Lecture 3

The rights of a copyright owner: Infringement

1. Introduction

Copyright is a statutory property right, the rights of property granted being the exclusive right to do various ``restricted acts´´ in relation to the copyright work. Being a property right, the rights of a copyright owner can be sold or licensed. In a commercial context, therefore, it is common to ask what are the rights of a copyright owner which are available or need to be obtained. As to enforcement of those rights, the remedy for invasion of a copyright owner´s exclusive rights by a third party is, by statutory definition, an action for infringement. Infringement only occurs if one of the exclusive rights of the copyright owner has been invaded.

A. Primary and secondary infringement

The copyright owner has certain exclusive rights which are conferred on him by the law and an infringement of those rights is known as ``primary infringement´´.

In addition, however, the law provides additional remedies to copyright owners in respect of various dealings in relation to copyright works and infringing copies. The necessary ingredients of these remedies are that:

(i) they only arise when some other infringing act has occurred or is assumed to have occurred (``the primary infringement´´) and

(ii) the liability of a defendant is dependent on establishing some degree of ``guilty´´ knowledge on his part.

The acts in respect of which these remedies are available are also classified as infringements although they are not strictly invasions of any of the exclusive property rights which are expressly conferred on the copyright owner, yet in some sense these remedies do constitute additional rights of the copyright owner. These are classified as ``secondary infringements´´.

B. The rights: basic definitions

The rights of the copyright owner are defined to be the exclusive right to do the following acts:

(i) copy the work (``the reproduction right´´);

(ii) issue copies of the work to the public (``the distribution right´´);

(iii) rent or lend the work to the public (``the rental and lending rights´´);

(iv) perform, show or play the work in public (``the public performance right´´);

(v) communicate the work to the public (``the communication to the public right´´);

(vi) make an adaptation of the work, or to do any of the above acts in relation to an adaptation of the work (``the adaptation right´´).

These various rights are described as the acts ``restricted by the copyright´´ in a work.

C. The basic definition of infringement

Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

In addition, copyright is infringed:

(i) by the doing of any of these acts not only in relation to the whole of a work but also in relation to any substantial part of it,

(ii) by the doing of any of these acts either directly or indirectly; and it is immaterial whether any intervening acts themselves infringe copyright.

The doing of any of these acts by any person other than the copyright owner or one who has his permission is therefore an infringement unless the act falls within one of the statutory permitted acts or is otherwise excusable.

Further, since copyright is a proprietary right and is infringed by invasion of the right, ignorance or innocence is not a defence. As copyright is a right of property, it is actionable without having to show damage. This is the case with respect to Primary Infringements.

2. The reproduction right

The exclusive right to prevent copying or reproduction of a work is the most fundamental, and historically the oldest, right of a copyright owner. In one form or another, the reproduction right exists today in relation to every category of copyright work.

Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form. This includes storing the work in any medium by electronic means.

In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three dimensional work.

Copying in relation to a film or broadcast includes making a photograph of the whole or any substantial part of any image forming part of the film or broadcast.

Copying in relation to the typographical arrangement of a published edition means making a facsimile copy of the arrangement.

Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work.

A. Common considerations

The common points are:

(i) The right is the exclusive right of copying. For the right to be infringed, two elements have to be established:

(a) a sufficient degree of objective similarity between the copyright work and the alleged infringement and

(b) that this was the result of the copyright work having been copied, i.e. that there is a causal connection between the two.

(ii) As with all rights of a copyright owner, the exclusive right relates not only to the entire work but also any substantial part of it. The exclusive right is the right to copy the work either directly or indirectly.

B. Sufficient Similarity

This has two aspects:

(i) First, the allegedly infringing work must in some real sense represent the claimant´s. Thus a literary work consisting of instructions will not be infringed by the making of an article in accordance with those instructions. Further, an artistic work such as a circuit diagram will not be infringed by describing it or its contents in words, no matter how detailed.

(ii) Secondly, even if the defendant´s work does represent the claimant´s in this sense, there will be no infringement if there is no sufficient objective similarity between it and the copyright work. Even if a copyright work has been used as a reference or is the inspiration for what the defendant has done, this by itself is not enough if there is no such similarity. For example, a defendant may have derived his work from the claimant´s, but may have done so in such a way, either deliberately or through incompetence, that what he produces does not amount to a copy in law. The issue here is whether a substantial part of the copyright work has been copied, an issue which is perhaps the most common and often the most difficult question arising in everyday copyright law.

C. Causal connection

Where the claimant´s and the defendant´s works are similar, there are four possible explanations:-

the defendant´s work was copied from the claimant´s;

the claimant´s from the defendant´s;

both from a common source; or

mere chance or coincidence.

It is only in the first case that an infringement of the claimant´s work can have occurred. There can be no infringement unless use has been made, directly or indirectly, of the copyright work. Copyright is not a monopoly right and no infringement occurs by an act of independent creation. This is one of the ways in which copyright differs from true monopoly rights such as patents and registered designs. In the case of the latter rights, a person can infringe even though he has arrived at his result by independent creation.

D. Indirect copying

Copyright may be infringed indirectly by copying something which is itself a copy of the claimant´s work. Indeed, in most cases of alleged infringement the copying is done indirectly, the plagiarist never having seen the original manuscript, drawing, etc., only the published work or other thing derived from the original work. An artistic work is capable of being infringed where the link between it and the copy is a written or verbal description, if the description is nevertheless sufficient to enable a copy of the artistic work to be made. Thus, for example, even if an independent designer is employed in an attempt to avoid infringement, it may be necessary to give him so much information that the work he produces is still a copy.

Even though copying may take place indirectly, it is still necessary to prove an unbroken chain between the claimant´s and the defendant´s work. It must therefore be shown that the intermediate copy is itself either a direct or indirect copy of the copyright work.

The need for a causal connection obviously implies the need to show that the alleged infringer has access, either directly or indirectly, to the copyright work. If there is sufficient similarity between the works, this will raise a prima facie case of access and thus causation.

E. Substantial part

The law has never allowed a defendant to escape liability on the grounds that he has not copied the claimant´s work exactly. Less than complete copying has always been an infringement. On the other hand, it has never been the law that copying of any part of a work, no matter how small, is unlawful; copyright should not be allowed to become an instrument of oppression and extortion. Some use of a copyright work is clearly permissible, for the law does not prohibit use of ``any´´ part, only a ``substantial´´ part. It is in arriving at the dividing line that the difficulty arises.

The use which has been made of the claimant´s work can usually be characterised as:

(i) the exact use of part of the work only (as where extracts from a literary work have been taken *verbatim*) or

(ii) some reworking of the whole of it (as where the whole of a literary work has been paraphrased, dramatised or translated into another language; an entire artistic work imitated in some way; or a complete musical work altered) or

(iii) a combination of these.

The essential test is whether the defendant´s work has been produced by the substantial use of those features of the claimant´s work, which by reason of the knowledge, skill and labour employed in their production, constitute it an original copyright work. The test has been put in a number of similar ways. Has the infringer incorporated a substantial part of the independent skill, labour, etc., contributed by the original author in creating the copyright work? Has the defendant made a substantial use of those features of the claimant´s work in which copyright subsists? Has there been a substantial appropriation of the independent labours of the author? Has there been an appropriation of a part of the work on which a substantial part of the author´s skill and labour was expended? Has there been an over-borrowing of the skill, labour and judgment which went into the making of the claimant´s work? It is therefore often important to ask what are the features of the claimant´s work which made it an original work and thus which gave rise to its protection under the law of copyright. For example, with a literary work it may be the skill or effort in expressing thoughts or information in words, or the collecting together and presentation of other material; with a dramatic work, the working out of details of character and plot; with a musical work, the composition of a melody or its orchestration; with an artistic work, the arrangement and representation of subject matter; and so on. If substantial use has been made of these features, then infringement will have occurred.

Further points of interest:

(i) The quality or importance of what has been taken is much more important than the quantity.

(ii) Depending on the circumstances, the question may depend on whether what has been taken is novel or striking, or is merely a commonplace arrangement of words or well known material.

(iii) In general it is wrong to dissect the claimant´s work, taking each part which has been copied and asking whether each part could be the subject of copyright if it had stood alone. It is the work as a whole which must be considered, particularly where the originality of the work lies in the creation of the work as a whole.

(iv) It is wrong to concentrate on the dissimilarities between the works: what is important is a comparison between the copyright work considered as a whole and those elements which have been taken from it.

(v) In the case of some works, such as works of historical reference, it may be that a greater amount of copying is permissible than with other works, such as novels.

3. The issue of copies to the public: the distribution right

One of the acts restricted by the copyright in all works is the issue of copies of the work to the public. Broadly, this means the act of first release onto the market of any particular copy of the work, including the original.

The expression ``the issue to the public of copies of a work´´ means:

(i) the act of putting into circulation in the EEA copies not previously put into circulation in the EEA by or with the consent of the copyright owner, or

(ii) the act of putting into circulation outside the EEA copies not previously put into circulation in the EEA or elsewhere.

For this purpose, ``issue to the public of copies of a work´´ does not include:

(iii) any subsequent distribution, sale, hiring or loan of copies previously put into circulation, or

(iv) any subsequent importation of such copies into the United Kingdom or another EEA state,

except insofar as paragraph (i) above applies to putting into circulation in the EEA copies previously put into circulation outside the EEA.

The effect of this is as follows:

(a) If the copy of the work has never been put into circulation anywhere in the world, the act of putting it into circulation in the United Kingdom for the first time is a restricted act.

(b) If the copy has previously been put into circulation within the EEA by or with the consent of the copyright owner, then the act of putting it into circulation in the United Kingdom is not a restricted act. In Community terms, the distribution right is exhausted by the consensual first act of distribution.

(c) If the copy has previously been put into circulation in a country outside the EEA, but not within the EEA, then the act of putting it into circulation in the United Kingdom is a restricted act.

(d) Whether the act of putting the copy into circulation in a country other than the United Kingdom is an infringement of copyright is a matter for the law of that state, not that of the United Kingdom.

It may be noted that releasing of a copy onto the market such that it may be passed on to other members of the public amounts to issuing to the public, or putting a copy into circulation.

4. The rental and lending rights

A. Historically, the right to control the rental or lending of legitimate copies was not one of the rights conferred on copyright owners. Implementation of the Rental and Related Rights Directive required the Member States to grant an exclusive right of rental and lending in relation to a wide class of works. Member States were permitted to derogate from this right in respect of ``public lending´´, provided that authors obtained remuneration for this.

Thus, the scheme of the present law is that both rental and lending of copies of a work to the public are now restricted acts, that is, they are two of the exclusive rights of the copyright owner. But, in some countries, if the lending of a book by a public library is within the special

Public Lending Right Scheme (whereby a limited class of authors is entitled to payment out of a central fund in respect of books lent to the public by local library authorities), or is by a prescribed library or archive, it amounts to a permitted act and is therefore not an infringement.

B. The rental and lending right only applies to certain categories of works, namely:

(i) a literary, dramatic or musical work, (ii) artistic works, (other than a work of architecture in the form of a building or a model for a building or a work of applied art), and (iii) films or sound recordings.

The rights do not extend to buildings, the intention being to exclude the possibility of an architect or copyright owner being able to control the leasing of property. The exception in the case of works of applied art refers broadly to articles to which an artistic work has been applied, usually by an industrial process. The distinction is between works of applied art and works of pure art. The intention is again to prevent the owner of the copyright in designs for such articles as cars or items of crockery from controlling their rental.

C. ``Rental´´ means making a copy of the work available for use, on terms that it will or may be returned, for direct or indirect economic or commercial advantage. This is aimed at the ordinary commercial rental of a work. The European Court of Justice has made it clear that rental right is not exhausted by the sale or other acts of release into circulation of a copy of the work, nor by other acts of rental.

D. ``Lending´´ means making a copy of the work available for use, on terms that it will or may be returned, otherwise than for direct or indirect economic or commercial advantage, through an establishment which is accessible to the public. The expression "lending" does not include making available between establishments which are accessible to the public (for example from one library to another). Where lending by an establishment accessible to the public gives rise to a payment the amount of which does not go beyond what is necessary to cover the operating costs of the establishment, there is no direct or indirect economic or commercial advantage.

E. The above rights only apply where copies are made available ``to the public´´. This clearly requires that the public at large has access to the work. It excludes the rental or loan of the work or a copy by one private individual or concern to another.

The expressions ``rental´´ and ``lending´´ do not include:

(i) making available for the purpose of public performance, playing or showing in public or communication to the public. (Thus, for example, the rental of a film to a cinema for public showing is not a restricted act.)

(ii) making available for the purpose of exhibition in public; or

(iii) making available for on-the-spot reference use. (Thus an organisation which allows users to have access to a work but not to take it away does not rent or lend the work for this purpose.)

5. Performance, showing or playing of a work in public: the public performance right

A. The performance of the work in public is an act restricted by the copyright in a *literary, dramatic or musical work*. For this purpose, "performance", in relation to a work includes delivery in the case of lectures, addresses, speeches and sermons, and in general, includes any mode of visual or acoustic presentation, including presentation by means of a sound recording, film or broadcast of the work.

The playing or showing of the work in public is an act restricted by the copyright in a *sound recording, film or broadcast*. Thus, for example, the playing of a sound recording in public by means of a record player or a juke box would amount to a public performance not only of the literary or musical works embodied in it, but also of the sound recording itself.

It must be noted that these rights are infringed by doing such acts in relation to a substantial part of the work and by authorising such acts.

It is clear that the expressions ``performance´´, ``playing´´ and ``showing´´ used in the above senses include the doing of such acts by means of a radio or TV set. Thus, for example, the playing of a radio or TV in public will amount to a public performance of works of the above descriptions embodied in the broadcast, and of the broadcast itself.

B. The person liable for the infringement

Where the works are played by the use of such means as radios, TVs or juke boxes, the person liable for the primary act of infringement will be the person who actually operates the apparatus by means of which the sounds or images are produced. Other persons may ofcourse be liable for having authorised such acts of primary infringement, and persons who provide the premises or apparatus for such performances may be liable for acts of secondary infringements.

However, where copyright in a work is infringed by its being performed, played or shown in public by means of apparatus for receiving visual images or sounds conveyed by electronic means, the person by whom the visual images or sounds are sent (example a **broadcaster**), and in the case of a performance the **performers**, shall not be regarded as responsible for the infringement.

C. ``In public´´

The distinction to be made is between performances which are public and those which are domestic or quasi domestic in character, that is, those in which the members of the audience are present in their capacity as members of the particular home circle.

A useful test is whether the persons coming together to form the audience are bound together by a domestic or private tie, or by an aspect of their public life.

It is the duty of the court to protect the rights of persons such as authors and composers, such that it is important to ask whether the public´s demand for their works may be affected by such performances. Thus the court should consider whether the performance is likely to injure the owner of the copyright in the sense that some of the audience might be willing to pay to see or hear such a performance.

The putting on of a play by children or adults at home would obviously not be in public, being domestic and private. The same would apply to a play put on for friends in a house hired for the occasion. However, if the public at large is freely admitted, the performance will almost certainly be in public. But the performance may also be in public if only a limited portion of the public is allowed to attend, for example the members of a club and their guests. The fact that no charge is made for the admission is of itself of little importance. Thus the playing of gramophone records and the radio over loudspeakers to workers at a factory during working hours, or the performance of orchestral music in the lounge of a hotel, the audience consisting of residents of the hotel and members of the public who had dined there are cases in which performances have been regarded as having taken place in public.

6. The communication to the public right

The communication to the public of the work is an act restricted by the copyright in (i) a literary, dramatic, musical or artistic work, (ii) a sound recording or film, or (iii) a broadcast.

To communicate to the public is defined to mean communication to the public by electronic transmission, and to include the broadcasting of the work and the making available to the public of the work by electronic transmission in such a way that members of the public may access it from a place and at a time individually chosen by them.

This is also covered by the Information Society Directive.

As we have seen previously, ``Broadcast´´ means an electronic transmission of visual images, sounds or other information which

(i) is transmitted for simultaneous reception by members of the public and is capable of being lawfully received by them, or

(ii) is transmitted at a time determined solely by the person making the transmission for presentation to members of the public.

The person making a broadcast, or a transmission which is a broadcast **is**

(i) the person transmitting the programme, if he has responsibility to any extent for its contents, and

(ii) any person providing the programme who makes with the person transmitting it the arrangements necessary for its transmission;

The place from which a wireless broadcast is made is the place where, under the control and responsibility of the person making the broadcast, the programme-carrying signals are introduced into an uninterrupted chain of communication (including, in the case of a satellite transmission, the chain leading to the satellite and down towards the earth).

Where the place from which the programme-carrying signals are transmitted to the satellite ("the uplink station") is located in an EEA State that place shall be treated as the place from which the broadcast is made, and the person operating the uplink station shall be treated as the person making the broadcast.

Where the uplink station is not located in an EEA State but a person who is established in an EEA State has commissioned the making of the broadcast that person shall be treated as the person making the broadcast, and the place in which he has his principal establishment in the European Economic Area shall be treated as the place from which the broadcast is made.

7. The adaptation right

The making of an adaptation of the work is an act restricted by the copyright in a literary, dramatic or musical work. An adaptation is made when it is recorded, in writing or otherwise.

The law provides that not only is the making of an adaptation a restricted act but it is also a restricted act to reproduce an adaptation in any material form, issue copies of it to the public, perform it in public or communicate it to the public. For this purpose it is immaterial whether the adaptation has been recorded, in writing or otherwise, at the time the act is done. Thus, for example, copyright in a musical work may be infringed by performing an adaptation of it on stage, even though the adaptation itself is never recorded.

``Adaptation´´ in relation to a literary or dramatic work, other than a computer program or a database, means:

(i) a translation of the work (it must be noted that two separate rights may exist where there has been a translation, namely the right of the owner of the copyright in the original work to restrain reproduction, etc., of the original or any translated form, and the right of the owner of the copyright in the translation to restrain reproduction of his translation. Even where the translation was unauthorised, although an infringement, it will be entitled to copyright);

(ii) a version of a dramatic work in which it is converted into a nondramatic work or, as the case may be, of a non-dramatic work in which it is converted into a dramatic work (for example when a novel is turned into a play or a screenplay for a film. That is not to say that mere ideas or a character can be protected in this way, certainly if the character or ideas are not novel, but if the combination of events which has been taken is not merely trivial, but amounts to a substantial part, there will be infringement);

(iii) a version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a newspaper, magazine or similar periodical (for example, a pictorial representation/strip cartoon of the plot of a book or a play will constitute infringement even though no words are used in the representation).

``Adaptation´´ in relation to a computer program, means an arrangement or altered version of the program or a translation of it. Here a ``translation´´ includes a version of the program in which it is converted into or out of a computer language or code or into a different computer language or code.

In relation to a database, ``adaptation´´ means an arrangement or altered version of the database or a translation of it.

``Adaptation´´ in relation to a musical work, means an arrangement or transcription of the work.

8. Secondary infringement of copyright

The law provides for a class of secondary infringements, the principal characteristic of which is that it is necessary to prove that the defendant has a degree of ``guilty knowledge´´ before he can be liable. The acts are termed secondary because they generally depend upon a primary act of infringement having first taken place.

There are three broad classes of secondary infringement: dealing with infringing copies, providing the means for making infringing copies and permitting or enabling infringing performances to take place.

A. Dealings in infringing copies

The copyright in a work is infringed by a person who, without the licence of the copyright owner:

(i) possesses in the course of a business,

(ii) sells or lets for hire, or offers or exposes for sale or hire,

(iii) in the course of a business exhibits in public or distributes, or

(iv) distributes otherwise than in the course of a business to such an extent as to affect prejudicially the owner of the copyright,

an article which is, and which he knows or has reason to believe is, an infringing copy of the work.

The copyright in a work is also infringed by a person who, without the licence of the copyright owner, imports into the country, otherwise than for his private and domestic use, an article which is, and which he knows or has reason to believe is, an infringing copy of the work.

These provisions are principally directed, not to manufacturers, but to third parties who deal in infringing articles supplied to them, and enable a copyright owner to limit the further dissemination of such copies. The need for a plaintiff to prove the element of ``guilty knowledge´´ reflects the fact that traders and others may handle infringing copies without necessarily suspecting or having the means of knowing that they are infringing. To an extent,

these secondary rights granted to copyright owners can be regarded as an aspect of the distribution rights although, of course, they only relate to infringing copies and not legitimate copies.

An article is an infringing copy if its making constituted an infringement of the copyright in the work in question. An article is also an infringing copy if:

(i) it has been or is proposed to be imported into the country, **and**

(ii) its making in the country would have constituted an infringement of the copyright in the work in question, or a breach of an exclusive licence agreement relating to that work.

Where in any proceedings the question arises whether an article is an infringing copy and it is shown that the article is a copy of the work, and that copyright subsists in the work or has subsisted at any time, it shall be presumed until the contrary is proved that the article was made at a time when copyright subsisted in the work.

B. Providing the means for making infringing copies

Copyright in a work is infringed by a person who, without the licence of the copyright owner:

(i) makes,

(ii) imports into the country,

(iii) possesses in the course of a business, or

(iv) sells or lets for hire, or offers or exposes for sale or hire,

an article specifically designed or adapted for making copies of that work, knowing or having reason to believe that it is to be used to make infringing copies.

The reference to an article `` specifically designed or adapted for making copies of that work´´ makes it clear that dealing in an article which is generally designed for making copies, such as a photocopier or tape recorder, will not fall within this provision. Rather, the provision is directed to dealings in articles such as photographic negatives, moulds, master recordings and the like which may be used to make copies of specific works.

The copyright in a work is also infringed by a person who without the licence of the copyright owner transmits the work by electronic means (otherwise than by communication to the public), knowing or having reason to believe that infringing copies of the work will be made by means of the reception of the transmission in the country or elsewhere. Thus, it is an infringement to fax / scan and email a work knowing that infringing copies will then be made at the receiving end.

C. Permitting or enabling public performance

(i) Permitting use of premises for infringing performance

Where the copyright in a literary, dramatic or musical work is infringed by a performance at a place of public entertainment, any person who gave permission for that place to be used for the performance is also liable for the infringement unless when he gave permission he believed on reasonable grounds that the performance would not infringe copyright.

For this purpose, ``place of public entertainment´´ includes premises which are occupied mainly for other purposes but are from time to time made available for hire for the purposes of public entertainment.

It should be noted that the giving of permission for use of the premises generally is not sufficient, since the permission must be for the premises to be used for the performance complained of.

(ii) Provision of apparatus for infringing performance, etc.

Where copyright in a work is infringed by a public performance of the work, or by the playing or showing of the work in public, by means of apparatus for playing sound recordings, showing films, or receiving visual images or sounds conveyed by electronic means, various persons are also liable for the infringement.

Firstly, a person who supplied the apparatus, or any substantial part of it, is liable for the infringement if when he supplied the apparatus or part he knew or had reason to believe that the apparatus was likely to be so used as to infringe copyright, or in the case of apparatus whose normal use involves a public performance, playing or showing, he did not believe on reasonable grounds that it would not be so used as to infringe copyright. Thus, for example - a person who supplied a TV for use in public, such as in a public house; or a person who supplied a juke box for use in public, or specialised equipment for use in a discotheque - knowing that no sufficient licence has been obtained, infringes the copyright.

Secondly, an occupier of premises who gave permission for the apparatus to be brought onto the premises is liable for the infringement if when he gave permission he knew or had reason to believe that the apparatus was likely to be so used as to infringe copyright. Again, this kind of case might arise where the occupier of a public house or discotheque allows equipment to be brought onto the premises knowing that no sufficient licence has been obtained.

Thirdly, a person who supplies a copy of a sound recording or film used to infringe copyright is liable for the infringement if when he supplied it he knew or had reason to believe that what he supplied, or a copy made directly or indirectly from it, was likely to be so used as to infringe copyright. Persons who knowingly supply records for use in jukeboxes are therefore likely to be caught by this provision.