

Desktop Marketing Systems Pty Ltd v Telstra Corporation Limited [2002]
FCAFC 112

FEDERAL COURT OF AUSTRALIA

BLACK CJ, LINDGREN & SACKVILLE JJ

BLACK CJ:

1 I agree that the appeal should be dismissed with costs for the reasons given by
Lindgren J and Sackville J, and add the following observations.

2 Ground of appeal 14 was that the primary judge should have found, on the evidence,
that Telstra's industry:

*“was not in collecting but was principally and relevantly limited to receiving
(as a matter of monopolistic entitlement), checking, maintaining and
publishing data.”*

3 This ground was developed in par 14 of Desktop's outline written submissions,
which, omitting footnotes and the references to them, was as follows:

*“In this case the Judge erred in holding that the Respondent had satisfied the
'industrious collection' test for subsistence of copyright because, on the
evidence, such industry as there was on the part of the Respondent was not in
collecting, but principally and relevantly limited to receiving (as a matter of
statutory monopolistic entitlement) data. The whole basis of the so-called
'industrious collection' approach is to protect the industry of a party from a
commercially unfair free ride by copyists. There is no free ride here. All
'industrious collection' cases (especially those relied upon by Telstra) were
ones where:*

*(a) the copyist could have, with sufficient industry, replicated the
database. That is not so here. No amount of industry could replicate
the Telstra database because of the privileged position Telstra enjoys
in granting lines and telephone numbers on the condition that the
subscriber proves such information and updates it as requested.*

*(b) The plaintiff was commercially disadvantaged by the copyist's
activities. Here Telstra is statutorily obliged to and does produce and
distribute the directories free of charge, and thus there can be no
suggestion of commercial damage to Telstra.*

*If there is any unfairness, it is the result of Telstra refusing to provide access
to its database on reasonable terms despite an obligation to do so.”* (emphasis

in the original)

The point was not substantially elaborated upon in oral submissions but was raised again in written submissions in reply.

4 In *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991), referred to in the judgments of the other members of the Court, Rural Telephone Services Co (“Rural”) was a certified public utility which, as a condition of its monopoly, published white pages and yellow pages directories and provided them free of charge to its subscribers.

5 In delivering the opinion of the United States Supreme Court, O’Connor J (at 362) observed that, in preparing the white pages directories, Rural simply took the data received from its subscribers and listed the data alphabetically by surname. Her Honour made that observation in support of her description of the “end product” as “a garden-variety white pages directory, devoid of even the slightest trace of creativity”. Her Honour also referred (at 363) to the fact that Rural was “required [to publish the names and telephone numbers of its subscribers] by the Kansas Corporation Commission as part of its monopoly franchise”. Her Honour made that observation in support of her view that there was no “selection” by Rural of the data to be published.

6 The considerations relied on by Desktop may thus point against the existence of a “spark of creativity”, but once that test of originality is rejected the question is whether a particular form of labour is determinative in attracting copyright protection. The reasons in *Feist* provide no ground for concluding that Telstra’s various forms of labour (collecting/receiving, verifying, recording, computer-aided assembling) should not suffice to attract copyright protection.

7 Turning then to the lines of authority in Australia and England, it is true that in most if not all of the so-called “industrious collection” cases the effort and expense applied by the author of the compilation included effort and expense in the *collection* of the data from external sources. This occurred by way of research (*Hogg v Scott* (1874) LR 18 Eq 444, *Ager v Peninsular & Oriental Steam Navigation Co* (1884) 26 Ch D 637, *Collis v Cater*, *Stoffel & Fortt Ltd* (1898) 78 LT 613, *G A Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329, *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd* [1979] FSR 46, *Harpur v Lambourne* (1999) 45 IPR 213); extraction from independent written sources (*Scott v*

Stanford (1867) LR 3 Eq 718, *T M Hall & Co v Whittington & Co* (1892) 18 VLR 525, *Leslie v J Young & Sons* [1894] AC 335, *H Blacklock & Co Ltd v C Arthur Pearson Ltd* [1915] 2 Ch 376); survey, canvassing or solicitation (*Kelly v Morris* (1866) LR 1 Eq 697, *Morris v Ashbee* (1868) LR 7 Eq 34, *Morris v Wright* (1870) LR 5 Ch App 279, *Cox v Land and Water Journal Company* (1869) LR 9 Eq 324, *Weatherby & Sons v International Horse Agency & Exchange Ltd* [1910] 2 Ch 297, *Waterlow Publishers Ltd v Rose* (1989) 17 IPR 493); annotation and documentation of events (*Walter v Lane* [1900] AC 539) or a combination of such activities (*Canterbury Park Race Course Co v Hopkins* (1931) 49 SR(NSW) 27, *Mander v O'Brien* [1934] SASR 87, *Winterbottom for the Western Australian Turf Club v Wintle* (1947) 50 WALR 58).

8 As the discussion of these cases in the judgments of the other members of the Court shows, however, they do not turn upon the circumstance that the effort and expense applied was in the collection, rather than receipt, of data. In general, they turn upon a reluctance of the Courts to allow unfair advantage to be taken of the outlays of another in originating a work.

9 In any case, to conclude that Telstra “receives” rather than “collects” the data is to pay insufficient attention to the fact that, even in the case of the White Pages, Telstra receives the data only because it has undertaken the effort and expense of setting up and maintaining systems to get the data from both new and existing subscribers. In a real sense, Telstra does collect the data for the purpose of its compilations and certainly the process can aptly be described as “collecting/receiving”.

10 There was no submission by Desktop that Telstra did not employ substantial labour and funds in the production of its directories and no such submission could reasonably have been made. There was much evidence before the learned trial judge that it did so and his Honour gave a brief summary of the labour involved, most of it relating to computer programs and databases but including also references to considerable and continuing involvement by editors and other people. Desktop’s submission is that Telstra’s labour, extensive as it might be, was nevertheless of a kind that cannot establish originality. That submission is not supported by the lines of Australian and English authority. Moreover, if accepted, it would involve the illogical result that work of “industrious collection”, understood in a narrow sense focussing on the activity of collection, would, even if of the

quite limited nature considered in some of the earlier cases, serve to found copyright protection for a compilation, whilst the laborious and costly computer-aided compilation activity engaged in by Telstra would not do so. The submission should be rejected.

11 Whether the same result would follow if the compilation in issue were produced from data harvested from transient information flows by an established computer program is, of course, a separate question. This case turns on its own facts.

12 I should add that I see no reason why copyright protection should be denied to Telstra by reason of its work in producing its directories being facilitated by obligations arising under statute or because it had an obligation, also arising under statute, to produce the directories.

LINDGREN J:

13 I gratefully adopt Sackville J's account of the background facts and of the relevant provisions of the *Copyright Act 1968* (Cth) ("the Act").

14 Telstra Corporation Ltd ("Telstra") alleges in its further amended statement of claim ("the Pleading") that Desktop Marketing Systems Pty Ltd ("Desktop") infringed its copyright in the White Pages Directories, the Yellow Pages Directories (the "Directories") and the Headings Books referred to in Annexures A, B and C respectively to the Pleading. Annexure A identifies the 1996-1999 White Pages Directories for all 55 Australian Telstra directory regions. Annexure B identifies the 1997-1999 Yellow Pages Directories for those 55 regions. Annexure C identifies two Headings Books, one intituled "Metropolitan Directories" and the other "Regional & Local Directories", in each case for 1997 and for 1998.

15 Both the White Pages Directories and the Yellow Pages Directories included information pages as well as their respective directory sections. The Yellow Pages Directories also included graphics, enhancements and advertisements. Desktop copied the data contained in the directory sections of the White Pages Directories and the Yellow Pages Directories, and separately stored those two bodies of data in databases. Desktop did not, of course, have access to Telstra's Heading Books. However, it copied headings from the Yellow Pages Directories, using them as descriptions of the lines of business of subscribers whose details it took from those Directories. In this way the headings that were copied formed part of the database founded on the Yellow Pages Directories. Accordingly, Telstra's

case in respect of the Headings Books is one of indirect infringement. Desktop did not copy any of the information pages, graphics, enhancements or advertisements.

16 This case is concerned with the element of “originality” in respect of compilations of factual information. Originality is not only an essential element if a work is to be protected by copyright (an “original literary, dramatic, musical or artistic work”; cf subss 32(1) and (2) of the Act); it is also an important aspect of infringement. The reason is that the notion of a “substantial part” of a work, reproduction of which, without licence of the copyright owner, is a form of infringement of the copyright in the work (cf subss 31(1) and (2) and 36(1) and par 14(1)(a) of the Act), is regarded as referring, generally speaking, to the original aspects or features of the work.

17 It follows that there is an element of artificiality in discussing subsistence and infringement separately, but I will do so for convenience.

SUBSISTENCE OF COPYRIGHT

18 The appeal raises the following issues in relation to the subsistence of copyright:

1. whether the Act’s requirements of originality and authorship can be satisfied, in the case of a compilation of factual information, by nothing more than labour and expense, or whether those requirements necessitate what has been variously called “intellectual effort” or a “creative spark” in respect of one or more of: the form of the individual entries, the selection of the elements to be included in the compilation, or the arrangement of the compilation as a whole (“the First Issue”); and
2. if the First Issue is answered favourably to Telstra, whether Telstra’s labour and expense qualify its White Pages Directories, Yellow Pages Directories and Headings Books as original literary works (“the Second Issue”).

(The First Issue has been much discussed; see, for example, Norman Siebrasse, “Copyright in Facts and Information: *Feist Publications* is not, and should not be, the Law in Canada” 11 *CIP Rev* 191 (1994); L Ray Patterson and Craig Joyce, “Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations” 36 *UCLA L Rev* 719 (1989); Judith Bannister, “Originality and Access; copyright protection of compilations and databases” (1999) 10 *Journal of Law and Information Science* 227; Jane C Ginsburg,

“Creation and Commercial Value: Copyright Protection of Works of Information” 90 *Colum L Rev* 1865 (1990); Jane C Ginsburg, “No ‘Sweat’? Copyright and Other Protection of Works of Information After *Feist v Rural Telephone*” 92 *Colum L Rev* 338 (1992); William Patry, “Copyright in Compilations of Facts (or Why the ‘White Pages’ Are Not Copyrightable)” 12 *Communications and the Law* 37 (1990); Robert C Denicola, “Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works” 81 *Colum L Rev* 516 (1981); Shira Perlmutter, “The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain” 38 *J Copyright Soc’y USA* 1 (1990-1991); Thomas P Arden, “The Conflicting Treatments of Compilations of Facts under the United States and United Kingdom Copyright Laws” (1992) 3 *Ent L Rev* 43; Mark Sherwood-Edwards, “The Redundancy of Originality” (1995) 6 *Ent L Rev* 94; Gary Lea, “In Defence of Originality” (1996) 7 *Ent L Rev* 21; David B Wolf, “Is there any Copyright Protection for Maps after *Feist*” 39 *J Copyright Soc’y USA* 224 (1992); Sam Ricketson, “The Concept of Originality in Anglo-Australian Copyright Law” 39 *J Copyright Soc’y USA* 265 (1992).

19 For convenience in what follows, I will, until indicated otherwise, discuss the two issues mentioned in relation to the directory section of the White Pages Directories – names, addresses and telephone numbers (for some subscribers, their facsimile machine, mobile telephone and paging service numbers were also included, but this is not material), although my observations also apply, with necessary adjustments, to the directory section of the Yellow Pages Directories.

20 It is not disputed that the directories are compilations and therefore literary works. Nor is it disputed that if they are original literary works, Telstra owns the copyright in them.

21 The case is a “whole-of-universe” case, that is, there is no selection of the subscribers to be included. The universe for each regional directory is all subscribers in the region, except those who have a private (“silent”) number. The details of subscribers reflect facts in the real world. All persons thoroughly exploring the same universe would discover the same factual information.

22 Moreover, a telephone directory permits of only one mode of arrangement of the factual information (a listing alphabetically by family name) and it permits of only one mode of expression of the individual entries (subscribers’ names with family name first, followed

by addresses and telephone numbers). The alphabet did not originate with Telstra. Both Telstra and the users of the directories approach the production and use of directories knowing the alphabet, understanding that it will provide the key to the factual information recorded in the directories, and understanding that the individual entries for subscribers will follow an inescapable form dictated by the alphabetical arrangement of the directory as a whole.

23 There are other compilations which both the compiler and intending users understand will be structured or arranged alphabetically, numerically or chronologically (such as the listing of placings, tipped or actual, in a race (cf *Smith's Newspapers Ltd v The Labor Daily* (1925) 25 SR (NSW) 593 ("*Smith's Newspapers*"), *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479 ("*Victoria Park*") at 497) and the days of the week in an annual calendar. But more commonly, there is some "scope for variance" in the manner in which both the individual pieces of factual information are recorded, in the selection of the factual details to be compiled, and in the arrangement of the compilation as a whole. But in the category of case of which the present directories provide an illustration, the compiler and users understand:

- that there will be no selection of the items to be compiled: **all** facts within the pre-defined category will be included;
- that the facts to be recorded for each entry will be expressed in a particular way; and
- that the compilation as a whole will be arranged in a particular way.

24 Accordingly, anyone given the task of producing a directory of the subscribers in a particular geographical region would produce a directory relevantly identical in form, as well as in content, to Telstra's.

25 As was emphasised by the United States Supreme Court in *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991) ("*Feist*"), the compiler of factual information is not the author or originator of the individual facts recorded in the compilation: they already exist. According to that Court, this consideration, coupled with the axiom that copyright in literary works protects forms of expression and not ideas, leads to the conclusion that where, as here, there is no scope for selection, for variance in the mode of expression of the individual items, or for variance in the mode of arrangement of the compilation as a whole, so that both content and form are "foregone conclusions", copyright cannot subsist in

the compilation. The Court was of the opinion that to accord copyright protection in those circumstances would be to accord it to facts or ideas.

26 It is at law, if not in practice, open to a person to ascertain all the facts recorded in a Telstra directory by independent inquiry and to compile his or her own directory containing the results. So long as the second compiler did not copy Telstra's product, there would be no infringement of any copyright in the (identical) Telstra directory, any more than the existence of copyright in a photograph of a scene signifies that there is copyright in the scene itself, which, therefore, a later photographer is not at liberty to photograph from the same viewpoint (cf *Creation Records v News Group Newspapers Ltd* (1997) 39 IPR 1).

27 In any event, it is said that the course of English and Australian authority is such that we must not or should not follow *Feist*. I have found it necessary, in order to consider this proposition, to review in chronological sequence the numerous English and Australian cases to which we were referred.

The pre-1911 cases

28 In *Matthewson v Stockdale* (1806) 12 Ves 270 (33 ER 103) an interlocutory injunction protecting the plaintiff's copyright in a directory of "all the names and appointments on the Indian Establishment" (at 276 (ER 105)) survived a motion for dissolution. The case is distinguishable on its facts in that the plaintiff had composed the entries, as to which there was scope for variance, and prepared an alphabetical index. Nonetheless, Lord Erskine LC only reluctantly accepted that copyright subsisted. His Lordship said (at 273 (ER 104)):

"Thinking it dangerous to carry this doctrine of copyright too far, the turn of my mind would lead me to a different decision of this case from that, which, following what I find the established law, I mean to give. Several cases have occurred, in which it was at least as difficult to maintain copyright; and yet it has been maintained."

The Lord Chancellor referred to cases of a map of an island and a chart of the English Channel, and said that there was **no room for originality on such subjects**, yet acknowledged that considerable expense and labour had in fact been protected by the law against "servile imitation". The Lord Chancellor was referring to considerable expense and labour in the antecedent identification of the facts to be described. To this extent,

Matthewson v Stockdale lends some support to the subsistence of copyright in the telephone directories.

29 *Longman v Winchester* (1809) 16 Ves Jun 269 (33 ER 987) was also an unsuccessful motion to dissolve an interlocutory injunction. The work was described as “containing lists of the Houses of Peers and Commons, &c”. There was verbatim copying by the defendant. The Lord Chancellor stated (at 270-271 (ER 987)):

“I cannot go the length of stating the proposition, that copyright cannot subsist in a work of this description: nor would I disturb the Injunction upon that ground without putting them to a trial. Assuming, that there may be a copyright, there is not much difficulty in the rest of the case. Take the instance of a map, describing a particular county; and a map of the same county, afterwards published by another person: if the description is accurate in both, they must be pretty much the same: but it is clear, the latter publisher cannot on that account be justified in sparing himself the labour and expense of actual survey, and copying the map, previously published by another.”

His Lordship concluded (at 272 (ER 988)):

“... I have said nothing, that has a tendency to prevent any person from giving to the public a work of this kind; if it is the fair fruit of original labour: the subject being open to all the world: but if it is a mere copy of an original work, this Court will interpose against that invasion of copyright.”

Longman v Winchester supports the availability of copyright to protect industrious collection of the information to be recorded, even if the form of expression is inevitable.

30 The *Literary Copyright Act 1842* (UK) (5 & 6 Vic c45) (“the 1842 UK Act”) contained provisions relating to copyright in “books” (as defined), and defined “copyright” for the purposes of the construction of that Act, to be:

“The sole and exclusive Liberty of printing or otherwise multiplying Copies of any Subject to which the said Word is herein applied.”

The 1842 UK Act did not state that copyright did not exist independently of that Act or expressly identify the circumstances in which it did exist. There was no reference to originality, but there were several references to a book’s “author”. For example, s 3 provided that the copyright in every book published after the passing of the 1842 UK Act and in the lifetime of its author should subsist for the lifetime of the author plus seven years and should be the property of the author and his assigns. Until *Walter v Lane* [1900] AC 539 (discussed below), the pre-1911 English cases on the subsistence of copyright in compilations made scant, if any, reference to the terms of the 1842 UK Act.

31 The fact that some facts would or might be described by independent authors in the same or similar words was referred to in *Spiers v Brown* (1858) 6 WR 352. The plaintiff was the author of a two-volume dictionary, comprising English–French and French–English parts, and an abridgment of the dictionary for school children. He alleged that the defendant had infringed the copyright in the French–English part and in the abridgment.

32 Vice Chancellor Wood dismissed the bill for an injunction. He referred (at 352) to the difficulty which arose in cases such as dictionaries, directories, calendars and Court Guides, which:

“not only related to a subject common to all mankind, but ... the mode of expression and language [of which] was necessarily so common that two persons must, to a very great extent, express themselves in identical terms ...”

The Vice Chancellor saw the issue for decision as whether the defendant had not made more than legitimate use of the plaintiff’s work, and decided he had not.

33 The case is quite unlike the present one in which Desktop has taken the whole of Telstra’s directory, then rearranged and added to the data recorded in it.

34 In *Hotten v Arthur* (1863) 1 H & M 603 (71 ER 264) the plaintiff, a bookseller, collected very old and curious books and issued catalogues from time to time in respect of his collection. The catalogues were not mere lists of the books and their prices, but contained, in a great majority of instances, a short account of a book’s history or contents or an anecdote concerning it. In granting an injunction, the Vice Chancellor, Sir W Page Wood, remarked that the catalogue was not “a mere dry list of names, like a postal directory, Court guide, or anything of that sort, which must be substantially the same by whatever number of persons issued and however independently compiled” (at 607-608 (ER 265-266)). That is to say, the Vice Chancellor distinguished the case from a case such as the present one, because there was some scope for variance in mode of expression. *Hotten v Arthur* therefore says nothing to the issue calling for our decision.

35 The first of “the three *Morris* cases” was *Kelly v Morris* (1866) LR 1 Eq 697. Kelly owned and published the “*Post-office London Directory*”; the defendant, the “*Imperial Directory of London 1866*”. The plaintiff’s work was updated and issued annually. It had come to contain twelve divisions or directories, and, excluding advertisements, comprised

2483 pages “indexed externally in a manner invented for the Plaintiff, and first used by him in his directory” (at 697). Sir W Page Wood VC stated (at 701-702):

“In the case of a dictionary, map, guide-book, or directory, when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road-book, he must count the milestones for himself. In the case of a map of a newly-discovered island (the illustration put by Mr Daniel) he must go through the whole process of triangulation just as if he had never seen any former map, and, generally, he is not entitled to take one word of the information previously published without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and the only use that he can legitimately make of a previous publication is to verify his own calculations and results when obtained. So in the present case the Defendant could not take a single line of the Plaintiff’s Directory for the purpose of saving himself labour and trouble in getting his information.” (my emphasis)

This passage clearly supports the subsistence of copyright in the present telephone directories: the Vice Chancellor contemplated protection of the compiler’s labour and expense of getting the factual information to be compiled, regardless of the absence of scope for variance in mode of expression. The case is one of many nineteenth century cases in which copyright protection is supported by reference to general statements that one may not appropriate the fruit of another’s labour or reap where one has not sown. It is, however, noteworthy that shortly after the passage set out above, the Vice Chancellor observed (at 702) that in fact the plaintiff had “adopted a very ingenious form of arrangement, which [was] to be found in no other directory that [had] been produced, except the Defendant’s”. Accordingly, although the passage set out above applies to the telephone directories with which we are concerned and supports the subsistence of copyright in them, *Kelly v Morris* is factually distinguishable from the present case.

36 *Scott v Stanford* (1867) LR 3 Eq 718 concerned statistical returns of the Coal Market of the City of London (“the Corporation”) published by the plaintiff who was the Corporation’s clerk and registrar. The plaintiff extracted the statistics from the books of the Corporation with its authority. Indeed, the Corporation allowed him the exclusive right to compile, print and publish the returns showing the quantity of imports into London from various collieries, as part of the remuneration attached to his appointment. The defendant published a work which included a chapter of coal statistics and acknowledged the plaintiff’s

work as their source.

37 The Vice Chancellor, Sir W Page Wood, noted that the subsistence of the plaintiff's copyright had been "only faintly impugned" (at 723). He observed (at 723):

"he has, at the expense of much time and labour, compiled and arranged, in very clear and lucid order, the vast mass of information accruing every day as to the importation of coal into the City ... It appears to me quite immaterial whether he has been assisted in the compilation by his own clerks, or by those of the Corporation. A great deal of time and labour must have been spent in this compilation, more, indeed, than in the case of a directory or guide; and there can be no doubt that he is entitled to be protected in the fruits of his labour."

The case is readily distinguishable from the present one. The form of the compilation originated with the plaintiff and was not inevitable. Indeed, the only issue as to subsistence appears to have been whether the plaintiff or the Corporation was the "author" of the work. Nevertheless, what the Vice Chancellor seems to have treated as calling for protection was the plaintiff's labour in selecting, extracting and compiling the information.

38 The second of the three *Morris* cases was *Morris v Ashbee* (1868) LR 7 Eq 34. Morris, who had been the unsuccessful defendant publisher of "*The Imperial Directory of London 1866*" in *Kelly v Morris*, was now the compiler of "*The Business Directory of London*". He sought to restrain publication by Ashbee of a rival directory "*The Merchants' and Manufacturers' Pocket Directory of London 1868*". Morris's work comprised the names and occupations of the merchants, traders and other persons carrying on business or residing in London and environs. The names were contained in a classified list of the various trades and professions arranged in alphabetical order, and also in another list in alphabetical order by names (the similarity to Yellow Pages and White Pages Directories respectively is noteworthy). As well, the directory contained advertisements and "extra lines" of business descriptions for those willing to pay for them. The plaintiff's copyright was not in terms denied or its existence distinctly put in issue.

39 The Vice Chancellor, Sir George Giffard, finding for the plaintiff, stated (at 40-41):

"The plaintiff incurred the labour and expense first of getting the necessary information for the arrangement and compilation of the names as they stood in his directory, and then of making the actual compilation and arrangement, and, though each individual who paid might no doubt have his own name printed in capital letters or with the same superadded lines

wherever he chose, neither one nor all of them could authorize the cutting of a series of slips, or the taking of the names as arranged, from the Plaintiff's directory, and the use of them in the printing of a rival work. ... the substance of the judgment [in Kelly v Morris] is, that in a case such as this no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road. If this was not so, there would be practically no copyright in such a work as a directory. ... The simple upshot of the whole case is, that the Plaintiff's directory was the source from which they compiled very material parts of theirs, and they had no right so to resort to that source. They had no right to make the results arrived at by the Plaintiff the foundation of their work or any material part of it, and this they have done." (my emphasis)

Although the Vice Chancellor referred in the first sentence to the labour of actually composing the compilation as well as to the antecedent labour of getting the information to be compiled, there is no suggestion that the latter alone, if sufficient, would not have attracted copyright protection. Indeed, the latter part of the passage discusses only the labour and expense of "working out and arriving at [the] results". The passage supports the subsistence of copyright in Telstra's directories.

40 In *Cox v Land and Water Journal Company* (1869) LR 9 Eq 324, the plaintiff published "*The List of Hounds*" in his "*Field*" newspaper and sought an injunction restraining the defendants from publishing "*The Hunting Field of 1870*" in their "*Land and Water Journal*". The plaintiff's list comprised particulars of the various packs of hounds in the United Kingdom, including the name of each hunt, the nearest town convenient for strangers, the number of hounds in the pack, the hunting days, the names of the masters, huntsmen and whips, and the address of the kennel.

41 Vice Chancellor Malins observed that the hunting days and the names of the masters of hunts and of the huntsmen were well-known, but that the whips were not, "being numerous and obscure persons" (at 332). The Vice Chancellor assumed, for the purposes of an application for an interlocutory injunction, that the law regarding compilations of factual information had been correctly stated in *Kelly v Morris* and *Morris v Ashbee*. He said (at 332):

"It is clear that in this case the getting the names of masters of hunts, the numbers of hounds, the huntsmen, and whips, and so forth, is information open to all those who seek to obtain it; but it is information they must get at their own expense, as the result of their own labour, and they are not to be entitled to the results of the labours undergone by others. And this is the

principle of Kelly v Morris.”

Again, it was the getting of the factual information to which reference was made as attracting copyright protection, although no doubt there was, as a matter of fact, some scope for variance in the form of expression of the compilation. The getting of the information is comparable to Telstra’s collection of details of telephone subscribers. *Cox v Land and Water Journal Company* supports the subsistence of copyright in the present directories.

42 The third *Morris* case was *Morris v Wright* (1870) LR 5 Ch App 279. Morris again asserted copyright in his publication “*The Business Directory of London*”. James VC granted, and subsequently dissolved, an interlocutory injunction. Morris appealed against the dissolution. Giffard LJ affirmed the Vice Chancellor’s decision on the basis that on the evidence, the defendants had used the plaintiff’s work only to direct them to other sources of information (cf *Pike v Nicholas* (1869) LR 5 Ch App 251), whereas in *Kelly v Morris* and *Morris v Ashbee* there had been direct copying. Giffard LJ said that the substance of the judgment in *Kelly v Morris* was that in a case such as that before him:

“no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at those results by some independent road.” (at 286)

Again the Court relied on notions of unfair competition, but, again, no doubt there was in fact scope for a spark of creativity in mode of expression, whereas there is not in the present case. Nonetheless, the passage set out above supports the subsistence of copyright in telephone directories.

43 In *Hogg v Scott* (1874) LR 18 Eq 444, the plaintiff was the author and proprietor of a book called the “*Fruit Manual*” from which the defendant had copied, frequently verbatim, and at other times with slight or merely colourable alterations. Vice Chancellor Hall granted an injunction on the authority of *Kelly v Morris* and *Morris v Wright*, stating (at 458):

“The true principle in all these cases is, that the Defendant is not at liberty to use or avail himself of the labour which the Plaintiff has been at for the purpose of producing his work – that is, in fact, merely to take away the result of another man’s labour, or, in other words, his property.”

The expression “for the purpose of producing his work” is akin to the expression “for the purposes of a rival publication” of *Morris v Wright* (above): neither suggests that one kind of labour will serve to give rise to copyright and that another will not. The statement is broad

enough to encompass Telstra's labour in producing telephone directories.

44 *Dicks v Yates* (1881) 18 Ch D 76 was not a compilation case but involved a somewhat extended consideration of the concept of originality before it was introduced as an express condition of copyright protection by the *Copyright Act 1911* (UK) ("the 1911 UK Act"). The plaintiff published in serial form in a weekly periodical a tale intitled "*Splendid Misery; or, East End and West End*" by one, C H Hazlewood. The defendant subsequently commenced publishing in a weekly newspaper issued by him a tale by Mrs Maxwell, commonly known as Miss Braddon, intitled "*Splendid Misery*". The evidence showed that a novel called "*Splendid Misery*" had been published in 1801, that it had enjoyed a large circulation and that second-hand copies of it could still be encountered.

45 Jessel MR thought there could not be copyright in "the common English words" used by the defendant, "*Splendid Misery*", which, it will be recalled, formed only part of the title to the plaintiff's work, and which, his Lordship remarked, had been used as the actual title of a novel as far back as in 1801. Later (at 89) the Master of the Rolls stated:

*"Now I do not say that there could not be copyright in a title, as, for instance, in a whole page of title or something of that kind requiring invention. However, it is not necessary to decide that. But, assuming that there can be copyright in a title, what does copyright mean? It means the right to multiply copies of an original work. If you complain that a part of your work has been pirated, you must shew that that part is original, and if it is not original, you have no copyright. How can the title 'Splendid Misery' be said to be original, when the very same words for the very same purpose were used nearly eighty years ago? The suggested answer is 'People have forgotten that old novel'. But that is not the point. Did the title become public property? If you go by the analogy of the patent law, it is very strong against the Plaintiff, because complete prior publication of an invention in England destroys the claim for novelty on the part of the patentee. I say complete publication, because there have been cases where it was held that a general description was not sufficiently complete and specific to prevent a title in the second inventor. But there is another circumstance. In the case of patentees, where there is a question of originality, you must prove that the alleged inventor was the inventor. **In this case, Mr Hazlewood being dead, and it having been shewn that the title was known many years ago, Mr Hazlewood could not be called, and no one else has been called, to shew that Mr Hazlewood invented the title, or that he did not copy it, as he might have done, from the old novel. Therefore in this case, even assuming you could establish a right to the title as original, if it was reinvented you have no evidence of the re-invention, but you have evidence of the prior publication. It seems to me, therefore, on that ground also that the action must be dismissed.**" (my emphasis)*

Lush LJ stated (at 92-93):

“I take it to be established law that to be the subject of copyright the matter must be original, it must be a composition of the author, something which has grown up in his mind, the product of something which if it were applied to patent rights would be called invention. Nothing short of that would entitle a man to copyright. Now, can it be said there is anything original in these two words? I suppose there is hardly a person who has grown to maturity in this country who has not read them hundreds of times and heard them spoken hundreds of times. To my mind ‘Splendid Misery’ is a hackneyed phrase. Moreover, it is in evidence that about eighty years ago a novel was published with that very title, and that, though it is out of print, second hand copies are still to be met with. If, therefore, we were to go no further back than that, the title has been known to the public for at least eighty years, and I cannot help thinking that the phrase originated many years before that. It was one likely to be coined in a very early age, and is one which, as I said before, most persons must have read and heard hundreds of times. That of itself is enough to determine the case. There is nothing original in the title. There is nothing in it that indicates any intellectual effort. There is nothing more than the taking up a phrase which had long been in public use. It had become public property, and it is impossible that a person can appropriate it and claim copyright in it.” (my emphasis)

I have referred to *Dicks v Yates* at some length because, at first instance in *Robinson v Sands & McDougall Pty Ltd* (1916) 22 CLR 124 (“*Robinson*”) (discussed at [89]-[90] below), Barton J treated Jessel MR and Lush LJ as having attached to the notion of “original” the meaning “not copied, not imitated” (at 132-133). As will be seen below, a “not copied/originating from the putative author” test of originality has now become firmly established. (It is necessary to be cautious in referring to the law of patents not to suggest that the ideas expressed in a literary work must be novel or that the form of expression of them must show inventiveness, and neither Jessel MR nor Lush LJ did so.)

In *Ager v Peninsular & Oriental Steam Navigation Co* (1884) 26 Ch D 637 (“*Ager*”), the defendant admitted that the plaintiff had copyright in “*The Standard Telegram Code*”, a book of about 100,000 words, arranged alphabetically, which the plaintiff had selected from eight languages, specially compiled with a view to correct telegraphic transmissions. Kay J stated (at 642):

*“Applying the usual test [his Lordship cited *Scott v Stanford* and *Kelly v Morris*], it seems to me that the Plaintiff must have expended a great deal of time and labour in this compilation, that what the Defendants are doing is to avail themselves very largely and unnecessarily of the labour and research of the Plaintiff without adequately recompensing him, ...”*

The compilation involved the exercise of skill and judgment in selecting the words to be compiled and is therefore factually distinguishable from the present whole-of-universe case. But the language “labour and research” is entirely appropriate to refer to the industrious collection involved in a whole-of-universe factual compilation.

49 Another “selection” case decided at about the same time was *Macmillan & Co Ltd v Suresh Chunder Deb* (1890) 17 I LR (Calc Series) 951 (which was cited with approval by the Privy Council in *Macmillan & Co Ltd v K & J Cooper* (“*Macmillan v Cooper*”) (1923) LR 51 Ind App 109). The case concerned an anthology of poems, “*The Golden Treasury of Songs and Lyrics*”. Copyright in the works included in the anthology had long since lapsed. Nonetheless, the Privy Council noted in *Macmillan v Cooper* that the Judge in the case, Sir Arthur Wilson, had correctly held that there was copyright in the anthology. Sir Arthur Wilson had stated (quoted in *Macmillan v Cooper* at 122):

“Such a selection as Mr Palgrave has made obviously requires extensive reading, careful study and comparison, and the exercise of taste and judgment in selection. It is open to anyone who pleases to go through a like course of reading, and by the exercise of his own taste and judgment to make a selection for himself. But if he spares himself this trouble and adopts Mr Palgrave’s selection, he offends against the principle.”

There were also the “usual” more general references in Sir Arthur Wilson’s judgment to the prohibition against taking the result of another’s labour. The feature of the exercise of skill, judgment and taste in selection distinguishes anthology cases from the present whole-of-universe case.

50 The earliest Australian compilation case to which we were referred was *T M Hall & Co v Whittington & Co* (1892) 18 VLR 525. Entries in the books of the Victorian Registrar-General were accessible to all on payment of a fee. The plaintiffs published a pamphlet, “*Hall’s Mercantile Gazette*”, each day from Monday to Friday and weekly on Saturdays when the issue was a weekly compilation from the previous five days’ issues. The publication consisted of factual information collected principally by searches made at public registry offices, and presented in the form of bills of sale and notices of intention to file bills of sale, stock mortgages and their renewals, contracts, insolvencies and so on. The defendant published the “*Federal Traders’ Protection Gazette*”, which included notices of intention to file bills of sale which he had copied from the plaintiffs’ publication.

51 Holroyd J described the plaintiff's process of searching at the Registrar-General's office, of noting in summary form the documents read there, and of exercising judgment and discrimination in deciding what to collect. His Honour said that the operation allowed "room for thought" and was "not merely mechanical" (at 531). He continued (at 531-532):

"In general in condensing the materials out of which the plaintiffs' pamphlets were composed considerable time and labour were consumed, and a certain dexterity and expertness in the art of condensation were called into play. This was true also of the notices of intention as regarded time and labour; and I should say that, although the skill exercised was probably less in this subject than in some others, yet it was appreciable."

His Honour concluded as follows on the issue of the subsistence of copyright (at 537):

"These pamphlets, as I have already found, were not mere transcripts of entries contained in the books of the Registrar-General, but compilations derived from sources accessible to everybody, or to everybody who could pay the fees where fees were exacted. Time and trouble, money and skill, were expended upon them, and they were fit subjects for copyright."

In contrast, the compilation with which we are concerned consists of a transcription of information provided by telephone subscribers which allows no "room for thought" and is "merely mechanical". But the fact that selection, judgment, skill, taste, ingenuity or arrangement may be referred to as justifying copyright protection in one case does not signify that industrious collection will not serve that purpose in another.

52 In *Leslie v J Young & Sons* [1894] AC 335, the House of Lords held that:

- a person who published in no particular order, the timetables issued by railway companies, leaving out stations considered not of sufficient importance or interest, did not acquire copyright in the collection; but
- a person who published abridged information about train services in connection with circular tours of a particular locality acquired copyright in that material.

53 The appellant was the proprietor of "*Leslie's Time Tables and Diary*", a monthly penny railway timetable affecting the Perth district. His circular tour information occupied only four pages out of about forty of his book. In support of his claim of copyright, he relied on his skill and labour in condensing into a small space a huge mass of information.

54 Lord Herschell LC stated in relation to the collection of the timetables themselves (at 340-341):

“The information in these time-tables was of course derived by the pursuer from sources which were as open to the defenders as to himself, and he does not and cannot claim any right to the information as such; he can only claim copyright in them, if they are the result in some respect or other of independent work on his part, and if advantage has been substantially taken by the defenders of that independent labour. The mere publication in any particular order of the time-tables which are to be found in railway guides and the publications of the different railway companies could not be claimed as a subject-matter of copyright. Proceedings could not be taken against a person who merely published that information which it was open to all the world to publish and to obtain from the same source.

...

*I do not think it can be said that as regards these tables there has been an appropriation by the defenders of the pursuer’s work such as to entitle the pursuer to complain, and to obtain the interdict which he claims. 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.**”*
(my emphasis)

By way of contrast, the Lord Chancellor thought the tourist and excursion tables exhibited “independent labour” and were “entitled to be regarded as an original work” (at 342). Lords Watson and Shand gave judgments generally to the same effect.

55 The case does not distinguish between one **kind** of independent labour and another. Rather, it distinguishes between the insufficiency of the appellant’s labour in collecting and reprinting the timetables themselves and the sufficiency of its labour in providing the abridged information about the circular tours. The telephone subscriber details with which we are concerned are not generally available and Desktop **does** seek to take advantage of Telstra’s labour in collecting and publishing them. On the other hand, it does not seek to take advantage of Telstra’s alphabetical arrangement of the data: Desktop’s objective is to take the data in all the individual entries into its database.

56 A catalogue of stock sold by a chemist and druggist, Collis, was held to be the subject of copyright in *Collis v Cater, Stoffell & Fortt Ltd* (1898) 78 LT 613 (“*Collis*”). Collis, prepared annually a catalogue arranged under various headings and sub-headings. The catalogue for 1898 contained the heading “Drugs and Chemicals, including Veterinary

Medicines and Photographic Chemicals”. Under that heading, articles were listed in alphabetical order with their prices. The catalogue also contained annotations. In its own catalogue, the defendant copied the heading mentioned, the items under it including their prices, and the plaintiff’s annotations.

57 North J rejected the defendant’s submission that the plaintiff’s catalogue was not entitled to copyright protection because it was a bare list of goods and prices. His Lordship justified protection by reference to the wrongfulness of appropriating that which had cost another “expense and trouble” (at 615 – elsewhere on the same page, variously, “expense and trouble”, “expense and trouble”, “trouble or expense”, “expense and labour”, “expense and trouble”). His Lordship thought the issue for decision governed by the law as to residential or trade directories, which he described as “settled”.

58 There are certain distinctions between the facts of *Collis* and those of the present case. The catalogue did not purport to be only a list of goods in fact stocked at a moment of time, that is to say, a compilation of information as to past or present facts: it stated under the heading “Patent Medicines and Proprietary Preparations”, “any new preparation not in stock will be procured to order with as little delay as possible”. Moreover, the annotations, the headings and the prices all indicate that the form of expression of the catalogue was not inevitable: the compiler decided what those matters were to be. These points of distinction, however, did not have to be addressed. The indiscriminate references to “expense” and “trouble” are at least consistent with the subsistence of copyright in a telephone directory.

59 *Walter v Lane* is the last case to be considered prior to the passing of the 1911 UK Act and its implementation in Australia as from 1 July 1912 by s 8 of the *Copyright Act 1912* (Cth) (“the 1912 Australian Act”). The case may represent the high point of the line of authority supportive of the proposition that one can be the “author” of a work without scope for variance in expression.

60 Lord Rosebery made public speeches which reporters of *The Times* took down in shorthand. Later they wrote out their notes and corrected, revised and punctuated their reports for publication. The speeches were published in *The Times* verbatim as they had been delivered. In a book, the defendant reproduced *The Times* reports, substantially verbatim.

61 Curiously, the case is the first one of those discussed to date to be decided expressly by reference to the 1842 UK Act's requirement that copyright in a "book" (as defined) should exist only if there was an "author" of it. Each "Sheet of Letterpress" of *The Times* on which the reports appeared was a "book" within the statutory definition of that word.

62 Approaching the question for decision in a manner that characterised so many of the nineteenth century cases, the Lord Chancellor stated (at 545):

"My Lords, I should very much regret it if I were compelled to come to the conclusion that the state of the law permitted one man to make profit and to appropriate to himself the labour, skill, and capital of another. And it is not denied that in this case the defendant seeks to appropriate to himself what has been produced by the skill, labour, and capital of others. In the view I take of this case I think the law is strong enough to restrain what to my mind would be a grievous injustice. The law which I think restrains it is to be found in the Copyright Act, and that Act confers what it calls copyright – which means the right to multiply copies – which it confers on the author of books first published in this country."

Unlike the Court of Appeal, his Lordship thought the reporters as much "authors" as the compilers of a residential street directory had been held to be. He rejected a proposition embraced by the Court of Appeal that to be an author of a book one had to be its "original composer", noting that the expressions "original composition" and "original composer" did not appear in the 1842 UK Act. (As noted below, the word "original" was to be introduced to qualify the works protected by copyright with the enactment of the 1911 UK Act.)

63 The Lord Chancellor saw the case as raising the sole question:

"whether this book (to use the language of the statute), printed and published and existing as a book for the first time, can be copied by some one else than the producers of it (I avoid the use of the word 'author'), by those who have not produced it themselves but have simply copied that which others have laboured to create by their own skill and expenditure." (at 547).

In my view, this formulation of the question is important. The reporters' final records of the speeches were a "book" and since they were printed and published and existed **as a book** for the first time, they attracted copyright protection. In this sense they were original and this sense of the word was to prevail in Anglo-Australian jurisprudence.

64 His Lordship rejected the proposition that the 1842 UK Act required "originality either in thought or in language" (at 548), and said that one must not read that Act as if it contained the word "original". Consistently with later authority (see for example, *Sands &*

McDougall Pty Ltd v Robinson (1917) 23 CLR 49 (“*Sands & McDougall*”) (discussed below at [89]-[92]), his Lordship rejected the proposition that copyright protection was attracted only by originality of thought or idea or by the inventiveness required by the patent laws. But as the passage set out above touching on originality makes clear, when his Lordship also said that the 1842 UK Act did not require, by its use of the word “author”, “originality ... in language”, he must have had in mind “inventive” or “imaginative” or “distinctive” language.

65 The Lord Chancellor saw no difficulty in the view that the reporters were authors or that there could be as many copyrights as reporters, and he referred to the painting or photographing of a favourite view by several painters or photographers.

66 Lord Davey, Lord James of Hereford and Lord Brampton gave independent concurring judgements, while Lord Robertson dissented.

67 Lord Davey also observed (at 551) that each sheet of letterpress of *The Times* constituted a “book” within the 1842 UK Act and that since it was the reporter who had brought into existence the sheet of letterpress which the defendant had copied, the reporter was the “author” of it.

68 Lord James of Hereford said (at 553-554):

“Whilst the Act supplies no definition of the word ‘author’, and whilst it may be difficult for any judicial authority to give a positive definition of that word, certain considerations controlling the meaning of it seem to be established. A mere copyist of written matter is not an ‘author’ within the Act, but a translator from one language to another would be so. A person to whom words are dictated for the purpose of being written down is not an ‘author’. He is the mere agent or clerk of the person dictating, and requires to possess no art beyond that of knowing how to write. The person dictating takes a share in seeing that the person writing follows the dictation, and makes it his care to give time for the writing to be made. But an ‘author’ may come into existence without producing any original matter of his own. Many instances of the claim to authorship without the production of original matter have been given at the bar. The compilation of a street directory, the reports of proceedings in courts of law, and the tables of the times of running of certain railway trains have been held to bring the producers within the word ‘author’; and yet in one sense no original matter can be found in such publications. Still there was a something apart from originality on the one hand and mere mechanical transcribing on the other which entitled those who gave these works to the world to be regarded as their authors.”

Now, what is it that a reporter does? Is he a mere scribe? Does he produce original matter or does he produce the something I have mentioned which entitles him to be regarded as an 'author' within the Act? I think that from a general point of view a reporter's art represents more than mere transcribing or writing from dictation."

Lord Brampton observed (at 556) that the preparation of the reports:

"involved considerable intellectual skill and brain labour beyond the mere mechanical operation of writing."

His Lordship continued (at 556-557):

"That the reports so published were 'books' within the meaning of the Copyright Act is undisputed; the great contention throughout the case has been whether the reporters were the 'authors' of them, for unless they were they could not acquire any copyright in them, the 3rd section of the Act conferring property in the copyright of a book only upon its author and his assigns. North J, before whom the case was first heard, held that although the reporter had no property in the speeches, he was entitled to copyright in his reports of them. The Court of Appeal reversed his ruling, and in a considered judgment emphatically stated that mere reporters were clearly not 'authors' of what they report, that the Act was passed to protect 'authors' not reporters, that a mere publisher of another man's verbal utterances could not acquire a copyright as the author of such publication, and they held 'that in order that the first publisher of any composition may acquire the copyright in it he must be the author of what he publishes, or he must derive his right to publish from the author by being of owner of his manuscript, or in some other way.' I can find nothing in the Act which compels me to assent to this view. A speech and the report of it are two different things, and the author of the one and the author of the other are presumably two different persons. The author of a speech is the author of language orally uttered by himself. The author of the report of a speech is the author of a writing containing the substance or the words of that speech. The speech must precede the report of it. The oral speech is not a 'book', the written report is. The book is the subject of copyright under s 3, and the property in such copyright in a book is in its author."

69 In dissent, Lord Robertson insisted that authorship required some element of composition or arrangement or structuring by the putative author, and rejected the appellants' submission that the owner of a phonograph which recorded a speech, who then recorded it in writing and published it as a written report of the speech, would have copyright in that report.

70 The fact that *Walter v Lane* was decided prior to the introduction into the legislation of an express requirement of originality coupled with the references in the speech of Lord Herschell to the absence of such an express requirement, has led to the suggestion that the case might have been decided differently if it had been decided after and under the 1911 UK

Act (see *Lady Helen Robertson v Harry Lewis (trading as Virginia Music)* [1976] RPC 169 at 174). But their Lordships' approach of inquiring whether there was a sheet of letterpress, within the definition of "book" in the 1842 UK Act, which had originated as such with the copyright claimant betokens the very kind of originality which was to become accepted in Anglo-Australian law under the modern statutory formula "original literary work".

The passing of the *Copyright Act 1911 (UK)* and the *Copyright Act 1912 (Cth)*

71 The 1911 UK Act, "[a]n Act to amend and consolidate the Law Relating to Copyright", was deemed by s 8 of the 1912 Australian Act to be in force in the Commonwealth from 1 July 1912, the date on which it came into operation in the United Kingdom (s 37(2)(a) of the 1911 UK Act). The 1911 UK Act had the following features:

- The one Act dealt with literary, dramatic, musical and artistic works, whereas previously various classes of works had been dealt with in different Acts, "books", for example, having been the subject of the 1842 UK Act, as noted earlier;
- Subsection 1(1) provided that subject to that Act's provisions, copyright should subsist in **original** literary works;
- Subsection 1(1) also provided that copyright should subsist in no works other than those identified in the subsection, and s 31 provided that no person should be entitled to copyright in any literary, dramatic, musical or artistic work otherwise than under and in accordance with the provisions of the 1911 UK Act;
- Subsection 35(1) defined "Literary work" to include "maps, charts, plans, tables, and compilations";
- Various sections continued to refer to the "author" of a work.

72 The 1911 UK Act did not define "original" or "compilation". What was the genesis of the use of these terms in the legislation? The President of the Board of Trade, Mr Sydney Buxton, when introducing the Bill for the 1911 UK Act into the House of Commons, said that there were three strong reasons for amending the law. First, there was the desirability of bringing domestic law into line with the Berne Convention 1886 (the *Berne Convention for*

the Protection of Literary and Artistic Works done at Berne on 9 September 1886, completed at Paris on 4 May 1896 and revised at Berlin on 13 November 1908). Secondly, there was the desirability of reforming the domestic law of copyright in the light of the recommendations of the *Thirty-Sixth Report of the Copyhold Commissioners, 1878*. Thirdly, there was the desirability of implementing suggestions made at an Imperial conference chaired by the President himself, of representatives of the self-governing Dominions, which had been assisted by the Report of a Departmental Committee called the “Law of Copyright Committee”, which had sat in 1909 and been chaired by Lord Gorell.

73 The Berne Convention, as it stood in 1886, recited in Article 1 that the Contracting States were constituted into a Union for the protection of the rights of authors over their literary and artistic works. Articles 2 and 3 provided for protection to be enjoyed by authors and their lawful representatives and by publishers. Article 4 stated that the expression “literary and artistic works” comprehended “books, pamphlets, and all other writings; ... , geographical charts; plans, ... ; in fact, every production whatsoever in the literary, scientific, or artistic domain which can be published by any mode of impression or reproduction”. Article 5 provided that authors and their lawful representatives should enjoy the exclusive right of making or authorising the translation of their works. Article 6 provided that authorised translations were protected as original works.

74 By the Berlin Revised Convention of 1908, the definition of “literary and artistic works” (amended in respects not presently relevant) was contained in the first paragraph of Article 2. The second paragraph of Article 2 was as follows:

*“Translations, adaptations, arrangements of music and other reproductions in an altered form of a literary or artistic work, **as well as collections of different works, shall be protected as original works** without prejudice to the rights of the author of the original work.”* (my emphasis)

Professor Ricketson has explained that collections (or compilations) of different works were included by the Berlin Act as a result of a German proposal of which he has observed as follows:

“The commission also offered the following explanation of what was intended to be protected under the rubric of ‘collections of different works’:

‘... it is the work which has been involved in bringing together diverse works following a determined plan, according to a more or less ingenious grouping. As the plan, as the combination, comprises a personal work, the protection

given to it is independent of that given to the materials which have been employed. They may be taken from the public domain ... They may be taken from the private domain, and, therefore, for this to be lawful, the consent of the author or authors may be necessary ... as ... for translations and adaptations' [Actes 1908, 232-233]." (Sam Ricketson, *The Berne Convention for the protection of literary and artistic works: 1886-1986* (1986) at 299).

75 In the *Report of the Committee on the Law of Copyright, 1909*, the Law of Copyright Committee commented (at 9-10) on the second paragraph of Article 2:

"With regard to par 2 of this article, the Committee notice that it makes a considerable extension of Art 6 of the Berne Convention, which only provides that lawful translations shall be protected as original works, whereas this new paragraph is intended to give protection also as against everyone except the original author to 'derivative' works which may not be authorised by the original author."

There had been some discussion of works derived from other works (such as a translations or adaptations) in the proceedings of the Law of Copyright Committee (see *Minutes of Evidence taken before the Law of Copyright Committee*, 25 May 1909, at [438]-[442], [450], [451] at 21-22). It was put to the Committee that a derivative work should be protected as an original work **in so far as there was original work in it**, but without prejudice to the copyright of the original author in his or her work.

76 The parliamentary debates on the Bill for the 1911 UK Act touch on both "originality" and the concept of a "compilation". In the House of Commons on 28 July 1911, Mr Booth moved to omit "original" in the expression "every original literary, dramatic, musical and artistic work" in subs 1(1) (*Hansard*, House of Commons, 28 July 1911 at 1911-1914). The Solicitor-General resisted the move, stating as follows (*ibid*, at 1915-1916):

"Originality in the language of the law of copyright is not the same thing as novelty. That is to say, two perfectly independent persons may survey a piece of ground and produce each a map. Each is entitled to copyright of his own map, though each of the two maps is the same. Therefore, originality is not the same as novelty. But under the head of originality it is required before a man can claim protection of the law of copyright that that which he claims to protect as his should really be his in the sense that his is the brain that has first of all applied itself to the subject matter and produced the composition, or, at any rate, that his is the brain which, though it has not produced the composition, has expressed it in a new form. In one sense you may say a photograph of an existing picture is not original, but that is not the sense in which the word is understood by a lawyer in connection with copyright. I can assure the House that is not the way in which it would be understood by the courts hereafter. What would be understood by originality

would be that there must be either in the form or in the composition itself some element of originality, a requirement that would not exclude derivative works from the ambit of the Bill.” (my emphasis)

Mr Booth did not press his foreshadowed amendment. The Solicitor-General’s speech seems to have favoured at least a “not copied/originating from the putative author” concept of originality. By “composition” the Solicitor-General seems to have meant simply “content”. I do not think his speech inconsistent with the view that industrious collection of the data to constitute a compilation attracts copyright protection.

77 Sub-clause 35(1) of the Bill, as introduced, defined “literary works” to include “maps, charts, plans and tables”, and, as the primary Judge noted, at the Committee stage in the House of Lords, Lord Gorell moved an amendment to include a reference to “compilations” stating as follows (*Hansard*, House of Lords, 16 November 1911, at 211):

“My first Amendment to this clause is to add to the definition of ‘literary work’, which is stated in the clause to include maps, charts, plans and tables. It has been suggested to me that this definition would not include many cases which are instances of copyright. The best instance I can give to your Lordships is Bradshaw, which would not come under the present interpretation but would come under the interpretation if the words ‘and compilations’, which I propose to insert, were added.”

Clearly, Lord Gorell contemplated that “*Bradshaw*” was a compilation which would not be excluded from copyright protection by the proposed express requirement of originality – a matter which I will have occasion to consider when discussing *H Blacklock & Co Ltd v C Arthur Pearson Ltd* [1915] 2 Ch 376 (“*Blacklock*”) at [81]-[85] below.

Post 1911 English and Australian cases

78 In *Weatherby & Sons v International Horse Agency & Exchange Ltd* [1910] 2 Ch 297 (“*Weatherby*”) the plaintiffs published in their “*General Stud Book*”, a list of all the thoroughbred brood mares at the stud in Great Britain. A fresh volume of this work appeared every four years. The defendant compiled a book called “*Bruce-Lowe Figures to Stud Book, Vol 21*”. This contained virtually the whole of the list of brood mares published in volume 21 of the Stud Book

79 The plaintiffs obtained an injunction founded upon infringement of their copyright. Parker J said that by using the plaintiffs’ list, the defendant had saved itself the trouble of making “exhaustive inquiries from the 1400 or 1500 breeding establishments in [the]

country” (at 303), that is to say, had saved itself the trouble of collecting details relating to all the members of a particular universe. His Lordship rejected the submission that the lists were “mere useless lists of names in which there [could] be no copyright” (at 304). Rather, he thought they informed a reader that a mare listed was, or recently had been, at stud. Finally, his Lordship also rejected a submission that the test of whether the defendant had made unfair use of the plaintiffs’ book was whether there was competition between the two works.

80 The case has striking similarities to the present one. Copyright was supported on the ground of the industrious collection of information as to the identity of all thoroughbred brood mares at stud and the resulting list was inevitably alphabetical. The defendant had used the plaintiffs’ list as the springboard for the provision of a service which was not in competition with the plaintiffs’ business. The case favours a finding of subsistence of copyright in the present case.

81 *Blacklock* concerned “*Bradshaw’s General Railway and Steam Navigation Guide*” (“*Bradshaw*”), which had been referred to by Lord Gorell in the parliamentary debates (see [77] above). *Bradshaw* was a monthly publication of the plaintiff’s, which:

“reproduc[ed], *inter alia*, but (speaking generally) in an altered form, the substance of the time-tables of every railway in Great Britain that [were] to be in force during the then or next current month, such tables being classified and furnished with crossreferences and some additional information.” (at 380)

Each monthly issue was prefaced by an index in the form of an alphabetical list of the stations and other places mentioned in the body of the book, with cross-references to the pages where they were mentioned.

82 The defendant published in its “*Pearson’s Weekly*” magazine, a “List of Railway Stations” in connection with a competition it was conducting. The names of some hundreds of the stations had been taken from *Bradshaw*.

83 The railway timetables produced in *Bradshaw* differed from month to month, the differences being more numerous at the beginning of the Summer and Winter seasons. Although the making of the list of station names was not entirely new every month, it was a work of labour and expense, particularly because some railway companies did not issue a timetable at all and some issued no index to their timetables.

84 Joyce J held that copyright subsisted in the *Bradshaw* list of station names contained in the index to the guide. As in the present case, the alphabetical sequence was inevitable: no other arrangement would unlock the information relating to individual stations contained in *Bradshaw*. The plaintiff's work was different in some respects from Telstra's. In *Blacklock* it was necessary for the plaintiff, in some cases to obtain the timetables, and in all cases to extract the railway station names from either the indexes to individual timetables or from individual timetables themselves. In the present case, on the other hand, applicants for telephone services had to provide their names to Telstra. But this difference is immaterial. In both cases, there was no scope for variance in relation to the sequence followed in the list, although that sequence was achieved manually in *Blacklock* and electronically in the present case.

85 Moreover, Lord Gorell's statement in Parliament (set out at [77]) referred to the entire compilation of timetables, not just the list of railway stations. I do not know how the timetables themselves were arranged in *Bradshaw*. Probably the sequence in which they appeared was of no consequence because the alphabetical list of railway stations constituting the index gave access to the timetables. The advantage *Bradshaw* offered to would-be travellers was that it was a collection within the covers of one book of **all** the timetables accompanied by an alphabetical list of railway stations which operated as an index. In some respects, *Bradshaw* was akin to Telstra's directories. But I do not know how many timetables were included in *Bradshaw* or how much labour was expended in collecting them.

86 *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 ("*University of London Press*") was not a compilation case, but Peterson J's discussion of originality has often been referred to. His Lordship's observations that, for copyright purposes, a "literary work" need not exhibit literary quality, style, finish or merit, and that "literary" in the expression "refers to written or printed matter", and his holding that copyright subsisted in the subject examination papers in mathematics, are all surely unremarkable. On the question whether the literary works constituted by the examination papers were "original" within subs 1(1) of the 1911 UK Act, his Lordship said, in a much cited passage (at 608-609):

"The word 'original' does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought,

*and, in the case of 'literary work', with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that **the work must not be copied from another work – that it should originate from the author.** In the present case it was not suggested that any of the papers were copied. Professor Lodge and Mr Jackson proved that they had thought out the questions which they set, and that they made notes or memoranda for future questions and drew on those notes for the purposes of the questions which they set. The papers which they prepared originated from themselves, and were, within the meaning of the Act, original.” (my emphasis)*

87 What is the result of applying Joyce J’s “not copied/originating from the putative author” test of originality to the facts of the present case? Neither the individual entries nor the alphabetical system of arrangement of them originated from Telstra, but the compilation as a whole did: no one else had previously collected the names, addresses and telephone numbers of all the subscribers within a region and applied the alphabet to produce a written list of them. Telstra’s labour of collecting and verifying details of all subscribers and applying modern technology to arrange the data alphabetically marked the compilation as a whole as original in the sense mentioned, even though the individual entries and the method of arrangement of them were not.

88 *University of London Press* itself is distinguishable on its facts: Joyce J noted that “it was admitted that the papers involved selection, judgment, and experience” (at 609).

89 In *Sands & McDougall*, Robinson claimed copyright in a map of Europe. In preparing the map, he had drawn on numerous sources of information. The primary Judge, Barton J, had stated in *Robinson* ((1916) 22 CLR 124 at 128):

“Separate maps of authority as well as a number of atlases were the subject of discrimination and selection for the purpose of determining the places and features to be shown on a map which was to be distinctive from its predecessors.”

and:

“The work involved considerable exercise of the cartographic faculty and art.”

and (at 129):

“The plaintiff himself not only did a great deal of the artistic, but all the intellectual work involved.”

There was therefore ample scope for bringing intellect, creativity and ingenuity to bear.

90 The appellant's submission, which had failed before Barton J, was that the originality which subs 1(1) of the 1911 UK Act required was novelty of idea or concept. On the appeal, Isaacs J delivered the principal judgment, with which Gavan Duffy and Rich JJ agreed. His Honour noted the appellant's submission that by introducing an express requirement of originality in the 1911 UK Act, the legislature must have intended that something over and above authorship be required, and that having regard to what was decided in *Walter v Lane*, that additional something was "inventive originality" (at 53).

91 Isaacs J thought the speeches in *Walter v Lane* inconsistent with this submission. His Honour also said it followed from what their Lordships had said that the reporters' ultimate written report of a speech was regarded as "an original production", simply because it had originated with the reporters, that is to say, had not existed previously. He said (at 55) that:

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

92 While, as a matter of decision, the judgment stands only for the rejection of a "novelty of idea or concept" meaning of "original", the Court also appears to have accepted, on the basis of *Walter v Lane*, the "not copied/originating from the putative author" test, noting that that test must be applied to that thing to which the legislation attaches copyright protection – a literary work in the form of the written record of a speech in *Walter v Lane* (a compilation of details of telephone subscribers in the present case).

93 Copyright was held to subsist in the standard form of contract embodying terms and conditions for the sale of real estate in New South Wales in *Real Estate Institute of New South Wales v Wood* (1923) 23 SR(NSW) 349 ("*Real Estate Institute*"). In support of the axiom that a "literary work" need not exhibit literary merit, Street CJ in Eq observed (at 352) that:

“compilations of various kinds, which cannot claim to rank as literature, are covered by the law of copyright, if they supply intelligible information and if mental effort and industry are required for their preparation.”

Although the case was not itself a compilation case, the requirement that mental effort and industry result in the conveying of intelligible information was to be applied in a compilation case in New South Wales a few years later, as noted below (at [101]-[102]). (In more recent times copyright was held not to exist in the artificial word “Exxon” on the basis that, although original, the word was not a literary work because it did not afford “information and instruction, or pleasure in the form of literary enjoyment”: *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1982] Ch 119 at 143 (“Exxon”); cf *Hollinrake v Truswell* [1894] 3 Ch 420 at 428 per Davey LJ.)

94 In *Macmillan v Cooper*, the appellant published a book which was a selection of passages from Sir Thomas North’s translation of “*Plutarch’s Life of Alexander*”. The appellant sought to restrain, on the ground of infringement of copyright, the defendant firm from publishing a certain similar compilation. The passages from *Plutarch* in the applicant’s book comprised 20,000 words while those in the respondents’ book contained those 20,000 words and an additional 7,000 words. The appellant’s book also contained an introduction and much other material designed to illuminate the study of the *Plutarch* text. In both books, the passages from *Plutarch* were not contiguous and were linked by newly written text. The respondents’ book contained notes, many of which were servilely copied from the appellant’s book.

95 Lord Atkinson delivered the judgment of the Privy Council. Contrary to the respondents’ submission, his Lordship said that in *Macmillan & Co Ltd v Suresh Chunder Deb* (discussed at [49] above), Sir Arthur Wilson had decided that copyright subsisted in the anthology “*The Golden Treasury of Songs and Lyrics*” with which that case was concerned. After referring to *Walter v Lane* and to Peterson J’s “not copied/originating from the putative author” test of originality in *University of London Press*, his Lordship said (at 125):

*“What is **the precise amount of the knowledge, labour, judgment or literary skill or taste** which the author of any book or other compilation must bestow upon its composition in order to acquire copyright in it within the meaning of the Copyright Act of 1911 cannot be defined in precise terms. **In every case it must depend largely on the special facts of that case, and must in each case be very much a question of degree.**”* (my emphasis)

Their Lordships held that there was no evidence “that an amount of these several things ha[d] been applied to the composition of ... the appellant’s book, as distinguished from the notes contained in it” (at 125), to attract copyright protection to the compilation of the passages itself, although copyright subsisted in the notes. Accordingly, injunctive relief was given to the appellant in respect of the notes, but not the passages of text.

96 It may be thought that concepts of “amount” and “fact and degree” are inconsistent with a “not copied/originating from the putative author” test of originality, on the basis that the latter raises a simple “all or nothing” question, not a question of degree. But this is not so. Once a compilation or other literary work in which copyright is claimed is identified, a question arises as to the degree to which that work was not copied but originated with the putative author, that is to say, as to the amount of the putative author’s contribution to bringing a new work into being. Anthologies and many compilations include copied elements but are treated as original if the anthologist or compiler has contributed sufficient labour, skill or judgment in bringing the work into being.

97 *Cambridge University Press v University Tutorial Press* (1928) 45 RPC 335 (“*Cambridge University Press*”) was another anthology case. The plaintiff published “*Hazlitt’s Selected Essays, Edited by George Sampson*” which included thirteen essays and notes on them. The defendant published and sold “*Hazlitt’s Selected Essays, Edition Hollingworth*” containing twenty essays, including the thirteen selected by Sampson. It was admitted that the plaintiff owned copyright in its book. Maugham J had no doubt that in selecting the thirteen essays, Mr Sampson had exercised “skill, discrimination, taste and judgment and ... his own personal qualities” (at 340).

98 The University of London prescribed the Sampson book for examination purposes, with a resulting substantial increase in sales. The defendant commissioned a person to select seven essays which were to be added to Mr Sampson’s thirteen to make up twenty, which the defendant was to publish in a book that would compete with the plaintiff’s. The defendant also engaged a person to write an introduction and notes.

99 Maugham J described the case as “very near the line” (at 343). In concluding that the defendant’s book did not reproduce a substantial part of the plaintiff’s work (for the purposes of subs 1(2) of the 1911 UK Act), his Lordship took into account that the thirteen essays common to both books were arranged in a different order in the two books and that their

introductions and notes were different. The case illustrates the necessity of conceiving of literary works, and in particular anthologies and compilations, as a whole for the purposes of the subsistence of copyright.

100 *Cambridge University Press* and the present case are distinguishable in terms of the factors available to be relied on as making the work in question original. In *Cambridge University Press* they were selection and arrangement. In the present case, it is the labour of collection and verification of the data to be compiled.

101 The compilation in which copyright was claimed in *Canterbury Park Race Course Co v Hopkins* (1931) 49 SR (NSW) 27 (“*Canterbury Park*”) was a list intitled “Names of horses and weights of horses accepted for races to be held at Canterbury Park Races on Saturday the 6th June, 1931”. The list recorded the result of various preliminary processes including:

“*the compilation of a programme, its circulation among owners and trainers, the receipt of letters with details as to horses to be entered in races, the tabulation of that information, the compilation of a list of entries, the handicapping of the horses, and after the time for scratching had elapsed the compilation from the list of entries and handicaps of the final list of acceptances.*” (at 28)

The defendant published the list of acceptances in its “*Turf Life*” newspaper without the plaintiff’s permission.

102 On the question of the subsistence of copyright, Long Innes J applied a test derived from *Real Estate Institute* ([93] above): Did the compilation supply intelligible information and were mental effort and industry required for its preparation? His Honour found the test satisfied. In stating (at 28) his opinion that “a considerable amount of ingenuity, industry, and mental effort” had been required, his Honour was referring to processes which preceded that of the actual reduction of the results into written form. The case points to the artificiality of distinguishing between different kinds of contribution to the bringing into being of a literary work, distinct from and antecedent to the actual writing of it.

103 In *Mander v O’Brien* [1934] SASR 87, it was submitted that *Canterbury Park* was wrongly decided. This was another of the many cases concerning a list of starting horses. The content of the list is indicated by its heading: “Names of horses, weights for horses and barrier positions of horses accepted for races to be held at Morphettville Racecourse on

Saturday, 18th November, 1933”. Murray CJ referred to Peterson J’s discussion of the meaning of “literary work” and “original” in *University of London Press*. Importantly, he referred to his Lordship’s “not copied/originating from the putative author” test of originality and to the acceptance of that test by Romer J in *British Oxygen Co v Liquid Air Ltd* [1925] 1 Ch 383 at 390-391, and by the High Court of Australia in *Sands & McDougall*. On this basis, Murray CJ concluded that copyright subsisted in the list, observing that “[n]o such compilation for the same meeting had been made before” (at 92) – a statement comparable to one that might be made in this case: “no compilation of particulars of telephone subscribers in the particular region had been made prior to that made by Telstra”.

104 In *Odham’s Press Ltd v London and Provincial Sporting News Agency (1929) Ltd* [1935] Ch 672 (“*Odham’s Press*”), Eve J held that copyright did not subsist in journalists’ notes of the starting prices or final betting odds on horses engaged in races. The journalists “picked up” and “extracted” this information from the Tattersall’s Ring. A few seconds later, the same information, at least in relation to the place-getters, was published to the world at large, and, a yet few minutes later, that information in relation to all starters was similarly published.

105 The basis of Eve J’s conclusion that the journalists’ jottings were not “literary works in the nature of tables or compilations” (at 680) appears to have been their insubstantial nature and transient significance. (The Court of Appeal ([1936] 1 Ch 357) dismissed an appeal without having to deal with the subsistence issue, but expressed some doubt about the correctness of his Lordship’s conclusion (at 364-365).) The “evanescence” of the significant life of a “writing” appears to have been the ground on which copyright was held not to exist in postings in relation to horse races in the Australian case next to be discussed.

106 The relevant copyright issue in *Victoria Park* was discussed by Latham CJ and Dixon J (Rich J and Evatt J did not find it necessary to discuss the issue, while McTiernan J said only that there was “no substance” in the contention that what the defendants had done was an infringement of copyright). That issue was whether there was copyright in the names and numbers of the starting and scratched horses and the winning horses, posted on a board within a racecourse. (Latham CJ and Dixon J held that, although copyright may well have existed in the relevant race book, it was not established that the plaintiff owned that copyright or that anything more than the facts referred to in it had been taken.)

Latham CJ stated:

- that it could not have been the legislature’s intention that something as evanescent as the short particulars which appeared for a few minutes on the board could support the subsistence of copyright for somebody’s life and fifty years;
- that the 1912 Australian Act required, not the first statement of facts in question, but “some originality in the expression of thought” (at 498).

For the latter proposition, his Honour cited *Halsbury’s Laws of England* (2nd Ed, 1932, vol 7) at 521, which stated, relevantly, and omitting footnotes and the reference to them, as follows:

“823 Only original works are protected, but it is not requisite that the work should be the expression of original or inventive thought, for Copyrights Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of a literary work, with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. It is not required that the expression should be in an original or novel form but that the work should not be copied from another work; it should originate from the author. Thus a report of a speech, a photograph of a picture, and a translation of a foreign work, are protected; and so too is a book of mathematical calculations, if independently worked out, even though in form identical with an existing book. The owner of copyright has, in short, no monopoly in the subject-matter. Others are at liberty to produce the same result, provided they do so independently and, though they are not the first in the field, their work is none the less ‘original’ in the sense in which that word is used in the Copyright Act 1911. But if no skill or labour is employed in producing the particular form in which the work is expressed there will be no copyright in it, although it may embody an original idea or opinion; there is therefore no copyright in news as such, but only in the form in which it is expressed, and there is no copyright in an advertisement slogan, or in the name of a horse selected as a probable winner.” (my emphasis)

Dixon J stated in relation to the expression “literary work” (at 511):

*“some original result must be produced. This does not mean that new or inventive ideas must be contributed. The work need show no literary or other skill or judgment. **But it must originate with the author and be more than a copy of other material.** The material for the board consists in the actual allotment of places and other arrangements made by the plaintiff company’s officers in respect of the horses. To fit in on the notice board the names and figures which will display this information for a short time does not appear to me to make an original literary work.”* (my emphasis)

Both Latham CJ and Dixon J expressed agreement with the primary Judge, Nicholas J (see (1936) 37 SR (NSW) 322), who had said that the information on the board was not copyright “because of the lack of any compilation and because of the evanescent character of the information, which [was] posted up to be pulled down after a few minutes exposure” (at 344).

109 *Victoria Park* affords little guidance in the present case, although Dixon J, and less clearly Latham CJ, seem to have approved of the “not copied/originating from the putative author” test of originality. The emphasis that what appeared on the board was an evanescent and short reporting of facts suggests that copyright protection was denied either because what appeared was too brief and short lived to constitute a literary work at all or because there was so little contribution by the putative author that it was not an original work.

110 The parties in *GA Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329 (“*Cramp*”) were publishers of pocket diaries. The respondents claimed that the appellants had infringed copyright in their “Liteblue Diary”. They succeeded before the Court of Appeal, but the House of Lords allowed an appeal. Both diaries contained tables of useful information and the appellant admitted it had taken seven of the tables in its “Surrey Lightweight Diary” from the respondents’ product.

111 The case was one of selection or nothing. At first instance Uthwatt J said that the respondent’s selection of tables and its arrangement of them was only a “commonplace selection of gobbets of information and a commonplace arrangement, neither of which involved any real exercise of knowledge, labour, judgment or skill” (quoted at 330), and therefore did not attract copyright protection. By majority, the Court of Appeal allowed an appeal.

112 In the House of Lords, three independent speeches were made (Lord Roche agreed with the Lord Chancellor, Viscount Simon, and with Lord Macmillan, while Lord Simonds said he “concurred”). Viscount Simon LC observed (at 335) that nobody disputed that “the existence of sufficient ‘originality’ [was] a question of fact and degree” and his Lordship cited as authority for this proposition the passage from the speech of Lord Atkinson (for the Privy Council) in *Macmillan v Cooper* at 125 (set out at [95] above). In concluding that originality was missing, the Lord Chancellor stated as follows (at 335-336):

“*One of the essential qualities of such tables is that they should be accurate,*

so that there is no question of variation in what is stated. The sun does in fact rise, and the moon set, at times which have been calculated, and the utmost that a table can do on such a subject is to state the result accurately. There is so far no room for taste or judgment.”

The same can be said of the individual entries in Telstra’s telephone directories.

113 His Lordship acknowledged that there was scope for choice as to what information (tables) should be included in the diary, but thought that the information in fact included was “commonplace” and was commonly in diaries, and he had difficulty seeing how the particular combination in which they appeared was “original work”. He said (at 336):

“It was not suggested that there was any element of originality or skill in the order in which the tables were arranged. My own conclusion is that the selection did not constitute an original literary work.”

If the forms of contribution to the creation of a work mentioned by his Lordship (selection or scope for variance in form or arrangement) are the only ones able to be regarded, a Telstra telephone directory would fail the test of originality. But in my opinion, they are not. There is present in the Telstra case a form of contribution which was not relevant to the case before their Lordships: the labour of collecting factual information to be compiled (in the present case, details of all the telephone subscribers within a region).

114 Lord Macmillan observed that the respondents made no claim to copyright in any one of the seven tables or in respect of the order in which the tables were arranged. The only claim they made was one of selection. His Lordship concluded that the selection was “of an obvious and commonplace character” and lacked “any meritorious distinctiveness” (at 338). He thought that the decision to include or exclude a table must have involved “the very minimum of labour and judgment” (at 338) and was not sufficient to support the existence of copyright.

115 The third independent speech was that of Lord Porter who noted (at 340):

“It is conceded that, if the work, labour and skill required to make the selection and to compile the tables which form its items is negligible, then no copyright can subsist in it. Whether enough work, labour and skill is involved, and what its value is, must always be a question of degree.”

His Lordship concluded that the respondents had not established (at 341):

“that the amount of knowledge, labour, judgment or literary skill or taste applied to the compilation of the tables and lists at the beginning of the

respondents' Liteblue Diary for 1933 entitles that compilation to copyright."

116 In sum, the various forms of contribution which might be suggested to be present, were thought insufficient as a matter of "fact and degree" to warrant copyright protection.

117 In *Winterbottom for the Western Australian Turf Club v Wintle* (1947) 50 WALR 58, a list of final acceptances and weights of starters for a race meeting was again held protected by copyright. Wolff J stated (at 67):

"The compiling of the lists here, I think, calls for skill and judgment, and while at one stage, after the materials for the list and its form have been decided on, the setting up is more or less mechanical, that is a feature which could be urged in respect of most literary works. But the argument is put in another way; it is said that the sheet is not compiled as a list, or for the purpose of a list, but it merely 'eventuates' after certain work, necessarily preliminary to the conduct of a race meeting, has been performed, and, therefore, there is nothing original in the work in the literary sense. But, in view of my finding, it is not necessary to pursue this matter further."

His Honour appears to have found that skill and judgment were exercised in both the actual making up of the list and the antecedent work. Accordingly, the case assists little for present purposes.

118 In *Purefoy Engineering Co Ltd v Sykes Boxall & Co Ltd* (1955) 72 RPC 89 ("*Purefoy*"), tables in the plaintiff's catalogue of standard engineering components were held protected. Each page in question comprised a photograph of the component; followed by its trade description; followed by a table of the dimensions of the various sizes available; followed by a line drawing or diagram indicating, by means of letters of the alphabet, the dimensions tabulated; followed lastly, by a statement of the material and finish of the component, code number and the word "Copyright". The Court of Appeal had no hesitation, citing *Collis*, in holding that the pages attracted copyright protection.

119 While the requirement that the catalogue be technically accurate limited the scope for variance in expression, there was some. Consistently with the idea/expression dichotomy, the Court also said that the defendant was entitled to offer for sale the same parts that the plaintiff had chosen to offer, and that there would be no infringement of copyright provided it devised its own catalogue without copying the plaintiff's, even if it transpired that the two were identical. This proposition is consistent with a "not copied/originating from the putative author" test of originality, and produces the result that there can be copyright in the two

independently created identical catalogues.

120 *Football League Ltd v Littlewoods Pools Ltd* [1959] 1 Ch 637 (“*Football League*”) was decided under the *Copyright Act 1956* (UK) (“the 1956 UK Act”), but subs 2(1) of that Act was relevantly identical to subs 1(1) of the 1911 UK Act. Moreover, as in subs 35(1) of the 1911 UK Act, “literary work” was defined in subs 48(1) of the 1956 UK Act to include a table or compilation.

121 The plaintiff alleged infringement of copyright in its chronological list of football fixtures, the making of which was “automatic and require[d] only a painstaking accuracy” (at 649). The chronological list was derived from a table of fixtures, which, by contrast, had resulted from much work, skill and ingenuity.

122 Upjohn J held that even if there was insufficient skill, labour or effort in providing the chronological list alone to support copyright, the earlier work of compiling the table of fixtures could not be disregarded. In any event, his Lordship held there was sufficient painstaking hard work in the preparation of the chronological list itself to support copyright, saying that notwithstanding the “automatic” nature of the process, it involved “a great deal of painstaking hard work with complete accuracy as the keynote” (at 656). Following *Blacklock*, his Lordship would have concluded that copyright subsisted in the chronological list without reference to the earlier table of fixtures.

123 At least, the case is authority for the proposition that there may be copyright in a non-creative chronological listing of the results of earlier work – a description with has some relevance to the computerised alphabetisation of the subscriber details in the present case.

124 The question in *John Fairfax & Sons Pty Ltd v Australian Consolidated Press Ltd* [1960] SR (NSW) 413 (“*John Fairfax*”) was whether the defendants had breached an injunction which had been granted *ex parte*. The issue was one as to the proper construction of the words “copying the whole or any substantial part of” in the order of the court. The case is of present interest only because of *obiter dicta* of the Full Court.

125 The Full Court said that the injunction must have been granted on the basis that the plaintiff newspaper publisher owned copyright in births and deaths announcement columns in

the “*Sydney Morning Herald*”. The Full Court observed (at 415) that the claim rested solely on the fact that, although copyright in the text of each announcement belonged to the person who tendered it for publication:

“the skill and labour applied by the plaintiff’s employees, in adapting the announcements and arranging them in sequence for publication, conferred on it copyright in the relevant column of announcements as published, ...”

The sequence followed in the columns was alphabetical by surname. I suppose this was inevitable, as in the present case, and for the same reasons. The Full Court appears to have accepted that the trial Judge had correctly found that there was copyright in the columns. This affords some slight support for its subsistence in the directories with which we are concerned, but there is the distinction that in *John Fairfax* there was some small editorial adaptation to “house style” by the plaintiff’s staff. (One reason given by the Full Court for construing the words of the injunction narrowly was that there was no copyright in the facts reported (births and deaths) and that the forms of expression in which they could be reported were limited.)

126 *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 (HL) (“*Ladbroke*”) is probably the most important of the modern authorities on copyright in compilations. A bookmaker’s weekly fixed-odds football betting coupons were held to be the subject of copyright. It was not disputed that “a vast amount of skill, judgment, experience and work” (at 275) went into the making of the coupon. The form of the coupon had not been altered for many years. The odds offered for each kind of bet were only occasionally altered. What was new each week was the selection of the matches to go into the lists.

127 Lord Reid said that the whole coupon must be treated as a single compilation. On the issue of originality, he quoted with approval the passage from the judgment of Peterson J in *University of London Press* set out earlier (at [86]). Apparently, therefore, his Lordship approved of the “not copied/originating from the putative author” test of originality. He noted (at 277-278) that it was not disputed that “as regards compilation, originality [was] a matter of degree depending on the amount of skill, judgment or labour that ha[d] been involved in making the compilation.” His Lordship rejected the familiar submission that a distinction was to be drawn between antecedent work and the actual drawing up of the compilation and that only the latter was relevant to originality. Finally, his Lordship distinguished *Cramp* on its facts.

128 Lord Evershed said that the express inclusion of compilations in the definition of “literary work” signified that the absence of literary taste or quality was not determinative as to the existence of copyright. His Lordship concluded that there was present the requisite degree of skill, judgment and labour, not only in the selection of the wagers to be offered, but also in their presentation and arrangement in the coupon, the coupon’s component headings, the manner of description and colouring of the headings and in informative notes for punters beneath the headings. Clearly, his Lordship relied on factors which have no counterparts in the present case.

129 Lord Hodson observed (at 285) that:

“commonplace matter put together or arranged without the exercise of more than negligible work, labour and skill in making the selection will not be entitled to copyright.”

Like Lord Reid, his Lordship rejected an approach which dissected the coupon in order to show that copyright does not attach to any of its individual parts. His Lordship thought that the selection of the bets to be offered was enough alone to attract copyright protection to the coupons. He could not accept:

“that preparatory work must be excluded in this case so as to draw a line between the effort involved in developing ideas and that minimal effort required in setting those ideas down on paper.” (at 287)

130 Lord Devlin stated (at 289):

“The requirement of originality means that the product must originate from the author in the sense that it is the result of a substantial degree of skill, industry or experience employed by him.”

His Lordship thought the work of selecting the bets to be offered sufficient for this purpose, but acknowledged that the position might be otherwise if there was no intention at the time of recording in writing the selection made. That is to say, antecedent work might have to be disregarded if it was not done for the purpose of production of the work – a qualification which has no scope for operation in the present case.

131 Lord Pearce also emphasised the need to consider compilations as a whole, and thought it:

“in each case ... a question of degree whether the labour or skill or ingenuity or expense involved in the compilation is sufficient to warrant a claim to

originality in a compilation.” (at 292)

His Lordship also rejected the attempt to distinguish as irrelevant to that question of “sufficiency” the introductory work of deciding on the bets to be offered. Like Lord Devlin, however, he acknowledged that such work might be irrelevant in a case where there was no accompanying intention to prepare a written record of the results.

132 *Ladbroke* emphasises that a compilation is to be regarded as a whole and that on the question of the sufficiency of the work of the putative author to demonstrate that it originates from him or her, it is impermissible to treat as irrelevant “antecedent” or “preliminary” or “preparatory” work, except perhaps work of that kind which was not accompanied by an intention to produce the compilation. To this extent the case is consistent with the subsistence of copyright in the present directories. As a matter of fact, however, the kind of antecedent work in question in *Ladbroke* differed from that in the present case. The selection of the wagers to be offered is different in kind from the mere, even if far more onerous, collection and verification of millions of details of telephone subscribers. But, as will appear later, in my opinion the difference is not a material one for the purpose of attracting copyright protection.

133 *Australian Consolidated Press Ltd v Morgan* (1965) 112 CLR 483 (“*ACP v Morgan*”) was another contempt case. It arose out of an interlocutory undertaking not to publish Gallup poll results in which the respondents (to the appeal) had copyright. Barwick CJ observed that there was copyright, not in knowledge or information, but in “the literary form in which knowledge or information is conveyed or cast”, and that the law had “gone a long way [the Chief Justice cited various cases] to protect **the labours of a man in producing and tabulating information**” (at 487 – my emphasis).

134 The *Ladbroke*-endorsed approach of identifying in the first instance the whole of the relevant work for subsistence purposes was followed by Plowman J in *Warwick Film Productions Ltd v Eisinger* [1969] Ch 508 (“*Warwick Film*”). A book on the life of Oscar Wilde included passages taken from the transcripts of shorthand notes of his trials and connected proceedings and from newspaper reports, in none of which the author of the book owned copyright. A film was made based on the trials. The script of the film included material copied from the book. It was held that, although there was copyright in the book as a whole, the material taken was not original to the author and therefore was not a “substantial”

part of the work. Plowman J observed (at 533-534) that the unedited copying in the book “had no originality and attracted copyright, as part of the whole book, only by reason of its collocation [so that w]hen robbed of that collocation it does not ... represent a substantial part of the copyright and so does not involve an infringement of it.”

135 In *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd* [1979] FSR 46 (“*Elanco Products*”), it was held to be arguable that copyright subsisted in a leaflet and label supplied in connection with the sale of the appellant’s herbicide “Trifluralin”. These documents were a compilation of the results of the appellant’s research. Goff LJ said (at 52) that the compilation cases proceeded on the basis of skill and labour in the making of the compilation, as distinct from skill and labour in ascertaining the information. This statement is, with respect, problematical, unless his Lordship was referring to skill and labour in ascertaining the information for purposes which did not include that of the making of the compilation (cf *Ladbroke* at 290 per Lord Devlin, at 293 per Lord Pearce). Buckley LJ spoke (at 57) of protection of the appellant’s skill and judgment and, in effect, of its research.

136 The plaintiff’s list of bingo game numbers was held to be an original literary work in *Mirror Newspapers Ltd v Queensland Newspapers Pty Ltd* [1982] Qd R 305 (“*Mirror Newspapers*”). The numbers were produced as a result of a mechanical exercise involving the use of “blowers”. Connolly J observed, however, that “[t]he requirement [was] not that the thought be original or inventive” (at 309). His Honour noted that the decision as to the length of the sequence of numbers was of practical importance to the plaintiff, so that “in a critical area judgment [was] being employed” (at 309). He identified the ways in which “mental effort and industry” were applied. Citing *Ladbroke*, his Honour said that it was not legitimate to draw a line between the work which went into arriving at the idea and the work that went into its expression, confining copyright to protecting the latter alone. The case is not conclusive, but is, at least, far from suggesting that the labour of collecting all the data within a given category, even where the arrangement according to which the data are to be stated is inevitable, will not suffice to attract protection.

137 In *Ogden Industries Pty Ltd v Kis (Australia) Pty Ltd* (1982) 62 FLR 241 (“*Ogden*”), Kearney J in the Supreme Court of New South Wales applied the “not copied/originating from the putative author” test of originality (citing *University of London Press* and *Ladbroke*), when finding that the plaintiff owned copyright in drawings of certain designs of

key blanks. His Honour observed (at 247):

“Hence, if the work originates from the author in the sense that it is the result of his skill, labour or experience, and is not copied from another, then it will be an original work for copyright purposes.”

138 In *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171 (“*Computer Edge*”), Gibbs CJ, Mason, Wilson and Brennan JJ thought that certain computer source programs were original literary works, but by majority the Court held that the corresponding object programs were not. Gibbs CJ said (at 182-183) that “original” meant not copied from another work, but originating from the author (the Chief Justice cited *University of London Press, Sands & McDougall* and *Victoria Park*), adding (at 182-183) that originality was “a matter of degree, depending on the amount of skill, judgment or labour that has been involved in making the work” (citing *Ladbroke*). The Chief Justice had no doubt that the production of the source programs “involved sufficient skill, labour and experience on the part of the authors to satisfy the requirement of originality” (at 183).

139 Mason and Wilson JJ (in a joint judgment) and Brennan J, agreed that the source programs were original literary works but did not find it necessary to discuss the meaning of “original”, while Deane J did not find it necessary to express any opinion on the question. In the result, the case provides the opinion of Gibbs CJ that originality raises a “not copied/originating from the putative author” test which calls for an assessment of the degree of “skill, judgment or labour” of the putative author involved in the work.

140 In *Kalamazoo (Aust) Pty Ltd v Compact Business Systems Pty Ltd* (1984) 84 FLR 101 (“*Kalamazoo*”) copyright was found to exist in sets of blank accounting forms. Thomas J applied the “not copied/originating from the putative author” test (citing *University of London Press, Ladbroke, Mirror Newspapers* and *Ogden*). Although the plaintiff had only varied in minor ways forms that were in general use, this was held sufficient to signify that the sets of forms originated from the plaintiff.

141 In *Interlego AG v Tyco Industries Inc* [1989] 1 AC 217 (“*Interlego*”) Lord Oliver of Aylmerton, delivering the judgment of the Privy Council, described the “not copied/originating from the putative author” test of originality formulated by Peterson J in *University of London Press* as “a classical statement of what is comprised in the concept of

originality in the context of copyright” (at 259). But his Lordship immediately (at 260) pointed out that Peterson J’s statement was:

“not complete in itself because there may clearly be original work which makes use of material obtained by the author from pre-existing sources.”

His Lordship referred to various authorities, including *British Northrop Ltd v Texteam Blackburn Ltd* [1974] RPC 57, in which Megarry J (at 68) had applied the “not copied/originating the putative author” test.

142 His Lordship observed that it was not every kind of skill, labour or judgment which will make a work original, and illustrated by reference to skill, labour or judgment directed to achieving exactness in copying. Nothing said in the judgment suggests that in a compilation case the labour of collecting and checking the data to be compiled is a kind of “skill, **labour** or judgment” which cannot serve to mark a literary work as one originating with the putative author.

143 A “*Solicitors’ Directory and Diary*” was held to attract copyright protection in *Waterlow Publishers Ltd v Rose* (1989) 17 IPR 493 (“*Waterlow v Rose*”). The facts had some similarity to those of the present case. Blank forms were sent out to solicitors’ offices and barristers’ chambers to be completed and returned so that an alphabetical directory could be produced. The completed and returned forms were checked against the galley proofs for the previous year’s diary and printers were instructed. The existence of copyright in the relevant part of the directory was not in issue but the identity of the author was. The parties accepted as correct a statement by Laddie, Prescott and Vitoria in *The Modern Law of Copyright* (1980) (at 245) that the author of a compilation is “the person who gathers or organises the collection of material and who selects, orders and arranges it”. Slade LJ, with whom Neill and Ralph Gibson LJJ agreed, refrained from expressing a concluded view as to the correctness or otherwise of this definition, adding (at 502-503):

“A compilation is a literary work of a character all its own, and the ascertainment of authorship may raise very real difficulties.”

In my opinion, Telstra satisfies the textbook definition quoted. Clearly, it “gather[ed] or organis[ed] the collection of” the subscriber details. Also it “select[ed], order[ed] and arrange[d]” the compilation in so far as those processes were relevant to the circumstances (selection was not), by causing the subscriber details to be ordered alphabetically by a

computer program. (In a second *Waterlow* case, *Waterlow Directories Ltd v Reed Information Services Ltd* (1990) 20 IPR 69, on an application for an interlocutory injunction, the subsistence and ownership of copyright were not in issue.)

144 In *Ibcos Computers Ltd v Barclays Mercantile Highland Finance Ltd* (1994) 29 IPR 25 (“*Ibcos*”), Jacob J found that copyright subsisted in the source code of computer programs constituting an accounting payroll package called the “Agricultural Dealer System” (“ADS”). Subsection 3(1) of the *Copyright, Designs and Patents Act 1988* (UK) (“the 1988 UK Act”) defined “literary work”, as previously, to include a table or compilation, and, as well, “a computer program”.

145 The case is of present significance because of Jacob J’s rejection (at 38-39) of a broad submission to the effect that “if there is only one way of expressing an idea that way is not the subject of copyright” (*Total Information Processing Systems Ltd v Daman Ltd* [1992] FSR 171 (Judge Paul Baker QC) at 181). His Lordship stated (at 39):

“The true position is that where an ‘idea’ is sufficiently general, then even if an original work embodies it, the mere taking of that idea will not infringe, but if the ‘idea’ is detailed, then there may be infringement. It is a question of degree. The same applies whether the work is functional or not, and whether visual or literary. In the latter field, the taking of a plot (ie the idea) of a novel or play can certainly infringe, if that plot is a substantial part of the copyright work. As Judge Learned Hand said, speaking of the distinction between ‘idea’ and ‘expression’: ‘Nobody has ever been able to fix that boundary and nobody ever can’.

It should be noted that the aphorism ‘there is no copyright in an idea’ is likely to lead to confusion of thought. Sometimes it is applied to the question of subsistence of copyright: is there a ‘work’ and if there is, is it ‘original’? Sometimes it is applied to the different question of infringement: has a substantial part been taken? That is not to say that the expression has no use: for instance if all a defendant has done is to copy a general idea, then it does not matter whether there is copyright in the plaintiff’s work, or whether the plaintiff owns that copyright.”

His Lordship proceeded to distinguish United States cases concerned with functionality and compilations, partly on the ground of the different language of the United States copyright legislation (see [194] below).

146 In the present case, the facts were detailed (names, addresses and telephone numbers) and there was only one way of recording them (alphabetically by surname). According to his

Lordship, these circumstances did not preclude the possibility of the subsistence of copyright in the compilation.

147 In *Bookmakers' Afternoon Greyhound Services Ltd v Wilf Gilbert (Staffordshire) Ltd* [1994] FSR 723, Aldous J said (at 731) that it was “settled law” that the word “original” required only that a work “should not be copied and should originate from the author”, and cited *Ladbroke* at 291. His Lordship continued:

“It is also settled law that to acquire copyright the author must have expended a sufficient amount of labour, judgment, literary skill or other such quality. What will be sufficient in any particular case is a question of degree and will depend upon the work produced and all the circumstances of the case. However the courts are not astute to enable one man to appropriate, without payment, the fruits of another’s labours. I must therefore consider the production of the race cards and the dividend forecasts and decide whether sufficient labour, judgment and skill were used so as to render them original literary works.”

Again, it will be noted that there is no suggestion that a “sufficient amount of labour” in collecting factual information for the purpose of the compilation will not attract protection; indeed, the suggestion is to the contrary.

148 His Lordship found (at 732) that “considerable skill, labour and judgment were involved in preparing [a certain advance greyhound racing program] and that copyright subsist[ed] in it”, and that the work needed to produce a certain “race card” was sufficient to make it also an original literary work.

149 In *Erica Vale Pty Ltd v Thompson & Morgan (Ipswich) Ltd* (1994) AIPC §91-068 (“*Erica Vale*”), Brownie J applied the “not copied/originating from the putative author” test of originality in concluding that copyright subsisted in printed material on certain seed packets (his Honour cited *University of London Press* at 608-609 and *Ladbroke* at 286-287). It is true that his Honour also stated (at 38,319) that “the choosing of the words used” must involve “such matters as skill, judgment, selection, ingenuity, labour, experience and expertise”, but this statement must be understood in the context of the facts of the case. The printed material was not a whole-of-universe factual compilation. Indeed, his Honour stated (at 38,320):

“it is not so much a case of a series of compilations of purely factual matter, as a series of adaptations of earlier literary works, in the ordinary sense, as distinct from the ‘compilation’ sense.”

150 In *Autospin (Oil Seals) Ltd v Beehive Spinning (a firm)* [1995] RPC 683 (“*Autospin*”), Laddie J drew attention to the fact while copyright subsisted in works, it protected them, not for their own sake, but because of an underlying policy of protecting that which had gone into the production of them.

151 The plaintiff had designed and developed a new type of oil seal and had produced charts or tables containing instructions to enable critical dimensions of the seals to be calculated to enable the manufacture of them. The plaintiff alleged that the manufacture of seals by the defendant was an infringement of its copyright in the charts. Pertinently for present purposes, his Lordship stated (at 697-698) that it was not the mere form of words of notation used in a compilation which justified copyright protection, but the author’s skill and effort expended in gathering the information together (the full passage is set out [235] below). This approach favours the subsistence of copyright in a telephone directory.

152 Copyright has been found to subsist in compilations in several recent Australian cases which I will note briefly. The first is *A-One Accessory Imports Pty Ltd v Off Road Imports Pty Ltd* (1996) 65 FCR 478 (“*A-One*”), in which Drummond J found that there was copyright in a catalogue of motor cycle spare parts. The respondents contended that the applicants did not have copyright in the catalogue because it was only an amended version of an earlier one and both the amendments and the earlier version had been copied from the catalogues of competitors. Drummond J held that a work could be original even though it infringed the copyright in an existing work, provided it contained “qualitatively significant changes to the copied material” (at 490). In such a case, his Honour held, the non-original material attracted copyright protection because of its collocation with original material (at 501) (his Honour cited *Ladbroke* and *Warwick Film*). The case emphasises the need to conceive of a compilation as an entirety and to apply the statutory requirement of originality to the work as a whole.

153 A Full Court of this Court held in *Skybase Nominees Pty Ltd v Fortuity Pty Ltd* (1996) 36 IPR 529 (“*Skybase*”) that there had been sufficient evidence before the primary Judge to support his conclusion that a “Weight Watchers program” was an original literary work. RD Nicholson J applied the “not copied/originating from the putative author” test of originality of Lord Devlin in *Ladbroke*. In this respect, French J agreed and Hill J appears to

have agreed.

154 A Full Court of this Court referred to *Ladbroke* and other authorities on the concept of an “original literary work” in *Milwell Pty Ltd v Olympic Amusements Pty Ltd* (1999) 85 FCR 436. The case concerned the prize scales of poker video games machines. The prize scales were tables or compilations expressed in words and figures. The Court observed (at 442-445) that the requirement of originality was directed to originality of expression, not ideas; that each prize scale must be considered in its entirety; and that antecedent mathematical work was to be taken into account. The facts of the case are distinguishable from those of the present case: much skill (of a mathematical kind) was involved in arriving at the content of the compilation, and there was scope for variance in the form of the document.

155 In *Acohs Pty Ltd v R A Bashford Consulting Pty Ltd* (1997) 144 ALR 528, Merkel J found (at 542) “sufficient skill, judgment and labour” in the production of a “material safety data sheet” to attract copyright protection. His Honour applied a “skill, judgment or labour” test. The case affords little assistance for present purposes.

156 In *Harpur v Lambourne* (1999) 45 IPR 213, Bergin J found that there was copyright in the plaintiff’s marine industry directory. The defendant alleged that the plaintiff had taken his information mainly from the Yellow Pages telephone directory. Her Honour cited (at 221), inter alia, the “not copied/originating from the putative author” test from *Ladbroke* and concluded that the plaintiff had applied significant energy and skill in research and had created something materially different from what was to be found in the Yellow Pages.

157 Finkelstein J found that copyright subsisted in catalogues of radiator caps and fuel tank caps in *Autocaps (Aust) Pty Ltd v Pro-kit Pty Ltd* (1999) 46 IPR 339. The catalogues took the form of a chart specifying the caps suitable for use with a particular make or model of vehicle. The caps were identified by their part numbers. His Honour said (at 352):

“For copyright to subsist in a compilation it must be shown that sufficient labour, skill, judgment or ingenuity has been brought to bear in its creation: Football League Ltd v Littlewoods Pools Ltd [1959] 1 Ch 637 at 651. What will be sufficient labour, skill, etc cannot be defined. ‘In every case it must depend largely on the special facts of that case, and must in each case be very much a question of degree’: Macmillan & Co Ltd v Cooper (1923) 1B IPR 204; 40 TLR 186 at 190 per Lord Atkinson.”

His Honour found the test satisfied, even without taking into account the antecedent process of selection of caps suitable for particular makes or models of vehicles. Accordingly, the case affords little assistance for present purposes.

158 The last High Court case to be noted is *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1 (“*Data Access*”). The joint judgment of Gleeson CJ, McHugh, Gummow and Hayne JJ discussed originality at two places (at 16 and 41). At both, their Honours adopt from Professor Ricketson’s work, *The Law of Intellectual Property* (1984) at 83, the test whether:

“the work emanates from the person claiming to be its author, in the sense that he has originated it or brought it into existence and has not copied it from another.”

This is the “not copied/originating from the putative author” test. As an intermediate appellate court, we must apply this test.

159 In *T R Flanagan Smash Repairs Pty Ltd v Jones* (2000) 102 FCR 181 (“*Flanagan*”), Hely J recognised that there could be copyright in a compilation consisting entirely of material not original to the compiler “by reason of the selection or arrangement of material, provided that sufficient skill, judgment and labour was involved” (at 187). But it seems clear that his Honour’s use of the word “and” was not intended to signify that all three must be present, since his next sentence (at 187) was as follows:

“Whether the amount of skill, judgment or labour that was involved is sufficient to impart to the compilation the quality of originality is a question of fact and degree in each case.” (my emphasis)

I do not think, either, that his Honour can be fairly regarded as suggesting that the skill, judgment or labour must be employed in selecting or arranging, and that skill, judgment or labour in the antecedent collecting or gathering of data can not suffice.

CONCLUSION ON SUBSISTENCE OF COPYRIGHT

The White Pages Directories and Yellow Pages Directories

160 While it is possible to distinguish particular cases on their facts, in my opinion the course of authority in England and Australia examined above supports the following propositions of relevance to the subsistence of copyright in compilations of factual

information:

1. The concept of originality is correlative with that of authorship (*Sands & McDougall*).
2. Authorship (likewise originality) does not require novelty, inventiveness or creativity, whether of thought or expression, or any form of literary merit (cf *Walter v Lane; University of London Press; Sands & McDougall; Victoria Park; Ladbroke*).
3. Not all works, even literary works, are of the same kind and one must identify and keep in mind the particular kind of work within the Act in which copyright is claimed to exist – in the present case, a particular form of literary work, namely, a “compilation” (cf *Walter v Lane; Sands & McDougall*). (The Act’s definition of “literary work” as including a “compilation” has made extended discussion of the meaning of “literary work” unnecessary, but it is noteworthy that the noun “work” has been defined to mean, in the word’s relevant general sense, “A thing, structure or result produced by the operation, action, or labour of ... a person or other agent” (*OED*) and as “a product of exertion, labour, or activity” (of which an artistic, literary or musical work is given as an example) (*Macquarie*).
4. It appears to be a necessary feature of a factual compilation that it supply “intelligible information” (cf *Real Estate Institute* discussed at [93], *Canterbury Park* discussed at [101]-[102]; and cf *Exxon*). Accordingly, a totally random collection and listing of unrelated pieces of factual information would not be a compilation within the Act. (Apparently the position would be different if the compilation included a statement that it was a random selection, since that very statement would give the whole a significance it would otherwise lack.) A telephone directory satisfies the apparent requirement that a compilation convey a significance of its own which is independent of that of its component items considered individually and in isolation from one another. A telephone directory purports to be an alphabetical listing of particulars of all listable telephone subscribers within a given geographical area, and therefore to perform the function of providing access to the telephone number of every subscriber. It impliedly proclaims: “These are the names, addresses and telephone numbers of all listable subscribers within the stated geographical region, and if a name does not appear in its alphabetical position, there is no listable subscriber by that name”.

5. One must apply the test of originality to the literary work, including a compilation, in which copyright is claimed to exist, as a whole, rather than dissecting it and applying the test to the individual parts (cf *Cambridge University Press; Ladbroke; Warwick Film; A-One*).
6. The test of originality is whether the work was not copied, but originated from the putative author (cf *Dicks v Yates; University of London Press; Mander v O'Brien; Victoria Park; Purefoy; Ladbroke; Ogden; Computer Edge; Kalamazoo; Erica Vale; Skybase; Harpur v Lambourne; Data Access*).
7. This test is not an “all or nothing” one but raises a question of fact and degree as to the extent of the putative author’s contribution to the making of the particular literary work in question, in the present case, a compilation (cf *Macmillan v Cooper; Cramp; Ladbroke; Computer Edge; Interlego; Flanagan*). (In *Sampson v Brokensha and Shaw Ltd* (1935) 37 WALR 90 (“*Sampson*”) it was decided that a person who merely bound into a book all the forms prescribed by a set of regulations did not have copyright in the compilation.)
8. For this purpose, no particular kind of antecedent work contributed by the putative author is, *a priori*, to be left out of account, except, perhaps, antecedent work which was undertaken for a purpose or purposes which did not include the making of the literary work at all (cf *Football League; Ladbroke; Mirror Newspapers; Autospin*).
9. It is not the law that where there is only one way of expressing and arranging a whole-of-universe factual compilation, the compilation cannot attract copyright protection (cf *Matthewson v Stockdale; Longman v Winchester; Kelly v Morris; Ibcos*).
10. Decisively for the present case, there is no principle that the labour and expense of collecting, verifying, recording and assembling (albeit routinely) data to be compiled are irrelevant to, or are incapable of themselves establishing, origination, and therefore originality; on the contrary, the authorities strongly suggest that labour of that kind may do so (cf *Matthewson v Stockdale; Longman v Winchester; Kelly v Morris; Scott v Stanford; Morris v Ashbee; Cox v Land and Water Journal Company*;

Morris v Wright; Hogg v Scott; Ager; Collis; Weatherby; ACP v Morgan; Autospin; and the recent Indian case, *Burlington's Home Shopping Ltd v Chibber* (1995) Patent & Trademark Cases 278 (noted in Pravin Anand, "*Burlington's Home Shopping Ltd v Chibber*" (1995) 6 *Ent L Rev* 159, in which the Delhi High Court, not following *Feist*, held that a computer database of mail order customers (names, addresses, telephone and fax numbers) was protected as a compilation within the definition of literary work).

161 To recognise copyright in compilations of factual data which do not involve selection or scope for variance in expression or arrangement may be seen, as a practical matter, to be an acceptance of the proposition that copyright can subsist in facts. No doubt policy reasons can be suggested for withholding, as for according, copyright protection in such cases. There are those who point to the advantages of permitting others to build on the first compiler's work, without first having to repeat that work independently. Others point out that to deny the first compiler copyright protection is to discourage research by would-be first compilers. The Act does not provide for the compulsory licensing of copyright for reasonable remuneration in aid of the commercial objectives of a would-be licensee. Accordingly, the situation in cases such as the present under Australian law is an "all or nothing" one.

162 Consideration has been given to some of the policy issues involved in Europe. In the United Kingdom the *Copyright and Rights in Databases Regulations 1997* (SI 1997 No 3022) ("the Regulations"), made pursuant to *Directive 96/9/EC of the European Parliament and Council of 11 March 1996 on the Legal Protection of Databases* ("the Directive"), has amended the definition of "literary work" in subs 3(1) of the 1988 UK Act by adding after the word "compilation", the words "other than a database", and including and dealing with databases as a special kind of literary work in their own right. A new s 3A of that Act defines "database" as:

"a collection of independent works, data or other materials which –

- (a) are arranged in a systematic or methodical way, and*
- (b) are individually accessible by electronic or other means."*

In *British Horseracing Board Ltd v William Hill Organization Ltd* (2001) 51 IPR 488, the parties agreed that the Regulations were to be construed consistently with the Directive and

that, for the purpose of that proceeding, attention was to be paid only to the latter. By art 7(1) of the Directive, Member States undertook to provide:

“a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database.” (my emphasis)

Unlike its United Kingdom counterpart, the Commonwealth Parliament has not amended the legislation to give effect to a policy in respect of the issues raised by the present case.

163 The task of carefully identifying and listing all the units constituting a defined universe is usefully and commonly, undertaken. Moreover, alphabetical order is a common form of arrangement according to which such lists are made up. There are two special benefits offered by the compiler in such cases. The first is the assurance that the universe has been thoroughly explored, and that all members of it have been captured. “Whole-of-universe certification” gives value to the list. A compilation which can only profess to have captured “nearly all” the members of a defined universe is not as valuable as one that can claim to have captured all of them. But whole-of-universe certification is a benefit only if the second special benefit to which I referred is also present: an intelligible arrangement of the data compiled. Who would want a telephone directory containing particulars of all subscribers listed randomly and therefore inaccessibly?

164 The making of accessible whole-of-universe compilations is arguably to be encouraged by the giving of copyright protection on account of the industrious collection, verification, recording and assembly necessarily undertaken for the purpose. But ultimately the weighing of the competing policy considerations is a matter for the legislature.

165 For reasons given above, and as a result of proposition (10) in [160], the First Issue should be resolved in favour of Telstra.

166 I can dispose of the Second Issue briefly. Telstra’s labour and expense in collecting, verifying, recording and assembling the subscriber data is described in the reasons for judgment of the primary Judge which are summarised by Sackville J.

167 Even in a whole-of-universe case, it is possible that the labour involved will be so

trivial or the “data” so insubstantial or the significance of the statement of the data so evanescent, that the statement will not be an original literary work (cf *Smith’s Newspapers; Sampson; Odham’s Press; Victoria Park; Cramp*; James Lahore, *Copyright and Designs* at [6015] and fn(1)). For example, the universe may have such a small number of members, perhaps two or three, that a list of them might be considered either too insubstantial to be a literary work at all, or, if the view prevailed that the Act necessarily makes **all** compilations literary works, as not an original compilation, and therefore an original literary work, even though the putative author was the first person to perform the very slight labour involved in identifying and listing the members of the universe.

168 But the universe which Telstra identified was the names, addresses and telephone numbers (except private numbers) of all telephone subscribers within defined geographical regions. Telstra expended substantial labour in collecting, verifying, recording and assembling (albeit alphabetically) all this data so that it could issue a whole-of-universe listing.

169 I am not dissuaded from concluding that this labour was sufficient to attract copyright protection by any one of the following considerations, or all of them regarded as a whole:

- that Telstra supplied the Directories pursuant to a statutory obligation;
- that Telstra supplied the Directories free of charge to its subscribers;
- that Telstra supplied the Directories as an incident of a broader business conducted by it;
- that Telstra enjoyed a monopoly;
- that, as a practical matter, it was not open to Desktop or anyone else to acquire the information recorded in the Directories, except from Telstra;
- that the alphabetical arrangement of the data was achieved by the use of computer programs.

170 While most of these features were not present in the industrious collection cases decided to date, and may be said to make the expression “industrious collection” a too elliptical description of Telstra’s labour, which included receiving, standardising, verifying and recording, in my view the principle of those cases is applicable. To deny copyright protection would permit Desktop to appropriate the benefit of Telstra’s substantial labour and

expense in performing those activities.

171 For the above reasons, Telstra owns copyright in the White Pages Directories and the
Yellow Pages Directories.

The Headings Books

172 On what basis did the primary Judge declare that Telstra owned copyright in the
Headings Books? The primary Judge did not base his conclusion on the compilation of all
the members of a given universe, as he did in the case of the Directories.

173 His Honour discussed the Headings Books at various places in his reasons for
judgment. He described (at [17]-[18]) the considerable work undertaken over the years on an
annual basis by the relevant Committee in composing, updating and otherwise developing the
Headings Books.

174 Much later, (at [91]) he stated as follows in relation to the headings as they appeared
in the Yellow Pages Directories:

“As regards the headings, the point is covered by authority. In Lamb v Evans [1892] 3 Ch 462, the plaintiff was the publisher of a trades directory consisting of advertisements furnished by tradesmen and classified under headings denoting the different trades, which headings were composed by the plaintiff. Chitty J held that the plaintiff had copyright in the headings. The Court of Appeal agreed ([1893] 1 Ch 218). In the course of his judgment Lindley LJ said (at 224): ‘It appears to me that the plaintiff has an exclusive right to the publication of those headings ... not that he can restrain other people from publishing the same sort of thing if they go about it in the right way, but he has a right to restrain other people from copying his book’.”

175 With respect, a decision that there was copyright in the group of headings in the trades
directory in *Lamb v Evans* [1892] 3 Ch 462 cannot determine that there is copyright in the
group of headings in the Yellow Pages Directories: whether copyright exists is a mixed
question of fact and law, and the facts of the two cases were not the same facts. Nonetheless,
Lamb v Evans is persuasive in favour of a conclusion that there is copyright in the group of
headings in the Yellow Pages Directories. The trades directory in *Lamb v Evans* and the
present Yellow Pages Directories contained and contain not just two or three names of kinds
of businesses but a large number which were composed by or on behalf of the putative

copyright owner. Clearly, the holding in *Lamb v Evans* was that there was copyright, not in each individual heading, but in the whole, and it would have been an infringement to reproduce them in the form of a list, as well in the form of headings dispersed throughout a directory. Bowen LJ noted that the headings were the result of “literary labour” (at 227) and Kay LJ of “sufficient literary labour” (at 232).

176 Later in his reasons for judgment, the primary Judge said (at [93]):

“Once it is accepted that ‘industrious collection’ will suffice to confer copyright, it follows that the directory portion of the white pages directories, the directory portion of, and the headings in, the yellow pages directories, and the headings in the headings books, are original and essential features of the respective works. This was not seriously in dispute. It would be otherwise if the ‘industrious collection’ view of originality were rejected. In that event, what has been taken is not substantial.”

This passage followed a reference by his Honour to the statement by Mason CJ in *Autodesk Inc v Dyason (No 2)* (1993) 176 CLR 300 at 305 (“*Autodesk No 2*”) that:

“in determining whether the quality of what is taken makes it a ‘substantial part’ of the copyright work, it is important to inquire into the importance which the taken portion bears in relation to the work as a whole: is it an ‘essential’ or ‘material’ part of the work?”

(On the hearing of the appeal, senior counsel for Desktop contended that in fact the issue to which the primary Judge referred in the passage set out above had indeed been seriously in issue before him and that Mason CJ’s formulation of the test of ‘substantial part’ was not satisfied in the present case.)

177 After the passage from his reasons for judgment set out above, the primary Judge said that the reason why a rejection of the “industrious collection” view of originality would have signified that the telephone listings were not original is that they were “garden-variety” directories “devoid of even the slightest trace of creativity” (quoting from O’Connor J in *Feist* at 362). Then his Honour said (at [93]):

“The position is a little more complex with regard to the headings, but the result is the same. I should explain why I have reached that conclusion.”

His Honour then proceeded to give reasons for two findings he made: first, that there was no relevant intellectual input in the allocation of business subscribers to headings (in almost all cases the subscriber selected the heading from those made available by Telstra); secondly, that there was little creative or intellectual effort in the devising of the headings. In relation

to the latter, his Honour said (at [102]):

“I do not mean to imply that the work of the headings committee never requires intellectual effort. However, it is rare for the committee to create a unique heading and often there is only one appropriate heading. Even if there is some choice to be made, no real difficulty is involved. I leave out of account altogether the effort involved in dealing with the commercial implications of adopting a particular heading. That effort has nothing to do with copyright.”

178 His Honour did not return to the issue of the subsistence of copyright in the Headings Books (as distinct from the question of infringement of copyright in them).

179 I think it clear that his Honour’s reason for concluding that there was copyright in the Headings Books was that Telstra had employed much industry (labour) in building up the compilation. His Honour used the expression “industrious collection”. This was, with respect, appropriate: the compilation was the product of an industrious collection of headings. It was, of course, of a different kind from the collection of details of subscribers. Details of subscribers were a reflection of independently existing facts. The subscribers constituted a universe able to be discovered and recorded. The headings, on the other hand, were created and recorded virtually simultaneously. But although the notion of “collection” applies in different ways to subscriber details and headings, this is not of present importance.

180 No error is shown in his Honour’s conclusion that because of Telstra’s labour in compiling the lists of headings constituting them, the Headings Books were also the subject of copyright.

FEIST AND ITS SEQUELAE IN THE UNITED STATES AND CANADA

181 Should the opinion of the Supreme Court of the United States in *Feist* persuade us to a different conclusion? Desktop placed much emphasis on this case.

182 In *Feist*, the respondent to the appeal, Rural Telephone Service Company Inc (“Rural”), was a certified public utility providing telephone services to several communities in northwest Kansas. Pursuant to a requirement of State law, it issued annually an updated telephone directory. The directory was the familiar one consisting of White Pages and Yellow Pages. Rural obtained data for the directory from subscribers, who were required to provide their names and addresses in order to obtain the telephone service. Rural distributed

its directory free of charge to its subscribers but earned revenue by selling Yellow Pages advertisements.

183 Feist Publications Inc (“Feist”) was a publishing company which specialised in area-wide telephone directories. These covered a much larger geographic range than did Rural’s directories. A typical directory of Rural’s covered only a particular calling area, but Feist’s area-wide directories covered a much larger geographic range, reducing the need to call “directory assistance” or to consult multiple directories. Like Rural, Feist distributed its directory free of charge, but earned revenue by selling Yellow Pages advertisements. Feist and Rural competed for Yellow Pages advertising.

184 To obtain White Pages listings, Feist approached each of the 11 telephone companies operating in northwest Kansas and offered to pay for the right to use its White Pages listings. Only Rural refused to deal with Feist. Rural’s refusal meant that there would be a gap in Feist’s area-wide directory, rendering it less attractive to potential Yellow Pages advertisers. Feist used Rural’s White Pages listings without its consent.

185 Unlike Desktop, Feist produced a telephone directory. There was therefore a general similarity of appearance as between Feist’s and Rural’s products.

186 O’Connor J, who delivered the opinion of the Court, observed that the case concerned the interaction of two well-established propositions: that facts are not copyrightable and that compilations of facts generally are. Her Honour thought that the key to resolving the tension between the two lay in understanding why facts are not copyrightable. This was the requirement that a work be original to the author. Her Honour said (at 345-346):

*“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. (M. Nimmer & D. Nimmer, Copyright §§2.01[A], [B] (1990) (hereinafter Nimmer).) To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess **some creative spark**, ‘no matter how crude, humble or obvious’ it might be. Id., §1.08[C][1]. Originality does not signify novelty: a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable. See Sheldon v. Metro-Goldwyn Pictures Corp., 84 F. 2d 49, 54 (CA2 1936).*

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, §8, cl.8, of the Constitution, which authorizes Congress to 'secur[e] for limited Times to Authors ... the exclusive Right to their respective Writings'.” (my emphasis)

187 Her Honour thought that a compilation would attract copyright protection if its author chose which facts to include, in what order to place them, and how to arrange the collected data so that they might be used effectively by readers. She stated (at 348):

“These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. ... Thus, even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement.” (my emphasis)

But her Honour explained that this does not mean that every element of a copyright work is protected, stating (at 348):

“Originality remains the sine qua non of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.”

It followed, she said, that the author of a factual compilation might clothe the facts with “an original collocation of words” (at 348) or might have demonstrated originality in “the selection and arrangement” (at 349), in which case it would be only those words or that selection and arrangement which would be protected: the facts themselves would not “become original through association” (at 349).

188 O'Connor J remarked that, as a result “the copyright in a factual compilation is thin” (at 349), because a subsequent compiler remained free to use the same facts, but not “the same selection and arrangement”.

189 In response to the suggestion that it may seem unfair that much of the fruit of a compiler's labour is freely available to be used by others, her Honour referred (at 349) to, *inter alia*, the “constitutional requirement” found in Art I, §8, cl 8 of the United States Constitution which empowers the Congress to make laws:

“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings

and Discoveries.”

She thought it followed that “[t]he primary objective of copyright is not to reward the labour of authors, but ‘[t]o promote the Progress of Science and useful Arts’.”

190 It was not only by reference to the “constitutional requirement” that her Honour repudiated the hypothesised suggestion of unfairness: she did so also by reference to “the essence of copyright”. For her Honour, this was, in the case of factual compilations, that only originality of expression, selection or arrangement should be protected.

191 O’Connor J proceeded to address the *Copyright Act of 1976* (US) (“the 1976 US Act”) and its predecessor, the *Copyright Act of 1909* (US) (“the 1909 US Act”). Her Honour observed (at 351-352) that the 1909 US Act necessarily incorporated a requirement of originality, but noted that some courts later came to hold that because factual compilations were mentioned specifically in § 5 of that Act, they were copyrightable *per se* without the necessity of originality. She said that these courts developed “a new theory to justify the protection of factual compilations”, known as “sweat of the brow” or “industrious collection”, the underlying notion of which was that copyright was a reward for “the hard work that went into compiling facts” (at 352). According to this theory, the only defence to infringement was that the later compiler had made his or her compilation independently of the earlier one. But her Honour thought the sweat of the brow theory contradicted the “most fundamental axiom of copyright law – that no one may copyright facts or ideas” (at 353).

192 O’Connor J noted that when Congress decided to overhaul the copyright statute, the Register of Copyrights had reported that the absence of any reference to “originality” in the 1909 US Act seemed to have led to misconceptions as to what was copyrightable (at 355). As a result, when enacting the 1976 US Act, Congress replaced the reference to “all the writings of an author” with the phrase “original works of authorship”. Extraneous documents showed that the intention was to maintain standards of originality. Whereas §3 of the 1909 US Act had stated simply that copyright protected only the “copyrightable component parts” of a work, the 1976 US Act replaced this provision with §102(b), which identified the elements of a work for which copyright was not available as “any idea, procedure, process, system, method of operation, concept, principle, or discovery ...”.

193 O’Connor J noted that Congress enacted two new provisions. First, in order to make

clear that compilations were not automatically copyrightable, a definition of “compilation” was provided in §101. Secondly, to make clear that copyright in a compilation did not extend to the facts themselves, Congress enacted § 103.

194

It is convenient now to set out §§101, 102 and 103 of the 1976 US Act:

“§101. Definitions

...

*A ‘compilation’ is 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 ...***

§102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works; ...

(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.

§103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

*(b) **The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.***” (my emphasis)

195

O’Connor J observed (at 357) that the definition of “compilation” in §101 identified three elements which had to be present if a compilation was to be copyrightable:

- (1) the collection and assembly of pre-existing material, facts, or data (the definition in §101 does not expressly mention “facts”);
- (2) the selection, coordination or arrangement of the material, facts or data; and
- (3) the creation, **by virtue of the particular selection, coordination or arrangement**, of “an original work of authorship”.

196 The narrow basis of originality in relation to a compilation allowed by §101 distinguishes the position in America from that in Australia. In Australia “compilation” is not defined (nor is the notion of originality).

197 But according to *Feist*, §§ 101, 102 and 103 merely reflected the general law. Thus, O’Connor J stated (at 357):

“Although § 102 states plainly that the originality requirement applies to all works, the point was emphasized with regard to compilations to ensure that courts would not repeat the mistake of the ‘sweat of the brow’ courts by concluding that fact-based works are treated differently and measured by some other standard.”

198 Her Honour thought the key to the definition resided in the second requirement noted above, of which she stated (at 358):

“It instructs courts that, in determining whether a fact-based work is an original work of authorship, they should focus on the manner in which the collected facts have been selected, coordinated, and arranged. This is a straight-forward application of the originality requirement. Facts are never original, so the compilation author can claim originality, if at all, only in the way the facts are presented. To that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.”

Her Honour said the statute envisioned that there would be some fact-based works in which the element of selection, coordination or arrangement was not sufficiently original to trigger copyright protection. However, she remarked that the originality requirement was “not particularly stringent”, adding (at 358-359):

*“Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), **and that it display some minimal level of creativity.** Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.”* (my emphasis)

Desktop submits that the directory sections of Telstra’s White Pages Directories and Yellow Pages Directories demonstrate no creative spark. I agree.

199 O’Connor J explained that even if a work qualifies as a copyrightable compilation, it receives only limited protection – a point made clear by § 103 (set out at [194] above). Her Honour stated (at 359-360):

“In summary, the 1976 revisions to the Copyright Act leave no doubt that originality, not ‘sweat of the brow’, is the touchstone of copyright protection in directories and other fact-based works. Nor is there any doubt that the same was true under the 1909 Act. The 1976 revisions were a direct response to the Copyright Office’s concern that many lower courts had misconstrued this basic principle, and Congress emphasized repeatedly that the purpose of the revisions was to clarify, not change, existing law. The revisions explain with painstaking clarity that copyright requires originality, § 102(a); that facts are never original, § 102(b); that the copyright in a compilation does not extend to the facts it contains, § 103(b); and that a compilation is copyrightable only to the extent that it features an original selection, coordination, or arrangement, § 101.”

200 Applying legal principle to the facts, her Honour noted that Feist appeared to concede that Rural’s directory, considered as a whole, was subject to copyright because it contained some foreword text, as well as original material in its Yellow Pages advertisements. But the question was whether Rural had copied “constituent elements of the work that [were] original” (at 361). Her Honour stated (at 361):

“Certainly, the raw data does not satisfy the originality requirement. Rural may have been the first to discover and report the names, towns and telephone numbers of its subscribers, but this data does not ‘ow[e] its origin’ to Rural. ... Rather, these bits of information are uncopyrightable facts; they existed before Rural reported them and would have continued to exist if Rural had never published a telephone directory. The originality requirement ‘rule[s] out protecting ... names, addresses, and telephone numbers of which the plaintiff by no stretch of the imagination could be called the author.’”

201 Her Honour went on to hold that although the originality requirement does not pose a stringent standard in the case of a factual compilation, nonetheless “the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever [and] [t]he standard of originality is low, but it does exist” (at 362). Her Honour said that Rural’s White Pages were “entirely typical” and that in preparing them, Rural had simply taken the data provided by its subscribers and listed the data alphabetically by surname. She said (at 362):

“The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.”

and (at 363):

“Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural’s subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.”

202 I do not think *Feist* is deprived of all persuasiveness by reason of O’Connor J’s references to Art I §8 cl 8 of the United States Constitution. Telstra’s submission seems to be that because of the terms of the US constitutional grant of power, the text of the 1976 US Act is construed narrowly so as to constrain copyright protection of a first compiler and to enlarge the field of legitimate activity of later ones. But it is commonplace that an objective of the grant of copyright, including that given in Australia, is to encourage the production of, relevantly, literary works in the public interest. It is true that the Australian constitutional head of power (to make laws with respect to “(xviii) Copyrights, patents of inventions and designs, and trade marks”) is not confined as the American one is: accordingly, it is open to the Australian Parliament to make a law which does not have the purpose identified in Art I §8 cl 8 of the United States Constitution, provided it is nonetheless a law with respect to copyright: *Grain Pool of Western Australia v Commonwealth* (2000) 202 CLR 479 at 498. But a careful reading of *Feist* does not persuade me that the result would have been different if the empowering constitutional head of power had been the Australian one rather than the American. The US constitutional notion of the “writings” of “authors” is found in the Australian legislation’s notion of the “literary works” of “authors”.

203 *Feist* is, however, distinguishable. The terms of §§ 101, 102 and 103, of the 1976 US Act (set out at [194] above), when understood against the background to their enactment, put it beyond question that in the United States the requirement of originality in relation to a factual compilation is not satisfied by mere independent creation coupled with the labour and expense of collecting and verifying the data to be compiled. Rather, it requires independent creation coupled with intellectual effort or a spark of creativity.

204 But to distinguish *Feist* on this basis is of little assistance. In the Supreme Court's view, the 1976 US Act merely made clear general principles of copyright law. The question for decision by us is whether the word "original" in s 32 of the Act requires the intellectual effort or creative spark on which *Feist* insists. In my opinion, the course of Anglo-Australian authority recounted earlier shows that it does not.

Cases in the United States and Canada since *Feist*

205 Two further United States cases are instructive. In *Key Publications, Inc v Chinatown Today Publishing Enterprises, Inc* 945 F 2d 509 (2d Cir 1991) the plaintiff collected business cards from businesses believed to be of interest to the Chinese-American community in New York. The plaintiff sorted them according to category of business then published a "Chinese Business Guide & Directory" with the businesses, their names, addresses and telephone numbers listed in its Yellow Pages in their various categories. The defendant also published a Yellow Pages directory. Approximately 75 per cent of its listings had appeared in the plaintiff's directory.

206 The Court held that there was copyright in the plaintiff's directory because there was evidence of "thought and creativity in the selection" process (the author "selected out" businesses not of interest to Chinese-Americans and businesses soon to close) and because the headings (business categories) were original rather than "mechanical groupings". The Court said that the arrangement was "in no sense mechanical" and involved "creativity". But as illustrations of "mechanical groupings" it referred to **alphabetical**, chronological and sequential listings of data.

207 In *Bellsouth Advertising & Publishing Corp v Donnelly Information Publishing Inc* 999 F 2d 1436 (11th Cir 1993), the United States Court of Appeals for the Eleventh Circuit, considered the issue of copyright in relation to a Yellow Pages directory. It was common ground that the directory was the subject of copyright. But the Court held that by copying the names, addresses, telephone numbers, business types, or units of advertisement in the listings, the defendant did not take any original element of selection, coordination or arrangement, and therefore did not infringe copyright.

208 I turn now to the position in Canada. In *Tele-Direct (Publications) Inc v American Business Information, Inc* (1997) 154 DLR (4th) 328 ("*Tele-Direct*") the Canadian Federal

Court of Appeal upheld the trial judge's conclusion ((1996) 113 FTR 123) that by far the greater part of the appellant's Yellow Pages directory was not subject to copyright, a result which, it noted, was consistent with *Feist*.

209 It was conceded that the Yellow Pages, taken as a whole, enjoyed copyright protection. Tele-Direct, an affiliate of Bell Canada, did not claim copyright in the subscriber information given to it by Bell Canada. It claimed copyright in respect of the organisation of that information, which it had received in a disorganised state from Bell Canada, and in respect of its own collection of additional data, such as facsimile numbers, trade marks and number of years of operation, which it obtained directly from Bell Canada's customers.

210 Décary JA, delivering the judgment of the Court, said that in the case of a compilation, skill, labour and judgment must have been involved in making the compilation, but agreed with the trial judge that Tele-Direct had arranged its information according to "accepted, commonplace standards of selection in the industry" (at 332), citing the trial Judge's decision ((1996) 113 FTR 123 at 139-140).

211 Décary JA referred to the definition of "compilation" which was introduced into s 2 of the *Copyright Act 1985* (Can) in 1993 to implement the *North American Free Trade Agreement*. That section, as a result of the *North American Free Trade Agreement Implementation Act 1993* (Can), contained the following provisions:

"every original literary, dramatic, musical and artistic work' includes every original production in the literary, scientific or artistic domain, whatever may be the mode or form of its expression, such as compilations..."

'Compilation' means:

- (a) ...
- (b) *a work **resulting from the selection or arrangement of data:...***
(my emphasis)

212 His Lordship stated (at 334-335):

"... the addition of the definition of 'compilation' in so far as it relates to 'a work resulting from the selection or arrangement of data' appears to me to have decided the battle which was shaping up in Canada between partisans of the 'creativity' doctrine – according to which compilations must possess at least some minimal degree of creativity – and the partisans of the 'industrious collection' or 'sweat of the brow' doctrine – wherein copyright is a reward

for the hard work that goes into compiling facts.

The definition of ‘compilation’ must be interpreted in relation to the context in which it was introduced. Simply put, it was introduced as a result of the signature of the North American Free Trade Agreement and with the specific purpose of implementing it. It is therefore but natural when attempting to interpret the new definition to seek guidance in the very words of the relevant provision of NAFTA which the amendment intends to implement. The applicable provision is Article 1705 which reads as follows:

Article 1705: Copyright

1. Each Party shall protect the works covered by Article 2 of the Berne Convention, including any other works that embody original expression within the meaning of that Convention. In particular:

- (a) ...*
- (b) 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.*

The protection a Party provided under subparagraph (b) shall not extend to the data or material itself, or prejudice any copyright subsisting in that data or material.

*Clearly, what the parties to the Agreement wanted to protect were compilations of data that ‘embody original expression within the meaning of [the Berne] Convention’ and that constitute ‘intellectual creations’. The use of these last two words is most revealing: **compilations of data are to be measured by standards of intellect and creativity. As these standards were already present in Anglo-Canadian jurisprudence** – as we shall see later – I can only assume that the Canadian Government in signing the Agreement and the Canadian Parliament in adopting the 1993 amendments to the Copyright Act expected the Court to follow the ‘creativity’ school of cases rather than the ‘industrious collection’ school.” (my emphasis)*

213 Décary JA went on to conclude that the 1993 amendments had not altered the law of copyright with respect to compilations of data, but had simply reinforced in clear terms what that law already was, or should have been: “The selection or arrangement of data only results in a protected compilation if the end result qualifies as an original intellectual creation” (at 336). In language reminiscent of that of O’Connor J in *Feist*, his Lordship stated (at 339):

*“Essentially, for a compilation of data to be original, it must be a work that was independently created by the author and which displays at least a minimal degree of skill, judgment and labour **in its overall selection or arrangement**. The threshold is low, but it does exist.” (my emphasis)*

214 Of relevance to the present case is his Lordship's discussion of the expression "skill, judgment or labour". He said (at 339-340):

*"It is true that in many of the cases we have been referred to, the expression 'skill, judgment or labour' has been used to describe the test to be met by a compilation in order to qualify as original and, therefore, to be worthy of copyright protection. It seems to me, however, that whenever 'or' was used instead of 'and', it was in a conjunctive rather than in a disjunctive way. **It is doubtful that considerable labour combined with a negligible degree of skill and judgment will be sufficient in most situations to make a compilation of data original.** One should always keep in mind that one of the purposes of the copyright legislation, historically, has been 'to protect and reward the intellectual effort of the author (for a limited period of time) in the work' (my emphasis). ...The use of the word 'copyright' in the English version of the Act has obscured the fact that what the Act fundamentally seeks to protect is 'le droit d'auteur'. While not defined in the Act, the word 'author' conveys a sense of creativity and ingenuity. I do not read these cases which have adopted the 'sweat of the brow' approach in matters of compilations of data as having asserted that the amount of labour would in itself be a determinative source of originality. If they did, I suggest that their approach was wrong and is irreconcilable with the standards of intellect and creativity that were expressly set out in NAFTA and endorsed in the 1993 amendments to the Copyright Act and that were already recognized in Anglo-Canadian law.*

Cramp & Sons [[1944] 2 All ER 92 at 97] is a good illustration in the House of Lords of the indifferent use of the words 'or' and 'and' in the application of the 'skill, judgment and/or labour test'; yet no one will argue [in the sense of "dispute"] that the proper test was that defined by Lord Porter:

*'It is conceded that, if the work, labour **and** skill required to make the selection and to compile the tables which form its items are negligible, then no copyright can subsist in it. Whether enough work, labour **and** skill is involved, and what its value is, must always be a question of degree.'*" (my emphasis in bold)

215 Telstra submits that *Tele-Direct* is distinguishable as turning on the different legislative provisions construed in the light of their background and purpose. It is true that the Court regarded the 1993 amendments as having decided "the battle which was shaping up in Canada between" the partisans of the "creativity" and "industrious collection" doctrines. But the Court also spoke more generally, and viewed its construction of the provisions as consistent with general principles of Anglo-Canadian copyright law. Décaré JA stated (at 336):

“... I have come to the conclusion that the 1993 amendments did not alter the state of the law of copyright with respect to compilations of data. The amendments simply reinforce in clear terms what the state of the law was, or ought to have been: the selection or arrangement of data only results in a protected compilation if the end result qualifies as an original intellectual creation.

Another impact of the 1993 amendments may well be that more assistance can henceforth be sought from authoritative decisions of the United States courts when interpreting these very provisions that were amended or added in the Copyright Act in order to implement [the North American Free Trade Agreement]. I do not wish to be interpreted as saying that Canadian courts, when interpreting these provisions, should move away from following the Anglo-Canadian trend. I am only suggesting that where feasible without departing from fundamental principles, Canadian courts should not hesitate to adopt an interpretation that satisfies both the Anglo-Canadian standards and the American standards where, as here, it appears that the wording of Article 1705 of NAFTA and, by extension, of the added definition of ‘compilation’ in the Canadian Copyright Act, tracks to a certain extent the wording of the definition of ‘compilation’ found in the United States Copyright Act [...].”

Later (at 342) his Lordship concluded that there was a “fortunate similarity in matters of compilation of data” between the American and Canadian approaches.

216 I do not think *Tele-Direct* is satisfactorily explained as depending on the local legislation, although, as in the case of *Feist* itself, the references to local legislation reduce the persuasiveness of the decision for an Australian court.

217 The United States and Canadian cases mentioned do not persuade me that this Court, at the intermediate appellate level, should depart from the long course of Anglo-Australian authority referred to earlier. If that is to be done, it must be done by the High Court.

INFRINGEMENT

General

218 Telstra pleads that Desktop produced, or caused or authorised the production of, three “CD-ROM products”: *Marketing Pro*, *Australian Phone Disk* and *CD Phone Directory*, and that each of these products:

“contains a reproduction of the whole or a substantial part of each of the *White Pages Directories*, *Yellow Pages Directories* and *Headings Books* which are listed below each such CD-ROM product in Annexure ‘D’ [to the

Pleading].”

(I need not discuss further the more precise alignment which Annexure D to the Pleading alleges as between Telstra’s works and Desktop’s respective CD-ROM products.) The Pleading alleges that by producing, or causing or authorising the production of, the CD-ROM products in these circumstances, Desktop infringed Telstra’s copyright in each of the White Pages Directories, the Yellow Pages Directories and the Headings Books.

219 I have concluded above that Telstra owned copyright in those literary works. By reason of par 31(1)(a)(i) of the Act, Telstra’s copyright included the exclusive right to reproduce those works in a material form and by reason of subs 36(1) of the Act it was an infringement of Telstra’s copyright for Desktop to do so.

220 It is usually said that “reproduction” has two elements: a causal link between the copyright work and the putative infringing work, and sufficient objective resemblance between them: see, for example, *Francis Day & Hunter Ltd v Bron* [1963] Ch 587 (CA) at 614 per Willmer LJ; *S W Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466 (“*SW Hart*”) at 472 per Gibbs CJ; *Computer Edge* at 186 per Gibbs CJ. Desktop admits a causal link in that it admits it took names, addresses and telephone numbers from the White Pages Directories and Yellow Pages Directories, and from the latter, also headings which it used as the “lines of business” of Yellow Pages subscribers. But Desktop denies that there is sufficient objective resemblance between its own products and those of Telstra. Telstra’s Directories were alphabetical lists of subscribers – in the case of the Yellow Pages Directories, arranged under business headings, themselves alphabetically listed. In substance, Desktop submits that it should be seen as having taken, not form, but fact: the individual names, addresses, telephone numbers and subscribers’ lines of business.

221 As noted earlier, the Headings Books are in a special position. First, any copying from them was necessarily indirect. Secondly, Desktop submits that because it used Telstra’s headings as descriptors of subscribers’ lines of business rather than as headings, this affords a further reason why it did not infringe Telstra’s copyright in the Headings Books.

222 Observations on two matters may be made at once. The first concerns (again) the fact/form dichotomy; the second, the issue of sufficient objective resemblance. I have noted earlier that the well-known dichotomy in respect of literary works between form

(copyrightable) and fact or idea (non-copyrightable) (cf *Jefferys v Boosey* (1854) 4 HLC 815 at 867 (10 ER 681 at 702); *Hollinrake v Truswell* at 427; *Hanfstaengl v HR Baines & Co Ltd* [1895] AC 20 at 26-27; *Blackie & Sons Ltd v Lothian Book Publishing Co Pty Ltd* (1921) 29 CLR 396 at 400; *Smith's Newspapers* at 596-597; *Victoria Park* at 498, 511; *Computer Edge* at 181; *Autodesk Inc v Dyason* (1992) 173 CLR 330 at 344-345) can be problematical. The infringement issue in the present case illustrates this. In one sense, Desktop did take Telstra's form: it accurately reproduced all the individual names, addresses, telephone numbers and business descriptions, more or less as they individually appeared in the Directories. In another sense it did not do so: it did not reproduce Telstra's alphabetical arrangement. Moreover, in one sense Desktop took ideas: it took the ideas denoted by names, addresses, telephone numbers and business descriptions. In another sense it did not do so: it did not take the idea of alphabetical arrangement.

223 Be this as it may, as was seen earlier, form was not important in the attraction of copyright protection in the present case. The use of the well-known alphabetical arrangement was predictable, indeed inevitable. Comparatively, little work went into the alphabetisation of the entries (as opposed to the considerable labour involved in gathering and checking the data): see [240] below. As will appear below, in my opinion, at least in the case of a factual compilation intended to be a work of utility, infringement must be tested by reference to the interest which copyright is intended to protect in the particular case. In the present case, that interest was the labour and expense of gathering together in the one place the details of all the members of a given universe – all the telephone subscribers in a region.

224 The element of sufficient objective resemblance can also give rise to difficulty. Objective resemblance has two potential roles. First, it can, in appropriate circumstances, give rise to an inference of actual copying. The House of Lords recently pointed out in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] FSR 113, a case concerning an artistic work, that once actual copying is proved or admitted, attention must be focused on the simple question whether what is proved or admitted to have been taken from the copyright work was the whole or a substantial part of that work. In my view, this approach, which has been followed in Australia in relation to an artistic work (see *Vella v Cummins* (2001) 53 IPR 538), is also generally applicable to literary works (cf *Newspaper Licensing Agency Ltd v Marks & Spencer Plc* [2001] 3 All ER 977 at 983-984). But this leaves outstanding a question as to the second role of objective resemblance. Ordinarily, reproduction (production

again) requires some degree of objective resemblance between the copyright work and the alleged infringing work. Does this requirement apply, and if so how, in the case of copyright compilations of factual information? Does reproduction in such a case require visual resemblance? The copyright compilations here were in the form of alphabetical lists. Does reproduction of them require arrangement in the form of alphabetical listings? I address these questions below.

225 Subsection 10(1) of the Act provides that in the Act, unless a contrary intention appears, “material form” in relation to a work “includes any form (whether visible or not) of storage from which the work ... or a substantial part of the work ... can be reproduced”. This inclusory definition of “material form” was inserted in the Act by s 3(g) of the *Copyright Amendment Act 1984* (Cth). Absent that amendment, Telstra could not establish its case as pleaded. The reason is that Desktop’s CD-ROM products do not resemble, or “contain” anything that resembles, any of Telstra’s three literary works or any part of any of them (cf *Boosey v Whight* [1900] 1 Ch 122, *Cuisenaire v Reed* [1963] VR 719, *Computer Edge*). It becomes necessary therefore, in accordance with the Pleading, to inquire whether it is possible to reproduce from the three CD-ROM products of Desktop, something which constitutes the whole or a substantial part of Telstra’s White Pages directories, or of its Yellow Pages directories, or of its Headings Books.

226 Desktop did not reproduce the whole of the copyright works, that is, the whole of the 55 White Pages Directories, the whole of the 55 Yellow Pages Directories or the whole of the Headings Books. By reason of par 14(1)(b) of the Act, the reference to reproduction of a work in par 31(1)(a)(i) is to be read as including a reference to the reproduction of a substantial part of a work (in the light of this, in so far as the inclusory definition of “material form” noted above also refers to the notion of a “substantial part”, there is a tautology). The notion of “substantial” is not adequately understood as referring simply to quantity: it refers to the quality of the part taken (see, for example, *Ladbroke* at 276 (Lord Reid), 283 (Lord Evershed), 288 (Lord Hodgson), 293 (Lord Pearce); *SW Hart* at 474 (Gibbs CJ); *Autodesk No 2* at 305 (Mason CJ)). Probably the most important indication of whether a part of a work is substantial is the originality of the part. In *Autodesk No 2*, Mason CJ said (at 305) that it was important to inquire into “the importance which the taken portion bears in relation to the work as a whole” and to ask whether it was “an ‘essential’ or ‘material’ part of the work”, citing Ricketson, *The Law of Intellectual Property* (1984) at 481. (Other considerations can

also be relevant, such as, the object of the reproduction, the degrading effect of the defendant's use, and any competition between the defendant's work and the plaintiff's work: see, Ricketson and Creswell, *The Law of Intellectual Property: Copyright, Designs and Confidential Information*, (2001) at [9.20] to [9.49] and authorities there cited.)

Approach of the primary Judge to the issue of infringement

227 As his Honour noted, there was a "split" between Desktop's residential and non-residential (loosely, business) databases. Accordingly, a search for a business in the residential section of *CD Phone Directory* or of *Australian Phone Disk* would not reveal a listing. If a business subscriber appeared in the White Pages Directories, but not in the Yellow Pages Directories, that subscriber would appear in the business section of the databank with the business descriptor marked as "unclassified".

228 *Marketing Pro*, the most sophisticated and informative of the CD-ROM products, contained enhanced listings from the White and Yellow Pages Directories.

229 Aspects of what I have sought to describe above are exemplified by the graphics and accompanying text in Sackville J's reasons for judgment at [299]-[310].

230 The primary Judge addressed the issue of "sufficient objective resemblance" by comparing the search results for which Desktop's CD-ROM products were intended to be used, and are in fact typically used, to generate, on the one hand, and the copyright works on the other. This comparison led his Honour to consider the question whether, in the case of a copyright factual compilation, "sufficient objective resemblance" necessitates visual similarity – a question which he answered in the negative. His conclusion was as follows (at [109]-[110]):

"In this case, the substance of the information that has been taken from Telstra's works (the directory portion of the directories and the headings that appear in the yellow pages directories and heading books) has been reproduced in the CD-ROMs. It must be remembered that copyright is not claimed for each particular entry, because copyright does not subsist in each individual recorded fact. It is claimed in the whole of the collected data, ordered in a particular way. As regards the directories, the significant recorded facts (name, address, telephone number, and the relevant type of business) are the same, or substantially the same, as they appear in Telstra's works. While there are differences, they are in the detail. For example, when displayed on a screen, the information from the CD-ROM does not appear as

columns on a page. But the information can be retrieved in alphabetical order (by postcode rather than region) and can be examined in much the same way as one would read a column on a page. The fact that the alphabetical listings are by postcode and not region, is not a material difference. Nor is the fact that portions of the advertisements are not reproduced. As regards the headings, it is true that they appear once only in each yellow pages directory and that the heading appears with each business entry in the CD-ROMs. This difference is immaterial. All the headings have been taken, as have all the listings beneath those headings. The appearance of the headings and the listings in the CD-ROMs is sufficiently similar to constitute a reproduction.

The result is, and I so find, that Telstra has copyright in the white pages directories, yellow pages directories and headings books, the subject of this action, and DtMS [Desktop Marketing Systems] has infringed that copyright.”

An alternative approach to the issue of infringement

231 In the course of the hearing before us, the question was raised whether it was possible to reproduce from Desktop’s CD-ROM products, the directory portions of the White Pages and Yellow Pages regional telephone directories in their familiar alphabetical format. It was conceded that it was possible to do so in the case of a White Pages Directory subject to the omission of the information pages and non-residential (loosely, business) listings, and in the case of a Yellow Pages Directory, subject to the omission of the information pages, graphics, enhancements and advertisements.

232 I would resolve the issue of infringement without pursuing the present question further.

The White Pages Directories and the Yellow Pages Directories

233 The issue of infringement in the present case raises the question in the context of factual compilations, of the meaning of the related questions of “sufficient objective resemblance” and “substantial part”.

234 In my opinion, in the case of the factual compilations with which we are concerned, neither concept requires visual similarity to exist as a condition of infringement.

235 In *Autospin*, Laddie J said that lack of visual similarity as between the copyright work regarded as a whole and the putative infringing copy regarded as a whole, does not exclude

the possibility of infringement. His Lordship emphasised that copyright protects the material form of a literary work, not for its own sake, but as a means of protecting the author's contribution to the creation of it, and summarised the position as follows (at 697–698):

“Copyright in a literary work, such as a written story, gives protection not just to the words used but may also extend to the themes and ideas incorporated into it if they are sufficiently substantial. For example a novel may be turned into a play with much of the dialogue replaced. What the copyright protects is the relevant work and skill embodied in the work. In the example given this may well include the combination of the main themes, incidents and characters in the story. It may be said, therefore, that copyright protects that combination. Both the 1956 and 1988 Acts require the relevant skill and effort to be fixed in some material form. Frequently this takes the form of words on a page. But it is not the form of fixation which is protected, it is the relevant skill and effort involved in creating the literary work.

The type of literary work at issue in this case is a compilation. Once again, it is not the mere form of words or notation used which justifies copyright protection for a compilation, it is the author's skill and effort expended in gathering together the information which it contains. For example, it is clear that the physical effort of writing down names and addresses to produce a street directory does not of itself justify the creation of compilation copyright in it. It is the effort and skill expended in finding out who lives at which addresses in which road which merits protection (see Kelly v Morris (1866) LR 1 Eq 697). When someone copies a directory he infringes because he reproduces the product of the author's skill and effort in compiling information, not his literary style. The relevant skill may be that involved in collecting the information, selecting it or arranging it, or all of these. The skill and effort deployed by the author is not in any conventional sense 'literary' yet copyright protection is given to it and the product of the author's endeavours is called for convenience a 'literary work'. (my emphasis)

*If those principles are applied to a case where an author has expended considerable skill and effort in working out the dimensions of an article and writing them down, the compilation so created is a literary work and protected by copyright. The Act (whether 1956 or 1988) then protects the work from being reproduced in **any** material form.” (emphasis in original)*

236 Similarly, Garnett, James and Davies state in *Copinger and Skone James on Copyright* (14th ed, 1999, vol 1) (at 7-50 on p 420) in relation to the taking of a substantial part of a factual compilation:

“It is irrelevant that the plan, arrangement or layout of the plaintiff's work may not have been copied if the labour of compilation has been appropriated [Kelly v Morris; Morris v Ashbee; Moffat and Paige Ltd v Gill (1902) 86 LT 465 (CA); Waterlow v Rose]. The fact that the information in the plaintiff's work is not available from any other source, as for example in case of

television programme schedules or football fixture lists, does not excuse infringing copyright [Independent Television Publications Ltd v Time Out Ltd [1984] FSR 64 at 69; Football League].”

237 The leading Australian textbooks on copyright are consistent with these views: cf James Lahore, *Copyright and Designs* at [34,195], [34,220], [34,225]; Ricketson and Creswell, *The Law of Intellectual Property: Copyright, Designs & Confidential Information* at [9.145], [9.155], [9.165]; and cf Laddie, Prescott and Vitoria, *The Modern Law of Copyright and Designs* (2nd ed, 1995) at [2.89] cited with apparent approval in *Pacific Gaming Pty Ltd v Aristocrat Leisure Industries Pty Ltd* (2002) AIPC §91-759 at [91].

238 I would follow his Lordship and the learned authors mentioned. The relevant principle is that where copyright protection is attracted to a compilation of factual information by the labour of collecting, verifying, recording and assembling the data and not by reference to the form of the compilation, reproduction does not require formal resemblance, and the notion of a substantial part of the compilation is not defined by reference to its form.

239 It follows that the visual dissimilarity between Telstra’s and Desktop’s products regarded as a whole (the non-copyright details of all the individual subscribers’ names, addresses and telephone numbers are in fact virtually identical in the respective works) is not inconsistent with a finding of infringement of the copyright in the Directories. Other cases in which infringement has been found, even though the infringer added original matter of his or her own to what was taken from the copyright work, include *Lewis v Fullarton* (1839) 2 Beav 6 (48 ER 1089), *Elanco Products and Waterlow v Rose*, and the “scrambling” of data has been said not to avoid infringement; cf *The Demerara Turf Club Ltd v Phang* (1963) 6 WIR 177. In *British Columbia Jockey Club v Standen* (1985) 8 CPR (3d) 283 the British Columbia Court of Appeal upheld a finding of infringement of the copyright in a compilation of factual details of forthcoming days’ horse races, where the defendant took many, if not all, the details in that compilation and published them in a different form. The Court relied on Laddie, Prescott and Vitoria, *The Modern Law of Copyright* (1980) at par 2.65 (the passage in the first edition comparable to that cited by me above), where it was said that the merit of a compilation may reside in the painstaking labour of assembling facts (as in the case of a directory) and that the copyright in such a work may be infringed by “appropriating an undue amount of the material, although the language employed be different or the order of the

material be altered”.

240 It would be odd that Telstra should fail on infringement because Desktop did not reproduce the details of subscribers in the form of an alphabetical list. Adapting what Gleeson CJ, McHugh, Gummow and Hayne JJ said of the alphabetical arrangement of the Reserved Words in *Data Access* (at 35), very little skill or labour was involved in putting the details of subscribers in the alphabetical form in which they appeared in the Directories over and above the sum of the labour involved in collecting, verifying and recording the details of all the individual subscribers.

241 Either one of two approaches to the question leads to the result that it was an infringement to reproduce, **in whatever form**, the details of all the subscribers. One approach is, as suggested above, to identify that which is not to be taken as that which made Telstra’s works original and therefore attracted copyright protection to them. An alternative approach is to subtract the alphabetical format and to accept that what remains must be that which is original and not to be taken.

242 What did Desktop copy from the White Pages Directories? It copied the names, addresses and telephone numbers of all subscribers. It did not copy the information pages. The subscriber details copied represented those of all of the subscribers. This suffices to show that Desktop has reproduced the original aspect, and therefore a substantial part, of the White Pages Directories.

243 But Desktop did not merely take quantitatively many pieces of factual information. It took the benefit of Telstra’s whole-of-universe certification. By taking that benefit it was able to certify that its own *CD Phone Directory* and *Australian Phone Disk* products based on the White Pages Directories contained details of all listed subscribers. Moreover, those products of Desktop’s conveyed intelligible information: indeed, a user could, inter alia, ascertain the address and telephone number of a residential subscriber, in fact, the names, addresses and telephone numbers of all residential subscribers, more or less as he or she could do by using a regional White Pages Directory.

244 For the above reasons, Desktop reproduced by means of its *CD Phone Directory* and *Australian Phone Disk* products, a substantial part of the White Pages Directories.

245 What did Desktop copy from the Yellow Pages Directories? It copied all names, addresses and telephone numbers of the subscribers (all business) recorded in those Directories as well as many of the headings recorded there. It did not copy information pages, graphics, enhancements or advertisements. The subscriber details taken represented all the subscriber details recorded in the Yellow Pages Directories.

246 Generally for the reasons I have just given in relation to the White Pages Directories, I would also conclude that by means of its *CD Phone Directory* and *Australian Phone Disk* products based on the Yellow Pages Directories and its *Marketing Pro* product, Desktop reproduced a substantial part of the Yellow Pages Directories.

The Headings Books

247 The primary Judge found as follows (at [27]):

“[Desktop] makes some changes to the headings that Telstra uses. There is a conflict in the evidence concerning the degree of overlap. It is not necessary to resolve the conflict. It is sufficient to note that around 95 per cent of the headings used by [Desktop] are identical to the headings used by Telstra and that only approximately 0.36 per cent of [Desktop’s] headings are unique. Except for some minor variations it was not seriously in dispute that [Desktop] has adopted Telstra’s headings.”

248 I infer that Desktop took all or most of the headings which appeared in the Yellow Pages Directories.

249 It is not suggested that Desktop’s copying was not exact or that the headings in the Yellow Pages Directories were not those in the Headings Books. Therefore, I infer that Desktop took all or most of the headings in the Headings Books.

250 Desktop submits that it did not infringe Telstra’s copyright in the Headings Books for two reasons: first, the visual dissimilarity between its numerous individual statements of lines of business and Telstra’s alphabetical list of headings; and, secondly, because Desktop did not use the words it took **as headings**.

251 I reject the visual dissimilarity submission for the reasons I gave above for rejecting that submission in relation to the taking of the details of subscribers.

252 Just as the appearance in the CD-ROM products of that which Desktop took from
Telstra's works is an irrelevancy, so is the use which Desktop made of it. That is to say, like
visual resemblance, resemblance of use is not a necessary element of reproduction of a
substantial part of Telstra's factual compilations.

253 It was not their alphabetical arrangement or their designation as headings that
attracted copyright protection to the compilation of headings constituting the Headings
Books. Rather, it was the labour of building up the collection (of headings). Desktop
appropriated the benefit of all or most of that labour.

254 Accordingly, by parity of reasoning with my reasons for concluding above that
Desktop reproduced a substantial part of the White Pages Directories and a substantial part of
the Yellow Pages Directories, it also reproduced a substantial part of the Headings Books,
and so infringed Telstra's copyright in those Books.

CONCLUSION

255 In my opinion, for the above reasons the appeal should be dismissed with costs.

SACKVILLE J:

THE APPEAL

256 The principal questions in this appeal are whether the respondent ("Telstra") is
entitled to copyright in its White Pages and Yellow Pages telephone directories and, if so,
whether the appellant ("Desktop") has infringed Telstra's copyright. The alleged infringing
works comprise three CD-rom computer software products ("CD-rom products") known,
respectively, as "*Marketing Pro*", "*Australian Phone Disk*" and "*CD Phone Directory*".
Each CD-rom stores what was described in evidence as "Yellow and White pages listing
data". The CD-rom products are essentially marketing tools which enable the user to search
the respective databases in a variety of ways and to reproduce the results of searches.

257 On 7 May 1999, the primary Judge made an order that all issues arising from pars 1-
14 of the further amended statement of claim ("FASC") and pars 1-14 of the defence be heard
and determined separately and prior to all other issues. In substance, these paragraphs
concern Telstra's claim to hold copyright in certain White Pages and Yellow Pages

directories and in so-called “headings books” and its allegation that Desktop infringed its copyright by producing and selling the CD-rom products. Telstra claimed copyright in White Pages and Yellow Pages directories for fifty-five geographic areas, published between 1996 and 1999, and headings books produced between 1996 and 1998. The declaratory relief sought by Telstra relates only to CD-rom products produced by Desktop in respect of periods between the calendar years 1996 and 1998 and the financial year 1998/1999.

258 The primary Judge resolved Telstra’s pleaded claim to copyright in its favour: *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd* (2001) 181 ALR 134 (“*Telstra v Desktop (No 1)*”). His Honour also held that Desktop had infringed Telstra’s copyright by producing the CD-rom products. He subsequently made declarations to the following effect (*Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd (No 2)* [2001] FCA 814 (“*Telstra v Desktop (No 2)*”):

1. Copyright subsists in the White Pages directories, Yellow Pages directories and headings books identified in Telstra’s FASC.
2. Telstra is and at all material times was the owner of the copyright.
3. By producing the CD-rom products without the licence of Telstra, Desktop infringed Telstra’s copyright in the directories and headings books in the manner specified in the Annexure to the FASC.
4. By possessing the CD-rom products, Desktop wrongfully converted them to its own use.

259 These declarations do not finally determine the proceedings commenced by Telstra. His Honour did not resolve Telstra’s claim that Desktop had also infringed its copyright by selling the CD-rom products and by authorising the production of lists and other documents containing material from the CD-rom products. While that claim appears to have been the subject of the order for separate trial, further issues were apparently identified after his Honour delivered judgment, but before the declarations were made. Moreover, by reason of the order for a separate trial, Telstra’s allegation that the second respondent (Mr Scibor-Kaminski), Desktop’s Managing Director, authorised or procured the infringing conduct, has not yet been addressed. Similarly, a cross-claim by Desktop alleging that Telstra wrongfully claimed infringement of copyright has not yet been considered by the primary Judge, although the declarations, if they stand, presumably remove the foundation for Desktop’s cross-claim. Finally, the primary Judge has not yet considered Telstra’s claim for injunctive

relief, damages and an account of profits.

260 Since the declarations made by the primary Judge do not dispose of the whole of the proceedings, his Honour took the view that the declaratory orders were interlocutory in character: *Telstra v Desktop (No 2)*, at [4]. The primary Judge granted Desktop leave to appeal pursuant to s 25(2) of the *Federal Court of Australia Act 1976* (Cth). Desktop's notice of appeal was duly filed pursuant to that leave. Telstra filed a notice of contention, to which reference will be made later.

261 The notice of appeal does not name Mr Scibor-Kaminski as an appellant nor, for that matter, as a respondent. The absence of Mr Scibor-Kaminski as a party to the appeal was drawn to the attention of counsel, but Desktop did not seek to join him and Telstra made no objection to the appeal being heard without Mr Scibor-Kaminski being joined.

262 During the hearing of the appeal Mr Nettle QC, who appeared with Mr McGowan for Desktop, sought leave to amend the notice of appeal. The effect of the proposed amendment was to seek modification of the declarations made by the primary Judge, so as to incorporate a declaration that the year 2000 edition of the CD-rom products did not infringe Telstra's copyright. According to Mr Nettle, the point of the amendment was to invite this Court to make findings that, even if Desktop's pre-2000 editions had infringed Telstra's copyright, Desktop had made sufficient changes to prevent any finding of infringement being made in respect of the 2000 editions.

263 The declarations made by the primary Judge, reflecting the relief sought in the FASC, refer only to pre-2000 CD-rom products. Desktop's cross-claim does not seek relief in respect of the year 2000 edition of the CD-rom products. The primary Judge, not surprisingly, made no findings about the 2000 edition of the CD-rom products. Dr Emmerson QC, who appeared with Mr Ryan for Telstra, told the Court that had an issue concerning the 2000 edition of the CD-rom products been raised by the pleadings or at the trial, Telstra would have led further evidence at the trial. In these circumstances, the Court refused leave to amend the notice of appeal.

LEGISLATION

264 Telstra commenced the proceedings on 18 January 1999. As I have noted, it

complained of conduct by Desktop during the period from 1996 to 1999. The relevant provisions of the *Copyright Act 1968* (Cth) (“*Copyright Act*”) in force during that period are referred to below.

265 The *Copyright Act* was enacted by the Commonwealth Parliament pursuant to the power conferred by s 51(xviii) of the *Constitution*. Section 51(xviii) confers power on the Parliament to make laws with respect to “Copyrights, patents of inventions and designs, and trade marks”.

266 Section 8 of the *Copyright Act* provides that, subject to a presently irrelevant exception, copyright does not subsist otherwise than by virtue of the *Act*. Section 32(1) provides that, subject to the *Copyright Act*:

“copyright subsists in an original literary, dramatic, musical or artistic work that is unpublished and of which the author:
(a) *was a qualified person...”.*

A “qualified person” includes an Australian citizen or a person resident in Australia: s 32(4). Section 32(2) of the *Copyright Act* states that, subject to the *Act*:

“where an original literary, dramatic, musical or artistic work has been published:
(a) *copyright subsists in the work;*
...
if, but only if,
(c) *the first publication of the work took place in Australia;*
(d) *the author of the work was a qualified person at the time when the work was first published; or*
(e) *...”.*

A reference in the *Copyright Act* to “the author of a work” is generally to be read, in the case of a work of joint authorship, as a reference to all the authors of the work: s 78. The references in s 32 to “the author of a work” are, in relation to a work of joint authorship, to be read as references to any one or more of the authors: s 79.

267 “Literary work” is defined by s 10(1) to include

“(a) a table or compilation, expressed in words, figures or symbols (whether or not in a visible form)...”.

It should be noted that the definition of “literary work”, prior to the amendments effected by the *Copyright Amendment Act 1984* (Cth), included “a written table or compilation”. The

current definition extends to compilations stored in electronic form.

268 In general, the author of a literary work is the owner of any copyright subsisting in the work: *Copyright Act*, s 35(2). This is, however, subject, *inter alia*, to s 35(6) which provides that 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, that person is the owner of any copyright subsisting in the work.

269 The copyright in a literary work is infringed by a person who, not being the owner of the copyright, and without the licence of the owner, does in Australia any act comprised in the copyright: s 36(1). Section 31(1) of the *Copyright Act* provides that for the purposes of the *Act*, unless the contrary intention appears:

“Copyright, in relation to a work, is the exclusive right:
(a) *in the case of a literary, dramatic or musical work; to do all or any of the following acts:*
(i) *to reproduce the work in a material form;*
...”.

The expression “material form”, in relation to a work, is defined in s 10(1) to include:

“any form (whether visible or not) of storage from which the work or adaptation, or a substantial part of the work or adaptation, can be reproduced”.

This definition of “material form” was introduced by *Copyright Amendment Act 1984* (Cth).

270 Section 14(1)(b) of the *Copyright Act* provides that unless a contrary intention appears:

“a reference to a reproduction, adaptation or copy of a work shall be read as including a reference to a reproduction, adaptation or copy of a substantial part of the work, as the case may be.”

THE ISSUES

271 Telstra claimed copyright in the White Pages and Yellow Pages directories under s 32(2) of the *Copyright Act*. Telstra’s case, both at trial and on appeal, was that the White Pages and Yellow Pages directories were literary works, being compilations expressed in words, figures or symbols, first published in Australia. Telstra claimed copyright in the headings books under s 32(1) of the *Copyright Act*, as unpublished literary works, being compilations of which the author was a qualified person at the relevant time.

272 Desktop raised no issue either at trial or on the appeal as to whether Telstra had shown that the telephone directories or the headings books had one author or joint authors. As his Honour noted, the trial (and, I would add, the appeal) was conducted on the basis that it was unnecessary for Telstra to establish that the directories or headings book had a particular author or joint authors or, alternatively, on the basis that all those involved in its preparation were joint authors who had acted in pursuance of their terms of employment: cf *Waterlow Publishers Ltd v Rose* (1989) 17 IPR 493, at 500, per Slade LJ (defining the author of a compilation as “the person who gathers or organises the collection of material and who selects, orders and arranges it”). It is not necessary for me to consider whether this assumption is correct.

273 In substance, Desktop conceded that each condition for the establishment of copyright had been satisfied, save for the requirement that the directories and headings books be “original” literary works. Desktop’s position was that the mere “industrious collection and arrangement in a trite format of publicly available information”, as distinct from an intellectual contribution in terms of selection or arrangement of a compilation, could not satisfy the requirement of originality. Desktop conceded that some parts of the published directories enjoyed copyright, such as the introductory and information pages, cover artwork, indexes and advertising artwork. But, so Desktop argued, it had merely taken the subscriber listing data (names, addresses and telephone numbers) from the White Pages and Yellow Pages directories; it had not taken anything in respect of which copyright subsisted. Desktop acknowledged that, in addition to taking the subscriber listing data, it had used Telstra’s Yellow Pages headings (derived from the headings books) in the arrangement of the data in electronic form. But it contended that the headings were insufficiently original in the relevant sense to attract copyright.

274 There was reference in argument to Telstra claiming copyright in a “whole of universe” compilation. The “universe” was identified as all residential and business telephone subscribers (other than those with silent numbers), as recorded in each of Telstra’s directories. In theory, anyone independently compiling a list of all such subscribers would produce (doubtless after a very great deal of work and effort) an identical list to that published by Telstra in its directories. Moreover, there would be little option but to present the information in alphabetical order according to the names of subscribers. It was in this sense that the compilation was of the whole universe.

275 It was common ground before the primary Judge that the directories and headings books in respect of which Telstra claimed copyright were not the first directories or headings books published or compiled by it. The case was, however, argued at trial and on the appeal on the basis that sufficient changes had been made to the later directories and headings books to enable copyright to subsist, if the works themselves were capable of being the subject-matter of copyright.

276 It was also common ground on the appeal that if Telstra was correct in its contention that “industrious collection” was enough for copyright to subsist in a compilation of facts, Telstra’s investment of labour and expense was sufficient to exceed any quantitative threshold requirement. In other words, Desktop did not submit that if (contrary to its position) “industrious collection” was enough to satisfy the requirement of originality in relation to a compilation of directory information, Telstra had not invested substantial labour and resources in compiling the information.

277 Desktop did dispute, however, that it had infringed copyright, assuming (contrary to its contentions) that Telstra had copyright in the directories as compilations. The issues relating to infringement appear from the parties’ submissions summarised later.

THE FACTUAL BACKGROUND

278 Subject to some minor exceptions, the parties did not challenge the primary facts found by his Honour, although there was disagreement as to the inferences to be drawn from the facts. The following account is drawn largely from his Honour’s findings, although I have added some material which was referred to in the course of the appeal.

TELSTRA’S FUNCTIONS

279 Telstra, then known as Australian and Overseas Telecommunications Corporation Limited, was incorporated under the *Corporations Law* of the Australian Capital Territory. Prior to the coming into force on 1 July 1997 of most of the provisions of the *Telecommunications Act 1997* (Cth) (“*Telecommunications Act*”), Telstra’s functions included controlling all domestic telephone services, a role previously performed by the Australian Telecommunications Commission and, before that, by the Postmaster-General. Since Telstra claimed copyright in directories and headings books published or prepared

before 1 July 1997, some of the material in respect of which copyright was said to subsist came into existence at a time when Telstra effectively had a monopoly over the provision of telephone services in Australia.

280 One of the objects of the *Telecommunications Act* is to provide a regulatory framework that promotes the efficiency and international competitiveness of the Australian telecommunications industry: s 3(1). To that end, the legislation permits competition in the provision of telephone services and provides for the issue of carrier licences: ss 52, 56, 57. Telstra is the holder of a carrier licence and, as such, is subject to the conditions attaching to the licence: s 63. Telstra is required, *inter alia*, to produce an “alphabetical public number directory” annually in volumes by geographic area, on the same basis as it produced a directory in 1997: *Carrier Licence Conditions (Telstra Corporation Limited) Declaration 1997*, cl 9(1). Telstra is obliged to publish and distribute the directory to its own customers and to the customers of other carriage service providers without charge: cl 9(2), (3). There has never been any obligation on Telstra to publish Yellow Pages directories, either before or after the *Telecommunications Act* came into force, but there have always been good commercial reasons for it to do so.

281 As from 1998, Telstra has also been required to establish and maintain an industry-wide integrated public number database (“IPND”), to provide information connected with, *inter alia*, publishing “public number directories” (an expression which includes classified business directories like the Yellow Pages): cl 10(1), (2). The database must include the public telephone number, name and address of a customer of each carriage service provider: cl 10(4). The database is available to other carriage service providers for certain purposes, including the production by that provider of a public number directory: cl 10(7).

THE DIRECTORIES AND HEADINGS BOOKS

282 Telstra has published every year a White Pages and a Yellow Pages directory for each of fifty-five geographic areas. In some areas, such as capital cities, the White Pages and Yellow Pages directories are published separately, while in others they are bound in the one volume.

283 Each White Pages directory published during the relevant period contains a section of “information pages” comprising text and artwork. The information pages include, for

example, a list of emergency telephone numbers, information about international and operator assisted telephone calls and lists of area codes, post codes and government and community services. A White Pages directory also lists in alphabetical order the names, addresses and telephone numbers of all subscribers in the area, apart from those with a “silent” number. Each subscriber is entitled to a basic listing free of charge but may purchase a more prominent listing, such as one in bold type. The listings in a White Pages directory include both residential and business subscribers. In the course of argument, it was suggested that business entries amount to something in order of ten per cent of all listings in the White Pages. While this was not the subject of a finding by the primary Judge, the parties appeared to be content to proceed on the basis that this was a reasonable estimate.

284 A Yellow Pages directory also has information pages. The directory itself is a listing of businesses grouped under headings describing the business activity. The headings appear alphabetically and businesses are listed, also alphabetically, underneath the appropriate heading together with their address and telephone number. A business that is listed in a White Pages directory for a particular area is entitled to one free listing in the Yellow Pages directory for that area, although it appears that not all businesses avail themselves of this entitlement. A business subscriber may purchase an enhanced entry in the Yellow Pages directory. Typically an enhanced entry is one where the business name is printed in bold in a box, as part of an advertisement, or is placed under more than one heading. In some Yellow Pages directories as many as 35 per cent of subscribers have purchased enhanced entries. The income derived from the sale of enhanced entries in the Yellow Pages directory covers the cost of producing both the White Pages directory and the Yellow Pages directory and returns a profit. Telstra also sells enhanced entries in the White Pages.

285 When a person takes out a new subscription for a telephone line, that person’s name, address and telephone number are entered into a computer program known as “Axis”. This program was developed for Telstra at considerable cost to replace an earlier, less satisfactory program. When the subscriber information is entered into Axis, it is classified into entries that must be manually edited (such as silent numbers) and those that do not need editing. The latter entries are formatted by editors. Axis transfers the information to another database, known as “Condor”, which stores all residential and business listings. The information in Condor is verified. If an entry is rejected it is manually checked. The Condor program sorts the listings into alphabetical order. To deal with unusual names or those presenting

classification problems (for example, those beginning with Mc or Mac), an editor can override the program. The entries are subjected to further processing, principally to correct errors notified by subscribers or by directory assistance operators.

286 The information in Condor is transferred to a graphics compilation and typesetting system where the printing process begins. Editors proofread every line of the proof pages to detect error, including errors in formatting and layout as well as checking once again for silent numbers. If any changes have to be made before printing, the production department makes them by means of a graphics compilation and typesetting system. Unlike Condor, this system has no validation process, so that all entering has to be done manually. When corrected, the proof pages are sent to the publisher, which produces the printing plates from them; from these plates it prints the directories. The pages are then bound and dispatched for distribution.

287 A Yellow Pages directory is produced in much the same way as a White Pages directory. There are, however, some differences. First, it is necessary to choose the heading under which each entry is to appear. According to the primary Judge, it is generally the subscriber who chooses the heading from those made available by Telstra, in some cases after recommendation by a salesperson who is trained to sell advertising space. Secondly, Telstra has sales staff who solicit businesses for enhanced entries and advertisements. The staff are trained to deal with subscribers' requirements as well as to take account of Telstra's interests. Thirdly, the graphics that appear in advertisements in a Yellow Pages directory are not stored in Condor, but in a separate database.

288 Three different categories of Yellow Pages directories are produced: a metropolitan directory, a regional directory and a local directory. The headings differ among the three categories. The various headings are taken from the unpublished headings books, one of which exists for each category of Yellow Pages directory. The headings books are intended to cater for all businesses and industries; to produce appropriate groupings for particular business entries (for example retail or wholesale); to be sufficiently specific but not too narrow; to use appropriate language; and to reflect regional and national usage.

289 Each headings book contains an alphabetical list of headings below which there is a list of "see also" and "cross reference" headings, as well as "allied headings". The primary

Judge illustrated this by reference to an entry in the headings book for the 1998 Melbourne Yellow Pages:

“ACCOMMODATION INQUIRY SERVICES

See also Flats – Agents
REAL ESTATE AGENTS
Flat Sharing
Holiday Accommodation
House Sharing
Share Accommodation”

In this example, the primary heading is “Accommodation Inquiry Services”; this heading appears in the directory. The entry “See also Flats – Agents” means that the Yellow Pages directory contains listings under this heading, where similar businesses are listed. The heading in capitals “REAL ESTATE AGENTS” (an allied heading) means that the Yellow Pages directory contains listings under this heading, but that the businesses might be slightly different. The cross-references to “Flat Sharing”, “Holiday Accommodation”, “House Sharing”, and “Share Accommodation”, indicate that the Yellow Pages directory contains these entries in its index, but not in the body of the directory. The index refers the user to related primary headings. The sales staff use primary headings to inform businesses of possible headings. They use the allied headings to suggest to subscribers other categories where a listing could be placed if the subscriber does not wish to be listed under the suggested heading or wishes to be listed under multiple headings.

290 Headings books have been developed over many years. Until 1995 an internal committee, the Yellow Pages National Headings Committee, was responsible for updating the Headings Books. In 1995 a private contractor was engaged to undertake that work on the basis that any copyright would be assigned to Pacific Access Pty Ltd, a wholly-owned subsidiary of Telstra. Each headings book is revised annually. Requests for changes to headings are usually made by the listed entities, users, industry associations, regulatory bodies or government departments. In recent years, more than 700 requests for change have been received annually. On rare occasions, the Committee makes changes on its own initiative as a result of directory research, changes in terminology and anticipated needs of users and advertisers.

291 In deciding whether to make a requested alteration, the Committee considers whether

others had made similar requests and how the proposed change would affect current listings (if the change is minor, such as the insertion of a cross-reference, the Committee is more willing to make the change). The Committee also surveys households and companies affected, consults *The Macquarie Dictionary* and sometimes conducts research. Telstra also has an on-line product similar to the Yellow Pages directory and a voice operated Yellow Pages directory. The Committee takes into account the search requests made by users of these products when considering changes. Long experience with the headings structure is considered to be important, because only those with experience can gauge a proposed change's significance. In deciding whether to make a change, consideration is given to a number of matters: the subscriber's wishes; an assessment of what readers of the directory will find most useable; the effect on completeness of coverage; and the financial implications of the change. There may be a financial impact if an additional heading is created or if two or more headings are combined. Usually somewhere between ten and forty changes are made each year.

292 The uncontested evidence showed that there was a total of approximately 8.5 million residential, business and governmental listings stored in the computer database for the 55 White Pages directories in 1996, while there were 8.8 million listings in 1997 and 10.0 million in 1998. Telstra spent approximately \$311 million between 1995 and 1997 on publishing the White Pages directories. In 1997, for example, Telstra spent \$36 million on "service order information", development and operation of the Condor systems and "processing functions" (mostly editors' wages). In the same year, \$68 million was spent on printing and distribution of the directories.

293 The number of businesses with listings in the Yellow Pages directories varied from approximately 892,000 in 1995 to 936,000 in 1998. In the latter year, there were around 604,700 free (or simple) listings in the Yellow Pages while some 332,000 businesses bought display advertisements or enhanced listings.

THE CD-ROM PRODUCTS

294 There are a number of differences between Telstra's directories and the CD-rom products. The most obvious is the form in which the information is presented. Each Telstra directory covers a particular geographic area. The listing of subscribers in the White Pages directories is in alphabetical order, according to the subscribers' names. The listings in the

Yellow pages directories are under business headings, with subscribers being listed alphabetically under each heading (although the text also includes advertisements placed by subscribers). On the other hand, each of the CD-rom products stores data on an Australia-wide basis. In the case of Desktop's most basic product, *CD Phone Directory*, the display in what was described in argument as the "default mode" is by postcode number, with subscribers listed in alphabetical order under each postcode number. Of course, depending on the sophistication of the particular CD-rom product, the data can be searched and displayed in many different ways. I shall explain later the functioning of each of the CD-rom products and set out several Telstra entries and their Desktop counterparts.

295 The primary data used to produce Desktop's CD-rom products are taken from Telstra's White Pages and Yellow Pages directories. A Sydney company, not associated with Desktop and not a party to the present proceedings, sends every directory to the Philippines, where a large team punches the listed names, addresses and telephone numbers into a computer. The information punched into the computer is changed in various respects. Certain abbreviations are expanded (for example, "Rd" becomes "Road"), the subscriber's State is included and the information is formatted to enable it to be processed. The information is processed in Australia and then provided to Desktop in electronic form, usually on a computer disk. The information provided to Desktop does not include that contained in the directories' information pages or indexes; nor does it include any of the graphics or advertisements from the directories.

296 Desktop loads the data it receives into its computer system. The primary Judge found that Desktop carries out "some cursory validation of the data", but does not undertake any significant checking. (Desktop said that this finding was "unfair", but the evidence referred to in its written submissions does not suggest that his Honour's finding was incorrect.) Desktop then adds data, such as the appropriate industry code for business listings (using the American Standard Classification Code and its Australian and New Zealand counterparts), number of employees, facsimile number, longitude and latitude of the subscriber's address, and Ausdoc DX number. The information is updated if errors are identified.

297 Desktop makes some changes to the headings used by Telstra in its Yellow Pages. The primary Judge found, however, that around 95 per cent of what he described as the "headings" used by Desktop at the relevant time were identical to the headings used by

Telstra and that only approximately 0.36 per cent of Desktop's headings were unique. Desktop did not dispute this finding, but Mr Nettle pointed out that the "headings" simply constituted one means by which the information in the database could be searched and the results displayed (that is, by "Line of Business").

298 Each of the three CD-rom products stores what the primary Judge described as "Yellow and White Pages listings data". Each is also produced in two versions: residential listings and business listings. In fact, the data for the residential version of each CD-rom product is derived from the White Pages directories (omitting the business entries recorded in those directories). Subject to a qualification I shall mention, data for the business version of each CD-rom product are derived from the Yellow Pages directories.

299 The product known as "*CD Phone Directory*" contains the names, addresses and telephone numbers of all telephone subscribers in Australia. The names are listed alphabetically within each postcode number, and the postcodes are ordered sequentially, beginning with 0800 for Darwin. A person wishing to obtain the address or telephone number of a subscriber can search by name. If there is more than one subscriber with that name, the name, address and telephone number will be displayed in postcode order, and alphabetically within each postcode.

300 Desktop's second product, known as "*Phonedisk*", contains the same information as the *CD Phone Directory* but the searching functions are more sophisticated. For example, the data may be searched by telephone number to obtain the name and address of a subscriber (a "reverse" search). It is also possible to search for subscribers within a particular postcode, and by proximity to a post office. Once a search has been conducted, the result can be printed or saved.

301 The third product, known as "*Marketing Pro*", is the most commercially valuable product. *Marketing Pro* consists of eight different editions representing different geographical areas. There is one national edition, four state editions and three city editions. The product is said to store "enhanced Yellow and White pages listing data". Although his Honour referred to businesses being "grouped by type as in the Yellow Pages", it appears more accurate to say that each business is tagged with a label or descriptor which enables a user to manipulate the database by group. As already noted, business listings in *Marketing*

Pro are classified both by type of business (as in the Yellow Pages directory) and by recognised business classification codes. When the information is available, a business entry will include the number of employees; a notation indicating the size of the advertisements the business has placed in the Yellow Pages directory; the Ausdoc DX and facsimile number; and a designation indicating whether or not the business wishes to be canvassed for marketing purposes.

302 His Honour found at [109]) that the information stored on desktop's CD-roms can be retrieved in alphabetical order, by postcode rather than by region, and can be examined in much the same way as one would read a column on a page. In the course of oral argument, the Court was given demonstrations of the manner in which information can be retrieved from Desktop's CD-roms by users. Some points arising from those demonstrations should be noted.

303 As I have observed, the residential listings version of each of the CD-roms is derived from Telstra's White Pages directories. A user is able to display or print out an alphabetical list of entries in the residential version of each CD-rom. Mr Nettle acknowledged that a user, at least of the most sophisticated product, could display or print out an alphabetical listing of residential entries that correspond to those in a particular White Pages directory, such as the one for Melbourne. The alphabetical listing would not, however, be identical to that appearing in the Melbourne White Pages. It would not, for example, include the business listings appearing in the White Pages. Nor would it reproduce entries in the same form as they appear in the White Pages: for example, entries appearing in bold in the White Pages would not appear in that form in the listing of entries derived from the CD-rom. Nonetheless, the information stored on the CD-rom can be manipulated to reproduce all residential entries in a particular White Pages directory in alphabetical order.

304 Subject to one qualification, the data stored on the business version of each of Desktop's CD-roms are derived from the Yellow Pages directories. The qualification is that there are apparently a relatively few entries in the business CD-rom which are derived from the White Pages directories. Thus a business entry in a White Pages directory, which has no counterpart in the Yellow Pages directory, will appear in the business version of each CD-rom. An example given in argument was the listing for the corporate office of Coles Myer Ltd, an entry for which appears in the Melbourne White Pages, but not in the Melbourne

Yellow Pages.

305 The data stored on Desktop’s business CD-roms can be manipulated by a user to reproduce, in alphabetical order, all entries under a particular heading in a particular Yellow Pages directory, such as all “Barristers” listed in the Melbourne Yellow Pages. We were told that in the case of Marketing Pro, the most sophisticated of Desktop’s products, all listings under a particular descriptor or heading can be printed out. In the case of the less sophisticated products, each entry under a particular heading or descriptor can be displayed on the screen successively and can be printed out individually. Of course, the material reproduced from Desktop’s business CD-roms will not include the advertisements appearing in the Yellow Pages directories or any artwork.

A COMPARISON

306 In the context of considering whether Desktop had reproduced Telstra’s works, the primary Judge set out a number of entries appearing in the directories and the counterpart entries stored in the CD-rom products, as displayed in what can be described as “default mode”. It is convenient to reproduce those entries here. As his Honour pointed out, the examples were intended to be representative, but do not necessarily cover the field.

307 The first example was taken from the 1997 Yellow Pages directory for Nowra & Districts under the heading “Air Conditioning-Automotive” and the Nowra 1997 *CD Phone Directory*, the most basic of Desktop’s three products:

A screenshot of a software window titled "Full Record Details". The window contains the following information:
Company Name: Eastgate's Auto Electrical & Air Conditioning
Address: LOT 8 Investigator St
Suburb: NOWRA SOUTH
State: NSW
Postcode: 2541
Telephone: (02) 4421-0528
Book: NOWRA, 1997
Lines of Business:
Auto Electrical Services
Air Conditioning-Automotive
Car Alarms
A "Close" button is located at the bottom right of the window.

The residential listings in *CD Phone Directory*, which are taken from the White Pages

directories, are displayed in similar format, but lack the “Lines of Business” information.

308 The second example is from Telstra’s 1997 Yellow Pages for Warragul & Districts under “Motor Engineers & Repairers” and the corresponding entry in Desktop’s Warragul, 1997 *Phonedisk*:

Supreme Tuning
Lot 2 Ford Pl Lngwry..... 5629 9305



Phonedisk listings taken from the White Pages directories are similar, but simply record “UNCLASSIFIED” for the “Type of Business” category.

309 The third example is from the 1998 Melbourne Yellow Pages under “Auto Parts Recyclers” and the corresponding entry in Desktop’s 1998 *Marketing Pro*:

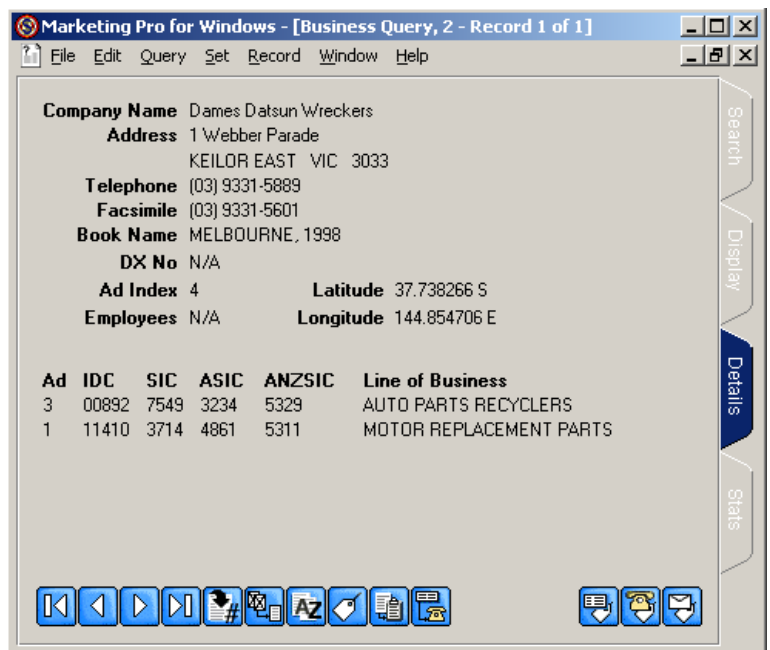
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The entry “Ad Index” refers to the total amount of advertising taken by the subscriber at one address across the various classifications in a particular Yellow Pages directory. The entries under “Ad” relate to the nature and size of the subscriber’s advertisements. *Marketing Pro*, like *Phonedisc*, has a reverse search function which permits a user to search, for example, by telephone number to ascertain the identity of a subscriber. The entry also records the classification of the subscriber under various industry codes. Searches of the database may be undertaken by industry code.

310 It is important to appreciate, however, that the default mode display of entries stored in Desktop’s CD-roms is not the only way information can be displayed or reproduced in hard copy. As has been explained, a search can manipulate the information contained in the CD-rom so as to display the entries, for example, in alphabetical order or under particular headings corresponding to those used by Telstra in the Yellow Pages directories.

THE PRIMARY JUDGMENT

311 The reasoning of the primary Judge can be divided into six sections.

312 In the first section ([29]-[64]), his Honour analysed in depth the historical development of copyright law in the United Kingdom. He pointed out that the case was not concerned with literary or artistic work in the popularly understood sense, but with a claim for copyright in a compilation of facts: that is, the names, addresses and telephone numbers of thousands of individuals and businesses. His Honour identified the principal issue for determination as whether the industrious gathering and listing of those facts qualified the work as “original” or whether some additional element, such as selection or arrangement was necessary.

313 The primary Judge said that the earlier authorities established two propositions:

- there can be no copyright in a fact; and
- a recording of facts can be original for the purposes of copyright if there is some degree of creativity on the part of the author in the process of selection and arrangement.

His Honour considered that the English authorities supported a further proposition, namely that copyright protection will be accorded to a compilation of facts as a reward for the

author's investment of time and money, even if there be no creativity in the work. The primary Judge summarised the effect of the English authorities in an important paragraph ([64]):

*“The author of a book that records facts, whether it be an encyclopedia, a map, a directory or some other factual compilation, does not acquire copyright in the facts that have been published. So much is trite. But the author may have copyright in the form in which he has published the facts. Copyright will subsist if there has been sufficient intellectual effort in the selection or arrangement of the facts. **It will also subsist if the author has engaged in sufficient work or incurred sufficient expense in gathering the facts.** The cases have not defined with any precision what amount of intellectual effort, labour, etc., is required to justify copyright. “In every case it must depend largely on the special facts of that case, and must in each case be very much a question of degree”: *Macmillan & Co Ltd v Cooper* (1923) 40 TLR 186, 190. What is not clear is whether the intellectual effort, labour, etc, must be more than negligible or whether it must be substantial: see *Kalamazoo (Aust) Pty Ltd v Compact Business Systems Pty Ltd* (1985) 84 FLR 101, 120-121 where the cases expressing the competing views are collected. When copyright does subsist in a compilation of facts, any person who wishes to publish the same facts is free to do so. But he must collect the facts himself. He cannot copy them from the first work.”* (Emphasis added.)

314 The second section of his Honour's judgment ([65]-[85]) addressed the North American authorities on which Desktop had relied in support of its contention that commercial information that is of no particular literary value can be the subject of copyright only if there has been some ingenuity in the selection or arrangement of the information. In particular, his Honour discussed in detail *Feist Publications, Inc v Rural Telephone Service Co, Inc* 499 US 340 (1991) (“*Feist*”). In that case, the Supreme Court of the United States rejected the “sweat of the brow theory” (the North American terminology), in holding that Rural did not have copyright in subscriber information contained in its white pages directory. The primary Judge held that, in view of the established English law and what he said was the adoption of that law in Australia, it was not possible to “jettison the old law” and replace it with the principles in *Feist*.

315 In the third section of his judgment ([86]-[88]) his Honour referred to a number of Australian authorities. He expressed the view that, although in some cases copyright was held to exist because of the intellectual effort involved in creating the work, this could not explain the result in all. The primary Judge also rejected a submission that the decision of the High Court in *Data Access Corporation v Powerflex Services Pty Ltd* (1999) 202 CLR 1 was inconsistent with the “industrious collection cases”.

316 The fourth section of the judgment ([89]-[91]) dealt with the question whether there was copyright in Telstra's directories and heading books. His Honour distinguished between this issue and the issue he had discussed earlier, namely whether the directory portion of the directories and the headings themselves were original compilations. It was still necessary to examine the whole work and inquire whether it was protected by copyright.

317 His Honour held that each directory, considered as a whole, was original. If skill was required, sufficient skill had been employed in its creation, as illustrated by the information pages. So far as the headings were concerned, the point was covered by *Lamb v Evans* [1892] 3 Ch 462, where the Court of Appeal held that there was copyright in the headings used in a trade directory.

318 The question whether Desktop had taken a substantial part of the copyright works was addressed in the fifth section of the judgment ([92]-[102]). The primary Judge said that once it had been accepted that "industrious collection" suffices to confer copyright, it followed that the directory portion of the White Pages directories, the directory portion of, and the headings in the Yellow Pages directories and the headings in the headings books were original and essential features of the respective works.

319 His Honour observed that it would have been otherwise if the "industrious collection" view of originality had been rejected. In that case, what had been taken would not have been substantial. The telephone listings were devoid of any creativity. The compilation of the headings also could not be regarded as the product of creative thought. While it could not be said that the work of the headings committee never required intellectual effort, it rarely had to create a unique heading.

320 In the sixth and final section of the judgment ([103]-[109]), the primary Judge found that Desktop had reproduced Telstra's works. His Honour pointed out that the notion of reproduction in copyright law has two elements, namely that the copyright owner's work has been copied and that there is sufficient similarity between the copyright work and that of the alleged infringer. Desktop had admitted copying. The question was therefore whether the CD-roms were sufficiently similar to constitute a reproduction of the directories and the headings books. His Honour added that a work can be reproduced when stored on a CD-rom, since copyright infringement will take place where a work is reproduced in a "material form"

and the definition of that expression in s 10(1) of the *Copyright Act* includes any form of storage, whether visible or not, from which the work can be reproduced.

321 Desktop had argued that the look, feel and arrangement of the CD-roms were radically different from Telstra's products. It had also argued that the visual appearance was different because the entries were alphabetically ordered by postcode (not by geographical areas), contained full mailing addresses, had a layout that was continuous rather than in columns on pages and were displayed in different fonts. Moreover, the CD-roms contained no advertisements and the "headings" were used only as a descriptor shown as part of each business entry. Nor had there been any reproduction of the compilation of headings because all that the CD-roms had reproduced were individual headings in relation to individual records of data.

322 In the primary Judge's view, in the case of a compilation of factual data, the sufficient similarity requirement is not concerned merely with physical appearance, but with whether the particular information conveyed in the alleged infringing work is substantially the same as the like information in the copyright work. His Honour expressed his conclusions in this way (at [109]):

"In this case, the substance of the information that has been taken from Telstra's works (the directory portion of the directories and the headings that appear in the yellow pages directories and headings books) has been reproduced in the CD-roms. It must be remembered that copyright is not claimed for each particular entry, because copyright does not subsist in each individual recorded fact. It is claimed in the whole of the collected data, ordered in a particular way. As regards the directories, the significant recorded facts (name, address, telephone number, and the relevant type of business) are the same, or substantially the same, as they appear in Telstra's works. While there are differences, they are in the detail. For example, when displayed on a screen, the information from the CD-rom does not appear as columns on a page. But the information can be retrieved in alphabetical order (by postcode rather than region) and can be examined in much the same way as one would read a column on a page. The fact that the alphabetical listings are by postcode and not region, is not a material difference. Nor is the fact that portions of the advertisements are not reproduced. As regards the headings, it is true that they appear once only in each yellow pages directory and that the heading appears with each business entry in the CD-roms. This difference is immaterial. All the headings have been taken, as have all the listings beneath those headings. The appearance of the headings and the listings in the CD-roms is sufficiently similar to constitute a reproduction."

323 In *Telstra v Desktop (No 2)*, the primary Judge made orders giving effect to his reasons for judgment in *Telstra v Desktop (No 1)*. He identified the principal issues resolved in Telstra’s favour as the following (at [2])

“first, whether copyright subsisted in Telstra’s white pages directories, yellow pages directories and headings books, and second, if there was copyright, whether [Desktop] infringed that copyright by producing the three CD-rom products known as Marketing Pro, Australian Phone Disc and CD Phone Directory. It is accepted that declarations should be made that give effect to these findings.”

The declarations made by the primary Judge have been summarised earlier (see [258] above). They reflect the allegations made in pars 4, 5 and 6 of Telstra’s FASC.

THE SUBMISSIONS

DESKTOP’S CONTENTIONS

324 Desktop submitted that the primary Judge had erred in holding (at [64]) that copyright subsists in a compilation of facts if the author has engaged in sufficient work or incurred sufficient expense in gathering the facts. Mr Nettle contended that under English and Australian law there can be no copyright in a compilation unless

- “(a) it is shown that some appreciable degree of skill or intellectual effort has been exercised in the selection or arrangement out of the contents of the compilation; or*
- (b) it is shown that some appreciable degree of skill or intellectual effort has been exercised in the organisation of the contents of the compilation into the form which it takes.”*

According to Mr Nettle, the English authorities on which the primary Judge relied were concerned only with expense or effort incurred in the selection and arrangement of the contents of the compilation.

325 Secondly, Desktop submitted that even if the primary Judge had been correct in holding that English law permits copyright in a mere industrious compilation, Australian law was different. Each of the authorities referred to by the primary Judge had assumed or decided that skill in selection or assembly is a *sine qua non* of copyright in the industrious collection cases. Moreover, although *Data Access v Powerflex* was not a compilation case, the High Court had there confirmed that in works of selection the exercise of skill is essential to the existence of copyright. It was consequently argued that there is no basis in Australian copyright law for conferring monopoly protection on the results of labour alone.

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Mr Nettle criticised the primary Judge's refusal to follow the decision of the Supreme Court of the United States in *Feist* and a similar decision of the Canadian Federal Court of Appeal in *Tele-Direct Publications Inc v American Business Information Inc* (1997) 154 DLR (4th) 328. Those authorities were said to be directly in point and were consistent with Australian authority. *Feist* could not be distinguished, as the primary Judge had suggested, on the basis that it depended on constitutional considerations peculiar to the United States. The United States constitutional conception of originality, so Mr Nettle argued, is little different from the originality requirement inherent in s 51(xviii) of the Commonwealth *Constitution*. As a matter of policy, the North American decisions were consistent with the nature and purpose of copyright law in Australia, in particular the notion that copyright protection requires the claimant to demonstrate some intellectual input, even if it be minimal. Mr Nettle also contended that the North American decisions were consistent with international conventions to which Australia is a party, notably the *Berne Convention for the Protection of Literary and Artistic Works 1886* ("the *Berne Convention*") and the *Agreement on Trade-Related Aspects of Intellectual Property Rights 1994* ("*TRIPS Agreement*").

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Thirdly, Desktop contended that, even if copyright subsisted in the directories and headings books, Desktop had not infringed that copyright. Its databases were completely different in order, layout, appearance and presentation. Since the question whether the substance of information has been taken is irrelevant to copyright (copyright being concerned with the expression of ideas and not the ideas themselves), the fact that the same information appeared in both Telstra's directories and headings books and Desktop's CD-rom products is irrelevant to the infringement issue. For this reason, so it was submitted, the primary Judge had failed to apply principles correctly to the facts. Mr Nettle contended that the test of objective similarity had not been satisfied.

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Desktop also disputed that it had taken a substantial part of the work in respect of which copyright existed. Mr Nettle submitted that the primary Judge had erred when he said (at [93] of his judgment) that if "industrious collection" suffices to confer copyright, there was no serious dispute that the directory portion of the White Pages and Yellow Pages directories were original and essential features of the works. He argued that the only original and essential features of the works could be the material which reflected some trace of creativity or intellectual input.

329 Fourthly, Desktop supported its argument on policy grounds. It was said that Telstra alone had a statutory monopoly that entitled it to compel subscribers to provide information. If Telstra had copyright in factual “whole-of-universe” databases (such as a listing of all telephone subscribers in Australia), the practical effect would be to deny that information to other service providers and to prevent them reworking the data even if they applied great ingenuity and skill to that process.

TELSTRA’S CONTENTIONS

330 Telstra emphasised that the *Copyright Act* specifically provided that a literary work includes a table or compilation expressed in figures or symbols (s 10(1)). According to Dr Emmerson, it follows that if something answers the description of a table or compilation, it is a literary work. The definition is not to be read down by incorporating *a priori* notions as to the inherent character of a “literary” work. Since the reason a compilation attracts copyright is that the compiler has brought together information, what is protected is the compilation of the information. The protection accorded by copyright goes beyond the form of arrangement of the data or any skill that may be involved in selecting the data. Dr Emmerson did not shrink from the suggestion that, to a limited extent at least, copyright in a factual compilation extends to the compiled facts.

331 Telstra submitted that the primary Judge had correctly concluded that Desktop had infringed its copyright in the compilations comprised in the White Pages and Yellow Pages. Contrary to Desktop’s contentions, copyright in a compilation was not limited to the selection, arrangement or presentation of data. Copyright subsisted in the compilation by reason of the labour and expense involved in collecting and compiling the directory information. It was not open to a competitor to appropriate the compilation **as a compilation**. This Desktop had done, since it had effectively copied the entirety of the compilation into its database, as well as taken the headings that appeared in the Yellow Pages directories and the headings books. It had appropriated the entire product of Telstra’s labour and expense.

332 Dr Emmerson submitted that it made no difference as to the order (or absence of order) in which the directory information was electronically stored on Desktop’s disks. Given that Desktop had copied or utilised copies of Telstra’s complete compilations, it had reproduced a substantial part of Telstra’s copyright work. Since the form of storage on the

disks enabled a substantial part (indeed the whole) of the copyright work to be reproduced, Desktop had reproduced the work in a “material form” (“*Copyright Act*, s 10(1)). It was not to the point that Desktop had added to Telstra’s compilations: if the whole of a copyright owner’s work is taken, it does not matter that the infringer adds to the material taken.

333 Dr Emmerson contended that the approach taken by the Supreme Court of the United States in *Feist* had been informed by the terms of the governing legislation and constitutional constraints. In particular, the requirement that an original work result from the exercise of some creativity or intellectual labour rested on considerations not applicable in Australia.

334 By its notice of contention, Telstra argued that if its industrious collection argument was rejected, the evidence nonetheless required a finding that significant skill, judgment and ingenuity had been brought to bear in producing compilations of directory information. In the case of the White Pages, for example, Telstra had employed skill, judgment and ingenuity in the following ways:

- gathering the data recorded in the directory;
- verifying new data and monitoring the accuracy of existing data; and
- reproducing the data in the directories.

According to Dr Emmerson, the primary Judge had erred in finding that these activities were devoid even of the slightest trace of creativity.

SUBSISTENCE OF COPYRIGHT

SOME PRELIMINARY POINTS

335 The principal issue in this case concerns the “innovation threshold” which must be satisfied if a compilation of the names, addresses and telephone numbers of subscribers to a telephone service is to be accorded copyright protection: see S Ricketson, *The Law of Intellectual Property* (2001), at [7.35], citing a comment by Professor James Lahore. The resolution of this issue and the related question of infringement ultimately depends on the proper construction of the *Copyright Act* since, as noted earlier, copyright in Australia cannot subsist otherwise than by virtue of the *Act*: s 8. It is, however, difficult to approach the task of construction without reference to the older authorities which predate the passage of the first comprehensive copyright legislation, namely the *Copyright Act 1911* (UK) (the “1911 *Act*”) declared to operate in Australia, subject to minor modifications, by the *Copyright Act*

1912 (Cth) (the “1912 Act”). Indeed, the written and oral submissions on the appeal referred to numerous authorities decided both before and after 1911.

336 The earlier authorities may be important, especially if they have been followed or approved in more recent cases based on modern legislation. Telstra relied, for example, on the decisions of the House of Lords in *Walter v Lane* [1900] AC 539, upholding copyright in reporters’ published records of speeches given by Lord Rosebery, and that of North J in *Collis v Cater Stoffell & Fortt Ltd* (1898) 78 LT 613, upholding copyright in a catalogue of medicines and other articles sold by a chemist. In *Sands v McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 Isaacs J (with whom Gavan Duffy and Rich JJ agreed) not only rejected the argument that the expression “original work” in s 1(1) of the *1911 Act* implied inventive ingenuity, but stated that the principles stated by the House of Lords in *Walter v Lane* continued to apply to the new statutory regime (at 55). Similarly, the Court of Appeal in *Purefoy Engineering Co Ltd v Sykes Boxall & Co Ltd* (1955) 72 RPC 89, at 95, a decision post-dating the *1911 Act*, remarked that *Collis v Cater* had never been doubted (see also *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, at 278, per Lord Reid; at 287-288, per Lord Hodson; at 292, per Lord Pearce).

337 Even so, some caution is necessary when reading the earlier authorities. There are significant differences between the nineteenth century law of copyright and the more modern law. At the time the much-cited case of *Kelly v Morris* (1866) 1 LR Eq 697 was decided (upholding copyright in the “Post Office London Directory”), the legislation in the United Kingdom made no explicit provision for a literary work to include a compilation. A provision to that effect was first introduced by s 35 of the *1911 Act*. The reasoning in other cases depends, at least in part, on provisions that have no exact counterpart in modern legislation. In *Chilton v Progress Printing and Publishing Company* [1895] 2 Ch 29, for example, the Court of Appeal held that there was no copyright in a list of the plaintiff’s selection of horses tipped to win at races to be held in the ensuing week. Lord Halsbury pointed out that the object of the *Literary Copyright Act 1842* (UK), as stated in the preamble, was “to afford greater encouragement to the production of literary works of lasting benefit to the world”. That object was, in his Lordship’s view (at 32), not served by regarding the plaintiff’s opinion as to likely winners as a “literary composition such as intended to be protected by the *Copyright Act*”. The *Copyright Act* currently in force in Australia makes specific provision for copyright in compilations, but has no preamble or

statement of objects corresponding to the provisions relied on by Lord Halsbury.

338 It is also important to bear in mind that copyright protection extends to many different kinds of work. Each particular category of copyright presents its own issues as to the subsistence and infringement of copyright. It ought not to be assumed that the concepts applicable to one form of copyright work necessarily apply, without modification, to others. In *Autospin (Oil Seals) Ltd v Beehive Spinning* [1995] RPC 683, the issue was whether the defendants, by manufacturing seals, had infringed the copyright in the plaintiff's drawings of seals and in a compilation of measurements included in the plaintiff's charts. Laddie J cautioned (at 700-701) against the assumption that the question of "substantial reproduction" must be decided without regard to the nature of the copyright work allegedly infringed:

*"When the court has to decide whether a particular act constitutes a substantial reproduction of a copyright work in my view it must have regard to the nature of the copyright work in issue. What amounts to a substantial reproduction of a particular type of artistic work may well not be a reproduction of a particular type of literary work. Indeed it should be remembered that the categories of copyright work created by copyright legislation are, in some cases, very broad and include materials which have little in common. Maps, charts and plans were protected as literary works under the 1911 Act but as artistic works under the 1956 and 1988 Acts. Therefore under the former Act they were treated as brethren to plays and novels while under the latter they are treated as being in the same category as paintings.... When considering what amounts to infringement of the copyright in, say, a compilation, there is no compelling reason why the courts should pretend that the works covered by literary and artistic copyright form a coherent whole. It should be borne in mind that it is not enough to say that the defendant has 'used' the plaintiff's work. He must have **reproduced** it. In my view the court should ask the question 'is it accurate to say that the alleged infringer's article is, from a common sense point of view, a reproduction of this particular type of literary work?'"*

A similar point was made by an American commentator in relation to copyright in factual compilations (R C Denicola, "Copyright in Collections of Facts: A theory for the Protection of Nonfiction Literary Works" (1981) 81 *Colum L Rev* 516, at 542):

"the subject matter of copyright law is varied, and slogans and catchwords that produce rational results in one context cannot always be successfully transplanted to another. Nonfiction literary works pose a unique challenge. They heighten concern for access and dissemination, yet they underscore the necessity of preserving incentive."

339 As the present case demonstrates, policy tensions permeate the law of copyright, especially in the area of factual compilations. In *Skybase Nominees Pty Ltd v Fortuity Pty Ltd* (1996) 36 IPR 529, Hill J (with whom French J agreed) identified (at 531) the

“tension in policy between the monopoly rights which are conferred upon the owner of copyright in a literary, dramatic or artistic work on the one hand, and the freedom to express ideas or discuss facts on the other. While there will be an infringement of the copyright of an owner in a literary, dramatic, musical or artistic work where there is a reproduction of that work or a substantial part of it, the fact that another work deals with the same ideas or discusses matters of fact also raised in the work in respect of which copyright is said to subsist will not, of itself, constitute an infringement. Were it otherwise, the copyright laws would be an impediment to free speech, rather than an encouragement of original expression.”

It is this tension between “incentive and dissemination” (Denicola, *supra*, at 519) that underlies the difficulties raised by the present case. It also underlies the difficulty of distinguishing between expressions of ideas (which are the subject matter of copyright) and the ideas themselves (which, generally speaking, are not).

340 The Supreme Court of the United States pointed out in *Feist* that there is an “undeniable tension” between the “fundamental axiom” of copyright law, that no author may have copyright in the facts narrated (*Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479, at 498, per Latham CJ), and the principle, enshrined in statute in Australia as elsewhere, that compilations of facts may be the subject-matter of copyright. The present case provides a nice illustration. Since compilations, consisting exclusively of a record of facts, can be the subject matter of copyright, does it not follow that Telstra should be rewarded for its substantial investment of time and resources by being accorded copyright protection in the directory information recorded in the White Pages and Yellow Pages? And if that protection is to be meaningful, should it not protect Telstra not merely against a competitor who produces more or less identical publications, but also against one who uses Telstra’s directory information to create a rather different commercial product? On the other hand, if Telstra is entitled to prevent use of its directory information by a competitor, regardless of whether the final product is structured and presented in the same way as the White Pages and the Yellow Pages, is this not, in effect, conferring copyright protection in

respect of facts?

THE ENGLISH AND AUSTRALIAN AUTHORITIES

341 The primary Judge referred in his judgment to a large number of authorities. In this section I refer to the English and Australian authorities that received most attention in oral and written submissions. The analysis is not exhaustive.

The Pre-1911 English Authorities

342 As already noted (see [335] above), the first comprehensive copyright legislation in the United Kingdom was the *1911 Act*, adopted with minor modifications in Australia by the *1912 Act*. The pre-1911 English authorities were decided before any statutory recognition of compilations as literary works. These authorities have generally been taken as establishing a broad approach both to the scope of copyright in compilation works and to the protection accorded to copyright. *Kelly v Morris* and the rather similar case of *Morris v Ashbee* (1868) 7 LR Eq 34, are two of the cases most frequently cited as supporting that approach.

343 In *Kelly v Morris*, the plaintiff published each year a new edition of the “Post-Office London Directory”. The last edition before the litigation comprised 2,483 pages, exclusive of advertisements. The defendant compiled his “Imperial Directory of London”, in part at least, by copying the plaintiff’s directory and sending out canvassers to confirm that the information so obtained was correct. There seems to have been no dispute that the plaintiff was entitled to copyright in its directory. The defendant argued, however, that there had been no unfair or improper use of the plaintiff’s work.

344 Sir Page Wood VC said (at 701-702) that the defendant had

“been most completely mistaken in what he assumes to be his right to deal with the labour and property of others. In the case of a dictionary, map, guide-book, or directory, when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road-book, he must count the milestones for himself. In the case of a map of a newly-discovered island...he must go through the whole process of triangulation just as if he had never seen any former map, and, generally, he is not entitled to take one word of the information previously published without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and the only use that he can legitimately

make of a previous publication is to verify his own calculations and results when obtained. So in the present case the Defendant could not take a single line of the Plaintiff's Directory for the purpose of saving himself labour and trouble in getting his information." (Emphasis added.)

This language suggests that a competitor infringes copyright in a directory if he or she uses any of the information contained in the directory so as to save labour and trouble in ascertaining factual information. Nothing in the judgment suggests that the principle is any different in a "whole of universe" case; indeed, the reference to "certain common objects of information" indicates that the principle does apply in such a case. It should be noted, however, that there were close similarities between the rival publications and later cases have said that Wood VC's observations went too far in the direction of according copyright protection to facts (see [346] below).

345 In *Morris v Ashbee*, the plaintiff's business directory contained the names and occupations of traders carrying on business in London, the names being presented both in alphabetical order and as groups of like traders arranged in alphabetical order. The defendant published a competing directory printed, to a considerable extent, from slips cut from the plaintiff's directory from the previous year. The defendant argued that there could be no copyright in the plaintiff's work and that, in any event, he had not infringed copyright. Giffard VC reasoned as follows (at 40-41):

*"The Plaintiff incurred the labour and expense first of getting the necessary information for the arrangement and compilation of the names as they stood in his directory, and then of making the actual compilation and arrangement, and, though each individual who paid might no doubt have his own name printed in capital letters or with the same superadded lines wherever he chose, neither one nor all of them could authorise the cutting of a series of slips, or the taking of the names as arranged, from the Plaintiff's directory, and the use of them in the printing of a rival work.... [T]he substance of the judgment [in Kelly v Morris] is, that in a case such as this **no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road.** If this was not so, there would be practically no copyright in such a work as a directory."* (Emphasis added.)

346 *Kelly v Morris* and *Morris v Ashbee* were considered in the modern case of *Waterlow Publishers Ltd v Rose* (1989) 17 IPR 493. This was a "whole of universe" case involving a claim to copyright in the annual Solicitors' Directory and Diary, a compilation containing a list of practising solicitors. The Court of Appeal held that copyright in the list had been

infringed. Slade LJ, with whom Neill and Ralph Gibson LJJ concurred, said (at 507) that *Kelly v Morris* and *Morris v Ashbee* established that:

“(a) the mere fact that material is checked with the data subject and verified as accurate or updated and authorised by him for insertion in the infringing directory does not mean that there is no infringement; (b) the fact that there is no infringement of the plan of Waterlow’s work or of the arrangement and layout of the information does not mean that there is no infringement of the compilation.”

This interpretation of the two nineteenth century decisions strongly suggests that the protection accorded to the compiler under modern legislation goes beyond the mere arrangement or layout of the information recorded in the compilation, at least where preparation of the compilation involves substantial labour and expense.

347 In another modern case apparently involving the same directory, *Waterlow Directories Ltd v Read Information Services Ltd* (1990) 20 IPR 69, Aldous J held, in interlocutory proceedings, that there was a strong case that the defendant had infringed the plaintiff’s copyright by copying onto a word processor about 1,600 out of the 12,600 names and addresses of solicitors recorded in the plaintiff’s list. Aldous J observed (at 73) that Wood VC’s comments in *Kelly v Morris* to the effect that the defendant could not take a single line of the plaintiff’s directory:

“may be too wide when considered against the requirements of the 1988 Act that there must be copying of a substantial part of the work before there can be infringement. However, the principle enunciated is, I believe, clear, that a person may not copy entries from a directory and use that information to compile his own directory.”

348 It will be seen that an important element in the reasoning in *Kelly v Morris* and *Morris v Ashbee* is the proposition that a publisher does not have the right to appropriate the fruits of the labour of another. In Australia, this principle has not been universally applied, as illustrated by the refusal of the majority in *Victoria Park Racing v Taylor* to recognise property in the promoter of a sporting spectacle (horseracing at the plaintiff’s racecourse). Under Australian law, therefore, “reaping without sowing” is sometimes permissible. Nonetheless, the notion that the fruits of labour and expense must be protected has been influential in this area of copyright law.

349 An example of the application of this principle is *Collis v Cater*. There a chemist

carrying on business in a provincial town prepared and registered a catalogue arranged under various headings and sub-headings of articles, medicines and drugs sold by him. The material under the heading “Drugs and Chemicals” was fifteen pages long and set out in alphabetical order the relevant items, together with their prices. There was a similar list under the heading “Patent Medicines and Proprietary Preparations”, in this case twelve pages long. A competitor in the same town inserted in his own catalogue copies of the headings and lists from the chemist’s catalogue, omitting two preparations only.

350 North J pointed to the utility of the chemist’s catalogue, observing that the chemist had incurred a good deal of trouble and expended significant time in preparing a full catalogue. To some extent, the work might have been done by stocktaking, but there were many articles in the catalogue that were not found in stock. A person preparing a catalogue of this sort (at 615):

“has incurred labour in its preparation, or it may be expense and trouble in its preparation, and has done it for the advantage of having his own catalogue.... The man who acts [to appropriate the catalogue] is simply using his neighbour’s expense and labour for his own advantage. He is what is called pirating his neighbour’s book.”

According to North J, the question was whether that person had the right to appropriate, without payment or recognition, what it had cost his neighbour in expense and trouble to prepare. The answer given by his Lordship (at 615) was in the negative:

“I cannot see any distinction between this and the publication of a directory.... If a man takes a town or a county...and prepares a new directory giving the streets and squares, the numbers of the houses, and the persons who live in them, sometimes where trades are carried on, giving the trades, or it may be merely a directory such as one finds in the West-end of London...such a thing is as entirely without what you may call ‘literary merit’ as anything well can be.... But the law is settled as to directories.... I think I am bound by these cases.”

351 On one view, *Collis v Cater* was a case of selection and presentation. In essence, the chemist selected items available for sale (not merely those in stock) and presented them in a particular format. The competitor, in effect, took the whole of the chemist’s work and reproduced it. The reasoning, however, does not depend on the skill or judgment involved in selecting and presenting the items comprised in the list. Rather, the critical point was the competitor’s appropriation of the chemist’s labour and expense in compiling the catalogue.

352 The well-known case of *Walter v Lane* did not involve compilation copyright, but the reasoning emphasised the importance of protecting the labour, skill and expense of a person who produces a published work. The House of Lords held, by majority, that reporters who took shorthand notes of Lord Rosebery’s speeches, and prepared edited and corrected *verbatim* reports of the speeches, were entitled to and could assign copyright in the published reports. A person who copied the published reports without licence was held to have infringed copyright. The decision has been said to represent the “most extreme instance of judicial exploration of the limits of authorship and originality”: Ricketson, at [7.70].

353 Lord Halsbury was reluctant (at 545) to conclude that the law

“permitted one man to make profit and to appropriate to himself the labour, skill and capital of another.”

His Lordship considered that the reporters were no less “authors” than the makers of a directory. He pointed out that the expression “original composition” did not appear in the *Copyright Act 1842* and rejected the notion that skill and accuracy were conditions precedent to copyright in published material.

354 Lord Davey took a somewhat similar approach. He observed (at 552) that

“[c]opyright has nothing to do with the originality or literary merits of the author or composer. It may exist in the information given by a street directory...or by a list of deeds of arrangement...or in a list of advertisements”.

Lord Brampton summed up the case this way (at 559):

“True it is that the reporter was not the author of the speech; but he was the composer and author of the book. Without his brain and handiwork the book would never have had existence, and the words of Lord Rosebery would have remained unrecorded save in the memories of the comparatively few who were present on those occasions.”

Lord James also distinguished (at 554) between “mere mechanical transcribing” and the skill of a reporter in accurately recording spoken words.

355 As Isaacs J said (at 54) in *Sands and McDougall*, decided by the High Court shortly after the *1912 Act* adopted the *1911 Act* in Australia, *Walter v Lane* certainly held that originality in respect of the ideas expressed or in the composition recorded in a report was not necessary to constitute the reporter the “author” of his report. However, Isaacs J interpreted

the speeches in *Walter v Lane* as indicating that the

“personal skill of the reporter as well as his labour and expense were considered to be material considerations.”

By the same token, the skills employed by the reporters can fairly be described as mechanical. As Lord Robertson said in dissent (at 561), the reports presented Lord Rosebery’s thoughts “untinctured by the slightest trace or colour of the reporter’s mind”.

356 In *Leslie v J Young & Sons* [1894] AC 335, decided shortly before *Walter v Lane*, a monthly publication contained tables “in the usual form found in all railway timetables” taking Perth (Scotland) as the main starting point. The tables were to be found in the books of the railway, steamer and coach companies. Lord Herschell LC (with whom the other members of the House concurred) observed (at 340) that the information in the timetables had been devised by the publisher “from sources which were as open to the defenders as to himself”. He said (at 340) that the publisher

“can only claim copyright in them, if they are the result in some respect or other of independent work on his part, and if advantage has been substantially taken by the defenders of that independent labour. The mere publication in any particular order of the timetables which are to be found in railway guides and the publications of the different railway companies could not be claimed as a subject-matter of copyright. Proceedings could not be taken against a person who merely published that information which it was open to all the world to publish and to obtain from the same source.”

His Lordship pointed out that the defenders’ work was by no means a copy of the publisher’s work. He continued (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.”

By contrast, it was held that copyright subsisted in the portion of the publisher’s book that set out information relating to circular tours from Perth, this being “a compilation containing an abridgement of information of a very useful character” (at 342).

357 Mr Nettle submitted that *Leslie v Young* demonstrated the need for some skill in selection or arrangement of material in order for copyright to subsist in a compilation. Dr

Emmerson said that the case turned largely on the fact that the defenders had not copied a substantial portion of the publisher's work and that, in any event, the publisher's work in copying readily available timetables was simply too insubstantial to support a copyright claim. The latter view of the case is supported by Lord Herschell's analysis, especially his emphasis upon the necessity for "independent labour" to support copyright in a compilation and the requirement that the alleged infringer be shown to have substantially appropriated that independent labour. The publisher failed in the claims for infringement of copyright in the timetables themselves because he had invested insufficient independent labour in their compilation.

The 1911 Act

358 The *1911 Act* was designed to implement Great Britain's obligations under the *Berlin Convention 1908* ("*Berlin Convention*"), which revised the arrangements under the *Berne Convention*. The *1911 Act* contained the first express statutory requirement in the United Kingdom for originality in a copyright work. Section 1(1) of the *1911 Act* provided that copyright was to subsist, subject to the *Act*:

"throughout the parts of His Majesty's dominions to which this Act extends...in every original literary dramatic musical and artistic work".

Section 35(1) of the *Act* defined "literary work" to include

"maps, charts, plans, tables, and compilations".

This was also the first reference in copyright legislation in the United Kingdom to "compilations", although the *Copyright Act 1909* (US) had previously included "composite and cyclop'dic works, directories, gazetteers and other compilations" within the subject matter of copyright.

359 The background to the inclusion of the reference to compilations in the *1911 Act* is of some interest. The definition of "literary work" in the *Copyright Bill* made no mention of compilations. The insertion of the word was suggested in the debate in the House of Lords by Lord Gorell, the Chairman of the Board of Trade Committee which had reported in favour of ratifying the *Berlin Convention*: Board of Trade, *Report of the Committee on the Law of Copyright* (C 4976, 1909). Lord Gorell explained the amendment as follows (*House of Lords Parliamentary Debates*, 15 November 1911, at 211):

“It has been suggested to me that this definition would not include many cases which are instances of copyright. The best instance I can give to your Lordships is Bradshaw[’s Guide], which would not come under the present interpretation but would come under the interpretation if the words “and compilations”, which I propose to insert, were added.”

Post-1911 UK Cases

360 Curiously enough, one of the first cases under the *1911 Act* involved *Bradshaw’s Guide*. In *Blacklock & Co Ltd v C Arthur Pearson Ltd* [1915] 2 Ch 376, the plaintiffs were the publishers of the *Guide*, which was a compilation of the current timetables of the various railways of the United Kingdom. The *Guide*, which was published monthly, included an alphabetical index to the thousands of railway stations mentioned. The defendants printed and sold for profit a list of railway stations, in connection with a competition they were conducting. The list bore a “striking resemblance” to the list in the index to *Bradshaw’s Guide*. It was not, however, taken entirely from the *Guide* (see at 378).

361 Joyce J held that copyright subsisted in the list of names contained in the index. He observed (at 380) that the compilation of the index and in particular the making up of a list of names of stations from the timetable “would obviously be a work of labour and therefore of expense”. The defendants had taken a “substantial proportion” of the names contained in the index, thereby (at 383)

“without any exertion of their own getting the benefit of the labour and expense expended in compiling the list which formed the index to Bradshaw.”

362 Mr Nettle accepted that *Blacklock v Pearson* can be seen as a case in which a claim for copyright was upheld solely on the labour and expense of the compiler. Moreover, it is a whole of universe case. Nevertheless, Mr Nettle submitted that if that were the correct interpretation, the case went further than was justified by the previous authorities, especially *Leslie v Young*. There is, however, a clear distinction between the two cases that explains the different outcomes. In *Leslie v Young*, the independent work of the publisher, insofar as it related to the compilation of the timetables, was too slight to support copyright. In *Blacklock v Pearson*, Joyce J thought (at 380) that the making up of the list of names and stations was “obviously” a work of labour and expense.

363 In *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601, it

was held that examination papers could be the subject of copyright as a “literary work”. Peterson J, in a much cited judgment, took a broad view (at 608) of the word “literary”:

“Under the Act of 1842, which protected ‘books’, many things which had no pretensions to literary style acquired copyright; for example, a list of registered bills of sale, a list of foxhounds and hunting days, and trade catalogues; and I see no ground for coming to the conclusion that the present Act was intended to curtail the rights of authors. In my view the words ‘literary work’ cover work which is expressed in print or writing, irrespective of the question whether the quality or style is high. The word ‘literary’ seems to be used in a sense somewhat similar to the use of the word ‘literature’ in political or electioneering literature and refers to written or printed matter.”

His Lordship also gave minimal content to the requirement that a work be “original” (at 608-609):

*“Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of ‘literary work’, with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. **But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.**”* (Emphasis added.)

364 *G A Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329, like *Leslie v Young*, was a case where insufficient labour or skill was involved in preparing the compilation to support copyright. The plaintiffs (respondents to the appeal) published the “Liteblue” diary. The diary included pages containing information of a kind customarily found in diaries: a calendar, postal information, a selection of “days and dates for the year”, tables of weights and measures and the like. The argument in favour of the defendants (appellants) was that there was no evidence that anyone had ever brought any labour, skill or judgment to bear on the compilation.

365 Lord Macmillan, with whom Lords Roche and Simonds concurred, observed (at 337) that not every compilation could claim to be an original literary work “even in the pedestrian sense attributed to these words by the law”. He gave as a “familiar example” the decision in *Leslie v Young*, where the compilation, although convenient, did

*“not require **either such labour or such ingenuity in its preparation as to render it fit subject-matter for copyright**”.* (Emphasis added.)

See also at 340, per Lord Porter; cf at 336, per Lord Simon LC (no feature of the diary was

“novel” or “meritorious” and there was no element of “originality or skill” in the order).

366 *Football League Ltd v Littlewoods Pools Ltd* [1959] Ch 637, shows that ingenuity and effort preceding the preparation of a compilation may be taken into account in determining whether copyright subsists in the compilation. The arrangement of the fixture lists for the soccer season, in a way that met the requirements of the 92 clubs in the four divisions for the forthcoming season, required considerable skill and ingenuity. Once the fixtures list was completed, the preparation of a “chronological list” of fixtures was an automatic process, but one necessitating “painstaking accuracy”.

367 Upjohn J held that the League had copyright in its chronological list and copyright had been infringed by the defendants who copied portions of the list each fortnight on their gambling coupons. He emphasised (at 650-651) the peculiar characteristics of compilations:

*“Compilations frequently, though not, of course, necessarily, consist of merely quasi-statistical reference matter such as railway time tables, horse-breeding material, catalogues, indices, solar and lunar calendar events and reference directories. Such material has no literary merit in the sense of having grammatical composition. The chronological list falls into this category of compilations; as to such compilations the law is clear, but difficulty arises in its application. **Copyright for such a compilation can be claimed successfully if it be shown that some labour, skill, judgment or ingenuity has been brought to bear upon the compilation.** The amount of labour, skill, judgment or ingenuity required to support successfully a claim for copyright is a question of fact and degree in every case.”* (Emphasis added.)

368 His Lordship accepted (at 651) that there could be no copyright in information and that copyright can only be claimed in the composition or language which is chosen to express the information. He considered, however, that the League’s activities in preparing the following season’s football program had to be regarded as leading to the production of the chronological list. It was not open to the defendants to break down the League’s activities into separate components: the chronological list had been produced as the result of the entire skill, labour, time, judgment and ingenuity of the League (at 656).

369 Upjohn J also considered the position if, contrary to his view, the only work of compilation consisted of the production of the chronological list from the clubs’ list. He said (at 656) that the case was a borderline one, but that he would have been prepared to find in favour of the League:

*“I accept at once that in such a compilation there is no element of skill, of selection, of taste, of judgment or of ingenuity. As the secretary of the League said, there is no difficulty – it is automatic. **But, I would add, it involves a great deal of painstaking hard work with complete accuracy as the keynote. That was all that was required, for example, in H Blacklock & Co Ltd v C Arthur Pearson Ltd.**”* (Emphasis added.)

370 The well-known case of *Ladbroke v William Hill* was in many respects similar to the *Littlewoods* case. Bookmakers sent their clients each week a fixed odds betting coupon. The coupon consisted of a single sheet of paper on which sixteen lists of matches were recorded. Clients were offered a variety of lists. It was not in dispute that “a vast amount of skill, judgment, experience and work” had gone into building up the coupon (at 275). In particular, the bookmakers had to select profitable wagers that would nonetheless appeal to clients and had to present the coupons attractively. They had used the same format for many years, although of course the selection of matches changed each week. The appellants, also bookmakers, copied fifteen of the sixteen lists and used similar headings and offered virtually the same varieties of bets. The competitors did not, however, copy the bookmakers’ actual odds or the particular matches they selected each week.

371 The competitors argued that the bookmakers’ coupons had to be regarded as having been produced in two stages: first, the working out of the bets to be offered and, secondly, the writing out of the results. It was said that only the skill, labour and judgment at the second stage could be taken into account in assessing whether the coupons were “original” works. Four members of the House of Lords held that the preparatory work could not be segregated in this fashion. Lord Hodson said (at 287) that a line could not be drawn between the effort involved in developing ideas and the “minimal effort” involved in setting down those ideas on paper. His Lordship illustrated the point by reference to the catalogue cases such as *Collis v Cater*; see also at 278, per Lord Reid; at 287-288, per Lord Hodson; at 290, per Lord Devlin; at 292-293, per Lord Pearce.

372 The judgments devoted some attention to the question of originality in compilations. Lord Pearce adopted (at 291) Peterson J’s definition of originality in *University of London Press v University Tutorial Press* (as did Lord Reid, at 277). His Lordship observed (at 291-292) that in compilation cases

“the courts have looked to see whether the compilation of the unoriginal material called for work or skill or expense. If it did, it is entitled to be

considered original and to be protected against those who wish to steal the fruits of the work or skill or expense by copying it without taking the trouble to compile it themselves....

Thus, directories, catalogues, and the like have been held to be original and to acquire copyright if the work that goes to their making has been sufficient: (Collis v Cater, Stoffel & Fortt Ltd; H Blacklock & Co Ltd v C Arthur Pearson Ltd.)

...

So in each case it is a question of degree whether the labour or skill or ingenuity or expense involved in the compilation is sufficient to warrant a claim to originality in a compilation."

Lord Devlin took a similar approach (at 289):

"There is copyright in every original literary work, which by definition includes compilation, so that there can be copyright in such productions as timetables and directories, provided always they are 'original'. The requirement of originality means that the product must originate from the author in the sense that it is the result of a substantial degree of skill, industry or experience employed by him."

Lord Reid said (at 277-278) that

"as regards compilation, originality is a matter of degree depending on the amount of skill, judgment or labour that has been involved in making the compilation."

373 *Ladbroke v William Hill* was a case involving not merely industrious collection of information, but the exercise of skill and judgment, which was held to be inseverable from the preparation of the coupons themselves. Nonetheless, the reasoning lends support to the view that the requirement of originality in factual compilations may be satisfied by skill, judgment **or** labour and, moreover, that skill, judgment or labour prior to the final stage of preparing the compilation in material form may be taken into account.

374 In *Autospin v Beehive Spinning*, as has already been mentioned, Laddie J considered whether the construction of a three dimensional work (a type of oil seal) reproduced a compilation of measurements contained in certain charts. While ultimately rejecting the claim on the facts, his Lordship held that, in principle, it would infringe copyright in the compilation to reproduce it in the form of a three dimensional article. He said this (at 698):

*"The type of literary work at issue in this case is a compilation. **Once again,***

it is not the mere form of words or notation used which justifies copyright protection for a compilation, it is the author's skill and effort expended in gathering together the information which it contains. For example, it is clear that the physical effort of writing down names and addresses to produce a street directory does not of itself justify the creation of compilation copyright in it. It is the effort and skill expended in finding out who lives at which addresses in which road which merits protection (see Kelly v Morris (1866) LR 1 Eq 697). When someone copies a directory he infringes because he reproduces the product of the author's skill and effort in compiling information, not his literary style. The relevant skill may be that involved in collecting the information, selecting it or arranging it, or all of these. The skill and effort deployed by the author is not in any conventional sense 'literary' yet copyright protection is given to it and the product of the author's endeavours is called for convenience a 'literary work'." (Emphasis added.)

This passage supports the proposition that what is protected in the case of a compilation is not merely the form of presentation, but the skill and effort expended in gathering the information contained in the compilation.

375 The authors of a standard text (who include Laddie J) have summarised the current law in the United Kingdom as follows (H Laddie, P Prescott, M Vitoria, A Speck and L Lane, *The Modern Law of Copyright and Designs* (2000), pars 3.88, 3.90):

*"A compilation is a work consisting of a collection of materials, and its merit normally resides in the painstaking labour which has been expended in assembling the facts (as in the case of a directory); or in the skill, judgment and knowledge involved in selecting those things which are to be included (as in the case of an anthology); or both. **Consequently the copyright in such a work may be infringed by appropriating an undue amount of the material, although the language employed be different or the order of the material be altered. Were the law otherwise copyrights in compilations would be of little or no value.** The point is succinctly stated in two dicta which have frequently been approved: 'No man is entitled to avail himself of the previous labours of another for the purpose of conveying to the public the same information': and 'The true principle in all these cases is that the defendant is not at liberty to use or avail himself of the labour which the plaintiff has been at for the purpose of producing his work; that is, in fact, merely to take away the result of another man's labour or, in other words, his property.*

...
In Football League Ltd v Littlewoods Pools Ltd it was left as an open question whether a copyist might legitimately take the contents of a compilation by rearranging the order of the words. It is submitted that the result of the authorities...is that he may not do so if he is still appropriating for himself a substantial amount of the pains, skill, judgment, knowledge and so on of the original author. Where, however, the originality resides in the order of the material, and the effect of the rearrangement is to destroy this, so that he is no longer appropriating a substantial part of the author's work, the process is legitimate." (Emphasis added.)

While these passages address both the question of copyright in a factual compilation and the circumstances in which copyright will be infringed, they emphasise that an important rationale underlying the current law in the United Kingdom is the need to protect the painstaking labour involved in assembling the compilation.

The Australian Authorities

376 It is hardly surprising that the Australian law concerning factual compilations has mirrored that in England. The *1911 Act* was adopted as Australian law in 1912 and until the 1960s Australian courts, including the High Court, regarded themselves as bound to follow decisions of the House of Lords. The similarity of copyright law in Australia and the United Kingdom was emphasised in the *Report of the Copyright Law Review Committee 1959* (the “*Spicer Report*”). The Committee, whose recommendations were ultimately largely implemented by the *Copyright Act*, said (at par 19):

“It thus appears that Australian law governing copyright has at all times followed closely, though (at times before the establishment of the Commonwealth) somewhat belatedly, developments in Great Britain, and for all practical purposes it can be said that since 1912 Australian law on this subject has been the same as that of Great Britain. Indeed, it may be said that Australian copyright law has always been substantially the same as the law operating in Great Britain.”

The *Spicer Report* went on to note that certain differences in United Kingdom and Australian law had come about as the result of the *Copyright Act 1956* (UK) which, curiously enough, preserved the operation of the *1911 Act* in Australia notwithstanding its repeal in the United Kingdom.

377 In *Sands & McDougall v Robinson*, to which reference has already been made, the plaintiff (the respondent to the appeal) had applied intellectual effort and judgment in preparing a map of the world that “presented both in its totality and in specific parts, distinct differences from other maps” (at 52). The defendant argued that the statutory requirement of originality, introduced in Australia by the adoption of the *1911 Act*, meant that a work had to be original in the same sense in which a patent must be novel.

378 Isaacs J (with whom Gavan Duffy and Rich JJ agreed) rejected the argument. I have previously referred to his Honour’s analysis of *Walter v Lane* (see [336] above). His Honour observed (at 55-56) that

“in copyright law the two expressions ‘author’ and ‘original work’ have always been correlative; the one connotes the other, and there is no indication in the Act that the Legislature intended to depart from the accepted signification of the words as applied to the subject matter. Indeed, the circumstance of reciprocal connotation is the key to the meaning of the enactment. We find in the Oxford Dictionary..., ‘author’ defined as ‘the person who originates or gives existence to anything’.

‘Original work’ in the Act is, in my opinion, used in the same sense as the phrase was used by Lord Eldon in Wilkins v Aikin [(1810) 17 Ves 422, at 426; 34 ER 163, at 166], where he speaks of ‘a mental operation deserving the character of an original work.’”

Isaacs J saw nothing in the *Berlin Convention* warranting a different conclusion.

379 As Dr Emmerson accepted, Isaacs J’s reference to a “mental operation”, taken in isolation, might suggest that originality for copyright purposes involves some creative element. Isaacs J, however, expressed agreement in the same paragraph with the judgments of Joyce J in *Blacklock v Pearson*, at 381, and Peterson J in *University of London Press v University Tutorial Press*, at 608. Each of those judgments supports the proposition that originality does not require that a literary work or compilation be in an original or novel form, but merely that the work not be copied from another author. It is clear enough that Isaacs J was not intending to depart from that principle.

380 *Sands & McDougall v Robinson* emphasised the link between authorship and originality and endorsed a low threshold test for determining whether a work is original. The actual decision in the case is of limited significance for present purposes, because once the defendant’s argument equating originality with novelty was rejected, there could be no doubt that the plaintiff’s map satisfied the test for originality, however expressed. The High Court was not directly concerned with copyright in factual compilations.

381 The question of copyright in a compilation of a particular kind arose, however, in *Victoria Park v Taylor*, albeit as a subsidiary issue. In the High Court, although not at first instance, the racecourse proprietor argued that it had copyright in the names and numbers of starting horses and of the winners of races. These were displayed on notice boards at the racecourse. The proprietor asserted that the defendant had infringed copyright by reading and broadcasting the information. Two members of the Court addressed this issue.

382 Latham CJ said (at 497) that the proprietor’s contention did not require a detailed

answer. He considered it untenable that merely because the proprietor had caused numbers of horses to be exhibited in a particular order for a few minutes on a noticeboard, everybody in Australia was thereafter precluded for a term of at least fifty years from reproducing them in a material form. His Honour said this (at 498):

“The law of copyright does not operate to give any person an exclusive right to state or to describe particular facts. A person cannot by first announcing that a man fell off a bus or that a particular horse won a race prevent other people from stating those facts.... What the law of copyright protects is some originality in the expression of thought.”

383 Dixon J observed (at 511), in the context of rejecting an argument founded on infringement of copyright in a published race book, that

“it is not information that is protected in the case of literary works but the manner in which ideas and information are expressed or used.”

His Honour also expressed the view (at 511) that if the list of starting or winning horses on the board was the subject of copyright, repeating the order did not amount to an infringement of copyright. He continued (at 511):

*“I am, however, quite unable to suppose that, when the names of the starters, their positions, jockeys and so on are exhibited before a race, doing so amounts to publishing a literary work which becomes the subject of copyright. No doubt the expression ‘literary work’ includes compilation. The definition section says so (sec.35(1)). But some original result must be produced. **This does not mean that new or inventive ideas must be contributed. The work need show no literary or other skill or judgment. But it must originate with the author and be more than a copy of other material.** The material for the board consists in the actual allotment of places and other arrangements made by the plaintiff company’s officers in respect of the horses. To fit in on the notice board the names and figures which will display this information for a short time does not appear to me to make an original literary work.”*
(Emphasis added.)

384 As the judgments indicate, the proprietor’s claim in *Victoria Park v Taylor* faced a number of obstacles. Dixon J seems clearly to have rejected the notion that “literary **or other** skill or judgment” was a prerequisite to copyright in a compilation. Moreover, as Mr Nettle accepted, Dixon J construed the word “original” in the *1911 Act* in accordance with the English authorities, to mean simply that the work had to originate with the author and be more than a mere copy of other material. On the other hand, Latham CJ’s approach, as Dr Emmerson acknowledged, was rather different. He placed greater emphasis on the principle that there can be no copyright in facts and appeared to accept that copyright protects

originality in the expression of thought.

385 Mr Nettle relied on *John Fairfax & Sons Pty Ltd v Australian Consolidated Press Ltd* [1960] SR(NSW) 413, to support the proposition that copyright in a compilation of facts protects only the particular arrangement or selection of facts and not the reproduction of the facts in some altered or rearranged format. The issue in *John Fairfax* was whether the respondent had committed contempt by infringing an *ex parte* injunction granted to the appellant. The injunction had restrained the respondent from “copying” the whole or a substantial part of the births and deaths columns in the *Sydney Morning Herald*, a newspaper published by the appellant.

386 The appellant had obtained the injunction after the respondent had reproduced in its newspaper, the *Daily Telegraph*, large numbers of births and deaths announcements in the same form and sequence as they had appeared in the *Sydney Morning Herald*. The Full Court of the Supreme Court of New South Wales identified the question for determination as the meaning to be attributed to the word “copying” in the injunction.

387 The Court held that the word did not extend to the publication of a colourable imitation of the births and deaths column, but was confined to the literal transcription of the column. The Court said this (at 415-416):

“Having regard to the fact already mentioned that the plaintiff could not have and did not claim copyright in the individual announcements themselves but only in their form of arrangement in the column, the only appropriate injunction was one which prevented such a literal transcription. This is supported by the fact that the normal form of injunction in a copyright suit directs the defendant to refrain from copying or colourably imitating or altering the work in which the plaintiff has copyright....

The choice of a more limited form of injunction was not, in our view, accidental but deliberate because to grant the normal and wider form of relief would presuppose that the plaintiff had copyright in the announcements themselves or in the statements of facts and events which they contained, whereas whatever rights it may have could exist only in respect of the total arrangement of the columns. Indeed, the plaintiff’s counsel was prepared to concede at one point of his argument that there could be no such things as a colourable imitation of a compilation in which copyright subsisted, yet if the injunction be construed in the wider sense contended for the plaintiff it would have that effect. Finally, we think that whatever general meaning may be imparted to the word ‘copy’ in ordinary parlance, in the law of copyright it means ‘copy’ in the sense of literal transcription.”

388 In my view, *John Fairfax* has limited significance for the present case. It was, after all, a contempt proceeding. Moreover, the Full Court said (at 415) that the appellant's claim to copyright rested

“solely on the fact that although the copyright in the text of each announcement belonged to the advertiser who tendered it for publication, the skill and labour applied by the plaintiff's employees, in adapting the announcements and arranging them in sequence for publication, conferred on it copyright in the relevant columns of announcements as published.”

In other words, the appellant had not invested significant labour or skill in compiling the relevant information. Any skill and labour could be directed only to adapting and arranging the notices submitted by individual advertisers. Thus copyright in the announcements was limited to the form of arrangement or presentation.

389 The *Copyright Act*, which came into force on 1 May 1969, did not make any significant changes to the provisions governing copyright in factual compilations. As I have noted, the legislation implemented many of the recommendations of the *Spicer Report*. The *Report* did not, however, specifically address the law relating to compilations, although it did include a section headed “Sporting Spectacles”. Under that heading, the *Spicer Report* considered submissions from football bodies which had argued that copyright should exist in lists of players and the numbers allocated to them. The *Spicer Report* rejected the submission (at pars 483-484):

“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 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.

It seems that the football clubs may have copyright in the lists they prepare as published in the various football publications (see Football League Ltd v Littlewoods Pools Ltd, [1959] 3 WLR 42). Such copyright, however, does not prevent a person making his own list by attending a match.” (Emphasis added.)

The *Spicer Report* seems to have taken the view that whether copyright existed in a compilation depended on the amount of labour, capital **or** skill expended in making the compilation and that the law in that respect should not be changed.

390 Desktop contended that the decision of the High Court in *Data Access v Powerflex* was inconsistent with, or at least detracted from, the view taken by the primary Judge, namely that industrious collection of information is enough to establish copyright in a compilation independently of the selection, arrangement or presentation of the information. The principal issue in *Data Access v Powerflex* was whether the “Reserved Words” in the Dataflex computer programs, either individually or collectively constituted a “computer program” as defined in the *Copyright Act*. As the joint judgment noted (at 12), each word in a computer language is an instruction to the computer to invoke lower level processes.

391 In the course of addressing that issue, the Court considered whether the Reserved Words were a substantial part of the Dataflex computer program. The joint judgment rejected the proposition (accepted in *Autodesk Inc v Dyason (No 1)* (1992) 173 CLR 330, at 346, per Dawson J, with whom the other members of the Court agreed, and in *Autodesk Inc v Dyason (No 2)* 176 CLR 300, at 311-312, per Brennan J; at 330, per Gaudron J) that the test of substantiality requires attention to be focussed on the “essentiality” or “criticality” of the element of the copyright work taken by the alleged infringer. Their Honours preferred the dissenting view of Mason CJ in *Autodesk (No 2)*, at 305, that the phrase “substantial part”, as used in s 14(1)(b) of the *Copyright Act*, refers to the quality of what is taken rather than the quantity and that the essential or material features of a work should be ascertained by considering the originality of the part allegedly taken. They pointed out that the “but for” test was not a practicable means of determining substantiality in relation to a computer program. The test would embrace even a minor, non-original element of the program if the program could not work without that element. It followed (at 33) that a person who merely reproduced those parts of a program which were “data” or “related information”, but which were irrelevant to its structure and choice of commands, would be unlikely to have reproduced a substantial part of the program.

392 The joint judgment next held (at 34) that the Reserved Words, when considered as a collocation, lacked “sufficient originality as data to constitute a substantial part of [the Dataflex computer program].” The Reserved Words were merely “literal strings” which, from the computer’s perspective could be replaced by any other literal string. Many of the words used were ordinary English words which were suggestive of the function to be performed (for example “RETAIN” and “UNLOCK”), while others were concatenations of two or more English words suggesting the function to be performed (for example,

“AUTOFIND”). Still others were single words in common use in other computer languages or concatenations of common computer terms (such as “SAVERECORD”)

393 The Court also rejected the submission that copyright subsisted in the table or compilation of the Reserved Words in the *Dataflex User’s Guide*. The joint judgment noted that there had been no submission that the Reserved Words were traditional literary works “no doubt because they would face significant hurdles in the form of originality and substantiality”. Their Honours said (at 35) that

“very little skill or labour was involved in compiling the Reserved Words in the form in which they appear in the User’s Guide [that is, in alphabetical order] over and above the sum of the skill and labour involved in devising each [word]”.

Moreover, each word was suggestive of the function it performed and many were English words or combinations of such words.

394 Their Honours added these observations (at 35):

“Even if the skill and labour involved in devising each individual Reserved Word is combined and consideration given to the total skill and labour, there may still be a real question as to whether there is sufficient originality for copyright to subsist in the combination: cf G A Cramp & Sons Ltd v Frank Smythson Ltd [1944] AC 329; Australian Consolidated Press Ltd v Morgan (1965) 112 CLR 483 at 486-487; Exxon Corporation v Exxon Insurance Consultants International Ltd [1982] Ch 119 at 144.

In any event, even if copyright does subsist in the table or compilation of the Reserved Words, we do not think that the respondents have infringed this copyright. The Reserved Words appear in the PFXplus source code program not as an alphabetical list, but as literal strings to which certain commands are assigned.

395 Finally, the Court held that the “Huffman compression table” embedded in the Dataflex program fell within the extended definition of “literary work”, being a “table...expressed in figures and symbols (whether or not in a visible form)”. The joint judgment addressed the issue of originality as follows (at 41-42):

“For copyright to subsist in the standard Dataflex Huffman table, it must be an ‘original literary...work’ (s 32(1) of the Act). As we have indicated, the requirement that a work be ‘original’ in copyright law is a requirement that ‘the work emanates from the person claiming to be its author, in the sense that he has originated it or brought it into existence and has not copied it from

another': Ricketson, The Law of Intellectual Property (1984), p 83. At first instance, Jenkinson J found that '[t]he use of the Huffman system to produce a compression table requires the employment of substantial skill and judgment and a very great deal of hard work'....

That being so, the Full Court was correct in holding that the standard Dataflex Huffman table constituted an original literary work."

396 It is difficult to see how *Data Access v Powerflex* assists Desktop. The joint judgment specifically accepts that originality in copyright law merely requires that the work emanate from the author, in the sense that he or she has brought it into existence and not copied it. Not surprisingly, the Court's approach to copyright in the Reserved Words was consistent with its view of originality. The citation of *Cramp v Smythson*, *ACP v Morgan* and *Exxon* shows that the Court's doubts about the combination of Reserved Words having sufficient originality for copyright to subsist rested on Data Access's failure to pass the threshold test of skill **or** labour. As has been explained, *Cramp v Smythson* was such a case. *Exxon* involved an unsuccessful attempt to claim copyright in "an artificial combination of four letters of the alphabet": at 144, per Oliver LJ. In the passage cited in the joint judgment from *ACP v Morgan*, Barwick CJ referred, *inter alia*, to *Kelly v Morris* and *Football League v Littlewoods* to show that

"the law has gone a long way...to protect the labours of a man in producing and tabulating information".

The adoption of Mason CJ's test of substantiality does not resolve or even bear directly on the test for determining whether and, if so in what respects, a compilation is original for the purposes of the law of copyright.

397 In *Skybase Nominees Pty Ltd v Fortuity Pty Ltd*, a case also relied on by Desktop, the issue was whether the appellant's weight reduction program, including recipes and other information, infringed the respondent's copyright in its "Weight Watchers" programs. The Full Court upheld the primary Judge's finding that the respondent's program involved a sufficient degree of skill and judgment in compiling and arranging the work to conclude that copyright subsisted in the program. It also upheld a finding of infringement.

398 Mr Nettle referred to the observations of Hill J (at 532) on the question of infringement:

“While the degree of similarity between the two works may lead to an inference of causal connection, both substantial reproduction and causal connection are separate and necessary ingredients of infringement. Mere causal connection will not be enough. A defendant may rework the work of a plaintiff, capturing the ideas used or facts referred to, but in his own language in such a way as not to constitute an infringement but rather to create his own new original work. Whether he has done so will involve a question of fact and degree. There is no principle of law, so far as I am aware, that the mere fact that it is shown that a defendant commences with the work of the plaintiff and then by his own skill and labours constructs a totally different work requires the conclusion that the new work is a reproduction of the original.

The extent of similarity which is required to exist before an infringement is found will vary depending upon the nature of the work alleged to have been reproduced and the degree of originality in it. It must, however, be said in general terms that it is ‘the quality of what is taken rather than the quantity’ which will be important: Autodesk Inc v Dyason (No 2) (1993) 176 CLR 300. For example, where the work said to be copied is a musical work the fact that the infringing work captures the essence of the melody will suffice, even though in another key or but a few bars On the other end of the spectrum a more exact reproduction of words used may be necessary to constitute infringement of a poem where the essence of the poem lies in the use of language to express ideas. The case of an alleged infringement of a compilation where the originality of the material copied might lie in the arrangement of the material, rather than in the words used, presents yet another class of case; cf Football League v Littlewoods Pools; Ladbroke v William Hill; Blackie & Sons Ltd v Lothian Book Publishing Co Pty Ltd (1921) 29 CLR 396; John Fairfax v Australian Consolidated Press.”

399 This passage from Hill J’s judgment is consistent with the authorities. Mr Nettle was correct to rely on it to show that substantial reproduction and causal connection are separate and cumulative requirements for a finding of infringement. But I do not read the passage as suggesting that copyright in a factual compilation can protect only the arrangement of material, as distinct from the labour and expense in collecting in one place the information recorded in the compilation. Hill J was not addressing that question. Rather, his Honour was concerned only to point out that the extent of similarity required for a finding of infringement, depends on the nature of the copyright work and its degree of originality. One illustration his Honour gave was a compilation work where the originality of the material copied lay in the arrangement of the material, rather than in some other attribute. *Blackie & Sons v Lothian*, for example, one of the cases cited by Hill J, involved an infringement of copyright in an annotated edition of Shakespeare’s *Henry the Fifth*. A case where the copyright work is a factual compilation, which reflects substantial labour and expense on the part of the compiler in gathering the facts, might be quite different.

The Berne Convention

400 Desktop argued that Australian law relating to originality should be construed in conformity with Australia's obligations under the *Berne Convention*. Although the contention was not developed at length, it appears to rest on art 2(5) of the *Berne Convention*, which provides as follows:

“Collections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations, shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections.”

401 Article 2(5) was introduced in its present form at the Brussels Conference of 1948 (and renumbered by the Paris Conference of 1971). It is true that art 2(5) refers to “intellectual creations”. But, as Telstra pointed out, the *Berne Convention* prescribes only minimum standards in relation to copyright protection. As Professor Ricketson has observed (*The Berne Convention for the Protection of Literary and Artistic Works: 1886-1986* (1987), at 303):

*“Article 2(5), by definition, does not cover collections of subject matter that are not capable of attracting copyright protection, that is, because they are not literary or artistic works in their own right. Instances are the names and addresses in a telephone directory ... such collections of non-copyright material may involve selection and arrangement in the same degree as are required for collections of literary or artistic works, but there is no requirement to protect them under Article 2(5). **This, then, is a matter for national legislation.**”* ... (Emphasis added.)

402 As I have noted, the requirement of originality was first introduced by statute into English law in 1911. At that time, the *Berne Convention* merely provided, in what was then art 2(2), that State parties were bound to protect “collections of different works”. The 1909 *Gorell Report*, examined the extent to which English law was not in accord with the *Convention*. The *Gorell Report* did not, however, address the question of copyright in compilations. The legislation specifically dealt with the question of compilations only because of an amendment proposed by Lord Gorell himself (see above at [359]).

403 It may be that the grant of copyright protection to compilations which are original in the sense accepted by the English and Australian authorities goes further than required by international law. But that does not place Australia in breach of its international obligations.

Nor does the fact that Australian law goes further than the requirements of the *Berne Convention* justify modifying the law.

A SYNTHESIS

404 This survey of the authorities shows that English and Australian courts have long grappled with the special difficulties created by claims of copyright in compilations. Well before legislation accorded compilations express recognition as “literary works”, English and Scottish cases accepted that compilations of factual information, such as directories and catalogues, could be the subject matter of copyright. The underlying rationale, stated in early cases such as *Kelly v Morris* and *Morris v Ashbee* but repeated in many later cases, was that the compiler should be rewarded for the labour and expense involved in collecting and presenting the information. The first copyright statute, 8 Anne c 19 (1709), had included among its objects the encouragement of learning and the prevention of ruin to authors and proprietors of books by unauthorised reprinting and publishing (see the preamble, set out in Ricketson, *The Law of Intellectual Property* (2001), at par 3.125). The nineteenth century authorities extended the rationale beyond the authors of “literary” works in the traditional sense to the less creative, but not necessarily less useful endeavours of compilers of factual information.

405 Some of the earlier judgments, reflecting the prevailing enthusiasm to protect the labour and expense of compilers, gave an expansive interpretation to the scope of copyright in compilations. Hence the famous but excessive admonition to the defendant in *Kelly v Morris*, that he was not entitled to take a single line of the plaintiff’s directory for the purpose of saving himself labour and trouble in getting his information. Later cases recognised the difficulty of reconciling an admonition in these terms with the principle that the “law of copyright does not...give any person an exclusive right to state or describe particular facts” (*Victoria Park v Taylor*, at 498, per Latham CJ).

406 The need to reconcile apparently conflicting imperatives led to two important qualifications or refinements of the approach taken in the early cases. The first was to impose a threshold requirement to be satisfied before the compiler’s labour and expense could support copyright in a particular compilation. Cases such as *Leslie v Young*, *Cramp v Smythson* and *Victoria Park v Taylor* are illustrations of a compiler’s failure to satisfy the threshold requirement. Secondly, later authorities emphasised the significance of the

statutory requirement that, in order to establish infringement, the copyright owner must show that a substantial part of the work has been taken (*Copyright Act*, s 14(1)). This requirement has become more onerous for the copyright owner in Australia by reason of the High Court's rejection, in *Data Access v Powerflex*, of the so-called "but for" test of substantiality and the substitution of a test requiring reference to the originality of that part of the copyright work taken by the alleged infringer.

407 Despite these qualifications, the course of authority in the United Kingdom and Australia recognises that originality in a factual compilation may lie in the labour and expense involved in collecting the information recorded in the work, as distinct from the "creative" exercise of skill or judgment, or the application of intellectual effort. The formulations, for example, of Dixon J in *Victoria Park v Taylor* and of the members of the House of Lords in *Ladbroke v William Hill* support this proposition. So too do the authorities which have approved the reasoning in *Blacklock v Pearson*. That case is very difficult to interpret except as a decision upholding copyright in a compilation which involved much work and effort in collecting information, but which required no particular judgment or skill. Moreover, much-cited cases such as *Football League v Littlewoods* and *Ladbroke v William Hill* have rejected the view that, in assessing the originality of a compilation, only skill, judgment or labour associated with the presentation of the compilation (as distinct from skill, judgment or labour at an earlier stage) can be taken into account.

408 It is true, as Dr Emmerson accepted, that the circumstances of the present case are not governed by an authoritative Australian decision. But it is also true that this is an area where the law of copyright of the United Kingdom and Australian law have developed in tandem, a point recognised by the *Spicer Report* in 1959 and reinforced by more recent authorities. There are now, of course, differences between the legislative arrangements in force in the two jurisdictions. There is as yet no equivalent in Australia, for example, of the *Copyright and Rights in Databases Regulations 1997* (UK) ("*UK Database Regulations*"), which implements the European Union's *Directive on the Legal Protection of Databases 1996* ("*the 1996 Directive*"): see [424] below. But there is nothing in the *Copyright Act* that suggests that, except for specific provisions such as the *UK Database Regulations*, the Australian law governing copyright in factual compilations differs materially from United Kingdom law.

409 In summary, the authorities support these propositions:

- (i) A compilation will ordinarily be an **original** literary work for copyright purposes if the compiler has exercised skill, judgment or knowledge in selecting the material for inclusion in the compilation (as with a collection of commentaries) or in presenting or arranging the material (as with the births and deaths column in *John Fairfax v ACP*.)
- (ii) In addition, a compilation of factual information will ordinarily be an **original** literary work for copyright purposes if the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation.
- (iii) In order for copyright to subsist in a factual compilation, on the basis of the labour or expense required to collect the information, the compiler must show that the labour or expense exceeds a minimum threshold (*Cramp v Smythson*; *Victoria Park v Taylor*). Various formulations have been advanced to describe the threshold requirement (see *Kalamazoo v Compact Business Systems* (1985) 84 FLR 101, at 120ff, per Thomas J), but it is not necessary to pursue the issue further in this case. In this sense, the question of whether a factual compilation is original is a matter of fact and degree (cf *Ladbroke v William Hill*).
- (iv) In assessing whether a factual compilation is an original work, the labour or expense required to collect the information can be taken into account regardless of whether the labour or expense was directly related to the preparation or presentation of the compilation in material form, provided it was for the purpose of producing the compilations (*Football League v Littlewoods*; *Ladbroke v William Hill*).
- (v) Copyright in a factual compilation will be infringed only where the alleged infringer takes a substantial part of the copyright work. Substantiality is to be determined by reference to the originality of that part of the work taken by the alleged infringer (*Data Access v Powerflex*). Where originality in a factual compilation is found, in whole or in part, in the compiler's labour or expense required to collect the information, infringement depends on the extent to which the collected information has been appropriated by the alleged infringer. To this extent, too, the issue of infringement may involve matters of fact and degree.
- (vi) These principles apply to "whole of universe" compilations.

FEIST PUBLICATIONS INC v RURAL TELEPHONE SERVICE CO INC

The Reasoning in *Feist*

410 The submissions devoted considerable attention to the decision of the Supreme Court in the United States in *Feist Publications Inc v Rural Telephone Service Co Inc*. In *Feist*, the respondent, Rural, was a certified public utility that provided telephone services to several communities in north-west Kansas. Pursuant to a requirement of State law, imposed as a condition of its monopoly franchise, Rural published annually an updated telephone directory, consisting of white and yellow pages in conventional form. Rural obtained the data for the directory from subscribers, who had to provide their names and addresses to obtain telephone services. Rural distributed its directory free of charge to subscribers but derived revenue from selling yellow pages advertisements.

411 The petitioner, Feist, was a publishing company specialising in area-wide telephone directories, covering much larger areas than particular directories. The Feist directory in issue in the litigation covered eleven different telephone service areas and contained nearly 47,000 white pages listings, compared with Rural's 7,700 listings. The Feist directory, like the Rural directory, was distributed free of charge, but Feist and Rural competed vigorously for yellow pages advertising.

412 Feist lacked independent access to subscriber information. It sought permission from the eleven telephone companies operating in north-west Kansas to use their white pages listings. All agreed except Rural. Feist nonetheless used Rural's white pages listings, taking 1,309 names, towns and telephone numbers without Rural's consent in order to complete its area-wide directory.

413 Rural successfully sued for copyright infringement in the District Court. The Court of Appeals for the Tenth Circuit affirmed. The Supreme Court, in an opinion delivered by O'Connor J, unanimously reversed the Court of Appeals, holding that the selection, coordination and arrangement of Rural's white pages did not satisfy the minimum standards of originality for copyright protection in the United States.

414 O'Connor J observed (at 344) that the case concerned the interaction between two well-established propositions. The first was that facts are not copyrightable; the second was

that factual compilations are copyrightable. The key to resolving the “undeniable tension” between the two propositions lay in understanding why facts are not copyrightable. O’Connor J said (at 345) that to qualify for copyright protection a work must be original to the author:

“Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.... To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”

415 The opinion emphasised that, in the United States, originality was a constitutional requirement. The source of Congress’ power was Art I, § 8, cl 8 of the *Constitution* which authorises Congress to “secur[e] for limited times to Authors...the exclusive Right to their respective writings”. In *The Trade-Mark Cases* 100 US 82 (1879), for example, the Court had explained that for a particular work to be classified as the writings of an author it had to be “original” and “originality” required independent creation plus a modicum of creativity. It was this “bedrock principle of copyright” that mandated the law’s seemingly disparate treatment of facts and factual compilations (at 347):

“[F]acts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact: he or she has merely discovered its existence.”

416 O’Connor J recognised that factual compilations can possess the requisite originality. Choices concerning the selection and arrangement of data, so long as they are made independently by the compiler and “entail a minimum degree of creativity” are sufficiently original that Congress can protect such compilations through copyright (at 348). But where the compiler author adds no written expression but lets the facts speak for themselves, the “only conceivable expression is the manner in which the compiler has selected and arranged the facts” (at 341). Furthermore, the mere fact that a work is the subject of copyright does not mean that every element of it is protected (at 348):

“Originality remains the sine qua non of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author....Thus, if the compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the

publication, but not the precise words used to present them.”

417 The opinion acknowledged (at 349) that copyright in a factual compilation inevitably is “thin”. In answer to the apparent unfairness that much of the fruit of the compiler’s labour may be used by others without compensation, O’Connor J observed that the primary objective of copyright is not to reward the labour of authors but to “promote the Progress of Science and useful Arts” (the language of Art I, § 8, cl 8). She noted (at 348) that

“[t]o this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”

The idea/expression or fact/expression dichotomy applied to all works of authorship. As applied to a factual compilation, in the absence of original written expression (at 350-351):

“only the compiler’s selection and arrangement may be protected; the raw facts may be copied at will.”

418 O’Connor J criticised the so-called “sweat of the brow” doctrine that had been embraced by a number of courts in the United States. The doctrine’s most “glaring” flaw was that it extended copyright in a compilation beyond selection and arrangement to the facts themselves (at 353). The “sweat of the brow” courts had

“eschewed the most fundamental axiom of copyright law – that no one may copyright facts or ideas.”

419 Applying these principles to the facts, O’Connor J concluded (at 362) that Feist, by taking the 1,309 names, towns and telephone numbers had not copied anything “original” to Rural. The raw data were uncopyrightable facts. Rural’s selection and arrangement of the raw data were so mechanical or routine as to require no creativity whatsoever. Rural had merely taken the data provided by subscribers and listed their names in alphabetical order.

Is *Feist* in Point?

420 Desktop argued that the reasoning of the Supreme Court in *Feist*, although not binding on Australian courts, applied directly to the circumstances of the present case and, accordingly, should be followed. This submission, in my view, underestimates the extent to which the opinion in *Feist* reflects considerations peculiar to the United States. The

conception of originality endorsed by the Supreme Court owes much both to its construction of the “Writings and Discoveries” power in Art I, § 8, cl 8 and to the terms of the *Copyright Act 1976 (US)*.

421 Mr Nettle acknowledged, as he had to, that constitutional issues played a part in the reasoning of the Supreme Court. But, so he argued, the Writings and Discoveries power, to the extent that it incorporates a minimum constitutional requirement for copyright protection of a “modicum of creativity” has an effect no different than s 51(xviii) of the *Constitution*. This argument encounters the difficulty that in *Grain Pools of Western Australia v Commonwealth* (2000) 202 CLR 479, at 498, the joint judgment pointed out that there were important textual differences between the two constitutional provisions. Their Honours noted, especially, the absence of the “purposive element” to be found in the introductory words of Art I, § 8, cl 8 (“To promote the progress of Science and useful Arts”) and said that s 51(xviii), unlike its counterpart, is not to be “constricted” by this purposive element. Perhaps more importantly, their Honours were at pains to give s 51(xviii) of the *Constitution* a broad construction, specifically rejecting an argument that the boundaries of the power are to be ascertained by identifying the content of “copyright” in 1900. Nor does the reference in the joint judgment in *Nintendo Co Ltd v Centronics Systems Pty Ltd* (1994) 181 CLR 134, at 160, to “products of intellectual effort” being the subject matter of s 51(xviii) suggest that the scope of the power conferred by s 51(xviii) is confined in the same manner as Art I, § 8, cl 8. The comment in *Nintendo* was made in support of a broad construction of the constitutional power, sufficient to uphold the validity of the new rights conferred by the *Circuit Layouts Act 1989 (Cth)*.

422 Moreover, the Supreme Court’s opinion in *Feist* rests to a considerable extent on the language of the *Copyright Act 1976*. O’Connor J pointed out that Congress had deleted the specific mention of “directories” in the previous legislation (the *Copyright Act 1909*) and provided a definition of “compilation”. The current definition (s 101 of the *Copyright Act 1976*) is as follows:

*“a work formed by the collection and assembling of pre-existing 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.**”*
(Emphasis added.)

Not surprisingly, the Supreme Court construed (at 358) this language as instructing courts

that

“in determining whether a fact-based work is an original work of authorship, they should focus on the manner in which the collected facts have been selected, co-ordinated and arranged.”

See, too, the discussion of s 103(b) of the *Copyright Act 1976: Feist*, at 359. It is clear that the Supreme Court’s definition of originality in relation to factual compilations was informed by its construction of the *Copyright Act 1976*.

Policy Issues

423 In view of these matters, the significance of *Feist* for present purposes is whether the reasoning, shorn of issues peculiar to the United States, convincingly establishes a “unitary concept of creative originality for copyright law”: J C Ginsburg, “No ‘Sweat’? Copyright and Other Protection of Works of Information After *Feist v Rural Telephone* (1992) 92 *Colum L Rev* 338, at 341. The opinion shows that the concept of “originality” in copyright law is capable of being understood as incorporating a “creative spark” requirement. But this is not the only view that can be taken. The English and Australian authorities, to which reference has already been made, demonstrate that the concept of originality can equally be understood as embracing a compilation that is the product of substantial labour or expense, provided that it goes beyond the mere copying of other works. On this approach, originality does not always involve the “creative spark” identified as essential in *Feist*. This view of originality also accommodates the special characteristics of factual compilations which, by statute, can be the subject matter of copyright.

424 Doubtless there would be good reasons to follow *Feist* in Australia if, from a policy perspective, its approach offers clear advantages over one which protects industrious compilations. The policy question essentially revolves around the means of resolving the tension between providing incentives to produce potentially useful works and encouraging free access to information or “raw facts”. In an article cited by the Supreme Court in *Feist*, Professor Denicola argues in favour of recognising that a

“particular collection of facts appearing in a work is itself a work of authorship” (Denicola, [338] above, at 542; emphasis in original).

Professor Denicola criticises as too limited the “traditional approach” (later affirmed in *Feist*) which insists on some creativity in the selection or arrangement of data. He argues (at 530) that the

“effort of authorship can be effectively encouraged and rewarded only by linking the existence and extent of protection to the total labor of production. To focus on the superficial form of the final product to the exclusion of the effort expended in collecting the data presented in the work is to ignore the central contribution of the compiler.”

This analysis, of course, reflects the policy considerations informing the nineteenth century authorities on copyright in factual compilations. The danger in refusing copyright protection to an industrious compilation is that a potential compiler will be deprived of the incentive to undertake work that may prove to be of great value. It is doubtless for this reason that the United Kingdom, in accordance with the *1996 Directive* issued by the European Union, has established a separate regime for databases, including a *sui generis* property right called a “database right”, which applies regardless of whether the database is a copyright work: see *UK Databases Regulations*, reg 13; *Copinger and Skone James on Copyright* (1999), pars 3-88, 3-96, 180-03ff. (United Kingdom law now provides that a database receives protection under the copyright regime only if “by reason of the selection or arrangement of the contents of the database the database constitutes the author’s own intellectual creation”: *UK Databases Regulations*, reg 5; *Copyright, Designs and Patents Act 1988* (UK), s 3A.)

425 Professor Denicola addresses the argument, subsequently given much emphasis by the Supreme Court, that copyright protection for industrious compilations would effectively confer monopoly rights in relation to facts. He argues (at 531) that unfettered access to individual facts would be protected by the requirement of substantial similarity:

“Since it is the collection as a whole that represents the original work of authorship, only copying sufficient to produce a substantially similar collection would generate potential liability.”

He also argues that the fair use doctrine provides a mechanism to moderate the effect of recognised property interests in collections of data (at 532). In short, he rejects the suggestion that copyright protection for industrious compilations amounts to granting copyright over facts as such. A competitor is free to gather facts from whatever source he or she wishes, so long as the product (in Australian terms) does not reproduce in a material form a substantial part of the compiler’s work. It is the collection in respect of which copyright subsists, not the facts collected by the compiler.

426 Another commentator has suggested that *Feist* encourages compilers of facts to add elements to a compilation of facts, not for the benefit of consumers but to satisfy the minimum creativity requirements of copyright law (J C Ginsburg, above, at 347). In such

cases, the compiler's primary interest is in securing copyright protection for the effort or expense in compiling the material, rather than for the particular form or presentation of the compilation. On the *Feist* approach, it is necessary to distinguish between the original (marginally creative) elements of the compilation and the non-creative labour or expense that has gone into the gathering of data. But the distinction may not be easy to draw (cf *Kregos v Associated Press* 937 F 2d 700 (2d Cir 1991); *Bellsouth Advertising Publishing Corporation v Donnelly Information Publishing, Inc* 999 F 2d 1436 (11th Cir 1993); *CCC Information Services v Maclean Hunter Market Report, Inc* 44 F 3d 61 (2d Cir 1994)).

427 I do not suggest that the policy issues raised by *Feist* and indeed by the present case are easy to resolve. The point is that policy considerations by no means compel the conclusion that the approach in *Feist* should be followed in Australia. The general propositions I have derived from the authorities can be supported by cogent policy arguments.

428 This is not to say that affording copyright protection to the compiler of a factual compilation, who happens to enjoy monopoly privileges that facilitate the making of the compilation, is necessarily a satisfactory state of affairs. This was an issue raised, but not pursued in depth, in the course of argument. It is striking that Telstra in the present case, like Rural in *Feist*, was able, for at least part of the relevant period, to compile the information incorporated into its White Pages by virtue of monopoly powers granted to it by law. (Telstra's position changed from 1 July 1997, when the *Telecommunications Act* came into force and the extent of its monopoly thereafter was not made entirely clear). There may be powerful reasons, in such circumstances, for requiring the owner of copyright in the compilation to submit to a compulsory licensing regime. Such schemes are established by statute in other areas: see, for example, *Copyright Act*, s 108, providing that copyright in a recording is not infringed by a public performance if equitable remuneration is paid. A compulsory licensing regime might appropriately reward the monopolist's labour and expense, yet leave room for innovative competitors who cannot gain access to the basic information required to establish databases of potential commercial value.

429 A court is ill-equipped to undertake the inquiries and make the policy assessments necessary to resolve these issues. The questions are for Parliament to consider. In the meantime, Australian law recognises copyright in so-called industrious compilations, even in

the case of whole of universe compilations prepared by monopolists.

430 As I have noted (see [326] above), Mr Nettle made reference in argument to the decision of the Court of Appeal of Canada in *Tele-Direct (Publications) Inc v American Business Information, Inc*. There the Court of Appeal followed the approach to originality adopted by the Supreme Court of the United States in *Feist*. Although the Court of Appeal referred to the well-known English authorities, the decision was heavily influenced by the terms of the North American Free Trade Agreement (“NAFTA”) and a definition of “compilation” inserted into the *Copyright Act 1985* (Can) by the *North American Free Trade Agreement Implementation Act 1993* (Can): see at 29-30. For present purposes, it carries the matter no further than *Feist* itself.

COPYRIGHT SUBSISTS IN TELSTRA’S DIRECTORIES AND HEADINGS BOOKS

431 The primary Judge pointed out that it is necessary, for the purpose of determining whether a work is protected by copyright to look at the work as a whole. As Lord Reid said in *Ladbroke v William Hill* (at 277), the correct approach

“is first to determine whether the plaintiffs’ work as a whole is ‘original’ and protected by copyright, and then to inquire whether the part taken by the defendant is substantial.”

Given that a compilation may constitute an original literary work if the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation, there is no difficulty in concluding that the primary Judge was correct to hold that Telstra had copyright in the White Pages and Yellow pages directories.

432 The White Pages directories largely comprise the listing data compiled by Telstra. This material satisfies the statutory requirement of originality. As I have explained, it was common ground that Telstra had undertaken substantial labour and incurred substantial expense in compiling and presenting the listing data. Other features of the White Pages directories such as the information pages are, as the primary Judge found, clearly the subject of copyright.

433 Much the same analysis applies to the Yellow Pages directories. They, too, largely comprise the listing data compiled by Telstra. The remaining material, including information pages, advertising artwork and the like, is also mainly if not entirely the subject of copyright.

434 The question of whether copyright subsisted in the headings books received little attention in argument. It might have been thought that the issue was of minor importance compared with the questions of copyright in the listing data. Be that as it may, so far as copyright is concerned, the heading books are in a somewhat different position than the listing data.

435 The primary Judge appeared to approach the question by applying the decision in *Lamb v Evans*. In that case it was held that a publisher of a trade directory had copyright in the headings that were used to classify the various advertisements. The subsistence or otherwise of copyright in the headings books in the present case cannot be determined simply by reference to authority. Ultimately the resolution of the questions must depend on the facts of the case. The primary Judge in fact made a number of findings relevant to the question. In particular, he found that Telstra had established a committee responsible for updating and revising the headings books annually; and that the committee or its contractor had surveyed households and businesses, undertaken research and considered requests made by users in order to select and amend headings. A reading of the judgment as a whole suggests that his Honour intended to find that the headings books, although not the product of intellectual effort, were produced in consequence of an investment by Telstra of substantial labour and expense. I think it was open to him to do so.

436 It follows that no error has been shown in the primary Judge's conclusion that Telstra had copyright in the White Pages directories, the Yellow Pages directories and the headings books.

INFRINGEMENT

437 Desktop in substance relied on two arguments on the question of infringement. The first was that the primary Judge had failed to keep in mind the principle that in determining whether a substantial part of copyright work has been taken it is necessary to consider the originality of the part allegedly taken: *Data Access v Powerflex*, at 32-33. The second was that the primary judge had failed to pay proper regard to the requirement that the notion of reproduction for the purposes of copyright law requires not only a causal connection between the copyright work and the allegedly infringing work, but a sufficient degree of objective similarity between the two works: *S W Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 159 CLR 466, at 472, per Gibbs CJ.

438 The answer to the first argument has already been given. The listing information incorporated in Telstra's directories satisfies the requirement of originality because of the labour and expense involved in the compilation. The originality of the compilation for copyright purposes does not lie in the prosaic method of presentation of the data, that is the listing in alphabetical order of the names and details of each subscriber.

439 Desktop accepts that information electronically stored on its CD-ROMs includes virtually all the listing data compiled by Telstra and published in its directories. The primary Judge found that around 95 per cent of the headings used by Desktop at the relevant times were identical to those used by Telstra and which had been derived from its headings books. Desktop clearly enough took the great bulk of headings compiled in the headings books (via the Yellow pages directories). Once it is accepted that the originality in Telstra's compilations lies in the labour and expense involved in compiling the information, the primary Judge was right to conclude that Desktop had taken a substantial part of each of Telstra's copyright works. It is not to the point that Desktop may not have adopted Telstra's mode of presentation of the data.

440 So far as the second argument is concerned, I agree in substance with what has been said by Lindgren J. The approach outlined by his Honour is consistent with the authorities to which I have referred: see especially [117], [118]. See also *Copinger and Skone James on Copyright* (14th ed 1999), par 7-57; *Independent Television Productions Ltd v Time Out Ltd* [1964] FSR 64, at 72-74, per Whitford J; *British Columbia Jockey Club v Standen* (1985) 22 DLR (4th) 467 (BC CA).

441 Even if it were necessary to demonstrate some degree of visual similarity between Telstra's directories and headings books, on the one hand, and Desktop's CD-ROM products, on the other, I think that Telstra has discharged the burden, at least in relation to the residential CD-ROMs and *Marketing Pro*.

442 In relation to a literary work, including a compilation, "material form" includes "any form (whether visible or not) of storage from which the work...or a substantial part of the work...can be reproduced". The definition is principally intended to overcome the difficulty under the earlier law that a database stored in electronic form may not have had the required objective similarity to a copyright work in a written form even though the database had been

compiled from the copyright work: cf *Computer Edge Pty Ltd v Apple Computer Inc* (1986) 161 CLR 171, at 186, per Gibbs CJ; *Pacific Gaming Pty Ltd v Aristocrat Leisure Industries Pty Ltd* [2002] AIPC 92-759, at 37,090-37,091 [105]-[108], *per curiam*.

443 It is true that the definition is only of the expression “material form”. The definition does not apply to the word “reproduce” in s 31(1)(a)(i) of the *Copyright Act*. But in overcoming the difficulty in copyright law associated with the taking of (say) printed works and reproducing them in (say) electronic form, Parliament must have intended that, if a visual comparison is to be made, it must be made between forms of presentation that are capable of comparison. In the case of alleged infringement of a printed work by the production of a CD-rom, for example, it is necessary (assuming objective similarity must be established) to find a common medium for the purposes of the comparison. Depending on the circumstances, the comparison might be between the printed work and hard copy material derived from the data on the CD-rom. Alternatively, the comparison might be between the printed work and material derived from a CD-rom which is displayed on a screen.

444 In the present case, the information stored on Desktop’s residential CD-roms was capable of being reproduced as a print-out of fifty-five alphabetical listings of subscribers, each corresponding to the alphabetical listing in a Telstra White Pages directory. The only significant difference between the contents of the alphabetical list in each case would be the absence, in the case of the print-out of the Desktop CD-roms, of the business entries included in each White Pages directory. Approximately ninety percent of the entries (according to the estimates made in argument) would in substance be the same, although each listing would not have the same layout (for example, the Desktop listings would not be in columns).

445 Similarly, at least in the case of Desktop’s most sophisticated business CD-rom, *Marketing Pro*, it appears that the data can be reproduced in alphabetical order, grouped by reference to descriptors, so as to correspond closely to the information printed in each Yellow Pages directory. There will be some differences in content. While 95 percent of the descriptors used in the CD-roms are identical to the headings in the Yellow pages directories, some five per cent are not. And of course the Desktop material will not include the advertisements or artwork in the Yellow Pages directories. Nonetheless, the data in the CD-roms can be manipulated to produce material capable of being read which corresponds in content and presentation quite closely to Telstra’s Yellow Pages directories.

446 For the reasons given by Lindgren J, I do not think it matters if there is no visual similarity between reproduction of the data stored on the Desktop CD-roms and Telstra's Yellow pages and White Pages directories. But if some visual similarity is required in cases involving the taking of factual compilation, I think that the form in which the information stored on Desktop's CD-roms can be reproduced satisfies any such requirement.

CONCLUSION

447 The appeal should be dismissed. There is no need to address Telstra's notice of contention. Desktop should pay Telstra's costs.