[HIGH COURT OF AUSTRALIA.]

BLACKIE & SONS LIMITED . . . . PLAINTIFF;

AGAINST

THE LOTHIAN BOOK PUBLISHING COMPANY PROPRIETARY LIMITED . DEFENDANT.

H. C. OF A. 1921.

MELBOURNE, *Mar.* 9-12, 22, 23; *June* 18.

Starke J.

Copyright—Literary work—Infringement—Annotated edition of play of Shakespeare—Notes copied—Order limited to notes which were copied—Copyright Act 1911 (1 & 2 *Geo. V. c.* 46), *secs.* 1, 2—*Copyright Act* 1912 (*No.* 20 *of* 1912), *sec.* 8.

A book, being an annotated edition of one of Shakespeare's plays, first published in Great Britain by the plaintiff in 1895, consisted of an introduction, the text of the play, notes thereon and a glossary. In the preparation of the book resort was had to the accumulation of information due to the industry of prior commentators and scholars, but its preparation involved much independent labour and research, and it was not a mere copy of written matter already published.

Held, that the plaintiff was entitled to copyright in respect of the book under the law prior to the British *Copyright Act* 1911 and under that Act.

Walter v. *Lane*, (1900) A.C., 539; *Leslie* v. *Young & Sons*, (1894) A.C., 335; *Savory Ltd.* v. *World of Golf Ltd.*, (1914) 2 Ch., 566, followed.

The object of the *Copyright Act* 1911 is not to accord protection to ideas but to the particular form of expression in which an author conveys his ideas or information to the world.

In an annotated edition of the same play first published in Australia in 1918 by the defendant, the arrangement of which was similar to, but not copied from, that of the plaintiff's book, parts of the introduction and of the notes were taken from the plaintiff's book either under a colourable disguise or verbatim.

Held, that in the circumstances the defendant had appropriated a substantial and valuable portion of the plaintiff's book, and was therefore liable in an action for infringement of copyright.

The parts of the defendant's book which were copied from the plaintiff's book being capable of separation from the parts which were not so copied, the Court limited its order prohibiting the use of the defendant's book to the parts which were so copied.

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HEARING of action.

An action was brought in the High Court by Blackie & Sons Ltd. against the Lothian Book Publishing Co. Proprietary Ltd. for breach of copyright. The action was heard by *Starke* J., in whose judgment hereunder the material facts and the nature of the arguments appear.

Campbell K.C. and *Latham*, for the plaintiff.

Owen Dixon, for the defendant.

Cur. adv. vult.

STARKE J. delivered the following written judgment:—The plaintiff, Blackie & Sons Ltd., is a well-known English publishing company, and the defendant, the Lothian Book Publishing Co. Proprietary Ltd., is an Australian publishing company. The plaintiff published a number of Shakespeare's dramatic works under the name of "The Warwick Shakespeare." One of the works so published was the historical play called "The Life of King Henry the Fifth." It was prepared for the plaintiff by Dr. G. C. Moore Smith, Professor of English Language and Literature in the University of Sheffield, and was first published in the United Kingdom on 26th December 1895. The defendant also published a number of Shakespeare's works, under the name of "The Australasian Shakespeare." One of the works so published by the defendant was also the historical play "The Life of King Henry the Fifth." It was prepared for the defendant by Mr. J. Le Gay Brereton, B.A., who, at the time of its preparation, was the librarian of the Fisher Library in the University of Sydney, and afterwards became Professor of English Literature in that University. This work was first published in Australia in the year 1918.

June 18.

The object of the action was to obtain an injunction restraining the defendant from publishing and selling its book, and an account

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of damages sustained by the plaintiff or of profits made by the defendant, and other ancillary relief. The pleadings in the case raise two points: one whether the plaintiff is entitled to copyright in the book published by it, the other whether the defendant has infringed that copyright. The first question depends upon the provisions of the *Copyright Act* 1912, which brought into force in the Commonwealth, as from 1st July 1912, the British *Copyright Act* of 1911.

The plaintiff's book is referred to in the pleadings as an annotated edition of Shakespeare's play called Henry the Fifth. It consists of an introduction, the text of the play taken from the Globe Edition of Shakespeare's Works, notes upon the text of the play, upon the metrical form of composition used by Shakespeare, including pronunciation, and upon other matters, and a glossary. The plan of arrangement adopted in the plaintiff's book is not new, and, indeed, the book is largely gathered from the works of other authorities. A vast mass of material—the industry of scholars over more than two centuries—is available for any commentator upon Shakespeare. These materials are well known to Shakespearian scholars, and are, in the main, sources of information open to all men. Professors Wallace and Brereton, in their evidence in this action, indicated some of the material available; such as concordances, dictionaries, grammars, the "Chronicles of Holinshed," and various editions of and commentaries upon the play by other authors. An examination of the plaintiff's book makes it clear that Professor Moore Smith had resort to all this accumulation of information, and, indeed, in his preface he acknowledges his indebtedness to the labours of his predecessors, specially mentioning Mr. Aldis Wright and Mr. K. Deighton. But undoubtedly the compilation of the plaintiff's book involved much independent labour and research. The literary expression of the matter so collected was in some cases that of Professor Moore Smith, as in the general introduction to the play and the notes on prosody at the end of the book; whilst in other cases the expression was copied from other authors, as in many instances in the notes upon the play itself. The whole was combined in the form of a book. It is not a mere copy of written matter

already published. Apart from the compilation, the work of Professor Moore Smith, the book did not exist.

I have no difficulty in deciding, on these facts, that the plaintiff was entitled to copyright in its book under the law in force prior to the passing of the British *Copyright Act* 1911, and is now entitled to the substituted right given by that Act (British *Copyright Act* 1911, sec. 24, sub-sec. 1; *Walter* v. *Lane* (1); *Leslie* v. *Young & Sons* (2); *Emerson* v. *Davies* (3); *Savory Ltd.* v. *World of Golf Ltd.* (4)).

The question whether the defendant has infringed that copyright is more difficult in the circumstances of this case.

During the trial particulars were delivered of the passages in the defendant's book which the plaintiff asserted were copied from the plaintiff's book. These particulars are to be found partly in a copy of the defendant's book underlined in red ink, and partly in a copy of the plaintiff's book marked with a pencil circle in the margin. It is, of course, clear that the plaintiff has not acquired the right to the materials which were common sources of information or the work of other authors. The defendant was free to use common materials as well as Professor Moore Smith and the work of authors other than Professor Moore Smith without infringing the plaintiff's copyright. The question is whether the defendant's book or any substantial part thereof was copied from the plaintiff's book, or whether it was the result of independent labour and research and a resort to sources of information that were open to all or from works other than the plaintiff's book? "It is not sufficient," as Mr. Justice *Story* said in *Emerson* v. *Davies* (5), "to show, that it" (the defendant's book) "may have been suggested by" the plaintiff's book, "or that some parts and pages of it have resemblances" to the plaintiff's book. "It must be further shown, that the resemblances in those parts and pages are so close, so full, so uniform, so striking, as fairly to lead to the conclusion" that the one was copied from the other in whole or in a substantial part. In the editor's note to the defendant's edition of Henry the Fifth Professor Brereton says that in its preparation he has made full use

(1) (1900) A.C., 539.
(2) (1894) A.C., 335.
(3) 3 Story, 768.
(4) (1914) 2 Ch., 566.
(5) 3 Story, at p. 787.

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of the labours of his predecessors, and was indebted particularly to the edition of Henry the Fifth by Porter and Clarke (1st fol. ed.), Moore Smith (Warwick edition) and Verity (Pitt Press), and had constantly referred to standard works of reference. The plaintiff relied upon this statement and the resemblances to its book which are to be found in the defendant's book, but it adduced no further evidence. Unfortunately Professor Brereton has long since destroyed his manuscript notes, which might perhaps have afforded some help in solving the question of fact here involved, and unfortunately also his memory as to the precise sources of his notes and comments is far from clear. But Professor Brereton is a scholar of repute and well acquainted with Shakespearian literature. And I have no doubt, and find as a fact, that the defendant's book was the result of some independent knowledge and considerable labour, research and skill on the part of Professor Brereton. Apart from his oath on the subject, which I accept, there is internal evidence in Professor Brereton's book that in its preparation he resorted to the sources of information open to all and to the works of other authors just in the same manner as did Professor Moore Smith. [His Honor referred to a few instances of this internal evidence.] Nevertheless, without attributing the *animus furandi* to Professor Brereton, it is still possible, owing to ignorance of the copyright law or carelessness, that he has made more use of the plaintiff's book than can be justified. This has led me to a detailed examination of the two books and a consideration of the various works which Professor Brereton in his evidence stated that he had consulted. And for the purpose of this examination I took it to be clear that, as to literary works, the object of the *Copyright Act* is not to accord protection to ideas but to the particular form of expression in which an author conveys his ideas or information to the world. (See *Hollinrake* v. *Truswell* (1); *University of London Press Ltd.* v. *University Tutorial Press Ltd.* (2); *Copinger on Copyright*, 5th ed., p. 2.) It may be that Professor Brereton derived some of his ideas from Professor Moore Smith, but, as Mr. *Dixon* very properly said, it was legitimate for Professor Brereton in preparing his edition to acquaint himself with the views of scholars, including Professor

(1) (1894) 3 Ch., 420, at p. 424. (2) (1916) 2 Ch., 601, at p. 608.

Moore Smith, and to allow those views to influence him in annotating his edition of Henry the Fifth. It would be unreasonable in this judgment to deal specifically with every passage in the defendant's book which has been challenged, though I have considered each of them. And I can do justice to the parties by indicating in general terms my findings in point of fact. The plan and arrangement of the defendant's book was not copied from the plaintiff's book. It is a common form (see Deighton's and Verity's editions of Henry the Fifth), but it was really adopted from the plan pursued by Professor Wallace, the general editor of "The Australasian Shakespeare," in his annotated edition of Twelfth Night, which was the first of the series of Shakespeare's plays published by the defendant. The text of the play was not copied from the plaintiff's book. It is founded on the first folio edition, and was an independent selection by Professor Brereton. Parts of the general introduction to the defendant's book are taken from the plaintiff's book under a colourable disguise, but the rest of the introduction was gathered from various sources. The part that was taken commences with the words "The source from which Shakespeare drew the historical material for his play" on page VIII. of the defendant's book and ends with the words "They have sealed their own doom" on page XII. I do not say that Professor Brereton was not to some extent assisted by his own knowledge and by other sources of information in this part of the introduction, but the internal evidence satisfies me that the defendant's illustrations of Shakespeare's divergence or deviation from history were taken from the plaintiff's book. Mr. Boswell Stone, in his edition of Henry the Fifth, had no doubt collected all the illustrations mentioned by Professor Brereton, and Mr. Verity has noted some with acknowledgment to Mr. Stone, but the plaintiff's book and not these authors was the source from which Professor Brereton took his illustrations and developed this part of his introduction. [His Honor in an appendix set forth the resemblances which led him to the conclusion already stated.] The introductory comments to Act I., Scene I., beginning with the words "This scene" and ending with the words "charm of his eloquence" are also taken under colourable disguise from the plaintiff's book. The arrangement of the note, the use of the words

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"main theme" for "main action," "many sided genius" for "genius," "charm of his eloquence" for "his charm of speech," and the identical words "moral reformation" are coincidences which the fact that both authors were giving a short summary of the same scene does not explain. The appendices A, B and C and the glossary in the defendant's book were not copied from the plaintiff's book. I am satisfied that Professor Brereton resorted in the main for his glossary to Schmidt's Lexicon, to the Shakespearian glossary by Mr. Onians and to the new English Dictionary edited by Sir James Murray. I ought, perhaps, to note the word "gross" in the defendant's glossary. There is an erroneous reference to line 106 which also appears in the plaintiff's book. The reference was probably taken from the plaintiff's book, and much stress was placed upon the fact. It is an isolated instance, and trivial in itself. The notes upon the text remain for consideration. Here the resemblances between the plaintiff's and the defendant's books are certainly remarkable. Some of these resemblances arise from the nature of the case, namely, the fact that two scholarly men were expounding the meaning of some word or passage in simple language for the use of students. I am convinced, however, that the great bulk of these resemblances arise from the fact that Professors Moore Smith and Brereton resorted to many of the same authorities, though it must be mentioned, in passing, that Professor Brereton had also the advantage of Mr. Verity's annotated edition of Henry the Fifth, which was not published when Professor Moore Smith prepared his book. Still, Professor Brereton did take either verbatim or under colourable disguise some notes from the plaintiff's book. The internal evidence of some of the notes satisfies me of this fact. [In an appendix his Honor set out these cases side by side.] As to the rest of the notes I find that they were not taken from the plaintiff's book.

Ought I on these facts to hold that the defendant has infringed the plaintiff's right? Has the defendant, to use the words of the statute, reproduced a substantial part of the plaintiff's book (see *Chatterton* v. *Cave* (1); *Leslie* v. *Young & Sons* (2)); or, as *Page Wood* V.-C. said in *Jarrold* v. *Houlston* (3), has an unfair or undue use been made

(1) 3 App. Cas., 483. (2) (1894) A.C., at p. 341.
(3) 3 K. & J., 708, at p. 714.

of the work protected by copyright? The question is, in truth, one of fact and not of law: "it is a question of degree, which must depend upon the circumstances of each particular case" (*Sweet* v. *Benning* (1), per *Jervis* C.J.; *Chatterton* v. *Cave* (2)). *Moffatt & Paige Ltd.* v. *Gill* (3) was much relied upon for the plaintiff, but the decision affords but little assistance in the present case. The facts in the two cases are quite dissimilar. It is undoubted that the books in question here are in direct competition for use in schools and for students in the Universities of Australia, and were intended so to be. The choice of Professors in Australian Universities as editors of the defendant's series of Shakespeare's plays was well calculated to assist the defendant in that competition. Even the remuneration of Professor Brereton depends upon the successful sale of the book prepared by him. In these circumstances it was the special duty of the defendant and its editor to avoid the appropriation of the labour and research of its rivals. The defendant did, in my opinion, appropriate a substantial and valuable portion of the plaintiff's general introduction to its book. It is true, but nothing to the point, to say that the information could have been derived from other sources. A considerable amount of labour and independent research was thus saved, and a useful and interesting addition was made to the general introduction of the defendant's book. The notes cannot be considered apart from the introductory comments for the purposes of infringement. The quantity of notes taken is not very considerable, and, taken by themselves, these notes are not, in my opinion, of any outstanding value. From about 110 pages of notes the defendant has taken about 50 separate notes. The notes in the defendant's book cover about 89 pages. The material and sometimes the very note taken from the plaintiff is intermixed with material the result of Professor Brereton's own knowledge or of independent labour and research on his part. In some cases in the notes acknowledgment is made to Professor Moore Smith, but this is the exception and not the rule. The defendant's book is by no means a "servile imitation" of the plaintiff's work, and is largely a "compilation from other common or independent sources" (*Emerson* v. *Davies* (4)).

(1) 16 C.B., 459, at p. 481.
(2) 3 App. Cas., 483.
(3) 86 L.T., 465.
(4) 3 Story, at pp. 793-794.

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Giving, however, the fullest consideration to all these facts, the appropriation by the defendant of the plaintiff's labour and research is, I find, on the whole, substantial and material, and beyond what was a fair and legitimate use of the plaintiff's book in all the circumstances of the case. The extracts were made, I do not doubt, for the purpose of enhancing the value of the defendant's book, and I see no reason for saying that the defendant did not achieve its purpose. Further, these extracts saved the defendant and its editor some labour and research.

It is not for the Court to make the way of the taker of copyright matter easy. It is a sound principle of copyright law that the Court should not allow one man to take away the result "of another man's labour, or, in other words, his property," unless it is satisfied that the part taken is "so slight, and the effect upon the total composition was so small," "as to render the taking perfectly immaterial," or, what is much the same thing, that the part taken is an unsubstantial part (*Hogg* v. *Scott* (1); *Chatterton* v. *Cave* (2)).

The extent of the relief that should be given in this case is somewhat important. A great deal of the defendant's book was not copied from the plaintiff's book, and the defendant should not be prohibited from using it so far as it lawfully can. If only part of a work has been copied and that part can be separated from the rest of the book, the Court can limit its order to the parts that have been copied (*Jarrold* v. *Houlston* (3); *Leslie* v. *Young & Sons* (4); *Lamb* v. *Evans* (5)). Such an order may render the use of the rest of the book difficult or impracticable, but the party who is in fault cannot complain, and must suffer from the consequences of his own wrongdoing (*Mawman* v. *Tegg* (6)). The offending passages can, I think, be easily and clearly separated in the present case.

I am not disposed to order the destruction of the defendant's book or any part of it. The plaintiff may have an inquiry as to damages at its own risk as to costs, but I would suggest that the plaintiff, in its own interest, waive this right.

The defendant must pay the costs of this action.

(1) L.R. 18 Eq., 444, at p. 458.
(2) 3 App. Cas., at pp. 490, 495.
(3) 3 K. & J., 708.
(4) (1894) A.C., at p. 342.
(5) (1892) 3 Ch., 462.
(6) 2 Russ., 385, at p. 391.

1. *Order that the defendant, its editors, managers, canvassers, agents, workmen and clerks, be perpetually restrained from further printing, publishing, selling, delivering or otherwise disposing of or causing or permitting to be published, printed, sold, delivered or otherwise disposed of, a book in the statement of claim called "The Australasian Shakespeare Henry the Fifth" containing the following passages or notes or any or either of them or any part of them respectively:—(a) The passage in the general introduction to the defendant's book on page* VIII. *beginning with the words "The source from which Shakespeare drew the historical material" to and inclusive of the words on page* XII. *"They have sealed their own doom." (b) The introductory comments to Act I., Scene* I., *on page* 114 *of the defendant's book beginning with the words "This scene introduces the main theme of the play" to and inclusive of the words "the charm of his eloquence." (c) The textual notes:—[The particular notes were set out.]*
2. *Order that an inquiry be taken (at the risk of the plaintiff) of what damages have been sustained by the plaintiff by reason of the sale of books containing the passages and notes aforesaid.*
3. *Order that the defendant do pay to the plaintiff its costs of this action (including costs of discovery if any) such costs to be taxed.*

Solicitors for the plaintiff, *Smith & Emmerton* for *Minter, Simpson & Co.*, Sydney.

Solicitor for the defendant, *S. A. Ralph.*

B. L.