Editorial • Profile – In Conversation with The Honourable Justice French AC • Articles • The Unbearable Lightness of Being an Intellectual Property Lawyer • Women at the IP Bar: A Case for Unpacking the “Merit” Ideal • Can a Work of Art Be Destroyed under Copyright Law? • From the Editor’s Bar Table – A Panorama of Forensic Cross-Examination of IP Luminaries and their Hobby Horses (1997-2015) • Current Developments • Australia • New Zealand • Asia • WIPO • Europe • South Africa • United States • Reports from IPSANZ Local Organisations
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Editorial – The Interweaving Web of Privacy and Technology in the Digital Age: Perceived Serious Invasions of Privacy in Australia

A Working Definition of Privacy

On one level, privacy is a rather vaguely-defined concept; yet on another, it is a seemingly well-understood concept at large. A review of the relevant literature on privacy law reflects that privacy is a complex concept – difficult to define with certain precision at a theoretical level under any uniform umbrella theory, even if various threads interconnect the diverse meanings.

Privacy in any given circumstance may be in tension with other values, needs or aspirations of the individual, subgroups, and society at large. As with most other values in modern democratic societies, privacy is not an absolute. It must be interpreted and considered in tandem with other socially important values and goals. How this balancing is to be achieved frequently becomes the centre of the controversy around privacy, as different people and groups balance in different ways these values that are in tension.

Privacy is part of a social context that is subject to a range of factors. While a relationship between privacy and society has always existed, the factors affecting privacy in the information age are varied and deeply interwoven. These factors, individually and collectively, are changing and expanding in a scale of unprecedented rapidity in terms of our ability to understand and contend with their implications to our world, in general, and our personal privacy, in particular. Some of these factors include the volume, magnitude, complexity, and persistence of information; the expanding number of ways to collect information; the number of people affected by information; and the geographic spread and reach of information technology.

In very recent times, the Australian Law Reform Commission (ALRC) has defined privacy – albeit in general terms – as “a value which is important for individuals to live a dignified, fulfilling and autonomous life … [It] is an important element of the fundamental freedoms of individuals which underpin their ability to form and maintain meaningful and satisfying relationships with others; their freedom of movement and association; their ability to engage in the democratic process; their freedom to advance their own intellectual, cultural, artistic, financial and physical interests, without undue interference by others.”

The Information Age

The rapid evolution and make-up of the “information age” reveals three overarching factors that have driven the vast changes affecting current ideas, perceptions, and expectations of privacy: technological change; societal shifts; and discontinuities in circumstances.

Technological change denotes the significant differences in the technological culture of today as compared to the technological environment that prevailed in the past. Societal shifts refer to evolutionary trends in society at large. Discontinuities in circumstances relate to those events and concerns that have transformed the national debate in a very short time, and did not allow for gradual adjustment to a new set of circumstances.

Technological advancements, combined with changes in other areas, have converged to make the privacy challenge particularly vexing. Technological change is, of course, not a novel phenomenon or movement. The printing press has been described as a precursor to the World Wide Web; email and phone text messaging have revolutionised interpersonal and collective communications. In addition, affordability and advances in sensor technologies have expanded the volume and scope of information that can now be practically and easily obtained.

What makes information special, if not unique, is its reproducibility. Information, in digital form, can be reproduced unlimited times without losing fidelity. In the modern digital era, the quantity of information; the ability to collect, assemble, and analyse it; the ability to store it inexpensively; and the magnitude and rapidity of all aspects of how we approach, use, characterise, and manipulate information are continuously evolving.

One important effect of new technologies has undoubtedly been the erosion of privacy protection once provided through obscurity or the passage of time. For much of the past, the effects of data collection were not a major issue, perhaps because the relevant data were inaccessible for practical purposes or individual pieces of data were stored...
in different locations so that patterns contained within the potentially aggregated data were difficult to find. Further, often the sheer volume of input would overwhelm the method of analysis or the patterns would be lost in a sea of data. It is not quite the case that data were inaccessible, but that they were contained in a form that was in practice expensive and difficult to access.

Debate in Australia on Information Privacy in the Digital Era with the Rapid Expansion of Technological Capacity

In 2013, debate about privacy in Australia resurfaced, this time focusing on information privacy in the digital era in the context of “the rapidly expanded technological capacity of organisations to track the physical location and activities of individuals, to collect and use information from social media, to aggregate data from many sources, and to intercept and interpret the details of communications.” This put the spotlight again on revisiting the possible enactment of a statutory cause of action for invasion of privacy.

To date, Australia has never developed an overarching, all-embracing cause of action for invasion of privacy. In September 2011, however, the Department of the Prime Minister and Cabinet published an Issues Paper about a Commonwealth Statutory Cause of Action for Serious Invasion of Privacy, which was intended to inform its response to the Australian Law Reform Commission’s recommendations to introduce a statutory cause of action for serious invasions of privacy. It recognised that community concern about the right to and protection of privacy [was] growing as new technologies change the way we interact with business, government, and each other.

In June 2013, the Commonwealth Attorney-General referred to the ALRC the issue of prevention of and remedies for serious invasions of privacy in the digital era. The first matter the ALRC was asked to address was “innovative ways in which law may reduce serious invasions of privacy in the digital era.” In October 2013, the ALRC produced an Issues Paper which framed the inquiry it was asked to explore as arising in the following circumstances:

5] The ubiquitous commercial and personal use of digital and affordable mobile technology, across all social and economic strata of society, has been world changing. New technologies allow unprecedented levels of surveillance and tracking of the activities of individuals, of recording and communication of personal information, and of intrusion into physical space. Both aspects of personal privacy that law reform commissions have previously investigated—unauthorised use of personal information and intrusion on personal privacy or seclusion—are significantly affected by the digital era and the capacities that digital technology provides.

The ALRC Final Report – Serious Invasions of Privacy in the Digital Era

On 3 September 2014, the ALRC tabled and made publicly available its final report dealing with Serious Invasions of Privacy in the Digital Era (No 123, 2014) (Final Report). The Final Report followed on from an inquiry that had been commissioned by the former Labor government which advocated for the introduction of a privacy tort to be created by statute.

In the context of this ALRC Inquiry into serious invasions of privacy in the digital era, the ALRC noted that: a cause of action for serious invasion of privacy does not presently exist in Australian law; a person’s privacy may be invaded in a range of ways; and that such invasions may occur with increasing ease and frequency in the digital era. The Inquiry then considered at large how Australian law may be reformed to prevent and remedy serious invasions of privacy, particularly in the context of other concerns about privacy, such as those raised by “big data” and surveillance by governments and others.

The ALRC’s Final Report provides a detailed legal design of a statutory tort to be created by a new Commonwealth Act. It makes 16 key recommendations which the ALRC states in a media release would “strengthen people’s privacy in the digital environment.” These cover a raft of issues relating to privacy law: a new tort in a new Commonwealth Act; two types of invasion; reasonable expectation of privacy; fault; seriousness and proof of damage; balancing privacy with other interests; forums, limitations and other matters; defences and exemptions; remedies and costs; breach of confidence actions for misuse of private information; surveillance devices; harassment; and new regulatory mechanisms.

Notably, the recommendations in the Final Report also recognise and emphasise that, while privacy is a fundamental right that is worthy of legal protection, that right must be balanced with other rights, such as the right to freedom of expression.
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and the freedom of the media to investigate and report on matters of public importance.

The ALRC recommended that any legislation dealing with the issue or privacy in the digital era should be at the federal level and involve a stand-alone act rather than amendments to the Privacy Act 1988 (Cth), noting that that Act primarily concerns information privacy, while the new cause of action would be designed to remedy a number of different types of invasions of privacy, including physical invasions of privacy. The ALRC added that the Privacy Act has a number of exemptions which would not apply to the new action.

The ALRC further recommended that such an act should cover two forms of invasion of privacy:

(a) Intrusion upon seclusion, such as by physically intruding into the plaintiff’s private space or by watching, listening to or recording the plaintiff’s private activities or private affairs; or

(b) Misuse of private information, such as by collecting or disclosing private information about the plaintiff.6

Safe Harbour Scheme for Internet Intermediaries

One of the key differences between the Discussion Paper7 and the Final Report8 is in respect of the original proposal to introduce a safe harbour scheme. The scheme, as outlined in the Discussion Paper, would have protected internet intermediaries – such as carriage service providers and search engines – from liability for serious invasions of privacy committed by third-party users of their services.

However, the ALRC rejected the introduction of a safe harbour scheme in the Final Report, noting that the proposed tort would only target positive conduct and not be aimed at omissions. On the basis that the internet intermediary would frequently be unaware that their service had been used to invade an individual’s privacy, a failure to act by the internet intermediary would not constitute an invasion of privacy under the proposed tort as it lacks the requisite intention or recklessness. However, the internet intermediary may be found to have the requisite fault/recklessness where it can be proven that they had knowledge of the invasion of privacy and were reasonably able to stop it but chose not to do so.

The ALRC recommended that internet intermediaries9 should not be liable under the tort for invasions of privacy committed by third parties using their services, where they have no knowledge of the invasion of privacy. The ALRC added that, where they do have such knowledge, there does not seem to be any justification to provide a complete exemption from liability. The ALRC therefore saw no need to recommend the enactment of a “safe harbour” scheme, to protect internet intermediaries from liability under the tort.

The ALRC identified two reasons why internet intermediaries are unlikely to be liable under this tort. First, the tort is targeted at positive conduct on the part of the defendant. It is difficult to characterise a failure to act as an “invasion” of privacy. It is not intended to impose liability for mere omissions – that is, failing to act to stop an invasion of privacy by a third party. Secondly, the tort is confined to intentional or reckless invasions of privacy. In the view of the ALRC, a mere internet intermediary will rarely have this level of intent, when third parties use their service to invade someone’s privacy. For example, it was noted that operators of a social networking platform do not intend to invade someone’s privacy, when one of its customers posts private information about another person on the platform.

The ALRC added that, in some circumstances, an internet intermediary may be found to have the requisite fault after they have been given notice of an invasion of privacy. They may be found to have intended an invasion of privacy, or been reckless, if they know that their service has been used to invade someone’s privacy, and they are reasonably able to stop the invasion of privacy, but they choose not to do so.

On the basis of those two reasons, the ALRC did not consider it necessary to recommend that safe harbour schemes for internet intermediaries be extended to protect intermediaries from liability under the new tort.

Finally, the ALRC stated that, if a safe harbour scheme were to be enacted, internet intermediaries should be required to comply with certain conditions to rely on the defence. Examples of such conditions might include requiring internet intermediaries to: remove, or take reasonable steps to remove, material that invades a person’s privacy, when given notice; provide consumer privacy education or awareness functions, such as warnings about the risk of posting private information; and comply with relevant industry codes and obligations under the Privacy Act 1988 (Cth).
The Way Forward or Not Forward?

While the ALRC recommended that new laws that would afford a legal remedy for serious invasions of privacy with the proposal for a statutory cause of action to protect privacy, the federal government has already indicated that it opposes the introduction of such legislation. Despite repeated calls by various stakeholders and growing community concern over loss of privacy in recent years, successive Australian governments have shown little desire for improving Australia’s privacy regime.

Australia now almost stands alone in not recognising a right to privacy. In most other common law jurisdictions, the courts have developed specific protections against invasions of privacy. In New Zealand, the United Kingdom and, most recently, Canada, judicial developments have been particularly prompted by human rights legislation. Those countries’ bill of rights guarantee fundamental freedoms, including the right to freedom of expression and a right to respect for private life. The absence of a federal human rights framework in Australia has arguably impeded the development of a common law right to privacy. It is this very legal gap that the ALRC has now recommended needs to be filled in the digital era.

This Issue

The general tenor and theme of this issue departs somewhat from the usual technical IP articles, insofar that it shares various insights of life in the judicial and practising world of intellectual property law.

The first article by The Honourable Justice French, Chief Justice of the High Court of Australia is based on a lunchtime presentation by his Honour to the Western Australia Branch of IPSANZ in September this year and takes as its title “The Unbearable Lightness of being an Intellectual Property Lawyer”, from the 1984 novel by Milan Kundera. The Unbearable Lightness of Being. As his Honour recalls, the term “lightness of being” was used as a metaphor to contrast with that of heaviness or the burdens of life. The theme of that novel was the impossibility of holding on to moments in life with particular significance, where its characters try to capture in memory those perfect moments but the lightness of life is such that they slip away and happiness dissolves. In the course of the article, his Honour skilfully justifies the application of this metaphor to the work of intellectual property lawyers, by demonstrating its application by reference to the intangible character of intellectual property rights, their dependency upon the statutes which gave rise to them, and the changeable purposes and policies informing those statutes, their negative character, the common law process of development of the concept of patentability, and the nature of the imaginary person skilled in the relevant art.

In the next article, The Honourable Justice Susan Kenny of the Federal Court of Australia provides a most valuable updated overview of women in IP law. While noting that a significant number of women have now forged successful legal careers, including at the Australian Bars, with a significant number having been appointed Queen’s Counsel or Senior Counsel and to the judiciary, her Honour equally notes the disappointing fact that the most recent studies of women in the profession, including at the Bar, indicate that, for the most part, women still face gender-based barriers to their progress in the profession. The author draws on relevant available literature, as well face-to face meetings in her Chambers in March 2015 with 12 junior and senior counsel separately specialising in intellectual property at the Victorian Bar to discuss the nature and extent of any gender-based challenges to their practice at the Bar. The article discusses the effects of such challenges, if any, on their careers, and explores why this is the case, focusing on the particular challenges encountered by female barristers specialising in intellectual property law today.

The next article is by Tania Cheng-Davies, the winner of this year’s IPSANZ Essay Prize (now renamed The John McLaren Emmerson QC Essay Prize, in honour of the late Dr John Emmerson QC). Here, the author proposes that artistic works are fundamentally different in nature to textual works, and that it is fallacious to treat them in precisely the same way under copyright law where destruction is concerned. The author also raises a crucial relevant point in that ultimately there is a difference between the purpose of the law and that of philosophy, as she emphasises that, although the premise of this article is to urge a more exhaustive, less superficial approach on the part of copyright lawyers to the question of artistic works and its existence, and to be receptive to established theories in metaphysics, it must always be borne in mind that the law bears upon real life problems and issues, and has a real influence and effect on art, artists and other players in the art world. Finally, the article highlights that it is not
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only instructive but also imperative that copyright lawyers look beyond the law for inspiration and other viewpoints which are relevant to the difficult issues that they face – in this case, whether a work of art can be destroyed will affect the issue as to whether or not artists should have the right to object to the destruction of their work.

The last article is based on a series of presentations that I delivered to the Western Australia, Victoria and New South Wales Branches of IPSANZ in the period May-August this year. Titled “From the Editor’s Bar Table – A Panorama of Forensic Cross-Examination of IP Luminaries and their Hobby Horses (1997-2015)”, I revisit snippets and reflect on some of the many leading figures from the judiciary, private practice, academia, the arts and the sciences whom I have had the privilege of profiling in the last 18 years. Each of my chosen subjects has something of particular value and insight to say about the evolution of intellectual property principles, procedure and practice (past, present and the projected future) in Australia and abroad.

This issue’s Profile celebrates the illustrious legal career of The Honourable Justice Robert French, Chief Justice of the High Court of Australia, who generously took a couple of hours out of his busy work schedule when I met with him in his Canberra Chambers in June this year. In our conversation, I focused on a range of his Honour’s legal views and experiences, both prior to and since his elevation in 2008 to the Bench of the High Court of Australia, traversing a range of issues including: his work as President of the National Native Title Tribunal and the possibility of a referendum to amend the Constitution to recognise Indigenous Australians; his term as a part-time member of the Australian Law Reform Commission; the collegiate process of the High Court and the task of writing judgments; his perceptions as to where the main future challenges lie in the field of intellectual property law; and predictions for life after the Bench upon him reaching the compulsory retirement age.

I am delighted to welcome to the Editorial Board of the journal Ms Rosemary Wallis, the newly elected President of IPSANZ, Mr Andrew Goatcher, Partner, Cornwall Stoddart and Immediate Past President of IPSANZ, and Associate Professor Michael Handler, Faculty of Law, University of New South Wales. Each will no doubt bring the wealth of their IP experience and expertise to the Board.

In other news, on 19 November 2015, United Nations Secretary-General Ban Ki-moon announced the establishment of a high-level panel on health technology innovation and access.

The Panel will comprise 16 eminent, well-respected individuals, with a deep knowledge and understanding of the broad range of trade, public health, human rights and legal issues associated with access to treatment, including former High Court of Australia justice and this journal’s Editorial Board member, The Honourable Michael Kirby AC, CMG. The Panel’s co-chairs are Ruth Dreifuss, former President of Switzerland, and Festus Mogae, former President of Botswana.

In a press release dated 19 November 2015 from the Office of the Spokesperson for the UN Secretary-General, the underlying objectives of the Panel were expressed as follows:

In order to ensure healthy lives and promote the well-being of people of all ages, as set out in Sustainable Development Goal 3, new modalities are urgently needed to ensure that everyone can access quality treatment at affordable costs while also incentivizing innovation and the development of new technologies such as vaccines, medicines and diagnostics.

Currently, most research and development in vaccines, medicines and diagnostic tests are undertaken on the basis of financial potential rather than focused on the needs of the poorest and most marginalised communities. The recent Ebola crisis, which led to more than 11,000 deaths in West Africa, highlighted the need for urgent investment in research and development for diseases where financial returns are not guaranteed. The Panel will also consider infectious diseases such as HIV and Hepatitis C, the rising burden of non-communicable diseases, and the affordability of health technologies, new and old.11

The Panel is expected to hold its first meeting in New York in December 2015 and to engage in extensive consultations with stakeholders. It will present a set of recommendations to the Secretary-General in June 2016.

Finally, as always, I thank the regular correspondents to the Current Developments section of the journal. I am indebted to their continuing commitment, providing reports that keep us all
abreast of the latest developments in the world of intellectual property law. I would like to thank Professor Owen Dean of Stellenbosch University who has served as Correspondent for South Africa over the past few years for his thought-provoking reports. Professor Dean has decided to become a "gentleman of leisure". I am delighted to welcome aboard Professor Sadulla Karjiker as the new Correspondent for South Africa, who holds the Chair of IP at Stellenbosch University. At the local level, I would also like to thank Simon Reynolds of Davies Collison Cave who has served as the New South Wales Correspondent for the past four years. That role will now be shared by Karl Ditko (a patent attorney in the Sydney office of DCC) and Aparna Watal (a trade mark attorney in the Sydney office of DCC). I particularly welcome the new correspondents to the journal.

I wish all readers of the journal a joyous, peaceful and safe Christmas, and a prosperous New Year.

2 Ibid., at [22], p.14.
3 Ibid., at [5], p.10.
5 Ibid., pp.7-14.
6 Ibid., Recommendation 5-1, p.9.
8 Final Report, see pp.207-211.
9 The broad term "internet intermediary" is commonly used to cover: carriage service providers, such as Telstra or Optus; content hosts, such as Google or Yahoo; and search service and application service providers, such as Facebook, Flickr and YouTube: Peter Leonard, "Safe Harbors in Choppy Waters – Building a Sensible Approach to Liability of Internet Intermediaries in Australia" (2010) 3 Journal of International Media and Entertainment Law, 221, 226. There is also a comprehensive definition of "carriage service provider" in the Telecommunications Act 1997 (Cth), s.87. For the purposes of that Act, the provision defines a "listed carriage service provider" as someone who provides carriage service to the public using a network owned by one or more carriers. This definition excludes online search engines and online vendors as they provide a platform for their customers, but not for the "public". This definition restricts the scope of the safe harbour scheme.
10 The ALRC reaffirmed a recommendation from its 2008 landmark report on privacy. The New South Wales Law Reform Commission in 2009 and the Victorian Law Reform Commission in 2010 also made similar calls for enhanced protections.
As I waited, upon my early arrival at the downstairs café of the High Court of Australia to sip a coffee, a pretty young waitress came up to me and asked what I was doing there. I replied, rather nonchalantly, “Just killing time to wait to see the Chief Justice.” Her eyes lit up, as she beamed: “Oh, he is so lovely. He comes down here sometimes, and he does love his ham and pickle sandwich!”

As I was to discover, shortly thereafter, the waitress’s assessment of the Chief Justice was right on the mark. In almost 20 years, I have interviewed some 40 eminent persons for this journal. To date, the only one of them, being no less than the current Chief Justice of the High Court of Australia, upon warmly welcoming me into his Chambers at the Court with a firm handshake, sat me down on the couch and insisted that, first, I tell him a bit about me! I admit that I was caught off-guard with the reversal of roles, however it does disclose much of the character of this most distinguished judge.

His Honour was first interviewed back in 2002 for the journal, when as a Justice of the Federal Court of Australia, by Jeremy Curthoys (now a Justice of the Supreme Court of Western Australia).¹

In this conversation, I did not revisit and traverse much of the Chief Justice’s early background. Rather, I was intent on focusing on a range of his thoughts and experiences since his Honour’s elevation in 2008 to the Bench of the High Court of Australia.

Q: You graduated from the University of Western Australia in science (1967), then changed your vocational path to the law. I understand, however, that you, or one of your lecturers, may have had misgivings about your future great prowess as a physicist. Did you find a nexus, or even difficulty, of moving from one field to the other?

A: The transition from the study of physics to the law in 1968, having finished the science degree, was informed by the view that I would never be a great physicist, unlike the late Dr John Emmerson QC, who was a serious scientist before he turned to the law. It wasn't so much that I had a “passion” for the law (as they like to say these days), but rather that the law seemed to offer the widest possible range of options. I had an idea then that I might become a lawyer, but I thought there were other possibilities as well.

In fact, even after I had finished my law degree, I applied for a position with the Department of Foreign Affairs, but deferred that possible choice for another two years so that I could complete my articles, and then decide what I wanted to do.

I found myself doing articles in a small but very good law firm, and charged with many responsibilities. My interest in legal practice and in finding legal solutions to clients’ problems, was engaged and cemented.
As far as my scientific education was concerned, I found that, from an early stage when I was doing petty criminal cases in the Magistrates court, there was a real intersection between the law and science. One of my areas of specialisation was in breathalyser cases, and there was quite a lot of contested science in that field. Another was in drug cases. One case which raised an issue of botanical taxonomy, went to the High Court. I found my scientific background was useful in two ways. First, in thinking about legal problems. Secondly, in understanding the scientific culture and method which had to be understood in cases involving an intersection between a scientific issue and a legal issue. Some of the content of my scientific education may have gone, but the methodology lingers on.

Q: You have a well-known interest in intellectual property. Do you think that your early education in science has assisted you in that field along the way?

A: In fact, I had thought of qualifying as a patent attorney, but that would have required another year of apprenticeship after articles, a prospect which did not particularly appeal to me.

Q: That raises the question as to whether you are in favour of combined law degrees, whether it be with the arts, commerce, or as with you, with a science qualification?

A: Absolutely. When you think about the history of science, and its place in our culture, to be scientifically illiterate is a disadvantage for any practitioner.

In 1964, as a student, I attended at the Nuclear Research Foundation Summer School at the University of Sydney, which was conducted by the late great Professor Harry Messel. It was a two-week program and I was one of two students from Western Australia who attended. I can still remember Messel promoting the new science curriculum of the day, holding up a big blue book and shouting at us: “Show me a young man in 10 years’ time who does not have a scientific education and I’ll show you a young man who has to be locked up for his own protection!”

Q: What is it about the law that you love, that has driven you?

A: I don’t know whether “love” is quite the “right” word! Nor is “passion”. Everyone seems to have to have a passion for something! What I have enjoyed immensely about legal practice, from my time as an articled clerk, is its diversity and its real world applications to people with legal problems with whom you are engaged. I had a very broad practice over the years, in crime, commercial law, trade practices, public law and intellectual property. The intersection of science with the law arose in cases where there was a technical issue which required expert testimony. It was necessary to work at a crossover between factual situations about which experts testified and the legal principle being invoked or applied. The diversity of those engagements appealed to my dilettantish temperament!

The experience of preparing for a hearing, particularly one focusing on complex technical issues is one which many lawyers would recognise, as akin to filling up a bath. At the end you pull out the plug leaving just a faint grey residue around the rim!

Q: You were admitted to practice in 1972 and practised as a barrister and solicitor in Western Australia until 1983 when you were called to the Western Australian Bar. Then, in 1986, you were appointed to the Bench of the Federal Court of Australia. How did you find the transition from life at the Bar to the more “circumspect” culture of judicial life?

A: I had been in practice for 14 years when I was appointed to the Federal Court. I did not find judicial appointment particularly constraining. There are, of course, basic rules to be followed in the conversations that you have, or in public utterances. Although I have given many speeches over the years on legal topics of interest to me, I have always been mindful of the need to avoid stating personal opinions on matters that might come before me as
a judge. Working in the Federal Court was a very collegial experience. It was a very collegiate Court. Even though for a time at the beginning I was the only Western Australian Federal Court Judge – following the appointment of Justice John Toohey to the High Court – I enjoyed then, as I did subsequently, sitting with colleagues from all over Australia on interstate Full Court appeals and sharing with them, in committees, the rule making and administration of the Court under the late Sir Nigel Bowen and the Hon Michael Black AC as successive Chief Justices during my time on the Court.

Q: But, interestingly, you also managed to extend your judicial interests in that period. From 1994 to 1998, you were President of the National Native Title Tribunal. On a personal level, what attracted you to accept that position? What did that experience, which must have been fascinating, inform you about Indigenous culture and land rights?

A: It was of course a non-judicial role. I was approached in 1994 to lead the Tribunal, which had been set up under the *Native Title Act* 1993 (Cth). I had had an involvement many years before in setting up the Aboriginal Legal Service in Western Australia. No doubt that was a factor in my appointment.

The Tribunal had an array of functions under the Act, including processing the registration of claims, marshalling the parties, and acting as a mediator in an extended and complex multi-party dispute resolution process. The Tribunal also had a role as an arbitrator. That role involved arbitral decisions about whether governments could grant to third parties interests that might affect native title. The largest area of arbitral activity related to the grant of mining tenements, some of which affected major projects. Another concerned the creation of land subdivisions in native title areas.

My initial response was to decline the offer. However, on reflecting about it I thought that I was going to be a judge for a long time, and the job offered an historic opportunity of becoming involved in the development of procedures for managing and resolving Indigenous customary native title claims.

From day one in May 1994, the job was a little like taking a dragon by the tail! The whole process was politically contentious. There were many industry and political concerns. Some people were worried that their backyards would be taken away from them.

The pastoral industry was concerned about the impact of native title on their ability to run pastoral leases if they had to co-exist with native title rights and the effect of co-existing native title rights on the value of those leases as securities for their bank loans. Initially, they had the view that their pastoral leases extinguished native title based on what had been said in Justice Brennan’s judgment in the *Mabo* decision. That assumption was dispelled in the *Wik* decision in 1996, which led to significant amendments to the Act in 1998. The mining industry was concerned, not least because of the perceived uncertainty of agreements with Indigenous groups and the risk that an agreement might later be challenged on the basis that it had not been made with the legitimate traditional owners.

Initially, a lot of the work of the Tribunal was focused on public education, explaining the process to Indigenous groups and to the various non-Indigenous interest groups and reassuring them that the sky was not going to fall in! It was not a judicial function but rather an administrative one. I was, of course, subject to judicial review by my colleagues of the Federal Court. Having said all that, it was an immense privilege to be engaged in that process as President of the National Native Title Tribunal. I met and learned a lot about Indigenous communities right around Australia. I also met and engaged with people in government and local government and industry to try to come to grips with the new paradigm which involved Aboriginal people, for the first time in our history, in a position to assert common law rights at the negotiating table.
Q: Of course, this is a foreshadowed topic of interest with the discussion of a possible referendum to amend the Constitution to recognise Indigenous Australians.

A: All that I can say on that issue is that in the past I have remarked publicly, in general terms, that I believe that the race power under the Constitution should be abolished and substituted with a power to make laws with respect to Aboriginal and Torres Strait Islander peoples. Whatever constitutional changes may be presented for consideration by the Australian people, the recognition of Australia’s Indigenous peoples is not a matter of privileging a particular racial group. It should be seen as an important part of the recognition of the special place of Indigenous peoples in our Australian history and identity.

Q: When on the Federal Court Bench, you were also a part-time member of the Australian Law Reform Commission (ALRC). Share with me a little of your experiences in that position, and your view on the importance of judges to maintain an “interest” in monitoring or, indeed, progressing the process of law reform.

A: I was very impressed by the way the ALRC went about its work, particularly its structured, consultative process and the extent of the research which made the discussion papers on issues referred to the Commission very constructive, as do many of the final reports. I am sad to see the ALRC’s resources reduced in recent times. The judicial input in their work was very useful. It is important, of course, that judges who participate in law reform activities do remain selective and do not become involved in particular issues which are likely to be politically contentious. Having said that, I think that the judiciary has a role to play in law reform, both through involvement in Law Reform Commissions and in monitoring changes to the law which may affect the work of the judiciary itself and in drawing attention to the impact of legal change on the judicial process.

Q: Then, the pinnacle of your appointment as the 12th Chief Justice of the High Court of Australia in September 2008. At the time of your appointment, a newspaper article reported, and I quote:

The Federal Government has chosen Justice Robert French, a highly regarded lawyer with small “I” liberal political views, to head Australia’s most powerful legal institution for the next nine years.

Legal experts say it is hard to pigeonhole Justice French. He was one of the Federal Court judges who struck down the NSW law against protesters “annoying” World Youth Day pilgrims. Yet he was also one of the judges who upheld the Howard government’s move in 2001 to block refugees on the Tampa entering Australia.

How important do you think public perception is when one holds judicial office? Does it really matter to be labelled, or does it affect you, one way or the other? At the end of the day, though, does it just come down to one’s own principles? What are the major factors that have most influenced and formed your principles?

A: Well, there are some people who are ready to label a judge, usually by reference to their decisions, which they either approve of or do not! (laughs). This is not easy to escape, but I have never been concerned about that. If there is a single proposition that has informed my approach to judicial office over the years it is the belief that we serve the rule of law. I like to think of the rule of law as part of our “societal infrastructure”, supporting the social space within which people can exercise their freedoms and their rights. Judges have the privilege of participating in the maintenance and development of that framework. You don’t have to be a “philosopher-king” to do that! (laughs) If you adhere to that approach, I think you can shy away from remaking society in your own image, especially in relation to the impact of the law on social justice issues.

Q: Even though the High Court is, of course, an appellate court, have there been moments when you have agonised over cases? Has the
“fraternity” amongst the other six judges on the High Court assisted you in clarifying your own ideas and position in reaching judgment along the way?

A: We have a collegiate process. We discuss cases at the beginning of each sitting week. At the end of each case we will meet to discuss it. Every judge participates as an independent but collegial member of the Court. Every judge is entitled to write his or her own judgment. Our conferences provide an opportunity for us to explore with each other the ways in which the case can be approached. In some cases after hearing another colleague's view, another judge may even reconsider his or her own approach. (laughs). It is an essentially collegiate process.

In recent High Court history, there has been a tendency to write more joint judgments, some of which may be unanimous and some of which may involve a plurality of the judges. There is no protocol, rule or pressure requiring that to be done. If there appears to be a general consensus, one judge may undertake to do a first draft. The other justices participating may concur and join in that draft, or write their own concurring separate judgments or write in dissent.

Q: Do you think the law in the recent years has become too specialised, even almost compartmentalised? Does this, as an often quoted “generalist” judge, concern you for future legal practitioners?

A: Yes, this may reflect the complexity of statute law in particular areas. Added to that is the demand for efficient delivery of legal services. There is, however, a disadvantage if a specialist lawyer is not able to identify the way in which the area of specialty intersects with other areas of the law which might be relevant to the matter on which he or she is advising. I would venture to say that there are in fact very few areas of the law where a lawyer can claim that the matter relates only to a particular area of specialisation.

The field of intellectual property is a good case in point. Intellectual property law involves statutory interpretation and the application of a considerable body of case law. It may also involve consideration of relevant international Conventions. It may involve dealing with intellectual property whose owners are affected by contractual or equitable rights and obligations or other statutory provisions. It may involve both Federal and State jurisdictional questions. It may intersect with constitutional and public law. It may also intersect with competition law.

Q: Along your long judicial career, have you enjoyed the process of writing judgments? Would you say you have developed a judicial style or approach to hearing cases or writing judgments, and has this evolved over the years?

A: No, but I really like finishing them! (laughs). I have been writing judgments for many years. The challenge is the shaping of them. It is the writing of the judgment that imposes the discipline where even if you commence with a clear view, the writing may cause you to modify or change it altogether.

Q: Intellectual property lawyers are noted for remaining fond of (even obsessed by) some of the IP cases that they have run, whether won or lost. Would you care to share some of your own that come to mind?

A: When I was in practice in Perth, I was involved in a number of IP cases. I found each of them interesting in their own way. The one I remember most fondly was about wine labels, a passing off /misleading or deceptive case. It was about a very low-end market wine selling for $2.99 a bottle in Western Australia (which my instructing solicitor cautioned me not to sample. He said it tasted like alcoholic ribena)! (laughs). We appeared before Justice Toohey for an interlocutory injunction. The defendant’s counsel produced a number of wine labels attached to their affidavit material. The Bench ended up looking like a wine shop! We failed on the injunction and decided that that should be the end of the litigation. Some years later when I was white water rafting in far north Queensland, it turned out that our rafting guide had a cask of this stuff, and produced it in a plastic glass at an overnight camp in the rainforest.
Q: You didn’t drink it, did you?
A: Alas, I admit that I did! (laughs). In that setting it was drinkable.

Q: Generally speaking, where do you think lie the main challenges of intellectual property law in the future?
A: First, the adaptation of intellectual property concepts to new technologies. Secondly, the globalisation of intellectual property. Thirdly, the clarification of the purpose of IP legislation.

One of the issues that I addressed in 4th Francis Gurry Lecture on Intellectual Property in 2012 at the University of Melbourne was the need for a degree of “moral clarity”. This is demonstrated, for example, by the difficulty of formulating persuasive anti-piracy messages. There is a tension between the proprietary purposes of the protection of IP rights and the instrumental purposes reflected in the public benefits to be derived from the creation of those rights.

In rather poetic, but relevant, form here his Honour introduced his lecture at the 4th Francis Gurry Lecture on Intellectual Property in 2012 at the University of Melbourne, as follows:

To consider public law and intellectual property together is like undertaking a wrestling match with Proteus. The object of such an exercise in Greek mythology was to hold fast the shape-shifting old man of the sea until he yielded a true prophecy. Menelaus succeeded in that task. I am no Menelaus.

His Honour then continued with the crux of his lecture on this issue:

[The] public purposes of intellectual property laws and the merits of those purposes are contested and contestable. That phenomenon is not only of interest to academia and the legal profession. It is a matter with which policy makers, rights holders and the wider public should be concerned for at least two reasons:

1. As a general proposition, it is difficult to secure respect for and enforce rights deriving from laws which lack moral clarity. A law has moral clarity when its public beneficial purpose is capable of explanation in relatively straightforward terms to those whom it binds. It is a fact of contemporary society that the complexity of some of our laws obscures their public purposes.

2. Related to the first, is the complexity of the issues thrown by debates about the extent of the protections which are or should be conferred by intellectual property rights and the absence of underlying consensus about their purpose. Professors Bohannan and Hovenkamp have recently argued that in the United States intellectual property laws have been the subject of special interest capture and thereby have become more disconnected from their purpose of promotion of innovation. They contend:

   The classic public choice paradigm clearly favours IP rights holders: they are fewer in number, have individually greater stakes, and typically have interests that are much more homogenous. On the other side, the users of IP rights tend to be numerous and heterogeneous. As a result, rights holders are much better organised than IP users and communicate their wishes to Congress much more effectively.

Whether or not the second concern is directly reflected in the Australian experience may be a matter for debate involving political scientists, lawyers and economists. It is difficult to exclude this second concern particularly in relation to the content of obligations assumed by States, including Australia, under international conventions, treaties and free trade agreements which are then translated into domestic law.

Intellectual property is a product of public law reflecting competing interests and norms whose resolution
must necessarily occur at the political, rather than at the judicial level. But the discernment of the balance that has been struck is not a straight forward matter. Where contested interpretations depend upon a view of where that balance is struck, the constructional choice may involve difficult judgments. This raises the general question of the relationship between statutory interpretation and public policy.

Q: At the risk of perhaps sounding impertinent (though I was also with The Honourable Susan Crennan when I interviewed her for the journal on the eve of her retirement last year and asked her the same question), upon reaching the compulsory retirement age (which you will in a couple of years), do you do so with a tinge of sadness or of optimism or a mix of both? Do you agree with statutory judicial retirement?

A: I think that the notion of fixed retirement is a good one, even if judges leave the bench “fully functional” (laughs). From an institutional point of view, I believe that the High Court does benefit from a combination of fresh perspectives and corporate memory!

Q: Do you have any pre-plans at this stage of life after a very long life in judicial office? I envisage writing, teaching, and deepening my scientific education, the latter, on a strictly informal level, where I left off many years ago!

It may well be fitting to conclude here this conversation, with his Honour's own pithy words, of his view of the future connection between intellectual property law, public policy and public law. It abounds with a certain insight and passion about those separate but interrelated fields:

"For its practitioners and for those who study and write about it, the field of intellectual property is engaging and absorbing. It involves a unique intersection of law, public policy and public law with the products of human creativity and ingenuity. Some may think we are better off without it. Perhaps one day we will be. For my part, I am not anxious to see its arrival."
It is a good working assumption that no idea, including the title of lunchtime talks, is new. That is not to indicate a bias against novelty but is based on long personal experience. Predictably, an internet search of the term “the unbearable lightness of being an intellectual property lawyer” validated that assumption. It yielded, among other things, an article by Alastair Hudson, a well-known barrister and academic in the United Kingdom who has written extensively on equity and finance law, including an article with the intriguing title “Remedies for being thought of as small when in fact you are tall”. The relevant article, for such purposes however, was “The Unbearable Lightness of Property”. It appeared in a collection of essays on New Perspectives on Property Law Obligations and Restitution.

Hudson's title referred to a discussion of changes in the nature of modern property offered by a social theorist, Zygmunt Bauman. Bauman argues that in today's world a cosmopolitan elite rides on lightness because their property is intangible and not tied to any particular space or workforce. Hudson's argument, based on that idea, was that our traditional property law is focused on segregation, tangibility and permanence and therefore has a problem because so much property, including intellectual property, is intangible. He explores illogicals at the heart of the law when it comes to dealing with the ephemeral and disposable nature of property in the contemporary capitalist world.

Lightness of being, which can be applied metaphorically to intangible property, has a particular application to intellectual property rights. Their general nature was discussed by the High Court in 2012 in the Tobacco Plain Packaging case. The legislation under challenge imposed restrictions on the use of trade marks on packaging and on tobacco products. The Court held by majority that the Act did not effect an acquisition of the trade mark rights for the purposes of s.51(xxxi) of the Constitution which, as interpreted by the High Court, requires that Commonwealth laws providing for the acquisition of property must provide for that acquisition on just terms.

It was not in dispute in that case that registered trade marks, designs, patents and copyright constitute or give rise to exclusive rights which are property within the meaning of s.51(xxxi). They are rights, however, which are created by statute in order to serve public purposes although they differ in their histories, their character and the statutory schemes which make provision for them. Gummow J, in that case, rejected the proposition that registration under the Trade Marks Act or the Designs Act, a grant under the Patents Act, or the subsistence of copyright, confers an unconstrained right to exploit those items of intellectual property or an immunity from the operation of regulatory laws. Some of the public purposes served by intellectual property laws may be in tension with each other. From time to time, the balance struck between those competing purposes may be shifted by changes to the law reflecting changes in public policy.

The purposive character of intellectual property rights was asserted by Dr Francis Gurry in his acceptance speech upon his appointment as Director General of the World Intellectual Property...
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Organisation in 2008, when he said:

> Intellectual property is not an end in itself. It is an instrumentality for achieving certain public policies, most notably, through patents, designs and copyright, the stimulation and diffusion of innovation and creativity on which we have become so dependent, and, through trade marks, geographical indications and unfair competition law, the establishment of order in the market and the countering of those enemies of markets and consumers: uncertainty, confusion and fraud.5

It seems unlikely therefore, that the creation of tradable intellectual property rights is the ultimate purpose of all intellectual property laws. If it were, then proprietorism would be the dominant, normative influence on intellectual property law and policy today. If, however, intellectual property rights can be seen as a means to publicly beneficial ends, their underlying purpose may be described as instrumental. Professor Peter Drahos, who wrote about these issues in 1996, said of the latter approach that:

> The practical import of the theory would be that the interpretation of intellectual property law would be driven in a systematic fashion by the purpose of that law rather than more diffuse moral notions about the need to protect pre-legal expectations based on the exercise of labour and the creation of value.6

Importantly, there is no judicial doctrine in Australia which provides generally for the protection of the products of intellectual effort. The High Court in *Campomar Sociedad, Limitada v Nike International Ltd,* in a unanimous judgment, affirmed as an authoritative statement of contemporary Australian law that of Dixon J in *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* that courts of equity had not:

> thrown the protection of an injunction around all the intangible elements of value, that is, value in exchange, which may flow from the exercise by an individual of his powers or resources whether in the organisation of a business or undertaking or the use of ingenuity, knowledge, skill or labour. This is sufficiently evidenced by the history of the law of copyright and by the fact that the exclusive right to invention, trade marks, designs, trade name and reputation are dealt with in English law as special heads of protected interests and not under a wide generalisation.9

As a result it is not easy to state a clear normative or moral purpose for particular intellectual property laws. Indeed, in some quarters there is debate about the merits of having such laws at all. A practical illustration of that normative uncertainty is the difficulty of finding effective anti-piracy messages. The use of the theft analogy is weak. As Professor Robert Stevens, Professor of Commercial Law at University College, London, wrote:

> In a world which is not one of limitless abundance, we need rules for determining who is entitled to physical things, but these rules of first possession have little application to ideas or information which cannot be possessed.10

An anti-piracy message can be made clear when it can be related to the individual creator of a work. The American performer Louis CK made a video of a performance for online purchase for $5 which he accompanied with this message:

> Please bear in mind that I am not a company or a corporation. I am just some guy. I paid for the production and posting of this video with my own money. I would like to be able to post more material to the fans in this way which makes it cheaper for the buyer and more pleasant for me. So, please help me keep this being a good idea. I can't stop you from torrenting; all I can do is politely ask you to pay your five little dollars, enjoy the video and let other people find it in the same way.11

The message did not lack for moral clarity.

The question – why is it wrong to infringe a person’s intellectual property rights? – may have more than one answer depending upon the nature of the rights and their statutory framework. Sometimes there may be no clear answer because the legislation which defines the right has been influenced by the agendas of particular interest groups. In some cases, the term “normative” may be too high flown to apply to the compromises reflected in particular statutory provisions. That point was made by the High Court in *Stevens v Kabushiki Kaisha Sony Computer Entertainment.*12

The case concerned the use of mod chips to bypass access code requirements in Sony PlayStations, thus allowing the use of copied CD-ROMs. There was a provision of the Copyright Act 1968 (Cth) providing for civil remedies against the vendors of “circumvention devices” whose purpose was to circumvent or facilitate the circumvention of technological protection measures.13 The question
was whether the access code reader in the Sony PlayStation was a technological protection measure within the meaning of the Copyright Act. The joint judgment found little in the way of useful indicators of the statutory purpose. The extrinsic materials gave no clear indication of how the relevant provisions took the final form they did. Their Honours said:

Indeed, the very range of the extrinsic materials, with shifting and contradictory positions taken by a range of interest holders in the legislative outcome, suggests that the legislative purpose was to express an inarticulate (or at least not publicly disclosed) compromise.14

The Court observed that to try to identify a single statutory purpose and then construe the definition of “technological protection measure” by reference to that purpose risked picking a winner when the legislature had not been prepared to do so.15 McHugh J, in a separate judgment, also made reference to evidence that the provisions concerned the product of a compromise agreed to or forced upon interest groups in the industry affected by the legislation.16 Kirby J quoted Professor Ricketson’s description of copyright as “one of the great balancing acts of the law” in which “[m]any balls are in play and many interests are in conflict”.17 Professor Ricketson had described copyright law as a dance and in the passage quoted by Kirby J said:

the multiplicity of participants and interests now involved in its rhythms inevitably affect the contemporary judicial task of resolving contested questions of interpretation of the Copyright Act.18

The lightness of being metaphor is therefore apposite to intellectual property rights not only because they are intangible and readily tradable, but also because they are embedded in a statutory cloud of changeable policies and purposes.

In the case of patents, the concept of patentability itself is subject to judicial development according to a common law process. A recent example of this was the decision of the High Court in Apotex Pty Ltd v Sanofi-Aventis Pty Ltd.19 The Court held there that a method of medical treatment for the human body was a patentable invention as a “manner of manufacture within the meaning of s.6 of the Statute of Monopolies”. That criterion of patentability appears in s.18(1)(a) of the Patents Act 1990 (Cth). There is no statutory definition of the term “manner of manufacture”. The concept has developed according to common law processes.

As was stated in the National Research Development Corporation v Commissioner of Patents,20 it has always been applied:

beyond the limits which a strict observance of its etymology would suggest, and a widening conception of the notion has been a characteristic of the growth of patent law.21

That common law process of development is necessarily informed by the proper limits of the judicial function. Not all proposed developments are necessarily best made by judicial decision. Developments in the law which involve the balancing of complex and contending policy considerations should generally be left to the legislature. In Apotex, the patentability of methods of medical treatment was held to be logically and normatively consistent with the existing body of principles developed for the application of the criterion in s.18(1)(a) of the Patents Act.

There is another aspect of intellectual property rights that makes the metaphor of lightness apposite. That is, their negative character. In a passage from the 4th edition of Laddie, Prescott and Vitoria on The Modern Law of Copyright and Design, the authors observed that:

Intellectual property is a purely negative right, and this concept is very important. Thus if someone owns the copyright in a film he can stop others from showing it in public but it does not in the least follow that he has the positive right to show it himself.22

Lord Herschel LC made a similar comment in relation to patents as long ago as 1893 in a case called Steers v Rogers,23 which was quoted with approval by the plurality in the High Court in Grain Pool of Western Australia v Commonwealth:

The truth is that letters patent do not give the patentee any right to use the invention – they do not confer upon him a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention.24

Enough about rights, what about people. In his novel, Milan Kundera attributed lightness of being to one of his characters, a woman called Sabina, who had simply left a man because she felt like leaving him. The author wrote of her:
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Her drama was a drama not of heaviness but of lightness. What fell to her lot was not the burden, but the unbearable lightness of being.

There is in intellectual property law a person to whom we can attach the attribute of an unbearable lightness of being. It is the intellectual lawyer’s imaginary friend — the person skilled in the relevant art. There is an entity who truly embodies Kundera’s characteristic. It was recently seen running through the pages of the judgments in the High Court and the Federal Court in AstraZeneca AB v Apotex Pty Ltd,25 dodging inventive steps and following a paper trail of prior art, which it examined one at a time as required by s.7 of the Patents Act, and keeping only the most obvious clues to its ultimate, uninventive destination. I do not assign gender to this entity which, after all, is a legal construct. Nor, despite the best efforts of counsel in AstraZeneca can it be attributed with will or purpose. It is, as I observed in my judgment, not an avatar for an expert witness, not even the most convincing expert witness — it is a pale shadow of a real person, a tool of analysis which guides the court. Its shadowy existence and elusive qualities place it well within my lunchtime metaphor.

There are many such imaginary persons to be found in the law. They are a species of lightly personified legal constructs used for the purposes of judicial decision-making. There is, for example, the recently notorious fair-minded lay observer who is used to determine whether or not there is a reasonable apprehension of bias on the part of a referee who determines whether particular material is defamatory.27 The hypothetical reasonable person is used to determine whether a use of postal communication services is offensive28 and in determining whether a representation to the public constitutes misleading or deceptive conduct.29 Each of these constructs hovers at the edge of evaluative judgment. They are, of course, not available for all evaluative judgments of which there are a number in intellectual property law.

I hope I have said enough to justify the application of this rather unlikely sounding metaphor to the work of intellectual property lawyers. I have tried to demonstrate its application by reference to the intangible character of intellectual property rights, their dependency upon the statutes which gave rise to them, and the changeable purposes and policies informing those statutes, their negative character, the common law process of development of the concept of patentability, and the nature of the imaginary person skilled in the relevant art. That leaves only the question whether the metaphor is applicable to the people sitting in this room. I would like to suggest that lightness of being in the sense of intellectual agility is indispensable to the intellectual property practitioner who faces a continually shifting and intellectually demanding, but intensely interesting, area of practice.

* This article is based on a paper presented to the Intellectual Property Society of Australia and New Zealand, WA Branch, on 16 September 2015.
3 ibid., 30 [55] (French CJ).
4 ibid., 44 [88].
5 Francis Gurry, “Acceptance Speech” (Speech delivered at the WIPO General Assembly, Geneva, 22 September 2008).
8 (1937) 58 CLR 479.
9 ibid., 509.
11 Louis CK word — Live at Carnegie Hall.
13 Copyright Act 1968 (Cth), s.116A(1).
15 ibid., 208.
16 ibid., 231.
18 ibid., 241 [169].
20 (1959) 102 CLR 252.
21 ibid., 269–70.
24 (2000) 202 CLR 479, 514 [84].
26 Discussed in British American Tobacco Australia Services Ltd v Laurie (2011) 242 CLR 283.
28 Monis v The Queen (2013) 249 CLR 92.
Women at the IP Bar:
A Case for Unpacking the “Merit” Ideal

Introduction

Judges at the beginning and end of their judicial lives are sometimes invited to share their reflections on aspects of their professional experience. Shortly after I was appointed a judge of the Federal Court of Australia, I delivered a lecture on the participation of women in the legal profession and later wrote an article on their courtroom experiences, particularly as advocates. The article concerned the effects of gender bias in the courts, the nature of the lawyer’s workplace and the difficulties to which that workplace gave rise, particularly for women. While noting that women no longer faced formal barriers to entering the legal profession, the article concluded that, if women were to be effective participants in the profession, then the legal workplace would need to be less inflexible in its “whole-of-life” demands and more accommodating to the diversity of its practitioners’ needs.

There have been significant developments since I last wrote about the position of Australian women lawyers. In each year since 1993, women have made up more than half the law students at Australian universities. Today, greater numbers of women are entering the legal profession than men, and have been doing so for more than a decade. As at October 2014, 60.2 per cent of all solicitors admitted in Australia in the prior year were women, and women comprised 59.2 per cent of those admitted in the previous 10 years. In 2014, 51.5 per cent of all solicitors practising in Australia were men and 48.5 per cent were women. The figures indicate that the proportion of women in this branch of the profession is steadily increasing.

A significant number of women have now forged successful legal careers, including at the Australian Bars. A significant number have been appointed Queen’s Counsel or Senior Counsel and have been appointed to the judiciary. The Australian Intellectual Property Bar, in particular, can claim some especially notable women with brilliant careers, such as the Hon. Susan Crennan AC QC, former Justice of the High Court of Australia, and the Hon. Justice Annabelle Bennett AO of the Federal Court of Australia. Their careers illustrate how legal talent and imagination, dedication and perseverance can lead to professional recognition. Inspiring though they are, this article is not about these lawyers.

The disappointing fact is that the most recent studies of women in the profession, including at the Bar, indicate that, for the most part, women still face gender-based barriers to their progress in the profession. Why is this so?

This article explores aspects of this question. The article was initiated by Christopher Sexton, in his capacity as the editor of this journal, who asked whether I would re-visit the topic of women in the profession, focusing on the particular challenges encountered by female barristers specialising in intellectual property law.

Just like Justice Melissa Perry, I see that all too few women present the difficult cases in court, whether at first instance or on appeal, particularly when regard is had to the numbers and skill of women currently at the Bar. I agree with her Honour that appearances in trials and appeals in the Federal Court are “less frequent than one would wish”. It is, however, more than 18 years since I was in practice at the Victorian Bar; and I have therefore no first-hand experience of the current demands of professional life at the Bar for women.

In order to overcome this deficit, I invited to my Chambers women barristers specialising in intellectual property at the Victorian Bar, to discuss the nature and extent of any gender-based challenges to their practice at the Bar and the effect of such challenges, if any, on their careers. I met
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with junior and senior counsel separately in March 2015. I am indebted to the 12 female members of the Victorian Intellectual Property Bar, who came to talk with me about their professional lives and the extent to which, if any, they perceived any aspect of their practice at the Bar affected by gender-based attitudes or behaviours.

This article concerns the contemporary experience of some women at the Bar and focuses on female barristers specialising in intellectual property law at the Victorian Bar. The article maintains that the professional experience of female intellectual property barristers in Victoria is similar to the reported experiences of women barristers in Australia generally, although the recounted experience of barristers in this specialist area indicates that they may occupy a more gender-neutral space than other women barristers.

The experiences of women in the legal profession in Australia and other countries have been extensively documented over the past 30 years or so. Scholars, professional bodies and lawyers themselves are aware that female lawyers have not, generally speaking, advanced as quickly or as certainly as their male counterparts. In order to understand the significance of the experiences reported in the March 2015 discussions, it is necessary to appreciate the reported position of women barristers over nearly 20 years. To this end, the article commences with the studies made or commissioned by various professional bodies, considers some pertinent themes from the literature and then examines the reported experiences of female barristers in Victoria specialising in intellectual property law. The article concludes with some current notions about the promotion of professional opportunities for women barristers.

Studies Made by Professional Bodies

Over the past 15 years, peak legal professional bodies in Australia have undertaken a number of studies on women lawyers. Generally speaking, the studies have provided the data that confirm that the career trajectory of most women is significantly lower than that of most men in the legal profession. The data prompt an examination of the factors that might constrain women’s, as opposed to men’s, participation in the profession. The studies by professional bodies, like most scholarly analyses, assume that the position of women in the profession is not simply a matter of free choice. This assumption is supported by the accounts that the studies give of the experiences of women in the different branches of the profession, including in practice at the Bar. The studies create a picture of the professional life of many women barristers between the late 1990s and today that has led to a loss of legal talent and the unjust denial of professional opportunities. What follows is a synopsis of some of the significant reports.

Aspiration: Equal Opportunity for Women at the Bar, 1998-2004

In 1998, the Victorian Bar Council published a report prepared by Hunter and McKelvie on the position of women barristers. It was the first report of this kind commissioned by a professional body in any Australian jurisdiction and aimed to gather quantitative and qualitative data by which to assess the status of women at the Victorian Bar and “to identify any barriers to women’s advancement”. It was a landmark report on the topic of women at the Bar. Hunter and McKelvie acquired their data by conducting face-to-face interviews, a study of court and tribunal appearances over a three-month period, and a literature review. Hunter subsequently noted that the Victorian Bar Council sought the research:

[only] after a prolonged period of agitation within the Bar over the question of whether women barristers experienced any form of gender-based disadvantage. The Equality Before the Law sub-committee of the Bar Council was concerned about the apparently high attrition rate of women from the Bar, and wanted research done on the issue, but their concerns were officially regarded as unfounded. The general view was that if people left the Bar it was an indication that they were not suited to the work, had not been able to build a successful practice, and therefore should probably not have been there in the first place.

Hunter and McKelvie made a variety of recommendations designed to diminish documented sexism amongst barristers and to promote more “inclusive” “cultural practices and events”. Other recommendations were designed to lessen or remove the discrimination encountered by women with family responsibilities. The authors reported that “[t]he interview findings clearly indicate that women and men at the Bar have markedly different experiences when it comes to maintaining their professional credibility in light of their status as parents” and that opportunities for women barristers became significantly reduced with motherhood. Further recommendations dealt with removing sexism from the courtroom and with discriminatory briefing practices and prejudices.
In light of subsequent initiatives, one of the most significant aspects of the Hunter and McKelvie report was the authors’ analysis of briefing practices and prejudices; and, as Hunter later observed, “[t]he quantitative study provided statistical evidence of discrimination against women barristers in the briefing process”. The report itself stated:

The court appearances study provides evidence of the outcomes of briefing processes. Data from the study suggests gendered patterns in the briefing opportunities afforded to women and men in the courts and tribunal studied, with individual women and women overall enjoying a narrower range of briefing opportunities than their male colleagues.

The report specifically noted a difference between private and public sector briefing patterns, adding that, with one exception, neither sector was “noticeably supportive of women barristers”.

In the decade after the publication of the Hunter and McKelvie report, the promotion and adoption of equal opportunity briefing practices was perceived by the Bar and Government as well as the Law Council of Australia to be the key to diminishing the documented discrimination and disadvantage experienced by women barristers. In an article published in 2005, Hunter noted, however, that the Bar had not addressed its own culture of “serious hostility towards women” in a similarly targeted way. As the March 2015 discussions outlined below indicate and the most recent studies confirm, this problem of “culture” remains with us.

In 2001 and 2002, the Equality Before the Law Committee of the Victorian Bar conducted further informal surveys of appearances in Victorian courts and VCAT. The results, which were published in 2003, “confirm[ed] anecdotal reports that women barristers continue[d] to be significantly under-represented in court appearances”:

That is to say, the proportion of appearances by women is less and, as the survey results demonstrate, this is often by half, than the proportion of women barristers at the Bar. It is also noted that this under-representation is more pronounced in final hearings when compared to interlocutory or Practice Court hearings.

The Idea of a Model Briefing Policy

In 2000, the Victorian Bar took the first step towards addressing the problem of discriminatory briefing practices by adopting an “Equal Opportunity Model Briefing Policy”. The Policy document set out equal opportunity briefing principles targeted at the potential sources of discrimination identified in the Hunter and McKelvie report. The Policy was translated to Western Australia and New South Wales in 2003, when it was substantially adopted by the Law Society of Western Australia, and the New South Wales Bar Council. The Law Council of Australia also adopted the Policy in 2003, although it expressed reservations about its efficacy in generating fundamental change.

There was also support at the governmental level for the idea that a model briefing policy would assist in removing discrimination against female barristers. For instance, the Victorian Government created the Legal Services Panel in 2002 and required that panel firms report to the Government on the barristers that they retained for State Government work, as a way of encouraging compliance with the Victorian Bar Equal Opportunity Model Briefing Policy. Then, in 2003, the Standing Committee of Attorneys-General requested the Law Council of Australia to prepare a model equal opportunity briefing policy to “assist in reconciling various existing policies aimed at equalising opportunities for female barristers” and to “develop a model policy suitable for adoption by the private legal profession and other briefing agencies”.

The Law Council responded by forming the Model Equal Opportunity Briefing Policy Working Group in 2004. Within the year, the Working Group had released a “Model Equal Opportunity Briefing Policy for Female Barristers” and the Council had adopted the Policy. In a media release of 20 March 2004, the then Law Council President, Mr Robert Gotterson QC, was reported as saying that the issue of gender equality was the Council’s “first priority” and that the Policy meant that “where there is equally capable male and female counsel available, prejudice should not be a factor in excluding a female barrister or advocate”. The Policy required that reasonable efforts be made to identify female counsel in the relevant practice area and to give genuine consideration to briefing them. It also required briefing bodies to monitor and review the rate at which female counsel were engaged.

The Law Council Model Briefing Policy was adopted almost immediately by the Victorian and New South Wales Bar Councils, the Bar Association of Queensland, the New South Wales Law Society and the Bar Council of the Australian Capital
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Territory Bar Association.27 The Western Australian Bar Association adopted the Law Council’s Model Briefing Policy in 2005.28 Shortly after the Law Council published its Model Briefing Policy, Australian Women Lawyers (AWL) published a “Gender Appearance Survey”, and this Survey provided the impetus for the Law Council’s further decision to fund a survey of appearances in Australian superior courts.29 The results of this survey (undertaken with the AWL)30 were published in October 2009 and showed that, whilst male and female barristers appeared in the survey population in the same gender proportion as they existed in the Bar population (81 per cent male; 19 per cent female), the male barristers appeared for significantly longer periods of time compared to females and that private law firms were more likely to brief male barristers.31

The Law Council responded by preparing and adopting “A Strategy for Advancing Appearances by Female Advocates in Australian Courts”,32 with the avowed objectives of:33

(a) Promoting an increase in the proportion of women going to, remaining and advancing at, the Bar.
(b) Promoting an increase in the number and quality of briefs given to female barristers, particularly by private law firms.
(c) Promoting discussion of, and educating the legal profession about, the issues contributing to shorter appearance times of female barristers in certain jurisdictions.

The Socio-cultural Conundrum

Since the Hunter and McKelvie report, a number of efforts have been made by professional and governmental bodies to collect data on women’s experiences in the legal profession and, in so doing, identify gender-related barriers to their equal participation and develop strategies to overcome them.34 Most of these studies have been directed to the position of solicitors, rather than the specific experiences of women barristers. The Victorian Equal Opportunity and Human Rights Commission (VEOHRC), for example, reported its findings on the position of female solicitors in Victoria in its 2012 report, “Changing the rules: The experiences of female lawyers in Victoria”.35

The VEOHRC’s report highlighted that pervasive social or cultural attitudes and behaviours seriously affected women’s professional life. The 2012 VEOHRC report found that “women with parental and carer responsibilities cited negative attitudes towards those responsibilities as both a barrier to their progression and ongoing employment”.36 The VEOHRC also found that discrimination and sexual harassment were barriers to workforce participation. An alarming 40 per cent of the survey respondents stated that they had personally experienced discrimination whilst working as a lawyer or legal trainee in Victoria.37 The majority (60 per cent) of women who had experienced discrimination did not make a complaint. Barriers of this kind were not confined to the law firms, as the Law Council’s recent “National Attrition and Re-engagement Study (NARS) Report”,38 published in 2014 (NARS Report) demonstrated.

In conformity with Hunter and McKelvie’s ground-breaking report, the Law Council’s Strategy recognised that, while briefing practices were critical, there were probably other factors adversely affecting women barristers, such as the culture of the Bar, the courtroom, and family responsibilities. In 2012 – the same year that the VEOHRC published its report – the Law Council decided to commission independent research on the factors contributing to the attrition, retention and re-engagement of women in the legal profession, including at the Australian Bars. The result was the NARS Report. The NARS Report provides a descriptive analysis of significant cohorts of women in the legal profession, including women at the Bar.

The NARS Report found that, nationally, the number of female barristers in Australia (7 per cent of the legal profession) is still less than half their male counterparts (15 per cent).39 The findings of the NARS Report concerning women at the Bar were discouraging overall. On the one hand, the Report found that female barristers were generally more satisfied with their independence and control of their work than women solicitors in private practice and that women barristers derived a higher degree of personal satisfaction from their work than their female counterparts in private practice.40 At the same time, women barristers reported working longer hours than lawyers in private practice;41 and the Report concluded that “[t]he research suggests it can be very difficult for barristers to balance the demands of their role with family responsibilities”.42 Of even greater concern was the NARS Report’s statement that:

Female barristers most often reported experiencing almost every form of discrimination or type of harassment at work than their counterparts in
Female barristers were twice as likely as those in private practice or in-house roles to believe they have ever experienced sexual harassment at their workplace. Female barristers were also more likely than other females to report experiencing discrimination due to gender, bullying or intimidation, and discrimination due to family/carer responsibilities.

Female barristers referred to both conscious and unconscious bias at the Bar. Conscious bias included female barristers being denied briefs because their clients preferred male counsel.

The findings of the NARS Report indicated that the prevalence of sex discrimination continued to injure women in practice at the Australian Bars. Unsurprisingly, the cultural attitudes that disadvantaged women solicitors in private practice also affected women barristers. Presumably too, the gendered behaviour patterns reportedly prevalent in some solicitors’ firms also found expression in briefing practices.

Achieving Tangible Outcomes for Equality

The NARS Report indicated that there was an urgent need to re-think strategies for change, particularly socio-cultural change. Professional bodies around the country had occasion to re-evaluate their gender equality strategies, particularly in light of the NARS Report.

Anticipating the publication of the NARS Report, the Victorian Bar launched “The Quantum Leap”, which undertook various measures aimed at diminishing the socio-cultural impediments to women’s professional practice at the Bar. The then Chair, Fiona McLeod SC, said that the reforms represented a “new boldness that is required to break through entrenched difficulties”. The measures included the collation and publication of data about the proportions of women barristers at differing levels of seniority and their gross earnings, a voluntary gender equality undertaking by senior counsel, unconscious bias and mentoring programs, re-engagement roundtables with women on career breaks and exit surveys to understand attrition drivers.

In mid-2014, the New South Wales Bar Council approved “Best Practice Guidelines” on a range of topics, including harassment, discrimination, vilification and victimisation, bullying, parental and other extended leave, and grievance-handling.

In August 2014, the President of the New South Wales Bar Association established an Equitable Briefing Working Group, charged with reviewing the application, in New South Wales, of the 2004 Law Council’s Equitable Briefing Policy.

The Working Group’s subsequent report in August 2015 confirmed the failure of the Policy and the need to re-think reform strategies. The Working Group reported that “[t]he available evidence suggests that the Policy ha[d] made little or no difference to the briefing practices nor ha[d] it provided greater opportunity for women barristers.” The Working Group noted that the Policy had not established tangible obligations as to outcomes, nor had it imposed an obligation to implement, monitor or report on adherence to the Policy. In substance, the mere obligation to consider women had not translated to a change in briefing practices.

Scholarly Insights Relevant to IP Female Barristers

Apart from the studies by professional bodies, there is a substantial body of scholarly literature on the position of women in the legal profession in Australia and elsewhere. With respect to the Australian Bar, the literature gives rise to three observations that bear on female barristers specialising in intellectual property law, as the subsequent March 2015 discussions indicate.
A Need to Quicken the Pace of Change
First, scholarly commentators agree that, generally speaking, little has changed for women barristers since 1998. Drawing on survey research on professional culture at the Bar in Victoria and Western Australia, Keating and Zirngast commented that the “slow rate of change suggests that structural reforms such as changes to briefing practices may be failing to produce shifts in professional culture.”

The Ideal of Merit
Secondly, some scholarly literature refers to a principle of “meritocracy”, which is said to be a cornerstone of the Australian Bars. According to this principle, the barrister who receives the brief should be the “best for the job”; and progression, whether to senior counsel or the judiciary, should be according to merit. If understood as an informing object, rather than an organisational principle, few would dispute its value. Indeed, Ragusa and Groves have reported that their survey of women barristers in New South Wales, Victoria, Western Australia and Queensland indicated that female senior counsel uphold meritocratic qualities, such as hard work, tenacity, legal skill, sensitivity to courtroom interactions, ability to focus and flexibility, as their personal keys to success. As the March 2015 discussions below indicate, for female barristers specialising in intellectual property law at the Victorian Bar perceive the “male monastic model” stereotype works against female barristers. It may be too that this stereotype translates into a perception that a female barrister, especially a mother, lacks the “necessary” commitment to justify her progress at the Bar. As the following discussion shows, female barristers specialising in intellectual property law at the Victorian Bar perceive the “male monastic model” of a barrister to undermine their professional credibility.

Re-creating Stereotypes
The scholarly literature also indicates that the lack of a genuinely gender-neutral stereotype of the successful barrister is a particular issue for women at the Bar. One powerful stereotype is the barrister who is “married” to the Bar to the virtual exclusion of other obligations. Such a barrister is always available for professional work, even at short notice, whether at the request of instructing solicitors, clients or the courts. As explained below, this “monastic” model typically suits men, not women. It is also misleading. While the demands of a long-running trial call for long hours and dedication to the task at hand, the fact is that most of a barrister’s work does not call for such a degree of intense commitment; and, in any event, long trials do end and with that end comes release. There is a need to define a more flexible reality and to change expectations.

As Ragusa and Groves note: “[s]tereotypes are crucial to sustaining gender inequality because they allow individuals to make instant judgements based on preconceived role expectations.” The stereotype of the barrister committed to work to the exclusion of all else is not just misleading, it may undermine the sense of self-worth of those who consider that they cannot conform to it, such as barristers who also assume primary responsibility for children or other vulnerable family members. While ever-conventional thought would see women, rather than men, take on these primary responsibilities, the “monastic mode” stereotype works against female barristers. It may be too that this stereotype translates into a perception that a female barrister, especially a mother, lacks the “necessary” commitment to justify her progress at the Bar. As the following discussion shows, female barristers specialising in intellectual property law at the Victorian Bar perceive the “male monastic model” of a barrister to undermine their professional credibility.

Other stereotypes have also been said to centre on “perceptions of legal competence, and performance skills which are measured against male behavioural stereotypes.” Hunter has noted that comments made by female barristers in interviews provide “a clue as to how women are expected to ‘do gender’ at the Bar, which is to suppress their femininity and pretend to be just like the men, in order to be accepted.” Hunter also maintained that the denial of discrimination by some interviewees “was clearly correlated with the denial of femininity (or at least its devalued aspects), with many of the interviewees attempting to present themselves simply as non-gendered barristers.”
As the following account shows, however, the March 2015 discussions with female barristers in intellectual property law provided little or no evidence of this latter phenomenon, reflecting, so it seemed to me, that the participants had an intelligent self-awareness of their own distinctive identities and their potential to make further significant achievements in practice at the Bar. Rather, these discussions support the observations of Keating and Zirngast that “a capacity to reflect on the impact of gender” is an important means by which a number of successful women barristers are finding points where the dominant Bar culture may be vulnerable to successful challenge.68

The Keating and Zirngast analysis indicates the ways in which some women are re-framing and even devaluing some of the more masculine elements of Bar culture,69 for example, by reshaping the “boys’ club” collegiality of the Bar by building meaningful relationships along gender lines,70 re-valuing family life often against the dominant norms of the Bar,71 and maintaining a critical distance from Bar culture.72 It was apparent from the discussions to which I now turn that barristers in intellectual property law had made their own appraisals and were re-casting aspects of Bar culture to conform more closely to their own perceived realities.

Discussions with Women IP Barristers

Background and Reasons for Joining the Bar

A striking feature of the female barristers whom I met in my Chambers in March 2015 was that they had all joined the Bar to engage in interesting work and, as one person put it, she “wanted a challenge” and “when she got there [she] was able to engage with the law”. Another stated that she “thought barristers had a better life because they were in court”. This barrister added:

“You also had more freedom and were able to control what was going on. And you got more interesting work because it was at the pointier end of a dispute. It gave you more flexibility than being in a firm.”

Another said:

“I was always going to go to the Bar. I went to the Bar because I was always interested in the pointier end of litigation. I also wanted to do appearance work. I was enchanted by the atmosphere of a courtroom.”

Most had previously been in private practice, and many had a science background. The greater proportion had numerous years’ experience in one of the larger commercial firms in Melbourne. Within this group, however, there was diversity, including those who had worked in the governmental science area and firms in London. A number had completed postgraduate degrees, including at leading universities outside Australia. Those who had not worked at leading commercial firms included two who had been on the staff of a university and included at least one patent attorney.

Most of the participants had been mentored by senior male barristers and all of these participants expressed an indebtedness to their mentors. More than half of the barristers with whom I spoke had children and had taken leave from professional practice because of children, including for the final school examinations.

Themes in Discussion

Intellectual Property Law Practice is Different

At the commencement of both discussions with senior and junior counsel, the participants commented on what made practice in the intellectual property field different from other fields, although they distinguished between patent law and other areas of intellectual property practice. Patent law was seen to remain principally male, while it was generally agreed that there were as many women as men in trade marks.73 As one participant said: “Patents is such a small area, only a few women are coming there.” Another observed: “Far more men are patentees than women. There are generally more male clients than women. Clients want to be involved in choosing counsel.”

One barrister commented that she had worked “with more men in patents” and that “[a] colleague has said that clients would prefer a man, but I haven’t experienced it”.

Almost everyone agreed, however, that it was more common in intellectual property than elsewhere to have female instructors. This was seen as advantageous. Thus, one participant said:

“We are lucky in IP in that there are a lot of women at the solicitor level. So, it is not a strange thing to have a woman in IP.”

Another participant observed that sometimes female instructors felt “the need to balance a team by having male counsel” but that generally “women have … found it easier to progress in IP than in other areas”.

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**The Desirability of More Speaking Parts**

Junior counsel agreed on the importance of getting enough speaking time “on your feet”. One participant identified this as the “biggest challenge” for junior counsel. There was general agreement with the sentiment that “sometimes it is better to accept a humble brief in a lower court where you are on your feet, than take a junior brief in a higher court”. Another participant said that she had not “seen a lot of senior women on their feet and often other senior men are brought in to lead senior women”.

Senior counsel agreed that it is important for less experienced female barristers to have speaking roles. They emphasised that, when first at the Bar, “it was good to put up your hand for anything” and that specialisation came later.

**Perceptions of Masculine Stereotypes**

Junior counsel were very much aware of the effect of “masculine” stereotypes in briefing practices. As one participant put it: “Litigation is seen as war and people are often more comfortable with an alpha male leading the team.” There was general agreement that solicitors and their clients wanted a “fighter”. Another participant observed that one solicitor had commented to her that he would not retain a senior female counsel because she “didn’t have enough gravitas”.

There was also a general perception amongst the participants that solicitors’ awareness of a barrister’s motherhood led to negative assumptions about her work practices or work ethic. One participant noted:

*Because you are a woman with children, people make all sorts of assumptions about travel and how late you will work – treat it as “motherism”. I haven’t been discriminated against because of my sex but I have been discriminated against because I am a mother.*

Another said:

*Being a woman in IP does affect my work. I was told that I wasn’t selected as a junior because apparently I don’t do work in Sydney, which was incorrect. I didn’t find this out until I was told by another more senior male barrister.*

As one person pithily observed, men have children too.

There was general agreement that such negative assumptions about female barristers were more commonly held by solicitors, rather than senior male barristers. A number of the participants remarked, however, on the “blokey” culture of the Bar. As one participant put it, “older barristers develop a man about town blokey culture”.

**Discriminatory Behaviours**

Participants gave a number of accounts of sexist behaviour on the part of male solicitors and barristers, although one participant stated that, on one occasion, a male member of the Bar had “told off” a misbehaving solicitor.

A number of the stories given by the junior barristers revealed that they saw women as having different experiences to men at the Bar. Participants recounted examples of “bad behaviour” by men barristers, in and out of court, ranging from sexual harassment to less overt sex discrimination. One participant noted the “huge” “culture shock” that she experienced in going from private practice to the Bar. She said:

*[T]he Bar is another world – it is an unreconstructed environment, and lack of accountability for men means they can try anything on. Law firm culture is based on accountability and consequences – one form of accountability for men at the Bar would be a lack of progression for bad conduct.*

**Discrimination in the Courts**

Sadly, there were also accounts of courts reinforcing masculine stereotypes and discriminatory patterns of behaviour. One participant said:

*I had a case a couple of years ago against a Sydney practitioner. In closing submissions he said female counsel’s submission were beguiling but like a siren’s call would lead one to the rocks. The judge did nothing about it.*

This also highlighted that there remained a lack of understanding amongst some practitioners that it was unacceptable to use sexually discriminatory language in any professional context, especially in the courtroom. In this case, when the female barrister took up this use of language with two male colleagues, “one said he would never do it, the other said he didn’t see it as sexist”.

**The Effect of Family Responsibilities**

In discussion, most participants noted that another significant difference between the experiences of men and women at the Bar was the pressures faced by women in juggling family responsibilities. As one participant put it:

*Women face challenges coming to the Bar because of children. That is, having to come to the Bar young*
before having children or older after children. Until men take on a more active role in child raising it will always be more difficult for women. You have to be very selective in who you marry.

Having children and being a female barrister was clearly viewed as a challenge unless partners also assumed responsibility for their children. As one counsel said:

I think that my male colleagues will not have to go home and cook dinner. If I make school lunches I make them the night before.

There was agreement that you have to be physically strong and “doubly so, if you have to go home, and look after children”.

One participant remarked, however, that she was aware that there were now “a number of women juniors who [were] primary breadwinners, and whose partners take primary responsibility for their children”. The difference between male and female barristers’ experiences of juggling family responsibilities was emphasised by the participants’ general agreement that male barristers found it less difficult to acknowledge their family duties. One participant recalled that at one hearing “a male silk said he couldn’t do a particular time because he had to pick up his children and he wore it as a badge of honour”.

Career Progression

As to career progression, senior counsel agreed that the change to a group chambers policy at the Victorian Bar may make things harder for women and that, for a newcomer “[t]o get on the right floor you need to have someone in your corner”. Some participants thought that “women tend to get silk sooner than men”, while others considered that women tended to apply later than men. Some thought, too, that extrinsic pressure for progression to senior counsel and to the Bench had a tendency to stymie the desirable development of the profession, by lessening the number of female senior counsel available to mentor less experienced women. Nonetheless, one participant commented:

[T]here are only a handful of women who apply for silk each year and I don’t know why. It is useful to have a mentor encouraging you along.

Strategies for Reform

In the course of discussions, participants touched on strategies for reform. Some considered briefing quotas a good idea. All thought good mentoring important, irrespective of whether the mentor was male or female. Most saw an urgent need to change solicitors’ assumptions about the qualities of female barristers and to instill in them the confidence to brief women and “not brief just based on what the client will think”. One participant commented:

Rather than shaming people into briefing women, it would be better to tell inspiring stories about female barristers doing well. Story-telling is effective as a method because people come to accept women as being good. We don’t talk ourselves up enough.

The discussion was divided on whether the courts had a role to play in this context. All agreed courts should be mindful of departing from court sitting hours. A number agreed that “encouraging male senior barristers to get women to do work on their feet is really the most practical and immediate response”. It was here, most thought, that the courts could give active encouragement. There was some support for the proposition that “judges ask when parties are timetabling a matter whether the female junior is going to be involved in submissions or evidence” since this would “create expectations”.

Strategies for Change

The numerous studies undertaken by professional bodies over the past nearly 20 years and the responses to them demonstrate a commitment by their instigators to the principle of gender equality. The studies have been invaluable in gathering the data and documenting the difficulties that justify the arguments for debunking sexist attitudes and behaviours in legal practice, including at the Bar. At the same time, as the history of the Law Council’s Model Briefing Policy indicates, they have provided the information for designing strategies for change and evaluating their success or failure. What lessons about these strategies do these studies teach?

First, in view of the NARS Report, there is evidently a need for a different approach to achieving equality reform. The model briefing policies, for example, have not brought about sufficient changes to briefing patterns. One difficulty with these policies was that they applied a “formal rather than substantive idea of equality of opportunity”. Further, as Bartlett observed, the Law Council’s Model Briefing Policy:

[can] be understood as the first step away from the detailed findings of the Hunter and McKelvie report. It removed several specifically targeted responses to areas of functional discrimination in
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Women at the IP Bar: briefing practices, such as promoting opportunities for junior female barristers. Furthermore, it placed the requirement for counsel to identify female counsel when asked for recommendations as a note to the policy. There are no measures ostensibly aimed at curbing the predominance of selection by fraternal networks. The third level of influence on briefing practices – the client – has also been omitted from the [Model Briefing Policy].

In this area, there is a need for strategies to stretch for substantive reform. Accordingly, a targeted and more rigorous approach to gendered briefing practices, of the kind advocated by the NSW Equitable Briefing Working Group, may well be necessary.

Secondly, the history of attempted reform indicates that to take gender off the agenda requires a basic change in the gender-biased cultural attitudes of the profession. This requires a multifaceted approach, including train-the-trainer programs directed to unconscious bias, strong mentoring programs and “equality” leadership schemes.

Thirdly, the history of reform initiatives to date indicates that reformers should be wary of placing too much reliance on the ideal of merit. The strengths and weaknesses of the ideal of merit are relevant in the present context. On the one hand, the merit ideal is seemingly gender-neutral and expresses the pursuit of excellence; and, for that reason provides a relatively uncontested standard. This probably explains why gender equality initiatives have thus far generally been expressed as “a meritocratic method of social change”, to adopt the words of Ragusa and Groves.

For example, both the Victorian Bar Council and Law Council of Australia justified their model briefing policies as policies based on “merit”, rather than on “affirmative action”. The history of women barristers over the last 20 years, as set forth in the studies discussed above, indicates, however, that adherence to the merit ideal has not brought about the desired changes. This is, so it seems to me, indicative of the fact that the merit ideal camouflages other values and that these values result in discriminatory practices antithetical to women. It is time to unpack this ideal to discover what elements are mistakenly packed within it.

This latter task is allied to the need to persuade law firms, barristers’ chambers and other legal organisations to move beyond an in-principle commitment to equity principles to an acceptance that gendered attitudes and behaviours impede their work and retard their progress. An aspect of this challenge is to ensure that briefing solicitors and through them, their clients, appreciate the qualities that are really required of a barrister in court-work today and to instil in them the confidence that a female barrister may in any particular case be the best choice. It seems to me that the opportunities of women barristers specialising in intellectual property law would be enhanced by a more informed and widespread understanding amongst briefing solicitors and their clients of the skills that contribute to effective advocacy in intellectual property cases. These are not gender-based skills or competencies. If approached in this way, the merit ideal may be referenced to support the knowledge and practical skills and competencies that are actually required of today’s best advocates.

Intellectual property cases call for high-level case management skills aimed at ensuring that costs are kept in check and delay minimised. Particularly in the early stages of intellectual property litigation, counsel is often required to rein in a case, by identifying for the court the key issues in contest and outlining a plan for the effective use of expert evidence. Good case management requires that counsel be well-acquainted with the prospective evidence. Case management skills that are actually required of today’s best advocates.

In a patent case, the court appreciates counsel’s ability to explain a complex body of scientific knowledge efficiently and clearly. Effective counsel are attuned to the needs and expectations of the court and are flexible in identifying the very best means of information transfer – whether by tutorial format, a primer or expert evidence or otherwise. Trade mark, copyright and industrial design cases may sometimes call for advocacy by way of narrative and, in a trade mark case, for a careful evaluation of the potential admissibility and utility of survey evidence. All cases call for an up-to-date expansive knowledge of the applicable law in Australia; and some cases call for knowledge of the law in other jurisdictions. Skilled counsel are aware of these possibilities and alive to the proper scope of the assistance they should offer. Especially in intellectual property cases, the art of the advocate is persuasion; and in intellectual property law cases persuasion is a function of knowledge, legal skill and practical acumen. Persuasion is not a function of
gender; and gender-biased attitudes and behaviours do not win cases.

Gendered stereotypes can be undone in various ways. One way is to encourage greater attention to what is in fact required of a barrister in court.

The Bar is, furthermore, a place for myths and legends. Reform strategies might well harness this characteristic. Storytelling about the feats of female barristers may be another way of enhancing the standing of female barristers, as one participant in the March 2015 discussions observed, and may perhaps give rise to alternative models for successful barristers. This is a grass-roots strategy in which each of us can join.

Conclusion

Professional bodies adopted diverse strategies in response to mounting concern amongst their own members and at a governmental level that the initiatives taken since the landmark Hunter and McKelvie report have not led to the desired changes.

The result of the reformers’ efforts is, however, a better understanding than in 1998 about the nature of the obstacles facing female barristers. This understanding has awakened more general support for change by lawyers and by the courts. More barristers than before recognise that discrimination on the grounds of sex (or a similarly irrelevant criterion) is contrary to the very virtues the Bar claims to nurture and protect. It also deprives the Bar and the courts of talents that they can ill afford to lose. There is a growing realisation that strategies for reform must be targeted at substantive deficiencies and an acknowledgment that panaceas concerned with form only are not enough.

The most disappointing aspect of the discussions with female intellectual property counsel at the Victorian Bar in March 2015 was that no-one had a number of speaking roles during that period. Her Honour referred to Vinod Mishra and Russell Smyth’s study “Barrister Gender and Litigant Success on the High Court of Australia”, Discussion Paper 15(13), Monash University, Department of Economics (2013), particularly statistics from Table 2 on p. 40, but this data may not provide a reliable guide to female barrister appearances before the High Court during that period. This is because Mishra and Smyth chose a sample of High Court cases that appear to be only a subset of the decisions handed down by the High Court in relevant years; for example, their sample set of 1996 cases in Table 2 includes 35 cases, though Austlii lists 58 cases decided by the High Court in 1996: http://www.austlii.edu.au/au/cases/cth/HCA/1996/. Of more concern, a review of the cases provided oral argument for at least one party’ reveal that the numbers provided by Mishra and Smyth must be treated cautiously. For 1996, Table 2 shows only 1 case for each of the categories of female barrister as lead counsel, and 2 cases as female barrister provided oral argument for at least one party’.

The most heartening feature of the discussion was the evident enthusiasm of the participants for the practice of intellectual property law at the Bar and their conviction that the unreformed stereotypes and gender-biases that they had encountered were vulnerable to successful challenge.

1 The author acknowledges and thanks Louise Brown and Anthony Hall for their invaluable assistance in the preparation of this article.
7 M. Perry, “Women at the Bar: Aspirations and Inspirations”, speech delivered on 5 April 2014, Women Barristers Forum, NSW Bar Association Common Room. I sound a note of caution in relation to Justice Perry’s statements about the numbers of female barristers having been lead counsel or having a speaking part before the High Court between 1994 and 2011. Her Honour referred to Vinod Mishra and Russell Smyth’s study “Barrister Gender and Litigant Success on the High Court of Australia”, Discussion Paper 15(13), Monash University, Department of Economics (2013), particularly statistics from Table 2 on p. 40, but this data may not provide a reliable guide to female barrister appearances before the High Court during that period. This is because Mishra and Smyth chose a sample of High Court cases that appear to be only a subset of the decisions handed down by the High Court in relevant years; for example, their sample set of 1996 cases in Table 2 includes 35 cases, though Austlii lists 58 cases decided by the High Court in 1996: http://www.austlii.edu.au/au/cases/cth/HCA/1996/. Of more concern, a review of the cases provided oral argument for at least one party’ reveal that the numbers provided by Mishra and Smyth must be treated cautiously. For 1996, Table 2 shows only 1 case for each of the categories of female barrister as lead counsel, and 2 cases as female barrister provided oral argument for at least one party’.
8 Christine Wheeler QC and S. C. Kenny in the following cases: Free v Kelly (No 2) (1996) 138 Dondas (No 2); Free v Kelly (No 1) (1996) 185 CLR 296. I note also that Wik Peoples v Queensland (1996) 187 CLR 1; Snowdon v North Ganalanja Aboriginal Corporation Queensland (1996) 185 CLR 140; McGinty v Western Australia (1996) 186 CLR 140; North Gavanlganj Aboriginal Corporation Queensland (1996) 185 CLR 795; Wit Peoples v Queensland (1996) 187 CLR 1; Snowdon v Dondas (No 2) (1996) 188 CLR 48; Free v Kelly (No 2) (1996) 138 ALR 646, Free v Kelly (No 2) (1996) 185 CLR 296. I note also that Pamela Tate QC, now the Hon. Justice Tate of the Court of Appeal of the Supreme Court of Victoria, was the Solicitor-General for Victoria from 2003 – 2010, and it would be safe to assume that she had a number of speaking roles during that period.
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Later in 2003, the Law Society of Western Australia replaced this Policy with another directed to eradicating discriminatory briefing policies based on “arbitrary or prejudicial factors such as colour, race, ethnic or national origins, sexual orientation, marital status, physical impairment or religious beliefs”. Law Society of Western Australia website, Available at: https://www.lawsocietywa.asn.au/page.php?id=405 (accessed 22 September 2015).


23 The Hon. Justice Robert Gottstein AO was appointed a judge of the Supreme Court of Queensland and a Judge of Appeal in April 2012.


50 By 2017: 10 per cent of all briefs to senior counsel to women silks, 20 per cent of all briefs to junior counsel with at least five years’ experience to women barristers, and 35 per cent of briefs to junior counsel with less than 5 years’ experience to women.
56 R. Hunter, “Talking up equality: women barristers and the denial of discrimination” (2002) 10(2) Feminist Legal Studies, p. 113 at 120. 
58 Interestingly, the varying experiences of practice in different areas of intellectual property experienced by women barristers from the Victorian Bar may reflect similar trends elsewhere. For example, female intellectual property attorneys from Silicon Valley, California interviewed by Hagen commented on the limited number of women in patent prosecutions and intellectual property litigation, in contrast to the large number of women in trade mark law: K. Hagen, “An Essay on Women and Intellectual Property Law: The Challenges Faced by Female Attorneys Pursuing Careers in Intellectual Property” (1999) 15(1) Santa Clara High Technology Law Journal, p. 139 at 141-147.
There are certain established reasons why destruction is not recognised as a breach of the integrity right in the UK. First, a strict reading of section 80 and Article 6bis would appear to dismiss the act of destruction altogether. Section 80 defines “treatment” of a work as one of a closed category of specified acts: addition to, deletion from, alteration to or adaptation of the work in question. “Destruction” does not fall neatly within any of these definitions. Furthermore, not only has there to be derogatory treatment of the work, ss.80(3), (4) and (6) require a further act in order to establish infringement. Prima facie, these subsections require that the result of the derogatory treatment is communicated or shown to the public in some way. As nothing would remain post destruction, there is nothing that may be communicated or shown to the public where destruction is concerned.

Secondly, as destruction leaves nothing of the original work behind, there can be nothing left that can affect the author’s reputation, unlike a work which has been maltreated or deformed in some way, which does leave behind a misrepresentation of the author’s work.

The third reason lies in the definition of “work” for copyright purposes. The CDPA specifies eight categories of works which may be subject to copyright protection. These works are subdivided generally into authorial works, i.e. literary, dramatic, musical and artistic works, and entrepreneurial works, i.e. sound recordings, films, broadcasts and typographical arrangements. For
the purposes of copyright law and moral rights, the protectable essence of authorial works such as novels, poems, symphonies and the like lies in their content, not their physical embodiment. Copyright arises and attaches to a work the instant it is created and fixed in a material form. It has been argued that for the purposes of copyright, the work then remains in existence even if its physical embodiment is destroyed.\(^{10}\)

This principle apparently applies in relation to all types of works, textual works such as literary and musical works, and also artistic works. It is clearly the creative content, i.e. words, plots, descriptions, characters etc of a novel which constitute the protectable core, not the printed paper or electronic-ink. In furtherance of this principle, it is argued that likewise the picture is the protectable aspect of an artwork, not its physical support, e.g. the canvas and pigments of a painting. It follows that the destruction of the first edition of a book or the original painting or any of their copies would still leave the content intact. Furthermore, through their copies, their protectable content would remain accessible indefinitely, and the relevant work cannot be destroyed.\(^{11}\) It is with this third argument i.e. that a "work" cannot be destroyed, including artistic works, that this article is solely concerned.

The UK is not alone in being ambiguous about the right to object to destruction of copyright works,\(^{12}\) however it may draw inspiration from fellow common law jurisdictions such as Australia,\(^{13}\) US,\(^{14}\) and the India,\(^{15}\) each of which has found its own way in granting authors such rights. In turn, it is hoped that this article will serve not only to foster an argument that the UK should consider such rights and rethink its approach to artistic works under its copyright law, but that it will also serve to endorse the rights which are already available in the abovementioned and other jurisdictions.

**Framework of Article**

This article will propose that artistic works are fundamentally different in nature to textual works, and it is unsound to treat them in exactly the same way under copyright law where destruction is concerned. This is reflected in the way we ordinarily treat works like music and literature as contrasted with the way in which we treat works like paintings and sculptures. We identify the latter with their original physical embodiment and feel an incalculable loss when the original physical work is destroyed. To all concerned, it is simply lost forever and no one would believe that it is not destroyed. However, there is no such depth of profound loss if the original handwritten manuscript for say, Mozart’s 40th symphony, is lost. There is of course a great sense of dismay but that is only because of the provenance accorded to the manuscript. Otherwise, Mozart’s 40th symphony is still performed and enjoyed in numerous concert halls throughout the world, and is recorded in the numerous copies of its music score. One may argue that we should treat all works of art alike, and could likewise consider that Mozart’s 40th symphony may be completely destroyed in the event the very last copy of its manuscript or recording of the last performance of the symphony is destroyed, and when all memories of the symphony have completely faded. It must be appreciated, however, that in the present digital age in which reproduction techniques are superlative, such a consequence is highly improbable.

It is intended to take issue with the concept of work as applied to artistic works, primarily on the premise that the physical matter i.e. the paint and canvas and other materials, takes on a fundamental and necessary role in the creation of an artistic work. It is argued that the purely immaterial element cannot function, on its own, as the entire artistic work, and that contrary to the view that a copyright work cannot be destroyed, destruction of the material will simultaneously destroy its immaterial content. It will also be argued that although an artistic work can be destroyed, copyright protection is not necessarily extinguished upon its destruction.

Therefore, essentially two questions are posed in dealing with the definition of “work” where artistic works are concerned, firstly the question as to whether the material aspect i.e. the medium, of a work of art is a fundamental and essential element of the same, and secondly, whether art can be destroyed, both of which are issues which have been subject to considerable scrutiny by art philosophers. A discussion of the ontology of art is therefore an important contribution to the present debate, where issues regarding the law and those regarding art intersect as they do here. The ensuing discussion in this article is not purely a discussion of metaphysics for its sake, but a matter of how the purposes of copyright protection and the moral rights doctrine in relation to art may be best served through a more helpful perception of what an artwork is.

Finally, the point must be made that, even if the legal concept of an artistic work is that it is an immaterial concept, the reality is that an original
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Artwork is a wholly unique entity, consisting of both the immaterial subject-matter and the material support which encapsulates the subject-matter, which once destroyed, is utterly irreplaceable. Due to the unique nature of artworks such as paintings and sculptures, their very destruction constitute an irretrievable loss of a unique piece, a fate that rarely befalls the other forms, such as literary and musical works, of which multiple copies are invariably made, especially in the age of digital technology. It is obvious that the effect of destruction of even the first edition of a literary work is therefore nowhere near as devastating and irrevocable as that of an original artistic work, hence the reason for focusing on artworks, as their requirement for a solution is far more pressing.

The Ontology of Art – Can a Work of Art Be Destroyed?

The question of whether a work of art can be destroyed is a question which features in any query investigating the nature of art works. The query is not so much a question as to what conditions a work must fulfil in order to be classified as an artistic work (for e.g. it meets some standard of beauty, or standard of craftsmanship), than a focus on asking what type of entity is a work of art. In other words, we ask if a work of art is perhaps a purely physical object, a feat of imagination, or a sensory experience for both artist and spectator? Destruction enters into the equation in that if a work of art is a purely physical object, then clearly it can be destroyed, but not if it is an abstract entity. These questions have been debated by numerous aesthetic philosophers, including Wollheim, Collingwood, Margolis and Thomasson, and it is from the works of these philosophers that inspiration is sought in order to address the issue in copyright law.

These same questions also crop up in copyright law, but they have not been debated to the same depth in legal circles. While judges and academics have certainly debated in much depth and detail the criteria which must be met by a work before it can be considered as an artistic work for copyright purposes, they have not considered the issue of destruction to the same extent, which is unfortunate as the issue is important particularly in considering whether an artist has a right to object to the destruction of his work. The following section will deal with the legal perspective on artistic works, before proceeding to a consideration of the key texts on the ontology of art by aesthetic philosophers.

Legal Perspective

The law and the arts have crossed paths in countless instances, ranging from issues relating to copyright, obscenity, customs and duties, and taxes. Problems in aesthetics have therefore necessarily been the subject of considerable judicial deliberation, although unfortunately without the assistance of, or reference to, any of the established aesthetic theories or expert opinion. The courts’ reluctance to enlist the help of experts in the field is explained by Lord Simon in *Hensber*:

... the court will endeavour not to be tied to a particular metaphysics of art, partly because courts are not naturally fitted to such matters and partly because Parliament can hardly have intended that the construction of its statutory phrase should turn on some recondite theory of aesthetics.

A few law academics on the other hand have increasingly taken up with art theorists in their discussions on art. Karlen refers briefly to the work of Collingwood, Margolis and Goodman in his general discussion on aesthetic theory in relation to legal problems involving art, while Pila, in writing on the categorisation of copyright works, relies on the work of Kendall Walton, while also making brief references to art philosophers such as Thomasson, Dickie and Levinson.

The engagement of law academics with the question of destruction have however generally been incidental, arising primarily from discussions of the following two perspectives. First, the issue crops up when law academics (Dercelaye, Pila, Garnett and Davies) consider the broader question of the requirement for fixation or permanence of copyright protected works, in the discussion of which, the same academics have questioned the nature of these same works. It will be seen that legal academic debate has readily accepted that destruction of the material form of a work does not destroy the “copyright work” itself. However, the conclusion is unaccompanied by any satisfactory reason, and certainly with little recourse to the extensive debates which have already taken place in art philosophy on the very same question.

Secondly, and closely related to the above legal query, other law academics (Liu, Waisman) have focused more pointedly on the material or physical aspects of artistic works, generally concluding that the physical material is a separate and distinct feature, which when destroyed, does not destroy the work of art. In arriving at the above conclusions, law academics in general appear to accept rather
too eagerly that destroying the physical work, even if it is a "singular" work, i.e. works of which there is only one instance, like a painting or sculpture, does not destroy the work of art itself, notwithstanding that this is a stance which has been debated at length by art philosophers and which has not been as readily accepted by them.

The above legal debates will be covered in the following sections, in which the point will be made that their conclusions on destruction arrived at thus far have been premature and unsatisfactory.

The Requirement for Fixation or Permanence?
The question of whether an artistic work may be destroyed is linked to numerous debates which have centred on the requirement of fixation, i.e. that the work is recorded in a material form, which is a long established principle of copyright law. In copyright cases pre-dating the CDPA, where the fixation requirement appears in s.3(2), the fixation principle has been expressed generally in terms of the necessity for certainty; first, of existence of the work itself, and secondly, for ascertaining the boundaries of the work claimed. Section 3(2) of the CDPA, which refers only in relation to literary, dramatic and musical works, simply states that copyright does not subsist in these works unless and until it is "recorded in writing or otherwise", and is also deemed to be the time the work is made. The act merely goes on to define "writing", but does not give any further guidance beyond this. Artistic works are presumably not subject to the same requirement as they exist ordinarily in a physical material form, and not in an ephemeral state.

The issue of destruction arises where debates on the fixation requirement have centred on the question of whether the fixation itself must also be in a permanent form. Copinger & Skone James categorically confirms that permanence is not a requirement, and indeed nowhere does it say in the CDPA that fixation ought to be permanent. It appears, however, that the courts have not been so certain themselves, of either the necessity for artistic works to be also fixed or that the fixation should be permanent. Derclaye, on having studied relevant cases and legal commentary on this issue, has concluded that permanence is not a requirement, but that, despite the absence of any reference to artistic works in s.3(2), fixation may well be a requirement for artistic works to the extent that the work for copyright purpose at least has to be static or accessible to some extent. Stokes, who has similarly referred to and analysed several of the same cases referred to by Derclaye, concludes that the current position is unclear.

While it appears at least from case law and the opinions of the above academics that permanence is not a requirement and that fixation may be a requirement for artistic works, underlying the debates surrounding the fixation of works and the issue of permanence lies the question of the fundamental nature of the works which are protectable under copyright law. In other words, what is the nature of artistic works? More specifically, is its physical or material form an integral part of an artistic work? Where literary and musical works are concerned, it is may be somewhat trite to state that it is clearly the novel or symphony that is protected not its printed material. But it is unclear if the same proposition extends equally to the visual arts. However, while the creative content of a novel can clearly be distinguished from its material fixation, i.e. the physical printed material, it does not also follow that a painting does not constitute the paint and canvas materials. It is proposed that a painting or a sculpture does constitute its physical material, and therefore if the physical painting or sculpture was destroyed, the painting or sculpture is clearly and certainly destroyed, a view which is discussed in more depth in the next section.

This is in contrast to the position taken by Davies and Garnett, who state (in relation to all types of copyright works, including artistic works): "First, it should be borne in mind that the integrity right is related to a copyright work, and a copyright work cannot itself be destroyed: it remains in existence even if the original embodiment or fixation of it is destroyed." The underlying reason for this bold statement appears in Copinger & Skone James on Copyright, in which the authors emphasise that copyright law's requirement for a material form should not be confused with a requirement that such form be permanent as the relevant work which is protected by copyright is an entirely separate entity from its physical material embodiment. The authors in Copinger & Skone James then conclude that: "Destruction of the material form in which the work was fixed does not destroy the work itself, nor the copyright which came into existence upon its being fixed." Hence, it would follow that destruction cannot breach the integrity right as the work cannot be destroyed.

In order to address the position articulated in Copinger and Skone James, it is first suggested that
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There is a difference between the protectable work for copyright purposes and the copyright protection afforded to works. In other words, it is argued that artistic works which can be protected under copyright law can be destroyed and further, just because a copyright protectable work is destroyed, it does not also necessarily mean that the protection that is afforded to the work by copyright is also destroyed. It would appear that academic debate on the issues of fixation, permanence, nature of copyright works and their destruction conflate the work which is protected under copyright with the protection itself. It is further argued that, as mentioned above, there is a difference between literary and musical works on the one hand and artistic works on the other. Generally, it is argued that literary and musical works are works which cannot be destroyed because of their abstract nature; the notation on printed paper merely represents them, and destroying the printed notation does not harm the work itself. However, it is further argued that this is not true of artistic works.

The question as to what happens to the copyright of a work when it is destroyed has been raised by legal academics,35 but it has not received much in-depth attention, despite the fact that it is not a question which has yet been afforded a definitive answer, hence we have very little literature on this issue. When this issue is raised however, it does appear that two different but related creatures are discussed: the "copyright work" or simply the "copyright" in the work. It is not always clear as to what exactly is at the heart of the issue, as academics have either asked if a copyright work may be destroyed, or as to what happens to copyright if a work is destroyed, and on occasion, as mentioned above, the two are conflated in discussions.

The issue is important where the integrity rights are concerned as legal academics have argued that because a "copyright work" cannot be destroyed, an artist cannot object to the destruction of his painting or sculpture, because the "copyright work" in his painting or sculpture survives the act of violence and continues to exist. However, it appears that the same academics have simply made the assumption that the work cannot be destroyed simply because copyright protects the creative content or core of a work. It is not at all certain that this is the logical conclusion, simply based on what copyright protects or chooses to protect. In other words, copyright law, according to these academics, appears to dictate its own ontology of art works, not on any logic or reason but by simply and only stating that because it protects the creative content of a work, be it literary, musical, dramatic or artistic, then even if the very last and only manifestation of the work is destroyed, the work in question is not. There must be more to this, indeed judging from the vast amount of literature generated by our art philosopher colleagues on this very question.

While the legal assumption may ring true for works like novels or symphonies where the printed paper or CD recording are obviously simply receptacles, there are ample valid arguments which stress that the paint strokes on a canvas or the carved marble are not simply receptacles, but are actually the art works themselves or at least are significant parts of the art works. The legal assumption cannot hold true for all works. Copyright law appears to have simply assumed and accepted that all works under its purview are abstract entities, without quite explaining why. It is the contention of this article that copyright law should not regard all works in the same manner, and that literary, dramatic and musical works are fundamentally different from artistic works and should be treated differently in this respect. In any case, it is also arguable that the canvas and its pigments or the marble that has been carved to form the sculpture are part of the creative content that copyright protects, a view which is discussed in the next section.

Pila, in discussing the requirement for the material fixation of copyright works, raised the issue of destruction, saying that "strictly speaking, if a work is constituted by its material form, destruction of that form will destroy the work, and consequently destroy its copyright as well",36 and hesitantly adds, "this, however, seems not to be so", relying on Lucas v Williams,37 which clarified that the existence of the material form of the work was a question of evidence, and that its absence would not necessarily defeat a claim of infringement. In a subsequent article,38 Pila points out that s.153(3) of the CDPA resolves this conundrum neatly as it provides that, if all of the qualification requirements of the act are satisfied, then "copyright does not cease to subsist by reason of any subsequent event". Two issues may be raised in relation to Pila's brief discussion of Lucas and s.153(3).

First, it is not certain that the destruction of a work will necessarily or consequently destroy copyright in any case, with or without relying on s.153(3). Section 153(3) simply confirms the nature of
copyright, and all its fundamental principles, i.e. when all the conditions are met, *copyright protection* arises and there is no reason why it should not continue to exist until its expiry, notwithstanding the destruction of a singularly unique painting or the one and only manuscript of a piano concerto. If a work has been created according to the accepted principles of copyright law, i.e. it is a literary, musical, dramatic or artistic work, and it has been fixed in some material form, and it meets all the formal qualification requirements (e.g. nationality of author or place of creation etc), then copyright protection arises. Why should *copyright protection* necessarily cease if the work has been destroyed or no longer exist in a physical form?

Secondly, Pila is right of course to say that the main practical role fixation plays is that of evidence, and that is the main import of *Lucas v Williams*. However, Pila relies on *Lucas* for the proposition that “artistic works are distinct from their material fixation, in which case paint ought not to be essential for the existence of a painting.” It is submitted that it is not clear that *Lucas* goes so far as to make this proposition or that such a proposition may necessarily be implied. It merely proposed that just because a physical copy of a painting was not available, it did not mean that *infringement* could not be proved.

In *Lucas*, as long as there was some other available evidence, in that case oral evidence by a witness who claimed to have seen the original painting, then that was sufficient evidence for an infringement claim. *Lucas* makes an important point for the law of evidence, and that is the main import of *Lucas v Williams*. However, Pila relies on *Lucas* for the proposition that “artistic works are distinct from their material fixation, in which case paint ought not to be essential for the existence of a painting.” It is submitted that it is not clear that *Lucas* goes so far as to make this proposition or that such a proposition may necessarily be implied. It merely proposed that just because a physical copy of a painting was not available, it did not mean that *infringement* could not be proved.

In *Lucas*, as long as there was some other available evidence, in that case oral evidence by a witness who claimed to have seen the original painting, then that was sufficient evidence for an infringement claim. *Lucas* makes an important point for the law of evidence, and that is the main import of *Lucas v Williams*. However, Pila relies on *Lucas* for the proposition that “artistic works are distinct from their material fixation, in which case paint ought not to be essential for the existence of a painting.” It is submitted that it is not clear that *Lucas* goes so far as to make this proposition or that such a proposition may necessarily be implied. It merely proposed that just because a physical copy of a painting was not available, it did not mean that *infringement* could not be proved.

The question that Pila asked is related but essentially different to that raised by Garnett and Davies, who, without making reference to s.153(3), contend in a more authoritative tone that a copyright *work* cannot itself be destroyed and “it remains in existence even if the original embodiment or fixation of it is destroyed”, on the basis that “a copyright work and the first physical embodiment of it are not the same things.” To an extent, as already pointed out above, this point can be appreciated, particularly of literary and musical works where the destruction of the first manuscript of a novel or a symphony would not destroy the novel or symphony itself. The protectable core of the novel or symphony lies arguably in their content, not in the printed strokes of their manuscripts or copies thereof. However, and this is a point which Garnett and Davies admit as much, it is difficult to say the same of artistic works which exist as unique singular works because of their aesthetic value, although they still maintain that the point nevertheless applies to artistic works without explaining why.

The language of Garnett and Davies refers to “work”, while both Pila and s.153(3) refer more specifically to simply “copyright”. Indeed, as already pointed out above, the judges in *Lucas v Williams* were making a point about *infringement*, i.e. copyright protection of the work, saying that copyright can still be infringed even in the absence of the work itself. *Lucas* did not refer to the *work*, but to *copyright protection*. What appears to be asserted according to s.153(3) and *Lucas* is that *copyright protection* remains whatever happens to the work itself. It does not necessarily mean that the “copyright work” remains in existence, whatever “copyright work” means.

The next question that arises is whether artistic works are truly distinct from their physical form, which is considered next.

Is the Physical Embodiment of an Artistic Work Material to its Existence?

Other law academics have focused more on the apparent distinction between the artistic work and its physical existence. Waisman, in discussing the integrity right, reiterates and extends the view held by Garnett and Davies, that the work protected by copyright and its physical embodiment are not the same thing, and that an artistic work, once created, remains in existence at least conceptually and in the public’s perception, despite the destruction of its physical state. Liu argues that even where it is difficult to distinguish between a work and its physical embodiment, especially in the case of sculptures, it is nevertheless still possible to draw a distinction, and hence destruction of the physical embodiment does not destroy the work itself.

The arguments by Liu and Waisman, while persuasive, fail to take into account the idea that the physical structure of an artwork is an integral part,
and that both its physical and conceptual aspects are inseparable, which is prima facie almost certainly the case for sculptures at least, and arguably the case for paintings. They also fail to appreciate that the original creation will be lost to future generations who would benefit from encountering the work in its original entirety not only on the basis first, that the original has incalculable social or historical value, but also secondly, as will be explained below, that the experience of encountering the original work cannot be replicated in encounters with mere copies.

It is intended to take issue with the above arguments primarily on the premise that the physical matter i.e. the paint and canvas and other materials, takes on a fundamental and necessary role in the creation of an artistic work, and forms the copyright protectable creative content. The purely immaterial element cannot function, on its own, as the entire artistic work. Prints and postcards merely depict the subject matter of an oil painting but are ineffective in representing the nuances conveyed by the roughness and texture of the individual brushstrokes. Ultimately, it is maintained that the conceptual and physical aspects of an artistic work should not be treated separately, and that destruction of the original physical support does destroy the artistic work for the purposes of moral rights.

In support of his argument that the material and immaterial of art are completely separate, Liu quotes from Iris Murdoch and Bindman, an art historian. In the selected quote, Murdoch opines that a work of art is not a material object, although in the same quoted passage, she does accept that, at least to some extent, the relation between material object and the art object seems close, especially so for sculptures. The statement does not conclude that the material and art are incontrovertibly distinct and separate. It could therefore be argued that the relationship between material and art is close or at least remains debatable.

It should, however, be noted that shortly after the quoted passage, Murdoch does go on to say that:

> The accessible existence of art, its ability to hang luminously in human minds at certain times, depends traditionally upon an external being, a fairly precise and fixed sensory notation or “body”, an authority to which the client intermittently submits himself. If this notation is or becomes unavailable the work of art is lost: the picture is burnt, no reproduction does it justice.

In the quote relied upon by Liu, Bindman observed that there was a tendency among neoclassical artists to “disdain material as being of lesser importance than the idea”. His statement essentially described the neoclassical sculptors who regarded material as secondary to the idea behind a sculpture. It is noted that the statement is made in relation specifically to neoclassical sculptors. At first glance, therefore, it can be said that this chosen statement of Bindman’s, is not necessarily of universal application.

Liu poses the example of creating the same sculpture in different materials: wood, bronze and marble. In other words, the posture of the figure and all other details are exactly the same in all three products. They differ only in relation to the material used. Liu says that the same statue may be made in any of these materials. The destruction of the wooden sculpture, he argues, will not destroy the work of sculpture, only the physical wooden embodiment of the sculpture is destroyed. The same goes for the sculpture in bronze or marble. Read together with the quoted statement of Bindman’s, it is clear that Liu’s argument, supported by the selected quotes by Murdoch and Bindman, implies that the material is not important.

It is submitted that there are two closely related arguments which may be levied against Liu’s conclusion. First, it is clear that there are fundamental differences between the natural properties or make up of wood, bronze and marble, and hence it is arguable that these differences would result in different characteristics in the sculptures, making each sculpture a unique work of art, even if the composition is exactly the same for all three. In other words, the sculptures in wood, bronze and marble are all different works of art. John Rood, a specialist in wood sculptures, illustrated the difference by way of an example: “What would you do if you wished to make a figure of Daniel Boone? Would you choose bronze or stone as your material? Do you think either would be as suitable as wood? Obviously not.”

Further, according to Rood, the difference does not stop there. There is even a difference between the different types of wood and sculptors would choose from the different varieties of oak, walnut, cherry, apple, cedar and the like.

Secondly, it is contended that the physical medium is important in terms of the artistic choice made by the artist, and it plays a fundamental part in the artwork. The artist’s choice of wood, bronze or
marble is not random, but purposive. This view is endorsed by Alec Miller, a master sculptor active during the Arts and Crafts movement at the turn of the 20th century, who explained: "Wood as a medium for portraiture has many conspicuous qualities. It has a warmth and richness of surface beside which marble and stone seem cold and unsympathetic."

The natural characteristics of each material contribute meaningfully to the resulting artwork.

The importance of the medium cannot be dismissed so lightly. For instance, John Dilworth, in his article "Medium, Subject-Matter and Representation", discusses the relationship between an art medium and ideas, and generally theorises that the medium plays a functional role in the artwork, as an expression of the artist’s commentary on the subject-matter. It may be distinct from the subject-matter of a painting, but it is no less important, and it is an integral part of the work of art as a whole.

The importance of medium can also be discerned from the language employed in Professor James Elkins’ book What Painting Is, in which he discusses the act of painting, and the "kinds of thought that are taken to be embedded in paint itself". He exhorts that every painting captures “a certain resistance of paint, a prodding gesture of the brush”, and that paint "records the most delicate gesture and the most tense". Elkins explains that:

"Paint is a cast made of the painter’s movements, a portrait of the painter’s body and thoughts. Painting is an unspoken and largely recognised dialogue, where paint speaks silently in masses and colours and the artist responds in moods. All those meanings are intact in the paintings that hang in museums: they preserve the memory of the tired bodies that made them, the quick jabs, the exhausted truces, the careful nourishing gestures."

The medium thus is not necessarily devoid of meaning, or a role in an artwork, whether it serves as commentary on the subject-matter or as a reflection of the painter’s moods and thoughts. A painter’s choice of watercolour or oil or acrylic for a painting is not made randomly. The thick and slick surface of an oil painting differs considerably from the thin and washed out appearance of a watercolour. The choice of medium is made to evoke a certain aesthetic experience on the part of the beholder. According to John Dewey: "Each art has its own medium and that medium is especially fitted for one kind communication. Each medium says something that cannot be uttered as well or as completely in any other tongue." The physical manifestations of these different mediums thus play an integral part of the work as a whole.

Furthermore, the impact on the viewer of simply the sheer size of some great artworks, Monet’s large scale Water Lilies series, for instance, cannot be reproduced in art books, prints or catalogues – nothing can reproduce the experience of being in the actual presence of the originals. If they are destroyed, this unique artistic experience is also lost forever. In relation to art that is destroyed, as quoted above and to reiterate it here, Murdoch has said that “no reproduction does it justice”.

Turning to Waisman’s arguments as outlined above, they are based on the simple proposition that if we accept that the destruction of a reproduction clearly does not destroy the artistic work, likewise we should accept that destruction of the original canvas which houses the work should not destroy the work itself. He uses the example of mass produced postcard reproductions of paintings, saying that there should be no difference between the destruction of a postcard copy of Picasso’s Guernica and the actual original canvas, because “the work as original expression exists independently from the material support that embodies it; that is precisely why works protected by copyright are a form of intellectual property.”

He observes that destroying the postcard would not destroy Guernica but however goes on to argue that if the destruction of the postcard does not destroy Guernica, why should the destruction of the original canvas do so? He develops this point by also citing the example of a U2 fan who breaks her CD of U2’s songs, and points out that obviously breaking the CD does not destroy U2’s works.

There are several problems with Waisman’s argument and the examples he has used in support. The first is that he has not actually explained why there is no difference between the destruction of a postcard and that of the original canvas. Indeed, he simply says “… there are no reasons why the conclusion should be different if the destroyed support is not a postcard but the canvas painted by the author’s hand.” While Waisman has not only ignored the vast body of literature which question the aesthetic value of copies and debate the ontology of art, he has also ignored the reality of such a scenario. While we would be rather indifferent to the thought of someone ripping up his postcard copy of Guernica, we would be rather
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The question as to whether copies have the same aesthetic value as the original has vexed art philosophers. In essence, the question is dependent on how aesthetic value is assessed, and whether the aesthetic value of an artwork survives its destruction in the form of mass-produced copies. This will be considered further below when discussing the views of art philosophers. It is contended that there is a difference between destroying a postcard and destroying the original. At the very least, considering the sheer importance, value and indispensability of the original physical embodiment to the artwork, it is arguable that to destroy the original physical embodiment of a work of art would destroy the work itself.

Waisman goes on to explain that “the previous example [i.e. the hypothetical destruction of Guernica| shows that at least one of the ways of altering the physical support, destruction, does not fully extend to a work and thereby cannot be considered an alteration of a work.”63 Turning to this point that destruction does not amount to alteration of the work, Waisman’s statement was made in the context of his main contention, which is that the infringement of the integrity right lies not so much in the altering or modifying act in question itself than in the effect of the act carried out.64 His article endeavours to point out that if the purpose of the integrity right is to be correctly realised, not all modifications can be considered an infringement. In fulfilment of this endeavour, he proposes a set of criteria by which all modifications may be assessed.

The key criterion appears to be the instant a particular modification of a work has also created a modified perception in the beholder’s mind. In other words, just because a work has been tinkered with is not good enough to constitute infringement. The point is whether it has also created a different perception in the public’s mind.65 This criterion fulfils the additional requirement that an infringing modification to the creation harms the reputation of the creator.66 As the creator’s reputation is dependent on how the public perceives his work, then Waisman’s proposal that we have to ascertain if the perception of the beholder is also necessarily altered by the act in question would certainly serve this additional requirement. Therefore, to Waisman, since destruction of the physical support or embodiment of a work of art would not alter the perception that the public already possesses of the work, it may not harm the reputation of the creator, and hence does not amount to infringement of the integrity right.

horrified at the thought of the original Guernica meeting the same fate. It is a reality that cannot be ignored and must be confronted in any discussion of the law which affects creators and their works of art. In response to Waisman’s statement, obviously there are reasons why the conclusion should be different, which reasons he has not explored in any depth.

Indeed, it appears that Waisman’s only reasoning is that: “The work as original expression exists independently from the material support that embodies it; that is precisely why works protect by copyright are a form of intellectual property.” Waisman does not explain how he rationalises that a work exists independently from its material support except to say that this is why such works are a form of intellectual property. Again, as we have seen above in discussing the approach of other law academics on this issue, there is a propensity to draw such conclusions merely on the basis of what intellectual property law, or more particularly, copyright law protects or seeks to protect, rather than a more exhaustive and objective enquiry into the issue. The issue of whether the destruction of the original canvas destroys the work of art itself is a query which is not unique to the law, and is one which has to be comprehended not only at a metaphysical level but also as an appreciation of how we ordinarily regard works of art in reality.

Further, there are a myriad of reasons as to why the U2 CD example does not lend support to Waisman’s point that destroying an original canvas does not destroy the work itself. A CD is a recording, which is the result of a technological process operated by a sound engineer. The production of a CD is not even a step in the process of creating any of U2’s songs. It is not an essential step in the creation at all. In this regard, the CD is purely and clearly a mere receptacle or device for the performance of U2 songs. In contrast, the canvas on which Picasso worked was necessary in expressing Guernica. There is at least a case for arguing that the canvas is an integral part of the work and that destroying the canvas would destroy the work, whereas none discernibly exists for the CD. This example in fact serves to highlight the fundamental difference between the nature of works such as music and literature, which are presented in mere receptacles such as CDs, and that of works like paintings and sculptures, whose physical embodiments are an integral part of their being.
Waisman’s point regarding destruction firstly presupposes that the perception of the original work has been widely held in the public’s eye at large, and secondly, ignores the points already made above, i.e. that we ordinarily accept the physical embodiment as part and parcel of the work of art. It also places much emphasis on the additional requirement of reputation. It is contended that first of all, reputation can be harmed by destruction. One reason is that, according to art historian, Albert Elsen: “Even a lost work’s survival by the best reproduction diminishes the artist’s reputation because the serious judgment of quality depends on confrontation with the work itself.” Secondly, even if it is thought that reputation may not be harmed by destruction, there still remains the additional requirement of honour, which may be harmed by destruction.

The Perspective from Art Philosophy

As already identified above, the questions concerning the ontology of art which have vexed philosophers are highly relevant at least to the questions concerning art’s status in the realm of copyright law. Amie Thomasson has identified the very real and practical reasons for caring about such issues. She has correctly observed that such theories of art have implications in practical problems experienced in various activities such as the curation or restoration of art, or in trading or collecting art. Thomasson has identified certain practical problems which may be served by asking the sort of questions which metaphysicians ask. It is contended that the problems she has identified also involve issues of law. For instance, she has identified the problem of the extent to which a painting is considered altered or destroyed, if at all, by restoration, which not only involves ontological issues but also moral rights doctrine. Another is the problem of establishing the conditions which determine if a new song is the same as an old one, which involves not only ontological issues but also, it is contended here, copyright infringement issues.

The present legal problem identified in this article itself clearly entails issues of copyright protection, moral rights and ontology. Out of necessity, such questions are regularly resolved in some fashion in the law courts, but usually without reference to art theory. As such, this article advocates that copyright law may benefit from considering art theory in depth, and in this particular instance, theories concerning the ontological status of art. However, this article similarly cautions that the question is an extraordinarily difficult one, one which has attracted an astonishing variety of different theories. Bearing this in mind, this article attempts to very briefly survey the major competing theories, before extracting the theory or theories which will serve the purposes of copyright law best.

Theorists fall into roughly two camps when concerned with the ontology of art. While some contend that all works of art are purely abstract entities or activities, others make a distinction between works like music, literature and drama on the one hand, and singular pieces like paintings and non-cast sculptures. This article aligns itself primarily with the latter view, and ultimately will depend on Thomasson’s observation that the problem with current theories is that they conflict with common sense views of art.

Chief among the proponents that works of art are purely abstract entities is RG Collingwood, who argues that works of art are not physical entities at all, but are purely the imaginative experience of the artist. To him, the canvas with its pigments and sounds which emit from the orchestra are merely the means by which artists reconstruct their imaginary experience. As such, since essentially the work of art exists only in the mind of its artist, it cannot be destroyed. Likewise, presumably if it is purely abstract, the work cannot be bought or sold, performed or read either, which are the sort of activities that we ordinarily indulge in.

Similarly, Gregory Currie claims that all works are abstract entities, each capable of multiple instances. The canvas or the musical score are not works of art, but instead the work is the taken in producing the canvas or the musical score. His account directly counters that of Wollheim who theorises that paintings and non-cast sculptures are physical entities while works of literature and music are types, of which their copies or performances are tokens. Currie rejects the view that “singular” works of art such as paintings and non-cast sculptures are aesthetically privileged by arguing that their reproductions, if molecule for molecule exactly the same as that of the original, are just as aesthetically valuable. As such, according to Currie, paintings and sculptures are not “singular” works as is commonly perceived, and that although we treat them as such, it is possible that we are mistaken about this.

Levinson, in his review of Currie’s work, argues first against the contention that works of art are mere action types, saying that appreciators of
artworks, appreciate the end result, not just the work or activity that has gone into the production of the work. We appreciate or experience art as the physical object or sensory experience that they clearly are. “In art we primarily appreciate the product [author’s emphasis], viewed in its context of production; we don’t primarily appreciate the activity of production, as readable from the product.” Levinson is not saying that we do not appreciate the activity that has gone into a work, but rather he is saying that Currie has got it back to front. We appreciate the product first and foremost. That Levinson is conscious that appreciators also appreciate the activity behind a work is borne out in his argument against Currie’s view that true copies are just as aesthetically valuable as the original, saying that mechanical copies are not substitutes for the original as they do not convey the artist’s unique achievement. The actual manner of production of a work of art plays a vital and important role in how we appreciate that work of art. “The original canvas is a unique repository of the painter’s achievement; indiscernible canvases produced otherwise are not. An original painting puts one in more intimate contact with the artist’s manual action than a copy produced from it even by a counterfactually reliable method can do.”

Dutton echoes a similar view, saying that we celebrate original works because we celebrate what the artist can do, his achievements, skill and creativity. Armed with the extra knowledge that the work in front of us is a copy or forgery changes our perception and appraisal of the work, not because of snobbery or elitism, but because we admire extraordinary displays of skill, which give us an elevated sense of pleasure. According to Wight, Adam Smith observed that “a great work of art commands a high price, but its exact duplicate commands only our disdain.” Thus, the original painting or work of art cannot be substituted by its copy, no matter how technologically perfect a copy, which in turn suggests the singularity in the nature of such works.

Instead of attempting to put forward a unified theory on the ontology of art, accounting for all of the different arts, Wollheim and Wolterstorf have sought to distinguish between paintings and non-cast sculptures on the one hand and the other arts, such as music and literature, on the other. Essentially paintings and sculptures are physical entities while literature and music are not, and therefore can outlast the destruction of any of their copies or performance. Thomasson takes issue with all of these theories, reminding us of how we ordinarily conceive the arts. She observes that where paintings and sculptures are concerned in particular, people ordinarily treat them as individual entities and identify them with the originals, not their copies. These original entities are bought, sold, and moved physically, and are also capable of being destroyed. In contrast, works of music and literature are conceived differently, that they survive the destruction of their original manuscript, but subject to Thomasson’s caveat that it survives only as long as a copy of it remains.

The main point is that Thomasson has correctly observed a divergence in how different types of works of art are treated and that therefore there is a possibility that they may not all be of the same ontological type at all. Further, she observes that all the major theories on the ontology of art have serious conflicts with our commonsense and ordinary beliefs and practice of the arts. Her conclusion is that “consistency with such beliefs and practices is the main criterion of success for a theory of the ontology of works of art.” According to Thomasson, any theory which purports to describe the arts, but also violates or conflicts drastically with our everyday beliefs and practices, may not actually be describing our works of art at all.

Where paintings and sculptures are concerned, Thomasson, taking into account our everyday practices and beliefs, argue that they are essentially physical objects but ones which come into existence through human intention. They are not purely “imaginary objects or abstracta, they are perceptible, are materially constituted by certain physical objects, and may be destroyed if their constituting base is [author’s emphasis].” The fact that Thomasson, in making the above meaningful observation, had taken into account our everyday practices and beliefs, suggests that her approach, more so than those of the other major philosophers, is eminently apposite for the purposes of copyright law. It has to be remembered that it is also Thomasson who understands that the ontology of art has a profound bearing and application in our everyday engagement with the arts, not least, the engagement too of the law with the arts.

Summary and Conclusion

The initial question posed in this article was whether the integrity right encompasses a right to object to destruction. In seeking answers to this
question, it has been necessary to ascertain the question as to whether an artistic work is destroyed when its physical embodiment is destroyed. Current conventional copyright scholarship suggests that the artistic work, at least for copyright protection purposes, is not so destroyed even though its physical embodiment is. Hence, according to Garnett and Davies in Moral Rights, this prima facie undermines any basis for having a right to object to destruction. This approach however goes against the grain of our ordinary and conventional beliefs and practices: if the painting which is exhibited in the Louvre and known to the world as the Mona Lisa is burned to ashes, then the world would surely mourn the irreplaceable loss of one of its greatest masterpieces; we are unlikely to accept that the work still exists.

Further, copyright scholars appear to have conflated copyright protection with that of the work that is protected by copyright. The UK CDPA simply states that an eligible work qualifies for copyright protection upon meeting certain requirements and that copyright shall not cease to subsist by reason of any subsequent event. What is certain is that according to the CDPA, copyright protection does not cease to subsist but that is all it is saying. Copyright law is otherwise silent on the existence of works which are protected by copyright. The fact that an original work is destroyed brings nothing to bear on whether its copyright can be enforced.

Further, other copyright scholars have argued that the physical embodiment of an artistic work is immaterial, and that therefore its destruction does not affect the existence of the artistic work. This article has argued, in reliance on the views of artists and art scholars alike, that the physical medium of a work is a vitally important and integral part of its whole.

More fundamentally, copyright scholars appear to have very readily accepted, without more, the continued existence of artistic works in the event of their destruction, a query of metaphysics which requires much more in-depth debate. Their stance reflects the stance of some of the major philosophers in the arena, Collingwood and Currie for instance, who have theorised that all works of art, including singular ones like paintings and sculptures, are essentially abstract entities. However, in contrast, Wolterstorff and Wollheim have established elementary differences between music and literature on the one hand, and paintings and sculptures on the other, essentially viewing the latter as physical entities, which can be destroyed. The point is that the major philosophers engaged in this ontological debate on the arts have themselves struggled with question of the nature of art, and it behoves copyright scholars to similarly engage in such debate or at least take cognisance of these theories.

However, the most crucial point of this article is that ultimately there is a difference between the purpose of the law and that of philosophy. Although the premise of this article is to urge a more exhaustive, less superficial approach on the part of copyright lawyers to the question of artistic works and its existence, and to be receptive to established theories in metaphysics, it must always be borne in mind that the law bears upon real life problems and issues. It has a real influence and effect on art, artists and other players in the art world. The task then for copyright lawyers is to seek out theoretical underpinnings which do not detract too far from our commonsense beliefs and practices.

In this regard, the observation by Thomasson that theories which conflict too violently with our commonsense beliefs and practices must necessarily fail in their goal of describing the arts accurately and completely is instructive for copyright lawyers. Among the theories which she has identified as diverging too far from our ordinary beliefs are those which envisage the singular arts as purely abstract entities which cannot be destroyed. Copyright law’s apparent treatment of artistic works, especially those of a singular nature, as abstract works which cannot be destroyed is at variance with how we ordinarily treat such works.

There is a further and final point that this article makes. This article has made the point that it is not only instructive but also imperative that copyright lawyers look to beyond the law for inspiration and other viewpoints which are relevant to the difficult issues they face. The issue in the present article is whether a work of art can be destroyed, which in turn will affect the issue as to whether or not artists should have the right to object to the destruction of their work. This, in turn, calls into question the underlying ethos of copyright law and moral rights doctrine. By merely accepting that the work of art is divorced from its canvas or marble block, and that it therefore cannot be destroyed, copyright law not only ignores the reality of our ordinary practices as argued above, but also fails to give proper consideration to what the singular nature of certain works of art ultimately represents.
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Wasiman has implied that there is no difference in the burning of a postcard and that of the original canvas. Currie argues that there is no difference in aesthetic value between that of an exact copy and that of the original, hence underlining his main contention that all arts, including paintings and sculptures, are abstract entities which cannot be destroyed. However, it was Dutton who has argued passionately that the reason we react differently to mere copies or forgeries is because we regard the original work as something quite special and unique, and that it has a human origin which a copy does not, and hence has an aesthetic value which no copy will ever have. Although Dutton’s thesis was in relation to the problem of forgeries and copies, the point he makes about how we appreciate works of art is also relevant here: “Every work of art is an artefact, the product of human skills and techniques”. Further, in articulating exactly that which the original possesses but a forgery or copy lacks, Jenkins states:

“There is another more cognitive meaning of originality involving creativity which involves a unique idea and the execution of that idea. This is a working out of a solution to a particular problem that belongs only to that person at that particular time in the sense that only they can do it, and is a creative act.”

Dutton and Jenkins have each identified the goal of copyright law and its related doctrine of moral rights. The law serves to acknowledge and protect the product of human creativity, endeavours and achievement. The original canvas of *Guernica*, which is the unique product of Picasso’s skills and techniques, is the work *Guernica* which we all admire today. We cannot divorce the canvas from *Guernica* nor the marble block from *David*. Destroying either canvas or marble will destroy precious works of art. Perhaps it is time that the law recognises and, more importantly, protects against such losses.

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3 As noted by Stina Tellmann, “Framing the law: the right of integrity in Britain” (2005) 27 European Intellectual Property Review, 19.

4 The four rights are the Paternity Right, Integrity Right, False Attribution Right and Privacy Right.

5 CDPA 1988, s. 80.


7 Davies and Garnett (n 6) para 8-023, 242.

8 The author deals with this issue in an article, *Author and Citation details omitted* Oxford Journal of Legal Studies, forthcoming 2016.

9 CDPA, s.1(1).

10 Davies and Garnett (n 6) para 8-023, 241.

11 ibid.

12 Most jurisdictions, including the civil law countries like France and Germany, either clearly lack any explicit legislative or judicial recognition of the right to object to destruction or display ambiguity in the recognition of such a right.

13 Copyright Act 1968 (Cth), s.195AK.


18 Henioh v Ratsabwhite (1976) AC 64, 94-95.


23 Tate v Fulbrook (1908) 1 KB 821; Tate v Thomas (1921) 1 Ch 503; Green v Broadcasting Corporation of New Zealand [1989] RPC 706.

24 CDPA, s.178.


26 Caddick, Davies and Harbottle (n 22), 3-110.


28 As indeed, the question of permanence itself is questionable as nothing can really ever be said to be truly permanent, a view expressed in Hector MacQueen and others, *Contemporary Intellectual
Since then, there have been 70 profiles published, 38 of them written by me. From 2004, I intentionally restrained myself from the compulsion to hog the profile section of the journal, when I assumed the post as editor of the journal. I would like to acknowledge the contributions by many of the other profilers, especially his Honour Jeremy Curthoys and Sydney barrister Andrew Fox.

The task of choosing a limited, select number of my profiles to parade, especially from such an illustrious line-up, has been akin to walking a proverbial diplomatic tightrope, not wishing to cause offence to those not mentioned. In the end, due to the constraints of time, I had little choice but to cull – brutally and regrettably – many leading figures from the judiciary, private practice, academia, the arts and the sciences whom I have had the privilege of profiling. Each of my chosen subjects has something of particular value and insight to say about the evolution of intellectual property principles, procedure and practice (past, present and the projected future) in Australia and abroad.

Dare I make, however, perhaps an injudicious admission at the outset, in that I intend to put the initial spotlight on my two personal “standout performers” (having interviewed both of them on two separate occasions:– Justice Annabelle Bennett of the Federal Court of Australia (first, as a leading silk, then later as a judge), and Former Justice Michael Kirby of the High Court of Australia (first, as a judge, then as a retired judge, but a still remarkably active and publicly engaged man).

Essentially, this presentation takes the shape and form of an historical narrative, but for the most part, in the interests of fairness and absolute accuracy I quote *ad verbatim* the answers by the respective subjects to my questions from their profiles.

Before I turn to the IP luminaries and their hobbies horses, I must confess that there have been a few “mistrials” along the way in my forensic cross-examination from the editor’s bar table. Two in particular spring to mind, which offer two different kinds of cautionary tales for any future profilers for the journal.

**Mistrial One – Kamil Idris**

In mid-2000, I was flown to Sydney courtesy of IPSANZ to meet with Kamil Idris, the then Director General of WIPO. He was in town to attend a regional symposium jointly hosted by IP Australia and WIPO at Manly. After his session, I interviewed him in his suite. All in all, the interview was an absolute catastrophe. As his two henchmen stood impassively and rather ominously by his side, I felt myself slowly drowning. With his heavy Sudanese accent, I could only understand every second word of his answers, not that it really mattered, as he “diplomatically” fudged each of my key questions. I went away forlorn, and hopped in a taxi to the Sydney CBD to interview my double subject for the day, Dr Annabelle Bennett SC (as she then was) in her Chambers.

When I returned to Melbourne, a little more heartened by a very cordial and informative interview with Annabelle Bennett, I played back the tape of my interview with the WIPO Director General with some trepidation. What was a feared disaster at Manly turned into an even greater disaster than I could have imagined. The tape was totally inaudible. What to do? This could prove to be an acute embarrassment. I could hardly ask for a repeat performance, not that I was terribly minded to do so anyway. Suddenly, I had brainwave. I knew that the then Assistant Director General and Legal Counsel (now the Director General) of WIPO Dr Francis Gurry, who had accompanied him to the Manly conference, was an ex-Melbournian, although now based in Geneva. A few days later, I rang him and explained the situation. He took pity on me, and agreed to a telephone interview to fill the WIPO gap. In short, he saved my hide!
As fate may have had it, in the end perhaps I was spared by the ordeal. Some years later, a report, carried out by WIPO’s Internal Audit and Oversight Division at the request of the United Nations Joint Inspection Unit which was subsequently leaked to journalists, concluded that Kamil Idris repeatedly misrepresented his age. The report stated “that Idris sought to change his records at WIPO to show that he was born on August 26, 1954, despite signing numerous earlier documents showing his date of birth as August 26, 1945”.

About that time, the Secretariat of the WIPO published “a note provid[ing] clarifications pertaining to a series of reported allegations and rumours concerning the Organisation and its Director General”. Kamil Idris stepped down a year early from his post of head of WIPO, agreeing to resign under pressure from Western countries. In his place, Dr Francis Gurry was promoted to the position, which he continues to hold. Age discrepancies and allegations of a shady past to one side, I shudder in hindsight to contemplate the veracity of the content of our interview, even if I had understood what he was saying.

Caution Tale 1: Choose your subject carefully, no matter how high up the office holder may be!

Mistrial Two – Justice Annabelle Bennett

In 2008, I interviewed Justice Annabelle Bennett in her Sydney Chambers. Upon returning home, I replayed the tape, to hear only the muffling of our voices. Again, it was virtually inaudible. I panicked. What to do? I had committed to the Profile, and I needed the product. There was only one solution. Finally, I picked up the phone and rang her Honour. As it happens, her Honour was rather nonchalant and not the least bit flustered, and so we arranged for another time to meet the following week.

I do recall that when I did return to her Chambers that next week, I rather sheepishly walked in and sat down. Her Honour smiled, but immediately eyed the new tape recorder which I had since bought for added insurance. “Is that the beast?” she asked. “Yes,” I almost whimpered. “Delivery-up, please!” she said. Handing it to her, in rather pathetic mitigation, I pleaded: “Your Honour, I did go out and buy a new one, and it is fitted with new batteries.” For a few minutes, she inspected it, employing the rigorous scientific skills that she must have acquired from her previous life, even unloading the batteries, then reloading them. Once satisfied, she handed it back to me and pronounced, “OK. Looks safe enough. Let’s roll again”.

Caution Tale 2: Come well-armed with trustworthy equipment, especially a working dictaphone with charged batteries!

I now turn to my chosen IP luminaries and their hobby horses.

IP Luminaries and their Hobby Horses

The Honourable Justice Annabelle Bennett AO

Justice Annabelle Bennett came to the law, after gaining a PhD from the University of Sydney on the nature and role of phospholipids in spermatozoa. I first interviewed her for the September 2000 issue of the journal. I first asked Dr Bennett SC (as she then was) what she identified as the main handicaps in Australia’s commercialisation of biotechnology?

A: In a nutshell, it’s a meeting of money and research. My own view is that a lot of researchers now appreciate the benefits of the commercialisation of their research. That’s a fairly new thing across the board. There are still huge areas where people are not IP conscious; yet IP remains the linchpin of the ability to commercialise. There are a lot of people out there with money to invest, but a lot of those people are frightened off by biotech because they do not necessarily understand what it is that is being sought to be commercialised. They don’t understand the technology. The philosophy I have is that it’s very easy for people to understand the concept of a new company called “frontdoors.com”, in other words a company set up to sell front doors, but it’s much harder for them to understand, first, the development of a biotechnological invention, and, secondly, the timeline involved in commercialisation, especially when it comes down to medical research.

On the subject of the protection of biotechnological inventions and procedures, with specific reference to genetic material, I asked her whether she shared the view that this whole area very much depends on what is meant by the term “genes”?

A: My own view is probably less philosophical and more pragmatic. For me, the bottom line is that the research in this area is very expensive. If you don’t provide patent protection for it, then it’s not going to be done. Governments are not going to pay to do it for nothing. I do believe that it is worth providing patent protection if it keeps the research in Australia. I would welcome specific statutory provisions dealing with
the patentability of genes and genetically modified organisms – in fact, everything to do with that aspect of biotechnology. Not wholly satisfied, I ventured further and put to her what of the argument that the subject matter of much genetic material is by way of discovery – that, as it is not an invention, it should not be patentable?

A: There are two approaches to that issue. There is the strictly legal approach and there is the pragmatic approach which, on a public policy basis, dictates that you have to provide patent protection otherwise the work will not be done. I know there are a lot of scientists who engage in the spirit of wanting to disseminate information and knowledge to the public. However, more and more they’ll find that they will not be given funding for their work unless that research is commercially exploitable.

Knowing of her love of patent law, I wondered whether as a legal regime for protecting biotechnological inventions, patent law is the best legal regime that we have. I asked how she saw other regimes such as designs or copyright as applicable forms of protection, or maybe even the creation of a sui generis regime. Her view was:

A: You might be able to get a sui generis regime – like the Plant Breeder’s Right Act. I have no problems if something were to develop within a statutory regime if that is within the power of the Commonwealth. But for the present, the patent regime is the most applicable we have in this area.

I was curious as to whether the issue of human cloning concerned her. Rather dryly, she responded:

A: I have a problem with the cloning of humans, were it scientifically possible. Scientifically, it is a wonderful idea if it could be done safely and rigorously. But I think it would be a shame if natural diversity were to be overridden by human cloning. I also find it an extraordinary concept that someone might think that he or she is so perfect that they deserve to be replicated in total.

Eight years later to the month, in September 2008, we met again (albeit on one aborted attempt followed by a productive session). I was interested to discern any changes in attitude or views since her elevation in 2003 to the Bench of the Federal Court of Australia.

I asked whether there have been moments when she has missed the “cut and thrust” of legal practice?

A: Of course! The two things that I miss are the camaraderie of the team approach to litigation where you have other people to bounce ideas off, and to put an argument together. I also miss the fact that at the end of a case the barrister can walk away from the matter with the feeling that one has done the job and now it is up to the judge.

I pushed with the issue of judicial office and wondered whether, when a case is over and she had to retreat to her Chambers in solitude, she looked forward to, even enjoyed, the process of writing the judgment?

A: I don’t think “enjoy” is quite the right word. Once one gets into a judgment there can be a certain “satisfaction” in working through the arguments and applying the relevant principles to the facts. Very rarely do cases run unless both sides really believe that they have a good argument. As such, very often there is seldom an obvious answer to the facts or legal issues in dispute in any given matter.

Did she agonise over cases? The answer was mixed:

A: Yes, but not every case. There are cases where there is not a clear “yes” or “no” answer. A good example is statutory construction where you can have a section which is ambiguous. You can see the meaning given by each side and you have to come down on one side or another. You can agonise over that. I find that cases keep me awake at night as much as they did when was at the Bar. I still do the 3am morning wake up with a thought going through my head about an answer to a particular aspect of a problem that has been worrying me.

Among my various profiles of the judiciary, the issue of solitariness has been a recurring theme.

In the words of Justice Bennett: “It is a solitary occupation – it can also be isolating to a degree”. In my more recent interview with Justice Susan Crennan (as she then was), I asked her how she found the initial transition from the frenetic and often unpredictable pace at the Bar to the rather more cocooned culture of the Bench? She replied:

A: I found it quite difficult at first. When I went on to the Federal Court, I discovered life as a barrister is very different from life as a judge. Unquestionably, life as a judge is a lot more isolated. What I missed the most was the companionship at the Bar, particularly of juniors assisting in a case. I certainly do not imply any complaints about the collegiality of the Bench.
The Honourable Michael Kirby AC, CMG

Michael Kirby is the longest serving judicial officer in Australia when he retired in 2009, having then served for 34 years was the youngest man appointed to federal judicial office in 1974, at the relatively tender age of 35. His career highlights include his appointment in 1975 as the foundation chairman of the Australian Law Reform Commission, in 1984 as President of the New South Wales Court of Appeal, and then from 1996-2009, as a Justice of the High Court of Australia.

My first profile of Justice Michael Kirby was for the June 2003 issue of the journal, when he was still a member of the Bench of the High Court of Australia.5

The Aktiebolaget case (2002) had been handed down by the Court in the previous year, so I thought this would be a good IP starting point. However, when I mentioned his (and McHugh J’s) dissent from the majority decision, he gently, if somewhat sternly, admonished me:

A: I want to make it clear that I am no opponent of intellectual property. On the contrary, the protection of scientific inventions is a human right. It is expressly mentioned in Mrs Roosevelt’s Universal Declaration of Human Rights. But, a balance has to be struck between the rights of access to information, the rights of public health care and the rights of intellectual property protection. It is a matter of one’s individual view as to where the balance should be struck. This, in turn, must be found by applying legal doctrine and principle to each case.

While I knew that he had not practised widely in intellectual property law, I also knew that he had a keen interest in The Human Genome Project, of translating the principle of the common heritage into effective content in IP law. So, I touched on this, to which he enthusiastically replied:

A: There are three important controversies in the field of the genome of relevance to the law.

The first relates to what we actually do in the technological field of genomics, out of which consequential questions like intellectual property protection arise. For example, do we by law forbid cloning or do we encourage these developments?

The second issue, perhaps not so significant for IP purposes, is the use of genetic data. The potential for discrimination in the use of genetic data is significant. There are many reasons for people to discriminate against others in insurance, employment, state social security as it is.

The third issue relates directly to intellectual property protection. In most developing countries, such as India, there is a strong feeling that intellectual property in the field of genomics is a new form of economic imperialism. In other words, the “common heritage of humanity”, as mentioned in the Universal Declaration of the Human Genome and Human Rights is (in effect) being “owned: for periods of time under intellectual property law by multinational corporations in the rich developed countries. The concern here is twofold. First, that it will add enormously to the costs of the tests and therapies when they are produced, and therefore effectively put them outside availability to developing countries and to their citizens. Secondly, and perhaps more fundamentally, that it will distort the focus of the human genome pharmaceutical developments more apt for the rich countries. In short, that the prevention of wrinkles will become more important than the prevention of malaria.

Ten years later, we met again in his Macquarie Street Chambers for a follow-up interview, this time without the trappings of judicial high office. It was on the afternoon of Melbourne Cup Day 2013, when I wrongly thought the whole nation stopped for that race.4 Not for Michael Kirby (nor for me) who was beavering away at his desk, occasionally heard to mutter: “Bah! Humbug!” In that interview, I unearthed many other projects that he had since undertaken and issues of concern to him relating to IP law since we last met; two in particular including his work for the UNDP Global Commission on HIV and the Law (which raises important intellectual property law-related issues), and his views on the proposed Trans-Pacific Partnership Agreement.

I put to him that the growing body of international trade law and the over-reach of IP protections, it is alleged, are impeding the fair production and distribution of low-cost generic pharmaceutical drugs. One of the recommendations in the recent United Nations Development Programme (UNDP) is that the World Trade Organisation must suspend the application of TRIPs as it relates to pharmaceutical products for lower to middle income countries. I asked him how realistic and achievable that may be? He replied:

A: I don’t think that the WTO is going to implement the recommendation of the UNDP Global Commission simply because the Global Commission had some very distinguished members such as the former President Fernando Henrique Cardoso of Brazil and my good self (laughs). It is therefore
necessary to set in train the steps that will lead to the reconciliation process that has not yet taken place between trade law designed essentially by trading nations to protect their interests and human rights law designed to protect the people of the world, including the most vulnerable.

The Report of the UNDP Commission arose in the context of the HIV epidemic. That epidemic has affected upwards of 35 million people who have been infected with HIV. At the beginning of this millennium, only about one million of the people infected had access to the antiretroviral drugs which were essential to their survival, to their work capacity and to enjoying a decent human life.

As a consequence of the intervention of the United Nations, and the creation of the Global Fund outside the United Nations, and also of initiatives by the President of the United States, the number of people on antiretroviral drugs has increased to more than 10 million people. But there are many millions more who could benefit from access to the antiretroviral drugs. Moreover, there is a special and urgent problem – namely that the original antiretroviral triple combination therapy is beginning to show its age such that the original drugs are not always effective for people who have been receiving them for a long time. They need to step up to the so-called "second-line" and "third-line" therapies. However, whereas the "first-line" therapies are now substantially out of patent, or can be the subject of generic copies in countries of need, the "second-line" and "third-line" therapies are not so easily susceptible to legal generic drugs. This is a stark indication of the conflict between the TRIPs Agreement and global intellectual property law and the urgent need of people in poorer countries to have access to pharmaceutical therapies that are literally essential to their lives, dignity and survival.

I then addressed the foreshadowed Trans-Pacific Partnership Agreement (TPPA), if it ever sees the light of day. I remarked that this proposed agreement has been described by some commentators as arguably the most important trade agreement in a generation. If implemented, it will cover two-fifths of the world's economy and one-third of interracial trade. Its negotiation has already taken several years. It has been attacked on several grounds – in particular, for its lack of transparency and lack of public consultation and input. Did he have any specific misgivings about the TPPA, particularly in that it appears to seek unprecedented access to the domestic markets of the 12 nation states, including their intellectual property rights? Further, as the TPPA is largely US driven, it did tend to attempt to imprint or impose US IP laws on the other nation states, which may well be a cause for some consternation. I asked him whether all this was a source of concern for him? He responded:

A: It is true that it is a controversial arrangement. It has been described by some of its critics as "NAFTA on Steroids" (that is, the "North American Free Trade Association on Steroids"), and as a corporate coup d'état which will undermine the sovereign laws of all the nations that are a party to it. I can see advantages in a free trade agreement that embraces such a range of countries in the Pacific. It is often said that the 21st century is going to be the century of the Pacific; and so, an early Trans-Pacific free trade agreement on proper terms would be beneficial. The fact that several of the countries around the Pacific are at different stages of economic development provides an opportunity for economic progress that would be positive.

The Economist newspaper recently strongly urged the leaders of the countries involved to endorse and ratify the TPPA. However, the lack of transparency is not just a procedural matter but is also a matter that affects the substance of the so-called partnership. It is the same flaw that existed in the Anti-Counterfeiting Trade Agreement attempted in 2011 but which came unstuck substantially because of suspicion and anxiety in the European Union about the secretive way that it had been negotiated. Where important arrangements are negotiated, it is completely legitimate that the citizens of the countries affected should be taken on the journey and not taken for a ride! They should be given the opportunity of understanding both the pluses and the minuses.

The story of free trade agreements has not been one of unalloyed advantage, including for countries such as Australia. The determination of the United States of America to defend its intellectual property is admirable on one level, but not necessarily in the best interests of the people of Australia. It may not be, for example, in the best interests of their national health schemes and the balances that are struck there between the universal human right of access to essential healthcare and the universal human right of protection of inventions and promotion of inventiveness is potentially at risk in the TPPA.

I will be watching with interest as to how this plays out. I will also be watching which Departments of State are leading the negotiations. If, as I suspect, those departments will be the National Treasury and/or the Department of Foreign Affairs, they may not be familiar with, or sympathetic to, the universal human
rights that can be put at risk by free trade agreements. This is important for Australia. But it is doubly important for some of the other countries around the edge of the Pacific that would be parties to the TPPA, if it were to be adopted. Indonesia, in particular, is one country that may not be fully protected in respect of its vulnerable population.

There may be overall advantages for a country, but if they surrender the TRIPs flexibilities that were hard fought for (and that have recently been extended to 2021 for the least developed countries), those overall advantages may mean that the universal human rights that are so necessary to human existence and, in the case of pharmaceuticals, to human survival and the right to life, are put at risk. Certainly, Australians should be fully informed of the negotiating compromises that have been reached and why they are advantageous to Australia and to other countries, specifically and relevantly in the matter of pharmaceutical pacts and the universal right to healthcare.

The Honourable William Gummow AC

In late 1998, I interviewed Justice William Gummow (as he then was) on the balcony of his Canberra Chambers, overlooking Lake Burley Griffin and the sprawling grounds of the High Court. Appointed to the Bench of the High Court in 1995, during his tenure he came to be regarded by many of his colleagues – rightly or wrongly – as the intellectual giant of the Court. As a pedagogue, he is of course well-known as the co-editor of Jacob’s Law of Trusts and Equity, Doctrines and Remedies, an authoritative and enduring work that reflects his love of the principles of equity.

To be frank, although his Honour was polite and hospitable, he was hardly forthcoming and I failed to extract much on the daily life as a High Court Justice. Circumspection ruled the day. Then again, in fairness such cautiousness by the highest judicial officers in the land is not uncommon. Of the three High Court Justices whom I have interviewed for the journal, only one was prepared to venture outside the judicial comfort zone.

Former Justice Gummow, however, did make one interesting point, when he confessed:

When I came on the bench Justice Lockhart said to me: “If you are in doubt about intervening and asking a question, just stay quiet.” And he was absolutely right. Judges who talk for the sake of talking are an enormous pest. But on the other hand, you’ve got to intervene to a certain extent.

I asked him whether, by and large, he thought that judges, not just those on the High Court, have become more interventionist in recent times? Here he was even more forthcoming:

A: Yes, I think so. Not always with the happiest results because there has not always been observance of Lockhart’s maxim. You have to bear in mind that parties do and don’t do things for very good reasons of their own which they cannot explain in open court. You have to respect that.

Here, I might add a related observation was made by Justice Bennett when I asked her whether it was ever appropriate for a judge to intervene in the course of a case. She, too, was equally candid:

A: It is a matter of balance. For instance, in migration cases, where the outcome is of such importance to the individual and the individual is often unrepresented, I think most judges end up looking at the matter for themselves and not treated strictly as adversarial litigation.

Generally speaking, for most judges, and certainly for myself, one does try to arrive at the right outcome or result. Sometimes that means thinking of an argument oneself or assisting in argument and putting that to counsel. There, however, one has to be very careful – not to do that on one’s own but to give the other side an opportunity to rebut the argument.

The Honourable Dr Kevin Lindgren AM, QC

I first met Justice Kevin Lindgren (as he then was) [appointed to the Bench of the Federal Court of Australia in 1994 until he retired in 2010], when we shared a platform at the Garma Festival 2003 in East Arnhem Land to speak on Indigenous communal moral rights. The former judge had a particular interest in copyright, especially in this area, as well as in native title claims. A short time after that event, the Copyright Amendment (Indigenous Communal Moral Rights) Bill 2003 was released. This was an important Bill to amend the Copyright Act to recognise and accommodate an important, long-neglected human right. I met with him in mid-2004 in his Sydney Chambers and, amongst other things, we discussed the proposed Bill. I had serious misgivings about the drafting and practical workings of the Bill, and asked him for his view:

A: I have looked at the Bill and there are a few aspects which I have found troublesome. (My question when we met again in 2004 for the Profile impliedly raised one of the fundamental issues on the subject, namely,
whether this is a matter appropriate for a copyright regime at all or whether it is akin to native title). Of course, the Bill is one to amend the Copyright Act, and the starting point is that there must be a copyright work under that Act. This then raises the problem of works of art, dance, rituals, songs and the like which are centuries old. They are not just "out of copyright": they preceded any copyright legislation.

A further issue is that the Bill requires that, as a condition of the recognition of Indigenous communal moral rights, there must be an "Indigenous moral rights agreement" between the author and the representative of the Indigenous community concerned. One might reasonably ask why that should be a requirement when, after all, the particular Indigenous community is going to have to prove that the copyright work draws on the particular body of traditions, observances, customs or beliefs held in common by that community. In other words, since the particular community is going to have to establish that element (perhaps not an easy matter), what is the point of giving the copyright owner the right to say, in effect: "Even if you can prove that I have drawn upon the particular traditions, observances, customs or beliefs of your community, I will stop you exercising any moral rights?" There may be a satisfactory answer but I don't know what it is.

The other point about the Bill that struck me as odd concerns the right of attribution. This is a right given to the community which has an association with the particular work. The conditions of the exercise of the right of attribution include a condition that the Indigenous community's association with the work is in fact already acknowledged in a manner satisfies s.195AZZL of the Act. There seems to be circularity here.

In summary, there are aspects of the Bill which I feel may leave some Indigenous people disappointed. The Bill proposes only a very limited set of rights and even they are dependent upon an agreement with the author.

Fortunately, the Bill, with its many defects, was never enacted. Unfortunately, however, Australia still does not recognise Indigenous communal moral rights.

**The Honourable Susan Crennan AC, QC**

I was fortunate to interview Justice Susan Crennan (as she then was) in her Sydney Chambers in late 2014, on the eve of her retirement from the Bench of the High Court of Australia. She was the first woman elected to the Chair of the Victorian Bar Council, the first female President of the Australian Bar Association; appointed a Federal Court Judge in 2004; then appointed as the second woman in history to the Bench of the High Court of Australia in 2005.

I was especially interested in her mildly controversial views on women in the law, so I put to her that clearly she has been a trail-blazer for women in the law, with her many "firsts", but that I understood that she somewhat eschewed those achievements as being "victories for women". In fact, in the past, she had expressed publicly strong views on affirmative action in the law and what she had called "the imperatives of biology". In fact, back in 1992, she was quoted as saying that "the problem with being a female barrister is that you don't have a wife". From her observations as a barrister and judge over a very long period, I asked her whether she had observed much advancement of the status and recognition of women in the law in Australia? Her answer was quite illuminating:

**A:** When I went to the Bar in New South Wales there were few women who had general practices. There were some who had focused on general advocacy but had not enjoyed the practices that they might have hoped for. What struck me most is the women who were the most successful were practitioners in criminal law and family law. So, being slightly contrary, I decided not to practise in those areas as I might find it hard to extricate myself from them.

The representation of women at the Bar has certainly improved, which is very good because it correlates with the percentage of women who are acquitting themselves extremely well in law degrees. However, the representation of women at the commercial Bar lags way behind, so something is going wrong in that aspect.

I asked her why she thought that to be the case. She continued:

**A:** I think that a possible cause (about which I have no empirical evidence), is that women have been given the opportunity to show their mettle in drafting advices and pleadings and the like, but when it comes to choosing someone to appear in a complex court matter, a client may take the view that, it being a combative profession, they would be better off briefing a young male rather than female barrister.

The point is that solicitors will brief a barrister who wins cases. Something must be happening so that women at an early stage are not being afforded the opportunity to demonstrate their capability. It is a very
complex problem, which still needs to be addressed. Even in the High Court, I found that generally speaking women were not as visible in leading advocacy roles except in public law and criminal cases.

Here, I insert a very brief remark on women in the law by Former Justice Catherine Branson of the Federal Court of Australia, whom I profiled in her Sydney Chambers in 2002.10 I asked her whether, as a judge, she was conscious that it was part of her role or duty to provide some form of hope or inspiration to younger female aspiring lawyers. Her reply was brief and a little unexpected:

A: Yes, I think most female judges are mindful of that expectation.

Returning to Former Justice Crennan, I also asked her where she thought the future challenges in IP law resided. She predicted:

A: I think a point floating in the ether these days is that stakeholders must have a convincing case about monopolies (laughs). In a way, you can go right back to the Tudor debates because, as you know, a patent for an invention was always an exception to the general reluctance to grant monopolies, and I think patents and copyright at the moment are both being subjected to a certain thinking – that monopolies are somehow bad, a bit old-fashioned and should be as short as possible. One strand of thinking, for example, in which this occurs is the view held that medicines should be widely available in certain countries unfettered by IP rights. There is some lack of interest in the counter-argument, namely that patent protection encourages the research that is required to combat many illnesses.

I invited her to identify the key intellectual property issues that she would like to see addressed, either by the Courts or by the legislature?

A: In relation to copyright, I think the copyleft movement in America is interesting. When I first read about it a year ago, I was shocked at the sustained attack on copyright theory. The whole point of copyright is to have a potential infringer pay royalties if they wish to legitimately use or exploit copyright matter in some form or manner.

As a short list, the future challenges are, as I see them: as to patents, I foresee a constant battle in relation to equity of access, particularly in the field of medicine; as to copyright, the continuing challenge of technology outstripping the conceptual framework; as to trade marks, I think that features such as colours, smells and the like might have heightened expectations that almost anything can be the subject of a trade mark.

Importantly, at the end of the day, you cannot easily solve the problem that technological developments can outstrip the concepts underpinning intellectual property protection. These are debates currently before the legislature. One example is the question of involving internet service providers requiring them to forward notices to copyright infringers, and therefore effectively acting in a policing role. I think that history has shown (as in the case of tape manufacturers) that if there is an activity that is technologically possible but which is also an IP infringement, if it is to retain its prohibited conduct it is necessary to police it, otherwise the law falls into disrepute.

So, I do think that constant technological changes challenge the traditional IP concepts.

Angela Bowne SC

In 2005, I interviewed Angela Bowne SC, former Associate to the late Former Justice Lionel Murphy and a highly respected IP Senior Counsel at the NSW Bar for the June issue of that year.11 Following on from Susan Crennan and Catherine Branson, Angela Bowne added her own reflections on fledgling women in the law, from her perspective as a seasoned IP barrister:

A: I gave a talk to a group of female law students in their final year at the University of New South Wales the other night. I spoke on “imagination” – of having a wider life than just legal practice. I stressed to them that there are many lawyers that have narrow lives and that formal legal training does not teach you about the real world of practice. They all nodded in unison. I talked about how, as a barrister, you need imagination in your practice, you have to work out strategies, to research, to persuade a judge to do something where there is no precedent to follow, to think up analogies to make it easier for others to understand what you are saying. There are so many avenues of imagination, and that is why I strongly believe fledgling lawyers should not confine themselves to black letter law. They need to expand their minds, to read history and literature, to go to the theatre, to be on charitable committees, to learn how to deal with people in the wider world.

She also jokingly reflected the general practice of IP law, when I asked her whether she found intellectual property, albeit an intellectually challenging, even creative corpus of law, to be a relatively “sanitised” form of legal practice, say as compared to other areas of law?

Smiling, she asked me: “What exactly do you mean by sanitised?”

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I elaborated: “Well, reasonably clean – where one is less likely to find oneself tainted by unpleasant subject matter and litigants.”

She laughed:

A: Well, it’s not that clean! Certainly over the years I have worked, for and against, some pretty strange characters – particularly in large scale piracy cases. It is hard to generalise but I do think it is fair to say that there are certain areas of the law into which, for whatever reasons, one personally fits more easily than others. Here, I would also say (perhaps at my peril) that, apart from the intrinsic interest which I have in the subject of IP, I have found IP practitioners are generally a breed apart from most other legal practitioners. I asked her: “How so?”

She answered:

A: A little, shall we say, more human.

Stephen Stern
In my profiling travels, I have interviewed many impressive IP practitioners, but perhaps no one more so than Stephen Stern, former IP partner at Freehills and now at Corrs in Melbourne. Nicknamed in certain IP quarters as the “rainmaker”, Stephen Stern has the uncanny knack of attracting (and retaining) the top shelf clients, his stable including Louis Vuitton, Hermès, Cartier, Ferrari, Hugo Boss, Lacoste, Gucci, Christian Dior, Versace, Moët & Chandon, Caterpillar, Ermenegildo Zegna, Fendi, Foster’s, Liz Claiborne, Prada, Quiksilver, Tommy Hilfiger, Vans, Brother, and BlackBerry. He is also one of Australia’s leading “wine lawyers”, acting for the INAO and numerous inter-professional organisations, such as the CIVC of Champagne, the BNIC of Cognac, the CIVB of Bordeaux and the BIVB of Burgundy for almost 25 years in protecting French wine (and other agricultural) controlled appellations of origin against misuse. The man never stops, nor does his phone, as I found when I interviewed him in late 2000 at the Hilton Hotel in Adelaide (where he was in town for the outset of the long-awaited Coonawarra geographical indication AAT dispute).12 He is a highly driven, yet atypically courteous man for one of such drive – 110% committed to his work.

I asked Stephen Stern, who at the time had been in private practice for more than 20 years, what he had observed to be the main changes that he had witnessed in IP private practice. He reflected:

A: From the mid-80s, client service became much faster. Clients came to expect, and were responsive to, a very fast turnaround. In terms of the work itself, the clients became much more interested in very commercial advice, as opposed to being advised of what the law was from a purely legal perspective. That was something that Brian Kewley (my principal) taught me up-front – it’s not a question of what the law is; it’s a question of how to deal with and solve the client’s commercial problems. Those days that’s just standard operating practice but 20 years ago, there were a lot of lawyers who didn’t work that way.

I then wondered whether or not he saw intellectual property as differing from other areas of commercial law, such as banking and finance, tax and superannuation. He offered some points of departure:

A: A lot of the things IP lawyers do are very different from those which other commercial lawyers do. The IP world is very much marketing focused.

For one thing, you quickly learn the marketing benefits of meeting your clients face to face and understanding their products and businesses. In litigation matters, that often requires international travel to see the clients because IP litigation is so regularly international in nature. For example, there is often no better way, especially in complex patent matters, to understand the technology than by taking face to face instructions from the client. You need to see and hear from the people who developed the technology as to learn the intricacies of the subject matter, how it works and why and how the defendant’s product is allegedly infringing your client’s product.

The second reason is that IP practice is international in the sense that the market is now a world market. People don’t look to market just in Australia, they look to market internationally. So too with lawyers. These days if you are merely Australian focused, you are judged as parochial by your clients.

I put it to him that, once in a conversation with a prominent Melbourne QC, he was described to me as one of the very few “rainmakers” in Australian IP practice. I asked him whether that description sat comfortably with him. His answer was forthright:

A: To answer yes would be boastful or immodest; to answer no might not be telling the full story. For some reason, which I’m not sure I fully understand, I have managed to attract a lot of clients.

I asked him to define a “rainmaker”, and whether there are different types of “rainmakers”? He elaborated:
Enter stage the academics, who deserve a brief mention: namely, the pioneers of Australian IP literature: Professors James Lahore and Sam Ricketson, and Dr Robert Dean.

Professor James Lahore
In his heyday, Jim Lahore came to be dubbed widely as the “King of Copyright” (with his wife Ann Dufty, with whom he worked both as partners at Mallesons as the “Queen of Trade Marks”). A former partner, later Special Counsel, at Mallesons Stephen Jaques, and having held the Foundation Chair of Intellectual Property at Queen Mary College, London University, he was the founding editor of the Intellectual Property Reports. I interviewed him in his office at Mallesons in Melbourne in 1999 for the June issue that year.  

In 1977, Jim Lahore published his first major text, Copyright Law in Australia, which would become the precursor to the current Butterworths intellectual property service. I remarked to him that he obviously recognised there was a vacuum to be filled for an authoritative work on the subject. He acknowledged:

A: Absolutely! There was no text on intellectual property in Australia, and even in England there wasn’t at that time any comprehensive book which covered all areas of intellectual property.

With what was then to become the indispensable three-volume IP Butterworths service, Intellectual Property in Australia: Patents, Designs, Trade Marks, I asked him how the break up of the areas of IP law amongst the contributors was agreed upon.

A: Initially, I did it all but then it became impossible. There was simply too much material, so Ann Dufy, Jim Dwyer and John Garnsey became involved as co-authors. The areas into which we carved up the service were really those of particular interest to and expertise of the parties in their various practices.

In this collaborative arrangement, I wondered if there had been the occasional arguments, even flare-ups. Again, he was convivially candid in his response:

A: Sure, there have been. For example, we have had different points of view on patentability. At the end of the day, we resolved them by discussion and consensus. We never published anything where we felt there was unresolved agreement. The nature of the project was such that everyone circulated their material to everyone different points of view on patentability. At the end of the day, we resolved them by discussion and consensus.

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Then, of course, there was his other great contribution to the corpus of Australian IP
literature with the founding of the Intellectual Property Reports. I asked him whether, given in the late '70s-early '80s when IP law was still relatively undeveloped, this had been a difficult venture to get off the ground. He admitted:

A: Yes, it certainly was! At the time, Butterworths thought there was no market for such a series. Finally, they accepted the idea and the reports far exceeded Butterworths' expectations. They are now accepted as one of the best series of intellectual property reports currently on offer anywhere.

Finally, I asked him about the mix and nexus of theory and practice – whether the academic and practitioner sides of his career had fed into each other. His "counsel" was instructive:

A: Absolutely. I don't think I could have been a good academic without the practice, and the academic side, at least the research side, feeds into the practice. Intellectual property, in particular, is one area where those two do go very well together because a lot of the so-called practical work is in fact research-based.

Professor Sam Ricketson

No doubt partly influenced by the trail-blazing academic work of Jim Lahore, a young Professor Sam Ricketson was to follow soon after in his footsteps. In the early '80s, he published his magnum opus, The Law of Intellectual Property (all 1201 pages), which was to become the first truly comprehensive, all round IP text in Australia.

In early 2004, I interviewed Sam Ricketson by telephone from Sydney to Melbourne and asked him what was the precursor for writing such a substantial tome back then against a relative dearth of published works to fall back on, and whether it assisted him in developing a curriculum for his teaching at Melbourne and later Monash Universities. He replied:

A: Originally I had in mind writing a casebook on the subject, but the publishers weren't very interested in that idea. Instead, I opted to write a textbook. I suppose I am one of those persons who really likes to cover the world as I see it, and this presented me with that opportunity. It was a kind of great indulgence which rather overtook me, and one which I really enjoyed.

Then, in 2000, at the ripened age of 50, Sam Ricketson took the plunge to realise a long-held ambition and went to the Victorian Bar. I ventured that perhaps it was not an altogether surprising new career, but more a kind of continuum of an already established legal career in IP academia, but only now in a different forum where he could apply that knowledge. He reflected:

A: It was a bit of a continuum between my teaching, which remains my chief love, and my more commercial-oriented practice of the law... But there really is no connection. Teaching is totally different. At the Bar, there are always the pressures of the "work style". You are always under the gun. That said, there are very many positive aspects – it is very democratic, everyone is equal, no-one is afforded any special favours.

In mid-2002, Sam Ricketson left the Bar to return full-time to academia, where he is Professor of Law and Co-Director of Studies, Intellectual Property Law.

Dr Robert Dean

Ambitious but modest, tenacious in his own pursuits but sensitive to the well-being of others, highly intellectual but acutely aware of the day-to-day struggles of those less privileged than himself is Dr Robert Dean. From starting out as a dyslexic schoolboy with a drive to perform and impress, he matured into a brilliant scholar, a respected barrister, only then to reach his long-held dream to be a politician. But like Icarus, just as he had almost reached that sunny zenith, his wings melted and that dream dissolved into dust and water. Now back at the Victorian Bar, he has consolidated his position as Australia's foremost expert on the law of trade secrets and breach of confidence, but clearly he learnt much from his full circle odyssey from the law to politics and back to the law.

When I interviewed him in late 2006, I asked him about the commissioning in 1984 by the Law Book Company to write what was to become a definitive Australian legal text on its subject, The Law of Trade Secrets. In particular, I asked what it was about trade secrets and confidential information that interested him, and whether he viewed it back then in the early 1980s as an esoteric, undeveloped area of the law.

A: In truth, I didn't. When it came for me to write a thesis for my Master of Laws at Melbourne University, I went to seek advice from Professor Harold Ford. I was happy to do something on intellectual property law, because I did want that part of my practice at the Bar to grow. Professor Ford suggested to me that the area of breach of confidence and trade secrets had received little academic attention but that it was...
beginning to grow on a practical scale. Back then, I had no idea what breach of confidence meant, but I was happy to take the plunge. In that way, the book came out of my Masters thesis on the protection from the misuse of unpatented trade secrets.

I recalled that when we were both resident law tutors at Trinity College, Melbourne University, we had the occasional discussion about the progress of his tome. There were times when it appeared it was like an albatross hanging around him, that it would never see the day of light.

A: That's true, but I was so far up the mountain I couldn't throw away all the work I had done. It was a huge undertaking, and took me about six solid years to complete. I remember going to see Sir John Young, the then Chief Justice of the Supreme Court, for permission to use the Court library after hours. He was wonderfully supportive, he gave me a key to access the library at night.

For the fruits of this long labour, in 1992 Robert Dean was rewarded with a Doctorate of Laws by Melbourne University.

I have earmarked Jim Lahore, Sam Ricketson and Robert Dean because, even to this day, IP practitioners throughout Australia remain indebted to them both for their enduring academic legacies. Without these sources of reference, IP practice would be if not very difficult, virtually impossible.

Dr Francis Gurry

Turning to one last, I suppose, in this case quasi-academic, Dr Francis Gurry, who as a research student at the Faculty of Law at the University of Cambridge was awarded a PhD in 1980 for his thesis dealing with breach of confidence. This was later published as a book. Since working with WIPO from 1985, he is now the fourth Director General of that international organisation, and, of course, he is the man who kindly came to my rescue in the Kamil Idris debacle.

When I interviewed Francis Gurry, by telephone from Melbourne to Geneva in 2000, I particularly wanted to touch on how WIPO operates in an often highly charged IP international political environment, such as seeking to protect traditional knowledge. I also wanted to know how he thought intellectual property can play a part in building wealth creation in Least Developed Countries.

I first asked him how dependent he was, as an official of a highly political organisation, on the goodwill and spirit of the governments of the day, even if by them being seen to be confronting thorny issues such as protecting the rights of the owners of traditional knowledge. He said:

A: This is one of the greatest constraints for international action for any international organisation. That is that no government of whatever political colour or persuasion wants to be embarrassed nationally by action that is taken internationally. The inevitable then is that what usually happens internationally is fairly conservative. Nor, for that matter, does anybody want a radical international organisation. The whole process is therefore fairly conservative and it means that you are constrained to those areas where you can manage to get some commonality in approach. This, in turn, requires you to define areas which are not going to cause embarrassment to governments at home.

I remarked that it is now axiomatic that intellectual property is a key component of wealth creation in any modern economy. I wonder, though, where this leaves the Least Developed Countries. Presumably, for the Least Developed Countries to participate more actively in the global economy, this requires a greater degree of development of their own national intellectual property infrastructures and regimes. I asked him what role WIPO plays in assisting with that process. His answer was frank:

A: The problem lies in the changing nature of the source of wealth creation and the fact that it could have consequences which are very detrimental for the gap that exists between the developed and the developing countries. WIPO's main challenge here is to create awareness of the nature of these changes and, as you say, to try to establish the necessary infrastructure at least to allow technological foreign investment in developing countries. If the nature of the foreign investment that they have is always limited to, if you like, the old economy, then the gap is going to be perpetuated. If we can create a very hospitable environment for technological foreign investment, and here I am thinking for example of the multimedia super corridor in Malaysia, that will at least provide some possibility of hope.

I went on to quiz Francis Gurry about how traditionally resistant he had found governments of the Least Developed Countries to be in embracing technological change so as to advance their local intellectual property. He offered this advice:
A: I think that the nature of some of the technologies, for example information technology in particular, presents those governments with some rather fundamental initial fears. I suppose the same might be said about biotechnology for a country which is agriculturally based. One's first approach understandably causes anxiety for the future, but that has to be overcome in time. That is why the educational or awareness role of WIPO is so vital.

Once those fears have been appeased or displaced, I don't think there is very great resistance to putting in place the requisite legislative framework. That happens relatively easily, but it is getting the commitment to elevate the question of intellectual property in its broadest sense to a sufficiently important level in the country's economic and policy that is the really difficult exercise.

Frank Moorhouse

My choice from the arts sector is Frank Moorhouse. The author of a swag of books and a past winner of the coveted Miles Franklin Prize for Australian Literature, he is one of Australia's most distinguished novelists and essayists. Apart from his stature as an internationally renowned writer, he is perhaps less widely known for his major contributions to the advancement of the rights of writers and journalists in Australia.

An obvious starting point with this famous author for our interview in a rather swish Kings Cross restaurant over lunch in early 2007 was that relatively few highly successful writers dare to step outside their rather insulated domain, to take reach out to the literary public and also to defend the rights of other writers, as he did. I was thinking, of course, of the pivotal part that he played in 1975 as the plaintiff in the High Court decision in Moorhouse v UNSW (1975), which effectively secured payment for the multiple copying of writers' works. He reminisced on that landmark case on "authorised" copyright infringement:

A: It was perfectly clear what was happening – that once a library had acquired a copy of a book, instead of requiring the student to buy the book, the teacher or even the student would simply copy and distribute it. On the most basic level, copying is publishing. Of course, I am talking here of multiple copying. If you copy for commercial or educational reasons you are taking away from authors their full capacity to earn income from their work.

Naturally, the injustice of that annoyed me. It was already hard enough for writers in Australia to earn a reasonable income. We therefore realised that we had to deal with this form of technology and to confront the free library system which was depriving writers of income from the sale of their books. On a philosophical level, I believed that in order to establish and maintain a sound creative culture it must be underpinned by a sound economic basis.

I asked why he had specifically targeted the University of New South Wales, to which he replied:

A: The University of New South Wales was simply one of many of the universities involved in this kind of conduct. I can recall that we did try to negotiate with the University, however they just dismissed the action as laughable and any proposed scheme as being impossible to administer.

While he had effectively won the case, I wondered what then happened on a pragmatic level after the judgment was handed down? He completed the story:

A: Once the University refused to pay a lump sum to writers, we began to lobby government for amendments to the Copyright Act. The system we devised, which is much the same as that currently practised, was based on statistical sampling. Initially, the law required that everyone was to record everything that they copied at the university or in the library at the photocopying machine, but we then offered the more practical alternative of requiring the student to buy the book, the teacher once a library had acquired a copy of a book, instead of even the student would simply copy and distribute the book. We could already see that this was having an impact on payments to writers, and in effect that was where the battle began.

I ventured further and asked him why the issue of educational institutions participating in the multiple copying of books without paying the authors sufficiently incensed him so much that he bravely embarked on full-scale litigation which ended up in the highest court in the land. He explained:

A: It was perfectly clear what was happening – that once a library had acquired a copy of a book, instead of requiring the student to buy the book, the teacher or even the student would simply copy and distribute it. On the most basic level, copying is publishing. Of course, I am talking here of multiple copying. If you copy for commercial or educational reasons you are taking away from authors their full capacity to earn income from their work.

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In 1980, as President of the Australian Society of Authors, Frank Moorhouse was instrumental in the establishment of CAL as a copyright collection agency for the printed word. He also remained as a director of CAL from 1980 until 1991. I invited him to reflect on how important the formation of CAL had become in protecting the interests of writers. Proud of this achievement, he expanded:

A: CAL became very important in enhancing not only many writers’ economic base, but also their cultural base. In effect, it didn’t matter what system was implemented. I was however committed to the notion to tie a writer’s income not to the grant system, as is provided for by bodies such as the Australia Council, but to the use of the book in the economy. That way you could measure the ways a book is used in the economy, identify the amount of income derived from that use, collect the income in an equitable way and return it to the copyright owner.

Last but by no means least, I conclude this narrative with two of the scientists whom I interviewed in the course of my profiling excursions. The first I am honoured to count as a good, long-time friend, Emeritus Professor Sir Gustav Nossal, whom I have known since 1985 when, as the Director of Melbourne’s Walter and Eliza Hall Institute, he assisted me in my research for a biography on his predecessor, the great Nobel laureate Sir Macfarlane Burnet. The second is Professor John Mills, former Director of the Macfarlane Burnet Centre for Medical Research (since renamed the Burnet Institute). While obviously neither has “practised” in IP as such, IP has directly impacted on their institutes’ activities, particularly in the protection, exploitation and commercialisation of patent discoveries. Both offered interesting, albeit slightly different, views on the subject.

Emeritus Professor Sir Gustav Nossal AC, CBE
Emeritus Professor Sir Gustav Nossal (more democratically and widely known simply as “Gus”) was the Director of the Walter and Eliza Hall Institute for 31 years, a former Deputy Chair of the Aboriginal Reconciliation Council and Australian of the Year 2000.

In 2000 for his Profile, I wanted to focus on the process of converting a scientific theory into a commercial product. I asked him that, when he became Director of the Hall Institute way back in 1965, whether there was any recognition of the benefits of commercialising those discoveries, whether IP back then was valued as a major asset to be exploited.19 For such an eminent scientist and, dare I add, shrewd administrator, his admission was disarmingly forthright:

A: You are now talking about one of the minor tragedies of Australian science. The answer to your question is an unequivocal “no”. The term “intellectual property” did not exist in our lexicon. The word “patent” was never enunciated. The word “profit” was a very dirty thing with which you did not sully your hands. Our job was to publish or perish, to amaze the world with our brilliance in the vague hope that someone, somewhere, at some time, might turn those discoveries into something useful.

Now, particularly over the last 20 years, one has learnt how abysmally wrong those orienting stances were. For example, if you make a discovery that has the potential of producing a cancer cure or a new treatment for asthma, or a blood pressure reducing pill in the longer term, and if you do not patent that discovery and protect the intellectual property, one thing is certain – you will delay the entry of that discovery into practice and you will delay whatever benefit humankind can derive from that discovery.

The reason is fairly simple. The boffin’s pipedream and basic research are cheap; what is devastatingly expensive is the applied research, the clinical trials, and the regulatory processes which companies must undertake to turn a bright idea into a usable product. We’re not talking millions of dollars here, we’re talking hundreds of millions of dollars. Therefore the very worst thing that you can do for humanity, and for your country and your institute, is not to protect the intellectual property.

I asked him how challenging then it had been for him to import the “new” ingredients of commerce and a greater reliance on government funding into an established scientific culture. Again, with the same candour, he looked back on those challenges:

A: It was quite difficult. I had relatively little difficulty in dealing with the bureaucrats or politicians because I was used to the public sector institutions like the universities. But the commercial side was hard because we simply didn’t know how to go about it. No-one had taught us the intricacies of intellectual property law. No-one had encouraged us to reach out even to local firms like CSL or Fauldings, let alone to a multinational corporation. There weren’t the kind of honest brokers that we now have. There certainly was nothing like the amount of venture capital that is available in Australia today.
In my interview in 1998 with Professor John Mills, the then Director of Macfarlane Burnet Centre for Medical Research (the country's largest laboratory research program in HIV and AIDS), this scientist took a slightly different slant on the issue of IP protection. I asked him what specific controls he thought should be put in place to ensure the protection of a scientific research institute's intellectual property. His answer was at some variance to that of Gus Nossal's:19

A: I have to admit that we at the Centre haven't been terribly controlled about it. That is partly a personal issue as far as I am concerned. I have hesitated to push the Centre too far toward a sort of commercial laboratory ambience. Instead, I prefer to see us occupying a niche which is somewhere between the universities on the one hand, and the pharmaceutical and biotech industries on the other. While I think we should be commercially focused and oriented, I am a little hesitant to set up the kind of rigid controls that the pharmaceutical industry might implement to ensure that absolutely every single skerrick of intellectual property is captured.

So, there we have two if not diametrically opposing, subtly different approaches 10 or so years ago by the former directors of two of the country's leading scientific institutes on the ethos of protecting their internal institutional intellectual property.

In conclusion, I think it fitting to pay tribute to the "late and great" – two towering figures lost to the Australian IP community in the last couple of years: Kathryn Everett and Dr John McLaren Emmerson QC.

Kathryn Everett was a long-standing and highly respected partner at Herbert Smith Freehills in Sydney, with an enviable reputation as an IP litigator and an adviser par excellence on IP regulatory issues, particularly in the life sciences, pharmaceutical and biotechnology industries. I have selected two questions from our conversation in late 2011 – the first because Kathryn was appointed in 2009 as joint co-Chair of the "Women at Freehills" Steering Committee (now called “Diversity at Freehills”).20

First, I asked her how, after working for more than 20 years in a top tier law firm, she would assess the progress of women in the legal profession? Her reply:

A: I think we have made huge strides, but we clearly have a long way to go. The percentage of female partnership, while improved, is still glaringly disproportionate to the percentage of female solicitors. The partnership composition must catch up with the level of intake on a gender basis. On the plus side, I do think that a lot of the overt discrimination that might have occurred 20 years ago simply does not exist anymore, at least not in firms like Freehills. There is widespread recognition and acceptance that no form of direct discrimination is tolerated.

The type of issues that we are now trying to address tend to be the more unconscious, cultural ones – why is it that women do not stay on in careers when they have already invested so much? What is it about the environment that may cause them to leave? Why do good employees fall out of the partnership pipeline?

I think we have reached the point where everyone at senior management level recognises that we need to work more closely with these highly capable women whom we train up and invest in, but lose at a later point, simply because we fail to identify and accommodate the transitions that they may want to make along the way.

My second and final question for the Profile (a standard one which I often ask at the end) was that if not the law, what path she would have pursued? After a long pause, she opened up:
A: Now that I’m older, I think I could have become a doctor. I believe I would have found that very rewarding, in a similar way to how I have found the law to be. But I have no regrets. The trouble in making career choices when you are very young is that you lack full maturity and insight to make informed decisions. So, the fact that I fainted at the sight of blood on an operating table all those years ago would not have dissuaded me from taking the plunge today. In my legal career, I have done so many things that have been far more difficult than overcoming the sight of blood! As has been the case in the law, my continuing interest in the sciences would have prevailed, so, yes, I probably would have been a doctor. As my patent matters let me practise law but learn all about medical and scientific issues – perhaps I have found the best of both worlds.

Little did I know that, at the time of the interview, Kathryn was not well.

To the dismay and deeply felt sadness, as expressed by the Australian IP community, she would be dead in less than two years, at the age of only 47.

**Dr John Emmerson QC**

The great presence and learned wisdom of Dr John McLaren Emmerson, nuclear physicist and queens counsel, was lost to the IP world last year. He was my third interview, dating back to late 1997. At the Victorian Bar, for many years he reigned as the peerless, undisputed doyen of IP law. He died at the age of 75 in August 2014.

The final question that I put to him, to which he responded rather quizzically was:

Q: *Will there be a “third career”?

The question clearly not expected, John McLaren Emmerson, scientist, scholar, barrister, bibliophile, released an equally unexpected loud laugh. There was, one detected, a touch of mischief attached to it.

A: *Oh dear!

He paused, a long pause, with the tips of his fingers joined bridge-like, resting gingerly under his chin. Finally, after some minutes of careful contemplation, he replied:

A: *The reason for my pause is, how can I say I am not going to answer that question without seemingly giving you an answer? Everyone needs a change from time to time but the law itself provides changes. Perhaps I’ll leave it there.

**Conclusion**

And, perhaps that is where I shall leave this retrospective of some of the many IP luminaries whom I have had the privilege to interview and write on within a span of 18 years. The good news is that the passing IP caravan of profiles continues to chug along the IP road, with many more profiles in the pipeline. For me, it has been a privilege and an enriching personal and professional experience to interview and write these profiles, and to share those insights with the readers of *Intellectual Property Forum*.

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1 * This article is based on presentations delivered by the author to the Western Australia IPSANZ Branch on 14 May 2015, the Victoria IPSANZ Branch on 2 July 2015, and the New South Wales Branch on 18 August 2015.


Current Developments – Australia

IP AUSTRALIA

Martin Friedgut and Amanda Caldwell
Spruson and Ferguson
Patent and Trade Mark Attorneys

**General**

**Business to Business (B2B)**

The IP Australia B2B portal has been designed to cater for the needs of high volume users. B2B facilitates the direct exchange of transactions between customer IT systems and the IP Australia portal, and provides immediate acknowledgement and validation reports. The B2B technology allows for the transfer of large attachments such as images and specifications and has upfront fee calculation and error detection. Customers using this technology pay on submission via direct debit which ensures that there are no over or underpayments. The immediate response and improved accuracy of the data captured by B2B means that customers can complete large numbers of IP right renewals quicker than ever before.

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- Trade Mark renewals.
- Designs renewals.
- Patent Applications (including Standard, Provisional and Innovation).
- Patent Examination requests.
- Trade Mark Applications.
- Design Applications.
- Plant Breeder’s Rights Applications.
- Renewals for all IP rights.
- Trade Mark Registrations.

Some key points to consider when assessing if B2B would be beneficial to your business are:

- B2B customers are required to sign the B2B agreement.
- Payment for B2B is by direct debit from an Australian bank account.
- Customers are required to obtain a digital certificate (KeyPost) which will be used to secure the transfer.
- B2B customers should consider that they may incur additional systems development, testing and maintenance costs to establish B2B from their business systems.

**Trade Marks and Designs Hearings Sessions in 2016**

The IP Australia Customer Service Charter commitment for patents, trade marks and designs hearings is to issue a decision within 12 weeks of holding a hearing, unless further submissions or evidence is provided. However, providing a timely service to other customers awaiting a hearing can be hampered when parties withdraw from the opposition process at short notice.

The hearings withdrawal rate is impacting on the availability and efficiency of hearings to customers with most withdrawal actions occurring in the fortnight leading up to a hearing.

As such, in order to address the unnecessary procedural delays and costs to both IP Australia and its customers, no interstate hearings will be set down for 2016 and subsequent years. Furthermore, the current schedule of interstate hearings will expire at the end of 2015.

Canberra-based hearings, in person, by phone or video conferencing, will continue to be offered throughout the year, as will the option of a hearing by way of written submissions only. The Registrar will also continue her practice of holding hearings at locations outside Canberra, at a convenient time, where the parties bear the travel costs of the hearing officer.

**Trade Marks**

**Approved Means for International Registration**

**Trade Marks Filed under the Madrid Protocol**

IP Australia has recently introduced an electronic filing facility, Madrid e-Filing, which provides a secure online channel for filing applications for International Registration of a trade mark under the Madrid Protocol. This facility is available through IP Australia's eServices channel.

From 21 July 2015, the Registrar has specified that IP Australia's eServices channel will be the approved means for filing International Registration applications. Applications lodged by the approved means will no longer attract a handling fee, following the recent amendment to Item 18 of Schedule 9 to the Trade Marks Regulations, and Regulation 21.21AA.

IP Australia will continue to charge a AU$100 handling fee for International Registration applications lodged via other means, including paper and fax.
Amendments to the Trade Marks Office Manual of Practice & Procedure

Part 1 – Introduction, Examination Quality Standards: Part 1 has been updated with changes to Examination Quality Standards – PQS Review:

- Amendment to: PQS 2.1, 2.2, 3.1, 4.1 to cover discontinued TMH requests.
- 6.1.2 and 6.2.6- cover further exam requirements.
- 6.2.3 is separated into two new attributes- 6.2.3.1, 6.2.3.2.
- Deletion of 6.2.4.3.
- Printable version updated.

Part 8 – Amalgamation (Linking) of Trade Marks: Part 8 has been reviewed with changes made to clarify the addition of endorsements for single classes on Parent applications and removal of requirements to return old registration certificates to IP Australia following the introduction of eServices.

Part 9 – Amendments and Changes to Name and Address: Part 9 has been reviewed with minor changes and clarifications surrounding requests for amendments.

Part 22 – Section 41 Capable of Distinguishing: Part 22 has been updated to include clarification regarding:

- Inherent Adaptation to Distinguish.
- Words in languages other than English.
- “My” trade marks.
- Images of persons. Letters — updated unclear references to “composite” marks.

Part 24 – DISCLAIMERS: Part 24 has been reviewed with changes made to clarify the effect of disclaimers on amendments to the representation of a trade mark.

Part 26 – Section 44 and Regulation 4.15A, Conflict with other Signs: Part 26 has been reviewed with minor changes to:

- Correct references to case law.
- Correct typographical and grammatical errors.
- Add an example of retailing services in the 10th edition of the Nice Classification to provide additional examples of factors to consider when comparing trade marks.
- Table Classes 32 and 33.

Part 29 – Trade Marks Likely to Deceive or Cause Confusion: Part 29 has been updated to include information on generic top level domain names, clarify potential claims which may give rise to a s.43 involving INNs and to clarify the requirements for demonstrating ownership or authorised use of a domain name.

Part 30 – Signs that are Scandalous and Contrary to Law: Part 30 has been updated to include reference to the Torres Strait Islander flag and information regarding specific consents and exemptions applicable to ADIs.

Part 31 – Prescribed and Prohibited Signs: Part 31 has been updated to clarify examination practice in relation to the Australian flag and to provide examples for guidance.

Part 32A – Examination of Trade Marks for Plants (in Class 31): Part 32A has been reviewed with significant updates made including examples of how s.41 and s.43 apply to plant examination and guidance on how to overcome grounds for rejection.

Part 32B – Examination of Trade Marks for Wine (in Class 33): Part 32B has been updated to delete the table – Reference Part 26.

Part 34 – Defensive Trade Marks: Part 34 has been reviewed and updates made regarding information on evidence.

Part 39 – Registration of a Trade Mark: Part 39 has been reviewed and changes made to format of certificate of registration, and registration process clarified.

Part 42 – Rectification of the Register: Part 42 has been reviewed with minor changes clarifying administration of rectification actions and advertisement and cancellation processes.

Part 43 – Assignment and Transmission: Part 43 has been reviewed with changes clarifying form requirements and prescribed documents as well as processes for full and partial assignments.

Part 44 – Claim of Interest or Rights in a Trade Mark: Part 44 has been reviewed with minor changes made to cancellation processes and clarification of timing for recording interest.

Part 47 – Procedures for Opposing an Application for Registration: This part has been updated with minor change to paragraph on s.58A to clarify when this ground is available.
SOUTH AUSTRALIA, VICTORIA and WESTERN AUSTRALIA

Peter Heerey AM, QC, Tom Cordiner and Alan Nash
Barristers
Correspondents for South Australia, Victoria and Western Australia

Note: Where any of us was involved in a case reported below and the matter is still running, or potentially so, the other correspondents have taken the role of reporting that case.

In this decadent edition, we report on a quartet of cases dealing with champagne, cigars, green tea and chocolate. And something of a novelty, a successful unjustifiable threats proceeding.

Delfi Chocolate Manufacturing SA v Mars Australia Pty Ltd

[2015] FCA 1065
1 October 2015

Trade marks – objection to registration – deceptive similarity – likelihood of deception or confusion – MALTESERS vs MALTTITOS

Delfi applied for the mark MALTTITOS in respect of various confectionary and chocolate products; Mars opposed the registration on the basis of its existing MALTESERS mark, relying on ss.44 and 60 of the Trade Marks Act 1995 (the Act). The delegate of the Registrar of Trade Marks upheld the opposition, agreeing that in light of the reputation MALTESERS enjoyed in Australia, use of MALTTITOS would be likely to deceive or cause confusion. The delegate rejected the s.44 claim, however, holding that MALTTITOS otherwise was not substantially identical with or deceptively similar to MALTESERS. Delfi appealed, and Mars cross-appealed the findings that went against them. Both appeals were heard before Justice Jessup.

In a short and sweet judgment, his Honour rejected Mars’s argument as to deceptive similarity between MALTESERS and MALTTITOS (and so dismissed the cross-appeal). In relation to the putative consumer whose aptitude to be deceived was relevant, his Honour did not consider that a “mere passer-by” without any pre-existing intention of buying confectionary was the correct standard (impulse buying aside). Rather, the relevant consumer was one with some previous exposure to the MALTESERS mark and “of a mind to make a purchase of confectionary”.

His Honour also disregarded arguments by Mars that sought to illustrate how confusing Delfi’s mark would be when presented in the same colour, layout and style as MALTESERS. His Honour observed, without sugar-coating: “Considerations of these kinds would, of course, be central aspects of any passing off case brought by the respondent against the applicant, but they have no place in a proceeding in which the only issue is whether the applicant’s mark, a single word in upper case letters, should be registered.” His Honour held that a consumer would not be left to wonder whether products sold under the MALTTITOS mark originated from Mars (bearing in mind that the test at the application stage does not involve a side-by-side comparison); nor was there such a close aural resemblance between the marks as would be likely to cause confusion.

As to s.60, the reputation of the MALTESERS mark was not in dispute. The issue was whether because of that reputation use of MALTTITOS would be likely to deceive or confuse. Justice Jessup rejected Delfi’s suggestion that s.60 is restricted to unregistered marks; the language of the section is not so confined. His Honour continued, however:

I would hold that, in a case in which the “other” mark is registered, the only respect in which s.60 requires an exercise different from that arising under so much of s.44 as relates to deceptive similarity is that the reputation in Australia of the “other” mark must be the reason why the use of the mark proposed to be registered is likely to deceive or cause confusion. What this means in practice is that the notional consumer of average intelligence thinking of making a purchase by reference to goods in association with which the latter mark is used, or intended to be used, is no longer someone who has had no more than some exposure to the “other” mark: he or she is someone who is assumed to have that level of awareness of that mark as is consistent with the content and extent of the reputation of it.

Accordingly, much of the logic deployed in the Court’s treatment of s.44 was applicable to its analysis of s.60. In what was no doubt considered by Delfi to be a delicious irony, the Court held that the strength of the MALTESERS brand counted against it; in his Honour’s view, with a stronger awareness of the MALTESERS mark, the putative consumer “would be immediately struck by the differences between the two marks”. Delfi’s appeal therefore was upheld.
Scandinavian Tobacco Group Eersel BV v Trojan Trading Company Pty Ltd

[2015] FCA 1086
9 October 2015

Trade marks – parallel importation – unpacking and repackaging due to tobacco labelling laws – whether infringing use by retailer importer – availability of s.123 defence

The applicants (collectively, STG) manufacture and sell cigars under various marks, including CAFÉ CRÈME, HENRI WINTERMANS and LA PAZ. In competition with STG’s authorised Australian distributor (STG Australia), Trojan imports genuine STG cigars, manufactured by STG (but sourced from a destination not subject of evidence in the proceeding). Due to Australia’s plain packaging laws for tobacco products, however, Trojan must unpack STG’s cigars upon their arrival in Australia and repackage them in compliant packaging. Trojan’s packaging, among other things, includes the relevant marks on the prescribed area and portion of the packaging. In contrast, cigars sold by STG Australian are pre-packaged by STG overseas in a manner that already conforms with Australian law. Trojan’s packaging and that used by STG Australia were not an exact match.

Trojan raised a threshold question as to whether s.26 of the Act precluded an authorised user (i.e. STG Australia) from suing alongside the registered owner of the marks in suit. Section 26 provides a mechanism for an authorised user to sue for infringement if the registered proprietor consents, or fails to bring an action within a prescribed period. This issue proved something of a smokescreen, however; Chief Justice Allsop declined to read into the section a proviso to the effect that an authorised user may sue “as long as the registered owner does not”.

It was not in dispute that the inclusion of the marks in suit on Trojan’s packaging was “use as a trade mark” for the purpose of s.120 of the Act. Trojan argued, however, that that “use” was by STG, not Trojan, because Trojan applied the marks only to indicate a trade connection between the goods and STG. That argument, in effect, re-ignited the pre-1995 debate concerning parallel importation. His Honour reviewed the authorities concerning the doctrine of exhaustion of rights and whether a registered owner’s exclusive rights extend beyond the point of initial sale, particularly as against a retailer importer. Ultimately, although his Honour thought it “counterintuitive”, he concluded that he was bound by a band of Full Court authorities to the effect that “absent s.123 being engaged, the mere sale of goods already marked by the registered owner (a fortiori if a mark is applied by someone other than the registered owner) would be an infringing use of the mark by the importer”.

Trojan also relied upon s.123 of the Act, which provides that use of a registered trade mark “in relation to” similar goods to those in respect of a mark is registered “does not infringe the trade mark if the trade mark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trade mark”. It was not in dispute that s.123 would apply to an importer referring to the marks for the purpose of advertising and invoicing genuine products, and selling the actual products themselves; the owner’s consent is implied in those contexts. But what of Trojan’s new packaging? In that regard, the burning issue was whether the registered owner’s “consent” is to be assessed at the time of manufacture (Trojan’s argument), or when Trojan repackaged and arguably “re-applied” the marks in suit to otherwise genuine goods (STG’s position).

STG’s claim ran out of puff at this point, because s.123 was held to apply. STG sought to emphasise that Trojan’s argument would place outside of a trade mark owner’s control the “secondary get up and packaging so important to modern commerce”. Trojan argued that that submission impermissibly introduced questions of goodwill into a provision designed to protect ancillary uses of a mark in relation to genuine goods. His Honour preferred Trojan’s submission, and favoured an analysis of the words “has been applied” that looks to consent as at the time of original packaging. His Honour also held that that interpretation was consistent with the role of s.123 in “protecting as non-infringing use that which does no more than draw a connection between the goods and the registered owner”.

With respect, the authors have some sympathy for the applicants’ predicament. A parallel importer who modifies a registered mark for the purposes of advertising and repackaging is unlikely to be able to rely upon s.123 because the protection applies only to the actual registered mark and not variations to it. But what of an importer who reproduces a mark faithfully, but uses sub-standard or defective packaging? Such conduct may affect the goodwill of the mark and/or the registered owner. In the present case, however, the Court may well have been influenced by the somewhat unique circumstances of...
the repackaging; absent Australia’s tobacco labelling laws, Trojan simply would have sold the genuine products in their original packaging.

**Truong Giang Corporation v Quach**

[2015] FCA 1097
15 October 2015

Trade marks – counterfeit goods – respondents manifestly unbelievable – compensatory damages – additional damages

Truong Giang Corporation (TG Corp) manufactures and sells “3 Ballerina Tea” green tea in packaging that features a variety of registered marks, including a device mark featuring three ballerinas. It was not in dispute that TG Corp enjoys a substantial and valuable reputation in Australia in its ballerina mark and the distinctive get up of its packaging (shown below on the left).

Since at least 2011, a counterfeit “3 Ballerina Tea” product has been sold in Australia. Although described as “Dieters’ Drink”, the packaging of the counterfeit product features the ballerina device (shown below on the right). The respondents (Quach, his company New Leaf Tea Pty Ltd, and one of their suppliers, Alexandrou) sell tea, coffee and nut products, including the counterfeit product.

The respondents plainly had trouble brewing: Justice Wigney had no doubt that the Dieters’ Drink get up featured TG Corp’s mark without authorisation, was deceptively similar to that of TG Corp’s product, and was intended to be passed off as the same. Quach and Alexandrou sought to downplay the extent and duration of their sales of infringing products and claimed ignorance as to their counterfeit nature, but their credibility evaporated in the face of compelling circumstantial evidence to the contrary. Overall, the Court found them to be “manifestly unbelievable”, and unsurprisingly held that trade mark infringement, misleading and deceptive conduct, and passing off had been made out.

Quach also was held to be personally liable for the wrongdoing of New Leaf. Justice Wigney noted that, whatever the correct test for joint tortfeasance might ultimately prove to be (alluding to the various tests espoused in decisions such as *Keller v LED Technologies Pty Ltd* (2010) 185 FCR 449), Quach had made New Leaf’s torts “his own” and used New Leaf as an “instrument for his wrongdoing”.

Among the usual catalogue of relief sought (and obtained), TG Corp elected to seek damages. Based on a decline in sales since 2011, on a “loss of profit” basis (see, e.g. *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd* (2009) 81 IPR 378), TG Corp established a loss of around US$2,700. TG Corp sought to increase that figure to $80,000, however, in light of the respondents’ inadequate discovery and unsatisfactory evidence and the likelihood that the true extent of their conduct extended beyond that which TG Corp was able to prove. His Honour allowed $3,500 in compensatory damages, but otherwise rejected TG Corp’s submission, as the respondents appeared to be “middle men” and not the producers or importers of the infringing goods, and the suggestion that their sales were greater than had been disclosed had not been put to them. Accordingly, there was insufficient basis for the Court to speculate that the respondents’ conduct had boiled over into a significantly higher number of additional sales.

His Honour’s award of additional damages under s.126(2) of the Act was more generous (but still only around one third of those sought by TG Corp): $50,000 as against Quach and New Leaf; and $25,000 as against Alexandrou. His Honour did not separately award exemplary damages for passing off, as he held that any such damages “would be the same as the additional damages assessed as payable in respect of the trade mark infringements”.

It should also be noted that the respondents’ legal defence appears to have run out of steam at the hearing stage, as they were unrepresented. Even so, the case illustrates the pitfalls of even a straightforward infringement claim where compensatory damages are sought in respect of counterfeit goods. Further, had the respondents not been so blatantly aware of the nature of the goods and at pains to downplay their conduct, the award of additional damages might not have mitigated the low level of compensatory damages as much as it did in this case.
Comité Interprofessionnel du Vin de Champagne v Powell

[2015] FCA 1110
20 October 2015

Geographical indications – “Champagne Jayne” – promotion on internet and social media – misleading and deceptive conduct

The respondent (Powell) provides “wine education services”, including wine events and consulting services, under the name “Champagne Jayne”.

The applicant (CIVC) is a French statutory corporation established to represent the interests of those involved in the manufacture and sale of wines from the Champagne region. It will be recalled that, in Australia, only wines that originate from that region can be called “Champagne”, with wines of a similar style but produced elsewhere referred to as “sparkling wine” (or something else). “Champagne” is a registered geographical indication under the Australian Grape and Wine Authority Act 2013 (Cth) (AGWA Act), and its use by Australian winemakers in respect of locally produced wine has been phased out in recent years pursuant to international treaties.

Powell is a somewhat effervescent personality, being the author of a successful book about Champagne wines and the holder of various awards relating to the same, and enjoying a significant online presence as “Champagne Jayne” through her website, YouTube channel and on social media like Facebook, Twitter and Instagram. She also engages in real-life conduct as “Champagne Jayne”, appearing at and conducting tastings, corporate functions and other wine-related events. Powell’s business and “Champagne Jayne” persona are consistently promoted by reference to the name “Champagne” and various indicia of “Frenchness” that (in an informal sense) evoke the positive reputation of Champagne wines. Although 90% of Powell’s business is focused on such wines, in some cases she also promotes non-Champagne wines, such as “Arras” sparkling wines from Tasmania.

CIVC did not allege trade mark infringement or passing off, nor seek to prevent Powell from calling herself “Champagne Jayne” per se. Rather, CIVC alleged that some of Powell’s conduct had bubbled over into the forbidden territory of misleading or deceiving consumers into believing that certain non-Champagne wines referred to by Powell were, or were likely to be, authentic Champagne wines.

Justice Beach held that the relevant class of consumers were prospective purchasers of Champagne and other sparkling wines, and that a not insignificant number of such consumers would have been exposed to Powell’s conduct. Powell’s conduct (and her online content in particular) could be assumed to have been directed toward, and read by, members of that class. Further, it was not relevant that Powell was not herself part of the wine supply chain; her conduct nevertheless was directed at relevant consumers.

Justice Beach held that Powell’s real-life activities in referring to non-Champagne wines at various social functions did not contravene s.18 of the Australian Consumer Law, as any erroneous impression that might arise at the start of the relevant events will have fizzed out by the end. His Honour also rejected CIVC’s argument that, in combination, the use of the name “Champagne Jayne” and Powell’s conduct misrepresented an affiliation or sponsorship with the Champagne sector, save in respect of instances in which Powell referred to herself as an “ambassador” for Champagne. That term falsely implied a level of official authorisation from the Champagne sector, and Powell holding various “titles” or awards by unofficial Champagne bodies was insufficient to justify the label “ambassador”. However, as Powell had already put a cork in it so far as referring to herself as an “ambassador” was concerned, his Honour was disposed to accept an undertaking rather than grant relief for that part of CIVC’s case.

The rest of Powell’s online activity, however, was held to contravene s.18 of the ACL. Most readers of content posted by “Champagne Jayne” would expect it to relate to Champagne wines. In a number of cases, Powell reviewed non-Champagne wines without clarifying that they were not Champagne wines (or, worse, referring to those wines as “champagne” in the body of the text). In other cases, images were posted of bottles of non-Champagne wines juxtaposed with Champagne wines, again without clarification as to origin.

CIVC’s additional claims that Powell had committed offences under the AGWA Act failed for a number of pleading and other threshold reasons, but also because it was not established that Powell was “selling” wine in the requisite sense.
And in other news:

• The owner of an innovation patent (Pro 3) for an invention relating to a system and components for safely enclosing handrails, stairways, walkways and platforms slipped up when it threatened patent infringement proceedings against the applicant parties (BLH). Pro 3’s invention, in effect, relates to a means by which panels can be affixed to industrial frameworks constructed of piping (like scaffolding walkways) to fill in the gaps between the pipes. Pro 3 successfully fended off BLH’s novelty-focused attacks on the validity of the patent, but was unable to satisfy Justice Jessup that BLH’s products (for which BLH was in the process of seeking its own innovation patent) in fact infringed its patent. It followed that threats by Pro 3 to commence infringement proceedings contained in pre-action letters from Pro 3’s solicitors (including without prejudice correspondence) fell within s.128 of the Patents Act 1990 (Cth). In contrast, separate letters to BLH’s major customer, BHP, did not constitute an unjustifiable threat as they did not contain a “threat” in the requisite sense; rather, that correspondence merely pointed to the existence of Pro 3’s patent, and thus fell through the gaps:

BLH Engineering and Construction Pty Ltd v Pro 3 Products Pty Ltd [2015] FCA 833

NEW SOUTH WALES

Simon Reynolds
Davies Collison Cave
Correspondent for New South Wales

Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks
[2015] FCA 756

Trade marks – whether a sign is inherently adapted to distinguish when the designated goods are constituted by a plant variety for which a plant breeder’s right has been granted

Background

In 1995, Buchanan Turf Supplies Pty Ltd (Buchanan) developed a new variety of soft leaf buffalo grass. On 30 September 1996, Buchanan applied under the Plant Breeder’s Rights Act 1994 (Cth) (the PBR Act) for a plant breeder’s right (PBR) in respect of the new variety of buffalo grass. On 27 March 1998, a PBR was granted. The term of the PBR was due to expire on 27 March 2018. The name of the plant variety provided in the PBR application was Sir Walter.

On 26 July 2012, Buchanan filed trade mark application no. 1504875 (the application) for the sign SIR WALTER in respect of goods and services in a number of classes including class 31. During examination the application was rejected under s.41 of the Trade Marks Act 1995 (the Act) in relation to “Turf grass” under class 31. The examiner considered that SIR WALTER was not inherently adapted to distinguish these goods from the goods of other persons. The examiner considered that s.41(6) of the Act was applicable in this instance. The examiner was not satisfied by the submissions and evidence of use provided by Buchanan that, before the filing date, the mark distinguished these goods as being those of Buchanan.

Buchanan requested a hearing in relation to the outstanding ground of rejection preventing acceptance of the application. A delegate of the Registrar of Trade Marks (the delegate) issued a decision on 21 March 2014. The delegate’s decision was based on a proposed amended description of the class 31 goods as Buffalo grass of the “Sir Walter” variety (as lodged with the Registrar of Plant Breeder’s Rights (ref: certificate no. 1028), being part of the genus Stenotaphrum and a member of the species secundatum.

The delegate concluded that, given Sir Walter was the name of a particular variety of buffalo grass, and given that the application for registration in class 31 was for that specific variety of grass, the sign SIR WALTER entirely lacked inherent adaptation to distinguish those goods from the goods of other traders. Thus, the application was to be considered under s.41(6) of the Act.

The delegate noted that SIR WALTER had been used prior to the filing date of the application with other material, usually in the form of a device element of a mounted knight (the knight device) as shown below.
The delegate found that when SIR WALTER was not used with the knight device, or other trade mark material, the use was most often descriptive. The delegate was not satisfied that Buchanan had established, before the filing date of the application, that SIR WALTER distinguished Buchanan's goods in class 31 as its goods. The delegate indicated that the application was to be rejected if the application was not amended to delete the class 31 goods.

Buchanan appealed the decision by the delegate. The appeal was heard by Yates J.

**Inherent Adaption**

Buchanan asserted that the evidence presented established that SIR WALTER was not used as a mere description of buffalo grass, but rather as a sign with a secondary meaning. In particular, Buchanan submitted that SIR WALTER identified a premium form of soft leaf buffalo grass, supplied by or on behalf of Buchanan subject to imposed quality controls.

Buchanan also submitted that most members of the public would not be aware that Sir Walter was the name of a plant variety distinct from the name of a soft leaf buffalo grass associated with Buchanan.

Yates J found that there was no evidence of Buchanan exercising quality control for buffalo grass generally or, indeed, for any turf other than turf comprising the Sir Walter grass. Furthermore, there was no evidence regarding what the public thought when they saw the name Sir Walter.

Buchanan also submitted that other traders could refer to the designated goods as "buffalo grass" or "premium buffalo grass" should the trade mark be registered. Yates J determined that a person is not entitled to appropriate words taken from the common stock of language when others may wish to use those words to designate their own goods or services. It was highlighted that registrability of a trade mark does not depend on whether there is a surplus of other signs that other traders could use for their own goods or services.

Yates J concluded that the sign SIR WALTER was not to any extent inherently adapted to distinguish the designated goods as the Buchanan's goods. At [45], Kitto J’s question in *Clark Equipment* was adapted for the consideration of the current appeal:

> Would traders of buffalo grass of the Sir Walter variety, in the exercise of the common right of the public to make honest use of words for the sake of the signification which they ordinarily possess, think of the sign SIR WALTER and want to use it in connection with the designated goods?

His Honour concluded that the answer to this question would undoubtedly be in the affirmative. Yates J reasoned that Sir Walter was the name of the plant variety that constitutes the very good for which trade mark registration was being sought. The sign SIR WALTER was considered to denote the Sir Walter plant variety of buffalo grass with its particular characteristics and attributes.

As SIR WALTER was not to any extent inherently adapted to distinguish the designated goods as the appellant's goods, s.41(5) of the Act was not available to Buchanan. Therefore, the application could only be considered under s.41(6) of the Act in relation to whether Buchanan had established that, because of the extent to which SIR WALTER had been used before the filing date, the sign distinguished the designated goods as being its goods and not those of others seeking to supply the same goods.

**Factual Distinctiveness**

Buchanan presented evidence of including television advertising campaigns, radio advertising, print media promotion, promotions involving vehicles, aircraft and road signage, promotion using websites, promotions in telephone directories, promotions at retail outlets and nurseries and lawn-related products. Yates J grouped the evidence into three broad forms of use: first, use of SIR WALTER before the filing date; secondly, use of SIR WALTER with the knight device; and thirdly, use of SIR WALTER as part of an endorsement logo which was applied to other products by authorising the use of the knight device with the words PROUDLY SPONSORED BY SIR WALTER.

In relation to use of SIR WALTER before the filing date, Yates J stated that the evidence overwhelmingly showed that the use was to designate a particular type of grass and not use as a mark for distinguishing Buchanan's Sir Walter grass from other traders' Sir Walter grass.

In relation to the use of SIR WALTER with the knight device, it was necessary to evaluate, as at the filing date, the function that SIR WALTER performed as an element in the knight device. Yates J found that the evidence showed that SIR WALTER was almost invariably rendered within inverted commas, suggesting that SIR WALTER was being referred to in some special way. Whilst Buchanan submitted that this rendering of SIR
WALTER strongly pointed to trade mark use, Yates J was of the view that the rendering of SIR WALTER was equally capable of indicating a descriptive use, and that text and words that accompanied the inverted commas version of the mark only reinforced that SIR WALTER was being used to designate the Sir Walter variety of grass.

In relation to the use of the endorsement logo applied to other products by authorising the use of the knight device, Yates J found that the same considerations above would apply. In particular, it was necessary to evaluate, as at the filing date, the function that SIR WALTER performed as an element in that particular rendering. His Honour was of the opinion that at the filing date, those who saw the endorsement logo would have understood the logo as signifying that the endorsed product was suitable for use on Sir Walter grass.

Based on the above reasons, Yates J was not satisfied that, at the filing date, SIR WALTER distinguished the designated goods as being those of Buchanan. In accordance with s.41(6)(b) of the Act, SIR WALTER was taken to not be capable of distinguishing the designated goods from the goods of other persons.

**Disposition**

The appeal was dismissed and the decision of the delegate was affirmed. The application was not to proceed to acceptance unless the specification was amended by deleting reference to the class 31 goods. Buchanan was ordered to pay the Registrar’s costs.

The application was eventually amended to remove the class 31 goods such that acceptance and eventual registration could be achieved.
Andrew Brown QC
Auckland
Correspondent for New Zealand

Case Law Developments

**Daimler AG v Sany Group Co Ltd**

Court of Appeal of New Zealand, France P, White and Winkelmann JJ, 8 September 2015

[2015] NZCA 418

Trade marks – appeal – likelihood of confusion – contrary to law – well-known marks – Trade Marks Act 2002, ss.17(1)(a), 17(1)(b), 25(1)(b), 25(1)(c)

**Facts**

Daimler AG used its three-pointed star mark on vehicles. It had registered a number of trade marks reflecting that use in New Zealand, namely:

In 2006, Sany Group Co Ltd applied to register the following mark:

Daimler opposed the registration. The Assistant Commissioner of Trade Marks allowed Sany's application. Daimler unsuccessfully appealed to the High Court.

Daimler then appealed to the Court of Appeal.

The grounds of appeal were:

(a) Whether use of the Sany mark would be likely to deceive or cause confusion (s.17(1)(a)).

(b) Whether use of the Sany mark is contrary to New Zealand law (s. 17(1)(b)).

(c) Whether the Sany mark is similar to the Daimler marks, in respect of the same or similar goods and services, and its use is likely to deceive or confuse (s.25(1)(b)).

(d) Whether the Sany mark, or an essential element of it, is similar to Daimler's well- known marks; whether Sany's goods and services are the same as or similar to Daimler's goods and services; whether the use of the Sany mark would be taken as indicating a connection in the course of trade with Daimler; and whether use of the Sany mark would be likely to prejudice the interests of Daimler (s.25(1)(c)).

**Held**, dismissing the appeal:

**Likelihood of Confusion**

(1) The question of similarity was ultimately one of impression. The Court agreed with Collins J and the Assistant Commissioner that the marks were not similar [24].

(2) The cases Crocodile International Pte Ltd v Lacoste (Simon France J) and Carabao Tawandang Co Ltd v Red Bull GMBH (Clifford J) did not stand for the proposition that a word without meaning is necessarily irrelevant as part of the mark. They made the point that in some cases the addition of a word may not be significant [32]. In this case, the inclusion of the word “Sany” did further distinguish the marks, but even without its inclusion there was no risk of confusion because of lack of visual similarity.


(3) Likelihood of confusion was further reduced by the fact that purchasers of the goods were likely to be discerning and knowledgeable [33]. The Court did not agree that Sexwax Inc v Zoggs International Ltd stood for the proposition that it is not possible to take into account the fact that purchasers and prospective purchasers are discerning [36].


(4) The Court upholding the High Court on s.17(1)(a) meant that the appeal on s.17(1)(b) also had to fail [43].

Section 25(1)(b)

(5) The High Court had found that the key difference between ss.25(1)(b) and 17(1) (a) was that s.25(1)(b) was not dependent on Daimler's actual use, but upon notional use. The High Court had concluded that the s.25(1)(b) ground of appeal had to be dismissed because of the conclusion under s.17(1)(a) that the marks were not sufficiently similar. Following the NV Sumatra Tobacco Trading Co v NZ Milk Brands Ltd approach
to s.25(1)(b), the Court agreed with the High Court [48].


### Section 25(1)(c)

The Court agreed that s.25(1)(c) was not engaged in this case because the marks were not similar and even if the word “Sany” is not taken into account, the Sany device inside the circle was not identical to or similar to Daimler’s three-pointed star [53].

The Court noted that the question of what is necessary to show a connection in the course of trade between a mark and another trader has “not been finally resolved in New Zealand. But it does appear to require more than a ‘tenuous association’ with limited similarity of names”. In any event, the only evidence as to common usage suggested that no connection should be made [54].

**Crocodile International Pte Ltd v Lacoste**

**High Court of New Zealand, Clifford J**

[2015] NZHC 2432

**Trade marks – appeal – intention to use mark**

**Copyright – registered designs – trade marks – agreement to registration of trade mark authorisation to do restricted acts in relation to copyright work**

**Facts**

This appeal was part of a long-running dispute between Lacoste and Crocodile International, competing garment traders.

Various manifestations of crocodile device and word marks had been registered and used in New Zealand by Lacoste. Two such examples were the following (the “Lacoste logos”):

![Lacoste Logos](image)

Lacoste also owned trade mark no. 70068:

![Crocodile Logo](image)

Trade mark no. 70068 was registered in New Zealand in 1961 by Crocodile Garments Ltd, a company related to Crocodile International Pte Ltd. In 1999, Lacoste applied to have trade mark no. 70068 revoked for non-use. Before that application was finalised, Lacoste and Crocodile Garments Ltd entered into a settlement agreement whereby Crocodile Garments agreed to assign trade mark no. 70068 to Lacoste.

In 2011, Lacoste applied to register trade mark no. 837027 (“the crocodile logo”), which was the same as trade mark no. 70068. Crocodile International opposed the application on the grounds that an individual named Dr Tan owned copyright in the logo so that use of the logo by Lacoste would be unlawful copyright infringement; Lacoste’s application was in bad faith; Lacoste did not own the logo trade mark; and Lacoste did not intend to use the logo trade mark.

The Assistant Commissioner found that no copyright subsisted in the logo; Lacoste’s application was not made in bad faith; it had not been established that Lacoste did not own the mark; and that Crocodile International had established that Lacoste did not intend to use the mark.

Lacoste appealed on the ground that the Assistant Commissioner was wrong to conclude that it did not intend to use the mark. Crocodile International cross-appealed inter alia on the ground that the Assistant Commissioner was wrong to conclude that copyright in the logo did not subsist in New Zealand. This note only considers Crocodile International’s cross-appeal in relation to subsistence of copyright.

**Held**, allowing Lacoste’s appeal and dismissing Crocodile International’s cross-appeal:

**Copyright in the Logo**

(1) Crocodile International’s challenge to the Assistant Commissioner’s decision, based on what it called the “traditional hostility” of trade mark law to dual registration as both a trade mark and a design, was not successful. The issue was not whether trade mark protection and copyright protection could co-exist, but the limited copyright provided to registrable designs, along with the exclusion of artistic copyright in designs capable of registration but not registered [83].

(2) “Capable of registration” in cl.28(1)(b) of Sch 1 of the *Copyright Act* 1994 did not require that the design was actually capable of...
registration at the time it was made; rather, it had to have all the elements of a design and be capable, without significant alteration, to be registered as a design [91]. The test was therefore whether the work in the crocodile logo possessed the essential elements of a design as defined in the Patents Designs and Trade Marks Act 1922.


(3) The concept of “eye appeal” did not require that the design be visible at all times. It only needed to be visible at one point in time and have impacted on the purchaser’s decision to buy the goods [94].


(4) The crocodile logo had eye appeal and was a feature of ornament that was applied to an article. The logo was first published in 1949 and was a design capable of registration under the Patents Trade Marks and Designs Act 1922, excluding it from copyright protection [95] – [99].

(Obiter) If, however, copyright could subsist in the logo, a sufficient degree of originality was shown in the crocodile logo to preclude an inference that the Lacoste logo had been copied to create it [110]. Even though other judges had found that the crocodile logo and Lacoste logos were deceptively similar, the concepts of originality in copyright law, and the concepts of deceptive similarity in trade mark law, were different [111].

(6) (Obiter) If copyright did subsist in the logo, then use of the logo by Lacoste would not infringe that copyright. That was because the purported owner of copyright, Dr Tan, could not argue that he had not agreed to Crocodile Garments’ registration of trade mark 70068 which was subsequently assigned to Lacoste. Dr Tan was to be taken, by his agreement to registration, to have authorised Crocodile Garments, and any subsequent owner of the trade mark, to do the acts referred to in s.16 of the Copyright Act. The Judge noted that he was attracted to the proposition that the owner of copyright in a trade mark who agreed to another person registering that trade mark in a particular jurisdiction was to be taken to have given the necessary authorisation to the registrant of the mark to enable it to use the mark in that jurisdiction, unless there was a reservation to the contrary. However, it was not necessary to go that far in the judgment given the facts [120].

Intention to Use the Trade Mark

(7) The Assistant Commissioner had held that while an application is prima facie evidence of intention to use, as Lacoste had pleaded that it had used the Crocodile logo because it had used its Lacoste logos, this rebutted the presumption. This was an incorrect approach. At the point of application it was appropriate to adopt a broad interpretation of intention to use. The Assistant Commissioner’s decision had effectively created an onus on any applicant who pleaded intention to use to provide some evidence of this, which had been rejected in the case law. Lacoste owned several crocodile device marks and word marks relating to crocodiles. The evidence had been that it intended to develop different ways in which to use the crocodile device and word marks in the future. To hold that Lacoste had no intention to use a trade mark made up of these two things would place an onus of proving intention that had been rejected [135], [137]-[138].


Dixon v R

Supreme Court of New Zealand, Elias CJ, William Young, Glazebrook, Arnold and O’Regan JJ

[2015] NZSC 147

This case is the final resolution of the proceeding reported in IP Forum in October 2014. The Supreme Court overturned the Court of Appeal’s finding that digital files were not “property”. The conclusion was that they are “property” for the purposes of the Crimes Act 1961 may have implications for intellectual property practitioners in New Zealand.


Facts

The appellant, Mr Dixon, had obtained a compilation of CCTV footage (showing a sporting celebrity in a bar) from a reception computer by transferring them to a personal USB stick. He had
then deleted the files from the desktop. He tried unsuccessfully to sell the footage to international media organisations. He then posted it to YouTube. The bar complained to the police. Mr Dixon was convicted after a jury trial.

He appealed to the Court of Appeal, which determined that digital videos were not “property” for the purposes of s.249(1)(a) of the Crimes Act 1961 as they were simply “pure information”. The Court of Appeal had used s.286(2) of the Crimes Act to substitute a conviction for accessing a computer system and thereby dishonestly and without claim of right obtaining a benefit.

Mr Dixon appealed to the Supreme Court on the issues of whether the digital files were “property” for the purposes of s.249(1)(a), and whether the Court of Appeal had been right to substitute the conviction. Prior to the appeal being heard, Mr Dixon dismissed his counsel. The appeal proceeded with Mr Dixon being self-represented.

This note only addresses the issue of whether digital files can be “property”.

**Held**, dismissing the appeal:

1. In the context of dishonest acquisition of property from a computer system under s.249(1)(a), and in light of the definition of property in s.2,1 the digital files at issue were property, whether classified as tangible or intangible [25]. The US cases were divided on whether software was tangible or intangible, but were in general agreement that it was “property”. There was no reason to treat data files differently from software in this respect [50].

   South Central Bell Telephone Co v Barthelemy 643 So 2d 1240 (Lou 1994); Erris Promotions Ltd v Commissioner of Inland Revenue [2004] 1 NZLR 811 (HC) discussed; Thyroff v Nationwide Mutual Insurance Co 8 NY 3d 283 (NY 2007); Your Response Ltd v Datateam Business Media Ltd [2015] QB 41 contrasted; Wal-Mart Stores Inc v City of Mobile 696 So 2d 290 (Ala 1996); Andrew Jergens Co v Wilkins 109 Ohio St 3d 396 (Ohio 2006); American Business Information Inc v Egr 264 Neb 574 (Neb 2002) referred to.

2. The word “property” was included in s.249(1)(a) for a broader purpose than simply covering the type of situation of a defendant accessing a computer and using credit card details to unlawfully obtain goods [34]. Referring to ss.248 (definition of computer system) and 250 (damaging or interfering with computer system) showed that Parliament had stored data in mind when drafting those provisions. The Court also considered that there was no doubt that Parliament had in mind situations where stored data was copied [35]. Given this, it was necessary to consider which offence might apply where a person copied stored data from a computer without authority. The Court doubted that s.250 could apply. Section 252, which created an offence of intentionally accessing a computer system without authority, could apply, however it focused on unauthorised access simpliciter and did not address the issue of dishonest purpose. Section 249 would apply where access was for a dishonest purpose, and carried with it significantly higher maximum penalties. An obvious example of accessing a computer system for a dishonest purpose was the present case, and the capturing of such conduct was consistent with the features of the legislation. The word “property” was most apt to capture what was obtained by Mr Dixon as a result of his unauthorised access [37]. His conduct was within the statutory purpose [51].

3. In this context, the fundamental characteristic of “property” was that it was something capable of being owned and transferred [38]. The compilation of CCTV footage had an economic value and was capable of being sold. It had a material presence and altered the physical state of the medium it was stored on, illustrated by the fact that electronic storage could become fully utilised [39].


4. The fact that Mr Dixon had deleted the compilation from the computer after he copied it was not critical to the conclusion that he had obtained property. He would still have obtained property if he had simply downloaded a copy of the compilation [fn 70].

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1 "property includes real and personal property, and any estate or interest in any real or personal property, money, electricity, and any debt, and any thing in action, and any other right or interest".
China's Cloud Gate and Copyright Protection

A sculpture in Karamy, Xinjiang, China has recently caught much media attention because of its striking resemblance with the famous bean-shaped sculpture in Chicago, “Cloud Gate” (or colloquially as “the Bean”).

Cloud Gate has been a landmark of the Chicago landscape since it was installed outside the Art Institute of Chicago and Millennium Park in 2006. It has a polished silvery exterior and is famous for its reflection of the Chicago's skyline. Having a unique structure, Cloud Gate has an arc underneath large enough for visitors to walk through. In “contrast”, the sculpture in China is supposed to mimic an oil bubble and is a reference to an oil well in Karamy. The Chinese installation also has a mirror-like surface and passages that lead to the underbelly of the “oil bubble”.

When Anish Kapoor, the author of Cloud Gate, learned about the sculpture in China, he said: “It seems that in China today it is permissible to steal the creativity of others, I feel I must take this to the highest level and pursue those responsible in the courts.”

How is copyright in a sculpture like Cloud Gate protected internationally? How can an author pursue a claim in China?

International Copyright Protection – How does it Work?

The first thing to note is that there is no right known as “international copyright”, meaning there is no uniform set of laws that governs copyright in a work around the world. Thus, copyright law is “territorial” in nature. The copyright protection afforded to a work in a certain jurisdiction depends on the national laws of the jurisdiction in which the author seeks protection, and the various copyright international conventions to which the respective country may or may not be signatory.

In Hong Kong, copyright subsists in certain types of works, including artistic works such as sculptures and paintings. It is not necessary to register copyright in Hong Kong in order to obtain protection under the Copyright Ordinance (Cap. 582). As an artistic work, copyright automatically subsists in a sculpture at the time of creation.

Through the application of international copyright conventions, a sculpture created in Hong Kong also enjoys protection in most countries around the world. The most significant international treaty that governs international protection of copyright is The Berne Convention for Protection of Literary and Artistic Works (Berne Convention). Some of its key features are:

- National treatment – Works originating in one contracting state must be given the same protection in each other contracting state as the latter grants protection to the works of its own nationals.
- “Automatic” protection – No formalities are required to be complied with in the other contracting states.

At present, there are 168 contracting states to the Berne Convention. As China (extending to Hong Kong) is a signatory to the Berne Convention, copyright works created in Hong Kong and in all other contracting states of the Berne Convention are also automatically protected in China, according to China's copyright law.

China's Copyright Law

Under China's copyright law, copyright subsist in works of fine art and architecture, including a sculpture. Any person who plagiarises another’s work commits an act of copyright infringement and should bear civil liability. Any person who reproduces a work without the author's permission (the “Infringing Act”) is also civilly liable. Furthermore, if the Infringing Act is considered to harm the public interest, the state and local copyright administration departments have the power to order the infringer to cease the Infringing Act, confiscate his illegal gains, confiscate and destroy the reproductions of work, and impose a fine on the infringer.

Should an author wish to pursue a copyright claim in China, they would need to collect evidence of infringement and will have a choice of pursing their claim by way of an administrative action or a civil action.

Challenges in Enforcement in China

Foreign authors often face difficulties when enforcing copyright works in China for the following reasons:

Differences Between China's Copyright Law and Foreign Copyright Law and Lack of Understanding of the Berne Convention
China maintains a system of voluntary copyright registration and domestic enforcement actions are often based on registered copyright rights. If the copyright in question has not been registered in China, enforcement agencies may be reluctant to assist with copyright infringement investigations as they may not understand the effects of the Berne Convention.

Local Protectionism

Enforcement agencies in China may be protective of local companies and individuals. They may also be reluctant to take action due to feared impact on the local economy.

Political Institutions in China Might have Vested Interests in Certain Industry Sectors and their Interests May Collide with the Interests of Foreign Investors and their Copyright and Other Intellectual Property Rights

Enforcement agencies may often face political pressure and incline to favour political institutions in enforcement actions.

Limited Manpower and Resources Dedicated to Intellectual Property Right Enforcement in China, Especially in Smaller and Lower Tier Cities

As a result of these challenges, many foreign authors and innovators have been put off from enforcing their rights in China.

Final Remarks

In recent years, the Chinese government has made tremendous efforts to address intellectual property rights problems and to improve enforcement efficiency, for example, by updating its laws and establishing specialised IP courts. It is hoped that China will continue to increase the transparency and certainty of enforcement actions so that intellectual property right owners will not hesitate to enforce their rights and China will become a more IP and innovation-friendly country for both authors and innovators domestically and internationally. In the meantime, we will continue to watch this space and see if Kapoor will really take the “China’s Cloud Gate” case to the courts in China.

3 Article 47 of the Copyright Law of the People’s Republic of China.
4 Article 48 of the Copyright Law of the People’s Republic of China.
5 Article 48 of the Copyright Law of the People’s Republic of China.
6 See Temporary Measures on the Voluntary Copyright Registration of Works issued by National Copyright Administration of China.

SINGAPORE

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Formula One Licensing BV v Idea Marketing SA

[2015] SGHC 263

Brief Facts

This case is an appeal of the Assistant Registrar’s decision in Formula One Licensing BV v Idea Marketing SA [2015] SGHC 263.

On 11 January 2007, Idea Marketing SA (the respondent) applied to register “F1H2O” (the “Application Mark”) in respect of certain goods in classes 9, 25, 38 and 41. The respondent is the global promoter for the F1 Powerboat World Championship since 1993, which has been held in Singapore in 1993, 2003, 2004 and 2005. The respondent is the global promoter for the F1 Powerboat World Championship since 1993, which has been held in Singapore in 1993, 2003, 2004 and 2005. Prior to this date, Formula One Licensing BV (the appellant), the trade mark manager for the FIA Formula One World Championship, had registered the following trade marks in various classes, including classes 9, 25, 38 and 41:

1.

2.

3.

(collectively referred to as the “Registered Marks”).

The appellant also claimed that they had used the unregistered “F1” mark (referred to as the “Plain F1 Mark”) as an “earlier trade mark” prior to 11 January 2007.

The appellant relied on the Registered Marks and the Plain F1 Mark to oppose the Application Mark on the following grounds:

(a) The Application Mark was similar to an earlier mark and is to be registered for goods or services similar to those for which the earlier mark was protected.
(b) The Application Mark was similar to an earlier trade mark well-known in Singapore.
(c) The Application Mark was similar to an earlier mark that was well-known to the public at large in Singapore.
(d) The Application Mark should not be registered as it would be contrary to the law of passing off.
(e) The Application Mark was registered in bad faith.
The Assistant Registrar dismissed the opposition on all grounds and the High Court upheld this decision.

Decision

Well-known Mark
Under s.2(1)(b), a “well-known trade mark” is an “unregistered trade mark” that is well-known in Singapore. At first instance, the Assistant Registrar referred to the High Court decision in Societe Des Produits Nestle SA v Petra Foods Ltd and another [2014] SGHC 252, where it was held that an “unregistered trade mark” will necessarily imply the exclusion of an unregistered trade mark that is deemed to be unregistrable under s.7 of the Trade Marks Act. Under s.7(1)(b) of the Act, a mark that is descriptive of some quality or characteristic of the goods or services in question cannot be registered. However, such a descriptive mark can be registered if it is show to have acquired distinctive character, under s.7(2).

In the present case, the High Court held that, prior to 11 January 2007, the term “F1” was a descriptive term that was used to refer to a standard by which vehicles – whether motor cars or powerboats – were categorised. As such, the relevant public had not associated “F1” exclusively with the appellant. The High Court also held that the Plain F1 Mark had not acquired distinctiveness as of 11 January 2007. The High Court upheld the Assistant Registrar’s finding that for a mark to become distinctive, mere association was not sufficient to establish that a mark had acquired distinctiveness. Showing that a section of the public may associate “F1” with the appellants or that motorsports races organised by the appellant are known as “F1” was insufficient to show trade mark significance as it had to be shown that “F1” signifies trade origin.

In view of the above, the High Court held that the Plain F1 Mark was not a “well-known mark” in Singapore.

Similar Mark Used on Similar Goods
In assessing whether the Application Mark should be refused under s.8(2)(b), the High Court considered the three requirements – namely, similarity of marks, similarity of goods or services and likelihood of confusion arising from the two similarities.

While the goods and services claimed were held to be similar, the High Court held that the Registered Marks were not similar to the Application Mark. The Plain F1 Mark was not considered under this ground as it did not qualify as an earlier trade mark at the relevant date. Given the conceptual disparity between the Application Mark and the Registered Marks, the High Court held that there was no likelihood of confusion as the reasonable consumer was unlikely to be confused.

Passing Off
Under s.8(7)(a) of the Act, a trade mark shall not be registered if its use in Singapore is liable to be prevented by virtue of any rule of law, in particular, the law of passing off, protecting an unregistered trade mark or other sign used in the course of trade.

Under the law of passing off, the appellant would have to prove that goodwill attached to the appellant’s product or service, misrepresentation that the respondent’s goods or services are the appellant’s goods or services or emanate from a source that is economically linked to the appellant and damage or likelihood of damage due to the respondent’s misrepresentation.

Whether the appellant had goodwill at the relevant date was an issue that was discussed by the High Court. The Court of Appeal had previously held in CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550 that, while goodwill generally attaches to business in the jurisdiction, certain types of pre-trading activity will be recognised as generating goodwill. Whether a pre-trading activity generates goodwill would depend on the nature and intensity of the activity in question. For instance, massive advertising campaigns before the commencement of trading to familiarise the public with the services or product may suffice as generating goodwill.

The High Court held that there was no goodwill in the F1 Plain Word Mark as at 11 January 2007, as the appellant did not have any business in Singapore as at 11 January 2007 and its pre-trading activities prior to 11 January 2007 were not targeted at generating demand in Singapore. For instance, the appellant submitted articles documenting television broadcasts in Singapore of the appellant’s championship and the promoting and marketing of “F1” merchandise, which they argued constituted substantial effort to establish goodwill in the Plain F1 Mark in Singapore prior to 11 January 2007. However, the High Court upheld the Assistant Registrar’s finding that the broadcasts were for the
Italian and Monaco Grand Prix and that there was no indication that it was intended to generate demand in Singapore for the opponent's goods and services. The appellant had also submitted numerous newspaper articles prior to 11 January 2007 which stated that Singapore might be hosting an F1 Grand Prix in 2008, but the High Court held that this did not amount to an unequivocal intention to enter the Singapore market.

**Bad Faith**

The High Court held that the appellant had failed to adduce any evidence to discharge their legal burden to prove bad faith. In contrast, the respondent had tendered evidence to support its assertion of prior use of the Plain F1 Mark in Singapore. The High Court affirmed the Assistant Registrar's finding that the extensive use of the term “F1” in relation to powerboat racing by the respondent between 1990 and 2004 and the fact that it is a term that relates to a particular class of powerboat racing and not exclusively with the appellant's motor racing events suggests that the respondent had not made the present application in bad faith.

In conclusion, the High Court upheld the Assistant Registrar's decision and dismissed the opposition on all grounds, allowing the Application Mark to proceed to registration.

**Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd**

[2015] SGHC 216

**Background**

Rovio Entertainment Ltd (the opponent) is the Finnish owner of the “Angry Birds” family of trade marks consisting of two marks (the “Red Bird Mark”) as well as the “ANGRY BIRDS” word mark (collectively, the “Angry Birds Marks”), both of which were registered in 2011 in class 30. These marks were used in relation to the popular mobile phone game franchise “Angry Birds”, which has 200 million active users worldwide, and 350 million downloads globally.

They launched an opposition against Kimanis Food Industries Sdn Bhd’s (the applicant) trade mark application for (the “Angry Bite Mark”) for snack foods in class 30, and filed in 2012, after the Angry Bird Marks.

**Executive Summary**

At first instance, the opponent failed on all the grounds of its opposition, and the Application Mark was directed to proceed to registration. The opponent subsequently lodged an appeal against that decision.

The opponent’s appeal in this case involved the key question of whether the Court could consider the separately registered Angry Bird Marks as a composite mark for the purposes of deciding whether the competing marks were similar, or whether the Court could only consider the Angry Bite Mark separately against the opponent’s Red Bird Mark and the ANGRY BIRDS word mark.

The Court eventually found against the opponent and affirmed the first instance holding, i.e. that it was not permitted to combine the opponent’s Angry Bird Marks for the similarity of marks comparison.

**The Opponent’s Arguments**

The opponent argued that, since a composite mark (consisting of both the Angry Birds Marks) could have been successfully registered as a trade mark as the individual components were already successfully registered, and since the opponent did in fact use the Angry Bird Marks as a composite on its products, the Court should consider it as a composite mark in the similarity of marks comparison.

The opponent further submitted that it was untenable to require trade mark owners to register every permutation of their registered trade marks. According to the opponent, it was not uncommon for trade mark owners to use their registered trade marks in a variety of combinations. If the law did not protect composites of two or more separately registered trade marks, this would severely reduce protection for registered trade marks. This, they contended, would be contrary to what was intended under the statutory regime.

Moreover, allowing the registration of the applicant’s Angry Bite Mark potentially gave the applicant legal grounds to object to the opponent registering the Angry Bird Marks as a composite, should it wish to do so in the future.

**The Applicant’s Arguments**

The applicant, on the other hand, submitted that there was nothing untenable about requiring trade mark proprietors to register all the permutations of their existing marks that they wished to use. They
asserted that this was already done by some trade mark owners.

Moreover, the applicant argued that allowing trade mark owners to mix and match various registered trade marks to form a composite, *de facto* registered mark provided excessive and unwarranted protection.

**The Court's Findings**

After an extensive survey of local and foreign case law, the Court noted that there was no direct local authority on the issue of whether two earlier registered trade marks may be combined into a composite whole for the purposes of the similarity of marks comparison. English law, on the other hand, appeared to disallow any such combination.

Having considered the parties' submissions, however, the Court took the view that the statutory purpose behind trade mark protection pointed against allowing the Court to combine the Angry Bird Marks.

The Court went on to address the opponent's submissions. In relation to the opponent's argument that it was impractical or untenable to expect trade mark proprietors to register each combination of the marks they intended to use, the Court noted that businesses already frequently register various permutations of their registered marks. While the Court acknowledged that, over the course of time, businesses may evolve the use of their trade marks such that the registered marks no longer sufficiently covered the trade marks that were used in practice, it did not follow that it would be unduly onerous or unfair to require a trade mark owner to register the evolved mark. If anything, the Court noted, the reverse was true as what was truly important in the trade mark registration regime was certainty. This is because a key objective of the trade mark registration regime and the trade mark register must be to give fair warning to other businesses and the public generally. Members of the public whose duty it is not to infringe registered trade marks are entitled to know with objective certainty which trade marks (and what they comprised) are and are not protected by registration.

The Court further noted that allowing a trade mark owner to claim protection over all the permutations of its registered marks would be granting excessive protection of a wholly uncertain scope. Doing so would limit competition from other businesses and expose them to unpredictable risks of infringement, and potentially increased trade mark litigation generally.

Even granting protection under the trade marks registration regime over a composite of just two separately registered marks which are used together in practice would create considerable uncertainty. The Court saw no reason why the trader should not be expected to register the composite mark either at the time when they applied to register the first two marks, or subsequently when their use of the registered trade marks and branding strategies made registered protection of the composite mark desirable.

Based on the above analysis, the Court went on to affirm the decision at first instance that it was impermissible to combine the opponent's Angry Bird Marks for the similarity of marks comparison against the applicant's Angry Bite Mark.

The applicant's Angry Bite Mark therefore survived the opponent's allegation that, since it was similar to the Angry Bird Marks in respect of similar or identical goods, there existed a likelihood of confusion, and it should be refused registration.

**JAPAN**

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Supreme Court of Japan Changes Product-by-Process Claim Interpretation

In a landmark decision that drastically altered the scope and practice of product-by-process claims in Japan, the Supreme Court of Japan overturned the leading IPHCJ decision on product-by-process claims and remanded the case back to IPHCJ for reconsideration under its new enunciated rule for product-by-process claims. This report outlines the events leading to this significant Supreme Court decision and how it will impact Japanese patent prosecution and enforcement practice of such product-by-process claims.

On 5 June 2015, the Supreme Court overturned and vacated the IPHCJ decision and abolished the IPHCJ's genuine/pseudo distinction and enunciated a new rule that the scope of a product-by-process claim should be determined as products having the same structure, properties and the like as a product produced by the process defined in the claim, even though the process of producing the product is defined in the claim. Accordingly, the
Supreme Court admitted that a product-by-process claim covers all the products having the same structure or properties as a product produced by the process defined in the claim even if the actual process for producing the product is different from the process in the claim.

Additionally, the Supreme Court held that generally, a product-by-process claim would be rejected as not complying with the “clarity requirement” of Japanese Patent Law. A product-by-process claim would be interpreted as complying with the “clarity requirement” only when there is circumstance that it is impossible or utterly impractical to specify directly the claimed product by structure or feature thereof at the time of filing date. The Supreme Court noted the following example: if it involves undue expense or time to characterise the product, this may be a circumstance where the product-by-process claim complies with the clarity requirement.

The Supreme Court remanded the case back to the IPHCJ to determine whether the product-by-process claim in question conformed to the “clarity requirement” of Japan’s patent law under its new enunciated test. In practice, the Supreme Court decision already has a significant impact on Japanese patent examination practice for a product-by-process claim. The Japan Patent Office (JPO) issued interim examination guidelines on 6 July 2015 as follows:

- When a claim concerning an invention of a product recites a manufacturing process of the product, the examiner will notify any reasons for refusal whenever the invention of that product is not clear. However, this will not be the case when the examiner can find that the invention involves “impossible or impractical circumstances”.
- The term “impossible or impractical circumstances” means any circumstances in which it is impossible or utterly impractical to define the product based on its structure or characteristics at the time the subject application for such product was filed.
- The reasons for refusal will be notified to give the applicant an opportunity to assert and prove the existence of “impossible or impractical circumstances”, and also an opportunity to make an argument and/or an amendment thereof. These opportunities are given in order to avoid situations in which an already granted patent could include grounds for invalidation, or in which interests of third parties could be unfairly harmed.
- The applicant can file other responses as arguments against a notice of reasons for refusal in order to resolve such reasons, including:
  (i) deleting any claim concerned,
  (ii) amending any claim concerned into a claim concerning an invention of a process for producing a product,
  (iii) amending any claim concerned into a claim concerning an invention of a product which does not include a manufacturing process, and/or
  (iv) asserting and proving the existence of “impossible or impractical circumstances” based on a written argument.
- When the applicant asserts and proves the existence of “impossible or impractical circumstances”, the examiner will, normally, conclude that “impossible or impractical circumstances” do exist. However, this will not be the case when the examiner has doubts, based on a tangible reason, about the existence of “impossible or impractical circumstances”.

The overall effect is that such product-by-process claims will be much harder to obtain in Japan in the future. In terms of enforcement, the Supreme Court appears to have broadened the coverage of product-by-process claims in that even if an infringer’s product is produced according to a method different from the one described in a patented product-by-process claim, the infringer’s product should be considered to fall within the scope of such product-by-process claim if the structure and characteristics of the infringer’s product are the same as those of the product by process claim.

However, the second prong of the Supreme Court’s newly enunciated test is that such product-by-process claims must satisfy the “clarity requirement” and accused infringers have been handed a potent defensive invalidation weapon. Accused infringers can now counter that the asserted product-by-process claim as not complying with the “clarity requirement” as there were no circumstances that it was impossible or utterly impractical to specify directly the claimed product by structure or feature thereof at the time of filing date.
In conclusion, the Supreme Court’s decision has changed Japanese patent prosecution and enforcement practice of product-by-process claims and will cause patent plaintiffs to think twice about asserting a product-by-process claim before suing, and will encourage many companies with existing product-by-process claim patent portfolios to take a closer look at their existing patents to assess their enforceability. Companies looking to prosecute such product-by-process claims should carefully monitor the new upcoming JPO examination guidelines when they issue and reconsider their specification and claim drafting strategies.

* John A. Tessensohn, Board Member, SHUSAKU YAMAMOTO. This article reflects only the personal views of the author and should not be attributed to the author's Firm or to any of its present or future clients.
From the Office of WIPO

Geneva

WIPO Welcomes Australia’s Continuing Support of IP Capacity-Building Projects

Geneva, 9 October 2015
PR/2015/782

WIPO Director General, Francis Gurry, welcomed on 9 October 2015 an Australian contribution of AUD $3 million for projects to help developing and least developing countries (LDCs) build capacity in the field of intellectual property.

The Director General thanked the Government of Australia for its support, stating: “WIPO is very grateful for the generous contribution from Australia which will enable continuation of the important work being done for the development of the capacity of least developed and developing countries to take advantage of the economic benefits of innovation and creativity.”

In a statement, Australia’s Ambassador and Permanent Representative to the World Trade Organisation Hamish McCormick said: “Australia’s contribution demonstrates its commitment to assisting least-developed and developing countries to promote and protect their creativity and innovation through the intellectual property and multilateral system, and recognises the strong collaboration between WIPO and Australia.”

IP Australia Director General Patricia Kelly said that she is pleased to be able to build on the outcomes achieved under the first Funds in Trust (FIT). “IP Australia is proud to continue the work of the WIPO-Australia FIT program, which will allow our partner countries to develop their IP systems and enhance their capacity to use IP to aid economic development.”

Australia’s FIT program began in 2012 with an investment of AUD$2 million in a range of innovative projects to help build capacity and address gaps in IP systems in developing and least developed partner countries, such as development of national IP strategies, support for researchers from developing countries under the WIPO Re:Search program, and supporting the production of books for people with print disabilities through the Accessible Books Consortium.

Australia announced its contribution at the WIPO General Assembly which met in Geneva from 5-14 October 2015.

Director General Francis Gurry Opens WIPO Assemblies

Geneva, 5 October 2015
PR/2015/781

WIPO Director General Francis Gurry opened the WIPO Assemblies by saying that increasing interest in intellectual property is driving uptake of WIPO’s global IP systems and resulting in a healthy financial state for the Organisation.

Welcoming hundreds of delegates to the 10-day engagement, Mr Gurry also cited advancements in the integration of infrastructure underlying the worldwide IP system, particularly in developing countries, as well as progress in public-private partnerships with WIPO involvement.

The Director General said that a “good overall surplus” is expected for the 2014-2015 biennium, following a 37 million Swiss francs surplus at the end of 2014. “The Organisation continues to enjoy a sound and, even, fortunate financial condition,” he said, “as a result of the rising interest in, and demand for, intellectual property, as knowledge, technology and creative works move to the centre of the contemporary economy and as governments respond by orienting economic strategies to innovation and creativity.” He added: “Intellectual property is a necessary, although not sufficient, component of successful innovation ecosystems and thriving environments for the creative industries.”

In addition to the continued growth of WIPO’s global IP systems – the Patent Cooperation Treaty (PCT), the Madrid System for marks and the Hague System for designs – geographical participation has evolved in line with more general economic trends. Asia, the Director General observed, is now the major origin of international patent applications, accounting for around 40% of the total, as against 30% for North America and 27% for Europe.

Mr Gurry underlined WIPO’s continued assurance of high quality of services while maintaining both
staff and fees at a constant level for seven years.

The Director General also pointed to advances in the soft infrastructure that underlies the operation of the IP system worldwide, namely global databases and information technology (IT) platforms, systems and tools, stating: “The various platforms that the Organisation is providing are increasingly forming part of a single global IP infrastructure platform that will, in the coming years, become more integrated.” These, he said, “will serve the interests of governments, users and the interested public alike by increasing efficiency, cost-effectiveness and transparency, as well as by enhancing the quality of outcomes in the operation of the IP system worldwide.”

Mr Gurry also noted that these platforms and systems represent a very good example of the implementation of the goal of the Development Agenda of mainstreaming development in the work of the organisation as they are oriented to the inclusion of the developing countries and to building their capacity to use and to participate in the IP system.

WIPO’s public-private partnerships are also bearing fruit, he said. WIPO Re:Search shares intellectual property to advance drug discovery in the areas of neglected tropical diseases, malaria and tuberculosis. Access to Research for Development and Innovation (ARDI) offers free or affordable access to scientific journals in LDCs and developing countries. Access to Specialised Patent Information (ASPI) partnership provides users in LDCs and developing countries with access to commercial patent databases. The Accessible Books Consortium (ABC) has made great progress in providing a practical vehicle for implementing the objectives of the Marrakesh Treaty.

“In each of these public-private partnerships, the private sector is making available or donating intellectual and financial assets. In each, the major beneficiary is persons and institutions in developing countries,” the Director General said. “Again, the partnerships are good examples of the mainstreaming of development and have been developed and are managed in parts of the Organisation outside our formal development sector,” he said.

Mr Gurry pointed out difficulties in moving forward in normative cooperation which provides the framework within which both the private and the public sectors are able to operate.

The lack of capacity to agree, he said, is a consequence of the increased value of intangibles and intellectual capital in the economy which has made innovation the focus of competition between enterprises, industries and economies. There are also enormous asymmetries in the distribution of knowledge and technology across the world and in the capacity to generate innovation, he said. In addition, the proliferation of bilateral, regional and plurilateral cooperation creates a more complex architecture that “tends, naturally, to suck some of the oxygen out of the multilateral space”. These developments, Mr Gurry said, require careful thought by member states on what can and should be done at the multilateral level.
Current Developments – Europe

EUROPEAN UNION

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Big Data Regulatory Update

The Current Phenomenon of Data

In the information society, computing storage becomes larger and cheaper over time. This enables datasets to be gathered together from open sources or other databases on a mass scale, which is greater than the traditional significant volume of data in banks or other individual organisations. Smarter statistical and computational analysis of these aggregated datasets from different sources may generate new value, meaning and context.1

In addition, artificial intelligence enables machines to replicate humans making decisions. Although machines are not as clever as people that make them, machines have the potential to continuously learn new datasets.2 Taking the advantage of data from various sources, a more sophisticated robot can just learn like a child.3 When such a robot has access to a database of facial expressions, it may have the ability to learn to recognise the expression of other faces and can gradually react to different humans engaging with him in a different way.4 All of these generate a new phenomenon known as “open data” and “big data”.

If robots with access to big data become so intelligent and closely connected to human beings, they may potentially cause other social and legal consequences. For example, there is a growing concern that whether human beings would be able to live in harmony with robots. It was reported that in Japan people “grow so attached to their robot dogs that they hold funerals for them when they ‘die’”.5 The interaction between robots and human beings, i.e. marriages and other contractual issues may also raise legal concerns.

This report looks into the concepts of open data and big data and discusses the legal challenges and regulatory development for the current phenomenon. It also seeks possible solutions to promote legal certainty in the era of big data.

Open Data

The relationship between open data and big data is that open data may provide a substantial amount of sources for big data. The term “open data” refers to “a subset of data, namely to data made freely available for re-use to everyone for both commercial and non-commercial purposes”.6 It also includes the re-use of public sector information – “the wide range of information that public sector bodies collect, produce, reproduce and disseminate in many areas of activity while accomplishing their Public Task”.7

In response to current barriers to public section information re-usage, in 2013 the Directive on Re-use of Public Sector Information was amended in order to remove barriers to the re-use of such information across the European Union.8 Member States were required to implement the revised Directive no later than 18 July 2015. In the UK, work has been progressing. For example, back in November 2011, the Chancellor of the Exchequer, George Osborne, had already presented his Autumn Statement to Parliament, which acknowledged that making more public sector information available would help catalyse new markets and innovative products and services as well as improving standards and transparency in public services. Taking into consideration the benefits of the usage of open data, the UK Government intended to open up access to core public datasets on transport, weather and health, including giving individuals access to their online GP records. It also promised to provide up to £10 million over five years to establish an Open Data Institute to help industry exploit the opportunities created through release of this data.9

Although Member States, such as the UK, consider open data to be of great value to society, there is still a general concern over data privacy protection, in particular health data, in practice. This prompts the consideration of the balance of trade-off between openness and privacy as they are not mutually exclusive.10 In order to strike the balance, data owners may need to understand their best interests to make informed decisions, while data providers may employ license restriction of using datasets. Accordingly, the European Commission has established the EU open data policy and legal framework; and prepared guidelines on recommended standard licences, datasets and charging for the re-use of documents to facilitate the implementation.11

In addition, other legislative and technological measures are also in place to further open up data for access and re-use. For example, the EU Open Data Portal and one-stop-shop open data digital service provide open data access across the EU. There are also measures which promote scientific
discovery and collaboration across disciplinary and geographical boundaries in the Commission’s scientific information package. Moreover, a number of Commission initiatives covering sector-specific data (transport, environment, etc.) as well as Guidelines on Open Access to Scientific Publications and Research Data in Horizon 2020 have been introduced to foster open data policies.

**Extra-large Datasets: Big Data**

Parallel to the regulatory development for open data, a new regulatory framework for extra-large data has also been called for. When extra-large data from a substantial amount of open data and other sources is generated, it generates a new phenomenon called “big data”. Extra-large data from various sources at a high speed does not just let us see more of the same thing we were looking at, but also allows us to see new, better and different aspects for enhanced insight and decision making. For example, when sufficient data is collected in a service-oriented computing system for car parking services, drivers’ credit cards will be automatically charged for the parking fee without any human interaction, as the automated system will immediately identify where those drivers are and what drivers are doing.

Just like the anti-theft device in cars developed in Tokyo, the car could recognise that a non-approved driver was behind the wheel, and the engine would just stop. Moreover, the emerging technology of driverless cars is also supported by big data analytics. In the US, big data is also used to help FBI fraud crackdown by identifying, tracking and prosecuting criminal activity in the Medicare system. This prompts an urgent need for big data management. It was reported that there is “a tenfold increase in demand for big data staff in the past five years, with vacancies rising from 1,800 in 2008 to 21,400 in 2013 – an average annual increase of 212 per cent”. This also urges for regulatory updates to be considered because the concept of “big data” challenges the traditional legal principles. There are three main issues as follows:

(a) When such data comes from different sources, it raises the issue of the ownership, usage rights and copyright.

(b) When such data comes from different individuals, it raises the issue of privacy and data protection.

(c) When such data comes from different jurisdictions, it raises the issue of restriction and harmonised standards of cross-border data transfers.

It is clear that all of the legal issues above have been covered by relevant legislation (regardless of their sufficiency) when governments, businesses and individuals are dealing with data before it attracts the name of “big data”. It is debated that it is not having “big data” that makes it different, but it is what people do with it that matters. However, this does not mean that “big data” is the same as “open data”, or should be treated the same as traditional datasets. “Big data” might be “closed and proprietary, not necessarily to the public at large” from different sources which require further consideration for regulations.

In response to the market trend on the emerging technologies supported by big data analytics, the EU Commission recognises that “this global trend holds enormous potential in various fields, ranging from health, food security, climate and resource efficiency to energy, intelligent transport systems and smart cities, which Europe cannot afford to miss.” Subsequently, the EU has launched communications towards a thriving data-driven economy, which is to set out some operational conclusions to support and accelerate the transition to the establishment of the right framework conditions for a single market for big data and cloud computing. The key tasks include “making sure that the relevant legal framework and the policies, such as on interoperability, data protection, security and IPR are data-friendly, leading to more regulatory certainty for business and creating consumer trust in data technologies; and rapidly concluding the legislative processes on the reform of the EU data protection framework, network and information security, and support exchange and cooperation between the relevant enforcement authorities (e.g. for data protection, consumer protection and network security)”.

**Legal Challenges of Big Data**

In order to establish a feasible legal framework for the phenomenon of “big data”, various key legal issues should be addressed and sought for interpretation. They are:

(a) How should “big data” be defined from a legal perspective?

(b) Under which laws should “big data” be governed? Is it database law, privacy law, data protection law, intellectual property law or others? When disputes occur, how is jurisdiction determined?

(c) If there is no current legislation providing provisions on big data, in what direction should the future legislation be heading? Is it possible to
interpret and apply traditional legal principles to big data issues in the digital economy? Or, is it feasible to foster innovation, protect rights holders, and promote the free flow of information by reforming existing law, developing specific policies and guidance for companies and consumers, or encouraging self-regulation?

Although the European Commission has not yet fully looked into all of the main issues above, slow progression has been made since 2012. For example, in 2012 the Commission proposed a major reform of the EU legal framework on the protection of personal data in order to strengthen individual rights and tackle the challenges of globalisation and new technologies.23

In 2014, the Commission continued working on a reform package to work towards a thriving data-driven economy, which aimed to build a single, modern, strong, consistent and comprehensive data protection framework for the EU. This is in line with a growing recognition for the need of a regulatory environment that strengthens individuals’ trust and confidence and enhances legal certainty for the development of innovative and sustainable data goods and services such as “big data”. The Commission stipulated that “the fundamental right to personal data protection applies to big data where it is personal: data processing has to comply with all applicable data protection rules.” 24 In addition, there are a series of legal measures suggested in this reform package to build the trust in order to exploit the full potential of the data-driven economy:

(a) Horizontal consumer and marketing law also applies to products based on big data technology. The Commission will ensure that small and medium-sized enterprises (SMEs) and consumers, suppliers and users, are given all necessary information, are not misled and can rely on fair contracts, notably as regards the use of data collected from them.

(b) The Commission also work with Member States and stakeholders to ensure that business, and in particular SMEs, receive adequate guidance, notably on issues such as data anonymisation and pseudonymisation, data minimisation, personal data risk analysis, and tools and initiatives enhancing consumer awareness. The Commission will also actively support research and innovation (R&I) for related technical solutions that are privacy enhancing “by design”.25

Meanwhile, the European Council also recognised the interplay between cloud computing and big data by calling for EU action to provide the right framework conditions for a single market for Big Data and Cloud Computing in its conclusions of October 2013.26 This echoed the view of the Commission, which launched a consultation process on the concept of user-controlled cloud-based technologies for storage and use of personal data (personal data spaces) in the phenomenon of big data.27

**Challenges of Big Data Definition**

In 2012, International Data Corporation (IDC) defined “Big Data technologies” as “a new generation of technologies and architectures designed to extract value economically from very large volumes of a wide variety of data by enabling high-velocity capture, discovery, and/or analysis”.28 In industry, the concept of “big data” has been further interpreted from a technical point of view, which “describes a holistic information management strategy that includes and integrates many new types of data and data management alongside traditional data. While many of the techniques to process and analyse these data types have existed for some time, it has been the massive proliferation of data and the lower cost computing models that have encouraged broader adoption”.29

As the name of “big data” indicates, big data is something “big” in size and it is “data” in nature. “Big data” is data that is unprecedented in scale and scope.30 “Big data” has been described as a phenomenon rather than a technology.31 It is often described in terms of the “three Vs” – volume, variety and velocity.32 An IT company, Oracle, has recently provided an architecture overview on “big data”, suggesting that one additional V – value – should be considered as an attribute of “big data”.33 In some cases, dimensions of “big data” have been further extended to “incorporate related considerations such as Variability (the daily, seasonal and event-triggered peaks in data) and Complexity (the challenge of linking, cleaning and matching data across multiple sources)”.34

A recent study of Big Data Analytics concludes that “there is no universally recognised operational definition of big data”.35 However, the Commission has continued to try defining the term “big data” in its recent work agenda towards a thriving data-driven economy as follows:

“Big data” refers to large amounts of different types of data produced with high velocity from a high number of various types of sources. Handling today’s highly variable and real-time datasets
requires new tools and methods, such as powerful processors, software and algorithms.  

To further differentiate big data from ordinary data, it is necessary to add the terms of “new” and the “three Cs” in addition to the “three Vs”. The data only becomes big (in a sense that the current regulation may need to be reviewed) when it generates a new set of data when information is aggregated; and it is “cross sectors”, “cross purpose”, and “cross border”.

Legal and Regulatory Developments

Great debates in big data have been generated by the foremost thinkers in their fields including law academics, practitioners, computer scientists, and business. Such debates go beyond what can be applied under the existing legal frameworks in countries, prompting law makers and business to consider the key tensions and questions underlying the subject matter and setting legal and regulatory developments in an interdisciplinary context.

Data Protection and Security

Data Privacy Protection

In the era of big data economy, it is widely accepted that the benefits of such new phenomenon cannot simply be traded with privacy rights. 37 In the UK, the recent Information Commission Office (ICO) Big Data and Privacy Report emphasises that the key Principles of the Data Protection Act (DPA) which should be considered when using Big Data are:

- That the processing of the personal information is fair and lawful.
- That further processing purposes must not be incompatible with the original processing purpose (i.e. the “purpose limitation” Principle).
- That the conditions for processing must be satisfied. These are either: that the consent of the individual concerned has been obtained; that the processing is necessary for the performance of a contract that an individual has entered into; or that the processing is necessary for the purpose of legitimate interests. 38

This implements the principle of fairness concerning the processing of data under the EC Directive on Data Protection. 39 The Proposed General Data Protection also contains relevant provisions concerning the assessment of the principle of fairness. The Proposed General Data Protection Regulation requires that “the data subject should be informed in particular of the existence of the processing operation and its purposes, how long the data will be stored, on the existence of the right of access, rectification or erasure and on the right to lodge a complaint. Where the data are collected from the data subject, the data subject should also be informed whether they are obliged to provide the data and of the consequences, in cases they do not provide such data”. 40 That is, the assessment of principle of fairness should include the users’ consent, the purposes of data processing and the minimum period of data storage.

Under the current EU Data Privacy Protection Framework, if an organisation is relying on users’ consent as the condition for processing their personal data, that organisation must notify users of terms and conditions, and users’ consent must be “freely given, specific and informed”. If an organisation has collected personal data for one purpose and then decides to start analysing it for completely different purposes, it needs to make its users aware of this. Users also have the “right to be forgotten” if their data is no longer necessary for the purposes for which they were collected or processed.

The Court of Justice of the European Union (CJEU) recently interpreted and implemented the “Right to be Forgotten” principle in the case brought by Google Spain SL (Google Spain) and Google Inc. against the Agencia Española de Protección de Datos (Spanish Data Protection Agency; (AEPD)) and a Spanish citizen Mr Costeja González. 41 The judgment supports that the operator of the search engine – Google Inc. – has the responsibility to remove search results concerning individuals, which is no longer necessary and relevant, upon users’ requests. However, it is worth noting that this is a highly technical and demanding task for data controllers to determine the nature and sensibility of those data concerned and to deploy appropriate technical measures. While it is fully understandable that courts give such orders to ensure the enforcement of the “right to be forgotten” principle, it could become a burdensome responsibility for operators of search engines and lead to ineffective outcomes without harmonised standards. 42

In practice, individuals always make the choice required in order to obtain desirable service or product, though they may not understand or read any terms. If in the sphere of big data, thousands of data exchanges by and about every individual
Current Developments – Europe

occur at a high speed around the globe every day, it remains an ongoing challenge to meet the required principles of “notice”, “consent” and “right to be forgotten” according to the Proposed General Data Protection Regulation.

Ownership and Transfer of Data

Nowadays, some car insurance companies offer policies for younger drivers with a discount if they allow a “black box” to be fitted to the vehicle. Such a black box will typically measure lateral and longitudinal acceleration, possibly time stamped and with positional information obtained from GPS, in an attempt to profile the ability and safety of the driver, and thus estimating whether the driver is at high or low risk of becoming involved in an accident. Drivers determined to be at a lower risk may gain the benefit of lower insurance premiums.

Although this data is related to a specific person, it can be combined and used anonymously to help develop competitive insurance packages to other customers. Thus, this data is valuable to all insurance companies. In addition, it could also be useful for software developers or automobile producers to generate dashboard warnings to drivers when similar unsafe driving occurs. If it is merged with other datasets, the combined datasets may be used to help foresee other circumstances, for example, traffic jams, road work and accident blackspots. So who is the owner of this data? Is it the owner of the car or the driver? Or is it the seller, the insurance company, or the automobile manufacturer?

It is noteworthy that downloading a piece of software may be subject to a contract of sale. It is debatable whether contracts for the supply of intangible goods (such as data and software) should be considered as a contract of sale for service other than a contract of sale of goods, in particular the supply of individualised/custom-made software with datasets rather than standardised/ready-made software.

In the English case of St Albans City and DC v ICL, Sir Iain Glidewell stated that software could constitute goods, because the software program itself is a formula, and it is of necessity contained in a physical medium. A program in machine readable from must be contained on a machine readable medium, such as paper cards, magnetic cards, magnetic tapes and discs. On 3 July 2012, the CJEU published its landmark decision in UsedSoft GmbH v Oracle International Corp, ruling that the commercial distribution of software via online downloading may be based on a contract of sale of goods in addition to a licence agreement. Under the contract of sale of goods, the copyright holder of the software cannot prevent a permanent licensee from reselling his software. This implies that a specific ownership may be attributed to intangible goods (i.e. downloaded software).

Accordingly, it raises debate over the ownership of data, and whether electronic databases should be considered as property. For example, in the US case of Yazoo Pipeline, it suggests that data “could not exist apart from some physical storage medium, such as a computer, flash drive, tapes, or film” and “could be accessed by a human user in a manner analogous to the access of traditional tangible property”. The recent English case of Your Response Ltd v Datateam Business Media Ltd, concerning whether data might be subjected to liens, provides that:

The electronic database was a type of intangible property which, unlike choices in action, was capable of possession and thus of being subject to a lien. An electronic database consists of structured information. Although information may give rise to intellectual property rights, such as database right and copyright, the law has been reluctant to treat information itself as property. When information is created and recorded there are sharp distinctions between the information itself, the physical medium on which the information is recorded and the rights to which the information gives rise. Whilst the physical medium and the rights are treated as property, the information itself has never been.

It is debatable whether the concept of intangible property over the internet can be accepted. In the absence of legislation recognising intangible goods as property, it is suggested that copyright protection might help to protect the structure of the database if the database is based upon a highly original concept.

It is also suggested that the sui generis rights of the owner of the website or the database may also be used to protect information. According to the EC Directive on Databases, the holder of database rights may not place restrictions of the purpose to which the insubstantial parts are used (Article 8(1)). In the age of big data, Article 8(1) of the EC Directive on Databases is unlikely to be applicable to mass data collection and analysis.
In addition, the EC Directive on Databases allows the protection of a substantial amount of time and money invested in structured data, which may also restrict the re-utilisation of database in the era of big data economy. In the CJEU case of the British Horseracing Board Ltd and Others v William Hill Organization Ltd, the CJEU diminished the factor of publicity that “the fact that the contents of a database were made accessible to the public by its maker or with his consent does not affect the right of the maker to prevent acts of extraction and/or re-utilisation of the whole or a substantial part of the contents of a database”.

With regard to the determination of database “extraction”, in the case of Directmedia Publishing GmbH v Albert-Ludwigs-Universität Freiburg, the CJEU also ruled that “the transfer of material from a protected database to another database following an on-screen consultation of the first database and an individual assessment of the material contained in that first database is capable of constituting an “extraction”, to the extent that – which it is for the referring court to ascertain – that operation amounts to the transfer of a substantial part, evaluated qualitatively or quantitatively, of the contents of the protected database, or to transfers of insubstantial parts which, by their repeated or systematic nature, would have resulted in the reconstruction of a substantial part of those contents”. In theory, the robot search for data from billions of websites at least once a day for a substantial part of content should constitute an “extraction”. However, in practice, robots have been commonly used for commercial purposes taking necessary precautions to avoid significant negative impacts.

Cross-border data transfer in the phenomenon of big data may also experience legal barriers under the current EU framework. Transfer of data to a third country or to an international organisation may only take place if the other jurisdiction meets the adequate standard. However, one of the exceptions to this principle is that “the transfer is necessary for the purposes of the legitimate interests pursued by the controller or the processor, which cannot be qualified as frequent or massive” (Article 44(1)(h) of the Proposed General Data Protection Regulation). The term “massive” hints at the phenomenon of “big data”. This may constitute a substantial impediment to the operation of big data from the EU to other parts of the world.

In response to the challenges to data ownership and cross-border data transfer, the Commission has recently started its study on such barriers, considering future policy actions, notably by taking into account the Trusted Cloud Europe report and recommendations by the European Cloud Partnership. In addition, the Commission has also taken various other actions and measures to develop a healthy big data environment and to build the trust that is necessary to exploit the full potential of the data-driven economy. They include:

- Launching a consultation and expert group to assess the need for guidance on specific issues of data ownership and liability of data provision, in particular for data gathered through Internet of Things (IoT) technology.
- Launching a consultation process on the concept of user-controlled cloud-based technologies for storage and use of personal data (personal data spaces), and support R&I on tools to assist users in selecting the data sharing policies that best match their needs. This is to enable users to better control and secure their data and to support projects aiming at reducing personal data breaches and ensuring original purposes of data collection.
- Consumer and marketing law also horizontally applies to products based on big data technology. This is to ensure the availability of necessary and non-misleading information and fair contacts concerning the use of data collected from SMEs, consumers, suppliers and users.
- With regard to security measures, the Commission will “explore the landscape of security risks relating to big data and will propose risk management and mitigation measures, including guidelines, e.g. on good practices for secure data storage, to further a security culture in many sectors of society and help detect and better respond to cyber-attacks. The Commission will also support Research and Innovation (R&I) to help reduce the risk of data breaches and of databases being exploited covertly for unlawful purposes.”
- This continues and enhances the work from the Cybersecurity Strategy for the European Union and the Commission proposal for a Directive on Network and Information Security. One of the most relevant legal measures concerning big data management is to establish a Public-Private Platform on Network and Information Security which identifies risk management and provides information sharing practices.
**Intellectual Property Protection**

As shown above concerning big data management, big data involves creation, mass collection and re-utilisation of data from different sources. The creativity of big datasets may be subject to the protection of intellectual property rights, whilst its re-utilisation from the mass collection of data (known as “data-mining”) may potentially infringe other right holders’ intellectual property rights, in particular copyright. In order to protect rights holders’ rights, the Commission has been investigating ways to enhance data-driven innovation based on data-mining, including text-mining in relation to copyright. The Commission thus tries to note possible exception rules which may facilitate mass data analysis activities in Member States under the current copyright framework.64

As discussed earlier, it is commonly known that the cloud may be used as an enabler for big data analytics.65 Parallel regulations on cloud computing and big data technologies are of necessity. It is noted that copyright aspects of cloud computing are considered a very important issue for building the digital single market in Europe, and that it is recommended for the review of the private copy levies focused on trying to fix the existing system and included suggestions to improve it by the European Commission in 2013.66 Accordingly, the issue of IP protection in the cloud-based environment and big data phenomenon was addressed by the European Parliament in 2014. The resolution of 27 February 2014 on private copying levies calls on “the Commission to assess the impact on the private copying system of the use of cloud computing technology for the private recording and storage of protected works, so as to determine whether these private copies of protected works should be taken into account by the private copying compensation mechanisms and, if so, how this should be done”.67 In 2014, the Report on the Implementation of the Communication, “Unleashing the Potential of Cloud Computing in Europe”, further clarified that “cloud based online content services provide unique opportunities to be remunerated on the basis of direct licensing deals, rather than indirect compensation mechanisms on devices, such as private copying levies”.68 It further provided three key actions in respect of standards and certification; development of safe and fair contract terms and conditions; and the launch of the European Cloud Partnership with the aim to bring together the public and the private sector.69

In addition, the Commission considered actions to follow up with the specific recommendations in the context of the on-going review of the EU copyright rules, in particular patent and trade mark aspects in relation to cloud services.70

This reaffirms the relationship of protection between big data and intellectual property. That is, as Tepp at US Chamber of Commerce Foundation explained:

> Collecting and storing data involves patented hardware. Organising and analysing the data involves software that is probably both patentable and copyrightable. The computer processors that run those programs are likely patented. The data itself may be a proprietary trade secret. Reports and interpretations that are produced are copyrightable. And trade marks will help us identify the companies that produce the best analyses and forecasts.71

It is important that patent, copyright and trade mark laws are efficiently employed to fight off unfair competition and unauthorised usage, and support innovation and market development. As the use of “big data” grows and develops, policymakers and businesses may face fundamental questions that need to further apply to the specifics of the “big data” marketplace as follows:

(a) What are the right incentives to encourage both the collection of data and a market for that data?
(b) How can we maximise the development and implementation of tools to analyse and interpret “big data”?
(c) Who should make those decisions: the government or the private sector?72

Although “cloud interoperability and data portability” increase efficiency and promote innovation, intellectual property (IP) rights may be used by the IP rights holders to prevent other cloud providers from interoperate the existing products. Such a balance may be possibly achieved through a sound legal infrastructure at community level, i.e. the interplay between the IP rights and competition rules which can be developed upon the previous experience of traditional software interoperability.73

Moreover, safe and fair model contract terms for cloud services in the phenomenon of “big data” may be of great help to enhance best practices and protect different right holders’ rights. The EU Commission has been working on this. It is noteworthy that an expert group on model contract terms and conditions for cloud services
for consumers and small firms and a working group with industry stakeholders on service level agreements for professional users were recently established in order to identify and disseminate best practices in respect of model contract terms for cloud services and to increase trust of prospective customers.74

**Jurisdictional Issues in Big Data and Cloud Environment**

Last but not least, in the “big data” and cloud environment, the threat to the use of the cloud in big data mainly includes content infringement (e.g. data security, privacy and IP rights infringement) and performance infringement (e.g. non-compliance with the requirements of cloud computing services and/or product description). In such an environment, it is likely that data centres may be relocated or added at any time and as a result they may be located in various jurisdictions. This may contribute to the difficulty in identifying the location of infringement and determining the competent court and applicable law. In addition, the need of striking proper balance between cloud interoperability, data interoperability and other rights protection may also contribute to the complexity of determining jurisdiction and applicable law.75

As to jurisdiction concerning data privacy protection in the big data and cloud environment, under the current Commission’s regulatory reform, Articles 3, 75(2) and 76(3)(4) of the Proposed General Data Protection Regulation in conjunction with the Brussels I Regulation (Recast) extend and advance the existing rule in Articles 4, 17(3) and Recital (20) of the EC Directive on Data Protection.76 For example, the Proposed General Data Protection Regulation provides a principal provision in its Article 72(2) concerning jurisdiction for data protection, which stipulates that “proceedings against a controller or a processor shall be brought before the courts of the Member State where the controller or processor has an establishment. Alternatively, such proceedings may be brought before the courts of Member State where the data subject has its habitual residence, unless the controller is a public authority acting in the exercise of its public powers”.77

As to jurisdiction concerning IP rights infringement in the “big data” and cloud environment, information published online can be accessed everywhere in the world except for geo-blockings. This challenges the traditional theory of the determination of copyright infringement which is subject to the protection of national law, because once a copyrighted work is distributed via the internet without the rights holder’s consent, damage may occur immediately anywhere in different countries. Moreover, events giving rise to such damage may also be in multiple jurisdictions. This requires justification and interpretation of the rules of internet tort jurisdiction for online copyright infringement.77 According to the effects approach in Article 5(3) of the Brussels I Regulation (or Article 7(2) of the Brussels I Regulation (Recast) 2012), there may be multiple locations that can qualify as the place where the harmful event occurs: (a) the place of the event giving rise to the damage; and (b) the place where the damage occurred. It is most likely that parties may need to enforce their IP rights in courts of different countries.78

The CJEU once again confirmed in the recent case of Pez Hejduk that the expression of “place where the harmful event occurred or may occur” in Article 5(3) of the Brussels I Regulation is intended to cover both possibilities:

- The place where the damage occurred.
- The place of the event giving rise to it.79

The principle of territoriality has also been consistently deployed to determine online copyright jurisdiction in Pinckney (Case C-170/12) and Pez Hejduk (Case C-441/13). That is, copyright rights, which were automatically granted without the need of registration, are subject to the principle of territoriality. Those rights are thus capable of being infringed in each Member State in accordance with the applicable substantive law.80 The Court explained that the protection of copyright “granted by the Member State of the court seised is limited to the territory of that Member State, a court seised on the basis of the place where the alleged damage occurred has jurisdiction only to rule on the damage caused within that Member State.”81 The principle of territoriality limits the scope in which the courts of respective Member State of registration are capable of ascertaining damage caused in that Member State.

**Afterthoughts**

“Big data” seems to transform how people live, work and think. It may also increase efficiency, productivity, safety, convenience, opportunities and profits in businesses and daily life. As pointed out in this report, the phenomenon of “big data” still faces legal uncertainty as there is no single
legislation which specifically tackles legal issues of “big data”. This update suggests that traditional legal concepts and principles of database law, data privacy protection law, intellectual property law, contact law and private international law need to be interpreted and applied to the specifics of the big data marketplace.

In addition, best practices and guidelines may also be helpful to contribute to the well-being of citizens as well as to socio-economic progress. Currently, the EU Commission is in the process of consulting with Parliament, Council, Member States and all relevant stakeholders to draw up a more detailed, multi-layered and evidence-based action plan for advancing towards the data-driven economy of the future and addressing Europe’s future societal challenges. However, the question remains as to whether it would be feasible to propose a balanced regulatory framework covering all areas of laws in response to the emerging technologies assisted by cloud services in the phenomenon of “big data”. This would then answer whether machine intelligence intertwined with “big data” in the cloud-based environment may foster a healthy economic and societal growth or cause chaos of social and legal order.


43. Heller, P., Pizik, D. and Knudsen, K., “An Enterprise Architecture White Paper – An Enterprise Architect’s Guide to Big Data – Reference Architecture Overview”, May 2015. Available at: http://www.oracle.com/technetwork/topics/entarch/articles/oec-oa-big-data-guide-1522052.pdf (last accessed 26 October 2015), p.4. “Value Data has intrinsic value – but it must be discovered. There are a range of quantitative and investigative techniques to derive value from data – from discovering a consumer preference or sentiment, to making a relevant offer by location, or for identifying a piece of equipment that is about to fail. The technological breakthrough is that the cost of data storage and compute has exponentially decreased, thus providing an abundance of data from which statistical sampling and other techniques become relevant, and meaning can be derived. However, finding value also requires new discovery processes involving clever and insightful analysts, business users, and executives. The real Big Data challenge is a human one, which is learning to ask the right questions, recognizing patterns, making informed assumptions, and predicting behaviours.”


51. Case C-131/12, Google Spain SL and Google Inc. v. Agencia Española de Protección de Datos (AEPD) and Mario Costeja González, Judgment of the Court (Grand Chamber) of 13 May 2014, para. 2.


54. St Alkmun City and DC v. ICZ [1996] All ER 481.

55. CJEU Case C-128/11, Unisys GmbH v. Oracle International Corp, Judgment of the Court (Grand Chamber), 3 July 2012.

56. Hoeren, T., “Big data and the ownership in data: recent developments in Europe”, (2014) European Intellectual Property Review, 36(12), pp.751-754 at 753. This paper also points out that there is contradictory judgment concerning the ownership of data in the two german cases – Nuremburg (OLG Nürenberg 1. Strafsenat, Beschluss vom 23.01.2013 - 1 Ws 445/12) and Szexy (LAG Sachsen, Urteil vom 17.01.2007 - 2 Sa 808/05).


Current Developments – Europe

77 Wang, F. (2015), “Online Copyright Jurisdiction: CJEU Ruling in Pez Hdyjuk (C-441/13) to Comparison with that in Pinckney (Case C-170/12) and Other Internet Tort Jurisdiction Cases”, (March 2015), Issue 100, Intellectual Property Forum, pp.89-94 at 89.
79 Case C-441/13, Pez Hdyjuk v EnergieAgentur.NRW GmbH, Judgment of the Court (Fourth Chamber), 22 January 2015, para. 18.
80 Case C-441/13 Pez Hdyjuk, para. 22; and Case C-170/12 Pinckney, para. 39.
81 Case C-441/13 Pez Hdyjuk, para. 36; and Case C-170/12 Pinckney, para. 45.

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Inadmissibility of a Copyright Infringement Action which is not Brought against All the Co-authors of a Work of Collaboration

Under French copyright law, a work of collaboration is a “work to the creation of which contributed more than one natural person”, Article L. 113-3 of the French Intellectual Property Code (IPC) provides that such a work is “the joint property of all the co-authors” and that “the co-authors shall exercise their rights by mutual agreement”.

French case law used to consider that an action brought by a co-author and aimed at defending the patrimonial rights of the latter was inadmissible if the other co-authors were not involved in the proceedings. In the same manner, an action based on a patrimonial rights infringement brought against one of the co-authors only, without involving in the proceedings the other co-authors, was held inadmissible.

As to moral rights (such as the right to respect of the work’s integrity or a paternity right), some courts held that, as those rights were very personal by their nature, each co-author could act alone in order to defend their own moral rights.

A decision issued by the French Supreme Court (Cour de cassation) on 30 September 2015 condemned such difference in assessment of the admissibility of an action depending on whether such action was brought on the basis of patrimonial rights or on the basis of moral rights.

In the present case, the author of a musical composition entitled “For Ever”, Mr X, brought an action based on the alleged infringement of both his moral and patrimonial rights against Mr Y (songwriter and publisher), Mr Z (co-author of the arrangements) and EMI Virgin Music Publishing (co-publisher), who had all contributed to the creation of two songs entitled “Aïcha 1” and “Aïcha 2”.

The Paris Court of First Instance held that the “Aïcha 1” and “Aïcha 2” songs did infringe Mr X’s copyright in the “For Ever” song.
In an appeal filed with the Paris Court of Appeal, the co-authors of the “Aïcha 1” and “Aïcha 2” songs raised the inadmissibility of the Mr X’s action since Mr A, the co-author of the “Aïcha 2” song’s lyrics, was not made a party to the proceedings. However, the appeal Judges rejected such inadmissibility claim on the grounds that since the appeal was lodged on the basis of moral rights only, and not patrimonial rights, it was not required to involve all the co-authors in the proceedings.

Referring to Article L. 113-3 of IPC, the Cour de cassation quashed the appeal decision on this point, stating the following principle: “To be admissible, an infringement action brought against a work of collaboration, which is a joint property of its co-authors, must involve all the co-authors in the proceedings, since their contributions to the work cannot be separated, whatever the nature of the copyrights invoked by the plaintiff” (emphasis added).

As a result of this important decision, every judicial action dealing with a work of collaboration requires the involvement in the proceedings of all the co-authors, regardless of the type of rights at stake (patrimonial rights, moral rights or both). The omission of one of the co-authors could lead to the inadmissibility of the entire action.

In practice, it may be difficult for a plaintiff to ensure that they have brought their action against every person having participated in the creation of the alleged infringing work of collaboration, since some of those co-authors could be unknown to the plaintiff at the stage of initiating proceedings.

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Ownership of Pictures Realised by an Employee of a Photography Agency

Relationships amongst press publishers or photograph agencies do not only give rise to claims connected to copyright ownership. Possession and ownership of the physical support itself remain key issues, should inter alia the photographers or their heirs be willing to retrieve them. Indeed, and until photographs were digitally taken, it was common for publishers or agencies to retain and store the photographers’ Ektachrome or films since they were in charge of the editing process.

Under French law, the regime covering both the copyright and the ownership of the physical support is governed by different rules from which it results that owners of property and of copyright may well be different. In that regard, Article L. 111-3 of the IPC provides that the copyright “shall be independent of any property right in the physical object”. Therefore, the mere possession of films cannot establish per se that its possessor is its author or copyright owner, nor can the transfer of films or Ektachrome imply an assignment of the copyright from the author. Any decision to the contrary would constitute a breach of Article L. 111-1 of the IPC, which provides that “the existence or conclusion of a contract for hire or of service by the author of a work of the mind shall in no way derogate from the enjoyment of the right”.

The possession of the films by a person (who could be different from the author) will, however, give rise to a presumption of their physical ownership by such a person, as stated by Article 2276 of the Civil Code. Similarly, the existence of an employment or commissioning agreement between the photographer and its contractor will in most cases establish the ownership of films to the benefit of the latter. Several French courts have adopted similar rulings. However, to our knowledge, they have not yet been confirmed (nor challenged) by the French Supreme Court (the Cour de cassation).

A very recent decision rendered by the Supreme Court on 28 October 2015 and to be published in the annual Bulletin has considered that the person in charge of “financing the blank camera rolls and the technical expenses for their development” is the initial owner of the material support (i.e. the rolls containing in essence the photograph or photographs developed with the authorisation of the author). This decision adopted a principle which was inter alia emphasised in 2002 by the Versailles Court of Appeal or more recently by the Paris Court of First Instance.

In that case, the Court of Appeal did, however, consider that the photographer working as an employee for the French magazine, Lui, had not assigned the physical property of the films to the company publishing the magazine. The appellate Judges had further even considered: (i) that the photographer by printing a photograph on the camera rolls was the initial owner; and (ii) that the payment of expenses and costs by the company was not relevant. That decision was quashed.
by the *Cour de cassation*, on the basis of Article L. 111-3 of the IPC, but also of Article 544 of the *Civil Code* providing for the definition of ownership, it being specified that that definition does not apply to copyright.

The position from the *Cour de cassation* is all the more logical in that it clearly draws a distinction between the ownership of the property (physical or support) and the ownership of the copyright, which fully complies with essence of Article L. 111-3 of the IPC. More interesting will be to see in the future how this position will cope with other decisions rendered by French courts. Indeed, the Paris Court of Appeal had considered in 1984 that the author of photographs remained the owner of camera rolls when the latter was reimbursed by its commissioner. More recently, it was considered that the photographer who was providing pictures to a publisher in view of an exploitation amounted to a deposit agreement in which the photographer remained the original owner and only allowed the publisher to exploit some pictures on a commonly agreed theme.

Needless to say, such disputes are less and less likely to occur again in the future since pictures digitally captured can be copied on a large scale and the original of a file cannot be distinguished from its copy.

1. This report reflects the personal views of the authors and should not be attributed to the authors’ Firm or to any of its present and future clients.
2. Article L. 113-2 of IPC.
3. French Supreme Court, 1st civil chamber, 10 May 1995, No. 93-10.945.
4. French Supreme Court, 1st civil chamber, 5 July 2006, No. 04-16687.
7. This report reflects the personal views of the authors and should not be attributed to the authors’ Firm or to any of its present and future clients.

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**Second Medical Use Claims – What is the Nature of the “Mental Element” Required for Infringement of a Swiss Form Claim?**

*Actavis Group PTC EHF and Others v Warner-Lambert Company, LLC and Others*

[2015] EWHC 2548 (Pat) (10 September 2015)

http://www.bailii.org/ew/cases/EWHC/Patents/2015/2548.html

**Introduction**

This dispute, which concerns the alleged infringement by Actavis of Warner-Lambert’s second medical use patent, will be familiar to readers, as we have reported on aspects of the litigation in the previous two issues of *IP Forum.* Both Arnold J, in an application brought by Warner-Lambert for an interim injunction, and the Court of Appeal in Warner-Lambert’s subsequent appeal, had to grapple with difficult and novel questions regarding the construction of Swiss-form claims (i.e. claims in the form: “the use of compound X for the preparation of a medicament for treating indication Y”) and the approach to determining when such claims are infringed.

Arnold J has now considered these issues once again in a comprehensive 174-page judgment following the trial of infringement, in which Actavis was ultimately found not to have infringed.

This report focuses only on the key points arising from the decision on infringement. However, for the sake of completeness, we note here that, following a challenge brought jointly by Mylan and Actavis, Arnold J held the relevant claims of the patent to be invalid in any event, on the grounds of insufficiency, and, further, found Warner-Lambert and Pfizer liable for making groundless threats of patent infringement proceedings.

**Background**

Pregabalin is a drug that is used in the treatment of epilepsy, generalised anxiety disorder and neuropathic pain. There is no longer any patent protection for the medicament itself, but Warner-Lambert holds a second medical use patent with claims in the Swiss form, directed to the use of...
pregabalin for the preparation of a medicament for treating neuropathic pain.

Actavis launched its own generic pregabalin product under the brand name Lecaent, and sought to avoid infringement by obtaining a marketing authorisation with a so-called “skinny label”, which carves out the indication of neuropathic pain. Warner-Lambert alleged that this infringed its patent on the basis that, notwithstanding the “skinny label”, Lecaent would inevitably be dispensed to patients who have been prescribed pregabalin for the patented indication. This is because, in the UK, the vast majority of prescriptions are written using the international non-proprietary name (INN) of a drug, rather than the brand name, and do not disclose the indication for which the drug has been prescribed, and further pharmacists are generally financially incentivised to dispense the generic version of a drug when presented with a prescription specifying the INN.

**Summary of the Decision on Infringement**

**Direct Infringement**

It was common ground that the word “for” (as used in the phrase “for treating neuropathic pain”) does not simply mean “suitable for”, but imports a mental element: it is the fact that the manufacturing is carried out with a new mental element (i.e. that it is now known that pregabalin is (or is plausibly predicted to be) effective for the treatment of neuropathic pain) that makes the claim novel. However, the question that fell to be decided was what was the nature of this mental element?

The Court of Appeal considered this question in some detail in a previous judgment in these proceedings, in the appeal from the decision not to grant an interim injunction. Floyd LJ held that the subject matter of the claim was concerned with the ultimate end use of the medicament, and it was the intention for which the compound is administered which is at the heart of the invention. Accordingly, infringement of a Swiss form claim did not require a subjective mental element on the part of the manufacturer (as had been previously held by Arnold J in the decision under appeal), but instead, a manufacturer would be liable for infringement when he “knows or foresees that users will intentionally administer it for pain”. Arnold J agreed with Actavis and the Secretary of State that the Court of Appeal’s commentary on this point was obiter (because the Court of Appeal did not overturn his original decision to refuse interim relief) and, therefore, was not binding. However, he nonetheless considered the judgment to be highly persuasive and, despite expressing “considerable doubts” as to whether it was correct, went on to apply it.

Arnold J dismissed Warner-Lambert’s submissions that Floyd LJ’s interpretation of the word “for” was no different from a pure test of foreseeability on the part of the manufacturer that its pregabalin would in fact be used for the treatment of pain. Instead he emphasised that the test requires two mental states: (1) a knowledge or foresight by the manufacturer that (2) users will intentionally administer pregabalin for treating pain. As to whose “intention” is relevant, Arnold J held that the intention of the prescribing doctor is highly relevant, if not exclusively so, as it is the prescribing doctor who has the medical expertise and intends to produce the new therapeutic effect.

However, it is not sufficient that the doctor intends pregabalin from any source to be administered for the treatment of pain, as submitted by Warner-Lambert, as infringement must depend on what the manufacturer can foresee happening with the pregabalin that it manufactures, not pregabalin made by others. Therefore, Arnold J held there would be no intentional administration of Lecaent for the treatment of pain if Lecaent is dispensed in circumstances where the doctor has prescribed generic pregabalin for pain and the pharmacist does not know the indication for which it has been prescribed.

After considerable hesitation, Arnold J also decided that the intention of the pharmacist is relevant where there pharmacist knows that the doctor has prescribed generic pregabalin for the patented indication (which occurs in 5% of cases), but nonetheless dispenses the “skinny label” generic product. Therefore, the key question the Judge had to decide was whether it was foreseeable to Actavis that, in those 5% of cases where the prescription indicated that generic pregabalin had been prescribed for pain, the pharmacist would dispense Lecaent despite the fact it was not licenced for that indication.

As Swiss form claims are process claims directed at the manufacturer of the medicament, this mental element of the manufacturer must be assessed as at the date of manufacture, regardless of when the manufactured drug is subsequently sold. Therefore, to explore the potential consequences of Actavis’ differing states of knowledge as the case progressed to trial, Arnold J analysed the infringement position as at three different dates, namely as at 8 December...
2014, 17 February 2015 and 15 July 2015, and on the assumption that Actavis had manufactured Lecaent in three separate batches similarly spaced out in time.

At all times, Actavis was held not to have infringed the patent. The case for infringement was strongest in relation to the earliest date, where Lecaent was manufactured between June and October 2014, but Arnold J concluded that it was not foreseeable to Actavis that Lecaent manufactured in this period would be intentionally administered for the treatment of pain save in a small number of exceptional cases which he regarded as de minimis.

In coming to this decision, Arnold J took into account the fact that: (i) Lecaent was marketed under a skinny label; (ii) Actavis had notified superintendent pharmacists that Lecaent was not licensed for the treatment of neuropathic pain; (iii) it was reasonable for Actavis to assume that its message would be disseminated by the superintendent pharmacists to those under their supervision; and (iv) Actavis was aware that Warner Lambert was offering brand equalisation deals to its main customers (i.e. agreeing to discount the price of the branded product so as to compete with the price of the generic product and preserve its own market share).

**Indirect Infringement**

Despite the Court of Appeal allowing Warner Lambert’s appeal against Arnold J’s earlier decision to strike out the indirect infringement claim, Arnold J was puzzled by the Court of Appeal’s reasoning and took the opportunity to reiterate the view that he expressed in his earlier judgment that the claim is to a process of manufacture and there is no act of manufacture by any party downstream from Actavis, nor any prospect of such an act, Actavis’ pregabalin product cannot be “suitable for putting, or intended to put, the invention into effect”: either the invention has already been put into effect by the time that Lecaent leaves Actavis’ hands or it is not put into effect at all.

**Comment**

Given that Swiss form claims have been around for a long time, it is surprising that there has been little judicial guidance in the UK (or elsewhere) on their scope of protection until now. Therefore, this decision has been welcomed by practitioners in this area. However, we doubt this is the end of the saga. An appeal is likely, possibly even to the Supreme Court ultimately.

In the meantime, it does bring some comfort to generic manufacturers who plan to launch generic products under a “skinny label”, although in this case the fact that Actavis had taken some additional steps over and above applying for a skinny label to avoid infringement was an important factor. However, what additional steps are required to avoid infringement is likely to depend on the circumstances of the case. It might be enough for a generic manufacturer to write to pharmacists to inform them that its generic product is not licensed for the patented indication (as Actavis did), but depending on the market in question and on the steps the patentee has or has not already taken, this may not be enough. The timing of such additional steps is also likely to an important consideration. On the one hand, such steps are likely to be more effective if taken in advance of the generic product coming onto the market. But on the other, a generic manufacturer wishing to gain a commercial advantage by surprising the patentee with the timing of its launch is likely to be reluctant to take any such steps prior to launch.

Arnold J’s judgment concludes with a very poignant afterword expressing the need to address the issues associated with the enforcement of second medical use patents, as highlighted by this case. In his view, the solution lies in separating the patented market for a substance from the non-patented market by ensuring that prescribers write prescriptions for the patented indication by reference to the patentee’s brand name and write prescriptions for non-patented indications by reference to the INN, and suggested that centralised and authoritative guidance should be provided to prescribers and other relevant stakeholders. How such a centralised system can be achieved in practice across what is a rather decentralised healthcare system in the UK is not clear. Nevertheless, Arnold J has called on the Secretary of State to try to ensure that such a system is implemented and it will be interesting to see whether this results in any changes which improve the environment for the enforcement of second medical use patents in the UK.

Finally, this judgment only deals with Swiss form claims and Arnold J makes it clear that it should not be assumed that anything in the judgment necessarily applies to claims drafted since the introduction of the EPC 2000 (i.e. claims in the form “substance X for use in treatment Y”). Therefore, where this judgment leaves EPC 2000 claims remains unclear. Such claims have no nexus to the manufacturer or the manufacturer’s “mental
state”, even though the intention of the legislator in introducing the purpose limited product claims appears to have been to provide a claim format which afforded equivalent protection to the Swiss form claim.

**Taxi for the Survey Evidence**

*The London Taxi Corporation Ltd (t/a the London Taxi Company) v Frazer-Nash Research Ltd & Anor*  
[2015] EWHC 1840 (Ch) (3 July 2015)  
http://www.bailii.org/ew/cases/EWHC/Ch/2015/1840.html

**Introduction**

On 3 July 2015, the High Court of England and Wales dismissed an application by the London Taxi Corporation Limited (trading as The London Taxi Company) to adduce survey evidence in support of its passing off claim against Frazer-Nash Research Limited (Frazer-Nash) and Ecotive Limited (Eco) in relation to the appearance of taxi cabs. Notwithstanding that the test for admission of a survey may be lower in passing off cases in comparison to trade mark infringement cases, Richard Spearman QC (sitting as a deputy judge) refused the application as he did not accept that "the game would be worth the candle" in the present proceedings, i.e. the value of the proposed survey evidence would not justify the likely costs involved.

This decision is in accordance with the principles and guidance concerning the admission of surveys and evidence derived from surveys which are found in three recent Court of Appeal decisions: *Interflora Inc v Marks & Spencer plc* [2012] EWCA Civ 1501 (*Interflora 1*), *Interflora Inc v Marks & Spencer plc* (No 2) [2013] EWCA Civ 319 (*Interflora 2*) and *Zee Entertainment Enterprises Ltd v Zeebox Ltd* [2014] EWCA Civ 82 (*Zeebox*).

**Background**

The London Taxi Company, a manufacturer of purpose-built taxis, brought proceedings alleging infringement of certain trade mark registrations relating to various models of its London black cab, and passing off in respect of the appearance of its London black cabs. According to the London Taxi Company, the "common design language" of its vehicles means that those vehicles are "instantly recognisable not merely as taxis but as London black cabs". In addition, the London Taxi Company alleges that "substantial and valuable goodwill" subsists in the appearance of London black cabs and that that appearance is recognised by members of the public as "denoting the taxis of a single trade source", i.e. that of the London Taxi Company.

The subject of the proceedings is a new model of Frazer-Nash and Eco's Metrocab taxi (the new Metrocab). At the time of the London Taxi Company's application, the new Metrocab had been publicised and had been trialled on the streets of London for a few months. However, commercial sales of the new Metrocab had not begun and it was unlikely that significant numbers of the new Metrocab would have appeared on the road before the main proceedings went to trial.

As a result, the London Taxi Company had conducted a pilot survey and sought permission to rely on that pilot and to conduct a full survey in support of its passing off claim. The London Taxi Company contended that the survey evidence would be particularly instructive in this case because of its *quia timet* nature, i.e. any evidence of actual confusion or deception was unlikely to arise before trial (in November 2015).

**Decision**

*The Show Materials*

The London Taxi Company's pilot survey involved conducting interviews with 98 people in London after showing them the following two photographs, C2 and M7. C2 is a photograph of the new Metrocab, taken from Frazer-Nash and Ecotive's publicity materials. M7 is a photograph of one of the London Taxi Company's TX4 taxis.
The deputy Judge acknowledged the difficulty in the present proceedings of replicating the “circumstances of the real world”, given that the new Metrocab was not yet available for commercial sale and significant numbers of the new Metrocab were yet to appear on the road.

However, there was a “real risk” that the photographs did not show differences between the signs on the parties’ vehicles “in a way that replicate[d] the real world sufficiently or fairly” and, as a result, the reliability of the survey responses was “devalued or corrupted accordingly”. The angle at which photographs C2 and M7 were taken meant that “a number of differences (of varying degrees of magnitude) between the appearance of the [London Taxi Company’s] TX4 and the new Metrocab … [were] not apparent”. In addition, the fact that the photographs were taken at night made it more difficult to see other differences than would be the case in ordinary daylight use of the vehicles (notwithstanding that the photographs depicted the parties’ vehicles “as some passengers are likely to see them in some circumstances”).

According to the deputy Judge, the two photographs did not come “anywhere near to bringing the circumstances of the real world present, as far as possible, in the circumstances of the survey”, stating that the photographs were “a poor substitute for the real world”. As such, the deputy Judge considered that the trial Judge would, when making his or her assessment, “enjoy a major advantage over a survey based on these two photographs” because such assessment would not be confined to reliance on still photographs.

The Whitford Guidelines

The “Whitford Guidelines” are long established principles for survey evidence, set out in the judgment of Whitford J in Imperial Group PLC v Philip Morris [1984] RPC 295 and summarised by Lewison LJ in Interflora 1. Guideline (iv) is: “the questions asked must not be leading and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put”.

The key question in the pilot survey questionnaire, Question 5, was originally phrased as: “What would you say if I told you that there is no connection between the company that makes this vehicle [C2] and the company that makes this vehicle [M7]?” It was subsequently rephrased as: “Do you think there is a connection between the company that makes this vehicle [C2] and the company that makes this vehicle [M7]?” and then “Why do you say that?”

However, the deputy Judge considered that both versions were “leading to an unacceptable degree” and therefore failed to comply with the Whitford Guidelines. He then went on to apply the dicta of Lewison LJ in Interflora 1, to the effect that surveys that are not fully compliant with the Whitford Guidelines constitute evidence that, even if technically admissible, are not useful and should not be allowed to “distract the focus of a trial”, as “[i]f the value of the evidence is severely diminished if not eliminated by a failure to follow the Whitford Guidelines”.

Connection versus Deception

In addition to being an impermissibly leading question, the deputy Judge considered that the key survey question was “fatally flawed” and that responses to that question were unlikely to be of “real value” for two reasons.

First, the deputy Judge’s view was that asking respondents about a “connection” between the companies that made the vehicles did not really address the issue of “deception”, which was central to a case for passing off. According to the judgment in Zeebox (to which the deputy judge referred as support for his view), a reason for degrading the value of a survey and not allowing it into evidence would be if that survey goes to the “peripheral or subsidiary issue” of whether the (relevant) public has “a propensity to make a connection between the mark and the sign”, as opposed to whether there is deception.

Secondly, the deputy Judge rejected the London Taxi Company’s submissions that, due to the lack of any actual connection between the London Taxi Company and Frazer-Nash and Ecotive, “anyone who believes there is such a connection must have been deceived into that belief; and such deception must arise because of the similarity in appearance”. The deputy Judge did not accept these submissions (referring to the results of the pilot survey for support), emphasising the danger of extrapolating from “connection” to “deception”, commenting that “it is perfectly possible, and even likely, that respondents may think there is a “connection” for reasons which have nothing to do with deception”.

The Cost Benefit Analysis

The deputy Judge referred to the strict “real value” test laid out by Lewison LJ in Interflora 1 at paragraph 150 (and reiterated more loudly by Lewison LJ in Interflora 2 at paragraph 26) in relation to whether survey evidence should be adduced:
Only if the court is satisfied that the evidence is likely to be of real value should permission be given. The reliability of the survey is likely to play an important part in that evaluation. Even then the court must be satisfied that the value justifies the cost.

According to the London Taxi Company, a full survey of 1,000 persons would cost just over £100,000, comprising about 20% of its total litigation budget. The deputy Judge considered these costs to be "significant whether viewed in absolute or proportionate terms", especially as the survey was relevant only to part of the case (i.e. passing off). As such, the deputy Judge doubted that the value of the survey would justify those costs, even if it had satisfied the criterion of being reliable.

The deputy Judge also gave significant weight to the likely impact on the existing five-day trial estimate. Although it was difficult to predict how many respondents would be called as witnesses if a full survey had been allowed, the deputy Judge thought it likely that the cross-examination of the respondents, as well as the time spent on the resulting expert and factual evidence, would result in the trial estimate being increased, or a disproportionate part of the trial being spent on those matters.

Comment

This judgment is an example of robust application of the "new" standards for survey evidence. The London Taxi Company sought to argue that, essentially, a leading question had to be asked to understand what the respondents really thought, but this decision demonstrates that including leading questions to gain meaningful answers may simply undermine the exercise.

The Judge's comments on the costs/benefits – that even if not otherwise objectionable, the costs would have outweighed the benefit – may signify a wind change. In Enterprise, the costs of the survey, which did no more than confirm a view the Judge was "minded" to reach anyway, exceeded those proposed in this application. If such costs are seen as significant in real terms (not just in proportion to the overall costs), so as to "not be worth the candle", the question is when those (or even greater) costs would ever be seen as justified, other than in cases involving very niche goods or services.

Overall, this judgment demonstrates that, outside of more specialist types of goods and services, with which the Judge is not likely to be familiar, (such as Zee TV), obtaining permission to rely on survey evidence is likely to be very difficult to achieve.

A Case of Cristal Clear Infringement

Champagne Louis Roederer v J Garcia Carrion SA and others

[2015] EWHC 2760 (6 October 2015)
http://www.bailii.org/cgi-bin/markup.cgi?doc=/ew/cases/EWHC/Ch/2015/2760.html

Introduction

The High Court has made a finding of trade mark infringement, on the basis of both likelihood of confusion and damage to reputation, in favour of Champagne Louis Roederer (Roederer) which sells one of the world’s most prestigious champagnes under the mark “CRISTAL” against J Garcia Carrion (Carrion), a producer of Spanish cava sold under the brand name “CRISTALINO”.

Background

In 1876, at the request of Tsar Nicholas II of Russia, Roederer created a champagne in a clear glass bottle with a flat base and named it CRISTAL. CRISTAL is the most expensive champagne that Roederer sells and it retails at approximately £175 per bottle. Roederer is the proprietor of several trade mark registrations for the mark “CRISTAL” for champagnes and sparkling wines. Carrion claims to be the largest Spanish wine producer and sells cava in the UK for £5 per bottle under the brand name “CRISTALINO” in supermarkets. Carrion has registrations for the mark “CRISTALINO JAUME SERRA” for sparkling wines. Carrion initially contested the proceedings but, after serving an amended defence and counterclaim, took no further part.

Summary of the Decision

Assessment of Roederer’s Evidence

Roederer’s evidence was that it started to sell CRISTAL champagne in the UK in 1949, when it imported six bottles. This trade has increased to 40,000 bottles per year, but this amounts to only 0.5% of the UK champagne market. In the UK, CRISTAL is sold in exclusive restaurants, hotels and night clubs as well as one higher end supermarket and specialist wine retailers. Because demand outstrips supply, Roederer does not engage in extensive advertising. Further evidence fell into two distinct categories; reviews of CRISTAL champagne and references to CRISTAL in popular media.
culture whereby drinking CRISTAL is seen as a status symbol (and being seen to waste it even more so). Roederer also carried out two surveys which found that 31% of respondents recognised CRISTAL as a brand of champagne when given the context and 14% of respondents recognised CRISTAL as a brand of champagne without having been given any context.

The Court assessed Roederer's evidence and made the following findings: (i) the mark CRISTAL is inherently distinctive for champagne and other wines; (ii) although the volumes involved were small, the sales were significant and valuable; (iii) the volume of press coverage of CRISTAL is remarkable given the share of the UK champagne market enjoyed by CRISTAL; (iv) the survey results show that CRISTAL has a strong reputation, particularly given the small number of people who will have actually sampled CRISTAL (given its scarcity and price); and (v) CRISTAL enjoys a reputation solus which does not depend upon the Louis Roederer name.

Likelihood of Confusion

In order to succeed on this ground, Roederer needed to demonstrate: (i) that the sign used by Carrion is similar to Roederer's registered mark CRISTAL; (ii) Carrion's goods are similar or identical to the goods protected by Roederer's registrations; (iii) Carrion is using its sign in the course of trade; and (iv) there exists a likelihood of confusion between Carrion's sign and Roederer's registrations.

In relation to (i), it was held that the presentation of Carrion's bottles and written references on receipts and invoices indicated that its product was referred to as CRISTALINO without the "JAUME SERRA" element. The Court went on to find that CRISTAL and CRISTALINO are visually similar given that seven letters are common and they appear at the beginning of the sign, that the signs are strongly aurally similar given that the entirety of the CRISTAL mark is incorporated in Carrion's mark and in nightclubs or similar environments the "INO" element may get lost; and that there is conceptual similarity due to the fact that both marks refer to crystal and the characteristics that word can imply. As regards to (ii), it was held that where Roederer's registrations covered sparkling wine, there was identity with Carrion's cava and where they covered champagne, there was similarity. In relation to (iii) Carrion accepted that it was using its mark CRISTALINO JAUME SERRA in the course of trade.

As regards to (iv), it was held that the lack of evidence of actual confusion was not fatal, given the short period of time in which CRISTALINO was on sale in the UK and the fact that Carrion would be the more likely of the two parties to receive complaints (but had not given any disclosure in the proceedings). It was further held that, although direct confusion was possible, the greater risk was with indirect confusion stemming from the possibility that the public would think that the brands were linked due to the common practice of prestigious chateaux and champagne houses to produce "second wines" which bear the label of the house but which retail at a lower price point. The names of these "second wines" often are a diminutive version of the premier wine; CRISTALINO may be interpreted as a diminutive of CRISTAL. The Court held that the public would think that Roederer produced CRISTALINO; a finding that there existed a likelihood of confusion followed.

Damage to Reputation

In order to succeed on this ground, Roederer needed to demonstrate: (i) that Carrion is using its sign in the course of trade; (ii) Roederer's registrations have a reputation; (iii) Carrion's sign is identical with or similar to Roederer's registrations and that the relevant public would make a "link" between the sign and the mark; (iv) Carrion's use of the sign takes unfair advantage of or is detrimental to the distinctive character or repute of Roederer's registrations; and (v) Carrion's use is without due cause.

In relation to (i), and (ii), as above, Carrion had accepted that it was using its sign CRISTALINO JAUME SERRA in the course of trade, and the Court found that the CRISTAL mark enjoys a strong reputation in the UK. As regards to (iii), the Court held that the public would make a link between the sign and the registrations for the same reasons as it found similarity between the marks for the purpose of likelihood of confusion.

In relation to (iv), the Court then considered each of the three possible types of harm. In relation to dilution or blurring, the Court held that CRISTAL was a very distinctive mark in relation to champagne, both inherently and as a consequence of Roederer's use. Accordingly, if another sign drew the same association with the qualities of crystal for sparkling wine, the association of those qualities with CRISTAL would be lessened, resulting in dilution and blurring. To be actionable, the Court
held that it was sufficient for Roederer to show that the public will buy less CRISTAL if the name ceased to be linked with luxury and prestige. The Court held that this requirement was made out as people who buy CRISTAL as a status symbol would be deterred from doing so if it became associated with a cheap sparkling wine.

In relation to unfair advantage, Roederer’s evidence from social media showed that people (albeit in the USA) were drinking CRISTALINO and pretending that it was associated with CRISTAL and also that journalists had referred to CRISTALINO as “poor man’s” CRISTAL. The Court held that CRISTALINO had differentiated itself from other sparkling wines by being associated with CRISTAL despite not contributing to the prestige image of CRISTAL. This evidence also supported the finding that there would be a change in the behaviour of cava purchasers as a consequence. Accordingly, the Court held that the use of CRISTALINO by Carrion would damage the origin, investment and advertising functions of the CRISTAL mark.

Finally, the Court held that, in relation to (v), Carrion had not raised a plea that its use was with due cause. Accordingly, a finding of infringement followed. Finally, in relation to tarnishment, whilst the Court commented that cava is not inherently unpleasant or degrading, given the success on the other grounds, it declined to make a finding on the tarnishment ground.

Comment
Historically in the UK, brand owners have experienced significant difficulty in enforcing their registered trade mark rights against lookalike products. Often, the problem has been in demonstrating a likelihood of confusion in circumstances where the lookalike has taken some, but not all, of the distinctive elements of the brand owners get-up or name, meaning that the brand owner finds itself in the position whereby either what has been taken is not protected by any of its existing registrations or trying to enforce registrations that have only a low level of similarity with the signs used for the lookalike product. This case represents a welcome break from that tradition.

It would appear that there are three key reasons for this break with tradition. The first concerns just how close Carrion chose to come to Roederer’s brand. Although Carrion attempted to distinguish its sign and product by using and registering the composite CRISTALINO JAUME SERRA mark, this branding strategy does not appear to have been implemented on the ground. In particular, Carrion itself appears to have referred to its products as CRISTALINO solus (e.g. on invoices) and the CRISTALINO element of the mark was given much greater prominence on its bottles of cava.

The second concerns the finding of the Court that there was a likelihood of indirect confusion based on the practice of famous chateaux and champagne houses of producing “second wines” which are sold under the house label but at lower price points. The fact that the public have been educated to be aware of second wines made it very easy for the Court to find that the public would think that there was a link between CRISTAL and CRISTALINO. Whilst this practice is common in the wine industry, it is not unique. The same reasoning could well be applied to fashion houses who produce diffusion lines or cosmetic companies who often produce different lines or fragrances at different price points.

The third concerns the Court’s willingness to find a “strong” reputation in the UK, despite a minimal market share, a low level of sales volume and a lack of evidence of marketing and other advertising efforts. The Court appears to have taken significant notice of the market in which Roederer operates, in particular, that luxury goods are often not advertised or marketed, that scarcity of supply can be useful in building a reputation and that the size of a market such as that for champagne has variations within it, i.e. whilst Roederer only had 0.5% of the total UK champagne market, it would have had a larger percentage of the “luxury” champagne market.
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DTI Dishes Up a Hopeless Curate’s Egg

The figure of speech used in describing something as a “curate’s egg” derives from a cartoon by G. du Maurier published in the British humorous magazine *Punch* in November 1895. It depicts a meek curate, faced with a bad egg at the Bishop’s breakfast table, commenting that it is partly good. In other words, it is something that is thoroughly bad but is discreetly said to be partly good.1

“The term relies on an objective analysis and intuitive understanding of the depicted scenario: a self-contained egg cannot be both partially spoiled and partially unspoiled. To pretend to find elements of freshness in a bad egg is thus a desperate attempt to find good in something that is irredeemably bad.”

The Copyright Amendment Bill published by the Department of Trade and Industry (DTI) in GG no. 39028 of 27 July 2015 is an archetypal curate’s egg. I will commence by making a desperate attempt to find some good in it, which indeed there actually is.

The Bill addresses certain issues that have been crying out to be dealt with for decades. It thus in principle makes laudable strides to modernise the Copyright Act 1978 which has become badly out of date, having received scant substantive attention from the legislature for some two decades while the world, particularly in the technological field and more particularly the internet, has been moving forward at a terrifying pace. The Act has simply become outdated and is in grave need of modernising and being brought into line with contemporary reality.

The worthy issues that it confronts and seeks to regulate include: the control of collecting societies; broadening the scope of exemptions from copyright infringement by providing for instances of so-called “fair use” of copyrighted works, particularly in the field of education; creating facilities for making works available to persons with disability on equitable terms; making provision for access to and use of so-called “orphan works” (i.e. works in respect of which the ownership of copyright is unknown); providing for sanctions for abuse of digital rights management measures built into copies of works. In so doing, it is purporting to give effect the report of the Copyright Review Commission dating from 2011. So far, so good.

On a perhaps less favourable level, the Bill introduces the European “droit du suite” in terms of which an artist can claim to receive as portion of the resale price of his artwork when onward sales of it are made; it provides for performers to have the moral rights of being acknowledged when their performances are publicly commercially exploited and of objecting to distortions of their performances (which provisions belong in the Performers Protection Act, which is their home); there is a provision prohibiting the purported granting of licences in situations where no right capable of being licensed exists.

But that is where the illusion of goodness in the Bill ends. I say this because, although the sentiments of the draftsman are commendable, the execution is abysmal. With more than 40 years of specialising in the practice of copyright law and having done a doctorate and written a textbook on the subject, which has been cited with approval by the court on many occasions, as well as having pursued an academic career in the field, I can safely say that I know my way about the copyright world. I regret to say that I have not come across a piece of intellectual property writing that is as badly formulated and presented, and that exhibits such a lack of understanding of the basic principles of the subject as is evident in this Bill.

The draftsmanship and usage of grammar and language in writing it are appalling. On a substantive level, it is as though the author of the Bill did not take the trouble to read, let alone understand, the Act that they are purporting to amend. It contains terminology which is foreign to the Act and rides roughshod over the basic principles of copyright law. The Bill is riddled with contradictions and anomalies; it is frequently nonsensical or downright incomprehensible even to someone who can claim expert knowledge of the subject matter. If, as a Professor of Intellectual Property Law, this Bill was served up to me as an answer to an examination question or as a dissertation, I would award it an assessment or grade of less than 20%. I would suggest to the student that they rather go and pursue some other avenue of study as they clearly have no aptitude for copyright law.

I have described the good part of the egg as best as I can find it. Let me now go on to the bad part. In the interests of keeping the length of this epistle within reasonable bounds, I will deal with examples and will not seek to catalogue all the defects.

At the outset, it must be borne in mind that our copyright law is determined to a significant extent by the Berne Convention and the TRIPs Agreement by which we are bound and with which our copyright legislation must comply. One of the fundamental principles of these treaties is “national treatment” in terms of which our law must give...
the same protection and benefits to foreign works as it gives to its domestic works. We cannot give preferential treatment to domestic works over foreign works. Furthermore, the fundamental approach of both our and foreign copyright law is to have a restricted selection of works eligible for copyright that are mutually exclusive. There is no overlap between the various categories of works.

With scant regard to the latter principle, the Bill appears to have created two new categories of copyright work, namely “craft works” and “phonograms”. These categories of works will have to co-exist with the existing categories of “works of craftsmanship” and “sound recordings” from which they are virtually indistinguishable. There is no conceivable justification or logic in creating these two new categories of works eligible for copyright when the Act already has two identical categories which have been part of our law for the best part of a century and which operate perfectly well. What the Bill does is to provide for the content of the copyright in these two new categories without laying the ground work for their coming into existence as occurs with all the existing categories. There is thus no way of knowing how and whether works of this nature qualify for copyright. The category “phonogram” is foreshadowed in the Bill by purporting to amend a definition that does not occur in the Copyright Act but is to be found in the Performers Protection Act (which is thankfully not addressed in the Bill).

The Bill requires the “broadcasting industry” to meet certain local content requirements in their broadcasts and even to oblige the institution regulating broadcasting to use measures to ensure compliance with the local content requirements. How can the broadcasting industry compel ICASA, the regulatory authority in respect of broadcasting, to do anything? This is putting the cart before the horse. What all this has to do with copyright is beyond my comprehension and provisions of this nature have no place in a Copyright Act which is concerned with the protection of original works, one category of which is broadcasts, the copyright in which is vested in the broadcaster who makes a broadcast – rights of a monopolistic nature in respect of its broadcasts are conferred on a broadcaster (that is the nature of copyright). In any event, giving preference to local content (literary and musical works, sound recordings and cinematograph films that are locally made) in the Copyright Act brings the Act into conflict with the national treatment principle discussed above and is thus in conflict with our international obligations and probably unconstitutional.

Another breach of our international obligations is created in the provisions introducing the droit du suite principle in relation to artistic works. This right on the part of the “creator” of an artistic work (the Act does not use this term at all and one can but wonder who the “creator” of a work is as distinct from the “author”, the term used throughout the Act and internationally) is limited to an “artist” (someone different to the “creator” or the “author”?) who is a citizen or resident of South Africa. This is a clear abrogation of the national treatment principle, with its attendant consequences. The provisions of the Bill dealing with this issue in general leave a lot to be desired and are unacceptable in their present form.

Section 9 of the Bill amends the existing s.9A of the Bill dealing with “needletime”. Sub-clauses (b) to (d) of the amendment is completely duplicated by its sub-clauses (g) to (i), thus creating considerable confusion and evidencing shoddy draftmanship. Sub-clause (k) of the amendment has nothing whatsoever to do with needletime and probably belongs in s.25 of the Bill dealing with s.20 of the Act (moral rights). Aberrations such as this contribute to the unintelligible nature of the Bill.

The live performances by performers of works, i.e. singers, musicians, dancers and the like, are protected by the Performers Protection Act. Performers’ rights under this Act are not copyright – they are rights somewhat akin to personality rights held by performers. A performer’s right is a cousin of copyright. These two types of rights often come together in a sound recording, which is a separate copyright work. A sound recording carries the performer’s rendition of a work (usually a literary and/or musical work). The Performers Protection Act creates economic rights in a specific performance, which rights vest in the performer.

Protection of performance rights are dealt with internationally in a separate treaty (the Rome Convention) to the Berne Convention and our Performers Protection Act is closely based on the Rome Convention, as is performers protection legislation throughout the world. Performers rights and copyright are different animals. However, the author of the Bill has thought it good to reiterate some of the provisions of the Performers Protection Act dealing with the economic rights and their enforcement in the Bill. Apart from amounting to mixing apples and oranges, this will create enormous confusion and will undermine the integrity of both pieces of legislation. This is, of course, entirely unnecessary and undesirable and indeed makes no sense whatsoever.

The Copyright Act confers upon authors both economic and moral rights in their works. This is in accordance with the Berne Convention. Moral rights comprise the right to be identified as the author of a work and the right to object to alterations or
mutilations of their work. In addition to conferring copyright economic rights on performers’ performances, the Bill also bestows moral rights on performers in respect of their performances. A moral right in a performance is a strange and remarkable concept and is not provided for in the Rome Convention. If it is to be provided at all it should be catered for in the Performers Protection Act and not in the Copyright Act.

The Bill introduces provisions allowing for permission to be obtained for the use of “orphan works”. Such works include works whose owner is deceased. The Copyright Act creates a right of property in a work and like all other forms of property this right of property can pass to an heir in terms of the Copyright Act and the law of succession. Accordingly, if a particular owner dies, their heir or heirs acquire the ownership of the copyright. It is thus difficult to see why a work should become an orphan work when its owner dies. To make matters worse, the ownership of the copyright in an orphan work is vested in the State which can grant licences in respect of it and generate income for the state from its use.

The copyright in an orphan work is perpetual, in complete abrogation of one of the basic principles of copyright law that a work should fall into the public domain after the effluxion on a specific time period. There is no reason why an orphan work should be in a preferential position as compared to a work that has a “parent”. Having provided that the copyright in an orphan work vests in the state, the Bill then goes on to provide in s.27 (introducing s.22A into the Act) that a licence can be granted in an orphan work and that royalty payments can be deposited into a particular account so as to enable the owner of the copyright or their heirs or executors to claim such royalty. This cannot be reconciled with ownership of the copyright in an orphan work (especially a work in respect of which the owner has died) vesting in the state. It makes no sense and is typical of the confusion and obfuscation that exists in the Bill.

Draconian criminal offences are created by the Bill for mild transgressions. For instance, someone who contravenes the provisions relating to the payments due in terms of the droit du suite is guilty of a criminal offence! Likewise, anyone who contravenes the provisions relating to orphan works. As a general rule, infringements of intellectual property rights are civil law wrongs and only in exceptional cases do they constitute criminal offences. These rather innocuous transgressions do not warrant being criminal offences when more serious infractions are mere civil wrongs. Moreover, the newly created criminal offences are provided for in s.23 of the Act, which deals with civil copyright infringements, and not in s.27, which is devoted to criminal offences. This is but one instance of several where the existing format and system of the Act is disrupted and upset for no good reason. This is not at all conducive to coherent regulation of the law of copyright and interpretation of the Act.

There are a myriad of other problems attaching to the Bill that need to be addressed, but space does not allow for this here. In conclusion, the best approach would be for the DTI to go back to the drawing board and start all over again. Persons skilled in copyright law with drafting experience should be commissioned to draft the Bill to meet the Department’s requirements and thereafter it should be published again for public comment. Once it is in a presentable and lucid form, proper constructive debate and consultation can take place in regard to its content. No fruitful intercourse is possible with the Bill in its present incoherent state. The egg that has been dished up should be consigned to the trash can.

2 Available at: http://encyclopedia.thefreedictionary.com/ Curate%27s+egg.

Current Developments – South Africa
The Federal Circuit’s First Reversal of an Inter Partes Review Decision by the Patent Office: What Does this Mean Going Forward in IPR Proceedings?

On 16 June 2015, the Federal Circuit decided Microsoft Corp. v Proxyc conn, Inc, which is the Federal Circuit’s first decision reversing an inter partes review (IPR) determination by the Patent Office’s Patent Trial and Appeal Board (PTAB). Given the increased filing of IPR petitions, the IP community has closely watched to see how much deference the Federal Circuit will accord with the PTAB’s decisions.

The Proxyconn case is thus historic insofar as it is the first time that the Court has reversed a PTAB decision invalidating claims in an issued patent. This decision also provides some insights into how the Federal Circuit will review appeals from PTAB decisions in future IPR proceedings, including how to apply the “broadest reasonable interpretation” and the propriety of the judge-made rules for amending claims.

Background: The Federal Circuit’s Recent Review of IPR Decisions

By way of background, an IPR is a recently created trial proceeding created by the America Invents Act (AIA). Congress created IPR proceedings for the purpose of “providing quick and cost effective alternatives to litigation”. In an IPR, the PTAB will consider grounds of unpatentability under §§ 102 or 103, and only based on prior art patents or printed publications. Issuance of a final written decision will normally estop a petitioner again challenging validity of patent claims in the district court based on grounds that were raised or reasonably could have been raised in the IPR.

IPRs began on 16 September 2012, and have grown rapidly in popularity as an alternative to district court litigation. Reasons for their popularity include the PTAB’s use of the broadest reasonable interpretation (BRI) standard for construing patents claims, which many perceive to be broader than the Phillips standard used in US district courts. The PTAB also reviews patentability under a “preponderance of the evidence” standard, which is lower than the “clear and convincing evidence” standard used in US district courts. These factors, combined with the significantly lower cost and speedier resolution of IPRs, as compared with litigation in district courts, have made IPRs attractive.

So far, the Federal Circuit has decided fewer than 20 appeals from the PTAB’s AIA trials. This has consisted of just three precedential opinions, 15 summary affirmances, and one non-precedential affirmation.

To date, Proxyconn, GTNX, and Cuozzo are the only precedent decisions reviewing the PTAB’s decisions in these recently created post-grant trials conducted by the PTAB. In Cuozzo, the Federal Circuit ruled that the PTAB correctly used the BRI standard in construing patent claims in IPR proceedings, rather than a Phillips claim construction analysis used in the district court. In GTNX, the Federal Circuit made clear that the Court would not review the PTAB’s decision whether to institute an IPR. Rather, the Federal Circuit would confine its review to the PTAB’s final written decisions as to patentability.

Until the Federal Circuit’s recent decision in Proxyconn, all of the Court’s other decisions had affirmed the PTAB’s rulings. This pattern of uniform affirmances by the Federal Circuit, at least before Proxyconn, contributed to the widely held perception that IPRs are a more favorable forum for challengers than for patent owners. In Proxyconn, the Federal Circuit provided some guidance regarding how to apply BRI and the requirements for motions to amend.

Proxyconn’s Observations about How To Apply “Broadest Reasonable Interpretation”

First, in Proxyconn, the Federal Circuit, citing Cuozzo, once again confirmed that the BRI standard applies to AIA trials. It also shed some light on how the BRI should be applied in IPRs and when the PTAB’s claim construction under the BRI goes too far such that its constructions are unreasonable under general claim construction principles.

In Proxyconn, the Federal Circuit made clear that it would not uphold unreasonably broad constructions that are inconsistent with the proper scope of a claimed invention. First, in construing claims under the BRI, the Court explained that “claims should always be read in light of the specification and teachings in the underlying patent”. Secondly, “[t]he PTO should also consult the patent’s prosecution history in proceedings in
which the patent has been brought back to the agency for a second review”.7 Thirdly, the Federal Circuit stated that any construction under the BRI “must be consistent with the one that those skilled in the art would reach”.8

In several different ways, the Federal Circuit warned that a construction under the BRI can be too broad if it does not follow the principles above. For example, the PTAB may not “construe claims during the IPR so broadly that its constructions are unreasonable under general claim construction principles”.9 Further, the PTAB’s construction “cannot be divorced from the specification and the record evidence” and “must be consistent with the one that those skilled in the art would reach”.10 Finally, “[a] construction that is ‘unreasonably broad’ and which does not ‘reasonably reflect the plain language and disclosure’ will not pass muster”.11

In applying these principles, the Federal Circuit determined that a claim that generically recited “two other computers” was limited to sender/receiver computers when read in view of the specification. The Court similarly held that the claim required sender/receiver computers distinct from gateway and caching computer intermediaries. On their face, the claims did not necessarily contain these requirements, but when read in light of the specification, the Federal Circuit determined they did under the BRI standard.

It is worthy to note that the Federal Circuit’s criteria for construction under the BRI, at least in this case, resemble those under Phillips.12 Interestingly, in Proxyconn, the Federal Circuit explained that it would have reached the same result if it had applied “the traditional claim construction framework set forth in Phillips”.13 This implies that, at times, the meaning of claim terms could be the same under the BRI and Phillips.

The similarity between the BRI construction discussed by the Federal Circuit in Proxyconn and traditional Phillips construction raises many questions about the use of the BRI in the future. For example, will the Proxyconn decision act to narrow the gap between a BRI construction and a US district court construction? Does the Proxyconn decision open the door for the Federal Circuit to decide later that the PTAB should use the analysis found in Phillips to determine the BRI of claim terms? Should practitioners and the PTAB use Phillips as a framework to support its claim construction analysis under the BRI? Given the number of appeals at the Federal Circuit and the growing interest in using AIA proceedings to invalidate patents, there will likely be future decisions providing guidance on the application of the BRI in IPR proceedings.

The Proxyconn decision was issued during a time when some criticized using the BRI to construe claims in these quasi-judicial proceedings. The policy behind the BRI is to ensure that claims have justifiable breath over newly applied prior art through an amendment process. The PTAB regularly denies motions to amend claims in AIA trials. This has led to legislative efforts to mandate statutorily the PTAB to use the same analysis as district courts since Phillips. This should provide another reason for both the Federal Circuit and PTAB to provide guidance on how to analyze a claim under the BRI rubric.

**Proxyconn’s Observations about Amending Claims in an IPR**

The Federal Circuit’s decision in Proxyconn also provides some guidance as to whether the PTAB’s current stern reluctance to permit claim amendments in the IPRs will continue.

While there are other appeals before the Federal Circuit that requested review of the PTAB’s amendment process, Proxyconn was the first to receive an opinion. Notably, in Proxyconn the Federal Circuit asked for supplemental briefing on the administrative procedure surrounding the amendment process. In particular, the Federal Circuit asked for briefing regarding the PTAB’s authority to apply Idle Free Systems, Inc. v Bergstrom, Inc.14 and its requirements when the rule governing motions to amend includes no such requirements.

Idle Free is an informative opinion that outlines what the PTAB requires in a motion to amend claims. First, the motion to amend should include one substitute claim for one challenged claim. Secondly, the substitute claim must be responsive to the alleged ground of unpatentability, must narrow the claim it replaces, and must not introduce new matter. The third condition is that the PTAB expects the patent owner to provide a showing of patentable distinction over the prior art for each substitute claim.

In Proxyconn, the Federal Court agreed with the PTO that the amendment rule “is not an exhaustive list of grounds upon which the Board can deny a motion to amend”. The Court agreed with the PTO that the agency, like other federal agencies,
may use rulemaking or adjudication to shape the contours of its rules.

The Federal Circuit stopped short of approving the complete set *Idle Free* requirements. It agreed with the PTO that the PTAB may require a patent owner to show a patentable distinction over the prior art of record, which in this case was limited to the prior art that "was very much a part of the entire [IPR]."15 Because this was the issue before it in *Proxyconn*, the Federal Circuit dropped a footnote that the Court was not addressing whether the patent owner needed to show a patentable distinction over all the prior art known to the patent owner – a major complaint of patent owners. So, it remains unclear whether the “prior art of record” includes more than what was used to challenge the patent claims. It also remains unclear whether the PTAB may require a showing of patentability under §§101 and 112 in the motion to amend.

**Conclusion**

*Proxyconn* further clarifies the BRI analysis and requirements for motions to amend. The BRI will remain the standard of claim construction in IPRs. Motions to amend will likely be restricted to one-for-one substitutions. Motions to amend will also have to show at least a patentable distinction over the prior art in the petition and the petitioner's opposition to the motion to amend.

*Michael W. O'Neill is a former Administrative Patent Judge on the Board of Patent Appeals and Interferences in the U.S. Patent Office, and represents clients in IPRs and reexaminations. Judge O'Neill, Mr Kramer, Dr Tonkovich, Mr Su and Mr Greenleaf are members of Dentons' Intellectual Property Group representing clients in patent litigation and IPR proceedings.

2 *In re Cuozzo Speed Technologies, LLC*, 778 F.3d 1271 (Fed. Cir. 2015).
4 *Proxyconn*, at 6.
5 ibid.
6 ibid. at 7.
7 ibid.
8 ibid.
9 ibid. at 6.
10 ibid.
11 ibid. at 7.
12 *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).
13 ibid. at 15, FN1.
15 *Idle Free* at 27.
Report on IPSANZ Annual Conference 2015

Rosemary Wallis

President
IPSANZ

This year’s 29th IPSANZ Annual Conference was held at the Fairmont Resort in Leura in the Blue Mountains, New South Wales over the weekend of 18-20 September 2015.

The Fairmont Resort is on the edge of the Jamison Valley, in the World Heritage-listed Blue Mountains National Park. The hotel was a beautiful destination for the conference and the facilities excellent. Unfortunately, for a good part of the time the weather rather let us down and we didn’t get the full benefit of the spectacular views due to mist and rain.

This year’s conference was well-attended with approximately 170 delegates (and accompanying persons), which ensured that all sessions were lively with much discussion.

I congratulate and thank the Trans-Tasman National Committee who, once again, ensured that the conference programme was varied and packed with topical issues. The assembled panel of speakers throughout the programme was excellent, and we are grateful to those speakers who generously gave freely of their time and expertise to deliver such educating and entertaining sessions. This is greatly appreciated.

The conference began late Friday afternoon with a presentation from Grant Elliott, the Director of the Enforcement Group for the ACCC, in New South Wales. This was the third session from the ACCC on its work over the past year, the first two sessions being presented by Paul Zawa. Grant kindly travelled up from Sydney to the Blue Mountains to give his presentation in the afternoon, before immediately heading back to Sydney for family commitments. IPSANZ is very grateful to Grant, especially given the time involved in travel from Sydney to the Blue Mountains and return! Grant’s presentation was well-received and attended. Of particular interest was Grant’s outline of the Pfizer case on atorvastatin (Lipitor), with the appeal scheduled for November.

After Grant’s presentation, we held the AGM, chaired for the last time by Andrew Goatcher. All Committee members of the Trans-Tasman National Committee were declared elected.

The social agenda got into full swing with the traditional welcome drinks held in Misty’s between 6pm and 8pm. The views from Misty’s are (supposedly) exceptional, but it was, unfortunately, too misty to see them, however, given the prevailing rain and light fog. The choice of name hinted that this might not be unusual!

Saturday morning began on a high note with an excellent presentation from the Society’s international guest speaker, Mr Henry Carr QC, introduced by Andrew Goatcher. Shortly before his departure for the conference Mr Carr had been elevated to the Chancery division of the High Court of England and Wales, with that appointment taking effect on 12 October 2015, upon his return to the UK. Mr Carr’s presentation was on “Patent Infringement Actions - Substantive and Procedural Developments in the UK and Europe”. He focused on two areas, interpretation of claims and the approach to “equivalents”, and changes made to speed up patent litigation and the two-track system available in the UK. The Bar’s loss is very much the Bench’s gain: the clarity and simplicity of his analysis on claim interpretation was outstanding and his comments on the Intellectual Property Enterprise Court illuminating. His session was well-attended and extremely well-received. Mr Carr was accompanied by his wife Jan. IPSANZ is very grateful to both Henry and Jan for their efforts to come out to Australia to present at the conference, but more so for giving up their time so freely to attend. We thoroughly enjoyed their company and hope that they will return down under.

This year’s conference presented a double whammy on patents with the second session covering the vexed issue of patentable subject matter in Australia. The session focused on developments in gene patents and computer software patents. Katrina Howard SC referred to her sense of déjà vu.
when involved in the *Myriad* litigation on DNA sequencing, a subject which she first came across a significant number of years ago. Her careful analysis of the issues would no doubt have assisted the understanding of many attendees when they came to read the High Court decision which issued shortly after the conference. Ian Horak reminded us of the central role of *NRDC* in patent interpretation on both sides of the Tasman, and his analysis of the recent *Research Affiliates* and *RPL Central* decisions involving computer-related inventions was very well-received and expertly delivered. The session was chaired by Sheana Wheeldon (New Zealand Bar) and was well-attended.

Following lunch held in Jamison’s Restaurant, overlooking the green lawn of the resort towards the Jamison Valley (lurking behind the continuing mist and rain) delegates were given a rare insight into the world of in-house counsel. Our second international speaker, Mr Batur Oktay, Director and Expert Senior Counsel of Starbucks Coffee Company (who travelled out from the US), co-presented with Nicola Adams of Pacific Brands (Melbourne) on the topic “Life in the Real World: The Role of in-house IP Counsel and Expectations of Advisors to the Business”. The session was chaired by Susan McMaster, (CSIRO Melbourne). In-house counsel may not have the pressures of time sheets and fee budgets, but they have other stresses and strains. Few of us will be sending them lengthy five-page opinions in future: distilling the essence of the advice into the first paragraph of the email is a skill we will all have to work on.

After a short break for afternoon tea, delegates reconvened for a panel presentation headed by Julian Miles QC (Richmond Chambers) and Daisy Williams (Shortland Chambers) both of Auckland, and Edward (Ed) Heerey (Victorian Bar) with the Honourable Justice Brendan Brown as Chair. Entitled “Death of a Trade Mark”, this session examined the issue of genericism on both sides of the Tasman. One of the most interesting aspects was the small number of successful cases, suggesting that revoking a trade mark on this basis is much harder than it might seem at first glance.

The conference dinner on Saturday night was held in the ballroom of the Fairmont Resort. At the dinner, Julian Miles QC, adjudicator of the 2015 IPSANZ Essay Prize, presented the prize to our first winner, Ms Tania Cheung-Davies, who had travelled from the United Kingdom on the Friday to receive her prize before returning back to the United Kingdom on Sunday! Julian Miles also awarded to Sandy Zhang...
and Sadaat Cheema the second and third prizes, respectively. We were delighted to be able to announce the renaming of the IPSANZ Essay Prize in honour of the Society’s long-time and greatly missed friend, as “The John McLaren Emmerson QC Essay Prize”.

I would like to once again congratulate the winners for their excellence and, in particular, thank Tania Cheung-Davies for her excellent entry and for taking the time to travel out from the UK to receive the IPSANZ Essay Prize. I would also like to take this opportunity thank the Prize Sub-committee (and members of the Trans-Tasman National Committee) for their ongoing efforts in the smooth running of the essay competition.

After the prize presentation, attendees were entertained by Cal Wilson, our after-dinner speaker. Cal had made a quick study of the law of copyright and was impressive in her ready grasp of the one of the more perplexing areas of intellectual property law. Her speech was highly entertaining and thoroughly enjoyable.

On Sunday morning, delegates assembled at 9.30am for the Judge’s Session given by The Honourable Justice Brendan Brown. The session was in the capable hands of The Honourable Justice Annabelle Bennett AO. The topic for the Judge’s session was “Through the Looking-Glass: A Career Volte-face: A Perspective from the Bench on Various Aspects of IP and Other Litigation”. Justice Brown’s presentation was insightful and delivered with his customary skill and style.

The final conference session on the topic “You Don’t Own Me: A Case Study on the Limits of Property, Personality, Parody and Privacy” was presented by a highly qualified panel of four speakers, Julia Baird SC (Barrister, New South Wales), Andrew Brown QC (Barrister, New Zealand), Professor Barbara McDonald (Faculty of Law, University of Sydney) and Professor Megan Richardson (Melbourne Law School, University of Melbourne). The session was chaired by Justine Munsie (Addisons, Sydney). A lively discussion took place around a factual scenario. It was a refreshing way to end the conference. Final words of closing were from the “retiring” Andrew Goatcher, ending three outstanding years as President.

And, wouldn’t you know it: the weather cleared just in time for us to head home.

I would like to take this opportunity to thank all the excellent speakers for giving so generously of their time in making the 2015 IPSANZ Annual Conference such a success.

Finally, I would also like to thank the outgoing executive officers of the Society for the 2014/2015 year, Andrew Goatcher (President), Ian Horak and Luke Merrick (Vice Presidents), Clare Cunliffe (Secretary) and our Committee members, and to welcome on board for 2015/2016, our new executive officers being Ian Horak and Sheana Wheeldon (Vice Presidents), Caroline Ryan (Secretary) and Clare Cunliffe (Treasurer) and also our other Committee members. Many thanks to everyone for standing for these positions: the society would not run effectively without your efforts.

So, where to next year? While we haven’t fixed on the spot, Sydney and Noosa are on the map. It will be our 30th IPSANZ Annual Conference, so expect a look back in time and some celebrations. I look forward to letting you know the destination and venue as soon as we have confirmed it and to seeing as many of you as possible there.
VICTORIA

Fiona Brittain
Davies Collison Cave
Victorian Committee

On 7 October, Dan Plane presented a “China IP Update” session, sharing his wealth of experience and knowledge in relation to the challenges and pitfalls of doing business in China from an IP perspective. The session included many practical tips and was followed by a lengthy Q & A session.

On 30 October, the “Trade Mark Update” session was presented by Ed Heerey of the Victorian Bar. We are very grateful to Ed, as he has now presented the TM Update for 10 years!

On 26 November, Professor Joshua Gans of the Rotman School of Management, University of Toronto, Canada, will speak on “Remixing Copyright” in a joint session of IPSANZ and The Arts Law Centre of Australia.

Plans are underway for the popular Christmas Moot to be held on 1 December. The Moot topic and other details will be circulated shortly. This is always an enjoyable and stimulating event to finish up the year.

Following an election on 7 October, the Members of the IPSANZ Victoria Committee for 2015/16 are as follows: Fiona Brittain (Chair); Kadri Elcoat; Simren Khosa; Robyn Sanders; Craig Douglas; David Franklin; Melissa Marcus; Jane Perrier; Bill Ladas; and Nico Burmeister.

We look forward to another successful year for IPSANZ Victoria.

NEW SOUTH WALES

Chris Williams
Gilbert + Tobin
New South Wales Committee

The NSW Local Committee recently held its annual election on 13 October 2015.

Welcome to our new and continuing members for the year ahead, including: Chris Williams (Gilbert + Tobin); Natalie Shoolland (Clayton Utz); Anna Spies (KWM); Roseanne Manning (DCC); Mandy Chapman (Beyond International); Joanna Jones (DCC); Alison Beamer (Allens); Eliza Forsyth (Dibbs); Melissa McGrath (Dibbs); Katrina Crooks (Shelston IP); Alison Jones (Corrs); Giulia Fimmano (AJ Park); David Lee (FB Rice); Shelley Einfeld (Einfeld IP); Gillian Woon (Bakers); Georgina Hey (Norton Rose); and Oliver Smith (Bird & Bird).

Thank you also to our outgoing Committee members, Georgia Marshall and Michael Sutton. Michael deserves a special mention given his decade of service on the NSW Committee, including as former Chairperson. Michael’s wine selecting abilities will be sorely missed and we hope that he will come back to the Committee at some point in the future after taking a well-earned break.

In the past quarter we have continued with our busy programme of speakers. On 18 August, we had an enlightening lunchtime presentation at the offices of Gilbert + Tobin by our journal’s editor, Christopher Sexton, on the topic, “From the Editor’s Bar Table – A Panorama of Forensic Cross-Examination of IP Luminaries and their Hobby Horses (1997-2015)”. On 13 October, Dan Plane, Director of Simone IP Services (Hong Kong) gave a well-received evening presentation at Bird & Bird on the topic “Protecting Trade Marks in China under the New Regime”. On 4 November, Ed Heerey presented his ever-popular “Trade Marks Update” at lunchtime to a maximum capacity audience at Gilbert + Tobin. And, coming up on 30 November, we have Andrew Fox delivering his annual “Patents Snippets” presentation at Allens.

We will be rounding out the year with our Christmas Party on 9 December 2015 at Hotel CBD and we look forward to seeing you there.

QUEENSLAND

Danielle Jepson
Fisher Adams Kelly Callinans
Queensland Committee

Many of our Queensland IPSANZ members thoroughly enjoyed attending the Annual Conference in the Blue Mountains in September. The Queensland Committee received excellent feedback in relation to the quality of the speakers and topics for the Conference, which is a credit to all those involved with organisation of the event.

On 21 October, Queensland members attended the annual Judges Dinner at the Gallery of Modern Art, Southbank. Guests were treated to a private art viewing of Daniel Crooks Motion, followed by an exceptional dinner with the annual presentation given by The Honourable Justice David Jackson.

The Honourable Justice David Jackson was appointed as a Judge of the trial division of the Supreme Court.
The Intellectual Property Society of Australia and New Zealand Inc. is pleased to announce its 2016 competition for an essay on a topic of the author’s choice regarding intellectual property.

1st Prize of the John McLaren Emmerson QC Essay Prize will comprise the sum of $5,000 AUD plus complimentary registration at the IPSANZ 30th Annual Conference scheduled to be held over a weekend in September 2016 including 2 nights’ accommodation at the conference venue and a return economy airfare from within Australia or New Zealand to the conference. The prizes for 2nd and 3rd place each comprise the sum of $1,000 AUD plus complimentary registration at the IPSANZ 30th Annual Conference.

It is intended that the Prize winners will be announced and presented at the Conference. The winning entry will be published in Intellectual Property Forum, the official journal of IPSANZ.

**COMPETITION RULES**

- Entries must be unpublished essays, which are the original work of the author. Entries should be between 5,000 and 10,000 words.
- Entries should be substantive works displaying original thinking in an area of intellectual property of the author’s choice. A maximum of two co-authors is permitted for entries. In the case of co-authors, the prize is to be shared between the authors. A maximum of two entries per author or pair of co-authors is allowed.
- Endnotes must appear at the end of the essay. Entries should include a summary of the essay (50-100 words). Entrants should keep a copy of the entry, as no entries will be returned.
- Each entry should be accompanied by a separate detached page giving the author’s name and contact details and a short biography. No identification of the author should appear on the entry itself.
- The decision of the judging panel will be final and no correspondence will be entered into. The judging panel will retain the discretion not to award the Prize.
- Three copies of each entry should be submitted by mail, typed, double-spaced and on A4 paper, and, a copy submitted electronically (in word format).
- Airfares, accommodation and entry to the IPSANZ Conference are non-transferable and not redeemable for cash. In the case of a winning entry from a country other than Australia or New Zealand a monetary contribution representing the cost of a return economy airfare from Melbourne or Sydney to the capital city in which the conference is to be held, will be made.

• Closing date for entries is Friday, 13 May 2016.

Entries should be sent to:
The Intellectual Property Society of Australia and New Zealand Inc.  
GPO Box 2491  
Melbourne Victoria 3001 Australia  
Telephone: (61 3) 9761 2833  
Facsimile: (61 3) 9761 2899  
Email: ipsanz@ipsanz.com.au
of Queensland and as a Judge of the Commercial List in 2012. Justice Jackson was the 113th judge to be appointed to the Supreme Court in its 151-year history. Justice Jackson’s practice at the Bar spanned 35 years, 22 of them as Queen’s Counsel. The topic of the presentation was “Copyright, the Trouble with Look and Feel” which was well-received by the attendees.

Queensland IPSANZ members are looking forward to celebrating the end of the calendar year with the annual Christmas Party Trivia Night, to be held at Fisher Adams Kelly Callinans on Wednesday 9 December.

SOUTH AUSTRALIA

Matt Murphy
Barrister, Anthony Mason Chambers
South Australian Committee

On 26 August, Mr Gary Cornelius from Leadenhall presented a session entitled “Valuation of IP – An Art or a Science”. The session covered the fundamental accounting principles and methodologies typically applied in valuing different species of registered and unregistered IP rights, which were further illuminated using practical examples and anecdotes. The session was very well-received and will likely be reprised in coming years.

On 12 October, Mr Daniel Plane from Simone IP Services presented an informative and practical session on the issue of counterfeiting in China. The session covered the mechanisms for IP right enforcement in China, together with practical steps clients can take to help safeguard their legitimate IP rights within China. This session had excellent feedback from the attendees.

On 22 October, Mr Ben Fitzpatrick from the Victorian Bar presented a patents update 2015 presentation. The session covered the latest developments in patent law, including High Court decisions that have broader implications for patent law. As always, Ben’s presentation was very well-received by those in attendance.

NEW ZEALAND

Rachel Colley
CreateIP
New Zealand Committee

Hot on the heels of the Conference, late September saw Ed Heerey in Auckland and Wellington to present his very popular ‘Australian Trade Marks Update for 2015’. This was followed by an October presentation by Andrew Brown QC on “Recent IP Decisions from the High Court and Court of Appeal”, which was nearly standing room only in Auckland.

The new Committee is now busy planning Christmas functions in Auckland and Wellington (it will be hard to top Wellington’s whiskey tasting of the previous year) and the seminar schedule for early 2016.

First off the rank in February 2016 will be a joint presentation by barristers, Kevin Glover and Greg Arthur. Aimed at the junior members, Kevin and Greg will provide guidance and tips for young players on navigating the early stages of an IP dispute.

Details of this seminar and others will follow.
Expressions of Interest
are invited from IP lawyers and writers
to contribute to the Profile Section of
Intellectual Property Forum

Since 1997, Intellectual Property Forum has featured regular interviews with a range of eminent persons who have made a significant contribution to the advancement of Intellectual Property Law in Australia and New Zealand.

Some of those who have been profiled include:

**Leading IP Judges** –
Chief Justice Robert French AC
Chief Justice James Allsop AO
Justice Arthur Emmett
Justice Andrew Greenwood
Justice Susan Kenny
Justice David Harper AM
Justice John Middleton
Former Justice William Gummow AC, QC
Former Justice Michael Kirby AC, CMG
Former Justice Ian Callinan AC, QC
Former Justice Susan Crennan AC, QC
Former Justice Kevin Lindgren AM, QC
Former Justice Peter Heerey AM, QC
Former Justice Alan Goldberg AO, QC
Former Justice Catherine Branson
Former Justice Kenneth Raphael
Former Justice Dr Annabelle Bennett AO, SC
The late Rt. Hon. Sir Thomas Munro Gault, KNZM, QC
The late former Justice Ian Sheppard AO, QC

**Leading IP Academics** –
Professor James Lahore
Professor Sam Ricketson
Professor Michael Blakeney
Professor Kathy Bowrey
Dr Francis Gurry
Dr Christopher Kendall
Dr Robert Dean
Professor Andrew Christie

**Leading IP Lawyers** –
The late Dr John McLaren Emmerson QC
Andrew Brown QC
John Katz QC
David Shavin QC
Clive Elliott QC
Angela Bowne SC
Anthony Franklin SC
Barry Hess SC
Katrina Howard SC
Jack Hodder SC
Clive Elliott QC
Brian Kewley
Des Ryan AM
Ann Dufty
Stephen Stern
Delia Browne
Terri Janke
Jim Dwyer OAM
Katrina Rathie
Jane Owen
Benny Browne
Yves Hazan
Kristin Stammer
The late Kathryn Everett
Adam Liberman
Scott Bouvier
Wayne McMaster
Margaret Doucas
Keith Callinan

**Leading IP Players** –
Emeritus Professor Sir Gustav Nossal AC, CBE
Professor Adrienne Clarke AO
Professor John Mills AO
The Honourable Daryl Williams AM QC
Frank Moorhouse AM
Tamara Winikoff
Rhonda Steele
Kathy Bail

Initial enquiries or expressions of interest to contribute a Profile are most welcome, and may be directed to:

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