Federal Court of Australia

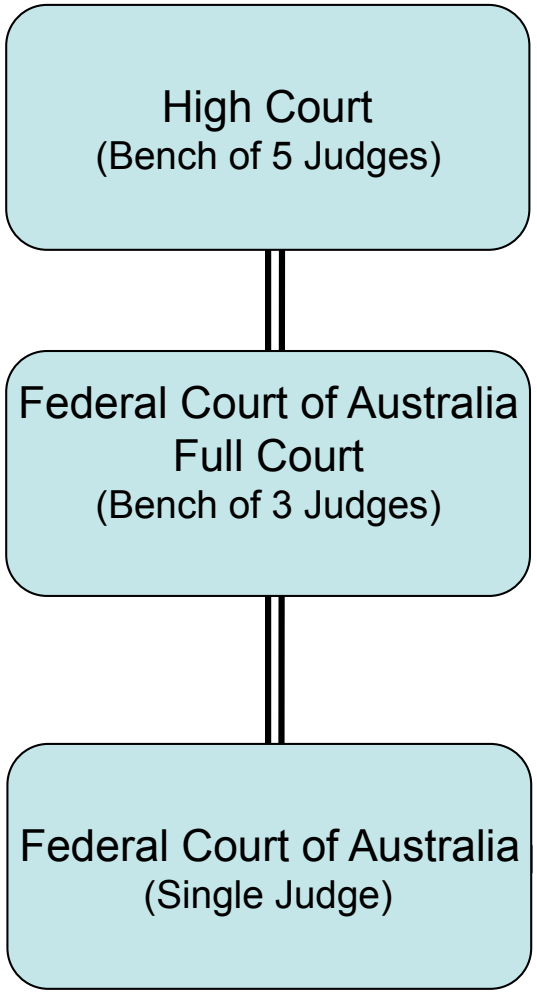
International Federation of Intellectual Property Attorneys

Judges Without Borders – How Judges Use Decisions From Other Countries

Justice Chris Jessup

IP Courts

Federal Court of Australia



Aktiebolaget Hassle & Anor v Alphapharm Pty Limited
(2002) 212 CLR 411

- Judge Rich – *In re O'Farrell (1988) 838 F 2d 894, 903:*

  The admonition that "obvious to try" is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. ... In others, what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.

Copyright Agency Ltd v New South Wales (2008) 233 CLR 279

- *"These comparative considerations emphasise the general reach of s 183(1) of the Act and the deliberate choice of the Parliament to combine the exception to infringement, for government use, with a remuneration scheme, rather than to frame the exception as a fair dealing, or otherwise as a free use"* [79]

Koninklijke Philips Electronics NV v Remington Products Pty Ltd (2000) 100 FCR 90

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- *Remington Rand Corp v Philips Electronics NV* (1995) 64 CPR (3d) 467, 477-478:

  "It is clear that every form of trade mark ... is characterized by its distinctiveness. … A mark which goes beyond distinguishing the wares of its owner to the functional structure of the wares themselves is transgressing the legitimate bounds of a trade mark".

Desktop Marketing Systems Pty Ltd v Telstra Corporation Limited (2002) 119 FCR 491

- ***Feist Publications Inc v Rural Telephone Service Co Inc*** **(1991) 499 US 340**

Lindgren J

- Her Honour went on to hold that although the originality requirement does not pose a stringent standard in the case of a factual compilation, nonetheless "the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever [and] [t]he standard of originality is low, but it does exist" (at 362). Her Honour said that Rural's White Pages were "entirely typical" and that in preparing them, Rural had simply taken the data provided by its subscribers and listed the data alphabetically by surname. She said (at 362): *"The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity."*

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- Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course .... It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution [363].

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- The terms of §101, §102 and §103, of the 1976 US Act (set out at [194] above), when understood against the background to their enactment, put it beyond question that in the United States the requirement of originality in relation to a factual compilation is not satisfied by mere independent creation coupled with the labour and expense of collecting and verifying the data to be compiled. Rather, it requires independent creation coupled with intellectual effort or a spark of creativity [203].

- The United States and Canadian cases mentioned do not persuade me that this Court, at the intermediate appellate level, should depart from the long course of Anglo-Australian authority referred to earlier. If that is to be done, it must be done by the High Court [217].

Sackville J

- Doubtless there would be good reasons to follow *Feist* in Australia if, from a policy perspective, its approach offers clear advantages over one which protects industrious compilations. The policy question essentially revolves around the means of resolving the tension between providing incentives to produce potentially useful works and encouraging free access to information or "raw facts". … The danger in refusing copyright protection to an industrious compilation is that a potential compiler will be deprived of the incentive to undertake work that may prove to be of great value. It is doubtless for this reason that the United Kingdom, in accordance with the *1996 Directive* issued by the European Union, has established a separate regime for databases, including a *sui generis* property right called a "database right", which applies regardless of whether the database is a copyright work …. [424]

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