

Intellectual Property Law (6th edn)

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### Abstract

This chapter considers the question of what amounts to copyright infringement, first by differentiating between ‘primary’ infringement and ‘secondary’ infringement. It then explains the three criteria used to determine whether copyright in a work has been infringed: whether the defendant carried out one of the activities that falls within the copyright owner’s rights; whether there is a causal link between the work used (that is, reproduced, issued, rented, performed, communicated, or adapted) by the defendant and the copyright work; and whether the restricted act has been committed in relation to the work or a substantial part thereof. It also looks at the European approach to finding infringement (following the *Infopaq* decision) and compares it with the British approach before concluding with a description of non-literal copying of such works.

**Keywords:** copyright, copyright infringement, primary infringement, derivation, substantial part, any part, *Infopaq*, non-literal copying, idea-expression dichotomy, secondary infringement

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### 1 Introduction

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This chapter examines when copyright is infringed. We begin by discussing ‘primary’ infringement—that is, the activities of those involved in infringing the copyright owner’s exclusive rights (which we described in Chapter 6). We then discuss the statutory provisions that render accessories—whether before or after the act of primary infringement—liable for assisting in the making or distribution of infringing copies or the giving of infringing performances. These liabilities are referred to as ‘secondary infringements’.

Before examining ‘primary’ infringement in detail, it is worth observing that, while there has been a great deal of norm-setting in relation to the rights of the copyright owner, the question of what amounts to copyright infringement has not generally been the subject of international attention and has only recently been regarded as a matter that has been the subject of regional harmonization. The relevant tests for infringement have largely been developed locally and, for the most part, by the judiciary. Having acknowledged that British law on infringement has taken its own course, it is worth noting two developments. First, the rule that copyright does not protect ideas has found its way into both regional and international arrangements, and has been interpreted as establishing an outer limit to the scope of protection that any state may grant through copyright.<sup>1</sup> Second, EU law requires that copyright infringement be found to occur where ‘any part’—as opposed to any ‘substantial part’—of a work is reproduced.<sup>2</sup> The concept of ‘part’ has now been interpreted by the CJEU, in relation to both authorial works and sound recordings, and this case law has transformed the fundamental principles by which infringement is analysed.<sup>3</sup> While it should be anticipated that the Court of Justice will continue to elaborate further what is currently rather embryonic guidance on infringement of copyright under the various directives, given the United Kingdom’s departure from the EU it is difficult to predict how far such rulings will be regarded as relevant.

p. 211 **2 Primary Infringement**

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In an action for primary infringement, the onus falls upon the claimant to show on the balance of probabilities that:

- (i) the defendant carried out one of the activities that falls within the copyright owner’s control;
- (ii) the defendant’s work was *derived* from the copyright work (a ‘causal connection’); and
- (iii) the restricted act was carried out in relation to the *work* or a *substantial part* thereof.<sup>4</sup>

### 2.1 Restricted Activities

The first question that needs to be asked in considering whether copyright in a work has been infringed is whether the defendant carried out one of the activities that falls within the copyright owner’s rights. This topic was discussed in Chapter 6.

### 2.2 A ‘Causal Connection’

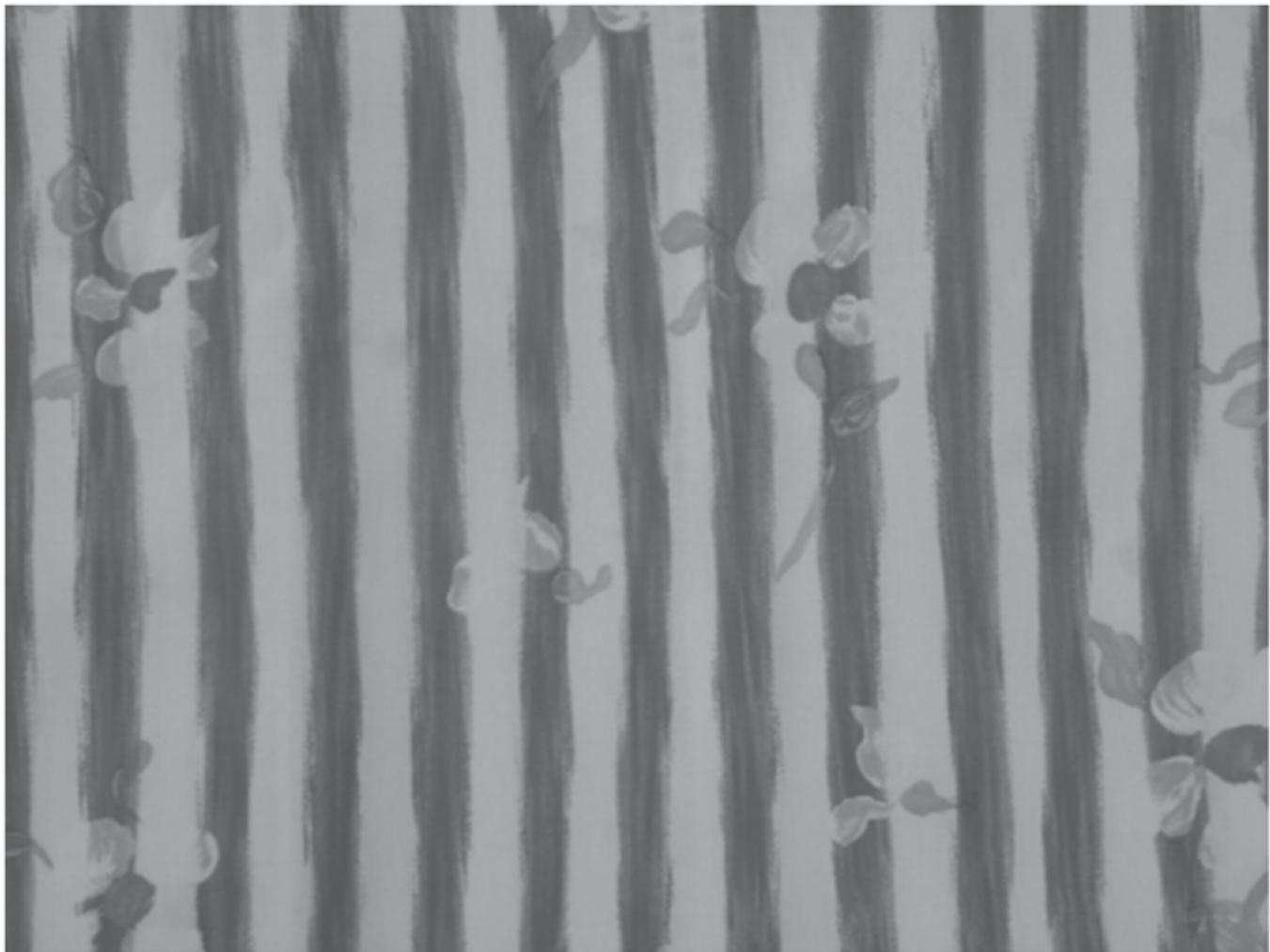
The second matter that needs to be proved in order to establish infringement is that the defendant’s work was *derived* from the claimant’s work<sup>5</sup>—that is, it is necessary to show that there is a causal link between the work used (that is, reproduced, issued, rented, performed, communicated, or adapted) by the defendant and the copyright work. This means that, unlike patent law, copyright law does not protect a copyright owner against independent creation. It is important to note that it is not necessary for the defendant’s work to be derived directly from the original of the work;<sup>6</sup> it is possible for a defendant to infringe where they base their work on a copy of the work. It is also important to note that it does not matter if the intermediate

reproduction is itself a legitimate or a pirated copy.<sup>7</sup> This means, for example, that where a person photographs a three-dimensional object (such as a sculpture), they may infringe the copyright in the drawings on which the sculpture was based, even though they have never seen those drawings.<sup>8</sup>

Whether a defendant's material was derived from a claimant's copyright work is a matter of fact, and it is for the claimant to persuade the tribunal that this has occurred.<sup>9</sup> In order to do so, the claimant may use several forms of evidence. First, and most convincing, is direct evidence that the defendant utilized the claimant's work in producing their own. For example, an ex-employee may be able to give evidence that they were asked by their employer to produce something similar to the claimant's work, or a third party ↗ may have witnessed the appropriation. Indeed, a defendant may, in some circumstances, admit that they drew upon the claimant's work.<sup>10</sup>

However, such direct evidence is often unavailable.<sup>11</sup> In these circumstances, the courts have sometimes been willing to infer derivation.<sup>12</sup> In order to persuade a court to infer copying, a claimant will typically rely on similarities between the works, coupled with evidence that the defendant had access and opportunity to copy the copyright work. A court is likely to accept that there is a causal connection between the two works if the similarities are very numerous, or so individual,<sup>13</sup> that the possibility of their having been independently conceived by the defendant is remote.<sup>14</sup> Even if the shared elements are less individual or numerous, an inference of derivation may be drawn where a claimant can positively demonstrate the defendant's familiarity with the copyright work.<sup>15</sup> Where such an inference of copying has been established by a claimant, the onus then shifts onto the defendant to prove that they created the work independently.<sup>16</sup> In order to do so, a defendant may claim that the similarities between the two works can be explained by factors other than copying. For example, a defendant may attempt to show that the similarities are attributable to the fact that the two works were inspired by the same source,<sup>17</sup> to the fact that both works were constrained by the functions that they perform,<sup>18</sup> or, less plausibly, to chance.<sup>19</sup> Such claims are likely to be undermined by evidence that the defendant has been engaged in similar acts of copying on previous occasions.

This process of inference can be well illustrated by the House of Lords' decision in *Designers Guild v. Russell Williams*.<sup>20</sup> The claimant had produced its fabric design, named 'Ixia', in 1994. The design was impressionistic in style, made up of roughly drawn pink and yellow stripes, with flowers scattered haphazardly across them (see Fig. 8.1).



**Fig. 8.1** The claimant's 'Ixia' design, created by Helen Burke

Source: Designer's Guild

The fabric was made available in shops from September 1995. A year later, the claimant discovered that the defendant was selling fabric with a design called 'Marguerite', also based on vertical stripes in alternating colours, with flowers and associated stalks and leaves scattered across the stripes (see Fig. 8.2).

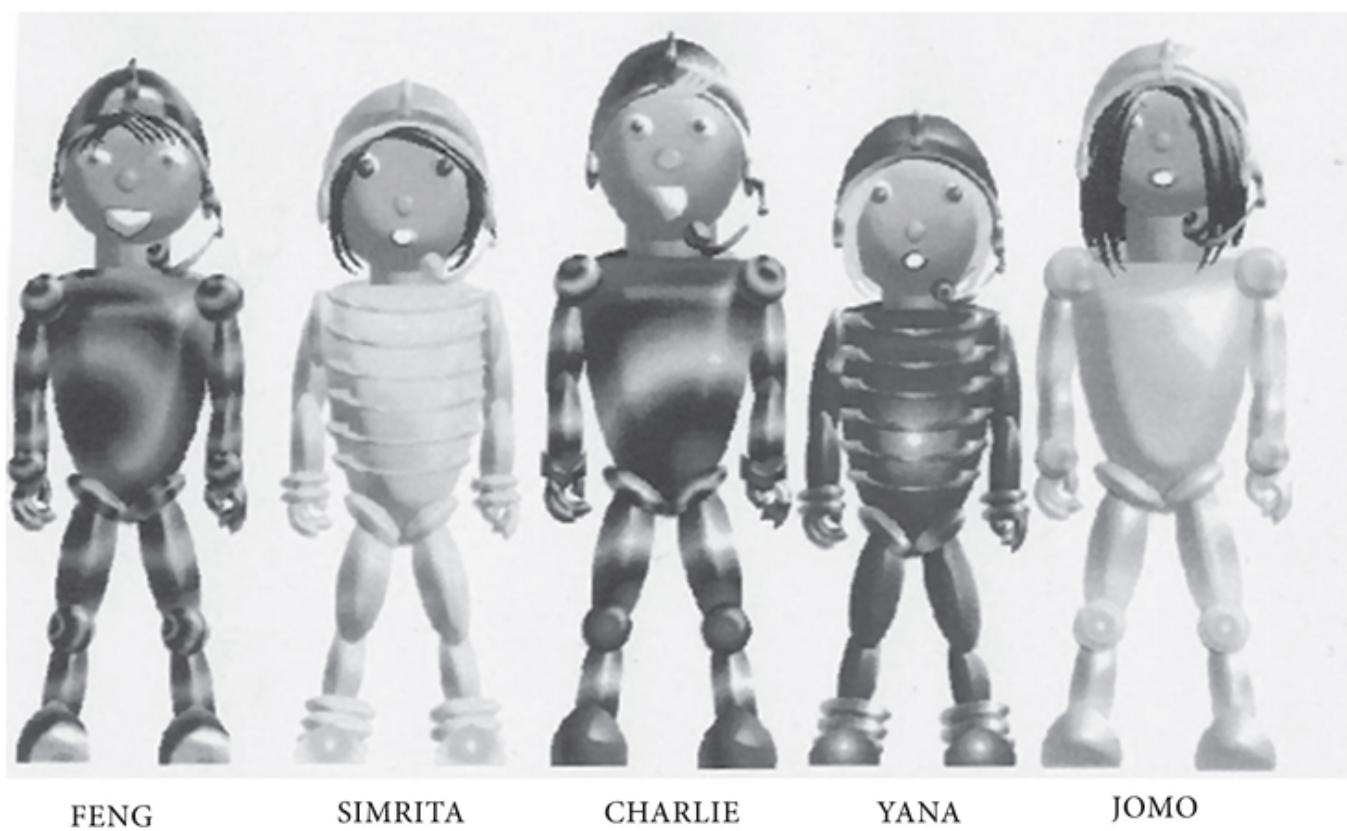


**Fig. 8.2** The defendant's 'Marguerite' design, created by Jane Ibbotson

Source: Designer's Guild

There were, however, several differences between the two designs, and the defendant denied that 'Marguerite' had been copied from 'Ixia', asserting that its designer had developed it from her own 'Cherry Blossom' design. Nevertheless, Judge Lawrence Collins QC inferred from the evidence that 'Marguerite' in fact had been derived from 'Ixia',<sup>21</sup> a finding that the House of Lords affirmed. First, the Judge found that there were seven similarities between the two designs:<sup>22</sup> both designs were based on stripes with scattered flowers; both were in an impressionistic style, showing brushwork; in both, the stripes had rough edges; in both, the petals were executed in a similar way; in both, the stripes showed through some of the petals; in each, the flower heads comprised a 'strong blob'; and in each, the leaves were in two shades of green. The Judge concluded that these similarities went 'far beyond the similarities which would be expected simply from both being based on an impressionistic style or from both being based on a combination of stripes and scattered flowers and leaves'.<sup>23</sup> Second, the Judge found that the designer of 'Marguerite' had had an opportunity to copy 'Ixia', since she was at a trade fair in 1995 at which the 'Ixia' design was exhibited. Third, the Judge rejected the defendant's own account of how she came to produce the 'Marguerite' design, finding her story unconvincing. Consequently, he found that the defendant's design was derived from the claimant's.

*Designers Guild* can be contrasted with *Mitchell v. BBC*,<sup>24</sup> in which a claim that the defendant's television cartoon had copied the claimant's characters (as artistic works) was rejected. The claimant's characters, named 'The Bounce Bunch', were a group of five student eco-rangers (see Fig. 8.3). The claimant had sent details to the defendant, who later produced their own cartoon characters, a group involved in a futuristic race, known as 'Kerwhizz' (see Fig. 8.4), which the claimant argued were so similar as to give rise to an inference of copying.



**Fig. 8.3** The Bounce Bunch

Source: Mr Mike Mitchell



**Fig. 8.4** Kerwhizz

Source: *Mitchell v. BBC* [2011] EWPCC 42

Judge Birss QC, sitting in what was then the Patents County Court (now known as the IPEC), rejected the claim. Although he found that there were sufficient similarities between the characters—namely, the characters' attire (a form of armour with helmets and microphones), the colour scheme used, and the characters' ethnic mixture, as well as the blonde quiff of the blue character (Charlie/Twist)—to place the onus on the BBC to prove independent creation, the BBC was able to do so. Evidence from the creators of Kerwhizz established that they had begun work (in 2006) before *The Bounce Bunch* were accessible (they were on Mitchell's website from 2007) and had already developed a series of characters that wore racing gear, with microphones attached to their helmets. While the design of some of the other features, such as chunky body armour and geometric shapes, had been added after '*The Bounce Bunch*' was accessible, they were explained as having been inspired by shared sources—that is, Japanese anime and manga characters. The Court also heard evidence that made it highly unlikely that the design team for Kerwhizz had seen Mitchell's proposal for *The Bounce Bunch*.

One factor that has been useful in proving derivation is the fact that the infringing work contains the same mistakes that occur in the original work. In these circumstances, it is assumed that the reason why the same mistakes appear in the two works is that they are copies of each other. If works involve low levels of innate individuality, in order to assist in the task of proving derivation, copyright owners sometimes place incorrect or meaningless information in their works. Where this incorrect or meaningless information appears in a defendant's work, it is very difficult for them to argue that they created the work independently of the copyright work.<sup>25</sup>

In most cases, the process of copying will be a conscious act. In some cases, however, the courts have been willing to accept that the process of derivation may occur at a subconscious level.<sup>26</sup> While a defendant may honestly not recall having seen or heard the copyright work, the courts seem open to the argument that the defendant subconsciously copied from the copyright work. This is particularly the case in relation to songs, where catchy—annoying even—tunes embed themselves in the subconscious. The acceptance of subconscious copying provides the courts with a way of reconciling the implausibility of independent creation with the conflicting evidence of a defendant who claims that they cannot remember having any contact with the work.<sup>27</sup> As with drawing inferences of deliberate copying, the court will consider the degree of familiarity that the defendant had with the claimant's work, the character of the work, and the degree of objective similarity between them.<sup>28</sup> However, it is worth noting that there is an important distinction between evidence that leads to a shift in the onus of proof and evidence that established a case of subconscious copying. As Judge Birss QC explained in *Mitchell v. BBC*,<sup>29</sup> while similarity combined with access may shift the onus of proof on to the defendant, the notion of subconscious copying is not concerned with the onus of proof but depends 'on the evidence as a whole'. After all, the only way in which to rebut an inference of subconscious copying would be to demonstrate that it is impossible for the defendant to have ever come across the claimant's work, whether directly or indirectly. Consequently, the evidence that would be necessary to support an inference of subconscious copying is likely to be a good deal more substantial than the evidence needed simply to shift the onus onto a defendant in a copyright case. Even though, as noted earlier, Judge Birss found sufficient similarities between *The Bounce Bunch* (Fig. 8.3) and Kerwhizz (Fig. 8.4)

to shift the onus onto the BBC, that was a long way from requiring a conclusion that there had been subconscious copying. Having found no evidence of familiarity on the part of the designers of Kerwhizz with The Bounce Bunch, given that The Bounce Bunch characters were simple, generic, and unmemorable,<sup>30</sup> and that the similarities were at a rather abstract conceptual level that could readily be explained by reference to common influences, the Judge concluded that the two sets of characters were a result of independent creative work and thus rejected the claim that there had been subconscious copying.

### 2.3 Whole Work or a (Substantial) Part Thereof?

The third and final question that needs to be asked in an infringement action is whether the restricted act has been carried out in relation to the *work* or a *substantial part* thereof. Identical copying (that is, copying the totality of the claimant's work in an identical form—sometimes referred to as 'piracy') raises no analytical problems and thus, in the absence of an exception (on which, see Chapter 9), a finding of infringement follows inevitably. Copyright law, however, has long recognized that protection ought not to be limited to situations in which the defendant makes an exact copy of the work. One reason for this is that if copyright protection were limited to situations in which identical copies of the work are used, plagiarists would be able to escape infringement simply by making minor variations to the copied work.<sup>31</sup> Since 1911, UK copyright law has therefore provided protection not only where the whole work has been copied, but also where a defendant has used a substantial part of the protected aspects of the work.<sup>32</sup> In extending protection from identical copying to copying of 'any substantial part' of a work, the law enables a copyright owner to control situations in which a defendant takes *part of a work* (such as where half of a book is photocopied or a sample of a sound recording is copied) ↗ and those in which the defendant *changes the form of the work* (such as where a play is converted into a film).<sup>33</sup> This move from protecting only against identical copying to also protecting partial copies or copies of the substance of a work has inevitably required the courts to make difficult value judgements.

p. 217 It is in relation to the question of partial (and non-literal) copying that we face difficult questions as to the state of British law in the light of European harmonization (see Table 8.1). In particular, it had become clear prior to the United Kingdom's final departure from the EU that there is a European test for assessing infringement of the reproduction right for authorial works protected under the Information Society Directive: the question is whether the defendant has reproduced 'a part' of the work that shares in the originality thereof (understood as being its author's own intellectual creation). There are, as yet, only a few cases applying the latter standard, which may—or may not—turn out to produce different results from those that would arise under the British test. At present, it appears that some of the flexibility—some might say incoherence—inherent in the British approach may have been lost. In order to understand the current state of affairs, we deal initially with cases in which there has been an act in relation to a discrete part of the protected work (as opposed to the situation in which there has been 'non-literal' copying).<sup>34</sup> With regard to acts in relation to discrete parts, we consider in turn:

- (i) the traditional British position in relation to what counts as a substantial taking of a literary, dramatic, musical, or artistic works (which remains relevant at the very least to the unharmonized right of public performance and adaptation);<sup>35</sup>
- (ii) ↗ the retained European law as to what counts as 'a part' of such an authorial work; and

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- (iii) the retained European law as to what counts as a part of a film, sound recording, broadcast;
- (iv) the traditional UK law as to what constitutes a ‘substantial part’ of a typographical arrangement (a work/related right that was never harmonized).

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**Table 8.1 How traditional UK law and retained EU law govern the definition of partial copying**

	<b>Authorial works</b>	<b>Computer Programs</b>	<b>Databases</b>	<b>Sound recordings</b>	<b>Films (fixations)</b>	<b>Broadcasts</b>	<b>Typographical Arrangements</b>
Reproduction	EU test ( <i>Infopaq</i> )			EU test ( <i>Hütter v. Pelham</i> )			UK substantial part test
Distribution	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	EU substantial part test ( <i>Hütter</i> )	EU test	EU test	UK substantial part test
Communication	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	EU test	EU test	EU test	N/A
Performance	UK substantial part test	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	EU test	EU test	EU test	N/A
Adaptation	UK substantial part test	EU test (probably <i>Infopaq</i> )	EU test (probably <i>Infopaq</i> )	N/A	N/A	N/A	N/A

### 2.3.1 The ‘British’ approach to authorial works

The ‘British’ approach (by which we mean the approach that had been developed prior to harmonization) was set out by Lord Millett in *Designers Guild*:

Once the judge has found that the defendants’ design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendants’ work ... The pirated part is considered on its own ... and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose.<sup>36</sup>

In principle, in order to answer this question, it is necessary to ask two subsidiary questions, as follows:

- (i) What is the claimant’s work?
- (ii) Has the defendant utilized the whole of the claimant’s work or a substantial part thereof?

#### **(i) What is the work for the purposes of infringement?**

Logically, the first task that arises when determining whether the defendant has utilized the whole or a substantial part of the copyright work is ascertaining the limits of the copyright work. To determine what the work is, it is necessary first to determine the parameters of the work and then to distinguish the protected from non-protected elements of the work. We will deal with each of these in turn.<sup>37</sup>

**(a) The parameters of the work** In many situations, the parameters of the work will not be in dispute. However, where a work is divisible into smaller elements, the question may arise as to whether the ‘parts’ should be treated as separate and distinct works. If we take the case of a book, for example, while it is clear that the book as a whole is a copyright work, what of the chapters, pages, paragraphs, sentences, or words that are included in the book? The decision as to the size of the copyright work may have an important bearing on the outcome of an infringement action. The reason for this is that the question of whether something is ‘the whole or a substantial part’ of something else depends on what it is being judged against. In this case, that something else is the copyright work.

The question of how the parameters of the work are to be determined was considered by Judge Laddie QC in *Hyperion Records v. Warner Music*.<sup>38</sup> This was an application for a summary judgment brought by Hyperion Records, which owned copyright in a sound recording of the medieval chant, ‘O Euchari’. The chant, which was 5 minutes 18 seconds long, appeared on the album *A Feather on the Breath of God*. Hyperion Records alleged that its copyright had been infringed when the electro-pop band, The Beloved, copied (or sampled) eight notes from ‘O Euchari’ and incorporated them into its record ‘Happiness’.

While it was clear that the song ‘O Euchari’ was a work, Hyperion Records argued that the eight notes sampled by The Beloved also formed a distinct copyright work in their own right. If this were accepted, it would clearly have been an infringement, because 100 per cent of the ‘work’ would have been taken. Judge Laddie QC rejected the argument, saying: ‘I do not accept that all copyright works can be considered as a package of copyright works, consisting of the copyright in the whole and an infinite number of subdivisions of it.’<sup>39</sup> He added that ‘if the copyright owner is entitled to redefine his copyright work so as to match the size of the alleged infringement, there would never be a requirement for substantiality’.<sup>40</sup> More specifically, Judge Laddie did not accept that it was legitimate ‘to arbitrarily cut out of a large work that portion which has been allegedly copied and then to call that the copyright work’.<sup>41</sup> The eight notes sampled by The Beloved were not a work in their own right, because a work has a discrete, natural, or non-artificial shape. Thus a day’s footage on a film that is ‘a discrete product of the film-maker’s art’ may be treated as a distinct work. Presumably, the results of a recording session, as distinct from the final product, would also attract separate copyright protection.

Judge Laddie’s judgment provides us with some useful assistance in undertaking the (much neglected) task of defining the parameters of the work. In addition to focusing on whether a particular item can be seen as ‘natural’ or ‘non-artificial’, it seems that other relevant considerations would include the intention of the creator, the level of interdependence or independence of the units concerned, and the commercial form in which the work is to be published or made available. Given that one consequence of recognizing small units as discrete copyright works is potentially to increase the level of protection, a useful starting point should be that, where a work has been published, the form in which the work is first issued is presumed to determine the parameters of the work.

**(b) Distinguishing the protected parts from the non-protected parts** Once the ‘work’ has been identified, the question arises as to what aspects of the work are protected. In most cases, there will be certain parts of a work that are not protected (which form part of what is sometimes called the ‘public domain’). When deciding whether a copyright work has been infringed, copyright law is concerned only with the protected parts of the work—that is, those that are original.<sup>42</sup>

A person will infringe only if they appropriate a part of the work that is original.<sup>43</sup> This means that the copying of an unoriginal part of the work is not an infringement.<sup>44</sup> As an example, we might consider the situation if a person were to compile a list of the names of Arsenal supporters living in Australia. If the originality of the compilation were to lie in the way in which the information was arranged, third parties would not be able to make use of that arrangement. They would, however, be able to make use of the information (if, for example, they were to scramble the list). Alternatively, if the originality of the compilation were to stem from the selection of the material (but not its arrangement), third parties would not be able to make use of the information (although they would not be prevented from independently compiling the list themselves).

A great deal of care needs to be taken when distinguishing between original and non-original aspects of a work. Although, in some situations, the work as a whole can be dissected and non-original aspects ignored for the purposes of the infringement analysis, such ‘dissection’ carries with it a potential danger. This danger arises from the fact that originality can be provided not merely from labour and skill (or, in European parlance, the ‘creative choices’) in the creation of new, original, material, but also from the collation or

collection of existing, non-original, material. A process of dissection can cause a tribunal to overlook the creativity involved in such collation or arrangement. In other words, dissection may cause a tribunal to treat the whole incorrectly as merely the sum of its parts. However, if a defendant takes a number of elements from the claimant's work, each of which might individually be non-original, there may well nevertheless be a taking of a substantial part of the labour and skill (or intellectual creativity) involved in collating the material.<sup>45</sup>

### (ii) Has the defendant taken the whole or a substantial part of the copyright work?

Once the protected elements of the work have been identified, it is then possible to consider what the defendant has taken from the copyright work and to ask whether the defendant has used the whole or a substantial part of the claimant's work.<sup>46</sup>

The term 'substantial' is one with a 'wide range of meanings' and the courts have preferred those at the lower end of the range.<sup>47</sup> This is not the place for a historical review of the case law, but it can be said that there has been a discernible shift towards allowing a copyright owner to control ever-smaller uses and reuses of their works. In the not-too-distant past, the courts often took the view that a person would infringe only where the part taken was an essential, vital, or important part of the work.<sup>48</sup> In recent years, however, tribunals have been willing to find infringement as long as the defendant's use is not of an 'insignificant' part or *de minimis*.<sup>49</sup>

Although the answer to the question of whether a restricted act has been carried out in relation to a 'substantial part' of a work always depends on the facts of the case, in essence the fate of a defendant depends on the relative *importance* of the part that is taken.<sup>50</sup>

p. 221 ↵ It is for the court to decide whether the part taken is important.<sup>51</sup> Although the focus of the tribunal should be on whether the part taken was important to the copyright work, in reaching a determination a court will inevitably be influenced by the surrounding circumstances, including: the way in which the claimant's work was created; the nature of the work, for example whether it is a work of information or fiction; the relationship between the parties, in particular whether they are in competition; the conduct of the parties, in particular whether the defendant has copied merely to save itself effort; the reason why the part was taken, for example whether it has been used for the purposes of parody; and whether the use is degrading.<sup>52</sup>

(a) *Importance to claimant's work* The importance of the part taken is judged in terms of its importance to the copyright work and not the defendant's work.<sup>53</sup> The reason for this is that the test imposed by the statute is whether the part used by the defendant is a substantial part of the *claimant's* copyright work, not whether it is a substantial part of the *defendant's* work.<sup>54</sup> This has two consequences. First, it means that it does not matter that the part taken forms an unimportant part of the defendant's work, nor that the defendant has expended considerable labour, skill, and effort themselves. The contributions of the defendant in transforming a copyright work have been regarded as largely irrelevant, the courts preferring merely to attend to what the defendant has taken. Translations and abridgements, however valuable, have for more than a century been regarded as infringements.<sup>55</sup> Equally, in the case of copying elements of an artistic work (as with that of 'Ixia' by 'Marguerite' in *Designer's Guild*<sup>56</sup>—see Figs 8.1 and 8.2), it is a matter of no relevance to a finding of

substantial taking that the defendant's work gives off an overall different impression from that of the claimant. For the same reason, (most) parodic uses of copyright works are regarded as infringements, irrespective of the parodist's skill or the social value accorded to parody.<sup>57</sup> The second consequence of focusing on whether the part is important to the claimant's work is that if it is not, then, in principle, it does not matter whether the part is used repeatedly in the defendant's work (as often happens with the digital sampling of musical works).

**(b) Substantiality: a qualitative criterion** While the use of the term 'substantial' suggests that importance should be judged in terms of the amount taken, the inquiry is as much concerned with the *quality* as the *quantity* of the part taken.<sup>58</sup> Indeed, in two significant decisions, Lord Hoffmann went further, saying that the question of substantiality is a matter of quality *rather than* quantity.<sup>59</sup> So long as a part is qualitatively an important part of the work as a whole, even a very small part of a work may be a substantial part.

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**(c) Assessing quality** To say that the issue is one of quality leaves open how quality is to be determined. In *The Newspaper Licensing Agency v. Marks and Spencer*, Lord Hoffmann provided some guidance when he stated that the qualitatively important parts of a work were to be identified 'by reference to the reason why the work is given copyright protection'.<sup>60</sup> He explained that, in the case of literary copyright, copyright is conferred (irrespective of literary merit) upon an original literary work, and it followed that the quality relevant for the purposes of substantiality is the 'literary originality' of that which has been copied.<sup>61</sup> In the case of an artistic work, Lord Hoffmann said, it is the 'artistic originality' of that which has been copied—which primarily relates to the visual significance of what has been copied.<sup>62</sup> However, it is not always easy to determine exactly which types of labour and skill are 'relevant'. This is because each category of works accommodates a whole variety of different genres—'literary works' include not only novels and poems, but also databases and computer programs; 'artistic works' include realist and abstract paintings and drawings, as well as engineering drawings and maps, and so on—and in turn there is potentially a wide variety of types of relevant skill and labour.<sup>63</sup>

**(d) Importance to audience** It is sometimes said that the importance of the part is judged from the point of view of the person to whom the work is addressed.<sup>64</sup> For example, in dealing with an infringement action brought in 1934 in relation to the copying of 28 bars from the well-known military march 'Colonel Bogey', the Court of Appeal concluded that the part was substantial because anyone hearing the part taken would recognize it.<sup>65</sup> It was also the part by which the march was chiefly known and the cause of its popularity.

This approach to the determination of the importance of a part may be misleading because the audience to whom the work is addressed might be interested in parts of the works that involve little *relevant* labour, skill, or investment. The key inquiry is that stated by Lord Hoffmann: the importance of a part of a work is to be judged in terms of criteria that are relevant to the type of work in question. In contrast, the mere fact that part of a work becomes commercially significant or that there is a market for it should not matter when deciding whether the part is substantial.

**(e) Functional importance** A similar difficulty has arisen in relation to determining the importance of parts of functional works. Here, the courts have held that while a part may be important to the functioning of the work, if it is not also significant in terms of the originality of the work, it will not be substantial.<sup>66</sup> The issue

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has arisen where a small part of a computer program is copied. Although the program will not function, or will not function properly, without the part, this does not mean that every part, however small, should be treated as a ‘substantial part’ of the program.<sup>67</sup>

(f) *The part must itself be capable of being protected* In some cases, the courts have suggested that a part will not be substantial if the amount that is taken would not itself attract copyright.<sup>68</sup> This can be seen in *Francis Day & Hunter v. 20th Century Fox*,<sup>69</sup> in which the owners of copyright in the song ‘The Man Who Broke the Bank at Monte Carlo’ brought an infringement action against a person who made a film of the same name. In response, Lord Wright said that the ‘copying which is complained of is the use of the title, and that is too unsubstantial on the facts of this case to constitute infringement’.<sup>70</sup> In other words, Lord Wright thought that there was no copyright in the title by itself. A similar approach was adopted in the parody case of *Williamson Music v. Pearson*,<sup>71</sup> in which the only parts left in the defendant’s parody of the claimant’s song ‘There is Nothin’ Like a Dame’ were the words ‘we got’, which were repeated several times. Judge Baker QC held that the words were not a substantial part of the copyright work, noting that ‘in themselves the words would not be copyright as a literary work’.<sup>72</sup>

(g) *Repeated takings* In certain situations, the question has arisen as to whether the taking of an insubstantial part of the copyright work over a period of time amounts to the taking of a substantial part of the work. This question arises in two situations. The first is where a defendant regularly takes insubstantial amounts from a *single copyright work*. For example, while students might not infringe the copyright in a 300-page textbook if they were to copy five pages, what if, over the course of an afternoon, the same student were to go to a photocopy machine 20 times and photocopy a different five-page section each time? While the copying of five pages may not amount to an infringement, what of the copying of 100 pages? The second scenario is where copyright works are created regularly and the defendant consistently takes insubstantial amounts from different works. For example, would it be an infringement for an evening newspaper to reproduce regularly an insubstantial amount taken from daily financial reports of foreign markets that appeared in a morning paper?

As regards the first situation—that is, where a defendant regularly takes insubstantial amounts from a *single copyright work*—the court in principle must decide whether there are a number of takings or only one: a person will infringe if the acts can reasonably be seen as a single act and the cumulative taking is ‘substantial’.<sup>73</sup> Relevant factors would presumably include whether the taking were used for the same purpose and the time frame within which the activities took place. Beyond those limited situations in which a series of acts could be interpreted as a single act, it seems that the courts recognize a broader doctrine of ‘repeated systematic copying from the same work’. Although Laddie J had indicated that the concept of infringement by taking small and regular amounts was problematical,<sup>74</sup> the Court of Appeal in *Newspaper Licensing Agency (NLA) v. Marks & Spencer* stated that such systematic copying could be infringement.<sup>75</sup> (The issue was not discussed in the House of Lords.) The Court of Appeal found support for its view from a case in which a defendant was held to infringe copyright in the fixture lists for the football season, because it had copied a part of the list every two weeks.<sup>76</sup> Nevertheless, the comments in *NLA* were obiter and the Court gave no indication as to when (or why) copying would be treated as ‘systematic’.<sup>77</sup>

In contrast, where there is repeated copying of insubstantial parts from a series of the claimant's works, there can be no finding of infringement (despite certain nineteenth-century cases to the contrary).<sup>78</sup> Dismissing those authorities on the basis of the different statutory terms, Peter Gibson LJ said: 'I do not understand how in logic what is an insubstantial part of a work can when aggregated to another insubstantial part of another work become a substantial part of the combined work.'<sup>79</sup> Here, the only issue is whether, in each case, the claimant can show some use of a substantial part of the individual works.<sup>80</sup>

### (iii) Judicial and practical responses to the complicated inquiry

Having set out a structured approach suited to a rigorous analysis of copyright infringement, we should conclude our discussion of the British approach to identifying whether a 'substantial part' has been taken by observing that courts have not always been as rigorous or structured in their analyses as we suggest is necessary in the preceding account. In most cases, in fact, the court has not examined carefully the nature of the claimant's work, instead taking for granted the boundaries of the work and that the work as a whole is protected. In these cases, the courts have often gone straight to the issue of substantiality of the taking.<sup>81</sup> In yet other cases, the court has avoided examining the substantiality issue with any rigour. In some such cases, the courts deployed the 'rough practical test' that 'what is worth copying is worth protecting'.<sup>82</sup> This might be thought to be justified where there is an indication that the defendant has deliberately copied, from which the court can at least draw an inference that the defendant regarded the material that they had appropriated as 'worth taking' and therefore as embodying original skill and labour.<sup>83</sup> In other circumstances, in particular where the issue of derivation has been determined through a process of inference from multiple similarities between the defendant's material and the claimant's work, the courts have sometimes indicated that further inquiry is superfluous.<sup>84</sup>

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#### 2.3.2 The European approach to authorial works

Article 4(1)(a) of the Software Directive,<sup>85</sup> Article 5(a) of the Database Directive,<sup>86</sup> and Article 2 of the Information Society Directive<sup>87</sup> all confer on the owners of copyright in computer programs, databases, and authorial works generally a right to control the reproduction of the work in whole or 'in part'. Although the reference to 'part' appears only in the context of reproduction, it is unlikely that a parallel criterion would not be applicable to other rights that are harmonized under European law (on which, see Chapter 6).<sup>88</sup> The Court of Justice regards the question of what counts as a 'part' as a matter of European law.

In *Infopaq International A/S v. Danske Dagblades Forening*,<sup>89</sup> the Court was responding to a reference from Denmark in relation to a 'press clippings service', which informed subscribers when certain specified search terms appeared in the daily newspapers. Infopaq, which provided the service, would scan the papers into TIFF form, subject the digital version to optical character reading, and then execute searches. The searches would reproduce the search term and the five words either side of it. One of the questions referred to the Court was whether such segments amounted to reproduction 'in part' for the purposes of Article 2 of the Information Society Directive. The Court reasoned that, to understand the scope of protection, it was necessary to understand the subject matter. Noting that Article 2(a) protected 'works', the Court asserted (on the basis of various provisions in directives and the Berne Convention) that this referred to 'intellectual creations'. The Court noted that there was nothing in the *acquis* that suggested that 'parts are to be treated any differently

from the work as a whole' and concluded from this that parts 'are protected by copyright since, as such, they share the originality of the whole work'.<sup>90</sup> The Court added that 'the various parts of a work ... enjoy protection ... provided that they contain elements which are the expression of the intellectual creation of the author of the work'.<sup>91</sup>

The test established by the Court is not a model of clarity. In particular, the Court first talks about parts 'sharing' the originality of the whole—a standard that might be taken to imply that anything but a *de minimis* component of a work is protected.<sup>92</sup> However, the Court goes on to indicate that a fragment of a work will be a protected 'part' only if that fragment itself contains elements that are themselves original. The latter understanding of the judgment seems preferable: if the fragment reproduced itself would be protected as original (in the European sense), then it is to be treated as a 'part' of the work that was reproduced.<sup>93</sup>

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The approach in *Infopaq* has been followed by the High Court and the Court of Appeal in the United Kingdom, and by the Court of Justice (Grand Chamber). In *SAS Institute v. World Programming*,<sup>94</sup> Arnold J treated the question of whether parts of SAS's computer manuals (literary works) reproduced by WPL were 'substantial' as requiring analysis of whether the sections that were reproduced were original.<sup>95</sup> On appeal, Lewison LJ observed:

In *Infopaq* the court said that parts of a work are entitled to the same protection as the work as a whole. But the parts in question must 'contain elements which are the expression of the intellectual creation of the author of the work': [39]. This is now the test for determining whether a restricted act has been done in relation to a substantial part of a work.<sup>96</sup>

In *Newspaper Licensing Association v. Meltwater & PRCA*,<sup>97</sup> the Court of Appeal applied the *Infopaq* test and held that the defendant's news-alert system, which forwarded links to web pages containing news stories relating to particular, preselected search terms, and a 256-character excerpt (which included the title) from the story, would from time to time amount to reproduction of a substantial part of the news article (a literary work). It would do so where what was reproduced was the author's own intellectual creation. In *Football Association Premier League v. QC Leisure*,<sup>98</sup> the Court of Justice (Grand Chamber) held that there would be infringement of copyright works contained in films where the amount held simultaneously in the 'buffer' system of the decoder or on the screen amounted to 'the author's own intellectual creation'.

### (i) Differences from the British approach

The *Infopaq* approach involves a quite different logic or approach to the question of what counts as infringement from that which formerly occurred in the United Kingdom. Three important dimensions are worth noting. First, in contrast to an approach that looks at whether the part taken comprises a substantial part of the protected work and thus requires some consideration of the parameters of the protected work, the *Infopaq* approach merely asks whether what is taken is itself original. *Infopaq* thus avoids a lot of difficult questions about the parameters of the work. Professor Jonathan Griffiths refers to this as the 'dematerialization' of copyright.<sup>99</sup>

Second, while the originality of the part taken is a necessary requirement for a finding of infringement under p. 227 the traditional UK test, it has not been regarded as the only consideration. Rather, under the British approach, a component was regarded as ‘substantial’ only if it was sufficiently important (from a qualitative viewpoint). The reproduction from a newspaper article of the phrase ‘a forthcoming sale of the telecommunications group TDC which is expected to be bought’ would be treated as substantial under the old UK jurisprudence only if it were thought to be an ‘important’ part of the literary labour, skill, and judgement involved in creating the article. The shift to the test in *Infopaq* thus represents an expansion in the scope of protection.<sup>100</sup>

A third potentially significant difference between the two approaches is that the CJEU has, on a number of occasions,<sup>101</sup> reiterated that the extent of protection of a copyright work does not relate to the level of originality of that work. In contrast, the traditional case law applied in the United Kingdom did seem to require that, with works of low originality (such as a line drawing of a hand),<sup>102</sup> there would only be infringement where the defendant had replicated the entirety of the claimant’s work. Whether, and if so, how far the statements from the CJEU would preclude such a rule is not altogether clear: the Court might merely have been ruling out distinctions between different categories of work. In any case, these propositions are ones an appellate court might prefer not to follow, given the attractiveness of the general principle that the degree of protection should be proportionate to the level of originality.

Having said this, the British approach was evolving quite rapidly in the last decades of the twentieth century. As we noted earlier,<sup>103</sup> there had been a discernible shift towards allowing a copyright owner to control ever-smaller uses and reuses of their works. In the 1980s, it was still arguable that ‘substantiality’ was a criterion that would enable third parties to make ‘fair use’ of a work. However, authorities such as *Designer’s Guild* supported a view that the threshold would only exempt a use of an ‘insignificant’ part or *de minimis* part.<sup>104</sup> Moreover, Lord Hoffmann’s speech in *Newspaper Licensing Agency v. Marks and Spencer* offered up a similarly restrictive logic: copyright would be infringed by any use of a part that was qualitatively ‘substantial’, in the sense that it reproduced protected ‘labour, skill, and judgement’ of the author.<sup>105</sup> In so doing, he steered British law towards an understanding of ‘substantiality’ based on a logic that is close to that deployed by the Court of Justice in *Infopaq*.<sup>106</sup>

Although the *Infopaq* test is not without its attractions, it should be recognized too that it is a substantial expansion in the protective scope of copyright. Consequently, it is more important than ever for policymakers in this field to ensure that appropriate flexibility for users is provided by way of exceptions (discussed in Chapter 9).

### 2.3.3 Entrepreneurial works and related rights

Although UK law refers to infringement of copyright in sound recordings, films, and broadcasts as dependent on whether the defendant has carried out a restricted act in relation to the whole or ‘a substantial part’ of the subject matter, as we have already observed, Article 2 of the Information Society Directive harmonizes the reproduction right not only for authorial works, but also for ‘phonograms’ (that is, sound recordings), films, and broadcasts.<sup>107</sup> That legislation envisages infringement by reproduction of ‘a part’ of the subject matter. The *Infopaq* case is not directly relevant, because it concerns authorial works that are subject to an

'originality' standard, whereas no equivalent standard is stated for related rights.<sup>108</sup> So far, the Court of Justice has only been asked to interpret the concept of a 'part' in relation to sound recordings (so-called 'phonograms').

In *Pelham GmbH v. Ralf Hüttner*, it was common ground that 'very short audio snatches' of approximately two seconds in duration from a recording entitled 'Metall auf Metall' by 1970s German electronic musicians *Kraftwerk* had been used by Pelham on a recording of performer Sabrina Setlur called 'Nur Mir'.<sup>109</sup> The German Supreme Court sought guidance on how to determine whether these 'samples' infringed the phonogram producer's related rights.<sup>110</sup> The CJEU held that, in general, reproduction of any part, however short, infringed the right conferred by Article 2 of the Information Society Directive.<sup>111</sup> To that rule, the Court added an exception: if freedom of the arts is implicated (as it would be with sampling),<sup>112</sup> the Court indicated that there will be no 'reproduction ... of a part' if the part used is so transformed as to be 'unrecognisable' (on the facts, 'to the ear').<sup>113</sup> In such a situation, the Court observed, the use 'would not interfere with the opportunity which the producer has of realising satisfactory returns on his or her investment'.<sup>114</sup> There is nothing in the reasoning to suggest a different approach would be taken by the Court of Justice to other related rights, such as film fixations or broadcasts.

p. 229 ↵ Although the ruling in *Pelham* on the meaning of 'part' has one thing to be said for it—namely, that it avoids difficulties in line drawing,<sup>115</sup> and, potentially, a corresponding need to identify the parameters of the subject matter,<sup>116</sup> the conclusion is deeply unsatisfactory.<sup>117</sup> The effect of the decision is to offer extraordinary protection to owners of copyright in sound recordings that is utterly disproportionate to the rationale for such rights. The limitation to that right created in the name of 'freedom of the arts' is of narrow but uncertain scope, but probably only likely to protect a tiny group of 'collage samplers'.<sup>118</sup> The effect of the decision is to confer stronger protection on 'entrepreneurial works' (related rights), which are mere products of investment, than on authorial works, which are the result of creative choices, and thus invert the conventional privileging of the latter.<sup>119</sup> Moreover, *Pelham* confers unnecessary and unjustified levels of control on such producers, given that only very limited freedoms are offered for downstream creators and users (on which, see Chapter 9).

It is suggested that the *Pelham* decision is one that the appellate courts might choose to ignore. We prefer the approach applied by Arnold J in *England and Wales Cricket Board and Sky UK v. Tixdaq and Fanatix*.<sup>120</sup> In that case the Court was called upon to assess the legitimacy of a mobile platform that was used by users to upload short segments from broadcast footage of cricket matches (e.g. wickets, dropped catches, or spectacular shots). Arnold J noted that broadcasts and fixations of films were entrepreneurial copyrights, designed to protect investment. Referring to the Information Society Directive, the Judge observed:

[P]arts of broadcasts and first fixations of films enjoy protection ... provided that they contain elements which reflect the rationale for protecting broadcasts and first fixations, that is to say, the investment made by the broadcaster or producer. I do not consider that ... reproduction of any part of a broadcast or first fixation amounts to an infringement.... [T]he correct test of substantiality is to consider the degree of reproduction both quantitatively and qualitatively, having regard to the extent to which the reproduction exploits the investment made by the broadcaster or producer.

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↳ In such cases, broadcasters and producers invest knowing that some parts of the footage—goals in football, wickets or sixes in cricket—will be more interesting to viewers than other parts. Indeed, these incidents are often reworked by way of ‘action replay’ and related analytical technologies (to highlight whether players were off-side, whether the ball pitched in line, or a foot or ball crossed a relevant line). Moreover, the investment is made knowing that there is not a single market just for footage of the whole game, but also secondary markets for programmes with just the highlights. Consequently Arnold J rejected the proposition that different parts of a broadcast or film could not be identified as qualitatively more important: ‘[T]he footage is not undifferentiated either in terms of its interest to viewers or in terms of its commercial value or in terms of the equipment and skills that is required to produce it ...’. Applying the test, the Court concluded that eight-second clips from cricket broadcasts were ‘substantial’ as they comprised ‘highlights’, ‘something of interest, and hence value’ and thereby ‘substantially exploited the ... investment in producing the relevant broadcast and/or film’.<sup>121</sup> In contrast, in an earlier case where four frames of a video stream were held in a decoder at a given moment, Kitchin J concluded that this was not a ‘substantial part’ of the film fixation, because it lasted ‘a fraction of a second’ and had ‘no inherent value’.<sup>122</sup>

### 2.3.4 Typographical arrangements

Infringement of the copyright in typographical arrangements has never been subject to harmonization at the EU level. As a result, the matter has always been governed by UK law. In *Newspaper Licensing Agency v. Marks and Spencer*,<sup>123</sup> the issue was whether the copyright in the typographical arrangements in a number of the newspapers had been infringed by copying and distributing individual articles. As a result, the House of Lords was called upon to consider whether the NLA had typographical copyright in each of the individual articles in the newspapers or only in each newspaper as a whole. The House of Lords held that ‘the frame of reference for the term “published edition” is the language of the publishing trade’ and therefore that ‘the edition is the product, generally between covers, which the publisher offers to the public’.<sup>124</sup> Thus, each edition of the newspaper rather than each article benefited from the typographical copyright. When the House of Lords turned to consider whether there had been reproduction of a ‘substantial part’, it indicated that this was to be considered from the perspective of the quality of the labour and skill invested in choosing the presentation and layout (as opposed to the particular words and images published in the edition).<sup>125</sup> One commentary says this suggests that the threshold may be set ‘fairly high’.<sup>126</sup>

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## 2.4 Non-Literal Copying of Authorial Works

As we explained in Chapter 6, the protection given to entrepreneurial works is limited to the form in which the work is fixed (in the case of a film, the specific images; in the case of a sound recording, the specific sounds recorded; for a broadcast, literally ‘the signal’). As Lord Justice Arnold has noted, these are ‘signal copyrights’.<sup>127</sup> One of the consequences of this is that the only question that arises in relation to entrepreneurial works is whether a substantial part of the ‘signal’ has been taken. In relation to authorial works, however, the protection extends beyond the specific form in which the work is recorded or communicated to include other aspects—what Arnold calls ‘the content’—of the work. For example, the protection afforded to a literary work, such as a novel, may extend beyond reproduction of the printed words on the page to include copying of the storyline, plot, and characters that form part of the novel.

In this section, we try to explain first what counts as the ‘content’—that is, how far down beyond the ‘signal’ the protection of authorial copyright reaches. We go on to explain the principle that such protection does not extend to ‘ideas’, understood broadly as encompassing also facts and ‘functions’. Finally, we consider the impact of European harmonization on these rules.

### 2.4.1 Non-literal components of an authorial work

Perhaps the best way in which to understand the scope of protection potentially available beyond the surface of the work is to provide some examples.

In relation to *literary and dramatic works*, as well as the words on the page (the literal aspect of the work), the non-literal elements of a novel or play (which may be protected by the copyright therein) may include the plot,<sup>128</sup> the storyline,<sup>129</sup> as well as the incidents and themes.<sup>130</sup> While the issue has not really been addressed in the United Kingdom, it is less likely that the characters of a novel or play will be protected.<sup>131</sup> As we explain later, the non-literal elements of a literary work do not include the general ideas that may have informed or underpinned a work.

In relation to *computer programs*, copyright protection potentially extends beyond the object and source code of the program to include non-literal elements such as the structure or architecture of the program.<sup>132</sup>

In relation to *musical works*, it seems that protection might include the melody, phrasing, or rhythm, the time, or the suggested orchestration, but not aspects such as timbre or pitch contour, which can be said to be purely aspects of performance style.

p. 232 ↵ The question of the scope of protection available for *artistic works* was considered in *Krisarts SA v. Briarfine*.<sup>133</sup> The defendants commissioned an artist, G, to paint a number of scenes, including one of the Houses of Parliament with Westminster Bridge in the foreground. They showed G postcards of the scenes that they wanted her to paint, as well as prints taken from the painting of another artist, L. Many of G’s paintings were made from the same view and the same angle as L’s paintings. While Whitford J stressed that other painters should not be prevented from painting the same scenes, he did accept that there could be certain elements of the scenes that were ‘distinctive’ enough to warrant being protected.<sup>134</sup> As he said:

When one is considering a view of a very well-known subject like the Houses of Parliament with Westminster Bridge and part of the Embankment in the foreground, the features in which copyright is going to subsist are very often the choice of viewpoint, the exact balance of foreground features or features in the middle ground and features in the far ground, the figures which are introduced, possibly in the case of a river scene the craft on the river and so forth. It is in choices of this character that the person producing the artistic work makes his original contribution.<sup>135</sup>

In light of this, Whitford J held that it was arguable that G’s use of L’s work was sufficiently substantial to amount to infringement of copyright. While it is highly unlikely that the style used by an artist could be protected (style being the equivalent of an idea), it has been suggested that if the ‘feeling and artistic character’ of the claimant’s work has been taken, infringement might have occurred.<sup>136</sup>

### 2.4.2 Non-protection of ideas

Although copyright protection thus extends to copying of non-literal elements that fall below the ‘surface’ of a work, nevertheless it is a long-established principle that copyright protection is not granted to the ideas that are embodied in or which may have inspired the work.<sup>137</sup> In more positive terms, this means that third parties are able to make whatever use they wish of the ideas that are contained in a copyright work. Thus, it is not an infringement for someone to take the ideas or concepts ‘behind’ a painting, a book, or a computer program and incorporate them into their own work. In this context, it is important to note that ‘idea’ is a shorthand expression that covers an array of different things such as the ideas that prompted the work (for example to explore the impact of copyright law on artists), the subject matter of the work (for example a book on intellectual property law),<sup>138</sup> or the general style in which the work is created (such as a Cubist painting).<sup>139</sup>

Sometimes, the principle that copyright law does not protect ideas is referred to as the ‘idea–expression dichotomy’. This is usually taken to mean that what is protected is not an idea, but its expression. Insofar as the dichotomy implies that copyright predominantly protects the mode of expression used by the author, rather than the ideas, the dichotomy is not inaccurate. It is unhelpful, however, in that it wrongly suggests that copyright protection is limited to the form or expression used by the author and that copyright does not

p. 233 ↵ protect against change of form or against non-literal copying:<sup>140</sup> as we noted earlier, copyright law will protect many of the ideas expressed in a work. As Lord Hoffmann explained in the *Newspaper Licensing Agency* case, copyright infringement:

is sufficiently flexible to include the copying of ideas abstracted from a literary, dramatic, musical or artistic work, provided that their expression in the original work has involved sufficient of the relevant original skill and labour [or presumably, now ‘intellectual creation’] to attract copyright protection.<sup>141</sup>

In *Designers Guild v. Williams*,<sup>142</sup> Lord Hoffmann reviewed the case law on idea and expression and concluded that it supported two quite distinct propositions. The first is that a copyright work may express certain ideas that are not protected ‘because they have no connection with the literary, dramatic, musical or artistic nature of the work’.<sup>143</sup> Lord Hoffmann said that this would be the case with a literary work that described a system or invention: although the work would be protected, copyright would not entitle the author to claim protection for their system or invention as such. He gave, as a specific example, the case of *Kleeneze v. DRG (UK)*,<sup>144</sup> in which Whitford J found that there had been no infringement of copyright in the claimant’s drawing of a letterbox draught excluder, where the defendant had merely taken the concept of the draught excluder.

The other proposition is that certain ideas expressed by a copyright work may not be protected because, although they are ideas of a literary, dramatic, or artistic nature, they are not original, or are so commonplace as not to form a substantial part of the work. Lord Hoffmann gave the example of *Kenrick v. Lawrence*.<sup>145</sup> This case concerned the copyright protection available for a rudimentary drawing of a hand pointing to a square on a ballot paper to be used by illiterate voters. While the Court held that the drawing was protected by copyright, it also said that, because the level of skill, labour, and effort that was used in creating the work was

minimal (it was a simple, functional work), nothing short of an exact literal reproduction of the drawing would constitute an infringement.<sup>146</sup> In that case, copyright subsisted in the drawing of a hand, but such copyright would not enable the copyright owner to object to other people drawing hands, if in so doing all that was reproduced was the idea. As Lord Hoffmann explained: ‘At that level of abstraction, the idea, though expressed in the design, would not have represented sufficient of the author’s skill and labour as to attract copyright protection.’<sup>147</sup>

Lord Hoffmann’s articulation of the rule that ideas are unprotected is helpful in that it recognizes that the vagueness of the concept of ‘idea’ is likely to lead to misinterpretation of the nature and scope of the exclusion. In fact, the exclusion is a relatively narrow one and does not encompass everything that might be referred to, in common speech, as an idea. However, his attempt to pin down the rule that copyright is not infringed by the use of some ideas is open to the criticisms that it lacks clarity,<sup>148</sup> is incomplete,<sup>149</sup> and

p. 234 ↵ (by collapsing the rule on the non-protection of ideas into a rule on originality, rather than acknowledging its basis in public policy) might produce an unduly limited account of the exception. Failing to acknowledge that the rule is based in public policy suggests that if general ideas embody substantial labour and skill, they will benefit from protection (unless they are ‘unconnected’ with the work). This would be a novel, and undesirable, outcome. The exclusion of ‘ideas’ from the scope of protection is an important judicial technique that is used to reconcile the divergent interests of copyright owners with those of users, creators, and the public more generally.<sup>150</sup> These interests include, but are by no means confined to: the public interest in ensuring that new works can be made dealing with the same topic, or subject matter;<sup>151</sup> the public interest in ensuring that copyright protection does not undermine the free use of functional ideas (other than those protected by designs);<sup>152</sup> the desirability of allowing multiple works using the same techniques of production (again, subject to the limitation of patent law); the public interest in free expression; and particularly the free dissemination of political and economic ideas and historical facts.<sup>153</sup> The rule on non-protection of ideas is thus primarily directed at leaving free from monopolization the building blocks of culture, communication, innovation, creativity, and expression.<sup>154</sup> It can be no surprise, then, that, given the potential variety of influences, the application of the rule has been somewhat unpredictable. Moreover, in an era in which there is increased international norm-setting in the definition of the rights of the copyright owner, the non-protection of ideas represents one of the few avenues by which the courts can take account of the individual circumstances and merits of particular decisions.

While *Designers Guild* might have heralded a narrow interpretation of copyright law’s refusal to protect ‘ideas’, subsequent cases indicate that the lower courts prefer to take advantage of the flexibility that the ‘idea-expression dichotomy’ provides to dismiss speculative claims. In *Navitaire v. EasyJet*,<sup>155</sup> the owner of copyright in a source code brought an action against a former licensee who, having never seen the source code, tried to emulate the functional behaviour of the program. Pumfrey J found no infringement, stressing that the functional behaviour of a program was different from the plot of a novel (which might gain protection) and that policy weighed against protecting the ‘business logic’ of a program through copyright.<sup>156</sup> In *Nova Productions v. Mazooma Games*,<sup>157</sup> Kitchin J held that similarities between video games were attributable to general ideas that had ‘little to do with skill and effort’ expended by the programmer. This was affirmed on appeal, Jacob LJ concluding that ‘what was found to have inspired some aspects of the defendants’ game is just too general to amount to a substantial part of the claimant’s ↵ game’.<sup>158</sup> In *Baigent v. Random House* (the *Da Vinci Code* case),<sup>159</sup> Peter Smith J held that Dan Brown’s book did not infringe

copyright in Baigent and Leigh's *The Holy Blood and the Holy Grail*. In essence, Peter Smith J held that Brown had used Baigent and Leigh's book (along with other books), but that what was taken were facts and ideas at such a level of abstraction that there was no infringement.<sup>160</sup> In so holding, the Judge observed that the line between idea and expression 'is to enable a fair balance to be struck between protecting the rights of the author and allowing literary development'.<sup>161</sup> The decision was affirmed on appeal, the Court unanimously agreeing that there was no reproduction of a substantial part of Baigent and Leigh's book because that which was in *The Da Vinci Code* was ideas rather than 'the form or manner in which ideas were expressed'.<sup>162</sup> Mummery LJ, in particular, emphasized that literary copyright does not give rights that enable persons 'to monopolise historical research or knowledge'.<sup>163</sup> A final example of a situation in which the defendant was 'inspired' by the claimant's copyright work, but was held not to have taken a substantial part, is provided by the 'World Cup Willie' case.<sup>164</sup> The claimant's work was the World Cup logo from 1966 comprising a lion in an England strip kicking a football. The defendant created a modernized version of a lion playing football for England. Although the defendant had copied the idea of a lion kicking a ball with its right foot, the postures were different (one leant back; the other, forward), the angle of the faces differed (the plaintiff's drawing depicted the lion's face from the side, whereas the defendant's showed the whole face). While the stylization was similar, the High Court concluded that all that had been reproduced was ideas rather than 'a substantial part of the original'.

On the other hand, in *Temple Island Collections v. New English Teas*,<sup>165</sup> the (then) Patents County Court took a rather narrow view of 'ideas' when it found infringement of copyright in a photograph of a red double-decker bus crossing Westminster Bridge (the background all in black and white) (see Chapter 4, Fig. 4.2, p. 118), when the defendants created a similar image (albeit from quite a different angle) of a red bus crossing Westminster Bridge with the background in black and white (Chapter 4, Fig. 4.3, p. 119). The case received widespread criticism on the basis that what had been reproduced by the defendant was the commonplace idea of a red foreground and monochrome background, and the idea of creating an image of an iconic London bus coupled with the setting of Westminster Bridge. Certainly, each was a commonplace idea. Perhaps the better view is that, in a case of relatively limited originality, there should be infringement only where there is near-perfect copying.<sup>166</sup>

### 2.4.3 European copyright law and non-literal copying

The *Infopaq* test has been developed primarily with copying of discrete parts or fragments of a work.

However, as already noted, under traditional UK law, reproduction might also occur through copying 'non-literal' parts of a work (other than 'ideas'). Consequently, reproducing the general structure of a work—the plot of a novel or the layout of an artistic work—might count as reproduction of a substantial part. As yet, we have little indication of how to approach such cases in the post-*Infopaq* era.

The starting point is that the European legislature has taken different approaches to harmonization of, on the one hand, computer programs and databases, and on the other, 'authorial works'. As we saw in Chapter 6, in relation to computer programs and databases, the legislature harmonized both the reproduction right and the adaptation right. It also made express provision in the Software Directive to the effect that copyright did not protect ideas. In contrast, the Information Society Directive harmonized only the reproduction right and

makes no explicit reference to non-protection of ideas. This structure might suggest that EU harmonization applies to non-literal copying of computer programs and databases, but not in relation to other authorial works.

However, in many countries (including the United Kingdom), the ‘adaptation’ right and the ‘reproduction’ right frequently overlap, the reproduction right also covering many non-literal uses.<sup>167</sup> It is quite conceivable that the Court of Justice will interpret Article 2 of the Information Society Directive broadly to cover non-literal copying (with the advantage that, by so doing, it will minimize the impact of the different approaches in the legislation).<sup>168</sup> Indeed, as we saw earlier, at least one Advocate-General has suggested that non-literal copying might be infringement of the reproduction right in authorial works. In *Painer v. SVGH*,<sup>169</sup> Advocate-General Trstenjak suggested that the making of a photofit image of a woman from a copyright-protected photograph such as to reflect the development of the woman’s appearance might be a ‘reproduction’ if ‘the personal intellectual creation which justifies the copyright protection of the photographic template is still embodied in the photo-fit’. If the photofit only appropriated raw data from the image (the size of the nose, the distance between the eyes) and none of the lighting, angle, etc., then the photofit would not count as a reproduction.

A second, related, matter is how the ‘idea–expression dichotomy’ applies to works falling within the Information Society Directive. The dichotomy is explicitly recognized in the Software Directive,<sup>170</sup> but does not feature in the Information Society Directive (perhaps for the reason that it covers only copying and not adaptation, and so was thought unlikely to be in issue).

However, the Court of Justice and English Court of Appeal decisions in *SAS Institute v. World Programming*<sup>171</sup> indicate that the exclusion from protection of ‘ideas’ applied in cases of non-literal copying of authorial works as much as in relation to infringement of copyright in computer programs. In that case, the defendants had developed a computer program that emulated the functioning of the claimant’s integrated set of programs that was used in statistical analysis (and generated revenue for the claimant of more than £2 billion a year). There was no suggestion that the defendant had had access to the source code for the claimant’s programs and the question arose whether, in creating the competing software, it had infringed copyright either in the computer program (protected under the Software Directive) or in the manuals for the SAS system, the latter being authorial ↗ works protected under the Information Society Directive.<sup>172</sup> SAS sought to distinguish between the law applicable to infringement under the Software Directive and that under the ordinary copyright rules (arguing that there was no exclusion of ideas from the latter or that it was a narrower exclusion).<sup>173</sup>

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At first instance, Arnold J held that, whatever the position when enacted, the 1988 Directive must now be interpreted to give effect to Article 9(2) of TRIPS and Article 2 of the WIPO Copyright Treaty. Therefore copyright, whether in relation to software or generally, protects only expression, and does not protect ‘ideas, procedures, methods of operation and mathematical concepts as such’.<sup>174</sup> Nevertheless, he referred various questions to the Court of Justice on the application of the idea–expression dichotomy within the Software Directive and its parallel application to the manual.

In relation to software, the Court of Justice explicitly held that neither the functionality of a computer program nor the programming language and the format of data files used in a computer program in order to exploit certain of its functions constitute a form of expression of that program. The Court's answer on the Information Society Directive was less clear-cut, merely reiterating the test of infringement that had emerged from *Infopaq*.<sup>175</sup>

The English Court of Appeal focused on the fact that Recitals 20 and 50 of the Information Society Directive specifically refer to the Software Directive.<sup>176</sup> Bearing in mind the international standards applicable and the jurisprudence of the Court of Justice (in particular as to originality), the Opinion of Advocate-General Bot in the *SAS* case, and 'well-established principles of copyright law', Lewison LJ concluded that:

[T]he same concept of what is capable of protection (as a form of expression rather than as an idea) applies to both the Software Directive and the Information Society Directive. Since the court's avowed intention was to establish a harmonized legal framework for copyright, this is not surprising.<sup>177</sup>

However, the Court of Appeal emphasized the Court of Justice's reference to reproduction of the 'expression of the intellectual creation', not merely reproduction of the intellectual creation.<sup>178</sup> In the view of Lewison LJ, the simple answer to the question of whether copying the compilation of functional elements was infringing was that the copying was not a copying of 'the form of expression' of the intellectual creation. Thus it was unnecessary for Arnold J to have rejected the claim on the ground that the intellectual creation that was copied lay in the programs rather than the manual.<sup>179</sup>

### 3 Secondary Infringement

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In an attempt to inhibit the negative impact that illegal acts have upon copyright owners, copyright law recognizes that it is not enough merely to provide remedies against those who copy or perform the copyright work. Instead, copyright law recognizes that it is also necessary to provide owners with protection against those who aid and abet the primary infringer. Such accessory infringement is known as 'secondary infringement'.

p. 238 ↵ There are two important differences between primary and secondary infringement. The first relates to the scope of protection: primary infringement is concerned with people who are directly involved in the reproduction, performance, etc. of the copyright work; in contrast, secondary infringement is concerned with people in a commercial context who either deal with infringing copies, facilitate such copying, or facilitate public performance. The second difference between the two forms of infringement relates to the mental element that the defendant must exhibit in order to infringe. As we explain later in this chapter, the state of mind of the defendant is not formally taken into account when deciding whether an act of primary infringement has occurred. In the case of secondary infringement, however, liability is dependent on the defendant knowing, or having reason to believe, that the activities in question are wrongful.<sup>180</sup>

### 3.1 Types of Secondary Infringement

Secondary infringers can be divided into two general categories: those who distribute or deal with infringing copies once they have been made; and those who facilitate copying by providing the equipment or means that enable the copying to take place.

#### 3.1.1 The distribution of infringing copies

The first general category of secondary infringement is concerned with people who deal with infringing copies of the work in a commercial context. To this end, sections 22 and 23 of the CDPA 1988 provide that the copyright in a work is infringed by a person who, without the licence of the copyright owner:

- (i) *imports* an infringing copy into the United Kingdom otherwise than for their private and domestic use;<sup>181</sup>
- (ii) *possesses* an infringing copy in the course of business;<sup>182</sup>
- (iii) *sells or lets for hire*, or offers or exposes for sale or hire, an infringing copy;
- (iv) in the course of business, *exhibits* in public or distributes an infringing copy;<sup>183</sup> or
- (v) *distributes* an infringing copy, otherwise than in the course of a business, to such an extent as to affect the copyright owner prejudicially.

Section 27(2) provides that an article is an ‘infringing copy’ if its making constituted an infringement of the copyright in the work in question.<sup>184</sup> In addition, there are many situations in which the making of a copy is not infringing because of the existence of a defence, but the statute requires the copy be treated as an infringing copy when subsequently dealt with in specified ways.<sup>185</sup> For example, a copy might be legitimately made for someone who is visually impaired, but if subsequently ‘dealt with’, might then automatically be converted from a legitimate to an ‘infringing copy’. In contrast, there is no explicit provision made for the situation where the making of a copy was initially unauthorized and infringing, but later was either permitted by the right holder or came to fall with an exception. For example, following the Hargreaves

p. 239 Review a new exception ↗ was added for parody,<sup>186</sup> but no provision was made to exempt from secondary liability those in possession of parodies made before 1 October 2014, which might well then have been infringing. The better view is probably to regard the ‘new’ parody defence as now applicable to the initially ‘infringing copy’, not by changing its status to a non-infringing copy, but rather by treating any of the secondary acts—possession in the course of business, distribution, communication, etc.—as ‘dealings’ done fairly ‘for the purposes of ... parody’. The latter seems a plausible solution, given that parody, caricature, pastiche, and quotation are intrinsically communicative acts, so acts that facilitate such communications are as much dealings ‘for’ the purpose as acts of generating the parody, etc., in the first place.

In the case of imported copies, infringing copy also includes ‘notional infringements’—that is, copies that, if they had been made in the United Kingdom, would have infringed copyright at the time of making or would have constituted a breach of an exclusive licence agreement relating to the work.<sup>187</sup> This provision has proved to be problematic.<sup>188</sup> Its significance has been reduced, however, by the extension of liability for primary

infringement to include the issuing of copies, including the importing of copies from outside the European Economic Area (EEA).<sup>189</sup> Liability for secondary infringement by import remains relevant in cases of import from an EEA state.

### 3.1.2 Providing the means for making infringing copies or performances

The second general category of secondary infringement is concerned with people who facilitate copying. This occurs, for example, where someone provides the equipment or the means that enables the copying to take place. There are a number of different situations in which the provision of the means for making infringing copies or performances will amount to a secondary infringement.

Section 24(1) of the CDPA 1988 provides that a person is liable for infringement where they supply an article that is specifically designed or adapted for making copies of the copyright work. More specifically, section 24(1) provides that:

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

- (a) makes,
- (b) imports into the United Kingdom,
- (c) possesses in the course of business, or
- (d) sells, or lets for hire, or offers or exposes for sale or hire,

*an article specifically designed or adapted for making copies of that work ...<sup>190</sup>*

It should be noted that section 24(1) states that the article must be *specifically* designed or adapted for the purpose of copying. This means that it is not enough that an article, such as a photocopier or a tape-to-tape recorder, has the potential to copy; rather, for the section to operate, the article must be specifically designed for the copying of a particular work. This would be the case, for example, if someone were to make a template or a mould of a copyright work that is used to create infringing copies.<sup>191</sup>

Special provisions are also made for people who *transmit the work* without the appropriate permission. Section 24(2) states that copyright in a work is infringed by a person who, without licence, transmits the work by means of a telecommunications system (such as a fax). It does not apply, however, to communications to the public. As with all forms of secondary infringement, infringement is dependent upon the defendant ‘knowing or having reason to believe that infringing copies of the work will be made by means of the reception of the transmission in the United Kingdom or elsewhere’.

Where the copyright in a literary, dramatic, or musical work is infringed by a performance at a ‘public place of entertainment’,<sup>192</sup> any person who gave permission for that place to be used for the infringing performance is also liable for infringement. This does not apply, however, where the defendant gave permission on reasonable grounds that the performance would not be infringed.<sup>193</sup>

Special provisions also apply to those who facilitate an infringing performance. Section 26 deals with the situation in which copyright is infringed by a public performance or by the playing or showing of the work in public by means of apparatus for '(a) playing sound recordings, (b) showing films, or (c) receiving visual images or sounds conveyed by electronic means'. In these situations, the following people will infringe:

- (i) The person who *supplies the apparatus* that enables the act of primary infringement to take place is liable for infringement. This covers someone who supplies equipment to play records or show films. Infringement here is conditional on the fact that, where an apparatus is normally used in public, the defendant did not believe on reasonable grounds that it would be used to infringe copyright.<sup>194</sup>
- (ii) An occupier of premises who gave permission for an apparatus to be brought onto the premises will be liable if they knew or had reason to believe that the apparatus was likely to be used to infringe copyright.<sup>195</sup>
- (iii) A person who *supplies a copy* of a sound recording or a film will be liable if they knew or had reason to believe that the copy was likely to be used to infringe copyright.<sup>196</sup>

Finally, it should be noted that special rules, analogous to provisions on secondary infringement, apply where persons do various acts that facilitate access to or duplication of works that have been protected by technological measures. We deal with these in detail in Chapter 13, section 4, pp. 390–400. For the moment, we merely need to note that these rights cover:

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- (i) acts that circumvent technological measures;<sup>197</sup>
- (ii) the manufacture and distribution of devices either 'primarily designed, produced, adapted ... for the purpose of enabling and facilitating' circumvention, or 'promoted, advertised or marketed' for that purpose, and having 'only a limited commercially significant purpose or use other than to circumvent';<sup>198</sup> and
- (iii) the provision of services for the purpose of enabling or facilitating circumvention.

Distinct, and narrower, provisions apply where the measures protect computer programs.<sup>199</sup>

### 3.2 Actual or Constructive Knowledge

One of the notable features of secondary infringement is that liability is dependent on the defendant 'knowing or having reason to believe' that the activities in question are wrongful—that is, liability is dependent on the defendant having either actual or constructive knowledge. The question of whether a defendant has the requisite knowledge is decided objectively.<sup>200</sup> As such, it does not matter that the defendant may not have believed that the act in question was wrongful; all that matters are the conclusions that a reasonable person would have reached in the circumstances.

The question that needs to be asked is whether the defendant knew or had reason to believe that they were dealing with or helping to facilitate the creation of an 'infringing copy' of the copyright work. In answering this question, the courts have stressed that the defendant must be in a position from which they are able to evaluate the information that is given to them.<sup>201</sup> This means that they must be given a reasonable period of time within which to consider the information.<sup>202</sup> It also means that the information that they are given

must be sufficiently detailed as to the nature of the work in question: general allegations about infringement will not suffice.<sup>203</sup> The courts have also said that it is *not* enough for the facts to lead a reasonable person to suspect the relevant conclusion.<sup>204</sup> Although it will enhance the claimant's case if the defendant is supplied with a copy of, or given reasonable access to, the copyright work, the circumstances of the case may be such that the reasonable defendant could have 'known' about the wrongful nature of their activities without ever having seen the copyright work.<sup>205</sup>

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<sup>1</sup> TRIPS, Art. 9(2) (copyright protection shall extend to expressions and not to ideas, procedures, methods of operation, or mathematical conceptions as such); WCT, Art. 2; *Nova Productions v. Mazooma* [2007] EWCA Civ 219, [2007] RPC 589, 602, [38]; Software Dir., Art. 1(1).

<sup>2</sup> Database Dir., Art. 5; Software Dir., Art. 4(a); Info. Soc. Dir., Art. 2(1).

<sup>3</sup> *Infopaq International AS v. Danske Dagblades Forening*, Case C-5/08 [2009] ECR I-6569; *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2019:624.

<sup>4</sup> CDPA 1988, s. 16(3). For an overview, see *John Kaldor Fabricmaker U.K. v. Lee Ann Fashions* [2014] EWHC 379 (IPEC), [10]–[22] (HHJ Hacon).

<sup>5</sup> See e.g. *Autospin (Oil Seals) v. Beehive Spinning* [1995] RPC 683 (failure to show a causal chain); *Sawkins v. Hyperion* [2005] 1 WLR 3281, 3288, [30]. As we saw in Chapter 6, section 1, pp. 153–6, the knowledge of the defendant is not important in determining whether an act of primary infringement has taken place, but see also Chapter 6, section 6.1, pp. 171–3.

<sup>6</sup> CDPA 1988, s. 16(3)(b).

<sup>7</sup> CDPA 1988, s. 16(3).

<sup>8</sup> *British Leyland v. Armstrong* [1986] AC 577 (production of replacement exhaust pipes for claimant's cars indirectly copied the claimant's original drawings).

<sup>9</sup> *BBC v. Mitchell* [2011] EWPCC 42, [25]; *The Racing Partnership v. Done Brothers (Cash Betting)* [2019] EWHC 1156 (Ch), [73]–[74] (Zacaroli J) (no infringement where defendant had generated its own betting odds and then referred to those of the claimant, leaving their own unaltered if there was correspondence, but adjusting their odds closer to the claimant's if there was a difference).

<sup>10</sup> *SAS Institute v. World Programming* [2010] EWHC 1829 (Ch), [70], [2013] EWCA Civ 1482, [17].

<sup>11</sup> *John Kaldor Fabricmaker U.K. v. Lee Ann Fashions* [2014] EWHC 379 (IPEC), [11] ('Spies who were at the defendant's elbow during the relevant time are seldom available').

<sup>12</sup> *IPC Media v. Highbury Leisure* [2005] FSR (20) 434, 443.

<sup>13</sup> *Billhöfer Maschinenfabrik GmbH v. Dixon & Co.* [1990] FSR 105, 123 (Hoffmann J) (observing the paradox that it is 'the resemblances of inessentials, the small, redundant, even mistaken elements of the copyright work which carry the greatest weight' in proving derivation). See also *L. B. (Plastics) v. Swish Products* [1979] FSR 145, 159 (Lord Hailsham); *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 298.

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<sup>14</sup> *Designers Guild v. Russell Williams* [2000] 1 WLR 2416, 2425 (Lord Millett).

<sup>15</sup> *Francis Day & Hunter v. Bron* [1963] Ch 587 (on facts, derivation not established).

<sup>16</sup> *Designers Guild v. Russell Williams* [2000] 1 WLR 2416, 2425 (Lord Millett); *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 297; *Stoddard International v. William Lomas Carpets* [2001] FSR 848, 857–8; *Mitchell v. BBC* [2011] EWPCC 42, [25]; *ATB Sales v. Rich Energy* [2019] EWHC 1207 (IPEC), [102]–[122] (defendant failing to rebut inference of copying).

<sup>17</sup> *Harman Pictures v. Osborne* [1967] 1 WLR 723, 728; *IPC Media v. Highbury Leisure* [2005] FSR (20) 434, 443, [10] (Laddie J); *Ogunkoya v. Harding* [2017] EWHC 470 (IPEC) (A. Michaels).

<sup>18</sup> *Catnic Components v. Hill and Smith* [1982] RPC 183 (CA, affirming Whitford J), 222; *Kleeneze v. DRG (UK)* [1984] FSR 399, 401.

<sup>19</sup> *Francis Day & Hunter v. Bron* [1963] Ch 587, 615–16 (Willmer LJ).

<sup>20</sup> [2000] 1 WLR 2416.

<sup>21</sup> *Designers Guild v. Russell Williams* [1998] FSR 803.

<sup>22</sup> Ibid., 815.

<sup>23</sup> Ibid.

<sup>24</sup> [2011] EWPCC 42; see also *Sheeran v. Chokri* [2022] EWHC 827 (Ch).

<sup>25</sup> *Waterlow Directories v. Reed Information* [1992] FSR 409; *Waterlow Publishers v. Rose* [1995] FSR 207.

<sup>26</sup> *Francis Day & Hunter v. Bron* [1963] Ch 587. According to Willmer LJ, at 614, to establish subconscious copying, it must be shown that the composer of the offending work was familiar with the work alleged to have been copied; cf. Upjohn LJ, at 621–2 (leaving undecided the issue of whether a different test applied for subconscious copying). In this case, there was not sufficient material from which such an inference could be drawn. See also *Sinanide v. La Maison Kosmeo* (1927) TLR 371; *John Richardson v. Flanders* [1993] FSR 497; *Jones v. London Borough of Tower Hamlets* [2001] RPC (23) 407, 432, [89]–[93].

<sup>27</sup> *Francis Day & Hunter v. Bron* [1963] Ch 587, 619 (Upjohn LJ). The decision of Wilberforce J at first instance is called ‘a wise judgment’ by Mummery LJ in *Baigent v. Random House* [2007] EWCA Civ 247, [2007] FSR 579, [122]. See also *Jones v. Tower Hamlets* [2001] RPC (23) 407, 432, [89]–[93]; *Elanco Products v. Mandops* [1980] RPC 213 (CA), 227.

<sup>28</sup> *Mitchell v. BBC* [2011] EWPCC 42, [121].

<sup>29</sup> Ibid., [39].

<sup>30</sup> Ibid., [126], [143]–[146].

<sup>31</sup> As should be clear, the circumstances in which someone infringes copyright are different from the circumstances in which someone might be regarded as a ‘plagiarist’. For discussions of the distinction, see I. Alexander, ‘Inspiration or Infringement: The Plagiarist in Court’, in L. Bently, J. Davis, and J. Ginsburg (eds), *Copyright and Piracy: an Interdisciplinary Critique* (2010).

<sup>32</sup> CDPA 1988, s. 16(3).

<sup>33</sup> These two situations are sometimes referred to as cases of ‘literal copying’ and ‘altered copying’. See e.g. *Designers Guild v. Williams* [2000] 1 WLR 2416, 2431 (Lord Scott).

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<sup>34</sup> This is an artificial distinction, because rarely will there be cases of pure partial copying or non-literal copying; most cases involve taking some literal fragments and some aspects of structure, organization, plot, theme, or idea. Nevertheless, the structure of EU law may imply such a distinction, and it will make the test relatively manageable.

<sup>35</sup> *England & Wales Cricket Board & Sky UK v. Tixdaq & Fanatix* [2016] EWHC 575 (Ch) [67]; J. Griffiths, ‘Dematerialization, Pragmatism and the European Copyright Revolution’ (2013) 33(4) OJLS 767, 784 ('part' test in Info. Soc. Dir., Art. 2, applies also to Arts 3 and 4).

<sup>36</sup> *Designers Guild v. Williams* [2000] 1 WLR 2426, 2426.

<sup>37</sup> The task of identifying the work is made easier because the claimants will specify in their statement of case the parameters of the work, as well as the parts of the work that they believe have been infringed. While not definitive, this provides a useful starting point for demarcating the scope of the work.

<sup>38</sup> (1991, unreported). See also *IPC Media v. Highbury-Leisure Publishing* [2005] EWHC 2985 (Ch), [2005] FSR (20) 434, [22] (Laddie J) (copyright is not a legal millefeuille with layers of different artistic copyrights); *Spelling Goldberg Productions v. BPC Publishing* [1981] RPC 283 (Buckley LJ); *Merchandising Corporation v. Harpbond* [1983] FSR 32, 39; *Coffey v. Warner/Chappell* [2005] FSR (34) 747.

<sup>39</sup> *Hyperion Records v. Warner Music* (1991, unreported).

<sup>40</sup> Ibid.

<sup>41</sup> Ibid. It is not always in the copyright owner's interests to define the work in this way. Where a defendant has taken small helpings from a number of separate publications, there may be benefits from asserting that the separate publications were, in fact, one. See e.g. *PCR v. Dow Jones Telerate* [1998] FSR 170, 183; *Electronic Techniques (Anglia) v. Critchley Components* [1997] FSR 401.

<sup>42</sup> *Ladbroke (Football) v. William Hill (Football)* [1964] 1 WLR 273, 293 (Lord Pearce); *Warwick Film v. Eisenger* [1969] 1 Ch 508.

<sup>43</sup> *Designers Guild v. Williams* [2000] 1 WLR 2416, 2431 (Lord Scott); *Cantor Fitzgerald International v. Tradition (UK)* [2000] RPC 95, 131; *Autospin (Oil Seals) v. Beehive Spinning* [1995] RPC 683, 697; *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275.

<sup>44</sup> *Ladbroke (Football) v. William Hill (Football)* [1964] 1 WLR 273, 293 (Lord Pearce); *Bowater Windows v. Aspen Windows* [1999] FSR 759, 781–2.

<sup>45</sup> *Designers' Guild v. Williams* [2000] 1 WLR 2416, 2421 (Lord Hoffmann), 2434 (Lord Scott). See also *Baigent v. Random House* [2007] EWCA Civ 247, [2007] FSR 579, [127]–[129] (Mummery LJ).

<sup>46</sup> *Designers Guild v. Williams* [2000] 1 WLR 2416, 2425 (Lord Millett).

<sup>47</sup> *Newspaper Licensing Agency v. Marks & Spencer plc* [2001] Ch 257, 268 (Peter Gibson LJ), 286–7 (Mance LJ).

<sup>48</sup> *Hawkes & Sons v. Paramount Film Service* [1934] 1 Ch D 593, 606 (Slesser LJ) (defendant's broadcast of part of the claimant's song, while not prolonged, was held to be 'a substantial, vital and essential part').

<sup>49</sup> *Designers Guild v. Williams* [2000] 1 WLR 2416, 2418 (Lord Bingham). See also *Newspaper Licensing Agency v. Marks & Spencer plc* [2001] Ch 257, 268 (Peter Gibson LJ), 287 (Mance LJ).

<sup>50</sup> *Sillitoe v. McGraw-Hill Book Co. (UK)* [1983] FSR 545, 549–50; *Hawkes & Sons v. Paramount Film Service* [1934] 1 Ch D 593 (CA), 605–6.

<sup>51</sup> In cases involving technical or esoteric subject matter, the court might rely on expert evidence from computer programmers, musicologists, choreographers, and other specialists as to the relative importance of the part: *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 302; *Cantor Fitzgerald International v. Tradition (UK)* [2000] RPC 95; *The Newspaper Licensing Agency v. Marks and Spencer plc* [2003] AC 551, [21].

<sup>52</sup> But note the emphatic statements of Lloyd LJ in *Baigent v. Random House* [2007] EWCA Civ 247, [2007] FSR 579, 620, [95], [97], that the intention of the copier is ‘irrelevant as a matter of law’ and ‘a red herring in modern English copyright law that ... should not be invoked in the future’.

<sup>53</sup> *Designers Guild v. Williams* [2000] 1 WLR 2416, 2420, 2426.

<sup>54</sup> *Warwick Films v. Eisinger* [1969] 1 Ch 508; *Hyperion Records v. Warner Music* (17 May 1991, unreported).

<sup>55</sup> D. Vaver, ‘Abridgments and Abstracts: Copyright Implications’ [1995] EIPR 225; R. Burrell, ‘Reining in Copyright Law: Is Fair Use the Answer?’ [2001] IPQ 361, 365 ff.

<sup>56</sup> *Designers Guild v. Williams* [2000] 1 WLR 2416.

<sup>57</sup> *Williamson Music v. Pearson* [1987] FSR 97, 107; *Schweppes v. Wellington* [1984] FSR 210; cf. *Glyn v. Weston Feature Film* [1916] 1 Ch 261 and *Joy Music v. Sunday Pictorial Newspapers* [1960] 2 QB 60 (both suggesting that the defendant’s effort is relevant, and if sufficient, parodies are non-infringing). On the new fair dealing defence for parody, see Chapter 9, section 8, pp. 265–9.

<sup>58</sup> *Ladbroke (Football) v. William Hill (Football)* [1964] 1 WLR 273, 276 (Lord Reid), 283 (Lord Evershed) (not only physical amount, but also substantial significance).

<sup>59</sup> *The Newspaper Licensing Agency v. Marks and Spencer* [2003] 1 AC 551, 559, [19]; *Designers Guild v. Williams* [2000] 1 WLR 2416, 2422, 2426 (Lord Millett); *Ladbroke (Football) v. William Hill (Football)* [1964] 1 WLR 273, 288 (Lord Hodson); *L. B. (Plastics) v. Swish Products* [1979] FSR 145, 152 (Lord Wilberforce), 159 (Lord Hailsham).

<sup>60</sup> *The Newspaper Licensing Agency v. Marks and Spencer* [2003] 1 AC 551, 559. Ascertaining parliamentary intention was relatively easy in relation to ‘typographical arrangements’ but may be less easy in relation to other works.

<sup>61</sup> At times, the courts come dangerously close to analysing quality in aesthetic terms and thus breaching the principle of ‘non-discrimination’, which they attempt to apply in the context of determining subsistence: cf. *Chappell v. D.C. Thompson* [1928–35] MacG CC 467 with *Kipling v. Genatosan* [1917–23] MacG CC 203.

<sup>62</sup> *Billhöfer Maschinenfabrik v. T. H. Dixon & Co.* [1990] FSR 105 (Hoffmann J).

<sup>63</sup> *Baigent v. Random House* [2007] EWCA Civ 247, [2007] FSR (24) 579, [145] (Mummery LJ).

<sup>64</sup> *Billhöfer Maschinenfabrik v. T. H. Dixon & Co.* [1990] FSR 105; *Francis Day & Hunter v. Bron* [1963] Ch 587, 623.

<sup>65</sup> *Hawkes & Sons v. Paramount Film Service* (1934) 1 Ch D 593, 609 (CA); *King Features v. Kleeman* [1941] AC 417.

<sup>66</sup> *Johnstone Safety v. Peter Cook* [1990] FSR 161, 178. See also *Rose Plastics GmbH v. William Beckett & Co* [1989] FSR 113, 123; cf. *Billhöfer Maschinenfabrik v. Dixon* [1990] FSR 105, 120.

<sup>67</sup> *Cantor Fitzgerald International v. Tradition (UK)* [2000] RPC 95, 130; *Data Access Corp. v. Powerflex Services* (1999) 45 IPR 353 (HCA).

<sup>68</sup> *Ladbroke (Football) v. William Hill (Football)* [1964] 1 WLR 273, 293 (Lord Pearce); *Designers Guild v. Williams* [2000] 1 WLR 2416, 2423 (Lord Hoffmann); *Merchandising Corp. v. Harpbond* [1983] FSR 32, 47; *IPC Media v. Highbury Leisure* [2005] FSR (20) 431, 443–4, [12]–[13].

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<sup>69</sup> [1940] AC 112.

<sup>70</sup> Ibid., 123–4.

<sup>71</sup> [1987] FSR 97.

<sup>72</sup> Ibid., 107.

<sup>73</sup> *Electronic Techniques Anglia v. Critchley Components* [1997] FSR 401, 410. See further *Infopaq International A/S v. Danske Dagblades Forening*, Case C-5/08, [2009] ECR I-6569, [49] (assuming that multiple searches of digitized version of daily paper, each followed by reproduction of an 11-word extract, might cumulatively infringe).

<sup>74</sup> *Electronic Techniques Anglia v. Critchley Components* [1997] FSR 401, 407–11.

<sup>75</sup> *Newspaper Licensing Agency v. Marks & Spencer* [2001] Ch 257, 269, [33] (Peter Gibson LJ). See also ibid., 288–9, [108] (Mance LJ).

<sup>76</sup> *Football League v. Littlewoods Pools* [1959] Ch 637 (whether such fixture lists would now be protected by copyright depends upon whether, as a result of the selection or arrangement, they could be said to be their author's own intellectual creation).

<sup>77</sup> Indeed, the fixture list case could have been an example of a single act, given that there was a preconceived course of action.

<sup>78</sup> *Cate v. Devon Constitutional Newspaper* (1889) 40 Ch D 500; *Trade Auxiliary v. Middlesborough* (1889) 40 Ch D 425.

There is a possibility of infringing *sui generis* database right: see Chapter 13, section 3.3, p. 387.

<sup>79</sup> *Newspaper Licensing Agency Components* [1997] FSR 401, 269, 288.

<sup>80</sup> *PCR v. Dow Jones Telerate* [1998] FSR 170, 183. But cf. *International A/S v. Danske Dagblades Forening*, Case C-5/08 [2009] ECR I-6569, [49] (not being so scrupulous).

<sup>81</sup> *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275.

<sup>82</sup> *Ladbrooke (Football) v. William Hill (Football)* [1964] 1 WLR 273 (HL).

<sup>83</sup> For criticism, see *Autospin (Oil Seals) v. Beehive Spinning* [1995] RPC 683; *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 289; *Cantor Fitzgerald International v. Tradition (UK)* [2000] RPC 95, 131 (Pumfrey J (test 'proves too much')).

<sup>84</sup> This was the view of the majority of the House of Lords in *Designers Guild v. Williams* [2000] 1 WLR 2416, 2418 (Lord Bingham), 2426 (Lord Millett), 2435 (Lord Scott). But cf. *Baigent v. Random House* [2007] EWCA Civ 247, [2007] FSR 579 (an inference of copying was drawn, but this was held not to be substantial) and *Nova Productions v. Mazooma* [2007] EWCA Civ 219, [2007] RPC 589, 599, [26].

<sup>85</sup> Software Dir., Art. 4(1)(a) ('in part or in whole').

<sup>86</sup> Database Dir., Art. 5(a) ('in whole or in part').

<sup>87</sup> Info. Soc. Dir., Art. 2 ('in whole or in part'), Recital 21. Strictly speaking, this relates to the reproduction right only, but Arnold J has said that in his view it applies to other harmonized rights (communication, making available, as well as distribution): *England & Wales Cricket Board v. Tixdaq* [2016] EWHC 575 (Ch), [67].

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<sup>88</sup> In the Fifth Edition we said this was ‘inconceivable’. We have changed this to ‘unlikely’ because in the context of related rights, the CJEU has applied a different test to infringement by distribution and infringement by reproduction: *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2019:62, [55]. However, in that context the CJEU was influenced by international law, whereas with authorial works there does not seem to be any relevant reason to deviate from a single test of ‘part.’

<sup>89</sup> Case C-5/08 [2009] *ECR I-6569*.

<sup>90</sup> Ibid., [38]; *Nintendo Co v. PC Box Srl*, Case C-355/12, EU:C:2014:25, [22].

<sup>91</sup> *Infopaq International A/S v. Danske Dagblades Forening*, Case C-5/08 [2009] *ECR I-6569*, [39].

<sup>92</sup> Cf. *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2018:1002, [AG28]–[AG29], [AG35] (AG Szpunar) (denying that there is a *de minimis* threshold applicable in the case of infringement of copyright in works).

<sup>93</sup> See *ibid.*, [49] (perhaps suggesting that it is only in the case of ‘lengthy fragments’ that a finding of infringement would be routine).

<sup>94</sup> [2010] *EWHC* 1829 (Ch), [244], [263] (Arnold J.).

<sup>95</sup> *SAS Institute v. World Programming* [2010] *EWHC* 1829 (Ch), [243], [244], [263] (Arnold J.).

<sup>96</sup> [2013] *EWCA Civ* 1482, [38]. The broad terms of Lewison LJ’s pronouncement may suggest that the English courts will apply the new European test even to parts of British law that have not been harmonized. One way in which to do so would be to highlight the similarities between the *Infopaq* test and that recognized by Lord Hoffmann in *The Newspaper Licensing Agency v. Marks and Spencer* [2003] AC 551.

<sup>97</sup> [2011] *EWCA Civ* 890, [24]–[28] (Chancellor Andrew Morritt).

<sup>98</sup> Case C-403/08 [2011] *ECR I-9083* (Grand Chamber), [156]–[159].

<sup>99</sup> J. Griffiths, ‘Dematerialization, Pragmatism and the European Copyright Revolution’ (2013) 33(4) *OJLS* 767, esp. 784 ff. Cf. Yin Harn Lee, ‘The Persistence of the Text’ [2018] *IPQ* 22 and 107.

<sup>100</sup> *Ibid.*, 788–90 (predicting judicial, or possibly legislative, responses).

<sup>101</sup> *Painer*, Case C-145/10, EU:C:2011:798, [97]; *Cofemel—Sociedade de Vestuário SA v. G-Star Raw CV*, Case C-683/17, EU:C:2019:363, [35]; [AG 31] (AG Szpunar).

<sup>102</sup> *Kenrick v. Lawrence* (1890) 25 *QBD* 99 (discussed in more detail at p. 253).

<sup>103</sup> See section 2.3.1, p. 220.

<sup>104</sup> *Designers Guild v. Williams* [2000] 1 *WLR* 2416, 2418 (Lord Bingham). See also *Newspaper Licensing Agency v. Marks & Spencer* [2001] *Ch* 257, 268, 287.

<sup>105</sup> *Newspaper Licensing Agency v. Marks and Spencer* [2003] AC 551, [19].

<sup>106</sup> *SAS Institute v. World Programming* [2010] *EWHC* 1829 (Ch), [243] (Arnold J) (opining that *Infopaq* took ‘the same approach’ as Lord Hoffmann). See further J. Griffiths, ‘Dematerialization, Pragmatism and the European Copyright Revolution’ (2013) 33(4) *OJLS* 767, 771 ff.

<sup>107</sup> Info. Soc. Dir., Art. 2(c) (phonograms), (d) (films), (e) (broadcasts). The right also applies to rights in performances: see *Heythrop Zoological Gardens v. Captive Animals Protection Society* [2016] *EWHC* 1370 (Ch), [41] (Birss J.).

<sup>108</sup> *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2018:1002, [AG30] (AG Szpunar) (distinguishing ‘phonograms’ from ‘works’ on two grounds: first that ‘works’ utilize unprotectable components (words, etc.) whereas ‘phonograms’ are ‘indivisible wholes’; and second, that protection or ‘works’ is premised on their originality).

<sup>1</sup>In this respect, it is notable that there is no requirement of ‘substantial investment’ comparable to that referred to for ‘*sui generis* rights’ in databases. The Court of Justice has used that requirement as a mechanism by which to sidestep the issue of what comprises a ‘database’: A. Ohly, ‘Economic Rights’, in E. Derclaye (ed.), *Research Handbook on the Future of EU Copyright* (2009), 212, at 215–16; *Apis Hristovich EOOD v. Lakorda ad*, Case C-545/07 [2009] *ECR I-1627*. See further Chapter 13, section 3.3, p. 387.

<sup>109</sup> *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2019:624.

<sup>110</sup> For the background to the reference, see *Metall auf Metall*, Case I ZR 112/06 (20 November 2008) (BGH) translated in N. Conley and T. Braegelmann, ‘*Metall auf Metall*: The Importance of the *Kraftwerk* Decision for the Sampling of Music in Germany’ (2009) 56 *J Copyright Soc’ USA* 1017; *Metall auf Metall*, Case I ZR 182/11 (13 December 2012), translated in (2017) *IIC* 343 and discussed in F. Niemann and L. Mackert, ‘Limits on Sampling Sound Recordings’ [2013] *E/PR* 356; BVerfG (Federal Constitutional Court), 31 May 2016—*Metall auf Metall* (Metal on Metal), 2016 *ZUM* 626, discussed by M. Mimler, ‘*Metall auf Metall*—German Federal Constitutional Court Discusses the Permissibility of Sampling of Music Tracks’ (2017) 7(1) *Queen Mary Journal of Intellectual Property* 119.

<sup>111</sup> Case C-476/17, *Pelham*, EU:C:2019:624, [29]. The reasons offered, at [30], were that the Directive expects a high level of protection and that sound recordings are a product of considerable investment.

<sup>112</sup> *Ibid.*, [35].

<sup>113</sup> *Ibid.*, [31]. The Court does not indicate whether this is the ear of the average listener or the musicological expert. The latter, of course, is likely to recognize much more than the former. When the case went back to Germany, the BGH used the test of the ‘average music listener’: BGH, Judgment of 30 April 2020, I ZR 115/16 (*‘Metall auf Metall IV’*), DE:BGH:2020:300420UIZR115.16.0, [29]. See B. Jütte and J. Quintais, ‘The Pelham Chronicles’ [2021] *JIPLP* 213, 217; Copinger (18th edn, 2021), [7–125] (preferring an average consumer test).

<sup>114</sup> *Ibid.*, [38].

<sup>115</sup> *Pelham GmbH v. Ralf Hütter and Florian Schneider-Esleben*, Case C-476/17, EU:C:2018:1002, [AG32] (AG Szpunar). Evidently, the Advocate-General’s concern that a qualitative threshold might be applied inconsistently in different member states is no longer a compelling reason to adopt the simpler test.

<sup>116</sup> Compare Laddie et al. (4th edn), 400, [6.29] (a point not retained in the 5th edition, [6.31]–[6.32]), suggesting it is not possible to speak in a meaningful way about the ‘important’ part of an entrepreneurial work, contending that the quality of the entrepreneurial work will not change throughout the work. For example, it has been argued that, while a three-second sample that contains the ‘hook’ of a song may be an important part of a musical work, it does not necessarily follow from this that the way in which the three seconds were recorded will be any different from the way in which the rest of the song was recorded. Indeed, it is more likely that the quality of the sound recording will be the same throughout the recording than that it will change from part to part. In the case of a sound recording, it seems that, on this basis, it would be wrong to treat the part that embodies the most distinctive, unusual, or catchy sounds as automatically representing the important part of the sound recording. This is because those parts may reflect, e.g., the musical work, performance, and so on, rather than labour, skill, and judgement in creating the recording itself.

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Moreover, if a brief recording of a bird chirping is itself protected, why should the equivalent part of any other recording (however long or sophisticated the remainder may be) also be regarded as protected? This analysis implies that the slightest shred of all of these productions should receive protection.

<sup>117</sup> Indeed, the Court itself embraced a ‘substantial part’ test in relation to the infringement of the right to distribute a sound recording.

<sup>118</sup> M. Senftleben, ‘Flexibility Grave—Partial Reproduction Focus and Closed System Fetishism in CJEU, Pelham’ (2020) 51 IIC 751, 758.

<sup>119</sup> A. Ohly, ‘Economic Rights’, in E. Derclaye (ed.), *Research Handbook* (2009), 212, 216. Advocate-General Szpunar indicated he was not persuaded by these arguments: EU:C:2018:1002, [AG28]–[AG40].

<sup>120</sup> [2016] EWHC 575 (Ch).

<sup>121</sup> *England & Wales Cricket Board & Sky UK v. Tixdaq & Fanatix* [2016] EWHC 575 (Ch), [99]. See also *Football Association Premier League v. QC Leisure* [2008] EWHC 1411, [2008] FSR (32) 789, [208]–[209] (Kitchin J) (holding that ‘action replays’ lasting a few seconds were a ‘substantial part’ of a 90-minute film of a football match).

<sup>122</sup> *Football Association Premier League v. QC Leisure* [2008] EWHC 1411, [2008] FSR (32) 789, [234]. In another case concerning buffering, Floyd J held that while the buffer copies might be a ‘substantial part’ of a film, they would not have been in relation to the broadcast: *ITV Studios v. TV Catch Up* [2011] EWHC 1874 (Pat), [110], [112] (Floyd J). It seems that Floyd J accepted counsel’s submission that ‘[t]he copyright which arises in a broadcast arises because of the collocation of subject matter which makes up the broadcast’. *ITV Broadcasting v. TV CatchUp* [2011] EWHC 2977, [27] (Floyd J) (‘I cannot see any basis on which it can sensibly be argued that there is a reproduction of a substantial part of a broadcast’). But cf. *Higgs* [2008] EWCA Crim 1324, [9] (suggesting that a single frame of a film might be protected, relying on CDPA 1988, s. 17(4)).

<sup>123</sup> [2003] AC 551 (HL).

<sup>124</sup> Ibid., [14].

<sup>125</sup> *Newspaper Licensing Agency v. Marks and Spencer* [2003] 1 AC 55.

<sup>126</sup> Laddie et al. (5th edn), [9.20].

<sup>127</sup> R. Arnold, ‘Content Copyrights and Signal Copyrights: The Case for a Rational Scheme of Protection’ (2011) 1 QMJIP 272 (explained in Chapter 6, section 2.2, pp. 159–60); *England & Wales Cricket Board v. Tixdaq* [2016] EWHC 575 (Ch), [60].

<sup>128</sup> *Harman Pictures v. Osborne* [1967] 1 WLR 723, 728; *Rees v. Melville* [1914] MacG CC 168; *Brighton v. Jones* [2005] FSR (16) 288, [63]–[66]. In relation to literary works, the taking of a plot of a novel or play can certainly infringe—if the plot is a substantial part of the copyright work: *Designers Guild v. Williams* [2001] 1 WLR 2416; *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 291.

<sup>129</sup> *Corelli v. Gray* (1913) 29 TLR 570; *Autospin (Oil Seals) v. Beehive Spinning* [1995] RPC 683, 697; *Kelly v. Cinema Houses* [1928–35] MacG CC 362.

<sup>130</sup> *Corelli* (1913) 29 TLR 570; *Rees v. Melville* [1914] MacG CC 168; cf. *Norowitzian v. Arks (No. 2)* [2000] FSR 67, 74, 76 (rhythm and pace, theme, and editing style were not subjects of copyright).

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<sup>131</sup> *Kelly v. Cinema House* [1928–35] *MacG CC* 362, 368. Cf. *Shazam v. Only Fool The Dining Experience* [2022] *EWHC* 1379 (IPEC), [131]–[136] (use of character attributes, catchphrases, etc., infringed copyright in scripts).

<sup>132</sup> *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] *FSR* 275, 292, 302; *Cantor Fitzgerald International v. Tradition (UK)* [2000] *RPC* 95, 133–4.

<sup>133</sup> [1977] *FSR* 557.

<sup>134</sup> While Whitford J was not willing to reach a final decision on copyright infringement, he was sympathetic to such a finding.

<sup>135</sup> [1977] *FSR* 557, 562.

<sup>136</sup> *Bauman v. Fussell* [1978] *RPC* 485; *Brooks v. Religious Tract Society* (1897) 45 *WR* 476.

<sup>137</sup> The principle that there can be no copyright in an idea has been described at the highest level as ‘trite law’: *L. B. (Plastics) v. Swish Products* [1979] *FSR* 145, 160 (Lord Hailsham), 165 (Lord Salmon).

<sup>138</sup> *Kenrick v. Lawrence* (1890) 25 *QBD* 99, 102.

<sup>139</sup> *Norowzian v. Arks* [2000] *EMLR* 67, 74, 76 (no copyright in film-editing style).

<sup>140</sup> For a warning about the use of this aphorism, see *Designers Guild v. Williams* [2000] 1 *WLR* 2416, 2422 (Lord Hoffmann); *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] *FSR* 275 (Jacob J).

<sup>141</sup> *The Newspaper Licensing Agency v. Marks and Spencer* [2003] 1 *AC* 55, 560, [20].

<sup>142</sup> [2000] 1 *WLR* 2416.

<sup>143</sup> Ibid., 2423. Discussed by Jacob LJ in *Nova Productions v. Mazooma* [2007] *EWCA Civ* 219, [2007] *RPC* 589, 601, esp. [35].

<sup>144</sup> [1984] *FSR* 399.

<sup>145</sup> (1890) 25 *QBD* 99.

<sup>146</sup> Ibid., 104.

<sup>147</sup> [2000] 1 *WLR* 2416, 2423.

<sup>148</sup> In particular, his speech leaves unclear what kind of connections make ideas part of the protected elements.

<sup>149</sup> Lord Hoffmann’s account seems to be incomplete, in that it omits techniques, methods, or style—matters that are usually considered unprotected: *Harman v. Osborne* [1967] 1 *WLR* 723, 728; *Norowzian v. Arks* [2000] *EMLR* 67, 74, 76; *Sawkins v. Hyperion* [2005] 1 *WLR* 3280, 3288, [29]; *IPC Media v. Highbury Leisure* [2005] *FSR* (20) 434, 444; *Baigent v. Random House* [2007] *EWCA Civ* 247, [146].

<sup>150</sup> There is an abundance of US literature: A. Yen, ‘A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work’s “Total Concept And Feel”’ (1989) 38 *Emory LJ* 393 (emphasizing the role and limitations of dichotomy in protecting freedom of speech); J. Litman, ‘The Public Domain’ (1990) 39 *Emory LJ* 965 (explaining the law’s reluctance to protect ideas, information, short phrases, simple plots, themes, stock scenes, and utilitarian solutions to concrete problems on the ground that they are difficult to trace); S. Vaidhyanathan, *Copyright and Copywrongs: The Rise of Intellectual Property and How It Threatens Creativity* (2001) (arguing that the distinction has been steadily collapsing and that it is crucial that we rediscover, reinvent, and strengthen the idea-expression dichotomy).

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<sup>151</sup> *Jones v. London Borough of Tower Hamlets* [2001] *RPC* (23) 407, 418–19.

<sup>152</sup> *Kleeneze v. DRG (UK) Ltd* [1984] *FSR* 399. See *Cofemel—Sociedade de Vestuário SA v. G-Star Raw CV*, Case C-683/17, EU:C:2019:363, [AG 60] (AG Szpunar) (highlighting the centrality of the idea-expression dichotomy to the policy of avoiding the protection of basic concepts for clothing designs).

<sup>153</sup> *Ashdown v. Telegraph Group Ltd* [2001] 3 *WLR* 1368, 1379, [2002] *RPC* 235.

<sup>154</sup> *Jones v. London Borough of Tower Hamlets* [2001] *RPC* (14) 379, 418–19, [27].

<sup>155</sup> [2006] *RPC* (3) 111.

<sup>156</sup> *Ibid.*, 162, [130].

<sup>157</sup> [2006] *RPC* (14) 379.

<sup>158</sup> [2007] *EWCA Civ* 219, [2007] *RPC* 589, 603, [44].

<sup>159</sup> [2006] *EWHC* 719, [2006] *FSR* (44) 893; (2007) *EWCA Civ* 247, [2007] *FSR* 579.

<sup>160</sup> [2006] *FSR* (44) 893, 952, [266].

<sup>161</sup> *Ibid.*, 926, [153], 951, [255]. See also at 963, [348].

<sup>162</sup> [2007] *EWCA Civ* 247, [2007] *FSR* 579, 618, [92], 621, [99] (Lloyd LJ), 622–3, [105] (Rix LJ), and [137], [153]–[154] (Mummery LJ).

<sup>163</sup> *Ibid.*, [156].

<sup>164</sup> *Jules Rimet Cup v. Football Association* [2008] *FSR* (10) 254.

<sup>165</sup> [2012] *EWPCC* 1. See also *Hodgson v. Isaac* [2010] *EWPCC* 37, in which the Patents County Court held that Isaac's film script 'Down among the Dead Men', the story of a wheelchair-bound football fan, was an infringing adaptation of the claimant's autobiography, *Flipper's Side*. The parties had initially been working towards an adaptation of Hodgson's story, but when the script began to deviate from his own account, Hodgson withdrew his consent. The Judge rejected the defendant's argument that it had relied on conversations with Hodgson as opposed to reading *Flipper's Side* and concluded that the amounts reproduced were substantial. More was taken than abstract biographical matters, including detailed incidents and, importantly, Hodgson's interpretation of those events: see [80]–[81].

<sup>166</sup> *Kenrick v. Lawrence* (1890) 25 *QBD* 99.

<sup>167</sup> *IViR, Recasting Copyright*, 53.

<sup>168</sup> Walter and von Lewinski, 970, [11.2.22]; J. Griffiths, 'Dematerialization, Pragmatism and the European Copyright Revolution' (2013) 33(4) *OJLS* 767, 784.

<sup>169</sup> *Eva-Maria Painer v. Standard VerlagsGmbH*, Case C-145/10 [2012] *ECDR* (6) 89, [AG129].

<sup>170</sup> Software Dir., Art. 1(2).

<sup>171</sup> [2013] *EWCA Civ* 1482; Case C-406/10, EU:C:2012:259 (Grand Chamber).

<sup>172</sup> [2010] *EWHC* 1829 (Ch), [64] (Arnold J) (explaining that there was no dispute that copyright subsisted in the manuals as original literary works).

<sup>173</sup> *Ibid.*, [251]; [2013] *EWCA Civ* 1482, [67].

<sup>174</sup> [2010] EWHC 1829 (Ch), [205], [254] (Arnold J).

<sup>175</sup> *SAS Institute v. World Programming*, Case C-406/10, EU:C:2012:259. In the Court of Appeal, Lewison LJ called it ‘disappointingly compressed, if not obscure’: [2013] EWCA Civ 1482, [5].

<sup>176</sup> [2013] EWCA Civ 1482, [27], [68].

<sup>177</sup> Ibid., [69].

<sup>178</sup> Ibid., [61], [63].

<sup>179</sup> [2010] EWHC 1829 (Ch), [260] (Arnold J), rejected at [2013] EWCA Civ 1482, [74].

<sup>180</sup> CDPA 1988, ss 22–4, 27. See Laddie et al. (5th edn), ch. 20; Copinger (18th edn, 2021), ch. 8.

<sup>181</sup> CDPA 1988, s. 22.

<sup>182</sup> Business is defined in CDPA 1988, s. 178, as including a ‘trade or profession’. See *Pensher Security Doors v. Sunderland City Council* [2000] RPC 249, 280–2.

<sup>183</sup> An art gallery carries on business even though certain paintings are not for sale: ibid., 282.

<sup>184</sup> CDPA 1988, s. 27.

<sup>185</sup> CDPA 1988, s. 27(6) referring to ss 32(5), 35(3), 36(5), 37(3), 56(2), 63(2), 68(4), and 141.

<sup>186</sup> See Chapter 9, section 8, pp. 265–9.

<sup>187</sup> CDPA 1988, s. 27(3), Sch. 1, para. 14(3).

<sup>188</sup> Described by Laddie et al. (5th edn), [20.18], as ‘far from straightforward’. One question that has been debated is who does the hypothetical making: the maker abroad, the importer, or someone else? Laddie et al. argue that the identity of the maker is not in issue; what is in issue is the purpose that the import is intended to fill.

<sup>189</sup> See Chapter 6, section 3.6, p. 166.

<sup>190</sup> Emphasis added.

<sup>191</sup> In between these two examples lies a device such as a media player (e.g. a so-called KODI box), which when adapted (by adding so-called ‘add ons’) and operated with a television may offer unauthorized access to pay-TV channels. Here, the device is specifically adapted to make transient copies of all the works streamed or broadcast. Nevertheless, it is suggested that this falls outside the scope of CDPA, s. 24, as the device is not specifically designed to make copies of particular works.

<sup>192</sup> Defined in CDPA 1988, s. 25(2), to include premises occasionally used for public entertainment.

<sup>193</sup> CDPA 1988, s. 25(1).

<sup>194</sup> CDPA 1988, s. 26(2).

<sup>195</sup> CDPA 1988, s. 26(3). For a possible example, see *PRS v. Kwik-Fit Group* [2008] ECDR (2) 13 (OH CS).

<sup>196</sup> CDPA 1988, s. 26(4).

<sup>197</sup> CDPA 1988, s. 296ZA. See section 4.1.1, pp. 391–2.

<sup>198</sup> CDPA 1988, s. 296ZD. See section 4.1.2, pp. 392–3.

<sup>199</sup> CDPA 1988, s. 296(1). See section 4.2, pp. 397–8.

<sup>200</sup> *Vermaat v. Boncrest (No. 2)* [2002] FSR (21) 331, [30]; Laddie et al. (5th edn), [20.7]–[20.8].

<sup>201</sup> *LA Gear v. Hi-Tec Sports* [1992] FSR 121, 129.

<sup>202</sup> The normal period is often 14 days. Cf. *Monsoon v. Indian Imports* [1993] FSR 486.

<sup>203</sup> *Hutchinson Personal Communications v. Hook Advertising* [1995] FSR 365; *Metix UK v. Maughan* [1997] FSR 718.

<sup>204</sup> *ZYX Music GmbH v. King* [1997] 2 All ER 129.

<sup>205</sup> *Pensher Security Doors v. Sunderland City Council* [2000] RPC 249.

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