

Lecture 2

1. Requirements for Copyright Protection

The question that arises first is whether copyright subsists in a particular subject matter. The first stage of inquiry is to identify whether the particular subject matter is capable of being a copyright work under the law. The second stage is to consider whether the requirements laid down in the law for the subsistence of copyright in such subject matter are met, namely: ``fixation`` and ``originality``. Further, there are certain circumstances in which copyright protection may be denied to works.

A. Subject matter of protection

Copyright can subsist, subject to the conditions for subsistence being met, only in specified categories of what in the law are referred to as ``works``. The works in which copyright can subsist are:

(i) original literary, dramatic, musical or artistic works

(a) ``Literary work`` means any work, other than a dramatic or musical work, which is written, spoken or sung. It includes a table or compilation other than a database, a computer program; preparatory design material for a computer program and a database.

Thus, every product of writing, speech or song is likely to be a literary work. These include, for example: substantial creative endeavours such as novels, newspaper articles, examination papers, or more mundane things such as ordinary letters, written advertisements, rules for games, etc. Generally, there is no copyright in a name or title.

(b) The expression ``Dramatic work`` should be given its natural and ordinary meaning, which is that it is a work of action, with or without words or music, which is capable of being performed before an audience. It includes a work of dance or mime.

(c) ``Musical work`` means a work consisting of music, exclusive of any words or action intended to be sung, spoken or performed with the music. Music is generally defined as sounds in melodic or harmonic combination, whether produced by voice or instruments. Mere sounds are not necessarily music. Music is that which is regarded by a reasonable body of persons as music. Aesthetic appreciation is irrelevant to whether a work qualifies as a musical work.

(d) ``Artistic work`` means:

- a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
- a work of architecture being a building or a model for a building, or
- a work of artistic craftsmanship.

“Graphic work” includes:

- any painting, drawing, diagram, map, chart or plan, and
- any engraving, etching, lithograph, woodcut or similar work.

“Photograph” means a recording of light or other radiation on any medium on which an image is produced or from which an image may by any means be produced, and which is not part of a film;

“Sculpture” includes a cast or model made for purposes of sculpture.

(ii) sound recordings, films or broadcasts

(a) “Sound recording” means:

- a recording of sounds, from which the sounds may be reproduced, or
- a recording of the whole or any part of a literary, dramatic or musical work, from which sounds reproducing the work or part may be produced.

This is regardless of the medium on which the recording is made or the method by which the sounds are reproduced or produced.

(b) “Film” means a recording on any medium from which a moving image may by any means be produced. The sound track accompanying a film shall be treated as part of the film. Copyright subsisting in a film sound track can also be classified as a sound recording.

(c) A “broadcast” means an electronic transmission of visual images, sounds or other information which:

- is transmitted for simultaneous reception by members of the public and is capable of being lawfully received by them, or
- is transmitted at a time determined solely by the person making the transmission for presentation to members of the public.

“Internet transmissions” are generally excepted from the definition of broadcasts. The only kind of internet transmission which qualifies as a broadcast is:

- a transmission taking place simultaneously on the internet and by other means,
- a concurrent transmission of a live event, or
- a transmission of recorded moving images or sounds forming part of a programme service offered by the person responsible for making the transmission, being a service in which programmes are transmitted at scheduled times determined by that person.

B. Fixation

It is a long established principle of copyright law that copyright does not subsist in a work unless and until the work takes some material form. This principle is known as the requirement of fixation. The reasons for this principle are practical. Since copyright is a form of monopoly in relation to the subject matter which is protected, there must be certainty as to what that subject matter is. This is necessary both so as to be able to prove the existence of the work and to establish what the work consists of, so that it can be judged whether the work has been copied or otherwise infringed.

Fixation also provides a limit to the monopoly, ensuring that the protection accorded to the work does not extend beyond the expression of the work to the ideas or information contained or represented in it. This is necessary in holding a balance between the author's interests and society's interests.

Further, fixation provides a defined moment when the work takes existence, essential for the purpose of applying the rules as to the status of the author.

Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise. Sound recordings, film recordings and broadcasts, by their very definition, need to be ``recorded''.

C. Originality

(i) Expression, not content

Copyright protection is given to literary, dramatic, musical and artistic works and not to ideas. Therefore it is original skill or labour in execution of the work, and not originality of thought, which is required. The originality required relates to the expression of thought.

(ii) Nature of skill or labour required

The work must originate from the author, in the sense that it must not be copied from another work for a mere copyist does not obtain copyright in his copy. **However, the work may nevertheless be original** even though the author has drawn on knowledge common to himself and others, or has used already existing material.

Whether or not the author has drawn on other material, what is required is the expenditure of more than negligible or trivial effort or relevant skill in the creation of the work.

In this context, skill means the use of one's knowledge, developed aptitude or practised ability in producing the work. There should be use of one's capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. This exercise of skill and judgment will necessarily involve intellectual effort. The exercise of skill and judgment required to produce the work must not be so trivial that it could be characterised as a purely mechanical exercise. For example, any skill and judgment that might

be involved in simply changing the font of a work to produce another work would be too trivial to merit copyright protection as an original work.¹

(iii) Derivative works

In many cases a work is derived from an existing work. Common examples are a translation of a work, the dramatisation of a novel, a photograph of a painting and an arrangement of a musical work, but a derivative version can take many forms. Whether in such cases a new copyright work is created will depend on whether sufficient skill and labour was expended upon it but, assuming that it was, the person who was responsible for that skill and labour will be the author of the new work.

So where A's work is independently translated by B, B is the author of the translation. A of course remains the author of his original work but he is not the co-author or joint author with B of the translation.

Where a new copyright work is created by B from A's work, the rights of the owner of the copyright in A's work will depend upon how much of A's work remains in B's work. If B's work contains a substantial reproduction of A's work, then A's licence will be required to exploit it, as well as B's, for otherwise such exploitation will amount to an infringement of A's copyright. If B's work does not contain a substantial reproduction of A's work, then A's licence is not required.

Some more points of interest are:

(a) Mere copy

When an author creates a work without reference to any existing subject matter (non derivative works), it will be rare that it will lack originality merely by reason of its simplicity.

However – skill, labour and judgment merely in the process of copying cannot confer originality, and a mere copyist cannot have protection for his work. This is despite the fact that copying, for example of an artistic work, even in the same medium, often requires a higher degree of skill and judgment than the mere reproduction of a literary work. Particularly, therefore, where the copy is in the same medium as the original, there must be more than an exact reproduction or facsimile enlargement or reduction if the copy is to secure copyright. There must be some element of material alteration or embellishment which suffices to make the totality of the work an original work. In this, the quality of the alteration is likely to be more important than the quantity.

(b) Other use of existing subject matter

Where the author has made use of existing subject matter, it has to be determined whether he has expended sufficient independent skill and labour to justify copyright protection for his result. In determining whether the work is original and entitled to copyright, the work must be looked at as a whole and if, notwithstanding that the author has used existing subject matter,

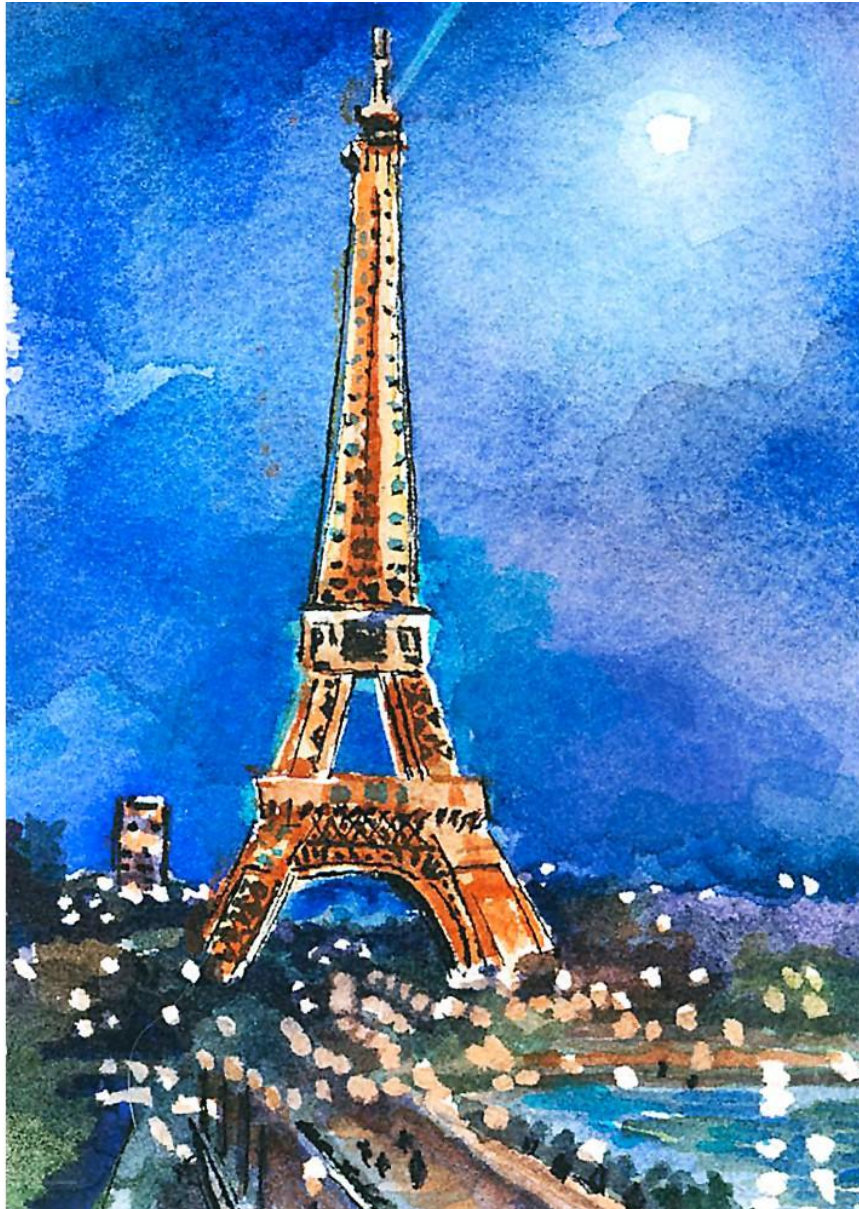
¹ CCH Canadian Ltd v Law Society of Upper Canada (2004) SCC 13 (Sup Ct of Can).

he has expended a degree of independent skill, labour and judgment, he will be entitled to copyright protection for his work as a whole.

(c) Change of medium or form

Changing the expression of a work from one medium or form to another may entitle the new work to copyright. For example, a drawing of a three dimensional object (statue or building) would qualify as an original work.

For example:



(d) New version of existing work

In the case of a new edition of an existing work, the issue will be whether any original work has been done by the editor. Such work may consist of additions to, or alterations of, the text which, if they are not merely trivial, but are material so as to make the totality of the work

original, will be protected in the same way as any original literary work, whether they form a substantial part of the complete work or not. Exploitation of the new edition will require the consent of the owners of the copyright in both works.

(e) New arrangement or adaptation of music

Any substantially new arrangement or adaptation of an existing piece of music is entitled to copyright. The test is whether the arrangement was a new and substantive work in itself.

Please see: *Castle Rock Entertainment Inc v Carol Publishing Group Inc* to get an understanding of the complex subject of derivative works.

D. Works denied protection

Copyright will subsist in a work which otherwise satisfies the requirements of the copyright law, even though the work may be considered by some to be libellous, immoral, obscene, scandalous, irreligious, to involve deception of the public or where its exploitation would otherwise be contrary to public policy.

Although copyright will subsist in such works, the court retains a jurisdiction to refuse to enforce some or all of the rights of a copyright owner, on the grounds of public interest or otherwise.

Works injurious to public life, public health and safety, or the administration of justice generally involve a deception of the public. Thus, a claim failed where the copyright work was falsely held out to be a translation from the German language of an author who had a high reputation for works of that kind, and the object had been to deceive purchasers and to give the work a value which it would not otherwise have had.

Copyright can subsist in a work which itself infringes copyright in an earlier work, and the issue is whether the court will enforce such copyright. As to this, a work which itself is an infringement of an earlier work, but which otherwise satisfies the requirements for copyright to subsist in the work, will normally be entitled to protection, subject to the right of the owner of the earlier copyright work to receive a share of any sum recovered.

Where the right to freedom of expression under Article 10 of the European Convention on Human Rights comes into potential conflict with the rights of a copyright owner, the fair dealing provisions, will usually provide a defence. In the public interest, the court would be bound to deny the copyright owner any relief the effect of which would be to prevent that freedom of expression.

2. The Chain of Title

In many circumstances it will be important to know who is the owner of the copyright in a work. This involves asking, first, who was the first owner of the legal title to the copyright, and secondly, whether that title has since devolved on some other person. The general rule under all the Copyright Acts in relation to literary, dramatic, musical and artistic works has always been that the author is the first owner of the copyright.

A. Transmission of title

Copyright is a statutory property right, being a thing in action, which is transmissible by assignment or by operation of law as personal or movable property.

(i) The root of title

Copyright has two features which combine to create difficulties when it comes to establishing title. The first is the potential longevity of many works, the period of copyright for literary, dramatic, musical and artistic works and films now being the lifetime of the author plus 70 years. Many works made in the 19th century are therefore still in copyright. The second is the absence of any system of registration of title (when compared with patents, registered trade marks and registered designs), or the existence of any rule whereby a good title can be deduced from a transfer made at least a certain number of years ago, or a concept equivalent to a possessory title to land.

The result is that, if required, the title to a work has to be proved by establishing a chain of title from the first owner through to the present claimant.

If the work is an old one, or is one which has passed through the hands of several owners this may present difficulties in obtaining the necessary evidence and is also likely to be expensive. Apart from insurance, however, there is no short cut if a purchaser requires title to be fully deduced.

In the context of litigation, suggestions that the burden of proof be altered such that the defendant should be required to prove that the claimant does not own the copyright have been rejected.

A claimant has two means of mitigating the problem as the law stands today, neither of them usually being very effective in practice. The first is to serve a notice to admit the various facts which establish the claimant's title, thereby throwing the risk of having to pay the costs of proving title on the defendant, whatever the result of the action. The second, where the appropriate material is available, is to seek to rely on one or more of the various statutory presumptions.²

² For example, the UK Copyright Act provides as follows:

Presumptions: Sections 104 - 106

104 Presumptions relevant to literary, dramatic, musical and artistic works.

(1) The following presumptions apply in proceedings brought by virtue of this Chapter with respect to a literary, dramatic, musical or artistic work.

(2) Where a name purporting to be that of the author appeared on copies of the work as published or on the work when it was made, the person whose name appeared shall be presumed, until the contrary is proved—

(a) to be the author of the work;

(b) to have made it in circumstances not falling within section 11(2), 163, 165 or 168 (works produced in course of employment, Crown copyright, Parliamentary copyright or copyright of certain international organisations).

(3) In the case of a work alleged to be a work of joint authorship, subsection (2) applies in relation to each person alleged to be one of the authors.

(4) Where no name purporting to be that of the author appeared as mentioned in subsection (2) but—

(a) the work qualifies for copyright protection by virtue of section 155 (qualification by reference to country of first publication), and

(ii) Distinction between transfer of title to copyright and to physical material

It is important to recognise that ownership of copyright in a work is distinct from the ownership of the physical material in which the copyright work may happen to be embodied. Copyright is not a chattel and so cannot be passed by delivery. Thus, for example, the purchaser of a book or DVD becomes the owner of the physical article but he does not thereby become the owner of any part of the copyright in the works reproduced in it. The copyright in the literary work remains with the copyright owner, who enjoys and is entitled to enforce all the exclusive rights of copying, publication, adaptation, sale, rental and so on conferred on him by copyright law.

(iii) Transfer of legal title by assignment

(a) Assignment

An assignment of the legal title to copyright is not effective unless it is in writing signed by or on behalf of the assignor. Writing includes any form of notation or code, whether by hand or otherwise and regardless of the method by which, or medium in, or on which, it is recorded. No notice to anyone is required to perfect the transfer. Minors can own and dispose of copyrights in the same way as adults, but subject to the usual rules as to infants' contracts. In the case of a body corporate, the requirement that the assignment should be signed by or on behalf of any person is satisfied by the affixing of its seal.

An assignment of copyright does not have to be in any special form, other than in writing, signed by or on behalf of the assignor. Since copyright is made up of various rights, in general an assignment of copyright will operate, in the absence of contrary intention, to convey to the assignee all the rights which go to make up the copyright. An assignor should therefore always take care that the assignment is drawn in such a way as not to carry rights in excess of those intended to be assigned.

An author who has assigned the copyright in his work may, like any other person, be restrained by the assignee from reproducing or authorising others to reproduce the work.

A copyright owner will often wish to divide up the copyright, parcelling out different rights to different persons and, in general, it is permissible to do so.

(b) Partial assignment

An assignment or other transmission of copyright may be partial, that is, limited so as to apply—

to one or more, but not all, of the things the copyright owner has the exclusive right to do;

(b) a name purporting to be that of the publisher appeared on copies of the work as first published, the person whose name appeared shall be presumed, until the contrary is proved, to have been the owner of the copyright at the time of publication.

(5) If the author of the work is dead or the identity of the author cannot be ascertained by reasonable inquiry, it shall be presumed, in the absence of evidence to the contrary—

(a) that the work is an original work, and

(b) that the plaintiff's allegations as to what was the first publication of the work and as to the country of first publication are correct.

to part, but not the whole, of the period for which the copyright is to subsist.

Thus copyright may be assigned for a period less than the whole term of copyright or for different territories.

Where different persons are in consequence of partial assignments entitled to different aspects of copyright in a work, the copyright owner for the purposes of, for example, infringement, is the person who is entitled to the aspect of the copyright relevant for the purpose of the law.

(c) Assignment of future copyright

The general law is that a work must be in existence before its ownership can be assigned at law.

Where by an agreement made in relation to future copyright, and signed by or on behalf of the prospective owner of the copyright, the prospective owner purports to assign the future copyright (wholly or partially) to another person, then if, on the copyright coming into existence, the assignee or another person claiming under him would be entitled as against all other persons to require the copyright to be vested in him, the copyright shall vest in the assignee or his successor in title.

A number of points arise in this regard:

- Future copyright means copyright which will or may come into existence in respect of a future work or class of works or on the occurrence of a future event.
- Prospective owner shall be construed accordingly, and includes a person who is prospectively entitled to copyright by virtue of such an agreement as is mentioned above.
- Assignments of future copyright can only be made by written agreement. Unlike an assignment of existing copyright, which does not require consideration or an "agreement", a specifically enforceable agreement is necessary in this case. This follows from the use of the word "agreement", in contrast to "writing" in the case of an assignment of existing copyright, and from the fact that the title will only vest if the assignee is entitled, as against all other persons, and thus including the assignor, to require the title to be vested in him by the assignor.
- the expression "entitled against all other persons" refers to the rules of priority. So, for example, where the prospective owner purports to assign the future copyright to two persons by separate assignments, the first in time will become the owner unless he has so acted to cause his right to be postponed.

(iv) Transmission by testamentary disposition and operation of law

(a) Death

On the death of an owner, his copyrights will devolve on his personal representative. Subject to payment of debts and administration expenses, the copyrights will be held by the personal representative for the benefit of the person to whom the owner has bequeathed them or, if he died intestate, his next of kin.

(b) Bankruptcy

On an owner's bankruptcy, the copyright in a work is held initially by the Official Receiver as receiver and manager, and, on the appointment of the trustee in bankruptcy of the copyright owner passes, to him by operation of law without any assignment in writing.

B. Mortgages and charges

The express giving of security over a specific copyright work or works has historically not been a common feature of copyright law but is becoming more so. An exception has been the film and related industries where the sums required to fund the making of a film are such that the financiers will usually require some form of security (usually a mortgage) over the film and underlying works (such as the screenplay) to protect their investment. Apart from this, it is of course an everyday feature of commercial life for companies to provide fixed and floating charges over their assets by way of a debenture to secure bank or other loans. Caught up in such charges will be any copyright works belonging to the company.

(i) Mortgages

As with any mortgage, the characteristic of a mortgage of copyright is the transfer of the copyright to another as a security for the payment of a debt or the discharge of some other obligation for which it is given. A legal mortgage of copyright is formally effected by an assignment of the copyright by the mortgagor coupled with a covenant by the mortgagee to reassign on repayment of the debt or discharge of the obligation. A legal mortgage must therefore be in writing, signed by or on behalf of the mortgagor-copyright owner. Where it is contemplated that the mortgagor will need to exploit the work during the term of the mortgage, the mortgage will need to include a grant back of a licence, usually an exclusive licence, to allow for this.

A legal mortgagee, having the legal title vested in him, can sue in his own name for infringements of copyright, although in his conduct of the action he must bear in mind that he holds the copyright as a mere security for his debt. The mortgagor, who retains an interest in the copyright by way of the right of redemption, also has a sufficient title to start proceedings to restrain infringements of copyright and thus protect his interest, but he must join the mortgagee or redeem the mortgage before trial.

(ii) Charges

A charge over copyright is created when the owner agrees to give another rights over the copyright as security for a loan or other obligation. This is formally effected by the owner agreeing that the copyright should stand charged with the repayment of the loan or discharge of the obligation, but the same result is achieved where the owner agrees to pay a debt out of the copyright or its proceeds of sale. In the case of many company debentures, the charge will be a floating one, enabling the company to deal freely with copyright works created or acquired in the course of the business until the charge crystallises. The legal title is **not transferred** to the chargee and in principle the chargee merely has the right to have the copyright realised by judicial process to obtain repayment of the loan. A well drafted charge

will, however, provide remedies such as the power to appoint a receiver to enable the chargee to realise his security without recourse to proceedings.

C. Licences

(i) General

Copyright law confers on the copyright owner the exclusive right to do the various acts restricted by the copyright. An infringement of copyright occurs if one of those acts is done without his licence. A licence therefore passes no interest but merely makes lawful that which would otherwise be unlawful; it is a permission which carries with it immunity from proceedings.

A mere licence from the copyright owner confers no proprietary interest on the licensee enabling him, for example, to bring proceedings in his own name.

Usually there is no requirement for a licence to be in writing. It can be oral, or implied into a contract.

A “sole licence” is one where the licence is coupled with a contractual promise that the licensor will not grant a license to any other party, the licensor himself remaining free to exercise the licensed rights.

A “sole and exclusive licence” (also known as an exclusive licence) is one where there is included a promise that the licensor will not himself exercise any of the rights which are the subject of the licence.

(ii) Exclusive licences

Exclusive licences are of great commercial convenience and thus enjoy a statutory procedural status entitling them to bring actions against infringers in their own name. Thus the law specifically provides that an “exclusive licence” means a licence in writing signed by or on behalf of the copyright owner authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the copyright owner.

Further, the licensee under an exclusive licence has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

(a) Rights and remedies of exclusive licensee:

- An exclusive licensee has, except against the copyright owner, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.
- His rights and remedies are concurrent with those of the copyright owner.

It should be noted however that the exclusive licensee is not himself the owner of the copyright, is not treated as such owner and is not entitled to the copyright. Nevertheless, an exclusive licensee is often spoken of as having an "interest" in the copyright.

Where an action for infringement of copyright brought by the copyright owner or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the copyright owner or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(b) Special provisions as to damages and account of profits:

- Damages

Where an action for infringement of copyright is brought which relates (wholly or partly) to an infringement in respect of which the copyright owner and an exclusive licensee have or had concurrent rights of action, the court shall in assessing damages take into account the terms of the licence, and any pecuniary remedy already awarded or available to either of them in respect of the infringement.

- Account of profits

No account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them; and these provisions apply whether or not the copyright owner and the exclusive licensee are both parties to the action.

- Delivery up and right of seizure

The copyright owner shall notify any exclusive licensee having concurrent rights before applying for an order for delivery up or exercising the right of seizure; and the court may on the application of the licensee make such order for delivery up or, as the case may be, prohibiting or permitting the exercise by the copyright owner of the right of seizure, as it thinks fit having regard to the terms of the licence.

(iii) Non-exclusive licences

A "non-exclusive licensee" means the holder of a licence authorising the licensee to exercise a right which remains exercisable by the copyright owner.

A non-exclusive licensee may bring an action for infringement of copyright if the licence is in writing and is signed by or on behalf of the copyright owner; **and expressly grants the non-exclusive licensee a right of action.**

However, in practice this is often impossible, because in most commercial cases, the copyright owner will not wish to give the licensee a right to sue independently of him and is thus unlikely to expressly grant the non-exclusive licensee a right of action.