

CERTAINTY OF SUBJECT-MATTER IN THE DEVELOPMENT OF INTELLECTUAL PROPERTY: “PLEASE SIR, I WANT SOME MORE”!

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This article discusses the need for greater certainty of subject-matter in developing guiding principles in intellectual property rights. It begins by noting the importance of certainty of subject-matter in property law in general and argues that certainty as to the scope of what is protected by intellectual property law is no less important especially with the strengthening of the rights conferred (particularly in copyright). It examines briefly the need for certainty of subject-matter in the context of registered trade marks and patent law before moving into a discussion of copyright and in particular the position of names and titles. It argues for greater caution in the use of competition driven mantra such as “reaping where you have not sown” in developing property based rights and for copyright law to make conscious attempts to apply with greater clarity and rigour the expression/idea or facts dichotomy.

I. INTRODUCTION

The past 50 years have witnessed considerable expansion of intellectual property. From a basic list comprising copyright, patents, trade marks (registered trade marks and passing off), registered designs and the law of confidence, we can now add geographical indications, lay-out designs of integrated circuits, plant variety rights and performers’ rights.¹ Other countries/regions might also boast of petty patents (utility models), database rights and unregistered design rights.² Not only are there new intellectual property rights: old established categories have expanded (whether by judicial interpretation or legislation) to cover new areas of valuable economic and industrial activity. Computer programs are now protected by copyright and

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¹ Some of these have in fact been around for quite some time as in the case of performers’ rights and plant variety legislation. The *Agreement on Trade-Related Aspects of Intellectual Property Rights* (1994) [TRIPS] covers copyright and related rights; trademarks; geographical indications; industrial designs; patents and plant varieties; layout-designs and undisclosed information.

² Especially in the U.K. and Europe.

to a greater or lesser extent can also be treated as patentable subject-matter. New methods of doing business may also (at least in some countries) be protected by patent law. Smells, tastes and sounds can fall within the embrace of trade mark protection. Even naturally occurring genes can be patented through beneficent interpretation of invention, novelty, inventive step and industrial application (or utility). In some cases, the term of protection has also increased and in many cases the remedies and enforcement procedures have been toughened. Most countries may have got rid of conversion damages for copyright infringement, but in its place we find statutory remedies such as aggravated damages and statutory damages alongside traditional compensatory awards and accounting of profits. Criminal penalties have also been introduced or enhanced, including new copyright offences that catch “significant” infringing uses other than sale, hire or other direct forms of commercial exploitation of infringing copies.³

Have we now reached the point where we can safely say: prove that the “thing” in question is a product of some person’s intellectual effort, labour and investment and chances are it will be capable of being protected by one or more intellectual property right? Intellectual property rights are justified on the back of broad economic and natural law arguments. They are needed to provide an incentive to spur the creation, development and exploitation of new products and services to the benefit of society as a whole. They also recognise and protect the personality interests of the author/creator as each intellectual product is the child of its creator. And so, the law must not allow others to reap where they have not sown. The law must act on the basis that if it is worth copying then it is worth protecting and that the best way to secure the economic and personality interests of authors, creators and entrepreneurs is through the concept of property. Imitation may be the most sincere form of flattery—but how much nicer if consent to imitate is first obtained and paid for! We may all stand on the shoulders of giants who have come before—but why should not the giant’s burden be eased through payment? And so the argument goes, on and on. This is not to say for a moment that the development and expansion of intellectual property these past 50 years is unjustified. The enormous advances in science, technology and business methods coupled with developments in international trade have deeply underscored the importance of the intellectual property system. Sometimes the demands of innovators and their financial backers can be met through judicious adaptation (judicial or otherwise) of existing intellectual property rights. In other cases, new intellectual property rights have been needed, such as the *sui generis* right to protect lay-out designs of integrated circuits. Then again, there are those who argue, and with some force, that a new tailor-made database right is needed to provide balanced protection for data collection: protection best developed outside of the copyright system.

In seeking the expansion and strengthening of the intellectual property system, supporters often remark that the unauthorised use of intellectual property is just like

³ In the U.K., see for example s. 107(2A) of the *Copyrights, Designs and Patents Act 1988* (U.K.), 1988, c. 48 [*CDPA 1988* (U.K.)]: infringement by communicating a work to the public either in the course of business or otherwise to such an extent as to affect prejudicially the copyright owner. In Singapore, see s. 136(3A) of the *Copyright Act* (Cap. 63, 2006 Rev. Ed. Sing.) [*CA* (Sing.)]: willful infringement that is significant or done for commercial advantage.

theft and ought to be treated as such. Property is King! Infringing a copyright or patent or a registered trade mark should attract the same opprobrium as unauthorised use of another person's car. Even if it is not theft—it should be penalised under appropriate criminal provisions. If property is King and is the way to go in developing protection for the intangible products of intellectual activity, then perhaps the time has come to reflect on some salient characteristics of personal property and in particular the importance of certainty of subject-matter.⁴ On the other hand, if unfair competition principles are to be used to drive the creation of new rights, such as possibly in the area of databases, it will be far less confusing if property is not used as a vehicle for protection.

The general theme that will be explored in this article relates to the importance of clarity and certainty in identifying just what it is that is being protected as a *property* right under intellectual property law. Where a trade mark is protected by registration, the public is surely entitled to reasonable certainty as to just what constitutes the protected mark in question. Where an invention is patented, the public is likewise entitled to a sufficiently clear description of what the claimed invention comprises. Where material such as a novel or drawing or film is protected by copyright, the public is also entitled to know just what it is that is being protected by copyright in the material in question. Just what is it about the story that is being protected by copyright law? There will of course always be some uncertainty and looseness in definitions, but there should at least be an attempt made to identify and to refine the principles which lie behind protection for the intellectual property in question. Simply to say that the principle is that the law should not permit reaping without sowing is not enough. If that were to become the governing principle of copyright, it would lead to continuous expansion of copyright subject-matter both in terms of range of protectable subject-matter (literary, musical artistic, dramatic works, *etc.*) as well as the depth and scope of what is protected (expression/idea dichotomy, *etc.*). Sometimes, as in the area of databases, it may be better if a new *sui generis* intellectual property right is developed to meet a perceived gap in protection. This is especially so if protection under *expanded* existing intellectual property rights may lead to overprotection or a watering down of developed guiding principles such as the expression/idea (fact) dichotomy in copyright law.

II. PROPERTY RIGHTS: IMPORTANCE OF CERTAINTY OF SUBJECT-MATTER

Property rights, under the common law system, have long been divided into two categories: real property and personal property.⁵ Real property concerns land. Personal

⁴ Whilst this article is mainly concerned with copyright and the need for a sharper focus on the nature of copyright subject-matter and what is protected, it starts with a brief analysis of the position of trade marks and patents so as to set the scene for the copyright discussion. After all, these are all examples of intangible property rights. Certainty of subject-matter is a term that is usually found in connection with validity of trusts (alongside certainty of intention and objects). What is suggested is that certainty as to the boundaries of property subject-matter is rightly part of the fabric of property law.

⁵ Andrew Burrows & David Feldman, eds. *Oxford Principles of English Law: English Private Law*, 2nd ed. (New York: Oxford University Press, 2007).

property encompasses all other forms of property (including leasehold interests). Personal property in turn is divided into *choses in possession* (tangible property) and *choses in action* (intangible property subject-matter). Choses in possession concern tangible moveable things which can be directly physically possessed. A spade, a plough, a DVD, a bottle of antibiotics, a computer instruction manual and a packet of tissue paper are all obvious examples of tangible property subject-matter long protected by the common law. These are all things that can be owned (and physically possessed). Ownership means a lot of things including the right of exclusivity or the right to sole enjoyment and to exclude all others from the thing that is owned. In the case of a packet of tissue paper, the owner has the exclusive right of possession. Beyond this he enjoys the exclusive right to use the tissue paper and to exploit it any way that is deemed fit. It can be used by the owner for his own purposes and then discarded. It can be sold. The owner is generally entitled to use reasonable self-help measures to defend his property interests and where these fail or are inappropriate he can rely on the law to vindicate and protect his property right through legal action. He may not always be able to recover the thing itself: but he will certainly be entitled to compensation for the loss of or damage to the property interest. Property rights are in this way essentially “selfish” rights. They are legally sanctioned rights of self-determination and autonomy over the thing that is owned. This is precisely what makes property so desirable. My neighbour may have a cough, cold or chest infection: I do not have to share my spare bottle of antibiotics with him if I choose not to even if my doctor requests me to do so. My neighbour may have a runny nose: there is no law that will compel me to lend the use of my handkerchief or to provide a sheet of tissue paper. If I decide to do so that is my choice done as a result of my personal desire. Property rights in tangibles are powerful rights and enforceable *in rem* against the world at large. I do not have to be in any pre-existing relationship (contractual or otherwise) with a trespasser: his duty not to interfere with my property arises simply because of my ownership (or possession) and the respect that the law demands because of that ownership. It is in the interests of society as a whole to safeguard property rights of individuals.

How then is property in tangibles defended? How is my ownership of a packet of tissue paper protected under the law? Reasonable self-help measures aside, the owner can resort to the law. An action may be brought for trespass—the tort of detinue and conversion. Not only is the defendant liable for unlawful detention/disposal of the tangible property (detinue and conversion) he can also be liable for the mere taking or touching. If a prankster were to take and hide my packet of tissue paper (only to return it undamaged later) an action for trespass may (in theory) be brought. The action for trespass to goods applies to any direct intentional interference with another person’s possession of goods. So long as the interference was direct and intentional it does not matter that the defendant did the act in the mistaken belief that the thing was his own. Trespass is actionable without proof of damage: it was and is actionable *per se*. The owner may not be able to compel return of the packet of tissue paper: but he certainly is entitled to compensation by way of damages. In some cases, that compensation might be assessed by the value of the benefit to the trespasser. And this is not the end of the matter. Where the tangible has been destroyed or disposed of, the trespasser can be prosecuted under the criminal law. Depending on the circumstances and the type of tangible property, offences

such as theft, taking and driving away a conveyance, criminal damage, *etc.* may be relevant.

Given all of this, it is not surprising that advocates of legal protection for the material products or manifestations of intellectual effort, labour and investment should pray in aid the concept and language of property in building and expanding intellectual property rights. The world is constantly reminded that copyright, patents and registered trade marks are property subject-matter and that analogies could and should be drawn between copyright infringement and theft of a text book. The fact that intellectual property rights are intangible property rights is not thought to make much of a difference so far as the policy for protection is concerned.

If we leave aside the subject-matter protected for a moment, it is of course fair comment that many of the attributes or exclusive rights conferred on copyright subject-matter bear more than a passing resemblance to the rights conferred on tangibles. Copyright is actionable *in rem*. It can be exploited directly by the copyright owner or turned to account by a sale (assignment) or licence to a third party.⁶ Copyright can form part of the estate of a deceased person and devolve in accordance with a will or the rules of intestate succession. Copyright is also actionable *per se* without the need to prove consequential damage and whilst infringement depends on copying this is no more than saying that there must of course be a trespass! The copying does not even have to be direct—it can be indirect as we are told that a copy of a copy of a copy is still a copy. Neither does the copying have to be conscious as the law recognises the concept of sub-conscious innocent copying. A reader who studies a poem and who becomes infatuated with a verse and who years later pens the same words in genuine belief that the words are his own (memory of the source having faded) will find himself liable for copyright infringement.⁷ He may not have intended to commit infringement. He may genuinely and on reasonable grounds have thought that the words were his own. All this will not matter if the court is prepared to draw the inference that the similarities are too strong or unlikely in the circumstance to be coincidence and due to independent re-invention.⁸ Of course, liability for sub-conscious copying is likely to be quite rare in copyright law. In many cases there will be evidence of direct intentional copying. In those cases where there is no direct evidence, the court may well find liability on the basis of opportunity and sufficient substantial objective similarity such as to establish conscious/deliberate copying on a balance of probabilities. Nevertheless the point that is made is that, rare though it may be, cases can be found where courts have been prepared to find

⁶ For example, see s. 90 of the *CDPA 1988* (U.K.), *supra* note 3: copyright is transmissible by assignment by testamentary disposition or by operation of law as personal or moveable property. In Singapore, see s. 194 of the *CA* (Sing.), *supra* note 3.

⁷ *Francis Day & Hunter v. Bron* [1963] Ch. 587 and *John Richardson Computers Ltd. v. Flanders* (1993) 26 I.P.R. 367. In the United States, a successful copyright suit for subconscious copying was brought against the George Harrison hit song *My Sweet Lord*. See *Bright Tunes Music v. Harrisongs Music*, 420 F. Supp. 177 (S.D.N.Y. 1976).

⁸ But note that innocence may have an effect on remedies. See s. 97(1) of the *CDPA 1988* (U.K.), *supra* note 3, that if a defendant can show he did not know and had no reason to know that copyright subsisted in the work, damages are not to be awarded. In Singapore, see s.119(3) of the *CA* (Sing.), *supra* note 3. If the defendant can prove that he was not aware and had no reasonable grounds for suspecting that the act constituted copyright infringement, damages are not awardable without prejudice to the right to an account of profits.

liability based on genuine innocent sub-conscious copying. After all, the fact that copyright is property supports a tough approach to infringement.

There does of course remain one important difference: the nature of the subject-matter itself. Real property and tangible property rights are inherently certain and distinct in terms of what is fenced off from public use. This is obvious. A text book is tangible and its boundaries are clear. You do not commit trespass by nearly touching the book. Either you have touched it or not. A bright line exists between what is tangibly mine and what is not. Of course disputes over ownership can arise. In the case of land, sometimes these may involve land boundary demarcation disputes. In other cases complex transactions may mean that there is some uncertainty or difficulty in unraveling the chain of title (legal or equitable) to a parcel of land. But at the end of the day there is considerable certainty as to the subject-matter that is protected. This is fair enough. If the law recognised property rights where the subject-matter protected was of uncertain content or scope, how mischievous would such a law become, for as has often been said strong rights impose strong obligations. The world at large should know at least with reasonable certainty just what it is that is being protected on a property basis (and where relevant, the scope of exceptions).⁹

If a property right is created where the exclusive rights and remedies are extensive and the defences and exceptions either very limited or vague or both—is it not fair if the public should respond: “Well, at least the law had better be clear on just what it is that is being protected in the first place”? And yet how much certainty is there in the law as to what is protectable by the different categories of intellectual property law? Do we want a system where the scope of protectable subject-matter is often unclear, always expanding and supported with rights of increasing scope and term duration, and where the defences and exceptions are either very specific and limited or flexible but difficult to apply (as for example the copyright defence of fair dealing for study or research)? How many defendants will have the means or will to test the scope through long protracted litigation?

III. CERTAINTY OF SUBJECT-MATTER AND INTELLECTUAL PROPERTY RIGHTS

To be sure, the need to balance flexibility with certainty in developing proscriptive legal rules has long been recognised. There is nothing new in this. Different groups

⁹ Of course, just because the boundaries of the subject-matter protected as a species of property is clear, this does not mean that other uncertainties will not arise. These include questions as to the scope of the exclusive rights conferred and also what amounts to infringement. For example, in the case of copyright and literary works, aside from the root question, “what is an original literary work?”, problems arise in applying the expression/idea dichotomy and the requirement of a substantial taking before infringement arises. To be fair, unlike tangible property rights, copyright at least requires a substantial taking (assessed quantitatively and qualitatively) before infringement arises. The difficulty is in knowing just how the courts will apply the requirement of substantiality in any given case, *viz.* a substantial part of *what*, and how is this to be assessed. Small wonder that a considerable body of case law exists on assessing substantiality and infringement. Mention should also be made of the fact that the different exclusive rights conferred (reproduction, adaptation, public performance, communicating to the public, *etc.*) can be separately dealt with and assigned to different persons in different countries. The copyright in a work can be carved up and owned by different persons. Unraveling the chain of ownership to the rights in different countries can be quite a daunting task in its own right.

at different times will prefer one over the other: it is the task of the law-makers (judicial and legislative) to strike the right balance for the good of society as a whole. Where that balance lies is not easy to determine. The balance point may well shift from time to time and place to place. Laws driven primarily by economic considerations and which work well for highly developed industrialised economies may not always be appropriate for economies trying to mount the first step of the ladder to success. Even so, there is likely to be agreement in all countries and economies that a necessary hallmark of a property right must be certainty of subject-matter. There is indeed plenty of evidence for this even in the intellectual property system.

A. Trade Marks

Take, for example, trade marks. It is true that at common law there is certainly “looseness” in what can amount to indicia of origin capable of being the carrier of goodwill, the latter being the intangible property asset protected by the tort of passing-off. It all depends not on the thing in question (name, slogan, shape, colour, logo, smell, sound, *etc.*), but on whether the public will recognise that thing as indicia of origin of goods/services in the market place. If it does, then it can be protected even if the thing has a strongly associated descriptive meaning. Thus a lemon-sized, -shaped, -textured and -coloured container for pure lemon juice has been held to be a repository of goodwill and protected on the facts under the tort of passing off.¹⁰ But at least there is certainty by reference to the underlying principle. That principle is not some vague notion of unfair trading, or reaping where you have not sown. It is, instead, whether substantial members of the public recognise the claimant’s use of the thing as an indicator of exclusive trade origin.¹¹ Merely for the claimant to shout aloud: “this is my trade mark!” does not make it so. He must prove that that is also the public perception. Reasonable certainty can be found in the objective test behind goodwill.

What then of registered trade marks? Recent years have seen an opening up of the definition of what is capable of constituting a trade mark for purposes of protection under registration systems. This is important because registration as a trade mark does not always have to depend on use and public reputation. Brand new marks can be registered. The protection afforded under the statutory system is also much stronger. Thus the question of what constitutes registered trade mark subject-matter is a question of some considerable importance. For example, in many countries, under revised registered trade mark law, shapes are now registrable—although there may be exclusions of certain shapes such as those dictated by functionality or aesthetic considerations.¹²

Even more important, trade marks are no longer limited to signs (indicia of origin) that are “visually perceptible”. It is enough if the sign speaks to any of the five human senses so long as “it” can still be represented graphically (by writing or drawing).

¹⁰ *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 (H.L.).

¹¹ Or at least this is the governing principle which has evolved out of a broad background policy concern to rein in unfair trading.

¹² In the U.K., see s. 3(2) of the *Trade Marks Act 1994* (U.K.), 1994, c. 26 [*TMA 1994* (U.K.)]. In Singapore, see s. 7(3) of the *Trade Marks Act* (Cap. 332, 2005 Rev. Ed. Sing.) [*TMA* (Sing.)].

But herein surfaces a considerable problem: certainty or rather lack of certainty as to the boundaries of the non-visual mark. Once visual perceptibility is no longer a mandatory requirement of the registration system, the question must be asked: how can any other law abiding member of the public be reasonably sure of what it is that is protected by the registration? How much ambiguity are we prepared to tolerate in the subject-matter protected by registration? Is it enough for the trade mark developer to prove that he has spent years and considerable money using a particular fragrance to brand his product or service? Few will doubt that the branding exercise involves commitment of sustained intellectual effort and labour and there is a “natural” desire to prevent others from reaping where they have not sown. But what does reaping where you have not sown really mean? The developer of the “alleged” trademark surely cannot prevent any other competitor from using/adopting the idea of applying fragrance as an exotic form of trade mark. Whilst there may be exceptional cases where ownership of an intellectual property right confers control over the market for a type of product (as where a patented invention opens up a new class of products), in most cases the law strives to ensure that the market for a type of product or service remains open to competition.

For example, the fact that a trader is first to develop a particular business model such as pricing all goods sold below £1 does not mean that he can claim that business model as his trademark.¹³ Otherwise, the business and the trademark will have merged in a way that can only hurt competition interests. Similarly, just because a manufacturer is the first to conceive, develop and market a 3-headed rotary electric shaver does not mean that he can use trademark law to prevent competition in the market for 3-headed rotary shavers.¹⁴ To do so, he will need to assert an intellectual property right that is directly concerned with protection of particular products or inventions. It is here that patent law naturally dominates the landscape. But, as discussed below, the concept of invention has not been without dispute. For example, different views exist as to whether a new method of doing business can amount to an invention in the absence of technical effect.

Notwithstanding the expansion of categories of trademarks, the fundamental nature of a trademark remains the same, that is, to identify and separate rival goods/services in the market place. They are indices of origin used in connection with goods/services. Both the trademark user and customer benefit from protection of the trademark function. Beyond this, the customer (consumer) will want competition in the market place between rival brands so as to increase the available choice. So in the case of fragrance trademarks, it must be the *particular* fragrance that has been used for which registration as a trade mark might be granted. But how is the trade mark system going to ensure that other traders will understand with at least reasonable certainty what that fragrance actually is? This is vitally important because if the trade mark is properly registered, infringement arises (*inter alia*) through the use of the same or *similar* trade mark. If a rival trader is not sure what the registered smell actually is, how is he to know whether his fragrance is the same, similar or dissimilar (in law!)? If a trade mark property right is to subsist in the fragrance it must follow that the boundaries must be fenced with intelligible objective lines of demarcation.

¹³ In Singapore, see *Lifestyle 1.99 Pte. Ltd. v. S\$1.99 Pte. Ltd.* [2000] 2 S.L.R. 766 (C.A.).

¹⁴ *Philips Electronics NV v. Remington Consumer Products Ltd.* [1998] R.P.C. 283 (Eng. H.C.), [1999] C.A. 820, [2003] R.P.C. 2 (E.C.J.).

Thus, whilst the attempts of the European Court of Justice (“ECJ”) to set out a test (for non-visual marks) may be criticised, the spirit and rationale behind the test is readily understandable. The mark, the ECJ explains, must be “clear, precise, self-contained, easily accessible, intelligent, durable and objective”.¹⁵ That this is not an easy test to apply is beyond doubt. What for example is meant in this context by “intelligent”? Nevertheless, the core requirement of objective clarity and precision is surely something that makes eminently good sense given the proprietary nature of a registered trademark. Of course, questions remain as to the degree of precision that is required: is it absolute or reasonable precision? Issues may also arise as to the frame of reference to be taken: precision from the point of view of olfactory (smell) experts, scientists, businessmen, consumers or someone else. That said, unless a costly system such as deposit of samples or recordings can be developed, it is hard to see any other choice save a requirement for sufficient graphic description. If this benchmark proves hard to satisfy one is tempted to respond “so be it”. The only other choice will be to accept a huge proliferation of vague and imprecise non-visual trademarks protected by the civil and criminal provisions of the trade mark registration system.

B. *Patents and Inventions*

And so we turn to patent law. Most patent systems define patentable subject-matter by reference to the concept of “invention”. It is perhaps inevitable that there is lingering ambiguity over the legal definition of invention. Neither the *Paris Convention* nor *TRIPS* sets out a conclusive test of invention. What is now required is that there should be no discrimination as between different types of invention. Definitions of what constitutes patentable subject-matter range from any useful thing under the sun that is a product of human ingenuity to things made by the hand of man or woman, to things that are of utility in the field of economic endeavour all the way to things of practical and/or technical utility. Within these legal approaches debates have of course arisen in recent years over the extent to which computer programs and methods of doing business may constitute inventions under the patent system. Different countries may well adopt different approaches but at least there is one universal truth and this is that whatever is the legal scope of invention, patent law requires registration of the claimed invention.¹⁶ It is the applicant’s duty to set out in his application the scope of what he says is the invention for which he is claiming protection by registration. Whether it is a business method or a computer program or a manufacturing process or a product or a new use for a known product, the applicant is bound to identify with precision the invention for which he seeks protection.

¹⁵ *Sieckmann v. Deutsches Patent und Markenamt* [2003] R.P.C. 38; *Shield Mark BV v. Joost Kirst* [2004] R.P.C. 17.

¹⁶ Patent rights are personal property rights. In the U.K., see s. 31(2) of the *Patents Act 1977* (U.K.), 1977, c. 37 [PA 1977 (U.K.)]. In Singapore, see s. 41 of the *Patents Act* (Cap. 221, 2005 Rev. Ed. Sing.) [PA (Sing.)]. Curiously, the Singapore provision, unlike the U.K. counterpart, provides that the patent whilst personal property is not to be treated as a “thing in action”. *Quaere* whether this is to exclude the application of s. 4(8) of the *Civil Law Act* (Cap. 43, 1999 Rev. Ed. Sing.). The latter deals with the effect of assignments of debts and other “legal choses in action”. The effect of assignments of patents is set out in Part VIII of the PA (Sing.), *ibid.*

Thus, in the United Kingdom, Europe (*European Patent Convention*) and Singapore (for example) patent claims must be “clear and precise” and define the matter for which the applicant seeks protection. The accompanying patent specifications are required to “disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art”.¹⁷

In short, although there may be dispute as to what amounts to an invention in law,¹⁸ at least the applicant must define what he claims to be the invention and to set out the scope of the claims with certainty and precision. If the claims lack certainty and precision then (at least in theory) they should be rejected by the Patent Office. If unclear claims are granted, then even if this is not a ground for revocation the lack of clarity is bound to affect the sufficiency of specifications. This could well lead to a subsequent revocation of the claims in whole or in part.

Of course the point can be taken that even with these statutory requirements, the reality is that it is often hard for rival inventors and indeed the courts to determine just what are the essential elements of the claimed invention. Disputes for example have occurred over the meaning of the word “vertical” in a patent claim and whether “vertical” includes something that is a few degrees off true vertical (90 degrees to the horizontal).¹⁹ A third party will be advised that under U.K. patent law he will avoid infringement if he does not take all of the essential elements of the claimed invention. Great—but what does that mean? Where do the *essential* elements begin and end? If the claim refers to a vertical steel support member, will he be held to infringe if his steel member is set at 96 or 90 or 80 or 70 degrees? Patent lawyers will be well aware that claim interpretation has been that most fruitful mother of patent litigation battles. Some take the view that patent claims simply indicate the “ball park” area of what is to be protected: claims are not to be treated as the equivalent of boundary posts in a land dispute. Others beg to differ and see the main function of claims as protecting certainty and as indicating the boundaries of what is being protected. Behind these two approaches there are of course policy concerns. Some stress the need for certainty for the public and rival traders. Others tend to stress the need to adopt looser interpretations to ensure adequate protection for the intellectual and financial investment of the patentee.

¹⁷ In the U.K., see s. 14(3)–(5) of the *PA 1977* (U.K.), *supra* note 16. Absolute clarity and completeness is not required. It is sufficient if *enough* is disclosed so that the skilled reader can work the invention as claimed. In Singapore, see s. 25(4)–(5) of the *PA* (Sing.), *supra* note 16. Even though there are some minor differences in wording, the Singapore provisions have been interpreted to mean that the disclosure is sufficient if it enables the skilled reader to perform the invention (without further inventive work). Even though patent law does not require absolute certainty in the disclosure requirements the point remains that the applicant must disclose enough such that the skilled reader can without any further inventive work perform the claimed invention. See *Ng Kok Cheng v. Chua Say Tiong* [2001] 3 S.L.R. 487 (Sing. H.C.).

¹⁸ It goes without saying that in any future review of the international conventions and agreements on patent protection, serious attempts should be made to put to bed once and for all the legal meaning of invention. Note that what *TRIPS* states in Art. 27 is that Members are to provide patent protection for any invention whether product or process in all fields of technology provided that they are new, inventive and capable of industrial application. This leaves open the question of what is an invention. Does the reference to technology mean that there must be technical effect?

¹⁹ *Catic Components Ltd. v. Hill and Smith Ltd.* [1982] R.P.C. 183 (H.L.). The invention comprised a steel lintel device. The rear steel member was described in the claims as being vertical or extending vertically from the horizontal plate. The defendant’s lintel used a rear steel member inclined 6–8 degrees from vertical. Did the defendant infringe when the claims referred to vertical rear members?

And then there is the middle-of-the-road approach favoured by the *European Patent Convention 1973* (“EPC”). The EPC directs its Members that the extent of protection for a patented invention is to be determined by the term of the claims, the description and drawings being used to interpret those claims²⁰ Claims define; specifications assist in the interpretation of the claims to locate the essential elements of the invention as claimed by the patentee. Just in case this did not make a middle of the road approach clear, the *Protocol on the Interpretation of Article 69 EPC* (“*Protocol on Article 69*”) goes on to state that this means that the extent of protection is not to be understood as that defined by the strict literal meaning of the wording used in the claims with the description and drawings only being relevant to resolving ambiguity in the claims. Neither did it mean that the claims only served as a guide with the issue of scope being determined by what the skilled reader would have thought the patentee contemplated on a reading of the description and drawings. Instead, patent offices are directed that what is intended is a “position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.”²¹

In some respects, interpretation of patent claims and specifications is like interpreting the language used in a Will. Both are unilateral documents. One records the words and intention of the patentee. The other sets out the words and intention of the testator. In a very real sense both patent applicant and testator enjoy the freedom to decide how they wish their rights to be dealt with. A testator may if he so chooses bequeath the bulk of his estate to an individual who has little or no connection with him or his family. The fact that the bequest may raise many a puzzled eyebrow is neither here nor there. Similarly, it is for the patent applicant to state the essential elements of the invention for which he desires protection. If he chooses to limit the scope of protection (say, for example, to a support member set at 90 degrees to the horizontal), it is not the concern of the law through interpretation to rewrite the claims so as to broaden the scope of protection.

This is not the time or place to embark on a detailed analysis of the many decisions on approaches to claim interpretation. The point that is being made here is that even though claim interpretation has been embroiled in considerable controversy, the need for certainty from the perspective of third parties is a key element that has to be factored in. As is well known, the *Protocol on Article 69* was amended in 2000 through the introduction of a new Article, which states that for the purpose of determining the extent of protection, due account must be taken of any element which is equivalent to an element specified in the claims. Put loosely, the fact that the defendant uses a different element in his invention does not mean that he will have avoided infringement. If that element is equivalent to an element specified in the claims, the law is to take that equivalence into account in deciding the scope of the actual claims. Does this mean that claims can be enlarged on the back of any and all functional equivalents of expressed elements? If so, certainty will have been sacrificed in favour of flexibility for the patentee. This is unlikely to be the position.

²⁰ Art. 69 of the EPC.

²¹ But it has been said that there is nothing in the middle of the road, save yellow stripes and dead armadillos! See the book by Jim Hightower where the phrase appears as part of the title and referred to by Matt Ridley in his work on evolution and genetics: Matt Ridley, *Nature via Nurture: Genes, Experience, and What Makes Us Human* (New York: HarperCollins, 2003).

The 2000 amendment does not set out a principle of law that patented inventions are infringed through use of functional or mechanical equivalents. It simply makes clear that the wording of the claims and specifications have to be interpreted in the light of the explanation of how the claimed invention works.²² Within that teaching, the patent applicant is surely entitled to limit the scope of what he is seeking protection for. There are of course different levels of equivalence. Something might be equivalent in a purely mechanical or functional sense to something described in the patent claims even though it is as a matter of language far removed from the words used.²³ In other cases, the variant used by the defendant may not just function in the same way, it may also fall within the linguistic penumbra of the words used in the actual claims. The amendment simply makes clear that equivalence is a matter that needs to be looked at; whether it is decisive will depend very much on the language actually used and the state of knowledge at the relevant time. The need for certainty and fairness to third parties has not been dispensed with under the amended *Protocol on Article 69*.

C. Copyright

Copyright, like patents and registered trade marks, is also treated as a species of personal property. As noted already, it can be assigned or licensed and it passes on death in accordance with any will or the rules on intestate succession. On the other hand, copyright does not create a true right of exclusivity as such since coincidental similarity will not amount to infringement. Liability depends on proof of copying. The position of course is different with patents and registered trade marks. In this way, it is sometimes said that patents and registered trademarks are stronger IP rights (as compared to copyright) as a monopoly is conferred on the invention or trademark in question. For this reason we should expect underscoring of the need for certainty in the case of patents and registered trademark law. But, does it follow that certainty or reasonable predictability of what amounts to copyright subject-matter is any less important? Surely not! Reasonable certainty as to what are literary works, *etc.* and what it is that is being protected by copyright in any given work is surely desirable. Copyright as we have seen already is a very powerful intellectual property right. The term of protection is much longer than in the case of most other statutory intellectual property rights. Earlier the point has been made that, although copyright may require proof of copying, this is usually not hard to establish through a combination of direct evidence and/or circumstantial evidence. The causal connection does not have to be direct; it can be indirect since a copy of a copy of a copy remains a copy of the original. Neither does the copying necessarily have to be in the same medium of communication or presentation. Then again, as we have seen, the

²² See *Kirin Amgen v. Hoechst Marion Roussel* [2005] R.P.C. 9 (H.L.), *per* Lord Hoffmann.

²³ Compare a device described in the patent claims as comprising a “helical spring” with a device best described as comprising “a plastic rod with slits cuts into the surface”. Both devices are connected to a motor and when switched on can be used to remove body hair by catching and pulling. Both devices serve the same purpose and function in a similar manner (catching and pulling): does this mean that a patent claim for the former would be infringed by the latter? See *Improver Corporation v. Remington Consumer Products* [1990] F.S.R. 181 (Eng. C.A.). If so, does this mean that claim covers any device that catches and pulls hairs if connected to some sort of motor?

copying does not even have to be conscious. As befits a property interest a conscious intention to infringe (trespass) is not necessary, though this may have an effect on remedies.

Much has been written of late on the need for review of the current balance in copyright law between authors, creators, copyright owners and users of copyright material. Does society at large really derive a sufficient *quid pro quo* for such a long copyright term that has always gone up and never down? Who benefits from term extensions—especially extensions late in the day many years after the original author/creator has died? Is there a need to reassess available exceptions and qualifications to the exclusive rights? Who should take the lead: the World Intellectual Property Organisation, the World Trade Organisation or some other association or grouping of countries? In the case of defences, whilst it is true that most copyright statutes contain many statutory defences these tend to be narrowly focused. There are of course broader fair dealing defences but in many countries these are quite technical in their requirements and are in any case quite hard for users to apply. As mentioned earlier: how easy is it to apply the defence of fair dealing for study or research? Whilst some courts may be prepared to take account of “reasonable efforts” in deciding whether a dealing for study, *etc.* is fair, this is at best a factor of wholly indeterminate weight.²⁴

Then again Article 13 of *TRIPS* requires that all exceptions and limitations to the copyright owner’s exclusive rights are to be limited to “certain special cases”, which cases must “not conflict with a normal exploitation of the work” and “which does not unreasonably prejudice the legitimate interests of the right holder”. Will Article 13 support more aggressive use of compulsory or statutory licensing such that a user who needs a licence and who is unable to secure a licence on reasonable terms is able to place the matter before a domestic tribunal for resolution? Of course, some countries have already put in place fair dealing or fair use defences which are not tied down to specific purposes, but it will take time and many cases before the true scope of such defences becomes clearer. Given that copyright ownership is not subject to a registration system, how easy is it for a user of copyright material to find the relevant owners so that licences can be applied for? Another consequence of the long copyright term is the well-known problem of orphan works where the identity of the copyright owner is hard if not impossible for the user to discover in any reasonably practical manner. Is there a need in such cases for a statutory licensing system? No doubt the copyright owner is not normally bound in any case to grant permission, but the point remains that as compared to real property or patents or registered trademarks or registered designs, finding out who is the relevant copyright owner is by no means a simple task. Where the different exclusive rights have been assigned to different individuals the task becomes even more

²⁴ There are of course many areas of tort law where liability depends on an assessment of what was reasonable in the circumstances, such as in the case of the tort of negligence. But at least in most cases the burden of proof lies on the claimant to establish negligence, whereas in the case of the fair dealing the burden falls on the user’s shoulders. This is not to say that defences to copyright infringement should be constructed in such a way that there is complete certainty or predictability as to its application in any given case. That would be impossible to achieve in any meaningful manner, especially one that gives fair protection to the copyright owner. What is suggested is that greater care needs to be taken in deciding the scope of the protected copyright subject-matter and whether there is a case of infringement that will need to be answered with a defence.

complex. So what is the picture of copyright that emerges? Strong rights of lengthy duration that are qualified by exceptions of uncertain operation. Would that be a fair comment?

What then of the nature of copyright subject-matter? How much certainty is there under existing law as to the scope of copyright subject-matter? A number of points arise. First, most copyright statutes now recognise numerous (sometimes overlapping) types of copyright subject-matter: original literary, dramatic, musical and artistic works (author's works), sound recordings, cinematograph films, broadcasts, cable programmes and published editions of works (other copyright subject-matter).

Within these recognised types an extraordinarily diverse range of material can be protected. In the case of authors' works, as has often been said, originality has proven to be a rather minimalist requirement—one that is easily satisfied in the vast majority of cases. So long as the work is the product of some intellectual effort and is not a slavish copy of another work, chances are the work will enjoy copyright. But what then do we mean by the work?²⁵ What is the "it" that is protected by copyright? If copyright subsists in a history text book as an original literary work, what actually is being protected? The short answer is that it is the original expression that is protected, not the raw facts or ideas. Any literary work is not infringed simply by being read for its informational content. If I read a text on copyright law, I can use the information to help me understand what it is that I can or cannot copy in my business. But is this because copyright does not protect ideas, facts and information, or because I have an implied licence to use the information, or because use in this form does not amount to a reproduction in a material form of a substantial part of the work?

How sure are we that there is universal agreement that underlying facts and information are *really* free from copyright? Article 9(2) of *TRIPS* does state that "copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such". Fair enough. This looks like the expression/idea dichotomy. But then what of facts and information and how will different countries interpret the "as such" proviso? Is there sufficient vagueness in Article 9(2) such that a country can quite legitimately take the view that account can be taken of the sheer effort and labour of *gathering* facts in conferring originality on

²⁵ The question of what actually constitutes a "work" in copyright law has received relatively scant consideration in copyright law. The focus has been on the requirement of originality. No doubt in the majority of cases originality will be the key issue. That said, originality and works form a composite requirement: neither are sufficient on their own to qualify material for protection as an original author's work. Consider for example the relevance of reduction to material form, the amount of information or pleasure that is provided and the position of drafts to the question, "Is there is a work for purposes of copyright law?" The position of very short works such as titles and reduction to material form is considered below. As to whether copyright subsists in drafts, see *LA Gear Inc. v. Hi-Tec Sports plc.* [1992] F.S.R. 121 (Eng. C.A.) and *Biotrading & Financing OY v. Biohit Ltd.* [1998] F.S.R. 109 (Eng. C.A.). Is a first draft of a work in progress a work in its own right and if so (as seems to be the case) what happens to the copyright in that draft when the work is completed? Can a work that has taken many months or years to write be treated as embodying countless "little" works such that copyright can subsist in all of these as well as the final version? This can be hugely important when considering infringement. A single paragraph or less may be a substantial part of a one-page draft work.

any resulting work such as the white pages of a telephone directory?²⁶ Appropriation of the labour and effort of finding the facts may be said to amount to infringement as it invokes visions of reaping where the defendant has not sown.

And yet there are cases where it has been said that greater allowance must be made for use (and by inference, copying) in the case of fact-based works and that these should not be judged on the same standards as works of fiction.²⁷ Why should this be so? If copyright is about protecting the effort and labour of authorship (whether of works of fiction or fact-based works) then a case can be made for recognising the effort and labour of finding and checking facts as part of what is protectable by copyright. Copyright is there to safeguard the investment made in producing the work. But if copyright is really about protecting original expression over and above underlying facts and ideas, a stronger case emerges for excluding mere sweat of the brow or industrious collection from the copyright equation. To the mantra, “if you have copied the sweat of the brow it must be worth protection for you are reaping the benefit of someone else’s labour”, might there be a response that copyright law should permit the dwarf to stand on shoulders of the giant so that he might see further?²⁸

Either way, hasn’t the time come for greater certainty as to just what is protected in copyright subject-matter?²⁹ To be fair at least Article 10(2) of *TRIPS* does clarify that, for compilations of facts (such as a trade directory) or other material (a species of literary work), copyright is concerned with intellectual creativity in the sense

²⁶ Compare *Feist v. Rural Telephone Service Ltd.*, 499 U.S. 340 (1991) and *Telstra Corp v. Desktop Marketing Systems Pty. Ltd.* [2001] F.C.A. 612. See also the recent decision of the Australian High Court in *Ice TV Pty. Ltd. v. Nine Network Australia Pty. Ltd.* [2009] HCA 14 [*Ice TV v. Nine Network*], holding that skill and labour in making television broadcast programming decisions were not relevant to the copyright in the weekly schedule guides. Interestingly, French C.J., Crennan and Kiefel JJ. also state at para. 27 that copyright could not be claimed in the time at which a programme was to be broadcast. This is important for however much effort is invested in making a decision as to when individual programmes are to be televised, the broadcast time “is a single item of quotidian information.” For a more detailed discussion of the position of databases, see George Wei “Telephone Directories and Databases: The Policy at the Helm of Copyright Law and a Tale of Two Cities” [2004] 3 I.P.Q. 316. Note that the expression/idea dichotomy affects the question as to whether there is copyright subject-matter as well as whether the defendant has infringed copyright in a protected work or other subject-matter.

²⁷ *Ravenscroft v. Herbert and New English Library Ltd.* [1980] R.P.C. 193 (Ch. D.), *per* Brightman J.:
[B]ut the author of a serious original historical work may properly be assumed. . . to have another purpose as well, namely to add to the knowledge possessed by the reader and perhaps in the process to increase the sum total of human experience and understanding. The author of a historical work must, I think, have attributed to him an intention that the information thereby imparted may be used by the reader because knowledge would become sterile if it could not be used by the reader. Therefore it seems to me to be reasonable to suppose that the law of copyright will allow a wider use to be made of a historical work than a novel so that knowledge can be built on knowledge. . . .

²⁸ *Ice TV v. Nine Network*, *supra* note 26 at para. 28, *per* French C.J., Crennan and Kiefel JJ.:
[T]he information/expression dichotomy. . . is rooted in considerations of social utility. Copyright, being an exception to the law’s general abhorrence of monopolies, does not confer a monopoly on facts or information because to do so would be to impede the reading public’s access to and use of facts and information. Copyright is not given to reward work distinct from the production of a particular form of expression.

This is well said and supports a sharper and clearer approach towards application of the dichotomy.
²⁹ See *Ice TV v. Nine Network*, *ibid.* at para. 15, *per* French C.J., Crennan and Kiefel JJ., that in copyright cases “it is essential that the plaintiff identify precisely the work or works in which copyright is said to subsist and to have been infringed.” Beyond formal identification of the work(s) what is suggested below is that there is a real need for more certainty as to just what amounts to a “work” as well as what is being protected in that work.

of selection or arrangement of contents (as opposed to the data or material). But does this mandate that a harder or sharper line should be drawn between protectable expression and unprotectable facts in the case of compilations of facts?³⁰ This is tempting. The problem however is that Article 10(2) only deals with compilations and specifically concludes that protection for the compilation (selection/arrangement) whilst not extending to the data or material is “without prejudice to any copyright subsisting in the data or material itself”. And so the debate goes on and on. Copyright, it has been said, only declines protection for the “raw” or “basic” idea. Detailed ideas can be protected. What does all of this mean? It has even been said that copyright is more concerned with foxes rather than hedgehogs. Foxes have many strategies to employ in their quest to consume hedgehogs for dinner whereas the poor hedgehog has only one big idea for defence: to curl up and present a back full of spines.³¹ Ideas embodied within any work can be identified at different levels of abstraction. It is only at the most basic level that copyright eschews protection—at least from one viewpoint. What will a user of a copyright work make of this? Has the time come for greater clarity in what is being protected by copyright, or do we take the view that this is a case where “vagueness” is desirable as offering greater potential protection for the investment (intellectual and financial) that has been expended on the work?

Leaving aside the uncertainty resulting from difficulties in applying the expression/idea dichotomy, another example of uncertainty and copyright subject-matter concerns the very nature of an “original work”. To begin, when is a work made? To be sure, many, if not all, common law copyright statutes have some form of requirement that the work must be reduced to writing or some other material form. This can be either because the statute provides that no work exists (for copyright purposes) without reduction to material form, or because it is said that copyright does not subsist in a non-recorded work.³²

There are of course important differences between these two approaches. The first approach denies that the work (expression or idea/facts) can exist without a material record. The second argues that whilst the work may well have an existence copyright will not, as a matter of law, subsist until there is a reduction to material form. Either way, what is the policy behind the requirement? Is it because of the expression/idea dichotomy—that is there is no expression without a record of the work? Or is it because as an intangible personal property right a material record helps to provide certainty of subject-matter?

Neither of these two explanations is entirely satisfactory. If a poem exists only inside a person’s head, then what does it matter if there is copyright? If he does not even orally communicate it to anyone else it can never be copied. If it cannot be

³⁰ See *Infopaq International A/S v. Danske Dagblades Forening* (2009) Case C-5/08 where the ECJ remarked that taking 11 words during a data capture process might amount to an infringing reproduction if the elements reproduced are the *expression of the intellectual creation* of the author [emphasis added].

³¹ *Designers Guild v. Russell Williams* [2000] 1 W.L.R. 2416 (H.L.), *per* Lord Hoffman. From this it follows that it is the exercise of choice and selection from alternatives that provides the intellectual fingerprint of the author over and above the facts being expressed.

³² In the U.K., see s. 3(2)–(3) of the *CDPA 1988* (U.K.), *supra* note 3. Copyright does not subsist until the literary, dramatic or musical work is recorded in writing or otherwise. It does not matter who makes the record. In Singapore, see s. 16 of the *CA* (Sing.), *supra* note 3. Literary, dramatic or musical work is made when first reduced to writing or material form.

copied any copyright can never be infringed. On the other hand, if he does recite the poem in public, why should he not be able to assert copyright in the spoken word in the absence of a material record? Leaving aside performers' rights (performances), what is wrong with recognising an oral work as copyright material? Alternatively why do we recognise the work's existence but hold back subsistence of copyright until the first material record is made? Is this because of certainty of subject-matter, in that in the absence of a record it will be that much harder to prove the scope of the work especially in terms of the details (as opposed to the general idea or basic facts communicated)? Existence of a material record does of course make it much easier to establish the (literal) boundaries of the work. But what happens when that first material record (a manuscript, for example) is lost? The requirement of reduction to a material form does not compel a requirement that the material record must continue to exist for the duration of the copyright term. It tells us when the work is made or when copyright subsists and not how long the copyright lasts for. Where the original record is lost, secondary evidence will be needed and of course there may be problems of proof in some cases. In any case problems of evidence do not normally affect the development of substantive legal principles.

An oral contract is usually valid notwithstanding problems of proof. Slander is intrinsically more problematic in terms of proof of what was said than a case of libel. There are of course exceptional cases in the field of contract where writing is required (by statute law) for the contract to be enforceable. Thus the *English Statute of Frauds 1677* provides (*inter alia*) that contracts for the sale or disposition of immovable property as well as declarations of trusts over immovable property must be in writing. The reasoning behind the requirement for writing for certain types of contract is complex and well written on and range from problems of finding facts, through old rules of evidence that might prevent contracting parties testifying, to avoidance of fraud and perjury. To these, some contract commentators have noted that the bulk of the special provisions concerned "protection of proprietary interests in general" and that "the close association with the conveyance of property doubtless explains the presence of contracts for the sale of goods, for the sale of interests in land. . .".³³

And so we return to copyright and original literary, dramatic and musical works: why is there a requirement for reduction to writing or material form? Certainty of subject-matter may be a factor. Beyond this it has been said that since copyright is about copying and "the very essence of copyright" is that it protects material in "permanent" form.³⁴ Either way the need for a material record before the work

³³ Andrew Phang, *Cheshire, Fifoot and Furmston's Law of Contract*, 2nd Singapore and Malaysian ed. (Singapore: Butterworths Asia, 1998) at 354. Note that the requirement for writing for certain contracts for sale of goods has been repealed both in the U.K. and Singapore.

³⁴ *Fraser v. Thames Television Ltd.* [1984] Q.B. 44 (Eng. H.C.), *per* Hirst J. In discussing ideas and breach of confidence Hirst J. observed that unlike the law of confidence, copyright is "good against the world generally". See also *Donoghue v. Allied Newspapers Ltd.* [1938] 1 Ch. 106 at 110 (Eng. H.C.), *per* Farwell J.: that because of the expression/idea dichotomy "it is not until. . .it is reduced into writing or into some tangible form that there is any copyright. . .". *Cf. Jeffrey v. Boosey* [1854] 4 H.L.C. 814, *per* Erle J., that the origin of the property in copyright is the order of the words in the author's composition, rather than the words themselves (they being analogous to elements of matter which are not appropriated unless combined) or the ideas expressed by those words (they existing in the mind alone).

exists (as a matter of law) or copyright subsists in the work makes good sense in an uncertain world.³⁵

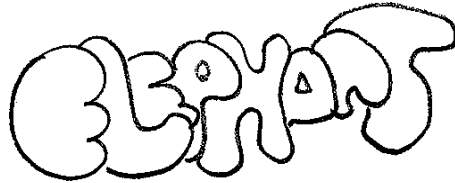
Moving on, it is perhaps surprising that questions still remain over the extent to which the law regards names, titles and slogans as copyright subject-matter. The controversy has now lasted well over 100 years! For sure, these are often the product of ingenuity. Great expense may have been incurred in their conception and promotion to the public—often as part of a branding exercise. A catchy slogan can be worth a lot of money. But that commercial value will often be rooted in the trademark function of the slogan as indicia of origin. That being so, registered trademark law and the tort of passing off naturally come to prominence. Subject to the statutory requirements of the registered trademark law, names, titles and slogans can be registered and protected against unauthorised trademark use by third parties. They may also become badges of recognition and vehicles to generate goodwill protectable by the tort of passing off.

As is well-known, English common law has yet to develop an action to prevent unfair competition head on. Instead, the policy to control unfair trading has led to step-by-step incremental common law case development of a number of specific causes of action. These include conspiracy to injure, inducing breach of contract, unlawful interference with trade or business and most “protean” of all, the tort of passing off.³⁶ Unfair trading lies at the heart of the tort of passing off and has been the driver developing the tort from its 19th century origins in the tort of deceit into the broad flexible action that the common law knows today. But, not content with trademark protection, the cry “Please sir, can we have more?” protection for words and slogans can be heard—more protection through the vehicle of copyright, specifically literary and artistic copyright. To be sure, some names, titles and slogans can easily and rightly be protected as drawings (artistic works). Even a signature might be protected—after all, stylised writing and calligraphy have considerable visual impact. Visual impact, in turn, is one of the main tools of artistic expression and protectable as such subject to the originality requirement. Corporate logos will often be artistic works even though key elements may include words or titles. In some cases the logo as a whole might even be treated as a species of literary work by reference to the selection and arrangement of the material compiled into the logo. Does this create unacceptable uncertainty for the public? This limited use of copyright is acceptable as the scope of the subject-matter protected is constrained. Artistic works are all about protecting artistic expression and in the case of drawings the tools of expression are essentially colour, tone, composition, shape and so forth. A word such as “elephant” written in standard font and found in a sentence is just a word. It is chosen for its meaning, and the visual impact in terms of

³⁵ See generally Hector MacQueen, “My tongue is mine ain’: Copyright, the Spoken Word and Privacy” (2005) 68 Mod. L. Rev. 349 and also Elizabeth Adeney, “Unfixed Works, Performers’ Protection and Beyond: Does the Australian Copyright Act Always Require Material Form?” [2009] 1 I.P.Q. 77. Whilst there is something to be said for giving a speaker copyright in spoken words when the words are reduced to material form by a third party, note that in the U.K. there have been significant developments in the recent past to expand the law of confidence to protect private personal information. See also *Ice TV v. Nine Network*, *supra* note 26 at para. 102, *per* Gummow, Hayne and Heydon JJ., that material fixation was necessary “so that protection did not extend to ideas or information and a balance is struck between the interests of authors and those of society in free and open communication.”

³⁶ *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd.* [1980] R.P.C. 31 (H.L.) at 91, *per* Diplock L.J.

the artistic expression is not relevant in any commonsensical way. But, if the same word is written on its own and in a stylised manner a different conclusion might arise.



The stylised representation of the word speaks to the eye and the stylisation is chosen for its artistic rather than literary expression. So long as the choice of the stylisation originates from the author's intellectual effort (creativity) there is no reason why artistic copyright cannot be claimed. If the word is written in standard font problems of originality may of course arise although we still have to be careful as words written in standard font can be built into a drawing. Much will depend on the facts of each case. That much uncertainty is inevitable but at least it is clear that artistic expression in the case of drawings is concerned with the visual impact of what is depicted. Furthermore, where the artistic expression is simplistic, barely crossing into the threshold of originality, nothing short of an exact replica is likely to infringe the artistic copyright.³⁷ There is little fear that artistic copyright can create monopolies over the building blocks of language.

The same of course is true for both registered trademark protection and the tort of passing off. The protection, powerful though it may be, is self-limiting. In the case of a registered trademark system, descriptive words, titles, slogans, and common surnames must run the gauntlet of capacity to distinguish and distinctiveness in order to be registered. Invented words are of course the easiest to register as they will carry no literary meaning and protection by registration does not fence off part of the public commons of language. If the invented word(s) later enter into common language (customary in current language, *etc.*) problems of distinctiveness arise, and if the word has already been registered the trademark proprietor may well find the registration under attack if the word has become the common name in the trade for the type of product or service.³⁸ Similar problems arise under the common law of passing off. It is trite law that the more descriptive a word or slogan is of the goods or services to which they are applied, the more difficult it will be to establish goodwill as a matter of law. Even if there is clear evidence of exclusive use of a descriptive word and public association of that word with the trader such as to generate goodwill, relatively slight changes will be sufficient to avoid infringement. This is because the law is anxious that rival traders should be able to compete legitimately with the first trader in the market place, and that monopolies should not be easily obtained over marks which *bona fide* and honest businessmen would want to use in the ordinary course of business. An invented word such as "Adogsty" which as a result of careless use and publicity becomes a generic term for dog food ceases to be

³⁷ *Kenrick v. Lawrence* (1890) 25 Q.B.D. 99.

³⁸ In the U.K., see s. 46(1)(c) of the *TMA 1994* (U.K.), *supra* note 12. In Singapore, see s. 22(1)(c) of the *TMA* (Sing.), *supra* note 12.

protectable by the tort of passing off. The word, whilst invented (and all words must have been invented by someone at sometime), will have entered the public language commons.

So, if there is a well-established pathway for protecting names, slogans and titles why have there been periodic attempts to assert literary copyright? Is this not, if one may borrow the expression, somewhat over the top? The reason can likely be found in the inherent limitations within registered trademark law, passing off and copyright as applied to artistic works. Slogans, names and titles can be valuable as commodities in their own right not so much because they are badges of recognition by means of which the public finds the business of the trader. If a trader can assert literary copyright in an invented word or a slogan or title, infringement does not depend on proof of deceptive or confusing use in the market place. Any unauthorised reproduction or for that matter public utterance of the word (public performance) might amount to infringement. Even if the word or slogan is written in an entirely different style (different visual impact) this will not avoid literary copyright infringement. True, some words that form part of a logo might be protected as a compilation (literary work). But if so, the protection that is afforded looks to the selection and arrangement of the elements of the compilation such as to make the compilation an intellectual creation. To copy the word for the sake of its informational content is most unlikely to amount to copyright infringement. But, change tack and assert literary copyright in the word and a different picture emerges—strong protection that carries real implications for the development of language for as long as the life of the author and 70 years thereafter. Of course, one way of avoiding this will be to develop a defence to copyright infringement that is designed to allow use of a word or slogan in ordinary and customary discourse. If there was, for example, literary copyright in the phrase “ROM chip” belonging to whoever first coined the phrase (in material form), how sure can we be as a user that the established fair dealing defences of study, research, criticism or review, reporting news, *etc.*, will apply?³⁹ Not all countries have a general statutory defence based on fair use *per se* and even if they did, how sure can a user be that the use will be regarded as fair? Then again, there are lingering arguments that a species of non-statutory public interest defence may still be available in copyright action. But this cannot be taken for granted and is it fair to put the burden of proof on the user to establish a defence in such marginal cases? Would it be preferable to take far more care in deciding whether there is copyright subject-matter in the first place, a matter on which the claimant rightly should bear the burden of establishing?

The problem is that the courts in the common law world, whilst cautious in accepting literary copyright in words, titles and slogans, have not adopted a consistent approach. Consider the following chain of case law. As long ago as 1867 in the case of *Maxwell v. Hogg*, the Court of Appeal (Chancery) dealt with a copyright action in respect of a magazine called “Belgravia”. Did the registration of the plaintiff’s magazine entitle him to exclusive use of that name (the plaintiff not having actually produced the magazine)? In denying copyright, Sir H.M. Cairns L.J. emphatically

³⁹ If copyright can subsist in invented words, is there any way in which the law can “take away” or refuse to enforce the copyright where the word enters into general language usage? Is it possible that in some cases abandonment or estoppel will apply? This seems rather improbable and will in any case require rather special facts.

asserted that, if it had been necessary to decide the point, copyright could not subsist in a single word even though the word was used as a title for a book.⁴⁰ First blood for the “no-copyright in a word” camp: but would the position have been different if the word had been newly coined or if the plaintiff had actually produced the intended magazine under the title?

Then in 1872, Lord Romilly M.R. granted an injunction to prevent the defendant from using the title “Birthday Text Book” in an action for copyright infringement. The copyright work was entitled “The Birthday Scripture Text Book”, a printed diary interleaved with blank spaces opposite each day of the year with a text of Scripture appended. The defendant produced a rival work using a similar format or arrangement (the selection of texts and verses being different) and preface. The claim was that the defendant’s work so closely resembled the plaintiff’s work in appearance as to induce incautious purchasers to believe that the two were the same. If we leave aside the copying of the language of the Preface, what else was copied and what was the literary copyright subject-matter said to be infringed? The court held that whilst the defendant was at liberty to publish a Daily Text Book and to adopt the general scheme of the plaintiff’s work, copyright would not allow publication of a work with such a title or in such form with respect to binding or general appearance as to be a colourable imitation. Copyright was held to subsist in the title “Birthday Text Book”.⁴¹ But where did the “general scheme” end and colourable imitation of copyright material begin? Then again is this a case where considerations more appropriate to the tort of passing off drove the use of copyright?

In 1878 the question of copyright in titles was considered again by Malins V.C. A series of books had been published under the title “The Parlour Library”. Number 196 under the series was a work called “Trial and Triumph”. The defendant subsequently published his own series under a different title. One volume in that series however was also called “Trial and, Triumph”. *Maxwell v. Hogg* was distinguished as being a decision against copyright in a bald title which had not been appended to an actual magazine publication at the time. Where a work had been published under the title as in the case at hand, Malins V.C. robustly pronounced that:

to say there is no title in a name as part of a publication, newspaper, book or periodical is . . .absurd and is not worthy of the time which has been consumed in considering it. The title of the book is part of the book and is as much the subject of copyright as the book itself. . . .⁴²

⁴⁰ *Maxwell v. Hogg* (1866–67) 2 L.R. Ch. App. 307. Other issues concerned trade mark rights and passing off which also failed on the facts.

⁴¹ *Mack v. Petter* (1872) L.R. 14 Eq. 431. The earlier case of *Maxwell v. Hogg*, *ibid.*, was not referred to.

⁴² *Weldon v. Dicks* (1878-79) L.R. 10 Ch. D. 247 at 260, citing *Bradbury v. Beeton* 39 L.J. (Ch.) 57 on “Punch and Judy”. But is this because the title or word enjoys its own copyright or because it is a substantial part of the larger work that it is part of? It seems probable that the latter was what was intended. If this means that the copyright in the larger work is infringed simply by taking of the title notwithstanding that the content and stories are entirely different, the effect is very close to copyright in the title *per se*. Applying the reasoning in *Weldon*, would the copyright have been infringed if the defendant called his ship “Trial and Triumph”?

But did this mean there was a separate copyright in the title or that the title might have been protected as a qualitatively substantial part of the book as a whole?

Next we come to another decision of the Court of Appeal in 1880 concerning the title “Splendid Misery or East End and West End”. This was the title of a particular issue of a weekly periodical. Did the defendant infringe copyright by publishing a story under the title “Splendid Misery”? In the end, the battle this time was decided on the basis of what today would be regarded as lack of originality. There was evidence that a much earlier work had been published under the title “Splendid Misery” and that the title consisted of common words and was in fact a “hackneyed phrase”.⁴³ As Jessel M.R. put it, there was no invention in the sense of originality. But originality of course means only that the work is a product of some skill and effort and that it is not a slavish copy of another work. If an author coins a term through his own skill and effort, that term is original to him in that however trite it may be, it is still a product of *his* skill and labour. The fact that an earlier work under the same title has been published does not mean that a second-comer who coincidentally comes up with the same title is being unoriginal in copyright law. Originality in copyright law after all is different from novelty or originality in patent law—something expressly alluded to by Jessel M.R. On the facts it therefore seems that the reason for the denial of copyright on originality grounds was because the court felt that insufficient skill and effort had been expended.⁴⁴

Jumping forward to the 20th century we come to a series of decisions on copyright and titles. In 1940 the Privy Council (on appeal from Canada) had to deal with a claim concerning the title of a song: “The Man Who Broke the Bank at Monte Carlo”. This title had been used by the defendants for their film. Nothing else was copied. Two strands emerge from the speech of Lord Wright. First, that, even if copyright subsisted in the song as a whole, the use of the title was too insubstantial to amount to infringement. Second, that as a general rule, a title was not the proper subject-matter of copyright because titles do not normally involve literary composition and the title in question was not in any case sufficiently substantial to *justify* a claim to protection.⁴⁵ But what does “literary composition” mean in this context? Is the title to be denied copyright because it lacks originality in the sense that there is insufficient literary skill involved in selecting the words for the title, or is it because—however much skill expended—the title as a work in its own right is not sufficiently substantial to deserve copyright protection? What did Lord Wright mean when he added the qualification that in particular cases a title may be so extensive in scale or important in character that it becomes the proper subject-matter for copyright protection? A full page of title to be sure would qualify as an original literary work in its own right. But what about a title of just a few words or just one newly coined word

⁴³ By hackneyed what is meant is trite or commonplace because of indiscriminate frequent overuse.

⁴⁴ *Dicks v. Yates* (1880-81) L.R. 18 Ch. D. 76. Jessel M.R. for example in *dicta* accepted that there might be a case for copyright in the case of a “whole page of title”. Also *per* Lush L.J.: that the subject of copyright must be original—a composition of the author, something which has grown up in his mind. What then if the claimant can show that considerable time was spent coining a new fancy expression or word, not something that was already commonplace. Does this mean that such a title or word can be protected even if it is a single word or just a short phrase? It may be original but does it provide sufficient information to be a work?

⁴⁵ *Francis Day and Hunter v. Twentieth Century Fox* [1940] A.C. 112 (H.L.) [*Francis Day and Hunter*].

that is closely related to a major theme in the story that follows? What does importance mean: factual importance, quantitative importance, qualitative importance or literary importance, or something else?⁴⁶ Can this be assessed with reasonable certainty?

And then we have the 1981 decision of the Court of Appeal concerning the rights in the invented word “Exxon”. The name was chosen as a new business name and trademark for a well-known petroleum company by a committee set up for that purpose. The new name had to satisfy 3 main conditions: (i) capability of being readily identified with the plaintiff and their goods and services, (ii) invented and devoid of meaning in English or in any other language spoken in any place where the plaintiff and their associated companies conducted business, and (iii) was short, distinctive and easy to remember. After considerable research (lasting over a year) the name Exxon was selected. Did the plaintiff enjoy rights against the defendant who used the same word as part of its corporate name? Unsurprisingly, the claim was founded on copyright and the tort of passing off. Stephenson L.J. in denying copyright stressed that a literary work is intended to afford either information and instruction or pleasure in the form of literary enjoyment. The word Exxon was not intended to do any of these things. Oliver L.J. agreed adding that “it is not necessary in construing a statutory expression to take leave of one’s common sense.” The name conveyed no information and provided no pleasure that his Lordship could conceive: it was simply an artificial combination of four letters used to identify companies in the plaintiff’s group!⁴⁷

If the above decisions did not close off all possibility of literary copyright protection for invented words, titles and slogans, the door was only left very slightly ajar. But that has been enough for claimants seeking more protection. The door was not locked and bolted and the handle could be tested in those cases where the claimant had no other intellectual property right to assert. If the facts enabled a plea that the defendant was reaping where he had not sown, might the court be persuaded to use literary copyright to prevent unjust enrichment? Of course, if there was an independent tort of unfair competition, this would not be necessary or desirable. But given the common law’s reluctance, could copyright be made to do the work of unfair competition?

⁴⁶ See *Exxon Corporation v. Exxon Insurance Consultants* [1982] Ch. 119 [*Exxon Corporation*]. Graham J. at first instance giving the example of “Jabberwocky”—the title of a poem in “Through the Looking Glass” by Lewis Carroll. Graham J. was prepared to accept that the invented word Jabberwock(y) was the essence of the poem and so memorable that the copyright in the work as a whole could be infringed by taking the invented words. That said, Graham J. did not go so far as to say that if an author invented Jabberwock on its own (with no poem) that this invented word could be regarded as a literary work entitled to copyright on its own. See also *Tavener Rutledge Ltd. v. Trexapalm Ltd.* [1977] R.P.C. 275 at 278, *per* Walton J., that whatever was the position in the United States, “so far as the law of England is concerned we do not recognise any copyright or other species of property in any names or words, whether invented or not.” See also *Green v. Broadcasting Corporation of New Zealand* [1989] R.P.C. 469 (N.Z.C.A.), noting that the trial judge had found that there was no copyright in the title “Opportunity Knocks” (applying *Francis Day and Hunter*, *supra* note 45). The point was accepted by the plaintiff. Whilst the point was not taken on appeal, Gallen J. added that the title was a hackneyed expression used in many different contexts and not involving any literary skill in compilation. See also *Sinanide v. La Maison Cosmeo* [1928] 44 T.L.R. 574 (Eng. C.A.), holding no copyright in the advertising slogan “a social necessity not a luxury” because the matter in which copyright claimed was too small for the court to attach any value to it.

⁴⁷ *Exxon Corporation*, *supra* note 46 at 144. But *quaere*—surely a name does offer information to a reader.

Take, for example, the 1985 case of *Express Newspapers plc. v. Liverpool Daily Post & Echo plc.*⁴⁸ In that case the claimant, who were newspaper publishers, adopted a promotional scheme to increase circulation entitled “Millionaire of the Month”. Cards were prepared in large (many millions) numbers and distributed at random to members of the public. Each card contained a 5-letter code that could be revealed by scratching off a paper cover. The possessor of the card could then compare the 5-letter code with a 5-by-5 grid of 25 letters published in the claimant’s newspapers. Apart from the grid of 25 letters there were also two 5-letter sequences published. Depending on whether and how the possessor’s sequence matched the grid or one of the two separate 5-letter sequences, prizes could be won. The possessor would not necessarily have to buy a copy of the newspaper: he might read a copy in a public library, borrow a friend’s copy and so on. Potentially £1 million could be won. Skill, effort and labour had been expended to create each grid of 25 letters and the separate 5-letter sequences. At the very least it was necessary to ensure that there were not so many winning lines as to make the claimant’s financial position hopeless! The defendants were a rival newspaper group who decided to copy and republish in their newspapers each day’s grid of 25 letters and 5-letter sequences. Possessors of cards could then discover whether they had won prizes by reading the defendant’s newspapers. In addition, the defendant offered some additional prizes of their own.

That the defendants were taking advantage of the skill, effort and expense incurred by the claimant in preparing the grids, cards, winning sequences was undeniable. The copyright question was whether there was copyright in the 25-letter grids and the two 5-letter sequences that were being copied. Were these original literary works? Each publication was in some senses a compilation or a table. This did not appear to be a case where copyright was asserted in a single invented word; instead the claims appeared to be directed to the compilation of the 25-letter grid and 5-letter sequences as a whole. The tables and sequences were clearly a product of skill and effort and were in the copyright sense original, but did they offer information, pleasure or instruction to the reader? To a reader who was not participating in the game and who did not have a card, the published codes, *etc.* would be largely meaningless as the informational content was related to the 5-letter sequence set out on the card. But to members of the public who did have a card, each grid of 25 letters and the two separate 5-letter sequences offered real information and possibly immense pleasure. Did it matter that the pleasure was not literary pleasure? Probably not, and in any case the presence of information in the context of the competition was hard to deny. Overall a total 700 grids and 5-letter sequences were prepared for the claimant newspaper. If this was the relevant work (compilation), the unauthorised taking of any individual day’s grid and 5-letter sequences was to be regarded as reproduction of a substantial part of the whole work. On the other hand, if the work was each individual grid and 5-letter sequences the defendant would have taken each work in its entirety. Overall, the decision in *Express Newspapers* finding in favour of copyright is understandable especially if the focus is on copyright in each 25-letter grid and associated 5-letter sequences. The question remains: what would the position have been if the defendant had merely copied the 5-letter sequences that were published

⁴⁸ [1985] 1 W.L.R. 1089 (Ch.) [*Express Newspapers*].

daily? Is there a separate copyright in each sequence or is the taking of just one sequence enough to amount to a substantial part of the work as a whole? This point was not dealt with although Whitford J. did state that in his view the work could be regarded as each one of a number of grids and 5-letter sequences.

In Scotland, the question of copyright in a title was briefly considered by the Court of Sessions in *Shetland Times Ltd v. Wills*.⁴⁹ The facts concerned the unauthorised copying and use of a newspaper headline for hypertext link purposes. The headline in issue read: “Bid to save centre after council funding cock-up”. The defender, whilst conceding that some headlines could in theory amount to original literary work, argued that the headlines in issue fell outside as there was insufficient expenditure of skill or labour and because the headlines were ordinary in the extreme. In granting an interim injunction (and without discussion of relevant case law), Lord Hamilton disagreed, holding that there was at least an arguable case sufficient to lead to the grant of an interim interdict.

And now there is a recent decision of the New Zealand High Court which if followed opens the door to literary copyright protection for titles and slogans (if not single invented words). In *Sunlec International Pty. Ltd. v. Electropar*,⁵⁰ the claimant enjoyed distribution rights for a wire marking gadget used in a method to label electrical wires with letters or numbers. To aid the marketing of a particular portable product with a see-through case (essentially a travel kit version), a title or slogan was devised in the form of a “snappy memorable phrase” to describe how the product could be best used by its customers. After reviewing a number of phrases, the title “Field Friendly—the best choice for field work” was selected. In a surprising decision, Wylie J. found that the title was an original literary work. The principles applied were unremarkable and well-established. Original literary work was not confined to works of literature as there is no requirement of literary merit. Mundane works could be protected and the “traditional” definition was that a literary work is concerned with providing information, pleasure or instruction. Wylie J. was of course quite right to say that copyright could not be denied to a literary work simply because it was used as a slogan. After all what is a short poem today might be used as an advertising slogan tomorrow! The intended objective is irrelevant so long as the words offer information, pleasure or instruction to the reader. The slogan was said to be original because of the skill, labour and effort expended in its creation. It was a literary work because it conveyed information about the product. Add the two together and the title passed into the protected realm of copyright.⁵¹ To be fair, whilst many earlier English and Australian cases⁵² had denied literary copyright to

⁴⁹ [1997] F.S.R. 604.

⁵⁰ Unreported. Judgment handed down 24 September 2008 [*Sunlec*]. For discussion, see Paul Sumpter, “Copyright in Slogans” [2009] E.I.P.R. i.

⁵¹ This was notwithstanding the earlier English cases denying copyright (on the facts) to slogans such as “Goodsight is your most valued asset. Avoid the predicament of being without your glasses. Let us make you a spare pair. Broken lenses promptly and accurately repaired”. See *Kirk v. Fleming* (1928–35) MacG. Cop. Cas. 44. Other slogans referred to in which copyright was denied by Australian courts included: “Somewhere in the Whitsundays”; “The Resort that Offers Precious Little” and “Smartfax”. See *Sullivan v. FNH Investments Pty. Ltd.* (2003) 57 I.P.R. 63 and *Brodell v. Telstra Corp.* [2004] F.C.A. 505.

⁵² *Ice TV v. Nine Network*, *supra* note 26. See French C.J., Crennan and Keifel JJ. at para. 27 that “generally speaking” copyright could not be claimed in a programme title alone. This was a case concerning the scope of copyright in television broadcast schedules.

slogans and titles, these were all decisions on particular facts and were not in any sense binding on the New Zealand High Court.

So where do all these cases leave the law on the copyright status of slogans, titles and words as a species of original literary work? What are the principles that might inform the exercise of judicial discretion in deciding whether there is sufficient originality for protection? The instinctive reaction (or prejudice) to deny copyright simply because the words are by way of a slogan or advertising jingle rather than a work of literature must be avoided. Equally, it would seem to follow that very short poems and minimalist “literary works” should not automatically qualify for protection in their own right simply because they are labeled as “poetry”.⁵³ The general principles should be the same and applied without prejudice or bias.

But what then are these principles? Is it enough simply to state that it is a question of judgment and commonsense whether sufficient independent skill and effort has been expended, resulting in a work that offers enough information or pleasure to the reader? Beyond this, there is of course the age-old expression/idea dichotomy denying protection for raw, basic unworked ideas. But again, how easy is it to apply this dichotomy and how many cases have there been where the courts have actually tried to apply the principle? With very simple short works of few words, the distinction between the two (expression/facts or ideas) may be very hard to pin down. Or is it simply a matter of asking whether the defendant has reaped what is not his? If an analogy can be drawn between copyright in literary works and patents for inventions and registered trade mark protection, is there not a case for more certainty and guidance as to just what is capable in law of amounting to an original literary work as well as the scope of just what it is that is being protected by the copyright in any given literary work? Reaping where you have not sown may be a powerful badge of unfair competition. It is not necessarily a badge of (intangible) property.⁵⁴

What the cases suggest is that there are a number of ways in which copyright in words, titles and slogans can be approached. Copyright in any literary work is fundamentally concerned with authorial expression through the use of language. Traditionally, language may have meant words in print or writing, although today any material record of the words should of course suffice (electronic, Braille and so forth). Application of the expression/idea dichotomy strongly argues that what is at stake is literary or linguistic expression, and not effort and labour on its own. The fact that the thing produced is commercially valuable is neither here nor there. The tools of literary expression will certainly include choice and selection of words, punctuation, grammar, arrangement and structure. It may even include the effort of selecting the information to be included. On this basis, the fact that the combination of words used is obvious or hackneyed or commonplace or done before by many others is an attack on originality. An exceedingly obvious phrase may still offer considerable information. But is it original in the copyright sense of involving enough literary/linguistic skill of selection and combination?

To describe the fact that “the sun is round” by using the words “the sun is round” requires no imagination or skill beyond basic competence in the English language.

⁵³ Examples of very short poetry include Haiku poems. See also “Reflections on Ice Breaking” by Ogden Nash.

⁵⁴ *Ice TV v. Nine Network*, *supra* note 26 at paras. 69–70, *per* Gummow, Hayne and Heydon JJ., that the rhetoric of misappropriation had influenced the Federal Court to find infringement.

The expression and the raw facts are hopelessly intertwined. On the other hand, to describe the same fact with the slogan, “the sun is neither square nor triangular not even a rectangle; it is that most perfect of shapes a circle in three-dimensions with no beginning or end”, is quite a different matter. Whether the reader finds the choice of words clever, silly, childish or pretentious is irrelevant. There is more choice and effort of linguistic selection to describe the same fact. If copyright does subsist in the latter phrase, it cannot amount to protection of the fact. Neither will it prevent anyone else from using obvious linguistic descriptions of the shape of the sun. And if a third party coincidentally coins the same expression, he will not infringe any copyright that may subsist in the phrase.

But, then, there is the second and related question. Are the words as a whole an original *literary work*? Leaving aside invented words, any phrase or slogan or title will offer some information or pleasure to the reader. The same must be true of any short literary work such as a Haiku poem. Even single words when used as corporate name offer contextual meaning to the reader. Suppose, for example, that member of the public comes across the following words: “Adogsty Plc”. He may never have heard the word before and he may know that it has no customary meaning in the English language. He will also know that it is being used as the name of a corporation. That is information. Just as the 5-letter codes in *Express Newspapers* case only offered information in the context of the competition, so too the context of use provides the information in the case of an invented corporate name. It seems to follow that the objection to copyright in very short works or titles (originality aside) must be on the basis that these often do not offer *sufficient* (as opposed to no) information or pleasure for it to be protected as a literary work. If so, the question that follows must be: how much information then is sufficient? What is the degree of complexity or quantity of information that is needed to qualify as a work? Similar questions have arisen in the case of artistic and musical works. Is a blank sheet of canvas simply a blank sheet or a minimalist painting where the shape and colour resides in the total absence of any marks? A painting must be concerned with offering pleasure, information or instruction in the form of artistic expression. Then what of a musical work that comprises two notes punctuated by a long pregnant pause? Is the absence of sound, music? A pause may well be musical punctuation. Can the pause itself be a musical work?⁵⁵ If an author publishes a book of a hundred pages, all blank save the words “This is the story of my life. . .” on page 1 and followed by “The End” on page 100, is the publication an original literary work? Does this offer

⁵⁵ See Saw Cheng Lim, “Protecting the Sound of Silence in 4’33’”: A Timely Revisit of Basic Principles in Copyright Law” [2005] E.I.P.R. 467. See for example the unreported case *Hyperion Records Ltd. v. Warner Music (U.K.) Ltd.* (Eng. H.C., 17 May 1991). This concerned alleged infringement of copyright in a sound recording. Track 5 comprised plain medieval chant lasting some 5 minutes and 18 seconds. The defendant was said to have taken 8 notes of the recording. The 8 notes were apparently reproduced repeatedly in the defendant’s recording. What was the copyright work? The claimant appears to have asserted copyright in the sound recording as a whole (multiple tracks), copyright in the sound recording of track 5 as well as copyright in the 7-8 introductory notes alleged to have been taken. Laddie Q.C. (as he then was) doubted that the appropriateness of “arbitrarily” cutting out from a larger work a smaller portion that is then referred to as the copyright work. If this was done without limit it would render otiose the substantiality requirement in determining infringement. The question was whether the 7-8 notes formed a substantial part of Track 5 and not whether the 7-8 notes were a copyright work in their own right. See George Wei, *Law of Copyright in Singapore*, 2nd ed. (Singapore: SNP Editions, 2000) at para. 8.29 [*Law of Copyright in Singapore*].

sufficient information to the reader to qualify as a literary work? Merely to say that the work is trite or valueless is insufficient. After all, if it is not copied it cannot be infringed. If the sentence is trite and commonplace this will also mean that it will be much harder to prove that a third party's use of the same phrase was due to copying as opposed to independent re-invention. Is there any more guidance from the case law on when the court will more likely deny copyright because of insufficient content?

Looking at words, titles and slogans and intellectual property rights in general it appears that a central (unspoken) concern of the law is perhaps to protect the public commons in language. Artistic copyright as we have seen cannot impede the development of language although problems might arise over new fonts and typefaces. But even here, protection of a new font will not protect alphabets *per se*. Passing off and registered trade mark law has also gone to great lengths to minimalise protection for descriptive words or phrases. Whilst these can be protected or registered in some cases, great care has been taken to ensure that other traders are not prevented from using words and phrases which honest, *bona fide* traders might want to use in connection with their goods or services. Might the same policy concern lie behind the reluctance to protect words, titles and slogans by means of literary copyright? The word "escalator" was originally coined as a trademark. Once the word entered the English language the trademark function disappeared and the English language was that much richer. What would have happened if the word "escalator" enjoyed copyright as an original literary work? Protection would have lasted a very long time, much longer than its ability to function as a trademark by way of a brand for one manufacturer/supplier of moving staircases! The building blocks of English language (grammar aside) are alphabets, words and phrases (metaphors, proverbs and the like). All words must have been invented at some time and may be the product of ingenuity and effort. Even if the word offers some meaning (literal, contextual or otherwise) there is a real danger that literary copyright protection will impede its incorporation into language.

Then what of titles and slogans? In many cases, an alternative basis for denying copyright will be lack of sufficient originality. Even if some courts deny that any modicum of creativity is necessary, some sufficient skill and effort is still required.⁵⁶ In this context it is suggested that a possible approach is that the skill and effort must be sufficient to safeguard the reasonable public interest in language development. Suppose, for example, that a manufacturer of mountaineering equipment was the first to coin the catchy and memorable expression, "Thin Air is No Problem": does it make sense to confer literary copyright from the point of view of the public interest in the tools of language?⁵⁷ Even if the view is taken that there is a modicum of creativity such as to render the choice of words original, does it necessarily follow that the slogan must be treated as a *work* for copyright purposes? If unfair competition by another trader is the fear, then the solution will surely have to reside in the tort of passing off. If there is no passing off or registered trademark issue and no artistic

⁵⁶ Even English courts which take a very minimalist approach to originality have on rare occasions denied copyright because of insufficient skill and effort expended in the making of a work. See for example *GA Cramp & Sons Ltd. v. Frank Smythson Ltd.* [1944] A.C. 329 (H.L.) denying copyright in a compilation of tables (postal charges, lighting up times, *etc.*) set out in a diary.

⁵⁷ Consider the expressions "Just Do It" and "Don't Leave Home Without It", memorable and catchy slogans used by Nike and American Express as trademarks.

copyright, surely that should be on the basis of the need to protect language. After all, the more popular and well-known the slogan becomes, the harder it will be to show that there has not been subconscious copying of the phrase. If copyright law accepts, as it does, that liability can arise for subconscious innocent copying, the perils of conferring literary copyright too easily on short phrases becomes apparent.⁵⁸ This is not to say that this approach will always be relevant, but at least it may help improve the level of certainty by offering a policy driven principle for guidance. Thus, in the case of *Shetland Times* and the fanciful headline concerning a mess over council funding, copyright in such a title is far less likely to have unreasonable implications for language development as it seems improbable that the exact words used will become a proverb or common expression for funding problems.⁵⁹

IV. CONCLUDING REMARKS

The general theme of this article concerns the need for certainty of subject-matter in intellectual property rights. As a matter of general principle, the stronger and more extensive the rights, the tougher the remedies, civil and criminal, and the greater the need for certainty and reasonable predictability as to what is protected. Intellectual property rights are not just about protecting the economic interests of the right-holder. They are or should represent a balance between the economic and moral interests of authors, inventors and businesses and the public interest in progress and access to knowledge and information. Reaping where you have not sown, if it is to be used at all in copyright, must be balanced with standing on the shoulders of giants. If it is worth copying it is worth protecting must be balanced against the fact that some forms of copying may not be unfair and that in some circumstances imitation is the most sincere form of flattery.⁶⁰

This is not to say that copyright legislation should be tightened by setting out precise and exhaustive definitions of copyright subject-matter. That would be very hard to achieve and likely to create severe problems of its own. Judicial discretion within principled case-by-case development is likely to be the best bet. What is suggested is that in the case of copyright, the principle should not be some loose concept of over-borrowing or reaping where you have not sown. Instead the courts should focus more on the expression/idea (fact) dichotomy and to develop principles that will offer more guidance than statements such as, "it is only bald or raw ideas/facts that are unprotectable". Originality under this dichotomy should be related to the expressive

⁵⁸ Compilations of words and slogans are in a different position. What is protected is not any individual word or slogan but the effort and skill in making the selection and arrangement as a whole. No doubt Haiku poems can be protected as original literary works applying basic copyright principles.

⁵⁹ See Hector MacQueen, "My tongue is mine ain": Copyright, the Spoken Word and Privacy" (2005) 68 Mod. L. Rev. 349 at 363, that "routine words and catch phrases with which we navigate our way through daily life may well fall short of even low standards of originality and literariness".

⁶⁰ See the late Justice Hugh Laddie: "Copyright Over-strength, Over-regulated, Over-rated?" [1995] 5 E.I.P.R. 253 at 259:

The whole of human development is derivative. . .we borrow and develop what they have done not necessarily as parasites but simply as the next generation. When we are asked to remember the Eight Commandment thou shalt not steal, bear in mind that borrowing and developing has always been acceptable.

elements of the work. Whilst these can include the intellectual effort of selecting information to be included in a work, care should be taken to avoid protection for mere “sweat of the brow”. Otherwise the dichotomy will be so thin as to play no real role in setting the boundaries of copyright subject-matter.

Courts in deciding whether there is an original copyright work should be mindful of the desirability for greater certainty in identifying the expressive elements in the work especially in those cases where there is no literal copying. If, as already suggested, in the case of literary works the hallmarks of expression are essentially choice of words, grammar, punctuation, order, sequence and structure then this is where the focus of discussion should reside in any given case. The fact that the work is economically valuable should not be the determining factor. If there is a new train-line with 26 stations named alpha, beta, gamma, delta, epsilon, zeta, *etc.* running across the city from north to south, what are the unprotectable facts as opposed to protectable copyright expression in a new train guide which describes the new line for the reader? If the defendant independently takes a train ride and records the names of the stations he will not have infringed because at the end of the day he did not copy from the new train guide. Is this all that is meant by the expression/idea (facts) principle? To what extent will copyright allow the defendant to use the information contained in the earlier work? If the defendant writes his own train guide with his own narrative and merely takes the information that there is a new train line running north to south and with the named 26 stations, is this infringement? What if the plaintiff deliberately adds in a false station? If this appears in the defendant’s work it will certainly provide evidence of copying, but copying of what—original expression or a false fact?

In the case of single words and short titles the question needs to be asked: is the claimant asserting literary or artistic copyright or both? It should make a difference as expression for artistic work is quite different from expression and literary works. If the claim is for protection as a literary work, is there sufficient intellectual effort in the selection of the word or words (invented or otherwise) for it to be regarded as original? That this will remain a question of judgment cannot be denied although policy concerns over language development may (but not necessarily must) operate at the margins. Simply to ask how important an invented word is to a larger work in which it is found does not help to clarify the position. How could it, if the importance arises from the coining of the word or phrase to describe a newly discovered fact or scientific theory, such as “quasar”⁶¹ or “the big bang”⁶² or “dark energy”⁶³ in cosmology?

⁶¹ A contraction of “a quasi-stellar radio source”.

⁶² Initially a prediction arising from Einstein’s 1916 General Theory of Relativity that large stars at the end of their lives could undergo gravitational collapse. What is left after the collapse was sometimes referred to as “frozen stars” or “gravitationally completely collapsed objects”. Professor John Wheeler of Princeton University apparently coined the term “black hole” to replace the latter long-winded term. *Quaere* also copyright in the title/phrase, “A Formal Foundation of the General Theory of Relativity”. Clearly enormous sweat of the brow and intellectual effort was expended by Einstein in developing this theory (gravity is a result of curvature of spacetime). No doubt time and effort was also expended on the title of the paper. Can there be copyright in the title of the paper, or indeed “General relativity”?

⁶³ An unknown form of energy permeating the universe and which is thought to be the cause of the increasing rate at which the universe is expanding. As mentioned earlier, aside from questioning subsistence of copyright in words and titles, tricky issues as to whether the author has impliedly “surrendered” any copyright in the word or title can arise. This is yet another area of copyright where uncertainty remains: to what extent if at all is it possible to “abandon” copyright outside of estoppel? Fair dealing or fair

Similarly, in deciding the question whether the defendant has copied enough to infringe copyright in a work, there is no doubting that the legal test of a substantial taking has to be assessed on a qualitative basis. This inevitably causes some uncertainty but at least principles have been developed to assist in an objective analysis of the facts.⁶⁴ Assessing substantiality of taking in copyright actions on a purely quantitative basis through some mathematical formula will be undesirable in most cases.

To be sure, there can be no doubt that intellectual property rights are an essential tool for economic, industrial and social or cultural development for all nations. Clearly, property concepts will play an important role in incentivising commitment of intellectual and financial resources. Intellectual property rights are about the future and adding to the store of human attainment. A definition of what may constitute a literary work or invention or trade mark that is so precise, specific and rigid may not incentivise future presently unknown or unknowable areas of creativity activity. That is not what is advocated. A balance must be struck between reasonable certainty/predictability and flexibility. For example, if 17th century patent law had defined invention solely in terms of mechanical devices the huge swathe of chemical and biological based inventions would have been left out in the cold. A definition based on the principle of technical useful contributions (whilst not free of problems) would allow for greater flexibility whilst (arguably) maintaining reasonable certainty. A definition of invention that covers anything made by a human and which is economically useful is even more flexible but raises the important question—does patent law (property) really need to go so far?

Returning again to copyright, as long ago as 1908, the English Court of Appeal in an action concerning infringement of copyright in a dramatic work by copying of “scenic effects” and “stage business” commented that the copyright statute had created a monopoly and that “in such a case there must be certainty in the subject-matter of the monopoly in order to avoid injustice to the rest of the world”. These sentiments are well worth repeating in a world that has seen considerable strengthening of copyright law. Farewell L.J.’s observation that the trial judge had confused considerations proper to a passing off case in deciding the copyright question is also salutary.⁶⁵ Copyright is not a tort of passing off or unfair competition.⁶⁶ It is a statutory property right over original expression that is

use considerations may also be relevant depending on the use in question. Using the title to discuss and review the theory is one thing: what about calling a race horse: “Quasar” or General Relativity”?

⁶⁴ See generally *Designers Guild v. Russell Williams* [2000] 1 W.L.R. 2416 (H.L.) and Wei, *Law of Copyright in Singapore*, *supra* note 55 esp. at paras. 8.29 *et seq.* Problems of law and application can also arise in patent law and trademark law where the defendant’s invention or trademark is similar but not identical to the plaintiff’s invention or trademark. Not surprisingly, a considerable body of case law now exists on the principles informing the question: has the defendant taken/used enough to infringe the patent invention or trademark?

⁶⁵ *Tate v. Fullbrook* [1908] 1 K.B. 82 (Eng. C.A.). The need for certainty of subject-matter was also referred to the Privy Council in *Green v. Broadcasting Corporation of New Zealand* [1989] R.P.C. 700 at 702, *per* Lord Bridge: “the protection which copyright gives creates a monopoly and there must be certainty of subject-matter of such monopoly in order to avoid injustice to the rest of the world.” For this reason a claim to protect the dramatic format of a game show failed on the facts as lacking certainty. Given the absence of precise scripts of what the show contained it was probable that they did no more than to express a general idea or concept for a talent contest. This could not form the basis of a copyright claim.

⁶⁶ See the excellent article by Paul Sumpter, “Copyright in Slogans: Another Bald Spot Exposed” [2009] E.I.P.R. i. The discussion in this article on the recent New Zealand decision in *Sunlec*, *supra* note 50, owes much to the heads up provided by Sumpter’s opinion in the E.I.P.R. Sumpter himself concludes that

conferred because of the perceived public benefit in encouraging the creation of works of authorship.

Whilst space constraints do not permit a fuller discussion of the nature of copyright and the nature of unfair competition principles, it stands to reason that care is needed when deciding whether a property-based approach is always the best way to provide effective but reasonable protection for creative activity. For example, aside from titles and slogans discussed earlier, questions as to how best to protect format rights in dramatic works as well as the investment in databases have arisen. In the case of databases, accepting that there is a real need to offer sufficient protection for the effort and investment, three main approaches are available. The first will be to argue that databases can be treated as original literary works and that appropriation of the effort and labour (sweat of brow) suffices to infringe notwithstanding the expression/idea dichotomy. The second will be to create a new *sui generis* right directly protecting databases on a property basis (by way of analogy to copyright). The third will be to create a new *sui generis* right based on unfair competition principles rather than property. The European experience with its Database Directive (property) and the endless debates in the United States on a possible new right based on unfair competition principles well demonstrate the importance of the debate. Even if a property-based approach is felt to be needed, taking it out of copyright will at least enable the legislator to craft specific tailor-made provisions as to duration, scope, defences and licences, *etc.*

Similarly, given the vagueness of what amounts to the “format” of a play or other dramatic work under copyright law, would it not be better to craft a new *sui generis* right so that a more precise definition can be developed and protected under its own regime of checks and balances? In short, less tension will arise within copyright law and in particular in respect of the expression/idea (fact) dichotomy if new bespoke intellectual property rights were developed to cater for new valuable areas of intellectual and industrial activity where these lie at the *margins* of copyright law principles. Even more so if these areas may lie outside those margins.

Writing in 1991, Professor Vaver noting the oft-stated view that the copyright owner owns the intellectual works in the same sense as a landowner owns land concludes that we would do well to remember that:

copyright and patent laws are not just isolated and immutable pieces of legislation that like Topsy, just grow'd. They are part of our social and economic policy. To the extent that our society seeks some semblance of social justice, intellectual property laws, as an important and growing part of that vision cannot escape scrutiny.⁶⁷

the case illustrated the tendency for copyright to become that outlawed species—an unfair competition law.

⁶⁷ David Vaver, “Some Agnostic Observations on Intellectual Property” (1991) 6 I.P.J. 125 at 153. See also Reto Hilty, “Copyright Law and the Information Society—Neglected Adjustments and Their Consequences” (2007) 38 I.I.C. 135 that the time has come to appreciate what the balance of interest in copyright law really means. T.E. Deurvorst, “Slimming Down Copyright with Lon Fuller” [2009] E.I.P.R. 161, that expansion of intellectual property continues undiminished and that the time has come for “an extreme makeover” in line with the rules and legal philosophy of Fuller. Rule 4 is that legal rules need to be simple and comprehensible and the outcome of a dispute must be predictable. For an excellent discussion of problems arising from uncertainty in the scope of copyright, see Michael Spence, “Vagueness in the Scope of Copyright” (2005) 121 L.Q.R. 657. Spence argues that, while vagueness in

That scrutiny cannot and should not be concerned solely with the sole goal of expanding the range and scope of intellectual property rights. The scrutiny must include the overall balance between individual intellectual property rights as well as the balance of protection offered by any individual intellectual property right. In the case of patents, for example, there have been considerable debates over patents and public health issues as well as the problems of bio-piracy. In the area of copyright law, whilst there are ongoing discussions and disquiet (especially in the area of entertainment, music and the Internet) over the expansion of copyright, it is uncertain whether there will be any significant retreat or reshaping of protection in the immediate future.

The existence of disquiet is not to deny the very real problems that have been caused by large-scale piracy in both the real world and the virtual world. As indicated at the start, globalisation, free trade, developing consumerism, new copying technologies, the Internet have all made it much harder for IP right owners in general and copyright owners in particular to enforce their rights. In some areas, toughening up of remedies and enforcement procedures have been essential. These include statutory damages, criminal sanctions as well as improved discovery, search and seizure procedures. In other areas, it has been necessary to go beyond remedies and to add to or clarify the exclusive rights conferred on copyright subject-matter, such as the new technologically neutral right of communication to the public as well as provisions on liability (and protection) of network service providers. These and other measures were necessary for copyright to retain its role in incentivising creative activity. Clearly, commercial pirates who copy wholesale for consumer sale can and should expect no sympathy. Effective remedies and enforcement procedures are a necessary complement to the rights conferred. But that said, there will be areas within copyright law such as term duration, qualifications and exceptions especially in the field of education which merit re-appraisal.

It will also be important, and this is the main theme in this article, not to gloss over the question of the nature or scope of the subject-matter that is protected by copyright. A strong and healthy copyright and intellectual property system is built not just on the foundation of powerful exclusive rights backed up with powerful remedies and procedures. There is a real need to win the battle of hearts and minds and to persuade and demonstrate that a proper balance has been achieved between the various interests groups. Thus the point has been made earlier that in the case of copyright term extensions it is obvious that these will benefit the owners of the rights concerned. But is that the only relevant point? How does the public at large benefit from the unilateral alteration to the social bargain that lay behind the original, limited-term grant of copyright? Then again, as stated above, given the strength of the rights conferred on copyright subject-matter there should be a conscious and subconscious effort made to develop clearer principles governing broad sweeping assertions that the effort and labour of authorship and creation are to be protected. As Gummow, Hayne and Heydon JJ. in *Ice TV v. Nine Network* noted, there are real dangers in adopting the rhetoric of appropriation of skill and labour. It bears repeating that copyright legislation does not provide for any general doctrine of misappropriation

the scope of copyright protection is not itself a defect, vagueness calls for greater control by a clearer articulation of the purpose of the enquiry as to scope and of principles to guide the decision makers conducting it.

and does not protect skill and labour alone.⁶⁸ This being so, it follows that greater effort should be taken to identify with reasonable certainty the subject-matter of the work(s) in which copyright is said to subsist, as well as the application of the facts/expression (idea) dichotomy. Of course, a text book or compilation of data used to produce maps will enjoy copyright as species of literary work. But it is still important to ask the question: just what is it about that map or text book or compilation that is the concern of copyright law? After all, the expression/fact or idea dichotomy is often said to be an important tool to ensure that broader public interests in access to knowledge is not unreasonably fettered. If so, there needs to be a conscious effort to apply that principle in copyright disputes. Claimants should be required to identify with greater certainty just what those expressive elements are said to be; otherwise, the temptation to rely on broad unfair appropriation mantras may become irresistible. On the other hand, if the fear of unfair competition is to become the controlling copyright principle, then perhaps the time has come to revisit some of the proprietary characteristics of copyright such as liability for innocent honest sub-conscious copying.⁶⁹

⁶⁸ *Ice TV v. Nine Network*, *supra* note 26 at para. 131.

⁶⁹ Since the finalisation of this submission, my attention has been drawn to an illuminating article which readers may wish to refer to. Justine Pila, "Compilation Copyright: A Matter Calling for 'a Certain ... Sobriety'" (2008) 19 AIPJ 231. This article discusses the Full Federal Court's decision in *Ice TV* and argues that courts should resist the temptation to read copyright as a law of unfair competition or a law of natural property rights subsisting in products of labour and value. See also and compare the analysis by David Lindsay, "Copyright Protection of Broadcast Program Schedules: *Ice TV* Before the High Court" (2008) 19 AIPJ 196.