

Duration, Authorship and Ownership of ©

(i) Duration

For literary, dramatic, musical and artistic works: life of author + 50 years (s.17(2))

(ii) Authorship: First person who creates a work (s.11)

“work of joint authorship” (s.12): a work made by collaboration of 2 or more authors in which the contribution of each author is not distinct from that of the other authors [otherwise: separate ©] [NB: as tenants in common with right of survivorship, *Redwood v Feldman*]

- In capacity as “author”: intellectual input, provide relevant skill, judgment or labour

Beckingham v Hodgens

- Violin part NOT original contribution of the right kind of skill and labour to song: NO evidence of working together in collaboration
- **NO** further requirement that parties **intended** the other to be a joint author

Robin Ray v Classic FM

- P (classic music expert) advised D on categorisation of music tracks in D’s library (select work to be included, assess popularity and provide information under each category)
- D granted licence foreign radio stations for use of system

Held:

- Contract for services, NOT employment
- NOT work of joint authorship as NO intellectual contribution by D (ONLY as providing raw materials)

(iii) Ownership: first owner as author (s.13)

Exception

1. Employee works in the course of employment: Employer as first owner
 - Subject to parties’ agreement to contrary (s.14(1))
 - **S.14(2):** employee entitled to reward where work exploited by employer in a way that cannot be reasonably be contemplated by employer and employee at time of the work

Stephenson, Jordan & Harrison v Macdonald & Evans

- Employee: as “integral part of business”

Noah v Shuba

- P wrote “Guide to Hygienic Skin Piercing” in his own time
- D’s article contained an extract from Guide, claiming that P cannot sue as © vested in his employer

Held: merely for e/ee’s own purpose; also evidence to displace statutory provision (as “contrary agreement”)

2. Commissioned work

- **S.15(1):** if there is agreement between parties, it would be given effect
- **S.15(2): [Override ss.(1) and s.13]**
- (a) person who commissioned work has an exclusive licence to exploit work for all purposes reasonably contemplated by parties when work was commissioned; (b) power to restrain exploitation which he could reasonably object
- ***Jet Tone Films v Lau Yuen Chui*:** CA noted, but did not decide, that P has right to host, maintain, update and use website for P's business purpose

Assignment

s.101(3): assignment not effective unless in writing signed by or on behalf of assignor

s.102(1): assignment of prospective © by agreement signed by or on behalf of prospective © owner

NB: Equitable assignment possible for a purported legal assignment which fails to satisfy legal formalities if it is specifically enforceable

- See ***Takmay v Wah Sang***: But equitable owner could only obtain interlocutory relief, NOT permanent relief as ONLY © owner has right to sue
- Proper solution: Discontinued proceedings and sought permanent relief after written (legal) assignment

Licensing

s.101(4): binding on © owner's successors in title except purchaser in good faith

s.103(1): exclusive licence means a licence in writing signed by or on behalf of © owner authorising licensee to exclusion to all others, including © owner, to exercise a right [i.e. specific for certain purpose, place and period: see ***Tong HokTak Daffy v Beverly Consultants***]

NB s.112(1), (2): concurrent rights with © owner; also to seek remedies

- BUT NOT against © owner (rather as breach of licensing agreement)
- **s.113:** Exclusive licensee may NOT proceed w/o leave of court unless © owner joined (see ***Swing Studio v Excel Media***)

Civil: Primary Infringement

s.22(1) © owner has exclusive right to

- | | |
|---|------|
| (a) To copy | s.23 |
| (b) To issue copies to public | s.24 |
| (c) To rent copies to public | s.25 |
| (d) To make available copies to public (Internet) | s.26 |
| (e) To perform, show or play in public | s.27 |
| (f) To broadcast | s.28 |
| (g) To make an adaptation | s.29 |

s.22(3): substantial; directly or indirectly [e.g. copying the article manufactured from © drawing: *Navystar v Fairing Industrial*]

(i) Substantial

- Depends on quality, NOT quantity: *Ladbroke v William Hill* [football coupon case: 15 out of 16 coupons]

NB for artistic work: correct question as “whether a substantial part of P’s work has been taken” [NOT whether P’s and D’s work look similar]

- See *Designers Guild v Russell Williams*

(ii) Copying

- s.23(2): copying is the reproduction of work in any material form [BUT literary work NOT “reproduced” in a non-literary form *Autospin v Beehive Spinning*]
C.f. “adaptation”: defined in s.29 [ss.(3)(a)(i) covers translation of work]

Two-stage test in *Francis Day v Bron*:

- Both as questions of facts
 1. Objective: whether D’s work is similar to P’s work
 - “Is it proper to infer that D’s work may have been copied from P’s work?”
 - See *Linda Koo v Lam Tai Hing*: inference of copying drawn (with assistance of expert evidence) from similar use of tables, sequences of questions, and grammatical mistakes
 2. Subjective: Has D copied P’s work, or is it an independent work of his own?
 - D may adduce evidence to rebut inference of copying, e.g. independent research, common source, merely using ideas without copying expressions

NB: (*Obiter*, per Wilmer LJ) subconscious copying is constitutes © infringement

See also *Solar Thomas Engineering v Barton*

- D sent sample of P’s work to independent designer: Verbal instruction to design a comparable product that would just avoid © infringement

Held: Infringement: No independent work by using P’s work as model with colourable differences only [still “substantial”]

- Causal connexion: copying as D’s work derived from P’s work

Civil: Secondary Infringement

s.30 Import / export otherwise than for private and domestic use

s.31(1) (a) possess “for the purpose of or in the course of any trade or business”
➤ Immaterial whether business consists of dealing with infringing copies
➤ Cover legitimate business using infringing copy (e.g. software)
(b) sell or let for hire
(c) exhibit in public or “distribute” for the purpose of or in the course of any trade or business”
(d) distribute (otherwise than for the purpose of or in the course of any trade or business) to such an extent as to affect prejudicially © owner
a copy which is, and which he knows or has reason to believe to be an infringing copy

Notes:

1. “has reason to believe”: involves concept of knowledge from which a reasonable man would arrive at the relevant belief (*LA Gear*)
 - E.g. *Yuen Chuk v Muhammad* (D dealt with P’s goods before [thus familiar with its designs] and obtained sweaters obtained from another manufacturer bearing similar design)
 - connotes allowance of a period of time to allow a reasonable man to inquire and evaluate facts into reasonable belief
 - *Vermatt & Powell v Boncrest*:
 - D warned by P “to be careful” of their similar design
 - P sent “letter before action” w/o identifying designs
 - 2 days later” D asked for details of designs alleged to be infringed
 - P did not reply, but started action the same day as D’s letter

Held: NO reason on D to believe samples as infringing copies

 - 2 days as too short for D to assess P’s claim
2. “infringing copy”
 - Defined in **s.35(2)**: its making constitutes infringement of © work
 - **S.35(3)**: parallel import is NO defence to secondary infringement (see *Eiichiro Oda v Po Fung Development*, import into HK (where there is an exclusive licensee) of Japanese comic books lawfully manufactured in Taiwan)
 - **NB: Defences under s.36(1)**, (a) made reasonable inquires, (b) reasonable ground to satisfy not infringing copy, (c) no circumstances for suspicion)

s.32 Providing means for making infringing copies

s.33 Permitting use of premises for infringing performance

s.34 Supplying apparatus for infringing performance

Defences

1. Statutory

Primary consideration (s.37(2)):

- NOT conflict with normal exploitation of work by © owner and NOT unreasonably prejudice legitimate interests of © owner

Fair dealing	Education exception	Fair dealing for education
<p>s.38(1): private study or news reporting [NOT cover copying of the same materials for more than one person: s.38(2)(b)]</p> <p>s.39(1): criticism or review + sufficient acknowledgment</p> <p>s.39(3): for purpose of reporting current events + sufficient acknowledgement (NB: no acknowledgement necessary for reporting of current events by means of sound recording, film, broadcast or cable programme)</p>	<p>s.41: copying not by means of reprographic process</p> <p>ss.(1): permitted to reasonable extent if copying is done by a person giving or receiving instruction in course of instruction or preparation for instruction</p> <p>ss.(2): for purpose of exam by way of setting question, communicating questions to candidates, or answering questions</p> <p>s.45: reprographic copying</p> <p>ss.(2): if licensing scheme knew or known to be available, have to follow</p> <p>ss.(1): permitted to reasonable extent if copies made by educational establishment for purpose of instruction</p>	<p>s.41A: by or on behalf of teacher or by pupil for purpose of giving or receiving instruction in specific course of study [medium neutral; pp162-3]</p>

Other defences: incidental inclusion in an artistic work, sound recording, film, broadcast or cable programme (**s.40**)

(a) “Fair dealing”

Consider factors in **s.38(3)**

- (a) purpose and nature of dealing, including whether for profit making and whether dealing is of commercial nature;
- (b) nature of the work;
- (c) amount and substantiality of portion dealt with in relation to the work as a whole; and
- (d) effect of dealing on potential market for or value of the work.

Pro Siben: question of fact and impression; concerned with genuineness of intentions and motives of user of © material and extent to which it is fair and reasonable in all circumstances to make as extensive a use

- **Hyde Park v Yelland** (Diana photo case): fairness judged by objective standard of whether a fair minded and honest person would have dealt with © work in same manner as D

NB: for photos, has to show most, if not the whole work, for purpose of critiquing them (**Fraser-Woodward v BBC**: Beckham photos case)

(b) “Private study or research” / “Criticism or review”

De Garis v Neville Jeffress Pidler Pty

- “Study”: ordinary meaning and include any application of the mind to acquisition of knowledge
- “Review” as process; “criticism” as application of mental faculties
 - Mere scanning without passing judgment as to merit of articles identified as insufficient to qualify for fair dealing defence under this head
- “Research”: take ordinary meaning

On facts:

- Research by D’s customer [D: operator of news-clipping service]: NOT by D
- NO study, research, criticism or review

Fraser-Woodward v BBC

- “Criticism” could be on ideas or philosophy underlying a certain style of journalism, as manifested in the works themselves

(c) “Sufficient acknowledgement” [defined: s.198]

Fraser-Woodward v BBC: could include voice-over mentioning name of author, showing photographer talking about the photos

(d) “Reporting current events”

Newspaper Licensing Agency v Marks & Spencer (obiter)

- Natural connotation as reporting of a recent newsworthy event
 - NOT natural to read to cover dealing which is the reporting of the mere fact that an article has appeared in the press
 - NO public interest involved: infringement of © within commercial organisation for commercial reasons [not wanting to pay for extra copies, so copies itself]
- BUT otherwise as “fair” dealing: not compete with © owner

(e) “Incidental inclusion”

Football Association Premier League v Panini UK Ltd

- Whether inclusion “incidental” turns on question why had P’s work been included in D’s work? (e.g. commercial and aesthetics consideration)
- Ordinary meaning
 - *IPC Magazine v MGN*: “causal, not essential, subordinate, or merely background”

Fraser-Woodward v BBC: inclusion of P’s photo “incidental” as it is included in headline, and D’s focus on headline, not photos (no zooming in, or shown for too long)

2. Common Law: Public interests

Hyde Park v Yelland

- Aldous LJ: circumstances where against policy of law to use court to enforce © NOT capable of definition
 - (i) immoral, scandalous or contrary to family life
 - (ii) injurious to public life, public health and safety or administration of justice
 - (iii) incites or encourages others to act in a way referred to in (ii)
- ➔ Though criticised in ***Ashdown v Telegraph Group***: not justified in circumscribing public interest tightly

HK: see ***Mak Hau Shing v Oriental Press*** (recognised existence of public interest defence, but no discussion on scope: only suggest that claim of depriving © NOT lightly entertained)

Remedies

(A) Generally: s.107

ss.(1): actionable by © owner (NOT author)

ss.(2): relief as for infringement of other property rights, including injunction and damages

(B) Exclusive licensee: s.112

ss.(1), (2): concurrent rights with © owner

ss.(3): D could apply same defences against exclusive licensee as against © owner

NB: Exclusive licensee may NOT proceed w/o leave of court unless © owner joined (**s.113**)

(C) Innocent D: s.108

ss.(1): if D did not know or had no reason to believe that © subsists in work in question, NO damages could be awarded (w/o prejudice to other remedies)

ss.(2): For flagrant infringement, court may order additional damages by considering all circumstances of the case, and in particular

- (a) Flagrancy of infringement
- (b) Any benefit to D by reason of infringement
- (c) Completeness, accuracy and reliability of D's accounts

See *Microsoft v Able System*

- D sold computers with unlicensed software of P

Held: Additional damages awarded

- Extensive infringement over long period of time (4 years)
- Lack of documentation for D's sale: P deprived of chance to seek account of profits