

WIPO-OECS/IP/JU/ROS/06/4

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ORGANIZATION OF EASTERN  
CARIBBEAN STATES



WORLD INTELLECTUAL  
PROPERTY ORGANIZATION

## **WIPO–OECS COLLOQUIUM FOR THE JUDICIARY ON THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS**


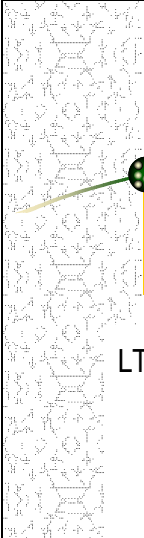

organized by  
the World Intellectual Property Organization (WIPO)  
in cooperation with  
the Organization of Eastern Caribbean States (OECS)  
through  
the Judicial Education Institute  
of the Eastern Caribbean Supreme Court

**Roseau, July 28 and 29, 2006**


**INFRINGEMENT OF COPYRIGHT – A DISCUSSION OF RECENT CASES**

*Document prepared by the Honorable Judge Louis T. C. Harms,  
Supreme Court of Appeal, Johannesburg, South Africa*





Slide 1



LTC Harms






Slide 2




- 'No man but a blockhead ever wrote, except for money.' (Samuel Johnson)
- Charles Dickens received nothing for his books published in the USA.
- Mozart was buried in a pauper's grave.

Slide 3



- The executor of the estate of the late Solomon Linda brought a claim of copyright infringement against Disney in the musical work 'Mbube' (Lion) from which the hit song 'The Lion Sleeps Tonight', was derived via 'Wimoweh'.
- Disney incorporated the song in the soundtrack of the movie 'The Lion King'.
- Song created in 1930s.
- Linda (died in 1962) received 10 shillings for the song.
- Case settled.

## Slide 4



## Balance


- *The Copyright Act* provides a balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect

AND

- obtaining a just reward for the creator (or, more accurately, to prevent someone other than the creator from appropriating whatever benefits may be generated).

*THEBERGE v  
GALERIE  
D'ART*

## Slide 5



## International obligations

- Berne Convention for the Protection of Literary and Artistic Works September 9, 1886.
- It has been the subject of a number of revisions .
- The Paris revision of July 24, 1971 is 'incorporated' by TRIPS.

## Slide 6



## Trips

- TRIPS agreement contains a number of provisions relating to copyright and related rights.
- Member countries of WTO are obliged to comply with the major provisions of Berne.
- Extends protection to computer programs and databases. (Also by WIPO Copyright Treaty.)

Slide 7



## Neighbouring/related rights

- Rights related to copyright are dealt with by other conventions than the Berne Convention.
- The Rome Convention secures protection for a period of 20 years in
  - performances of performers,
  - phonograms of producers of phonograms, and
  - broadcasts of broadcasting organizations.
- There are also other conventions.


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## Berne Convention: *National treatment.*

‘Under the international copyright conventions, the owners of copyright recognized under the legislation of a contracting State are entitled, in the territory of every other contracting State, to the same protection against the infringement of copyright, and the same remedies for such infringement, as the nationals of the latter State.’

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## Berne: *Automatic protection*

- Copyright protection may not be conditional upon compliance with any formality.
- This means that copyright protection may not be dependent on registration.

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independent



## Berne: *Independence of copyright*

- Copyright protection is independent of the existence of protection in the country of origin.
- If, however, a contracting state provides for a longer term than the minimum prescribed by the Convention and the work ceases to be protected in the country of origin, protection may be denied once protection in the country of origin ceases.

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## Territoriality

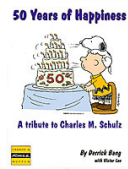
- Copyright law respects the territorial principle.
- Copyright is a creature of statute, and the rights and remedies provided by the *Copyright Act* are exhaustive.
- Copyright may be in different hands in different countries.

*Euro Excellence Inc. v. Kraft*  
*Canada Inc., 2005 FCA 427*

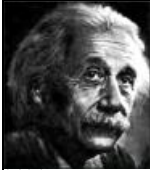
Slide 12

## Term of protection

- Minimum standards:
- Life plus 50 years.
- 50 years from authorised publication.
- 50 years from making.




Slide 13



## Ideas vs expression

- Copyright protection extends to expressions
- Not to ideas, procedures, methods of operation or mathematical concepts as such. (Trips.)
- Einstein:  $E=mc^2$

Slide 14




## Ideas

Copyright does not exist in:

- style;
- merely in news;
- history, historical incidents or facts;
- scientific principles or descriptions of an art.
- mere principles or schemes.
- methods of operation.
- general ideas, e.g. for entertainment.


Slide 15



## Ideas

- It is not a breach of copyright to borrow an idea, whether of an artistic, literary or musical nature, and to translate that idea into a new work.
- In 'altered copy' cases, the difficulty is the drawing of the line between what is a permissible borrowing of an idea and what is an impermissible piracy of the artistic, literary or musical creation of another.
- In drawing this line, the extent and nature of the similarities between the altered copy and the original work must play a critical and often determinative role.


Slide 16



## Author's rights

- The common law does not recognise the concept of an author's right to the same extent as does the civil law.
- Commercial interests are often more important than those of the author.

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## Moral rights

AMAR NATH SEHGAL v UNION OF INDIA  
2005 (30) PTC  
255 [India]

- Independently of the author's economic rights, and even after the transfer of the said rights, the author has
  - the right to claim authorship of the work and
  - to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the work,
  - which would be prejudicial to his honor or reputation.

Slide 18

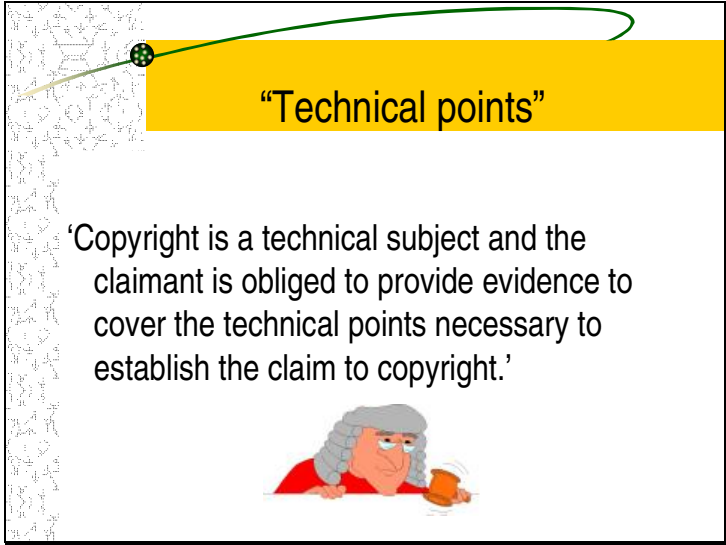


## Moral rights

THEBERGE v GALERIE D'ART DU PETIT CHAMPLAIN INC  
2002 SCC 34  
(Canada)


- The approach to moral rights differs between common-law and civil law jurisdiction. Generally speaking, the protection in civil law countries is more extensive.
- The important feature of moral rights in the common law statutes is that the integrity of the work is infringed only if the work is modified *to the prejudice of the honour or reputation of the author*.

Slide 19



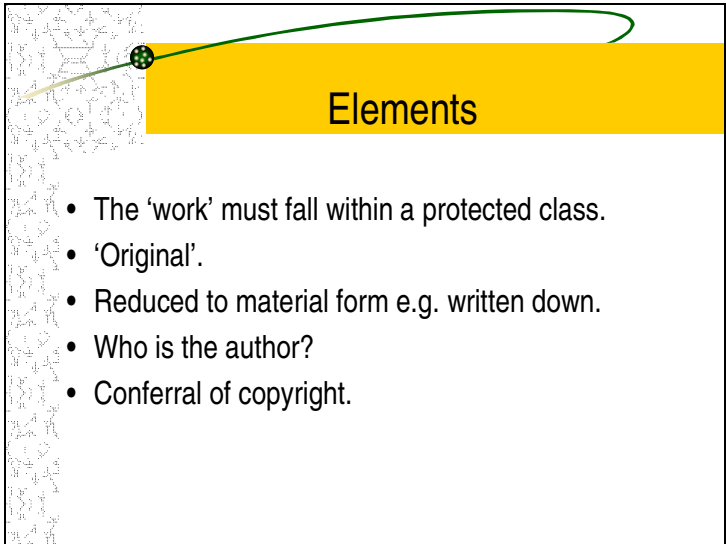
“Technical points”

‘Copyright is a technical subject and the claimant is obliged to provide evidence to cover the technical points necessary to establish the claim to copyright.’



Slide 19 features a yellow header with the text “Technical points”. Below the header, a quote states: ‘Copyright is a technical subject and the claimant is obliged to provide evidence to cover the technical points necessary to establish the claim to copyright.’ At the bottom center, there is a cartoon illustration of a judge with a grey wig, wearing a red robe, and holding a wooden gavel.

Slide 20

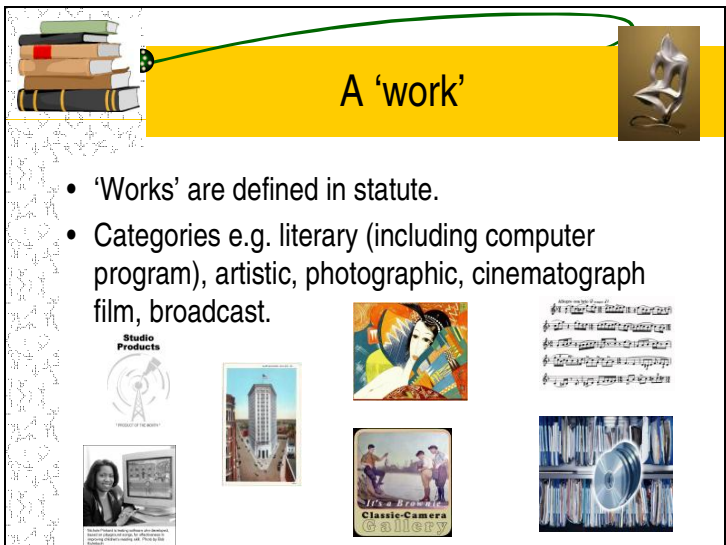


Elements

- The ‘work’ must fall within a protected class.
- ‘Original’.
- Reduced to material form e.g. written down.
- Who is the author?
- Conferral of copyright.

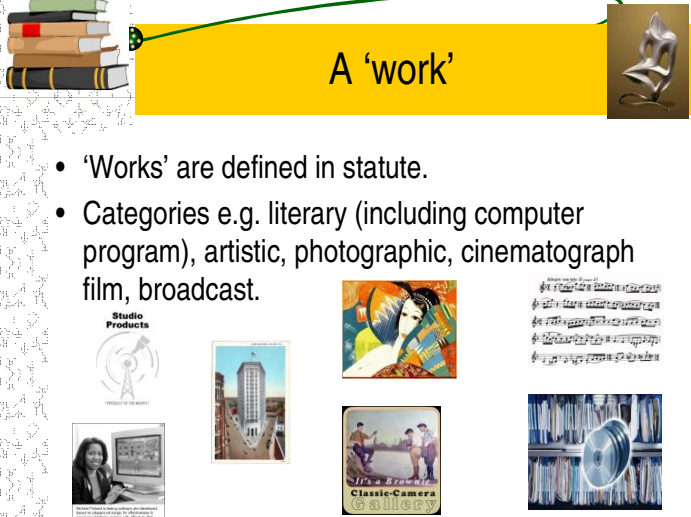
Slide 20 features a yellow header with the text “Elements”. Below the header, there is a bulleted list of five points: ‘The ‘work’ must fall within a protected class.’, ‘Original’, ‘Reduced to material form e.g. written down.’, ‘Who is the author?’, and ‘Conferral of copyright.’

Slide 21



A ‘work’

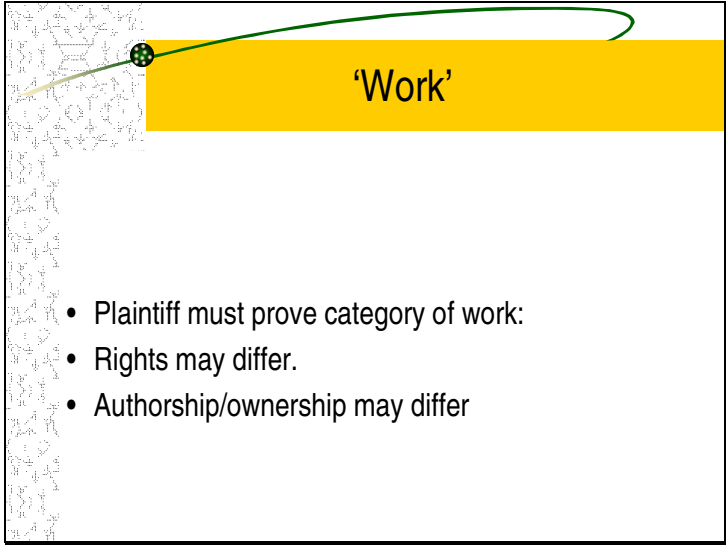
- ‘Works’ are defined in statute.
- Categories e.g. literary (including computer program), artistic, photographic, cinematograph film, broadcast.



Slide 21 features a yellow header with the text “A ‘work’”. Below the header, there is a bulleted list of two points: ‘Works’ are defined in statute. and Categories e.g. literary (including computer program), artistic, photographic, cinematograph film, broadcast. The slide is decorated with several small images: a stack of books, a white chair, a radio tower, a person at a computer, a tall building, a painting of a woman, musical notation, a classic camera gallery, and a CD/DVD.



Slide 22

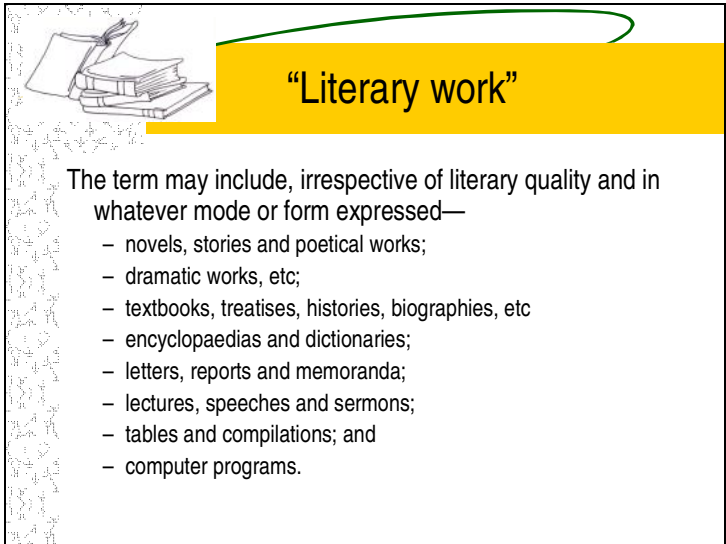


Slide 22 features a yellow header with the word 'Work' in black text. A green line with a circular endcap points from the top left to the word. The background of the slide is a light gray pattern of small, faint text. Below the header, there is a bulleted list of three items.

### 'Work'

- Plaintiff must prove category of work:
- Rights may differ.
- Authorship/ownership may differ

Slide 23



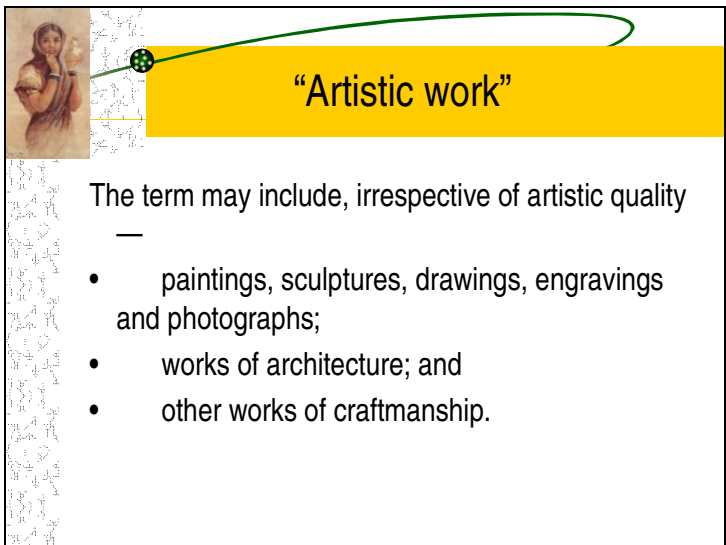
Slide 23 features a yellow header with the text 'Literary work' in black text. An illustration of a stack of books with one open on top is positioned to the left of the header. A green line with a circular endcap points from the top left to the text. The background of the slide is a light gray pattern of small, faint text. Below the header, there is a paragraph followed by a bulleted list of seven items.

### "Literary work"

The term may include, irrespective of literary quality and in whatever mode or form expressed—

- novels, stories and poetical works;
- dramatic works, etc;
- textbooks, treatises, histories, biographies, etc
- encyclopaedias and dictionaries;
- letters, reports and memoranda;
- lectures, speeches and sermons;
- tables and compilations; and
- computer programs.

Slide 24



Slide 24 features a yellow header with the text 'Artistic work' in black text. An illustration of a classical painting of a woman is positioned to the left of the header. A green line with a circular endcap points from the top left to the text. The background of the slide is a light gray pattern of small, faint text. Below the header, there is a paragraph followed by a bulleted list of three items.

### "Artistic work"

The term may include, irrespective of artistic quality —


- paintings, sculptures, drawings, engravings and photographs;
- works of architecture; and
- other works of craftsmanship.

Slide 25




## Bundle of rights

- One 'work' may contain more than one copyright work.
- A DVD for instance may contain
  - An artistic work on the cover.
  - A musical work: the music score.
  - A literary work: the text of the lyrics.
  - A sound recording.
  - A cinematograph film



Slide 26




## Originality: "Sweat of the brow".


- Typically, common-law jurisdictions that follow English precedents require a very low level of 'originality' and have reduced the requirement of originality to the question of whether the author has copied the work.
- 'The Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work, that it should originate from the author.'

*UNIVERSITY OF LONDON PRESS v UNIVERSITY TUTORIAL PRESS*

Slide 27



## Originality: USA



- Original means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. The requisite level of creativity is extremely low; even a slight amount will suffice.
- Originality does not signify novelty.
- A work may be original even though it closely resembles other works, so long as the similarity is fortuitous, not the result of copying.


*FEIST PUBLICATIONS INC v RURAL TEL SERVICE*

Slide 28


*CCH  
CANADIAN  
LTD v LAW  
SOCIETY OF  
UPPER  
CANADA*  
2004 SCC 13

## Originality: Canada

- For a work to be 'original', it must be more than a mere copy of another work.
- It need not be creative, in the sense of being novel or unique.



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## Originality: Canada

- What is required is an exercise of skill and judgment.
- Skill means the use of one's knowledge, developed aptitude or practised ability in producing the work.
- Judgment means the use of one's capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work.
- This exercise of skill and judgment will necessarily involve intellectual effort.

Slide 30

## Conferral of copyright: *Qualified persons*.

- Copyright is conferred on every work, eligible for copyright, of which the author is at the time the work is made a 'qualified person': locally domiciled, resident or incorporated.
- Applies to published and unpublished works.
- Citizens of a convention country or persons there domiciled or resident, and juristic persons there incorporated, are also regarded as 'qualified persons'.

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## Conferral of copyright

- *First publication.* If the work was not made by a qualified author, copyright will be conferred on it if the work was first published either locally or in a convention country.
- *State (crown) copyright.* Copyright is also conferred on a work made by or under the direction or control of the State. In such event the initial copyright vests in the State and not in the author.

Slide 32

## Infringement

- It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by the Act only the owner has the right to do.
- The owner of copyright has not the exclusive right to use or sell the work in which copyright subsists. The buyer of a book does not need the consent of the owner to read, or to re-sell, the book.
- The sale of a copy of a book is NOT a licence to do the acts comprised in the copyright.

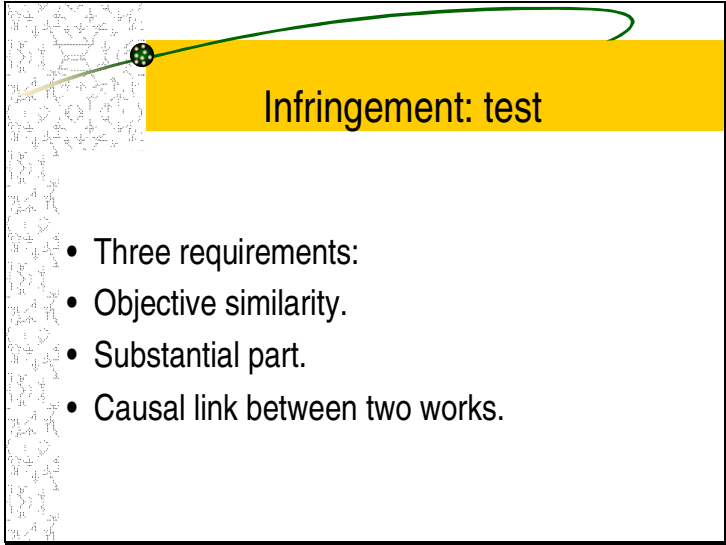
Slide 33

## Content of rights

Differs depending on nature of work. E.g. literary work:

- Reproducing the work in any manner or form;
- publishing the work if unpublished;
- performing the work in public;
- broadcasting the work;
- etc.

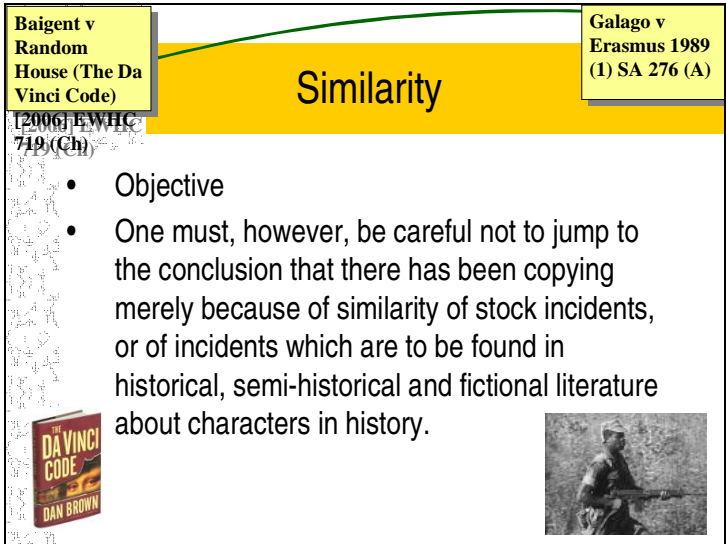
Slide 34



## Infringement: test

- Three requirements:
- Objective similarity.
- Substantial part.
- Causal link between two works.

Slide 35


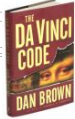


## Similarity


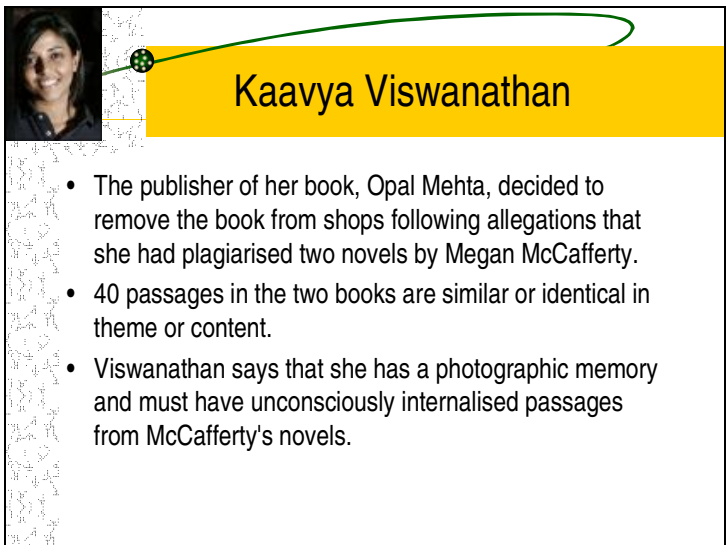
**Baigent v Random House (The Da Vinci Code)**  
[2006] EWHC 719 (Ch)

**Galago v Erasmus 1989**  
(1) SA 276 (A)

- Objective
- One must, however, be careful not to jump to the conclusion that there has been copying merely because of similarity of stock incidents, or of incidents which are to be found in historical, semi-historical and fictional literature about characters in history.



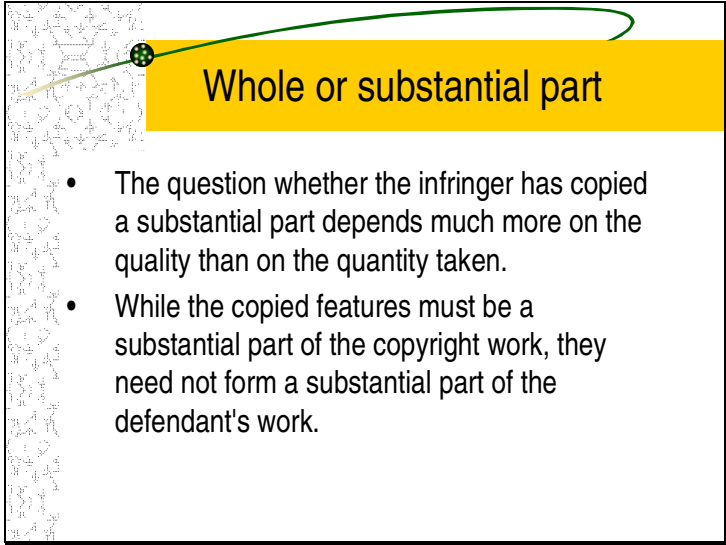
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## Kaavya Viswanathan

- The publisher of her book, Opal Mehta, decided to remove the book from shops following allegations that she had plagiarised two novels by Megan McCafferty.
- 40 passages in the two books are similar or identical in theme or content.
- Viswanathan says that she has a photographic memory and must have unconsciously internalised passages from McCafferty's novels.

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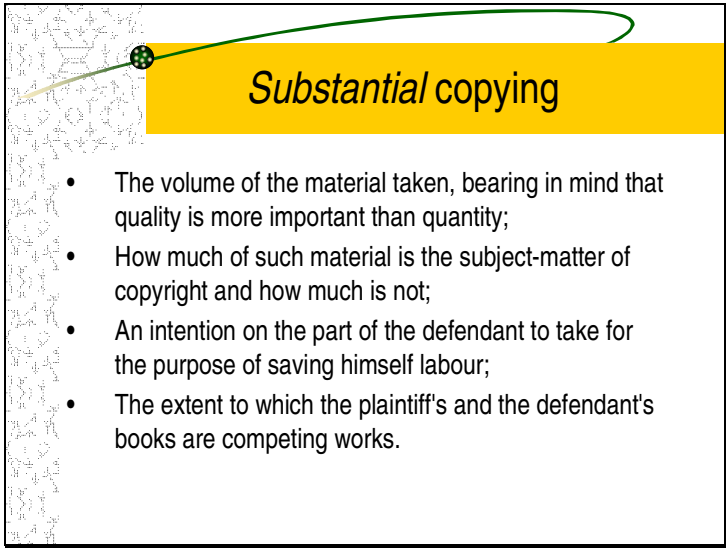


Slide 37 features a decorative background of faint icons on the left side. A yellow banner at the top contains the title "Whole or substantial part" in black text. Below the banner, there are two bullet points.

### Whole or substantial part

- The question whether the infringer has copied a substantial part depends much more on the quality than on the quantity taken.
- While the copied features must be a substantial part of the copyright work, they need not form a substantial part of the defendant's work.

Slide 38

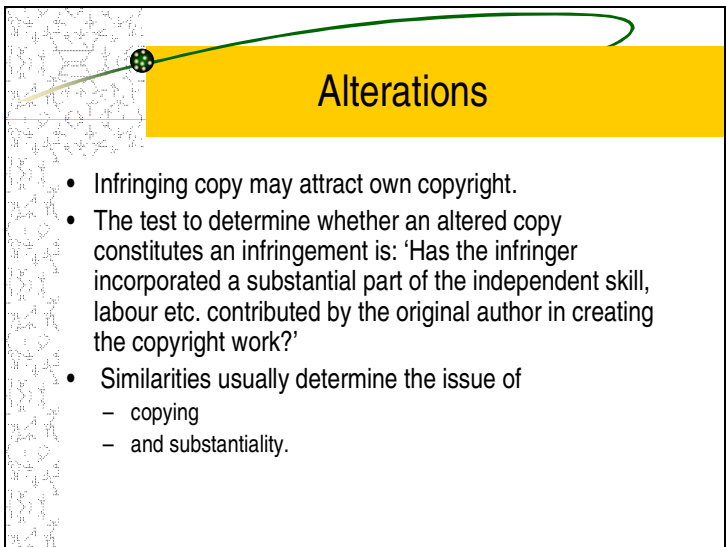


Slide 38 features a decorative background of faint icons on the left side. A yellow banner at the top contains the title "Substantial copying" in black text. Below the banner, there are four bullet points.

### Substantial copying

- The volume of the material taken, bearing in mind that quality is more important than quantity;
- How much of such material is the subject-matter of copyright and how much is not;
- An intention on the part of the defendant to take for the purpose of saving himself labour;
- The extent to which the plaintiff's and the defendant's books are competing works.

Slide 39



Slide 39 features a decorative background of faint icons on the left side. A yellow banner at the top contains the title "Alterations" in black text. Below the banner, there are three bullet points, with the last one having two sub-bullets.

### Alterations

- Infringing copy may attract own copyright.
- The test to determine whether an altered copy constitutes an infringement is: 'Has the infringer incorporated a substantial part of the independent skill, labour etc. contributed by the original author in creating the copyright work?'
- Similarities usually determine the issue of
  - copying
  - and substantiality.


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*Jacana Education (Pty) Ltd v Fransden Publishers (Pty) Ltd* (1998) 1 All SA 123 (SCA)

## Causal link

- Similarity gives rise to inference of link.

– Map.




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## Secondary/indirect infringement

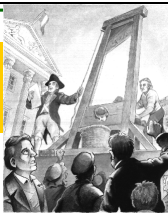
Three elements :

- a primary infringement of copyright;
- the secondary infringer knew or should have known that he was dealing with a product of infringement; and
- the infringer did something listed in the Act e.g. Importing, Selling, Distributing.

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## Piracy



- Criminal act
- Copies
- made without consent of right holder in country of production and
- made directly or indirectly from an article
- where the making of that copy would have constituted an infringement of a copyright
- or a related right
- under the law of the country of importation.

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**Fair dealing**

The Berne 'fair dealing' exceptions apply if:

- Special case. 'Special' means a justification by some clear reason of public policy or some other exceptional circumstance;
- No conflict with normal exploitation; and
- No unreasonable prejudice.

*Commercial exploitation is not fair dealing .*


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**Fair dealing**

- The requirements are cumulative and are to be applied one after another.
- Must be defined in national legislation.
- The test is objective.
- It is a matter of fact, degree and impression.
- Only possible in relation to works that have been made available to the public in a lawful manner.

Slide 45



**Examples**

- *Research or private study*
- *Criticism and review*
- *Incidental inclusions and quotations.*



Slide 46



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