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Landmarks in Australian Intellectual Property Law

Edited by Andrew T Kenyon, Megan Richardson and Sam Ricketson

This authoritative text provides a picture of how Australian intellectual property law has developed as a distinctly Australian body of law during the century since Federation. The book takes a selection of key intellectual property law cases and tells their stories, situating each case in its social context, as well as providing factual details about the arguments made in each case and the evidence adduced. *Landmarks in Australian Intellectual Property Law* offers a closer legal analysis of selected cases, many of which have been central to the framing of Australian intellectual property law. It provides a fuller sense of each case as revealing and influencing wider understandings and practices.

Landmarks in Australian Intellectual Property Law is a valuable resource for academics, researchers, practitioners and judges in Australia and throughout the common law world.

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collection (with Andrew Kenyon), *New Dimensions in Privacy Law: International and Comparative Perspectives* (Cambridge University Press, 2006).

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Situating intellectual property law: introducing landmark Australian cases

Andrew T Kenyon, Megan Richardson and Sam Ricketson

That law and social conditions are inexorably intertwined is shown by the fact that the first inventions granted patents in Australia, under the then state Acts, included a windlass, an improved method of manufacturing charcoal, improvements in the construction of timber and iron bridges, and improvements in the manufacture of pipes.[1] Nor is it surprising that the Australian colonies would be among the first in the world to introduce modern-style patent, designs, trade marks and copyright regimes, and also among the first to use them. As Barton Hack notes, the second half of the 19th century was a period of great development in Australia, especially in Victoria and especially during the long boom years of the 1870s and 1880s:

> The stump-jump plough was invented by RB Smith in 1876, the commercial shearing machine by Savage and Wolseley in 1877, telephone exchanges were opened in Melbourne and Brisbane in 1880 and in Sydney in 1881, superphosphate was available by the eighties, the Melbourne International Exhibition was held in its new building in 1880–1881, Melbourne and Sydney were finally linked by rail in 1883, HV McKay demonstrated his combine harvester in 1884, Melbourne's first cable tram ran in 1885, a state system of education was established in NSW in 1883, the Working Man's College (later the RMIT) was inaugurated in 1887 (Sydney University had opened in 1852 and Melbourne University in 1855), the Broken Hill lode was discovered in 1883 and mining commenced in 1885, and between 1871 and 1891 the population of Sydney increased from 137 586 to 383 333 and that of Melbourne from 206 780 to 490 896. The rapid industrialization was of course achieved at a social cost, but the changes caused by technological advancement could not be reversed.[2]

Even at this early stage, however, the influence of imported legal models was evident with both state legislation and case law following closely the precedents of the 'mother country'. In part, the influence may be attributed to the effects of

1 South Australian Private Act No. 1 of 1848; South Australian Private Act No. 2 of 1850; Victorian Patent No. 1, 1854; Queensland Patent No. 1, 1860. See also B Hack, 'A History of the Patent Profession in Colonial Australia', paper presented at the Annual Conference of The Institute of Patent Attorneys of Australia, Brisbane, Queensland, 29–31 March 1984; and Victorian patent indexes, 1854 to 1904, held at the State Library of Victoria.
2 Hack, ibid., pp. 47–8.

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British colonialism in the Australian states, as one of us has pointed out in another context.[3] But it may also have been a response to the tension universally found within intellectual property law between the particular territorial concerns of sovereign states and the essentially non-territorially confined character of the subject-matter – whose physical boundaries, if any can be ascertained, may vary over time and are certainly not dictated by considerations of where state borders start and finish. The response was found in a high level of symmetry in state-based legal standards, followed by an eventual move to a supra-state level, once Australian federalism made Commonwealth legislation on intellectual property a feasible option. Now, the tension has been transferred to the international arena, and we can again observe the symmetry of national law standards and foresee the possibility of fully internationalised standards as well. But a question that remains is how much such harmonised and internationalised intellectual property standards can take into account the exigencies of social circumstances, which may vary according to time and place. As shown by the cases discussed in this volume, the answer is a surprising amount when it comes down to actual issues being debated in courts. And this becomes particularly apparent when the story of the case is told and integrated with the legal analysis, our chosen methodology. Or, as Matthew Rimmer puts it in his chapter, the *petite histoire* is a useful way of understanding this reality.

The case studies are placed in chronological order from earliest to latest in time, not simply as a matter of convenience. If anything, we suggest, Australian courts have over years become more openly socially aware in their decisions, exploring opportunities for solutions to be found to problems that are not merely legal within the scope allowed by the statute or precedent in the case of equitable and common law actions. That trend, of course, also influences the ways in which chapters engage in their storytelling, with greater opportunity to broaden doctrinal analysis into contextual understanding for decisions from more recent decades. Already, in the late 1950s, we see the High Court referring in *NRDC v Commissioner of Patents* to the

> remarkable advantage, indeed to the lay mind a sensational advantage [of the applicant's invention for a process of applying weedkiller to crops] ... [lying in] the cultivation of the soil for the production of its fruits' as crucial to answering the essential question of whether the claimed invention was 'a proper subject of letters patent'.[4]

Stephen Hubicki and Brad Sherman note that the language demonstrates 'the widespread cultural appeal that technological control over nature has exerted in the modern era', especially since World War II. Sixteen years later, as Sam Ricketson and David Catterns observe, the High Court's extension of authorisation in copyright law to the provision of photocopiers in a university library in

3 See S Ricketson, 'The Future of Australian Intellectual Property Law Reform and Administration' (1992) 3 *Australian Intellectual Property Journal* 3, 9–11 (the context there being a discussion of British influences on post-federation Commonwealth legislation).
4 *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252, 277; 1A IPR 63, 75.

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University of New South Wales v Moorhouse[5] represented an imaginative but logical response to the culture then prevalent within Australian universities of treating copyright as irrelevant to educational concerns. Australia's highest courts may have eschewed social referencing in *Cadbury Schweppes v Pub Squash*[6] and *Firmagroup v B & D Doors*[7] in the 1980s (and although the *Pub Squash* case may be put aside as a Privy Council decision, Mark Davison questions whether the High Court would have taken a markedly different approach), but by then the lower courts were taking on a more significant role. The Aboriginal folklore and art cases of *Foster v Mountford & Rigby*[8] and *Bulun Bulun v R & T Textiles*[9] show modern Australian courts seeking to accommodate traditional cultural values in their decisions. References to the values and customs of modern society can be found in judicial comments about the audience's response to the *Crocodile Dundee* film and character in the case of *Pacific Dunlop v Hogan*.[10] And, according to Elizabeth Adeney, the Full Federal Court's refusal to find that a popular techno dance version debased Carl Orff's *O Fortuna* chorus in *Schott Musik v Colossal Records*[11] displays an Australian unwillingness to make negative value judgments about (derivative) creativity – although she adds that this may have to change in an era of Berne Convention compliance on moral rights.

There are cases still where judges appear unable to find a satisfactory solution to a matter of social concern within the established parameters of the law (as in *Lomas v Winton Shire Council*[12] and its 'Waltzing Matilda' trade mark registrations), or they fail to find a consensus on how social policies might be accommodated within legal standards (as with the different judgments on fair dealing for criticism or review and news reporting in the *Panel* case, *TCN Channel Nine v Network Ten*[13]), or resolve only the narrow 'legal' issue before them while leaving broader ones open (as in the Coonawarra wine label case, *Beringer Blass v Geographical Indications Committee*[14]). But they seem ready to acknowledge at least that the cases have a social dimension. In contrast, *Potter v BHP*,[15] *Attorney-General of NSW v Brewery Employees' Union* (*Union Label* case)[16] and *National Phonograph Co v Menck*[17] at the turn of the 20th century, and even *Victoria Park Racing v Taylor*[18] in the late 1930s, were almost entirely black-letter law in their

5 (1975) 133 CLR 1.
6 *Cadbury Schweppes Pty Ltd v Pub Squash Co Ltd* [1981] RPC 429.
7 *Firmagroup Australia Pty Ltd v Byrne & Davison Doors (Vic) Pty Ltd* (1987) 9 IPR 353.
8 *Foster and Others v Mountford and Rigby Ltd* (1976) 14 ALR 71.
9 *Bulun Bulun and Another v R & T Textiles Pty Ltd* (1998) 41 IPR 513.
10 *Hogan and Others v Pacific Dunlop Ltd* (1988) 12 IPR 225 and (on appeal) *Pacific Dunlop Ltd v Hogan and Others* (1989) 14 IPR 398.
11 *Schott Musik International GMBH & Co and Others v Colossal Records of Australia Pty Ltd and Others* (1997) 38 IPR 1.
12 *Lomas v Winton Shire Council and the Waltzing Matilda Centre Ltd* (2003) AIPC 35,165.
13 *TCN Channel Nine Pty Ltd v Network Ten Pty Ltd* (2002) 65 IPR 112.
14 *Beringer Blass Wine Estates Ltd v Geographical Indications Committee* (2002) 125 FCR 155.
15 *Potter v Broken Hill Pty Co Ltd* (1906) 3 CLR 479.
16 *Attorney-General (NSW) v Brewery Employees of NSW* (1908) 6 CLR 469.
17 *National Phonograph Company of Australia Ltd v Menck* (1908) 7 CLR 481 and (on appeal) [1911] AC 336.
18 *Victoria Park Racing & Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479; 1A IPR 308.

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reasoning – with the notable exception of the later-to-be influential dissent of Higgins J in *Union Label*.[19]

As close inquiry into those cases show, however, the first two involved fascinating stories of political controversy (*Potter* an early case of states' rights with respect to an invention patented in New South Wales before federation, and *Union Label* involving a dispute over original versus more progressivist interpretations of the intellectual property power under the Commonwealth Constitution, in the face of new 'union label' provisions inserted into the *Trade Marks Act 1905* (Cth) by the then Labor Government), while *Menck* presaged modern economic debates about the extent to which intellectual property rights holders should be free to exploit their market power by seeking to control an industry. Moreover, as Jill McKeough's discussion of *Victoria Park* makes clear, the case was not just about the High Court's treatment of legal arguments relating to copyright, nuisance, privacy and unfair competition. It was at heart a story of an ingenious broadcaster profiting from a neighbour's ability to overlook the spectacle of races being conducted on a commercially operated racetrack. Yet, with the possible exception of Latham J's passing comment that the plaintiff could have built a higher fence (for economists a signal of a cheaper cost avoidance analysis),[20] there is little mention of broader policy issues in the leading judgments in the case, which were rather framed around judicial statements about the settled boundaries of existing law.

The inevitable conclusion is that a court's readiness to address the social dimension of law depends, at least in part, on the attitude judges have to their role. Although it has been said in an earlier *Landmarks* book that '[u]ndoubtedly the High Court in its present composition is signalling a retreat from the Mason era of judicial activism',[21] we might wonder whether this is especially a feature of Australian intellectual property decisions or whether the experience has rather been one of gradual expansion of the judicial role over the hundred and more years since the High Court was established.

True, it was in the Mason era that Deane J said in *Moorgate Tobacco v Philip Morris*[22] that courts should be prepared to adopt a flexible approach to existing forms of action within their purview to 'meet new situations and circumstances' in preference to adopting torts of uncertain definition and parameters[23] (curiously, this was but three years before a similarly constituted High Court gave one of its most conservative and uninspiring judgments in the *Firmagroup* designs case,[24] leaving the reform agenda here squarely with the legislature). By contrast, as

19 See *Grain Pool of Western Australia v Commonwealth* (2000) 46 IPR 515.
20 (1937) 58 CLR 479, 494; 1A IPR 308, 310.
21 HP Lee, 'The Implied Freedom of Political Communication' in HP Lee and G Winterton (eds.), *Australian Constitutional Landmarks*, Cambridge University Press, Cambridge, 2003, p. 405.
22 *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No. 2)* (1984) 156 CLR 414.
23 See especially ibid., p. 445.
24 (1987) 9 IPR 353. Three of the five judges – Wilson, Deane and Dawson JJ – were on both panels, *Firmagroup* having also Brennan and Gaudron JJ (neither of whom are known for their conservatism) and *Moorgate Tobacco* having also (the normally conservative) Gibbs CJ as well as Mason J.

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McKeough points out with respect to *Victoria Park*,[25] no such flexibility was evidenced in that case when the High Court declined to find any intellectual property or other basis for granting exclusive rights over the spectacle of races being carried out in the plaintiff's grounds.

But already by the end of the 1950s, Hubicki and Sherman observe, incremental adaptation of legal standards was a feature of the Dixon court in *NRDC*.[26] More recently, various members of the (in some respects) Dixon-like contemporary High Court have not eschewed Deane J's statement of 'preferred legal method' but instead have endorsed it as a way forward for the court, making it clear that Deane J's language of 'situations and circumstances' must include not only new technologies and trading practices but social practices and values as well.[27] That such broadening out might lead to judicial uncertainty and even anxiety cannot be denied. For instance, the differences that emerged in the *Panel* case, the apparent inability to resolve more than the narrow issues in *Beringer* and the abject failure to protect the folkloric status of Banjo Paterson's much loved national song in the *Waltzing Matilda* case do not just result in less clear and stable legal precedents (as those having to deal with the cases may complain), but reveal courts grappling with their own realisation of their limited abilities to address all the social aspects of the case before them.

The challenges for judges are even greater where social practices and values may be highly localised and vary over time. Nevertheless, we suggest, the benefits of an 'anthropological' approach can still be immense. The particular case studies we have selected are designed to show that, at least in some circumstances – those involving mining, union marks, crop farming, the spectacle of horse racing, pubs, cars, crocodile hunters who run tourist operations on the side, Aboriginal stories and art, Coonawarra wines and Australian folk songs, for instance – there is a distinctly Australian flavour. Some of them, especially *Foster v Mountford*,[28] *Bulun Bulun*[29] and *Beringer*[30] show the inklings of a more narrowly localised flavour as well. Moreover, while many of our cases may be seen as especially about rural Australia, there are also some fascinating urban tales as well: the location of *Menck*[31] in Nicholson Street at the border between Fitzroy and Carlton in Melbourne shows the significance in 1908 of small inner-suburban businesses in Australian life;[32] *Firmagroup*,[33] with its back-story of a garage door handle-lock, shows the popularity of the commuting suburb 80 years later; the techno

25 (1937) 58 CLR 479; 1A IPR 308.
26 (1959) 102 CLR 252; 1A IPR 63.
27 See for instance *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* (2001) 208 CLR 199, 250; (2002) 54 IPR 161, 192 (Gummow and Hayne JJ), and for an earlier signal of Gummow J's endorsement of this approach, the beginning of his judgment in *Hogan v Pacific Dunlop* (1988) 12 IPR 225.
28 (1976) 14 ALR 71.
29 (1998) 41 IPR 513.
30 (2002) 125 FCR 155.
31 (1908) 7 CLR 481; [1911] AC 336.
32 An urban setting revelled in Fergus Hume's classic crime novel, *The Mystery of a Hansom Cab*, published by Hume in Melbourne in 1886, and in Great Britain by the Hansom Cab Publishing Co in 1887.
33 (1987) 9 IPR 353.

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dance remix of Orff's *O Fortuna* chorus, which featured in the *Schott* case,[34] was popular at rave parties in the early 1990s;[35] *Crocodile Dundee*[36] is as much a story about successful Australian film-making by citified entrepreneurs as it is about a fictional crocodile hunter in the Northern Territory; and *The Panel*,[37] with its sophisticated mash-ups of Channel 9 content, was a wildly popular Australian television program in the predominantly urbanised sub-40 Australian demographic. Taken together, the facts of the cases, ranging over the century after the first Australian Act, give a picture of a varied and complex Australia. Accordingly, they invite a variety of possible multilayered responses from commentators, whether of a more doctrinal or scholarly kind, as reflected in this book, which includes diverse contributions from the judiciary, legal practice and academia.

For this reason, if no other, the essays are worth reading. But we also suggest that understanding the stories aids an understanding of their role in the development of intellectual property law in Australia, and sometimes other areas of law as well (particularly at the contestable boundary with privacy, an issue that features in several of the chapters, most notably *Victoria Park*[38] and *Foster v Mountford*[39]). Some cases undoubtedly have cast a longer shadow over the law than others, and their shadow may extend beyond the shores of Australia. *Victoria Park*,[40] *NRDC*[41] and *Moorhouse*[42] come especially to mind and, as a result, we predict their chapters will be read especially carefully. But one reason for their longevity comes from a certain universal quality to their circumstances, despite their highly localised character in other respects – with digital and genetic innovation, the phenomenal business of sport, and internet-based music sharing presenting 21st-century parallels to the race-going, crop spraying and student photocopying of the 1930s, 50s and 80s. Other cases are more interesting in the changes they initiated, as for instance *Menck*[43] and *Firmagroup*,[44] which prompted a degree of legislative takeover of issues initially left to courts, and *Union Label*,[45] which prompted a different approach to Constitution-reading in more recent times. Finally, and most subtly, it will be seen that some of the cases have, somewhat anomalously, served as precedents long after the particular conditions that led to their being ceased to exist. The most obvious example is the earliest case in the collection, *Potter v BHP*,[46] which has become a

34 (1997) 38 IPR 1.
35 And still is, according to our informal consultations.
36 *Hogan v Pacific Dunlop* (1988) 12 IPR 225 and (on appeal) *Pacific Dunlop v Hogan* (1989) 14 IPR 398.
37 The program featured not only in *TCN Channel Nine Pty Ltd v Network Ten Pty Ltd* (2002) 65 IPR 112 but also (on the issue of what constitutes a broadcast) *Network Ten Pty Ltd v TCN Channel Nine Pty Ltd* (2004) 59 IPR 1 and *TCN Channel Nine Pty Ltd v Network Ten Pty Ltd (No. 2)* (2005) 65 IPR 571.
38 (1937) 58 CLR 479; 1A IPR 308.
39 (1976) 14 ALR 71.
40 (1937) 58 CLR 479; 1A IPR 308.
41 (1959) 102 CLR 252; 1A IPR 63.
42 (1975) 133 CLR 1.
43 (1908) 7 CLR 481 and (on appeal) [1911] AC 336.
44 (1987) 9 IPR 353.
45 (1908) 6 CLR 469.
46 (1906) 3 CLR 479.

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Commonwealth precedent on the territoriality of intellectual property jurisdiction, and whose continuing force, as Richard Garnett points out, is at odds with a world of multi-territorial communications. This case surely is an example of what the legal realist Guido Calabresi has called 'legal obsolescence'.[47]

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There are undoubtedly many cases that might qualify as Australian intellectual property 'landmarks' in a purely legal sense that have not been included in this volume. But there are plenty of excellent other sources of discussion about these, no doubt with more to come. This volume sets out, rather, to frame Australian intellectual property cases that tell us something not just about the development of intellectual property law in Australia, but also about the situation of intellectual property law – and intellectual property itself – in the economic and broader social fabric of our society. It finds its initial inspiration in an American collection, *Intellectual Property Stories*.[48] We are grateful to the editors of that book for their helpful advice on our project. We are also grateful to the editors of Cambridge University Press and anonymous referees for their support and guidance, and we particularly thank our commissioning editor, Zoe Hamilton, for her unstinting enthusiasm. Acknowledgment must be given to Bella Li, of the Melbourne Law School's Centre for Media and Communications Law, for her excellent editorial and research support in transforming this collection of chapters into a complete, consistent and coherent book. Our colleagues David Brennan, John Waugh and Robin Wright provided cheerful advice and assistance at various points along the way; their help is much appreciated. Above all, we are grateful to our distinguished authors for their significant contributions to a broader understanding of intellectual property judicial decision-making in Australia and, in particular, for their unwavering commitment to participation in the project notwithstanding the many other calls on their time.

47 G Calabresi, *A Common Law for the Age of Statutes*, Harvard University Press, Boston, 1982, p. 2 (although talking about statutes in referring to 'laws ... governing us that would not and could not be enacted today', analogous reasoning applies to the common law in a strongly precedent-based system).
48 J Ginsburg and R Cooper Dreyfuss (eds.), *Intellectual Property Stories*, Foundation Press, Thompson West, New York, 2006.

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