They were responsible for extracting and publishing in the Aggregated Guides the totality of the information in the Weekly Schedule alongside like information provided by other free to air television stations.

121 The final step in the relevant sequence of evidence involved the revision of the time and title information after provision of the Weekly Schedule to the Aggregators. The evidence showed that the Weekly Schedule occasionally was issued to the Aggregators with timeslots marked "Details: TO BE ADVISED" and late changes to programming made for competitive and other reasons. Mr Healy explained:

"I often deliberately keep certain program information back from inclusion in the Nine Database until the print deadline for *TV Week* magazine, which is ten days before the commencement of the particular week. I am likely to do this where Nine has scheduled a special event or the premiere of a new series or movie that we do not want our competitors to have early knowledge about."

Responsibility for entering late changes in the Nine Database rested with Mr Forrest, who also informed the Aggregators of such late changes by the provision to them of memoranda identified in the litigation as "Late Change Notices".

The holdings of the primary judge and the Full Court

122 Upon the concession of Ice as to subsistence of copyright in the Weekly Schedule, the primary judge held that the relevant work in suit was each Weekly Schedule published by Nine since IceTV commenced its activities in 2004. Her Honour held that the Weekly Schedule was a "compilation" literary work which expressed the time and title information, the additional programme information and the synopses for each day of the relevant broadcast week. Each of the categories of information included in the Weekly Schedule was there for good commercial reason. Bennett J rejected the submission of Nine that distinct copyrights subsisted in mere components of the Weekly Schedule, such as the time and title information of the first two columns.

123 As to infringement, the primary judge found that (i) IceTV never took the synopses and did not take the whole of the time and title information from the Aggregated Guides; (ii) IceTV had copied no more than "slivers" of time and title information from the Aggregated Guides in order to maintain and update the IceGuide; and (iii) the slivers in question did not bear substantial importance in relation to the originality of the Weekly Schedule as a whole. This led the primary judge to the conclusion that IceTV had not reproduced a substantial part of the Weekly Schedule, with the consequence that the alleged infringement was not established and the application was dismissed.

124 It should be noted that the primary judge recorded that the case on infringement was founded on the assertion that IceTV had appropriated the "'skill and labour of authorship' of *Nine*" (emphasis added). Her Honour's findings in this respect were critical to the conclusion that there had been no reproduction of a "substantial part" of the Weekly Schedule.

125 Bennett J explained that the relevant "skill and labour" of Nine included both the skill and labour of making decisions as to the selection and arrangement of programmes for broadcast in particular timeslots (referred to as the "preparatory" skill and labour) and the later "skill and labour" in drafting the synopses and selecting and arranging the time and title information, the additional programme information and the synopses in the form of the Weekly Schedule once the preparatory work was done.

126 As to the former, the primary judge found that the preparatory "skill and labour" involved the consideration by Mr Healy and Ms Wieland of many factors, such as viewer preferences and trends, audience size and demographic appeal, contractual and regulatory obligations, competitor programming and ratings information. However, she also found that the primary purpose here was not to produce a literary work, but rather, to produce a programme line-up that would maximise viewers (and hence advertising revenue). The conclusion followed that the skill and labour in determining the programme line-up was not co-extensive with the skill and labour in creating the Weekly Schedule. IceTV was not a broadcaster and there was accordingly no relevant "appropriation" by it of the skill and labour of placing programmes. IceTV adopted its own form of presentation of the time and title information and drafted its own synopses and thus had not taken sufficient of "Nine's skill and labour" so as to have infringed by copying "slivers" of time and title information.

127 In the Full Court, the findings by Bennett J as to the identity of the relevant works in suit went unchallenged. The primary issue was whether the copying by Ice of time and title information from publicly available Aggregated Guides constituted the reproduction of a substantial part of the Weekly Schedule.

After setting out the "Principles" identified earlier in these reasons, the Full Court turned its attention to this issue under the heading "Assessing the Primary Judge's Views on Ice's Appropriation of Nine's Skill and Labour"¹⁴⁵.

128 It was in the assessment of this topic that a critical difference of opinion emerged in the reasoning of the Full Court. The Full Court explained¹⁴⁶:

"Ice, to the extent it reproduced time and title information from the Weekly Schedules, *appropriated the skill and labour used by Nine* to create the Weekly Schedules. Contrary to her Honour's conclusion, the skill and labour in selecting and arranging programming *should not be regarded as separate and discrete from the extremely modest skill and labour involved in setting down on paper the programs already selected and presenting them in the form of the Weekly Schedules*. The skill and labour expended by Nine were part of a single process leading to the creation of the copyright work as the written record of Nine's programming decisions and the associated program information." (emphasis added)

Upon this basis, that the skill and labour invested in the programming decisions could not be separated from the skill and labour of creating the copyright work, the Full Court continued¹⁴⁷:

"Ice took, via the Aggregated Guides, precisely the pieces of information that reflected *the exercise of skill and labour by Nine* in determining the program for a particular day or other period ... Ice's use of material derived from the time and title information – we would not use the expression 'slivers of information' – *appropriated* the most creative elements *of the skill and labour utilised by Nine* in creating the Weekly Schedules." (emphasis added)

129 The Full Court concluded that the time and title information was the "centrepiece" of the Weekly Schedule and that by taking it Ice had reproduced a substantial part of the relevant Weekly Schedules. Accordingly, the appeal was allowed and the proceedings were remitted to the primary judge for hearing and determination consistently with the reasons of the Full Court.

¹⁴⁵ (2008) 168 FCR 14 at 37.

¹⁴⁶ (2008) 168 FCR 14 at 41.

¹⁴⁷ (2008) 168 FCR 14 at 42.

Misappropriation of skill and labour "of Nine"

130 Before turning to the submissions presented in this Court, several points should immediately be made concerning the focus by the primary judge and the Full Court upon the skill and labour "of Nine" in their treatment of infringement.

131 The first is to emphasise the dangers when applying the Act of adopting the rhetoric of "appropriation" of "skill and labour"¹⁴⁸. A finding that one party has "appropriated" skill and labour, of itself, is not determinative of the issue of infringement of a copyright work. The Act does not provide for any general doctrine of "misappropriation"¹⁴⁹ and does not afford protection to skill and labour alone.

132 In the present case, the alleged infringement was identified in the reproduction of a substantial part of the relevant copyright "work" (ss 36(1), 31(1)(a)). To speak of the "appropriation" of "Nine's skill and labour", rather than attending to the relevant "original" work of the author or authors, was to take a fundamental departure from the text and structure of the Act. In particular, while s 35(6) might have produced the consequence that Nine was the relevant copyright owner after identification of the relevant "author" or "authors", notions of the "skill and labour" of Nine were irrelevant to the existence of its title to the copyright and to the assessment of "substantial part".

133 The second point is that the conduct of the litigation in this manner reflected the decision in *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd*¹⁵⁰. That case decided that telephone directories were "original" works in which copyright subsisted because "Telstra had undertaken substantial labour and incurred substantial expense"¹⁵¹ in compiling and presenting the details of telephone subscribers in a particular region. Infringement was

148 *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 218 CLR 273 at 281-282 [14]-[17]. See also Deazley, "Copyright in the House of Lords: Recent Cases, Judicial Reasoning and Academic Writing", (2004) 8 *Intellectual Property Quarterly* 121 at 134-135.

149 cf *International News Service v Associated Press* 248 US 215 (1918); *Moorgate Tobacco Co Ltd v Philip Morris Ltd [No 2]* (1984) 156 CLR 414 at 440-442; [1984] HCA 73.

150 (2002) 119 FCR 491.

151 (2002) 119 FCR 491 at 599 per Sackville J (emphasis added); see also at 535 per Lindgren J.

identified in the appropriation of "the benefit of Telstra's substantial labour and expense"¹⁵².

134 However, a reason to treat the decision in *Desktop Marketing* with particular care appears from the reasons of the trial judge. Finkelstein J had observed¹⁵³:

"There are literally hundreds of appropriately trained or qualified employees who make some contribution towards the production of a telephone directory. When the nature of the work they do is described, there arise three relevant questions to the subsistence of copyright: (a) Must a copyright work have an author? (b) Does a telephone directory have an author? (c) Is every employee who contributes to the final product a joint author of the directory? These are difficult questions for which there are no ready answers."

Finkelstein J went on to explain that the parties had sought to elucidate none of those issues in the litigation, with the consequence that, as here, the relevant author or authors of the work in suit remained unidentified.

The EU Database Directive

135 In 1996 the Directive of the European Parliament and of the Council on the Legal Protection of Databases ("the Directive")¹⁵⁴ was adopted by the European Union ("EU"). It is significant for the issues on the present appeal that the Australian legislation has no counterpart.

136 Of the genesis of the Directive, Professor Cornish has written¹⁵⁵:

"At once excited and alarmed by the capacity of digitization to store massive files of information and of the internet to deliver it in individually

152 (2002) 119 FCR 491 at 535-536, 600. See also *Nine Network Australia Pty Ltd v IceTV Pty Ltd* (2008) 168 FCR 14 at 36.

153 *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* (2001) 181 ALR 134 at 136.

154 Directive 96/9/EC of 11 March 1996, OJ No L77, 27 March 1996 at 20.

155 Cornish, *Intellectual Property: Omnipresent, Distracting, Irrelevant?*, (2004) at 37-38.

requested packages, the publishing industry, and, by its side, music and films, secured a Database Directive from the EU".

Whilst "traditional copyright" respecting compilations was carefully confined and fixed upon the effort that went into the selection and arrangement in a compilation, the new right was "accorded directly to the investor in a database"¹⁵⁶.

137 The Directive defines "database" to mean "a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means"¹⁵⁷. Chapter III of the Directive relevantly provides for the implementation of a "sui generis" right for the "maker" of a database who shows there has been a "substantial investment" in either the obtaining, verification or presentation of the contents of the database and for that right to extend to prevention of the extraction and/or re-utilisation of the whole or of a substantial part of the database¹⁵⁸, subject to certain exceptions¹⁵⁹ and lawful uses¹⁶⁰.

138 The Directive also provides in Ch II for Member States to afford protection to databases which, "by reason of the selection or arrangement of their contents, constitute *the author's* own intellectual creation"¹⁶¹ (emphasis added). However, the position of "the author" in Ch II may be contrasted with that of "the maker" in Ch III. In explanation of the latter, recital 39 states:

"Whereas, in addition to aiming to protect the copyright in the original selection or arrangement of the contents of a database, this Directive seeks to safeguard the position of makers of databases against misappropriation of the results of the financial and professional investment made in obtaining and collection [of] the contents by protecting the whole or

156 Cornish, *Intellectual Property: Omnipresent, Distracting, Irrelevant?*, (2004) at 38.

157 Chapter I, Art 1(2).

158 Chapter III, Art 7(1).

159 Chapter III, Art 9.

160 Chapter III, Art 8.

161 Chapter II, Art 3(1).

substantial parts of a database against certain acts by a user or competitor".

139 In the absence of implementation of laws analogous to the kind described in the Directive, the matters now in issue cannot be resolved by concluding, as did the Full Court¹⁶², that Ice appropriated "the fruits of Nine's skill and labour".

The submissions on "substantial part"

140 In their submissions in this Court, each of Nine and Ice emphasised that the Court should look to the "originality" of the work as contributed by the author in determining whether there had been any reproduction by IceTV of a "substantial part". If that be done, Ice submitted that the relevant originality would be seen to lie not in the composition of the time and title information, but in the selection and arrangement of that information, the additional programme information and the synopses into the "Excel" and "text" format of the Weekly Schedule.

141 As the course of oral argument progressed, there emerged between the parties fundamental differences as to the nature of the relevant "originality". The extent of these differences crystallised on the second day of the hearing when, apparently for the first time in the litigation, Nine sought to identify the work in suit as a single work "first made" upon the "dumping" of the Nine Programme Schedule into the Nine Database by Mr Forrest and "first published" upon the emailing of the Weekly Schedule in "Excel" and "text" format to the Aggregators. These have been described earlier in these reasons as "step five" and "step six"¹⁶³.

142 Counsel for Nine explained that the work:

"was the work which was in material form made over a period of time but in final material form on the [Nine] [D]atabase. The [Weekly Schedule in 'Excel' and 'text' format] which were published [were] published by making it in another material form which was a piece of paper and sending it out. It did not become a different work. It was just another form of the same work."

162 (2008) 168 FCR 14 at 43.

163 See [116]-[117].

The authors of the work so propounded were said by counsel to be Mr Healy and Ms Wieland¹⁶⁴ and their "original" work was identified in the judgment and skill required to create the sequence or relationship between the programme title and time of broadcast, as expressed in the time and title information. In putting the case this way, Nine emphasised that the synopsis and the additional programme information followed "automatically" from the decision to broadcast a particular programme at a particular time; the "key element" of the work was the selection of the programmes and their arrangement in particular time sequences relative to each other. This lay the ground for submissions that although IceTV had not "appropriated" the synopses and additional programme information, IceTV had taken a "substantial part" of the Weekly Schedule.

143 Nine submitted that this analysis reflected the findings of the Full Court. But two points should be made here.

144 The first point is that the proposition now advanced by Nine, that the work in suit was a single work reflected in the Nine Database, does not appear from the elliptical references to "the Nine Program Schedules" in the pleadings. As a consequence, issues of the kind to be described below were not agitated at any stage in the Federal Court.

145 The second point is to emphasise the difficulties of adapting the provisions of Pt III of the Act to cases such as the present, where multiple works and authors might be identified and the requisite expression of "authorship" of each may be dictated by a specific commercial objective. The point is illustrated sufficiently by contrasting the provisions of the Act and the evidence with the proposition that "the work" was a single work represented in the Nine Database and "first published" upon dissemination to the Aggregators of the Weekly Schedule in "Excel" and "text" format.

146 The combined effect of s 32(1), s 22 and the definition of "material form" is to provide for subsistence of copyright in an unpublished literary work at the time or period of first fixation in a material form by a qualified person, whether then "visible or not". Thus, copyright might subsist in the Nine Database as a

164 This was consistent with particulars supplied by Nine on 7 July 2006, which had stated:

"Nine confirms that the authors of the Nine Program Schedules as published since April 2005 are Mr Michael Healy and Ms Penny Wieland, both of whom are Australian residents and have at all relevant times been employees of Nine."

"compilation" upon the time of "dumping" by Mr Forrest, notwithstanding that the relevant expression of "words, figures or symbols" might then have been invisible to the human eye (s 10(1)). Further, the Act provided for "first publication" (s 32(2)(c)) to occur upon supply of a reproduction of "the work" to the public (s 29(1)), as might be done by dissemination to the Aggregators of the Weekly Schedule. However, the relevant reproduction for the purposes of first publication must be of the whole (s 29(2)) rather than merely a substantial part (cf s 14(1)). A work is taken to be reproduced if converted into or from a digital or other machine-readable form; any article embodying the work in such a form is to be taken to be a reproduction of the work (s 21(1A)).

147 The evidence showed that the words, figures or symbols which comprised the Nine Database were not co-extensive with those which comprised the Weekly Schedule. For example, the evidence showed that each programme was allocated a short "Catalog" code (eg, "NODD01") and that Mr Forrest keyed these into the Nine Database prior to generation of the "Excel" and "text" format of the Weekly Schedule. The catalogue codes permitted the cross-referencing by Nine of the time and title information with its internal tape library in a further schedule called "the First and Final" schedule. This comprised a collocation of the catalogue codes, the time and title information and certain other information, and was also generated from the Nine Database for this purpose prior to each broadcast week. However, the catalogue codes had no utility to the Aggregators or the public and accordingly were omitted from the "Excel" and "text" format of the Weekly Schedule.

148 The requirement in s 29(2) of the Act for publication by reproduction of the whole work is significant. The presence of catalogue codes in the Nine Database, but not the Weekly Schedule, points, when assessing infringement, against the former being the same compilation work as the latter. Further, assuming the Nine Database and the Weekly Schedule to be distinct literary works, questions inevitably arise as to whether the author of the latter would be identified with the author of the former and whether the requisite "originality" of each might differ in the assessment of infringement.

149 In this respect, the absence of evidence of the structure and manner of operation of the Nine Database becomes significant. There was evidence that Mr Forrest and Mr Holman were each involved in transposing information into the Nine Database. However, the evidence did not indicate how the Nine Database operated to select, arrange and present that information into the "Excel" and "text" format of the Weekly Schedule (step six), or who was responsible for designing the Nine Database so as to achieve that function.

150 Further, while the evidence described the giving of access to information in the Nine Database ("dumping") as enabling persons with this access to view or

in some cases modify the proposed programme schedule (step five), there was no evidence about how the information in the Nine Database came to be assembled in the way it was when those persons viewed it or sought to modify it. Nor was there evidence about who it was who decided that information should be assembled in this way.

151 The relevant issues which this situation presents are elucidated by Professor Davison in his work *The Legal Protection of Databases*¹⁶⁵ as follows:

"There is some argument that some databases do not have authors in the copyright sense. This argument is based on the proposition that electronic databases are arranged automatically by the computer program ... The operator may simply key in the data in an indiscriminating manner or insert data that are already in digital form, and the data may be organised by the computer program. There may be no originality associated with the selection of the data included in the database, particularly if the selection consists of all the available material relating to a particular topic. It could be further argued that, as the arrangement has occurred automatically as a consequence of the operation of the computer program that manipulates the data, the supposed author of the database has not in fact authored it." (citation omitted)

The author goes on to explain that there are a number of possible responses to this problem, but that these¹⁶⁶:

"require some understanding of the process of creating and updating an electronic database. First, the actual creation and updating of a database is rarely as simple as indiscriminately keying new data into some form of digital storage ... A decision has to be made about defining the records and fields (or the rows and columns) that are to be contained within the database ... Even though the final result is produced by the 'work' of a computer in arranging the material in this way, human thought went into the scheme of the database and the conception of how the material would look to the external user ...

The second response ... is based on the proposition that the authors of databases can claim authorship by virtue of having considered the possible outcomes of their input into the database. *They have chosen the*

¹⁶⁵ (2003) at 21.

¹⁶⁶ Davison, *The Legal Protection of Databases*, (2003) at 22-23.

software used in the database and therefore chosen the operations that it can carry out on the data included." (emphasis added)

In the absence of evidence as to matters of this kind and of any provision in the Act akin to s 9 of the 1988 UK Act¹⁶⁷, Ice submitted in its oral submissions in reply that the relevant author of the Weekly Schedule was unknown. We agree. It would follow from this that no finding could be made as to whether the Weekly Schedule was a work of joint authorship within the meaning of s 10(1) of the Act¹⁶⁸.

152 However, the appeal to this Court may be resolved without resolving issues of this nature. On the assumption favourable to Nine that the Weekly Schedule was "the same work" as the Nine Database, the Court should accept the submission by Ice that the originality of the compilation being the Weekly Schedule lay not in the provision of time and title information, but in the selection and presentation of that information together with additional programme information and synopses, to produce a composite whole.

153 The reasons for accepting that submission appear from further consideration of the reasons of the Full Court.

Treatment of "substantial part" by the Full Court

154 The effect of s 14(1)(a) of the Act is that an infringement by reproduction of a work may result from the reproduction of "a substantial part of the work". The word "substantial" has been said to be "not only susceptible of ambiguity" but to be "a word calculated to conceal a lack of precision"¹⁶⁹. However that may be, which of the various possible shades of meaning the word bears in a provision such as s 14 of the Act will be determined by the context¹⁷⁰. With respect to s 14, that context includes the matters of development of copyright law to which reference has been made earlier in these reasons¹⁷¹.

167 See [98].

168 The text of the definition of "work of joint authorship" is set out above at [100].

169 *Tillmanns Butcheries Pty Ltd v Australasian Meat Industry Employees' Union* (1979) 42 FLR 331 at 348.

170 See *Wong v Silkfield Pty Ltd* (1999) 199 CLR 255 at 266-267 [27]; [1999] HCA 48.

171 At [72]-[76].

155 The Full Court stated that a finding of substantiality depended much more on the quality than the quantity of that which had been copied. That starting point is in accordance with authority¹⁷². However, the "quality" relevant in the case of a literary work, including a compilation, was said to be "the literary originality of what has been copied"¹⁷³. That quality was to be assessed by reference to "the interest protected by the copyright". The origin of these latter two propositions in *Newspaper Licensing*¹⁷⁴ has been described earlier in these reasons¹⁷⁵.

156 Neither proposition is satisfactory and each is apt to mislead.

157 The proposition that in a case such as the present one looks to the literary originality of what IceTV copied, rather than to the Weekly Schedule as a whole, in answering the question whether IceTV reproduced a substantial part of the Weekly Schedule, shifts consideration to an extraneous issue. This is whether what the primary judge called the "slivers" of information may themselves be classified as original literary works. The issue requiring the comparison between what was taken and the whole of the work in suit may be distorted by a meditation, inspired by *Desktop Marketing*¹⁷⁶, upon the protection given by the Act against misappropriation of any investment of skill and labour by the author. In the present case, the temptation then is to classify the slivers each as original literary works. An important proposition may be overlooked. This is that the statutory requirement that the part of a work taken must be substantial assumes there may be some measure of legitimate appropriation of that investment.

158 A collateral matter should be put to one side. The case law does disclose that special difficulty has been encountered in considering the relationship between the phrase "a substantial part" in s 14(1) of the Act and the definition in s 10(1) of that species of "literary work" which is a "computer program", being:

"a set of statements or instructions to be used directly or indirectly in a computer *in order to bring about a certain result*". (emphasis added)

172 *Autodesk Inc v Dyason [No 2]* (1993) 176 CLR 300 at 305; [1993] HCA 6.

173 (2008) 168 FCR 14 at 37.

174 [2003] 1 AC 551.

175 See [62].

176 (2002) 119 FCR 491 at 535-536.

The phrase emphasised suggests the importance of function, although this is usually encountered in patent and designs law, rather than in the "traditional" law of copyright respecting original literary works.

159 It was in this context, of the infringement of computer programs, that in *Data Access Corporation v Powerflex Services Pty Ltd*¹⁷⁷, Gleeson CJ, McHugh, Gummow and Hayne JJ disfavoured a "but for" analysis which treated as essential for the purposes of substantiality each of the many necessary integers in a computer program, so that the presence of any one of them indicated the taking of a substantial part; such an analysis was overly protective of the interests of the owners of the copyright in that species of literary work, and overlooked the need for some process of qualitative abstraction of the material features of the computer program in question in order to determine any issue of substantiality under s 14(1) of the Act. But the special considerations that are present in cases such as *Data Access* are not found here. Use of the term "functionality" in compilation cases is unhelpful.

160 The proposition that the Court should look to "the interest" which the copyright protects invites processes of reasoning to which there applies the warning by Judge Learned Hand in *Nichols v Universal Pictures Corporation*¹⁷⁸. This is to the effect that the more remote the level of abstraction of the "interest", the greater the risk of protecting the "ideas" of the author rather than their fixed expression. That risk appears to have been realised in the reasoning of the Full Court.

161 The Full Court approached the issue of substantiality at too high a level of abstraction, and in doing so tipped the balance too far against the interest of viewers of digital free to air television in the dissemination by means of new technology of programme listings. The Full Court did so by treating the issue of substantiality as dominated by an "interest" in the protection of Nine against perceived competition by Ice.

162 The Full Court emphasised the apparent commercial value of the time and title information in the conduct of the business of the Nine Network. On the one hand, the time and title information was a "central element of [Nine's] business as a television broadcaster" while the synopses and additional programme information were of little or no value, whether commercially or as a repository of

¹⁷⁷ (1999) 202 CLR 1 at 30-34 [77]-[87].

¹⁷⁸ 45 F 2d 119 at 121 (1930).

programming information¹⁷⁹. Moreover, Nine and Ice were "competitors in the sense that each was seeking to derive profit from the dissemination of the time and title information"¹⁸⁰.

163 The Act operates in the general legal milieu. Section 9(3) recognises this in specifying that the statute does not affect the operation of the law relating to breaches of confidence. No litigation alleging breach of confidence could successfully have protected the time and title information at any rate after it left the control of Nine and reached the Aggregators. None was attempted. To the contrary, the Digital Alliance submitted that this litigation was an attempt to use the copyright law to control the further dissemination of information after it had reached the public domain.

164 The Act also may have to be read with Pt IV of the *Trade Practices Act* 1974 (Cth)¹⁸¹ and with any conditions from time to time imposed upon licensees under the Broadcasting Act.

165 (It may be noted that provision now is made, by amendments to the Broadcasting Act in 2006¹⁸², for industry codes and industry standards respecting the provision of information for the purpose of compiling electronic programme guides¹⁸³. Further, in the United Kingdom, s 176 of the *Broadcasting Act* 1990 (UK) imposes a duty to make available programme information to any publisher, subject to the settlement of terms of payment by the Copyright Tribunal¹⁸⁴.)

166 It is unnecessary to pursue any of these considerations here, save to make several points. First, evidence was not led to establish any relevant "market" in which Nine and Ice competed; nor did the evidence establish that the time and title information was of greater value (however assessed) in that market than the synopses or additional programme information. Secondly, any consideration of the objectives of competition law may favour the interests of Ice rather than

179 (2008) 168 FCR 14 at 40-41.

180 (2008) 168 FCR 14 at 39.

181 See, in particular, s 51(3) of that statute.

182 *Broadcasting Legislation Amendment (Digital Television) Act* 2006 (Cth).

183 Broadcasting Act, s 130K(3)(b).

184 See *News Group Newspapers Ltd v Independent Television Publications Ltd* [1993] RPC 173 at 179-180.

Nine. The decision of the European Court of Justice in *Radio Telefis Eireann and Independent Television Publications Ltd v Commission of the European Communities*¹⁸⁵ was that reliance upon copyright law to found the refusal of the appellants to provide programming schedules of Irish and British television to the publisher of a weekly television guide was an abuse of a dominant position within the sense of Art 86 of the Treaty of Rome. Thirdly, to speculate upon matters of commercial competition as indicative of the "interest" protected by the Act distracts attention from the closer consideration required to what is now the case based upon the significance of step five and step six in the processes leading to the production of the Weekly Schedule.

167 The primary judge approached the issue of substantiality correctly when she stressed that the detailed and lengthy preparatory work involved in what are identified in these reasons as steps one through to four was directed to the conduct of the business of the Nine Network in broadcasting programmes which would attract viewers. Likewise the making of late programme changes, as Mr Healy explained¹⁸⁶.

168 There remained what the Full Court accepted was "the extremely modest skill and labour"¹⁸⁷ in setting down the programmes already selected and in taking what may now be identified as steps five and six.

169 If the Weekly Schedule be seen in that light, several propositions advanced by Ice should be accepted. First, it ought, in a case such as the present, and to reprise the theme of Lord Herschell LC in *Leslie v Young & Sons*¹⁸⁸, to be clearly established by Nine that, looking at the Weekly Schedule as a whole, there has been a substantial reproduction in the particular use by IceTV of the Aggregated Guides to access the time and title information.

170 Secondly, in assessing the quality of the time and title information, as components of the Weekly Schedule, baldly stated matters of fact or intention are inseparable from and co-extensive with their expression. It is difficult to discern the expression of thought in statements of which programmes will be broadcast and when this will occur. If the facts be divorced from the other elements constituting the compilation in suit, as is the case with the use by IceTV of the

185 [1995] FSR 530.

186 See [121].

187 (2008) 168 FCR 14 at 41.

188 [1894] AC 335 at 341.

time and title information, then it is difficult to treat the IceGuide as the reproduction of a substantial part of the Weekly Schedule in the qualitative sense required by the case law.

171 Thirdly, it is important also to ask whether IceTV acted as it did in preparing the IceGuide with *animus furandi*, to take from the Aggregated Guides the time and title information to save itself from effort on its part¹⁸⁹. This invites further attention to the business plan and methods adopted by Ice and to the matter of "predictions".

"Prediction" of time and title information

172 Nine relied upon the decision of Whitford J in *Independent Television Publications Ltd v Time Out Ltd*¹⁹⁰. However, the publishers of *Time Out* had decided to "take a short cut"¹⁹¹ and there had been wholesale copying of dates, titles and times from the *TV Times* and the *Radio Times* published by the commercial and public broadcasters respectively¹⁹².

173 Bennett J found that IceTV had proceeded in a very different manner. The objective of IceTV had been to start with "a clean sheet of paper" and develop an EPG without infringing third party intellectual property rights. IceTV obtained legal advice as to how this might be done and began by creating templates of the daily programming of the Sydney channels Nine, Ten and Seven ("the Sydney templates"). The author of the Sydney templates was IceTV's Content Manager, Mr Mitchell Rilett.

174 The Sydney templates included seven spreadsheets populated with time and title information and additional programme information for programmes broadcast by TCN-9 on each day of the broadcast week. Nine alleged at trial that this information had been copied from the publicly available guides. However, Bennett J found that Mr Rilett created the Sydney templates by watching television over a period of three weeks in August 2004 and recording the time and title of the programmes then broadcast; his evidence of that experience and

¹⁸⁹ *Milpururru v Indofurn Pty Ltd* (1994) 54 FCR 240 at 260-261; *Gold Peg International Pty Ltd v Kovan Engineering (Aust) Pty Ltd* (2005) 225 ALR 57 at 104.

¹⁹⁰ [1984] FSR 64.

¹⁹¹ [1984] FSR 64 at 69.

¹⁹² [1984] FSR 64 at 67, 73.

description of it as "torture" were found by her Honour to be compelling. The primary judge went on to find that Mr Rilett compared his templates with the publicly available guides in September 2004, noted a "slight variation" in the time and title information, and amended the Sydney templates accordingly.

175 In this Court, the alleged copying of time and title information was identified not in the creation or amendment of the Sydney templates, but in the making and updating of successive IceGuides built upon those templates. This commenced in October 2004, when Mr Rilett transposed the information in the Sydney templates into a computer database maintained by IceTV ("the Ice Database") and began using IceTV's software to compile 24-hour guides for the commercial networks for each day of the calendar week, six days ahead of when the programmes were scheduled for broadcast.

176 The findings of the primary judge and the evidence supported the identification of three tasks required to populate the IceGuide schedules with time and title information for the Sydney station, TCN-9.

177 Task one was to cause IceTV's software to create a "starting template" populated with time and title information copied from a past IceGuide schedule for TCN-9 Sydney for the same day of a previous week. This was done by Mr Rilett or one of two other IceTV staff, Ms Suzanne Langford or Ms Samantha Tai. By way of example, the primary judge explained¹⁹³:

"Mr Rilett used the IceGuide for TCN-9 Sydney for Saturday, 16 September 2006 as the source schedule to create an IceGuide for TCN-9 Sydney for Saturday, 23 September 2006. 'Predicting over' the source schedule using Ice[TV]'s software caused the starting template for 23 September 2006 to contain the same program listings information as the source schedule, save for date and episode information."

This process was referred to within IceTV as "predicting it over" and relied on the assumption, noted earlier in these reasons, that the TCN-9 programming for any given day was likely to be substantially the same as it was on the same day of the previous week. While that assumption was made good for "strip programs" broadcast by TCN-9 in the same timeslots, 6:00 am to 7:00 pm, Mondays to Fridays, "predicting it over" could not accommodate movies, one-off programmes or other changes in programming from week to week.

193 (2007) 73 IPR 99 at 132.

178 For that reason, task two was necessary. This was to check the time and title information in the starting template with at least three online published guides. In the event of the published guides indicating a variation in programming from the previous week, Mr Rilett, Ms Tai or Ms Langford typically amended the starting template to reflect the time and title information in the published guides.

179 To illustrate the extent of amendments made, Bennett J found that it was necessary for Mr Rilett to amend the time and title information for 17 out of 31 timeslots in the starting template for TCN-9 for Saturday, 23 September 2006. However, the primary judge also found that fewer amendments were necessary for weekdays because of strip and series programmes. Thus, her Honour's reasons recorded the making of changes to programme title, time or episode for 13 out of 29 timeslots when creating an IceGuide schedule for TCN-9 for Monday, 2 October 2006.

180 The nature of amendments made to the starting template was further illustrated by the setting out by the primary judge of each change made by Mr Rilett in creating the IceGuide schedule for TCN-9 for 23 September 2006. By way of example of five such changes, Mr Rilett¹⁹⁴:

- " • changed the start time for *Nightline* from 12:25 am to 12:15 am to reflect the information in published guides;
- deleted the movie *Lansky*, which was scheduled to appear at 12:55 am in the IceGuide but was not in the published guides;
- added the movie *The Inspectors* at 12:45 am to the IceGuide, based on the information in the published guides;
- changed the start time in the IceGuide for the *Late Show with David Letterman* from 3:05 am to 2:35 am, based on the information in the published guides;
- added the program *Entertainment Tonight* to the IceGuide at 3:30 am, based on the information in the published guides".

However, the evidence also showed that the time and title information was not universally amended to reflect the published guides. For example, in the course of making the amendments just described, Bennett J explained that Mr Rilett¹⁹⁵:

194 (2007) 73 IPR 99 at 132.

195 (2007) 73 IPR 99 at 133.

"ignored the published guides' indication that *The Batman* would be broadcast at 8:05 am, 8:40 am and 9:20 am and instead left the IceGuide starting template's indication that *Classic Looney Tunes* would be broadcast at these times. Mr Rilett disregarded the published guides as he determined that TCN-9 Sydney may not broadcast *The Batman* at that time by reason of the program not being suitably rated for viewing during children's hours".

181 To amend the time and title information in the starting template, Bennett J found that IceTV staff searched the Ice Database for programmes or episode titles previously included in that database. This was done by causing IceTV's software to generate an on-screen list of available programme titles. Start times could be selected or amended using on-screen "drop-down boxes", while mouse-clicking buttons marked "Revise" or "Update Show" caused the software to insert new starting times or programme titles into the IceGuide schedule. Episode titles were similarly presented by IceTV's software in a list available to the operator and available for selection for inclusion in the IceGuide schedule. If, at the time of amendment of the starting template, the programme or episode had not been previously added to the Ice Database, it could be added using IceTV's software.

182 The third and final task was to capture late changes to Nine's programming. The primary judge found that this was done by Ms Langford, who undertook a daily comparison of the time and title information in the IceGuide schedule with the listings in the YourTV Guide for the up-coming 60-hour period. Late changes were also inserted by Mr Rilett in response to information obtained from his review of a website styled *Television Programming News* and from messages posted by subscribers on an online forum maintained on IceTV's website.

183 The evidence showed the same three tasks were performed to create IceGuide schedules for other stations in the Nine Network, subject to one variation in task one. This comprised the use of a different channel within the Nine Network as the source schedule. Thus, IceGuide schedules for GTV-9 in Melbourne were made by "predicting over" time and title information derived from the IceGuide schedule for TCN-9 for the same day. In the expectation that the same episodes would be shown by the various stations in the Nine Network, episode titles were retained by IceTV's software where the source schedule channel was different from the destination channel. The evidence included a chart prepared by Mr Rilett documenting the relevant "source schedule" for the various stations within the Nine Network. However, for each new schedule, it remained necessary to repeat task two and cross-check the time and title information with online, publicly available guides.

184 One further point concerning the making and updating of the IceGuide should be noted. This concerns the source of the IceGuide synopses. Bennett J found that the synopses appearing in the IceGuide for the Nine Network were drafted by two IceTV staff, Ms Madeleine Doyle and Ms Kiriaki Orfanos. Reference books such as *Halliwel's Film & Video Guide 2002* and websites were consulted for this purpose, but Ms Doyle and Ms Orfanos were not permitted to have regard to the published guides. The primary judge found that IceTV's synopses had a different commercial purpose from that of Nine, as evidenced by the use of humour or criticism. For example, the IceGuide synopsis for the Nine programme *The Footy Show (AFL)* on 28 September 2006 read:

"From [t]he Rod Laver Arena comes this extra long torture session. Apologies for not bringing you the 'entertainment' line-up, it's not through lack of research. Unfortunately, the only way to have truly known was to be watching *The Footy Show* last week and frankly, not for love or money will the IceMan do that. So, those of you who enjoy the 'humour' and baffling ego inflation. Enjoy."

Conclusions

185 When the issue of substantiality is approached in the manner indicated in these reasons, it is apparent that the primary judge reached the correct result and that this should not have been disturbed.

186 Ice also emphasised that the time and title information appearing in the Weekly Schedule was "decompiled" into the very different form of the Aggregated Guides, and that IceTV derived the time and title information through that medium, rather than directly from the Weekly Schedule. Given the above conclusion respecting the issue of substantiality, it is unnecessary to determine whether the fact of so-called "indirect copying" by IceTV prevented there being a "reproduction" of the Weekly Schedule.

187 One final point should be made. This concerns the submission by the Digital Alliance that this Court consider the Full Court's decision in *Desktop Marketing*¹⁹⁶ and, to the contrary of *Desktop Marketing*, affirm that there must be

196 (2002) 119 FCR 491.

some "creative spark"¹⁹⁷ or exercise of "skill and judgment"¹⁹⁸ before a work is sufficiently "original" for the subsistence of copyright.

188 It is by no means apparent that the law even before the 1911 Act was to any different effect to that for which the Digital Alliance contends. It may be that the reasoning in *Desktop Marketing* with respect to compilations is out of line with the understanding of copyright law over many years. These reasons explain the need to treat with some caution the emphasis in *Desktop Marketing* upon "labour and expense" per se and upon misappropriation. However, in the light of the admission of Ice that the Weekly Schedule was an original literary work, this is not an appropriate occasion to take any further the subject of originality in copyright works.

Orders

189 The appeal should be allowed with costs. The order of the Full Court made on 8 May 2008, as varied on 20 August 2008, should be set aside and, in place thereof, the appeal to that Court be dismissed with costs.

197 *Feist Publications, Inc v Rural Telephone Service Co, Inc* 499 US 340 at 345 (1991).

198 *CCH Canadian Ltd v Law Society of Upper Canada* [2004] 1 SCR 339 at 352.

