

REVIEW OF LEGISLATION ON COPYRIGHT AND RELATED RIGHTS

Australia¹

The present document reproduces the introductory statement made by the delegation of Australia in the review of legislation on copyright and related rights at the Council's meeting of 22 to 25 July 1996², the questions put to it and the responses given.

I. INTRODUCTORY STATEMENT

Australia has submitted to the Council for TRIPS seven different sets of laws and regulations in accordance with Article 63.2 of the TRIPS Agreement. We did this on 5 April 1995. The overall structure of our implementing legislation in respect of copyright is reflected in the table of provisions of the Copyright Act of 1963, which has been circulated in document IP/N/1/AUS/1/Add.1. Briefly, the different areas covered by the Act are the preliminary section, which is essentially procedural, interpretation, copyright in original literary, dramatic, musical and artistic works, copyright in subject-matter other than works, remedies for infringements of copyright, copying of broadcasts by educational and other institutions, copying of works by educational and other institutions, the copyright tribunal, the crown, extension or restriction of the operation of the Act, false attribution of authorship and miscellaneous. Legislation or changes to regulations which have been made in order to bring our legislation and regulations in conformity with the TRIPS Agreement are contained in Addenda 6 and 5 and Supplement to Addendum 6.

II. REPLIES TO QUESTIONS POSED BY THE EUROPEAN COMMUNITIES AND THEIR MEMBER STATES

1. *Is Australian copyright legislation to be interpreted as conferring protection as "original works" to translations, adaptations and arrangements and other alterations of literary as well as artistic works (Article 9(1) of the TRIPS Agreement in conjunction with Article 2(3) of the Berne Convention)?*

Australia does protect adaptations of literary and artistic works and rights are conferred on the makers of such adaptations and arrangements, etc.

¹Australia's notification of laws and regulations in the area of copyright and related rights under Article 63.2 of the Agreement has been circulated in documents IP/N/1/AUS/1, IP/N/1/AUS/1/Add.1-7 and IP/N/1/AUS/1/Add.6/Suppl.1.

²The minutes of the meeting have been circulated in document IP/C/M/8.

This is so even though the language of the *Copyright Act 1968* (the Act) does not make this plain on its face. This is acknowledged and accepted in the textbooks on copyright in Australia. For example, in *The Law of Intellectual Property*, S. Ricketson (Law Book Co. 1984) it is stated (at p.108) that a translator may have copyright in a translation on the basis that the degree of skill and labour required to undertake the translation is sufficient to satisfy the requirement of originality. Ricketson also notes that it has always been held that an abridgment of another work may itself be an original work if there has been a sufficient application of knowledge, judgment, skill or labour so that the result is a new work in which the ideas and sense of the first work are preserved but within a smaller compass rendering it less expensive and more convenient both to the time and use of the reader.

This principle applies generally to arrangements and transcriptions. Thus it has been held that a piano arrangement of an opera is protectable as a musical work in its own right and there is similar case law regarding piano arrangements of unprotected material as well as protected orchestral scores.

2. *Has Australia implemented or does it intend to implement Section 185 of the Copyright Act 1968 so as to deny copyright protection to works the author of which is a national of a WTO Member on the grounds that another WTO Member does not provide adequate protection to Australian works (Article 9(1) of the TRIPS Agreement in conjunction with Article 3, Berne Convention, Article 3(1) TRIPS Agreement)?*

No regulations have been made under Section 185 in respect of a WTO Member country, nor does the Australian Government presently contemplate recommending the making of any such regulations.

3. *Does Australia grant protection to authors of cinematographic works where the makers of such works have their headquarters or habitual residence in a WTO Member country but are not incorporated under the law of a WTO Member country (Article 9(1) of the TRIPS Agreement in conjunction with Article 4(a) of the Berne Convention)?*

Regulation 4 of the *Copyright (International Protection) Regulations* (CIP Regulations) protects the works, films and sound recordings of corporations on the basis of incorporation in a WTO country. It is considered that this gives practical effect to the requirements of Article 4(a) of the Berne Convention.

By Section 89, copyright subsists in a cinematographic film if any one of three conditions applies:

- (a) if the maker of the film was *inter alia* an Australian national, resident, body corporate or protected person (see definition of qualified person in Section 84); or
- (b) if the film was made in Australia; or
- (c) if first publication took place in Australia.

By Regulation 4 of the CIP Regulations the above provisions apply as if the references to Australia were references to a WTO country.

Accordingly, the only circumstance not covered by the Australian provision would appear to be those of a film:

- that was made by a corporation that was not incorporated in a WTO country, but which nevertheless had its headquarters or habitual residence in a WTO country;
- that was made elsewhere than in a WTO Member country; and

- that was not first published in a WTO Member country;

and the corporation was the first owner of the copyright or otherwise acquired the rights from a non-WTO national or a corporation not incorporated in a WTO Member country. The likelihood of such circumstances is considered very remote.

[Follow-up question]

What happens if a company is not incorporated in Australia or another WTO Member but has its headquarters or principal place of business in Australia or another WTO Member?

By way of correction to the original answer, the reference to Section 89 should be replaced by a reference to Section 90. The further question does not seem to raise any circumstances that were not raised in the original question and, accordingly, seems to be covered by the terms of the original answer, subject to the correction just mentioned. If a particular example is contemplated by the further question, perhaps details could be supplied for our further consideration.

4. *Is Regulation 3 of the Copyright (International Protection) Regulations read together with Regulation 5 of the Regulations to be interpreted so that a country which is not a Member of the WTO, but with which Australia has entered into a bilateral copyright protection agreement, is to be considered the country of origin of a work, even if it implies that the copyright in the work will have a shorter term of protection than that provided for in Articles 5 and 7(8) of the Berne Convention (in conjunction with Article 9(1) of the Berne Convention)?*

Australia has bilateral copyright agreements with Singapore and Indonesia. Both are Members of the WTO and both are listed in Part III of Schedule 1 which lists the countries with which Australia has bilateral copyright agreements. Under the provisions found in Regulation 3 of the CIP Regulations, where there is a simultaneous publication in a country listed in Part III of Schedule 1 and another country, the country of origin of the work or film is deemed to be the country in Part III of Schedule 1.

Regulation 5 of the CIP Regulations applies the rule of the shorter term in relation to the term applicable in the country of origin.

The combination of these regulations does appear to raise at least the theoretical prospect of a shorter term applying to a work or film of a Berne or WTO Member country that was simultaneously first published in Singapore or Indonesia. Such a prospect is considered to be remote. Nevertheless, Australia appreciates the EC's drawing this matter to attention and will consider whether any remedial action is required.

5. *Is Australian legislation to be interpreted as conferring upon the authors of artistic works which incorporate literary works the exclusive right of making or authorizing the translation of their works (Article 9(1) of the TRIPS Agreement in conjunction with Article 8 of the Berne Convention)?*

Any unauthorized substantial use of a literary work incorporated in an artistic work would, of course, breach the right of adaptation of the literary work (Section 31(1)(a)(vi) and definition of adaptation in Section 10). Although the right of reproduction of an artistic work does not expressly include the right of translation, any substantial reproduction of an artistic work will infringe the copyright in that work (see Section 14). Similarly, any unauthorized reproduction or translation of a work or a substantial portion of a literary work incorporated in an artistic work will infringe the copyright in the literary work (Section 14). Whether there is a substantial reproduction of the artistic work, merely by the translation of certain writing included in and as part of an artistic work is not a matter that, to our knowledge, has yet come before the Australian courts.

6. *Does Australia protect literary, dramatic, musical or artistic works embodied in a film for at least 50 years after the death of the author, even if the copyright in the film concerned has expired before the end of this period (Article 9(1) of the TRIPS Agreement in conjunction with Article 14 of the Berne Convention)?*

Yes. However, there is a limited exception, which is considered justifiable under Article 13 of TRIPS, in the case of public exhibition of a film after the expiry of the copyright in the film (see Section 110(2)).

7. *Is Australian law to be interpreted as granting authors of artistic works the right to authorize the cinematographic adaptation of their works or the adaptation into any other artistic form of cinematographic productions derived from their original artistic work (Article 9(1) of the TRIPS Agreement in conjunction with Article 14 of the Berne Convention)?*

The provisions of Section 31 and the definition of adaptation Section 10(1) of the Act, which is exhaustive, does not purport to cover all possible adaptations to which Article 12 of the Berne Convention may apply. However, the scope of what constitutes "reproduction" and "copy" under the Act, coupled with Section 14(2), which provides in part that "reproduction ... or copy of a work shall be read as including a reference to a reproduction ... or copy of a substantial part of the work", is considered capable of covering adaptations contemplated by Article 12 that are not specifically provided in Section 31 or would fall outside the definition of "adaptation" in Section 10(1).

There will be infringement if another work bears a substantial similarity or resemblance to a substantial part of the artistic work even if it differs markedly in other respects. It has been held that features such as choice of light and colour, perspective or the balancing of features may represent a substantial feature of the original work.

8. *Is Australian legislation to be interpreted as providing for the protection of the right of authors of cinematographic works to authorize the adaptation of their works (Article 9(1) of the TRIPS Agreement in conjunction with Article 14bis of the Berne Convention)?*

Section 86 of the Act lists the rights in cinematographic films. That list of rights in cinematographic films does not expressly include a right to make an adaptation of a film.

Article 14bis(1) of the Berne Convention states *inter alia* that the owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in Article 14.

The definition of adaptation Section 10(1) of the Act, which is exhaustive, does not purport to cover all possible adaptations to which Article 12 of the Berne Convention may apply. However, the scope of what constitutes "reproduction" and "copy" under the Act, coupled with Section 14(2), which provides in part that "reproduction ... or copy of a work shall be read as including a reference to a reproduction ... or copy of a substantial part of the work", is considered capable of covering adaptations contemplated by Article 12 that are outside the definition of "adaptation" in Section 10(1). In relation to cinematographic films, Section 14(1) provides in part that "the reference to the doing of an act in relation to ... other subject-matter shall be read as including the doing of that act in relation to a substantial part of the ... other subject-matter".

The reproduction right under the Act would enable the producer of a film to take action against the unauthorized production of an edited version of the film or a substantial part of it, whether the editing consisted in omitting some parts, changing the sequence of the pictures, dubbing a new soundtrack or adding subtitles.

9. *Has the rental of cinematographic works in Australia led to widespread copying of such works which is materially impairing the exclusive right of reproduction of authors (Article 11 of the TRIPS Agreement)?*

To the knowledge of the Australian Government rental of cinematographic works has not led to widespread copying that is materially impairing the exclusive right of reproduction. Australia's reported rate of video piracy is understood to be generally regarded as low by international standards.

10. *Is Australian legislation to be interpreted as conferring protection to performances for a period of 50 years computed from the end of the calendar year in which the performance was given, also if that performance was given after the date of entry into force of the Copyright (World Trade Organization Amendment) Act (Article 14 of the TRIPS Agreement)?*

Yes. Section 248F provides that, except for Section 248QA (which provides for protection of past performances in relation to which see answer to US Question 4), Part XIA of the Act (dealing with the protection of performers) applies to an act done on or after the commencement of the Part in relation to a performance given on or after that commencement. Part XIA commenced on 1 October 1989.

Article 14 of TRIPS grants, in our view, rights to performers to prevent the unauthorized fixation of their performance in a sound recording and the unauthorized sound broadcast or sound communication to the public of their live performances.

Section 248CA(2) provides for a term of protection of 50 years after the calendar year in which the performance was given (the protection period), in relation to performances fixed in sound recordings, that were given prior to 1 July 1995 (the commencement of Part 4 of the *Copyright World Trade Organization Amendment*) Act (C (WTOA) Act).

Section 248CA(3) together with Section 248CA(4) apply a 50-year protection period in relation to sound recordings of a performance given since the commencement of Part XIA (i.e. since 1 October 1989).

Since a broadcast or cable communication to the public of a live performance is necessarily simultaneous with the live performance it was not necessary to prescribe a 50-year term applicable to the prohibition on that activity - the infringing conduct must be virtually simultaneous with the performance. To the extent that any term of protection is relevant to such live transmissions of performances it may be noted that by Section 248CA(1) a 20-year term is provided.

Rights are granted to WTO performers in the CIP Regulations consistent with the above view of Article 14 of TRIPS for details of which see the answer to Question 1 of the United States of America.

III. REPLIES TO QUESTIONS POSED BY SWITZERLAND

1. *Please explain how collecting societies have organized the distribution of royalties to foreign authors.*

For comprehensive information on collecting societies in Australia the Swiss Federation is referred to the whole text of "The Simpson Report"; a report to the Australian Government on Copyright Collecting Societies delivered in September 1994. The report is available at: <http://www.dca.gov.au/simpson1.htm> on the World Wide Web.

The accompanying extract from the report responds to the question as well as providing some additional background material on Australian Collecting Societies.

2. *Part VC of the Copyright Act was repealed. Please explain how the collection of royalties on blank tapes is dealt with after the decision "Australian Manufacturers Association Ltd. v. Commonwealth of Australia" of 1993?*

No royalties of any nature are being levied on blank tapes.

IV. REPLIES TO QUESTIONS POSED BY THE UNITED STATES

1. *Please explain whether and how Australian law provides protection for works, phonograms and performances from other WTO Members and whether and how it does so on the basis of national treatment as required by TRIPS Article 3 (generally with respect to all copyright and neighbouring rights) and Article 9.1 (incorporating Berne Article 5(1)).*

Rights are granted to nationals of WTO countries under the Australian copyright legislation to the extent of the obligations in Articles 3 and 9 of the TRIPS Agreement.

The *Copyright Act 1968* (the Act) operates to grant rights directly where there is a connection with Australia (through nationality, residence, publication or place of performance or broadcast - see Sections 32, 89, 90, 91 and 92).

Part VIII of the Act provides for the application of the Act to foreign nationals and residents and in relation to publication, performance or broadcasts made in foreign countries. It does this by providing (in Sections 184 and 185) (except in relation to performers, provision for which is in Part XIA) for regulations to be made applying the Act, in full or in part, to foreign nationals, etc. where the countries concerned are members of a treaty to which Australia is also a member or where there is, or expected shortly to be, broadly reciprocal protection of Australian protected works, etc.

Regulations made pursuant to that power, the *Copyright (International Protection) Regulations* (the CIP Regulations), were amended twice in 1995 to extend protection in relation to WTO Member countries.

The basic regulation for works, sound recordings and cinematographic films (this includes videos) is Regulation 4. It extends protection under the Act to works, sound recordings and films of residents, nationals and corporations of countries named in the relevant Parts of Schedule 1 and, as relevant, to publication in any of those countries. Following amendments to the CIP Regulations in April 1995 (Statutory Rule No. 67 of 1995) Regulation 4 now refers to countries listed in Parts I, II, III, IV and V of Schedule 1.

Countries listed in Part I of Schedule 1 are Member countries of the Berne Convention. Countries in Part II are countries that are Members of the Universal Copyright Convention but not the Berne Convention. Countries in Part III are countries that have concluded a bilateral copyright agreement with Australia. Countries in Part IV are Members of the Rome Convention. Countries in Part V are Members of the World Trade Organization. The CIP Regulations were amended in December 1995 to update the lists in the various Parts of Schedule 1. This updating is carried out periodically. Regulation 4 provides no limitation on national treatment but there are some limits in other regulations (as to which see below).

Similar provisions to those in Sections 184 and 185 of the Act in relation to works, films and sound recordings are found in Section 248U and Section 248V of the Act in relation to performances.

By Regulation 4A of the CIP Regulations, all of the rights granted by the Act to performers are extended to foreign performers having a relevant connection with a country that is a member of the Rome Convention. By Regulation 4B, foreign performers having a relevant connection with a WTO Member country are granted the rights provided in the Act in relation to:

- (a) sound recordings;
- (b) sound broadcasts of live performances; and
- (c) sound transmissions of live performances to subscribers to diffusion services.

Limitations on national treatment

Rule of the Shorter Term

Pursuant to Article 7(8) of the Berne Convention, Regulation 5 of the CIP Regulations provides that the term of protection applicable to works and films does not exceed the term applied in the country of origin.

Limitation on rights of sound recordings owners in relation to the public performance and broadcast of sound recordings

Australia has entered a reservation in respect of Article 12 of the Rome Convention. Regulations 6 and 7 of the CIP Regulations limit the public performance and broadcast right in sound recordings to recordings with a relevant connection with countries listed in Schedule 3. Countries in this Schedule include all Rome Convention countries that have not made a reservation in respect of Article 12 of the Convention and other countries considered to grant adequate rights over broadcasting and public performance of sound recordings.

The TRIPS Agreement does not require the grant of such rights and Article 3 provides *inter alia* that "In respect of performers, producers of phonograms and broadcasting organizations, this obligation only applies in respect of the rights under this Agreement".

[Follow-up question]

The answer states that there are some limitations on national treatment under Australian law, and describes two such limitations. Does Australian law contain any limitations on national treatment for any of the rights required to be granted by the TRIPS Agreement other than these two?

The information contained in the original answer is supplemented by reference to regulation 10 which limits the range of works and other subject matter originating in countries that are members of the Universal Copyright Convention (UCC) but not the Berne Convention to those materials first published after they joined the UCC.

2. *Does Australia apply the rule of the shorter term to phonograms and performances from other WTO Members? If so, please explain how you justify such action under TRIPS Article 4.*

Australia does not apply a rule of the shorter term in respect of phonograms or performances. Australia reserves its position on whether it may do so in the future.

TRIPS Article 4 provides *inter alia* that:

"Exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member:

- (a) ...;
- (b) granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authority that the treatment accorded be a function not of national treatment but of treatment accorded in another country;
- (c) in respect of the rights of performers, producers of phonograms and broadcasting organizations not provided under this Agreement."

Australia is of the view that these provisions in Article 4 are directed towards these provisions in pre-existing conventions permitting a departure from national treatment.

3. *Please explain whether and how Australia protects against direct and indirect reproduction of phonograms as required by TRIPS Article 14.2, including by digital transmission in the context of subscription or interactive services.*

The Act expressly makes direct or indirect reproduction of phonograms an infringement of copyright in the sound recording.

Indirect reproduction extends to copies made from a free-to-air broadcast and made from a pay cable TV program or a computer bulletin board or by accessing subscription or interactive services. The person responsible for the unauthorized reproduction is liable for infringement.

The right to make a copy of a sound recording is included as one of the exclusive rights of owners of copyright in sound recordings under Section 85 of the Australian Act.

Section 10(3)(c) of the Act (the main definitions and interpretation provision in the Act) provides that "a reference to a copy of a sound recording shall be read as a reference to a record embodying a sound recording or a substantial part of a sound recording being a record derived **directly or indirectly** from a record produced upon the making of a sound recording" (emphasis added).

"[R]ecord" is defined in Section 10(1) to mean a "disc, tape, paper or other device in which sounds are embodied".

"[S]ound recording" is defined in Section 10(1) to mean "the aggregate of sounds embodied in a record".

Section 13(2) provides, *inter alia*, that the exclusive right granted under the Act is to be read as including a right to authorise a person to do whatever is included within the right.

A person who makes an unauthorized copy is liable for infringement (Section 101). Additionally, any person or body that sanctions, approves or countenances an infringing act in Australia will also be liable as having authorized the infringement (also Section 101). This may include the giving of permission or the extending of an invitation to do the act in question. Such permission or invitation may be express or implied from the circumstances (*University of NSW v Moorehouse* (1975) 133 CLR 1 per Justice Jacobs at p.20).

The question of authorization depends in each instance on a careful examination of the facts. Thus it is not possible to say in general that a person responsible for making sound recordings available for downloading or transmission will be liable for authorizing infringement by reproduction.

4. *Please explain whether and how Australia provides full retroactive protection to works, phonograms and performances from other WTO Members, as required by TRIPS Articles 9.1, 14.6 and 70.2, each of which incorporate by reference or rely upon Berne Article 18. Please give the date back to which such protection extends in respect to each category of subject matter.*

Subject to non-revival of expired copyright (Section 210) and other transitional aspects, Section 207 of the Act provides that the Act applies in relation to things in existence before the commencement of the Act (on 1 May 1969) in like manner as it applies to things coming into existence after the commencement of the Act.

The duration of term of the various protected subject matter is set out in the following table.

Section	Subject Matter	Period
Section 33(2)	Literary, dramatic, musical or artistic works (other than photographs)	50 years pma
Section 33(3)	Literary, dramatic or musical works which are unpublished, have not been broadcast or performed in public and records of which have not been offered for sale to the public at the time of the author's death	50 years after the year of the first of these events to occur; otherwise indefinite (publication of an authorized adaptation is treated as publication of the original work, etc.)
Section 33(5)	Engravings which are unpublished at the time of the author's death	50 years after the year of first publication; otherwise indefinite
Section 33(6)	photographs	50 years after the year of first publication; otherwise indefinite
Section 212	photographs taken before 1 May 1996	50 years after the expiration of the calendar year in which the photograph was taken
Section 93	Sound recordings	50 years after the year of first publication; indefinite if unpublished
Section 220(3)(b)	Sound recordings made before 1 May 1969	50 years after the year in which made
Section 94	Cinematographic films	50 years after year of first publication; otherwise indefinite
Section 95	Television and sound broadcasts	50 years after year in which broadcast was made

Section 80	Works of joint authorship	as in Section 33 except that the references to the author are to be read as references to the author who died last
Section 34	Anonymous and pseudonymous works 50 years after year of first publication	

As regards extension to WTO Members - see answer to Question 1.

In respect of performers, retroactive protection against making and commercially dealing with unauthorized sound recordings is dealt with in Section 248QA. In Section 248QA(1) the section is expressed to apply to an act done in Australia on or after the commencement of Part 4 of the Copyright

(Copyright (WTOA) Act) in relation to a performance given at any time before that date. Part 4 of the Copyright (WTOA) Act commenced on 1 July 1995.

Various prohibitions are listed in Section 248QA. These are:

- to have during the protection period possession of a plate or recording equipment that a person "knows or ought reasonable to know is to be used for making a copy of an unauthorized sound recording of the performance" (i.e., a bootleg recording);
- during the protection period to knowingly make a copy of the unauthorized recording; and
- during the protection period, in summary, to commercially deal with an unauthorized recording (including importation for a commercial purpose).

The protection period is defined, pursuant to Article 14(5) of TRIPS, in Section 248CA(2) as 50 years from the calendar year in which the performance was given.

Penalties for breach of Section 248QA are set out in Sections 248R(3A) and (3B).

Prospective protection is granted in the Act (Section 248F) for performances given after the commencement of Part XIA of the Act.

Protection is extended to WTO nationals and to performances in WTO countries via the mechanism described in answer to Question 1. Protection applies against acts constituting unauthorized uses of performances undertaken on or after 1 July 1995 and earlier in some cases.

[Follow-up question]

The answer states that the Australian Copyright Act applies in relation to things in existence before the commencement of the Act in like manner as it applies to things coming into existence after the commencement of the Act, but qualifies this statement as being "subject to non-revival of expired copyright and other transitional aspects". Please explain the meaning of these qualifications. In particular, what pre-existing works are not protected, and what is the content of the transitional rules referred to?

Sections 208-242 of the Copyright Act make particular provision regarding the application of the Act to works and other subject matter predating the commencement of the Act, and Sections 243-248 make particular provision regarding works made before 1 July 1912. These particular provisions deal with such matters as the nationality of the author, duration of some works, initial ownership of copyright and variation of the terms of exceptions to exclusive rights in Parts III and IV of the Act and the remedies for infringement provided for in the Act.

Section 210 provides that, notwithstanding anything in Part III, copyright does not subsist by virtue of Part III in a work first published before the commencement of the Act unless it subsisted under the 1911 Act immediately before that commencement. Special provision is made for pre-1911 works.

5. *Please explain whether and how Australian law protects compilations of data or other materials including compilations of sounds, images and audio-visual works that comprise "multimedia works" as required by TRIPS - Article 10.2.*

Article 10(2) of TRIPS reads:

"Compilations of data or other material whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself."

So far as compilations are concerned, the Act provides, in Section 10, that literary work includes:

- (a) a table or compilation expressed in words, figures or symbols (whether or not in a visible form); and
- (b) a computer program or compilation of computer programs.

This is supported by extensive case law even prior to the insertion of the relevant definition involving, for example, births and deaths columns in newspapers and a list of figures used in a "bingo" newspaper game. A contemporaneous example is offered by a recent newspaper report. On 24 June 1996, it was reported that industry analyst Gartner Group Pacific paid \$30,000 plus legal costs to another company in compensation for the unauthorized use by Gartner of the other firm's database obtained by Gartner from a customer of the other firm.

The Act currently extends protection to all forms of original works stored in computer memory. (See Section 22 and definition of "material form" in Section 10(1).)

In so far as a multimedia production consists of moving pictures and accompanying recorded sounds, it seems to come within the definition of a cinematographic film where it is defined as:

"... the aggregate of the visual images embodied in an article or thing so as to be capable by the use of the article or thing:

- (a) of being shown as a moving picture; or
- (b) of being embodied in another article or thing by the use of which it can be shown;

and includes the aggregate of sounds embodied in a sound tract associated with such visual images."

In its 1995 Report on *Computer Software Protection*, the Copyright Law Review Committee (CLRC) commented (at paragraph 14.84):

"It does not seem to the Committee that the inclusion of text and still images in a multimedia production serves to deprive it of protection, as a cinematographic film, any more than does the inclusion of credits or other narrative, text or still images sometimes seen in movies."

6. *Please indicate whether the definition of "Adaptation" in Section 10 of the Australian Copyright statute covers all types of adaptation, as required by Berne Article 12, or just those that are specifically listed.*

The definition of adaptation Section 10(1) of the Act, which is exhaustive, does not purport to cover all possible adaptations to which Article 12 of the Berne Convention may apply. However, the scope of what constitutes "reproduction" and "copy" under the Act, coupled with Section 14(2), which provides in part that "reproduction ... or copy of a work shall be read as including a reference to a reproduction ... or copy of a substantial part of the work", is considered capable of covering adaptations contemplated by Article 12 that are outside the definition of "adaptation" in Section 10(1). In relation to cinematographic films, Section 14(1) provides in part that "the reference to the doing of an act in relation to ... other subject-matter shall be read as including the doing of that act in relation to a substantial part of the ... other subject-matter". In relation to artistic works, reference is made to Section 21(3) which deems reproduction to include three-dimensional versions of two-dimensional works and vice versa.

7. *Please explain how the scope of protection granted to cinematographic works under Section 86 of the Australian Copyright Statute is consistent with Berne Article 2(1) and 14bis, as incorporated through TRIPS Article 9.1, given that the scope of rights such works enjoy does not appear to be coextensive with the rights in literary and artistic works generally. For example, there does not appear to be an adaptation right provided.*

Section 31 of the Act provides that unless a contrary intention appears copyright in relation to a literary, dramatic or musical work is the right to:

- reproduce the work in a material form;
- publish the work;
- perform the work;
- broadcast the work;
- cause the work to be transmitted to subscribers to a diffusion service;
- make an adaptation of the work;
- to reproduce, publish, perform, broadcast or cause an adaptation to be transmitted to subscribers to a diffusion service.

Section 86 of the Act lists the rights in cinematographic films. That list of rights in cinematographic films does not expressly include a right to publish a film or a right to make an adaptation of a film.

Article 14*bis*(1) of the Berne Convention states *inter alia* that the owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in Article 14.

Although the words "shall enjoy the same rights as the author of the original work" are stated without qualification, it has been the view in Australia that the rights referred to may only be the rights required by the Convention to be conferred on authors of original works. As the rights so required by the Convention do not include a right of publication, Australia does not regard itself as bound to provide such a right to owners of copyright in cinematographic films.

As to a right of adaptation, see also the answer to Question 6. The reproduction right under the Act would enable the maker of a film to take action against the unauthorized production of an edited version of the film or a substantial part of it, whether the editing consisted in omitting some parts, changing the sequence of the pictures, dubbing a new soundtrack or adding subtitles.

8. *Please explain how the exceptions provided in Sections 40(3), 45, 46, 89(3), 106, 110 and 199 of the Australian Copyright statute comply with Berne Article 9(2) and TRIPS Article 13, which require limitations and exceptions to exclusive rights to be limited to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the rightholder.*

Section 40(3)

Section 40(3) of the Act provides that the copying of an article in a periodical publication or, in any other case, not more than a reasonable portion, for the purposes of research or study is to be taken to be a fair dealing that does not constitute an infringement of copyright.

Subsection 40(4) provides that only if no more than 1 article in the periodical publication is copied can the copying permitted by Section 40(3) be treated as a fair dealing.

In Australia, reasonably clear and strict provisions apply in regard to exceptions to exclusive rights. By and large clear guidance is thus provided to the courts as to what will constitute an exception to the exclusive right of reproduction.

Subsections 40(3) and 40(4) are the application by the legislature of a view about what complies with permitted exceptions under Berne. It is to be noted that the exception is limited to copying for research or study (a "special case") and not for general amusement or information, is directed to limited copying (only 1 article per periodical or a reasonable portion of other works) and, unlike, for example unremunerated commercial copying of extracts, is limited to individual use. (See *De Garis & Ano v Neville Jeffress* (1990) AIPC 90-678.)

What constitutes a "reasonable proportion" is partly defined in Section 10(2) which provides, *inter alia*, that it will be a "reasonable proportion to copy no more than 10% of the pages in the edition being copied or no more than 1 chapter of a work divided into chapters".

These restrictions ensure that the use comes within the terms of Article 9(2) of the Berne Convention and Article 13 of TRIPS:

- the use is a special case;
- the use is restricted to limited copying - not the whole work; and
- the use does not, therefore, unreasonably interfere with a normal exploitation of the work.

Section 45

Section 45 exempts from infringement reading or recitation in public or the inclusion in a broadcast of a reading or recitation of an "extract of reasonable length" of a published literary or dramatic work, "if a sufficient acknowledgement of the work is made".

The provision is considered to be permitted by Berne Article 10(1), and that Article 9(2) is not applicable because reproduction is not being dealt with by Section 45. As reading or recitation of an extract of reasonable length would not nowadays be considered to conflict with the normal exploitation of a published literary or dramatic work, the provision is considered to be compatible with TRIPS Article 13. It seems significant that the Australian Government has no recollection of representations from authors or publishers' representative organizations expressing concern at Section 45. This suggests to the Government that Section 45 is little relied on or, if it is relied on, it is not seen by authors or publishers as prejudicial to their interests.

Section 46

This provision provides an exception to infringement by performance "in public" of literary dramatic or musical works, or adaptations of them by the use of wireless telegraphy apparatus (i.e., radio or TV broadcasts) or the use of a record at premises where persons reside or sleep. The exception extends to performances where guests of the inmates of these establishments are present.

By the terms of Section 27 a public performance extends to any mode of visual or aural presentation including by the operation of a radio or television receiver by which the works are seen or heard. The owner of the premises who has consented to such use is deemed to be the person causing the performance to have been given. Thus, for example, because Section 46 is confined to performances "exclusively for residents or inmates of the premises" and their guests, it is an infringement where works are performed by playing a television or radio set in a public bar.

It may be doubted that performances for residents or inmates is a performance "in public" in terms of the convention or treaty meaning. Clearly, it is not a performance "in public" for the members of a family and their friends to view a television or listen together, to a radio broadcast.

That is, the provisions of Section 46 could be considered to make an offsetting correction to the over-protection that would otherwise result from the deeming provision in Section 27 that would otherwise fix liability for use broadly analogous to an individual or family use merely because that use was in a premises and the receiver used was supplied by or with the consent of the owner.

Under the Australian law as it currently stands, the relevant collecting society in Australia, the Australasian Performing Right Association, is able to operate effectively to collect performing right fees from a very wide variety of establishments, including hotels, bars and other places of public access, where public performances occur. The circumstances described in Section 46 are limited to a special category of cases so that, by reason of its narrow compass, the section does not result in conflict with a normal exploitation of the works used and does not unreasonably prejudice the rightholders' interests.

Section 89(3)

This subsection provides that, in addition to Australian nationality or residence of the maker of a sound recording or Australia being the place of making of a recording, a criterion for extending copyright protection to a sound recording is first publication in Australia. The subsection is thus not an exception to exclusive rights.

Section 106

This subsection provides for an exception to the right to cause a sound recording to be heard in public, being one of the rights conferred by the Act on owners of copyright in sound recordings. Sound recordings are not protected by the Berne Convention. The right to cause a sound recording to be heard in public is not one of the exclusive rights required by TRIPS to be conferred on owners of copyright in the recordings, and it is considered that Article 13 would have no application.

Section 110

This section makes particular provision relating to old cinematographic films. Subsection 110(1) effectively provides for the expiry of the public exhibition right in a film of items of news at the end of 50 years after the events filmed. This deeming applies only for the purposes of causing the film to be seen or heard, not for reproduction, broadcasting or transmission via a cable diffusion service. To the extent that this can be said to be an exception to rights, it satisfies the criterion of being a special case that does not unreasonably interfere with the legitimate interests of the rightholder because of the very specific limits on the exception.

Subsection 110(2) applies a similar exemption to that in Section 110(1) as regards any underlying works in old films in which the copyright has expired. It makes an exception to the performance right in those works in the case of public showing of the films after they have fallen into the public domain. This is clearly a very limited derogation from the total range of possible ways of performing the works concerned, and is considered not to conflict with a normal exploitation of the works or unreasonably interfere with the legitimate interests of the copyright owners.

Subsection 110(3) clarifies that the use of a record which embodies the sounds used in a film soundtrack, but is not derived from the soundtrack, does not infringe copyright in the film. This merely clarifies the law and the question of the application of Article 13 of TRIPS does not arise.

Section 199

Subsection 199(1) is a counterpart provision to Section 45 regarding broadcasts of readings or recitations of literary works. It provides an exemption from infringement in the case of any public performance resulting from the reception of the broadcast. Because it is limited to circumstances where the inclusion of the reading or recitation is not an infringement, it can be seen as largely coextensive with Section 45 and compatible with Berne and TRIPS for the reasons given in the answer on Section 45.

Subsection 199(2) is considered to be not governed by Berne or TRIPS for the reasons given in the answer on Section 106

Subsection 199(3) provides that where a person plays a television set in public, the person is to be treated as if he or she had a licence from the film copyright owner for that public performance of the film. The playing of television sets in public is not considered a substantial exercise of the right to cause films used in TV broadcasts to be seen or heard in public.

Subsection 199(4) deals with retransmission by wire of a broadcast. Because prior to 1995 no substantial commercial cable transmission services were in operation, the subsection had no substantial practical application. Following the licensing and commencement of major commercial services, the Government is actively reviewing the appropriateness of Section 199(4).

Subsections 199(5) to (7) amplify or qualify the operation of Section 199(1) to (4).

[Follow-up questions]

Section 40(3): The answer states that the exception to rights provided in Section 40(3) of the Australian Copyright Act, allowing certain copying for purposes of research or study, comes within the terms of permissible limitations on rights under Berne and TRIPS. Please explain whether the exception applies when the research or study is engaged in for commercial purposes or by a commercial entity, or when the copying substitutes for a purchase of the book or a subscription to the journal from which the copying is done.

Section 40 of the Act provides:

40(1) A fair dealing with a literary, dramatic, musical or artistic work, or with an adaptation of a literary, dramatic or musical work, for the purpose of research or study does not constitute an infringement of the copyright in the work.

40(1A) A fair dealing with a literary work (other than lecture notes) does not constitute an infringement of the copyright in the work if it is for the purpose of, or associated with, an approved course of study or research by an enrolled external student of an educational institution.

40(1B) In subsection (1A) the expression "lecture notes" means any literary work produced for the purpose of the course of study or research by a person lecturing or teaching in or in connection with the course of study or research.

40(2) For the purposes of this Act, the matters to which regard shall be had, in determining whether a dealing with a literary, dramatic, musical or artistic work or with an adaptation of a literary, dramatic or musical work, being a dealing by way of copying the whole or a part of the work or adaptation, constitutes a fair dealing with the work or adaptation for the purpose of research or study include:

- (a) the purpose and character of the dealing;
- (b) the nature of the work or adaptation;
- (c) the possibility of obtaining the work or adaptation within a reasonable time at an ordinary commercial price;
- (d) the effect of the dealing upon the potential market for, or value of, the work or adaptation; and
- (e) in a case where part only of the work or adaptation is copied - the amount and substantiality of the part copied taken in relation to the whole work or adaptation.

40(3) Notwithstanding subsection (2), a dealing with a literary, dramatic or musical work, or with an adaptation of such a work, being a dealing by way of the copying, for purposes of research or study:

- (a) if the work or adaptation comprises an article in a periodical publication - of the whole or a part of that work or adaptation; or

(b) in any other case - of not more than a reasonable portion of the work or adaptation; shall be taken to be a fair dealing with that work or adaptation for the purpose of research or study.

40(4) Subsection (3) does not apply to a dealing by way of the copying of the whole or a part of an article in a periodical publication if another article in that publication, being an article dealing with a different subject matter, is also copied.

The interpretation of the provision was considered by Mr. Denis Rose QC, then Chief General Counsel of the Attorney-General's Department in an opinion provided to the Copyright Law Review Committee in the context of its report on computer software. Mr. Rose concluded that it was:

"likely that the courts would hold that 'study' is confined to study by individuals for their own purposes, whether in private, or in some institutional course or otherwise. Moreover, the courts could confine 'research' to research activities such as those in universities and the CSIRO, for the purpose of increasing knowledge in the community as a whole - by contrast for instance, with research in a Government Department for the purpose of advising Ministers on proposed legislation, or research by a manufacturing company for the purpose of improving its products."

Such a view would be consistent with other aspects of the legislation which require, for example, educational institutions to pay for the reproduction of works for use by students for their studies.

Section 46: The answer states that the exception to rights provided in Section 46 of the Australian Copyright Act, allowing certain public performances at premises where persons reside or sleep, "does not result in conflict with a normal exploitation of the works used and does not unreasonably prejudice the rightholders' interests" (as required by TRIPS Article 13). Please explain whether this Section allows performances at commercial establishments, including hotels and other lodging places, and apartment buildings.

It has not been possible to identify any judicial decisions interpreting the expression "premises where persons reside or sleep", as used in Section 46 which, it is emphasized, limits the exception to public performance on such premises to the operation of a radio or TV receiver or record player "as part of the amenities provided **exclusively for residents or inmates of the premises** or for those residents or inmates and their guests".

9. *Please explain the criminal and civil remedies available for copyright infringement and the extent to which they fully implement the obligations in TRIPS Articles 41, 45, 50 and 61. In the response please specify, inter alia whether these remedies may include seizure, forfeiture and destruction of infringing articles and equipment used to make the infringing articles, as required by Articles 46 and 61, and the manner in which the grant of civil provisional relief is provided in accordance with TRIPS Article 50.*

Criminal and civil remedies are available under Sections 115, 116, 133, 133A, 248J, 248Q, 248QA, 248R and 248T. These provisions permit actions for damages, injunctions, account of profits and conversion or detention of infringing copies. Under the provisions for non-criminal enforcement, delivery up of the infringing items may be ordered. Under the criminal provisions delivery up and destruction may be ordered.

Interim relief including interim injunctions are available according to well-established court and common law rules. Additionally, the Australian courts have recognized the right of plaintiffs to Anton Piller Orders and to Mareva Injunctions in appropriate cases.

[Follow-up question]

Do the remedies provided by Australian copyright law include the forfeiture and destruction of equipment used to make infringing copies, in both the civil and criminal contexts?

Yes. In the case of civil infringement proceedings, Section 116(1) provides:

"Subject to this Act, the owner of the copyright in a work or other subject matter is entitled in respect of any infringing copy, or of any plate used or intended to be used for making infringing copies, to the rights and remedies, by way of an action for conversion or detention, to which he or she would be entitled if he or she were the owner of the copy or plate and had been the owner of the copy or plate since the time when it was made."

In the case of proceedings for criminal infringement, Section 133(4) provides:

"The court before which a person is charged by reason of a contravention of Section 132 may, whether the person is convicted of the offence or not, order that any article in the possession of the person that appears to the court to be an infringing copy, or to be a plate or recording equipment used or intended to be used for making infringing copies, be destroyed or delivered up to the owner of the copyright concerned or otherwise be dealt with in such manner as the court sees fit."