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Update Summary

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**THE LAW OF INTELLECTUAL PROPERTY:
COPYRIGHT, DESIGNS AND CONFIDENTIAL
INFORMATION
Ricketson & Creswell**

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December Update Summary

Sam Ricketson has written new commentary on:

Recent Developments

Inquiry into enforcement of copyright and further copyright consultations

The author provides a comprehensive update on the continuing roundtable consultations by the Attorney-General's department on priorities for copyright reform. The "Inaugural ministerial roundtable on copyright" in February 2023 identified five reform issues: a limited liability scheme for orphan works, quotation from copyright material, use of copyright material in remote learning environments, the implications of AI for copyright law, and the definition of 'broadcast' for the purposes of the *Copyright Act 1968* (Cth). A second roundtable followed in June which focussed on the first three items identified. The third roundtable, held in August 2023, dealt with the remaining topics of AI and broadcasting definitions. See [RD.2000].

Private member's bill to remove cap on licence fees for broadcasting of published sound recordings under Copyright Act 1968 (Cth), s 152(8)–(11)

The private member's bill *Copyright Legislation Amendment (Fair Pay for Radio Play) Bill 2023* (Cth) proposes to remove the 1% cap of the radio broadcaster's gross annual earnings which arises under s 152(8) of the *Copyright Act 1968* where there are applications before the Copyright Tribunal, and, likewise, the 0.5 cents per head of the Australian population maximum that applies in the case of the ABC under s 152(11). See [RD.2400].

Developments in Artificial Intelligence

In August 2023, the US District Court for the District of Columbia gave summary judgment in favour of the Copyright Office's dismissal of an application to register an artwork made by Dr Thaler's "Creativity Machine" on the ground of lack of human authorship: *Thaler v Perlmutter* No. CV 22-1564 (BAH), 2023 WL 5333236 (D.D.C. Aug. 18, 2023). See [RD.2300].

Copyright infringement, defences and damages – *Sheeran v Chokri* (Ch) [2022] EWHC 827; [2022] F.S.R. 15 (6 April 2022)

An issue raised against musician Ed Sheeran in *Sheeran v Chokri* (Ch) [2022] EWHC 827; [2022] F.S.R. 15 was his alleged practice of "borrowing" from other composers by way of tribute or acknowledgement, that he was something of a "magpie" in the way he allegedly collected bits and pieces of music from different sources. This was held to have no relevance to the proceeding. It also appeared that when this occurred, Mr Sheeran attributed his source and/or gained permission for the use. Ed Sheeran has been the subject of infringement claims in other jurisdictions, notably

in the US. In May 2023, he subsequently won a jury trial action in Manhattan where the allegation was that another of his hit songs “Thinking Out Loud” (2014) had infringed Marvin Gaye’s classic 1973 song “Let’s Get It On”. See [RD.1030].

Designs

The author provided updates on IP Australia’s continuing consultations on extension of protection for virtual designs, partial designs and incremental designs in the following chapters: Chapter 19 “Origins and rationale of designs protection” from [19.0], Chapter 20 “Meaning of design” from [20.0] and Chapter 21 “Requirements for registration” from [21.0]. See, in particular, [20.71], [20.15]–[20.25].

Collective Administration and Legislative Controls Over the Exercise of Copyright Owners’ Rights

The role of copyright owners’ organisations – collecting societies

The author provides updated information on current operations of principal collecting societies. See [15.0]–[15.50].

Civil Remedies for Infringements of Copyright

Mandatory injunctions against carriage service providers – The mandatory nature of the order

Roadshow Films Pty Ltd v Telstra Corporation Ltd [2023] FCA 1167 deals with applications for injunctive relief against online infringing websites. This decision deals particularly with the issues arising when applicants seek to extend or vary initial blocking orders, and his Honour’s judgment contains a careful examination of the matters to be taken into account in granting such applications. See [13.635] and [RD.1060].

October Update Summary

Sam Ricketson has written new commentary on:

Recent Developments

Wright v BTC Core [2023] EWCA Civ 868 (20 July 2023): Fixation of works

In the recent decision *Wright v BTC Core* [2023] EWCA Civ 868; [2023] 7 WLUK 282; [2023] F.S.R. 21 of the English and Welsh Court of Appeal, there has been the first extended judicial discussion for some time of the requirement of fixation in UK and EC copyright law, as well as under the international treaties such as the Berne Convention and the WCT. The court emphasizes the need to distinguish between fixation in the context of subsistence and fixation that occurs by way of an infringing reproduction of the work. See [RD.1050].

Recent UK cases on literary and dramatic copyright infringements

“Big” cases involving infringements of literary and dramatic works such as novels, television scripts and characters are not common in Australia (perhaps, because of the time and costs involved), but two recent UK cases of this kind, involving extensive evidence and argument should be noted here as useful (and interesting) exemplars of this kind of litigation: *Pasternak v Prescott* [2022] EWHC 2695 (Ch); [2022] 10 WLUK 305; [2023] F.S.R. 9; (25 October 2022) (involving claims of infringement in relation to a work of non-fiction and a translated work) and *Shazam Productions Ltd v Only Fools The Dining Experience Ltd* [2022] EWHC 1379 (IPEC); [2022] 6 WLUK 41; [2022] F.S.R. 25 (8 June 2022) (claims of infringement and passing off in relation to characters and defences of parody and pastiche). See [RD.1055].

Civil Remedies for Infringements of Copyright

The author has reviewed the chapter on “Civil Remedies for infringements of Copyright” from [13.010], in particular:

Mandatory injunctions against carriage service providers – Parties to the application, notice and evidence

There is an obligation under s 115A(4) of the *Copyright Act 1968* (Cth) for the copyright owner to “notify” the carriage service provider, online search engine provider (if relevant) and the person operating the online location, but the obligation of notification for the third of these persons may be dispensed with by the court “on such terms as it sees fit” if satisfied that the owner of the copyright is “unable, despite reasonable efforts, to determine the identity or address of the person who operates the online location, or to send notices to that person”. For an instance of such dispensation by the court, see *Roadshow Films Pty Ltd v Telstra Corporation Ltd* [2022] FCA 1413. See [13.640]ff.

Circumstances justifying an award of additional damages – flagrancy of infringement

In *Universal Music Publishing Pty Ltd v Palmer (No 2)* (2021) 158 IPR 421; [2021] FCA 434, the billionaire Clive Palmer showed a “contumelious” disregard for the applicant’s rights, gave false evidence, failed to comply properly with discovery obligations and gained a political benefit from his unauthorized use of the applicant’s music in his political campaign. Katzman J made here an award of \$1 million additional damages pursuant to s 115(4) of the *Copyright Act 1968* (Cth). See [13.940] and [13.710].

Circumstances justifying an award of additional damages – defendant’s conduct after notice

In *Sankey v Bollig* [2023] FedCFamC2G 227, Lucev J awarded \$7,000 awarded with respect to “injured feelings” under s 115(2) and \$6,000 by way of additional damages. See [13.942].

Mandatory injunctions against carriage service providers – Requirements for the grant of orders under s 115A(1)

See [13.630] for a discussion of cyberlockers by Nicholas J in *Roadshow Films Pty Ltd v Telstra Corporation Ltd* [2022] FCA 1413.

Damages for conversion or detention of infringing copies – Relationship between conversion damages and damages for infringement

In *Aristocrat Technologies Australia Pty Ltd v Konami Australia Pty Ltd (No 3)* (2022) 170 IPR 42; [2022] FCA 1373, Nicholas J recognised that the remedies of damages and account may be pursued in the one proceeding with respect to different infringements. See [13.1140] and [13.710].

Actions in relation to circumvention of technological protection measures and electronic rights management information – Action against circumvention of an access control TPM – s 116AN

That something is not a “technological protection measure” (TPM) within the meaning of s 116 AN will be an arguable defence in any proceeding under this section: see, for example, *Take-Two Interactive Software, Inc v Anderson* [2021] FCA 1024. See [13.2920].

