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Australia - Copyright in Databases/Compilations – The Ice Case –

Is any use of information in a database subject to copyright permitted?

**Nine Network Australia Pty Limited v IceTV Pty Limited
[2009] HCA 14**

Overview

On 22 April 2009, the High Court of Australia allowed an appeal by IceTV Pty Limited (“**IceTV**”), finding that there was no infringement by IceTV of copyright held by Nine Network Australia Pty Limited (“**Nine**”) in its television program schedules. The High Court unanimously held that IceTV did not infringe Nine’s compilation copyright as there was no substantial reproduction of Nine’s program titles and times in IceTV’s subscription-based electronic program guide for television.

This decision has ramifications for parties who hold copyright in a compilation which comprises information. It is now arguable that persons seeking to use commercially available information contained in a compilation, including a schedule or timetable, in which another party holds the copyright, may have the right to do so without a licence from that party. This is not completely free from doubt but the degree of risk involved has lessened as a result of the IceTV decision.

Among the possible consequences of the High Court’s decision are:

- copyright protection in a compilation extends only to the expression of information and not to the information itself;
- small (or obvious) quantities of information taken from a compilation work may not be a ‘substantial part’ of the work for the purpose of determining whether infringement has occurred;
- for infringement of copyright in a compilation to be established, the particular form of expression adopted must be original;

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- a person may not be liable for copyright infringement where they have used skill and creativity in producing a new work, even where that new work incorporates part of another's compilation work;
- a higher burden exists to establish infringement of copyright in a compilation which comprises factual information.

Background

IceTV provided a subscription-based, interactive EPG called "IceGuide", which allowed its customers to view television program schedules on a television screen or computer. IceGuide could be used to record free-to-air television programs with certain program recording devices. In order to receive IceGuide, subscribers had to connect their program recording device to the Internet. IceGuide data was held by IceTV in a database. A program recording device could then be programmed to connect to the database and collect and download the latest version of IceGuide for a 6-8 day period.

IceTV prepared the IceGuides by creating templates of time and title information from TV channels. This template was then updated daily by IceTV employees by checking the information through "aggregated guides". The aggregated guides are prepared by "aggregators", who compile television programming data supplied by different television broadcasters, including Nine, under licence.

In May 2006, Nine commenced proceedings against IceTV for copyright infringement, claiming that IceTV had infringed Nine's copyright in their weekly television programme schedules ("**Weekly Schedules**"). Nine's case was that IceTV had copied time and title information from the aggregated guides, and thus indirectly copied Nine's copyright work.

Nine argued that it had applied considerable skill and labour in making programming decisions, which were documented in the Weekly Schedules. In selecting and arranging programs, Nine considered numerous factors such as likely size and demographic composition of audiences, programming decisions of competitors, advertising revenue, and the availability of broadcast rights. As a result, the skill and labour expended by Nine in balancing these considerations gave the Weekly Schedules the character of original literary works. By reproducing the Weekly Schedules in the IceTVGuide, Nine claimed that IceTV was appropriating a 'substantial part' of Nine's original literary work.

Legislation

Section 32 of the *Copyright Act 1968* (Cth) ("**Act**") provides that copyright subsists in, inter alia, published and unpublished original literary works. Under section 10 of the Act, a "literary work" can include a "table, or compilation, expressed in words, figures or symbols." In accordance with section 31, copyright is the exclusive right to reproduce the work in a material form, to publish the work, and to communicate the work to the public.

Under section 36, copyright is infringed in respect of a literary work by "a person who, not being the owner of the copyright, and without the licence of the owner of the copyright, does in Australia, or authorises the doing in Australia of, any act comprised in the copyright." Pursuant to section 14 of the Act, copyright is infringed under section 36 if such an act is done in respect to a "substantial part" of a work.

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Trial

It was not in dispute that Nine had copyright in Weekly Schedules. Rather, the issue considered by the Court was whether IceTV had infringed Nine's copyright in the Weekly Schedules by indirectly copying the program times and titles from the aggregated guides.

At first instance, Bennett J, rejected the claim of copyright infringement by Nine. Her Honour held that, although copyright did subsist in the Weekly Schedules as compilations, Nine had not established that IceTV reproduced a substantial part of Nine's copyright works.

Her Honour also found that Nine's skill and labour had not been primarily expended for the purpose of creating a literary work. Rather, Nine's skill and labour was chiefly utilised in respect of selecting programs to maximise television audiences, which was merely 'preparatory' to tabulating the Weekly Schedules. Thus, there was not "a relevant appropriation of that skill and labour by Ice in composing the IceGuide"¹. Her Honour did not consider that, by taking excerpts of time and title information and incorporating them into their own guide, IceTV had reproduced a 'substantial part' of Nine's copyright work.

Her Honour also confirmed that a 'substantial part' should be decided according to the quality of the work reproduced and the protection of the relevant skill and labour, rather than the quantity. Ice had "not take(n) sufficient of the skill and labour of the content of the Aggregated Guides, let alone the Weekly Schedule, to constitute a substantial part."²

Appeal to the Full Federal Court

On appeal, the Full Federal Court held that IceTV had indirectly copied a substantial part of Nine's copyright work.

The Full Federal Court considered that the trial judge erred by distinguishing between the skill and labour in selecting program times, and the skill and labour in tabulating the results. The Court stated that skill and labour expended by Nine were part of a single, continuous process culminating in the creation of the copyright work as the "written record of Nine's programming decisions and associated program information."³

In considering whether a substantial part of Nine's Weekly Schedules had been reproduced, the Court found that even a small quantity of information could constitute a 'substantial part' of the copyright work. Further, the Court was of the opinion that, where small quantities are systematically taken on a regular basis, as in this case, it would be particularly willing to conclude that copyright infringement had taken place.

Accordingly, the Court held that the time and title information used by IceTV in the IceTVGuide constituted a substantial part of Nine's compilation copyright work on the basis that the information was a "crucial element"⁴ of the work, and the outcome of considerable skill and labour expended by Nine.

¹ *Nine Network Australia Pty Ltd v IceTV Pty Ltd* [2007] FCA 1172 (9 August 2007) at 193 per Bennett J.

² [2007] FCA 1172 (9 August 2007) at 210 per Bennett J.

³ *Nine Network Australia Pty Limited v IceTV Pty Limited* [2008] FCAFC 71 (8 May 2008), 111 per Black CJ, Lindgren and Sackville JJ.

⁴ *Supra* at 109 per Black CJ, Lindgren and Sackville JJ.

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Decision of the High Court

IceTV was granted special leave to appeal the Full Federal Court decision, and the matter was heard over two days in the High Court in November 2008. The decision of the High Court consisted of two joint judgments.

French CJ, Crennan and Kiefel JJ noted that “copyright does not protect facts or information”⁵. Therefore, in considering whether IceTV had reproduced a substantial part of Nine’s compilation, their Honours looked at the quality of the reproduction, and not simply the quantity. One ‘critical factor’ of the quality was the originality of the infringed work. Nine’s Weekly Schedules were found to have an “obvious and prosaic” arrangement of time and title information, and as such lacked originality⁶.

The skill and labour used in respect of compilations must be focused on the originality of the expression of work, rather than any considerations of “industrious collection” or “creativity”. Their Honours held that the Nine employees expended ‘minimal’ skill or labour in expressing the time and title information.

Gummow, Hayne and Heydon JJ found that, due to a lack of legislative guidance relating to compilations (such as the EU Database Directive, which protects the whole or substantial part of the compilation), the Full Federal Court had decided correctly that IceTV did appropriate the “fruits of Nine’s skill and labour”. However, their Honours noted that skill and labour alone were not protected by the Act, and it was inappropriate to give consideration only to the skill and labour involved as this would mean that other issues, such as authorship and whether a substantial part had been adopted, would be cast aside.

In considering whether there was infringement of a ‘substantial part’, their Honours held that the Full Court had erred in their consideration of the interest which the copyright protects, and took the view that the Full Court’s decision resulted in the ‘ideas’ of Nine being protected, rather than the fixed expression (i.e. of the Weekly Schedule). In doing so, the Full Court “tipped the balance too far against the interest of viewers of digital free to air television”⁷.

Therefore, their Honours held that IceTV did not derive a ‘substantial part’ of the work from the Weekly Schedule, but had derived the time and title information from the Aggregated Guides.

Conclusion

On 22 April 2009, the High Court ordered that the appeal be allowed with costs, and the order of the Full Court to be set aside. The High Court’s decision establishes the difficulties now involved in a copyright owner establishing successfully infringement of copyright in a compilation which comprises information.

The assistance of Jenny Kojevnikov, clerk, in writing this article is appreciated.

⁵ [2009] HCA 19 at 28 per French CJ, Crennan and Kiefel JJ

⁶ [2009] HCA 14 (22 April 2009) at 43 per French CJ, Crennan and Kiefel JJ

⁷ Ibid, at 160.



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