the most obvious level, patents create monopoly rights that prohibit other producers from exploiting the invention.[90] While innovative products are likely to have substitutes,[91] the patent provides market power because it enables product differentiation, that is to say the patentees' product will be different from competing products.[92] The higher the degree of market power, the greater the ability of the producer to increase the price. Moreover, the grant of market power also increases the capacity of the right holder to engage in anti-competitive conduct,[93] a concern expressed in the IPCRC Report, which described the potential for intellectual property rights 'as a mere camouflage for entering into agreements to fix prices, to divide markets and/or in other ways to monopolise supply'.[94]

Intellectual property rights promote innovation especially in works that are risky and/or require substantial capital investment.[95] But this must be contrasted with the harm to consumers that occurs when the granting of intellectual property rights gives such market power that it facilitates anti-competitive conduct. As stated in the IPCRC Report, the 'correction of one form of market failure creates another'[96] – the use of the intellectual property system to relieve the free-rider problem and to increase innovation can create anti-competitive conduct.

Moreover, there is no necessary relationship between the inventive merit of a given patent, or the amount of research and development devoted to it, and the commercial value of the legal monopoly conferred by the patent. A mere 'scintilla of inventiveness' is sufficient[97] and 'no smallness or simplicity will prevent a patent being good'.[98]

Conclusion

Menck recorded a decisive victory for intellectual property rights over competition principles, a victory that, in the specific case of RPM, endured for 60 years. Its relative obscurity is all the more remarkable.

90 *Patents Act 1990* (Cth), s. 13; J McKeough, 'Is Intellectual Property Different, or Are All Unhappy Monopolists Similar?' (2003) 9 *UNSW Law Journal Forum* 40, 40; and B Yu, 'Potential Competition and Contracting in Innovation' (1981) 24 *Journal of Law and Economics* 215, 215.
91 G Adams and D McLennan, 'Intellectual Property Licensing and Part IV of the Trade Practices Act: Are the TPA's Pro-competitive Provisions Anti-IP Commercialisation?' (2002) 51 *Intellectual Property Forum* 10, 14.
92 Market power reduces constraints from other competitors and consumers: *Queensland Wire Industries Pty Ltd v Broken Hill Pty Co Ltd* (1989) 167 CLR 177, 200 (Dawson J).
93 IPCRC, op. cit., p. 27.
94 ibid., p. 26.
95 McCarthy, op. cit., p. 201.
96 IPCRC, op. cit., p. 25.
97 *Meyers Taylor Pty Ltd v Vicarr Industries Ltd* (1977) 137 CLR 228, 249.
98 *Vicars, Sons & Co v Siddell* (1896) 14 RPC 105, 115.

4

Horses and the law: the enduring legacy of *Victoria Park Racing*

Jill McKeough*

Introduction

The Victoria Park Racing and Recreation Ground was a popular racecourse in Sydney in the 1930s. Built on an open fairground, the owners erected a fence around the track to ensure that only ticket buyers could watch the action or place bets on the races. The defendant, Taylor, built a tower that was used by a Mr Angles to peer over the fence and, using a telephone, broadcast descriptions of the races on radio 2UW. In *Victoria Park Racing and Recreation Grounds Company v Taylor* (*Victoria Park Racing*),[1] both the neighbour and the broadcaster were sued in nuisance and infringement of property rights by the owners of the racecourse. The High Court dismissed the suit but the minority judgment of Evatt J foreshadowed the potential problems for those mounting spectacles and events with the advent of television on the horizon.

Victoria Park Racing is still an important decision in the light of attempts to expand notions of property and control of information. The case is not only about intellectual property, as conceived in terms of creators' rights, and the extent to which rewards of entrepreneurial activity can be protected as a form of property, but property law in general. The case foreshadows some of the great debates on whether the 'sweat of the brow' leads to creation of protectable subject matter;[2] whether the common law recognises rights of privacy; and whether using baseball statistics somehow infringes on personality rights. The principles discussed are relevant, for example, to attempts by sports associations

* I would like to acknowledge the work of my research assistant, Katherine Giles, BA/LLB (UTS).
1 (1937) 58 CLR 479; 1A IPR 308.
2 See *Feist Publications Inc v Rural Telephone Co Inc* (1991) 20 IPR 129; *Jewler's Circular Pub Co v Keystone*

and various sporting leagues and codes to assert control over athlete blogging, posting photographs, podcasting (audio online), vodcasting (video online) and the use of player statistics.[3] It raises copyright issues and is frequently cited for the proposition that copyright in compilations is conferred by the exercise of skill, judgment or labour, and that this can amount to originality even where the compilation consists of existing material.[4] In addition, the case demonstrates a particular use of legal method and approach to action on the case. In declining the opportunity to formulate a property right in spectacles such as sporting events, the majority 'cautioned against the use of ... a unity of underlying principle between different causes of action when, in truth, there is none'.[5]

Judicial decisions to recognise or to refuse recognition of novel proprietary interests are influenced by more general theories about the purposes and justifications for the existence of private property. *Victoria Park Racing* is, perhaps, an 'anti-proprietarianism'[6] example of a case. In *A Philosophy of Intellectual Property*, Peter Drahos explains proprietarianism as

> a creed and an attitude which inclines its holders towards a property fundamentalism ... A person who is first connected with an object that has economic value or with an activity that produces economic value is entitled to a property right in that object or activity. The property right can be thought of as an extraction right. It is a right to extract or appropriate economic value.[7]

Drahos proposes an instrumental rather than a proprietarian approach to the law of intellectual property.[8] The proprietarian approach, he posits, is a 'property fundamentalism' that assigns property rights a fundamental and entrenched status. According to Drahos, instrumentalism in this sense refers to the idea that law is a tool that recognises the social costs of intellectual property protection, rules out the idea of property as a natural right, and displays a scepticism concerning any theory based on the idea that property is a subjective right.[9] As Drahos maintains: 'Instrumentalism would require a strongly articulated conception of the public purpose and the role of intellectual property.'[10] The apparent conservatism of the majority in *Victoria Park Racing* is based on a refusal to extrapolate doctrine to novel situations without a compelling justification.

3 M Geist, 'Silencing Sports Bloggers', *Mediacheck*, 7 January 2008, available at http://thetyee.ca/Mediacheck/2007/07/10/SportsBloggers/.
4 *Murray v King; King v Murray and Anor* (1983) 2 IPR 99; *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* (2002) 55 IPR 1; *TR Flanagan Smash Repairs Pty Ltd and Anor v Jones* (2000) 48 IPR 19; *Autodesk Inc and Anor v Dyason and Ors* (1992) 22 IPR 163; *Andrew Cash & Co Investments Pty Ltd v Porter and Ors* (1996) 36 IPR 309; *Millwell Pty Ltd v Olympic Amusements Pty Ltd* (1999) 43 IPR 32.
5 *Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd* (2001) 208 CLR 199, 250; (2002) 54 IPR 161, 192 (Gummow and Hayne JJ), referring to *Moorgate Tobacco v Philip Morris* (1984) 3 IPR 545, 562 (Deane J), who was in turn discussing *Victoria Park Racing* and *International News Service v Associated Press* (1918) 248 US 215.
6 P Drahos, *A Philosophy of Intellectual Property Law*, Dartmouth, Aldershot, 1996, p. 201.
7 ibid.
8 ibid., pp. 199–200.
9 ibid., pp. 213–16.

Background to the case

Racing has been an integral part of the economy since the earliest days of the Australian colonies. Besides being a spectator sport, horse racing is also a major industry, which provides full-time or part-time work for almost 250 000 people. In addition, some 330 000 people have a direct interest as owners or members of syndicates in the 31 000 horses training in Australia.[11] All this is usually hidden, however, until an event like equine flu exposes the data to our gaze. On 28 February 2008 New South Wales was declared free of equine influenza[12], following a year of severe restrictions on the transport of horses, racing and other activities associated with horses. In 2007 equine influenza arrived in Australia (most probably from Japan) and affected Sydney first and most of all. The 'darkest day in racing history'[13] occurred when Randwick racecourse was locked down for at least three months and the Sydney Spring Racing Carnival was cancelled. There was much discussion in the press relating to the economic effects on the Australian racing industry, which is a major employer of up to 50 000 people in New South Wales alone. The loss of income to the state coffers and individual bookmakers was also 'in the hundreds of millions'.[14]

Thoroughbred horse racing is the third most-attended spectator sport in Australia, behind only Australian rules football and rugby league, with almost two million admissions to the 379 racetracks throughout Australia in 2002–03.

In the 1930s horse racing was no less important, in fact more so in the context of no television, no internet, silent movies and early closing.[15] In *Victoria Park Racing* the High Court was dealing with a case that went to the heart of the leisure activities of the time. Seven horses arrived with the First Fleet and as the Australian colonies developed, the community began to rely on fast, sound horses in order to explore the continent and provide transport. Sporting interests based around horses emerged early with unofficial racing, including over large distances,[16] and a reference to a racecourse was made in the *Sydney Gazette* in 1805, although the first official meeting took place in what is now Hyde Park in October 1810.[17]

11 Available at http://en.wikipedia.org/wiki/Thoroughbred_racing_in_Australia.
12 NSW Department of Primary Industries, 'Equine Influenza Conquered: Macdonald', 28 February 2008, available at http://www.dpi.nsw.gov.au/aboutus/news/recent-news/agriculture-news-releases/equine-influenza-conquered.
13 J Fife-Yeomans and R Thomas, 'The Darkest Day in Racing History', *Daily Telegraph*, 31 August 2007, available at www.news.com.au/dailytelegraph/story.
14 'Horse Flu to Hurt Economy, Warns Treasurer Costello', *Herald Sun*, 27 August 2007, available at http://www.news.com.au/heraldsun/story/0,21985,22314190-662,00.html.
15 'Early closing' was the 6pm closing of hotel bars, introduced in Australia during World War I; populous states abolished it in the 1950s and 60s. For background see, for example, http://australianscreen.com.au/titles/australia-today-lucky-strike/clip3/.
16 For example, Hawkesbury to Sydney. See J Churchill, 'NSW: The Birthplace of the Thoroughbred in Australia', *Thoroughbred Breeders New South Wales*, 3 October 2006, p. 1, available at http://www.tbnsw.com.au/aushistory.htm.
17 W Peake, 'Unregistered Proprietary Horse Racing in Sydney 1888–1942', UWS PhD thesis, chap. 1, p. 30,

> All elements of the white community, including women and children, attended Sydney's first formal race meeting organised by the 73rd Regiment at the Hyde Park racecourse in October 1810, a holiday having been declared for each of the three days, which consisted entirely of heat racing. Later Hyde Park meetings included pony races – not as part of the advertised program, but in the form of impromptu challenges arranged to satisfy the desire for additional racing. This extempore organisation was to be the model for pony racing for the next 80 years.[18]

From the earliest days of the 20th century racing thrived, with clubs being formed by 'proprietary groups' of speculators from about 1900. Among these was the Associated Racing Clubs (ARC), a non-profit organisation racing under the patronage of the government and in opposition to the Australia Jockey Club (formed in 1828).[19] Races organised by the ARC were known as 'pony' meetings. Victoria Park was the base for 'pony racing' and was completed in January 1908, the last course for galloping to be constructed in metropolitan Sydney.[20] The importance of the 'proprietary courses' was the capacity to determine the type of betting and the persons who could attend; 'By building racecourses on their own land at their own expense, where racing could be conducted as seen fit, and in pursuing their own ends in determining who would be allowed to attend.'[21] Importantly the upkeep of the track could be organised by the owners. The damage done to tracks by racing meant that those on government-owned land could only host two to three meetings a year, in the absence of somebody prepared to undertake the upkeep of the track.

The first Victoria Park meeting, which the club promoted as 'the event of the year', took place on Wednesday, 15 January 1908, followed by a second meeting three days later. The completion of Victoria Park marked the end of the great era of racecourse building in Sydney. Intended to become a Sydney institution, it was used as a racecourse for less than 35 years. Victoria Park racecourse was in fact the most ambitious and most expensive project associated with the creation of a Sydney pony racecourse. James Joynton Smith, manager of Brighton and Epping racecourses, wanted a track that would rival Randwick. Smith and his companies spent an estimated £70 000 on the development of Victoria Park racecourse.[22] In fact, it could be said that '[t]he position of and the improvements to the land thus fit it for a racecourse and give its occupation a particular value'.[23]

Legal analysis

This is primarily a property case in which the full High Court considered whether to recognise or refuse recognition of a new form of proprietary interest. There

18 ibid.
19 Churchill, op. cit, p. 3.
20 ibid, p. 28.
21 'Sweepstake' betting, which allows more fun at more affordable odds, is a feature of 'proprietary racing' and is a whole study in itself: see ibid., pp. 29–30.

were three separate judgments by the majority and two separate dissenting judgments. The dissenters, Evatt and Rich JJ, found in favour of the plaintiffs by relying on the tort of nuisance. The majority, Latham CJ, Evatt and McTiernan JJ, took the view that nuisance should not be stretched to cover these particular facts and, finding it too difficult to define 'property in a spectacle'[24] in accordance with underlying legal principle, declined to give such a thing proprietary status. Infringement of copyright was also argued in use of the information concerning the names of the horses, their positions, the jockeys, and so on, but this was held by the majority not to be a literary work.[25]

In the report of the High Court case it is possible to discern a certain criticism of the pleadings at first instance in the Supreme Court of New South Wales. The majority judges seemed to be saying that they were 'not quite certain what the plaintiffs were expecting us to do although certainly the plaintiffs expect some relief'. In fact, Latham CJ was quite contemptuous of the nature of the plaintiff's argument:

> It has been argued that by the expenditure of money the plaintiff has created a spectacle, and that he therefore has what is described as a quasi-property in the spectacle which the law will protect. The vagueness of his proposition is apparent upon its face. What it really means is that there is some principle (apart from contract or confidential relationship) which prevents people in some circumstances from opening their eyes and seeing something and then describing what they see ... the mere fact that damage results to a plaintiff from such a description cannot be relied upon as a cause of action.[26]

On Latham CJ's view, labelling the subject-matter 'quasi-property' indicated that the plaintiff did not really believe a proprietary interest could subsist. The plaintiff's argument that staging of a spectacle is proprietary and that the defendants and Angles were, by their actions, interfering with that property right, was far too vague and imprecise; a spectacle can be 'property only in a metaphorical sense', any appropriateness in the metaphor would depend on the existence of the legal principle. The principle cannot be based upon such a metaphor'.[27] Furthermore, damages were impossible to assess as there was no way of knowing whether people would have bought a ticket (although the plaintiffs were seeking an injunction partly because the damage could not be calculated and there was little doubt the interference would persist).

In order to conform to a more conventional form of pleadings, the action was framed in nuisance. The majority dealt with the nuisance case fairly conventionally and easily: 'It is not shown that the broadcasting interferes with the use and enjoyment of the land or the conduct of the race meetings or the comfort or enjoyment of any of the plaintiff's patrons.'[28] In dealing with the rather novel claim of infringement of a property right, both Latham CJ and Dixon J took a fairly similar line. Latham CJ applied a more 'legalistic' approach, arguing that use of

24 ibid., p. 496; 1A IPR 308, 311 (Latham CJ).
25 ibid., p. 511; 1A IPR 308, 320 (Dixon J).

the term 'quasi-property' was an admission of lack of a case and not a doctrine within any known case law. Similarly, Dixon J declined to accept the American doctrine of 'quasi-property' or recognition of 'broadcast rights' in respect of the races, referring instead to the history of intellectual property rights as 'dealt with in English law as special heads of protected interest, and not under a wide generalisation'.[29]

Dixon J applied a typical 'Dixon analysis': strong on legal history and discussing the development of negligence with nuisance as an action on the case. His judgment contains an admission that the law was once more flexible so that the judges, by developing the action on the case, were able to expand the common law to accommodate new wrongs where an existing writ did not fit the bill. Nuisance itself came from an action on the case,[30] but apparently by 1937 the possibility of the law developing as it had in the past was no longer appropriate and this was too novel an action: 'the right to exclude the defendants from broadcasting a description of the occurrences they can see upon the plaintiff's land is not given by law. It is not an interest protected in law or equity'.[31] With respect to action on the case in the nature of nuisance, Dixon J said:

> The feature in which the plaintiff finds the wrong of the nuisance is the impairment or deprivation of the advantages possessed by the plaintiff's land as a racecourse by means of a non-natural and unusual use of the defendant's land ... the fact is that the substance of the plaintiff's complaint goes to interference, not with its enjoyment of the land, but with the profitable conduct of its business. If English law had followed the course of development that has recently taken place in the United States, the 'broadcasting rights' in respect of the races might have been protected as part of the quasi-property created by the enterprise, organisation and labour of the plaintiff ... But courts of equity have not in British jurisdictions thrown the protection of an injunction around all the intangible elements of value ... which may flow from the exercise by an individual of his powers and resources ...[32]

The majority of the court relied on the dissent of Brandeis J in *International News Service v Associated Press*[33] to dismiss the notion of 'quasi-property'. This case 'has long occupied a prominent place in American legal education',[34] and been used as an example of the 'incremental power of common law reasoning'[35] as compared with the lumbering legislature's attempts to balance competing public policies. The case dealt with news gathered by International News Service from Associated Press newspapers, bulletin boards, news services and newspapers. Taking advantage of time differences between the east and west coast of the US, International News Service provided rewritten stories to newspapers on the

29 ibid., p. 509; 1A IPR 308, 319.
30 ibid., p. 506; 1A IPR 308, 317.
31 ibid., p. 510; 1A IPR 308, 319.
32 ibid., pp. 506–9; 1A IPR 308, 317–19.
33 (1918) 248 US 215.
34 DG Baird, 'The Story of *International News Service v Associated Press*: Property, Natural Monopoly and the Uneasy Legacy of a Concocted Controversy' in JC Ginsberg and R Cooper Dreyfuss, *Intellectual Property*

west coast. As International News Service had only used the facts as reported by Associated Press, and not the actual expression of these facts, Associated Press couldn't sue for copyright infringement. Despite this, the US Supreme Court granted relief based on the common law action of unfair competition due to the appropriation of labour which was 'contrary to good conscience'.[36] There was also reference made to the fact that the two parties were direct competitors.[37]

International News Service illustrates contrasting views on the nature of property rights as between 'Lockeans who believe that property comes into being as a result of labor ... against utilitarians who insist on weighing the costs and benefits of bestowing rights and denying them'.[38] Baird points out that the 'quasi-property' right in news that the court discovered in *International News Service* 'came without any metes and bounds and proved nearly impossible to apply in later cases'.[39] In fact, Baird considers the case not properly about property at all, but about competition law; the regulation of a natural monopoly, being the large fixed costs of the network of telegraph lines which comprised the wire service, over which news travelled. The difficulties created by extrapolating *International News Service* to 'an abstract pronouncement of a grand principle that has no obvious boundaries'[40] have partly been overcome by reading the case narrowly, including in a number of cases associated with 'pure information' such as basketball statistics.[41]

The majority judgments in *Victoria Park Racing* demonstrate the utilitarian (or instrumental) approach to property. In contrast, Evatt J's judgment is perhaps the most interesting. He was prepared to find a protectable property interest in the provision of the spectacle through holding the race meeting, given that the 'inherent adaptability' of the common law would allow this action as an example of nuisance, extended using the 'fundamental principles recently summarised in the House of Lords in *Donoghue v Stevenson*'.[42] These principles were that

> The grounds of action may be as various and manifold as human errancy; and the conceptions of legal responsibility may develop in adaptation to altering social conditions and standards. The criterion of judgment must adjust and adapt itself to the changing circumstances of life. The categories of negligence are never closed.[43]

36 *International News Service v Associated Press* (1918) 248 US 215, 240.
37 ibid., pp. 229, 240 and 235.
38 Baird, op. cit. n. 34, p.10. See also Drahos, op. cit.
39 Baird, ibid., pp. 10–11.
40 ibid., p. 32.
41 *National Basketball Association v Motorola Inc*, 105F 3d 841 (2nd Cir 1997). See also *Rudolph Mayer Pictures Inc v Pathe News Inc*, 255NYS 1016 (App Div 1932) where photographs of a boxing match were taken from the roof of a nearby building; *Madison Square Garden Corp v Universal Pictures, Co*, 7NYS 2d 845 dealing with photographs that simulated Madison Square Garden's interior which were held to violate a property right in the arena's reputation; and *Twentieth Century Sporting Club v Transradio Press Service Inc*, 300 HYS 159 which concerned the violation of the club's terms against broadcasting a boxing match.
42 (1937) 58 CLR 479, 515; 1A IPR 308, 322.
43 *Donoghue v Stevenson* [1932] AC 562, 619 (Lord Macmillan) cited in ibid., p. 515; 1A IPR 308, 323

Evatt J continued:

> Here the plaintiff contends that the defendants are guilty of the tort of nuisance. It cannot point at once to a decisive precedent in its favour, but the statements of general principle in *Donoghue v Stevenson* are equally applicable to the tort of nuisance.[44]

Although the relief granted by Evatt J would have been on the basis of tort, his reasoning does seem to approach what could be called a proprietary analysis and he suggests that where people expend money to create something they have a property interest which can exclude the rest of the world from interfering with that thing, where that interference is taking away potential earnings. The defendants are 'trespassing' upon this right and reaping without sowing in a way that is 'not honest',[45] and therefore an injunction could be granted because this unlawful interference amounted to a legal wrong being committed. In his conclusion, Evatt J approved of the majority judgments in *International News Service v Associated Press*[46] which

> In my opinion ... [evidence] an appreciation of the function of law under modern conditions, and I believe that the judgment of the majority, and of Holmes J, commend themselves as exposition of principles which are not alien to English law.[47]

Evatt J's decision contemplated the ability of tort law to protect not just quasi-property rights, but also notions of privacy, as part of the 'functions of law under modern conditions'. He discussed nuisance in response to the defendant's claim that 'the law of England does not recognize any general right of privacy', saying that it was erroneous to assume that under no circumstances could systematic watching amount to a civil wrong. Evatt J also referred to Brandeis J's minority judgment in *International News Service*, which found that 'news' is not property in the strict sense and that a person who creates a spectacle does not create exclusive rights of first publication. He did not take Brandeis J's comments to mean that 'because some overlooking is permissible, all overlooking is necessarily lawful'.[48] Although television did not become available in Australia until 1956, Evatt J mentioned the development of TV and the possibility that this might be important in the future. This seems perhaps a bold prediction in 1938, but parliament subsequently had to step in to legislate for the relevant broadcaster's rights.[49]

In 1960 as Chief Justice of the Supreme Court of New South Wales Evatt CJ took a very similar approach in the case *Henderson v Radio Corporation*.[50] In this action, relief was sought based on the development of tort law – not nuisance but the tort of passing off. Evatt CJ there granted relief by finding a property interest in the reputation of the Hendersons – well-known ballroom dancers whose photograph had been used without permission on the sleeve of an

44 (1937) 58 CLR 479, 515; 1A IPR 308, 323 (Evatt J).
45 ibid., pp. 518–19; 1A IPR 308, 325 (Evatt J).
46 (1918) 248 US 215.
47 (1937) 58 CLR 479, 518; 1A IPR 308, 324 (Evatt J).

album of dance music. Again, he extrapolated from tort law to protect a property interest; the reputation was property and had been appropriated, much as the defendants had done in *Victoria Park Racing*. In *Henderson* the defendants had interfered with the rights of the plaintiffs to exclude the rest of the world from using that property (their reputation) at a time when passing off still required other hurdles, including that of common field of activity.[51]

The other dissenting judge in *Victoria Park Racing*, Rich J, was prepared to give a finding in favour of the plaintiffs on the basis of the action in nuisance and principles of land law. In an analysis that was bold but clumsy, Rich J referred to 'the right of the normal use of the land by the adjoining owner' and the idea that 'defendant's rights are related to the plaintiff's rights and each owner's rights may be limited by the rights of the other'.

He argued that the defendants' act of overlooking a lawful meeting conducted by the plaintiffs on their land could constitute a 'nuisance', just like things such as vibration, smells and fumes. This example was likened to voyeurism, or 'watching and besetting', and

> the prospects of television make our present decision a very important one, and I venture to think, that the advance of that art may force the courts to recognise that protection against the complete exposure of the doings of the individual may be a right indispensable to the enjoyment of life.[52]

Rich J's analysis does not distinguish between invasion of personal privacy and damage to commercial interests.

The legacy of *Victoria Park Racing*

It is hard to believe that a single Australian case from the late 1930s would turn out to have myriad implications for contemporary life, both in Australia and internationally, especially given its (on the face of it) rather dated facts and dry reasoning. The following discussion highlights four key areas in which this classic decision is not only traditional but surprisingly modern.

Copyright in compilations and 'raw data'

Victoria Park Racing is often cited on the point of copyright in compilations, and that they require

> some original result [to] be produced. This does not mean that new or inventive ideas must be contributed. The work need show no literary or other skill or judgment, but it must originate with the author and be more than a copy of other material.[53]

This dealt with the argument in the case that the board displaying names and figures amounted to an original literary work.

51 See J McKeough, A Stewart and P Griffith, *Intellectual Property in Australia*, 3rd edn, Butterworths, Sydney,

Foreshadowing recent US cases on baseball and other player statistics, the Spicer Committee discussed whether copyright exists in the names of players and their numbers. They stated:

> We are unable to see how copyright can be conferred merely in respect of the name of a player associated with his football number. It has been held that copyright may exist in various compilations such as an alphabetical list of railway stations, a list of fox-hounds and hunting dogs and lists of stock exchange prices and football fixtures. In all these cases the question of whether copyright exists depends to a large extent on the amount of labour, capital or skill expended in making the compilation. We think that the law in this regard should not be changed. It seems that the football clubs may have copyright in the lists they prepare as published in various football publications (see *Football League Ltd v Littlewoods Pools Ltd* (1959) 3 WLR 42). Such copyright, however, does not prevent a person making his own list by attending a match. In the field of copyright there is not, in our view, any way to legislate against this. Indeed, no proposal on how this could be achieved was submitted to us. We, therefore, reject the submissions in this regard.[54]

Copyright protection for compilations has been taken to extremes in attempts to prohibit use of data for 'fantasy baseball' games, as the professional sports industry tussles with the issue of who owns player statistics in fantasy league games. Big media companies such as Yahoo, ESPN and CBS operate online 'fantasy leagues' where participants create teams comprised of real baseball players. Over the course of a season, participants track statistics to judge how well players are performing. Websites provide player statistics and this information is used as the basis of 'fantasy baseball' games which are played online. In *CBC Distribution & Marketing v Major League Baseball Advanced Media*,[55] a fantasy sports games operator sued to retain the rights to produce and promote fantasy games using player statistics without having to get a licence from Advanced Media, the organisation that runs baseball's interactive division. The ruling is currently under appeal but appears to follow a more robust approach, similar to that taken in earlier cases.[56] The defendant's argument is that the raw data is information in the public domain and cannot be protected by copyright without something more. Advanced Media insists that the statistics cannot be used for commercial gain without a licence. In fact, Advanced Media has already been sued itself by a group of former players who argued that printing their names and statistics in a game program was a violation of their rights of publicity. The court held that they were historical facts and Major League Baseball had a right to use them.[57]

In *National Basketball Association v Motorola*,[58] Motorola supplied player statistics of NBA games to pagers and mobile phones while the games were

54 *Report of the Committee Appointed by the Attorney General of the Commonwealth to Consider What Alterations are Desirable to the Copyright Law of the Commonwealth*, AGPS, Canberra, 1959 (Spicer Report), paras. 483–4.
55 *CBC Distribution & Marketing Inc v Major League Baseball Advanced Media, LP* 443F Supp 2d 1077, 1091 (ED Mo 2006); 505F 3d 818 (8th Cir 2007), denied, Nos. 06-3357 & 06-3358 (8th Cir 26 November 2007).
56 *Feist Publications Inc v Rural Telephone Co Inc* (1991) 20 IPR 129.

in progress. NBA sued for copyright infringement for the publishing of player statistics created by its efforts. The court held that misappropriation exists when

> (i) a plaintiff generates or gathers information at a cost;
> (ii) the information is time sensitive;
> (iii) a defendant's use of the information constitutes free-riding on the plaintiff's efforts;
> (iv) the defendant is in direct competition with a product or service offered by the plaintiff; and
> (v) the ability of other parties to free-ride on the efforts of the plaintiff or others would so reduce the incentive to produce the product or services that its existence or quality would be substantially threatened.[59]

The NBA's action failed as Motorola was compiling its own statistics and not obtaining them from the NBA: just because the NBA organised the games did not mean that Motorola were free riders. The court held that players' names and statistics are not protected by copyright.[60]

In *Morris Communications v PGA Tour*[61] the court also considered the extent to which a promoter should be able to control the diffusion of information about a golf tournament. The PGA Tour developed a real-time system for reporting each golfer's score on a website. This information was available in the PGA Tour media centre and restrictions were placed on journalists, who were unable to use the information for a certain period of time. Journalists who didn't follow the restrictions had their credentials revoked. Morris Communications asked for permission to syndicate the results and PGA Tour declined their request and informed them that their credentials would be revoked if they did. Morris Communications filed a suit for unlawful monopilisation. PGA Tour argued that they had a property right in the real-time scores. The court held that PGA Tour had a property right in the scores, which dissolved when scores entered the public domain. The public domain was defined as the area outside the media tent, when they were made available for public consumption.[62]

> In effect, the court held that when someone expends resources to create or gather information ... that person has a property right to control that information as long as it does not become known to third parties over whom the person has no legitimate control.[63]

In both the *Motorola* and *Morris* cases the promoters were given the right to control real-time data (referred to as 'hot news') and exploit the commercial

59 ibid., p. 845.
60 GP Quiming, 'Playing by the Rules of Intellectual Property: Fantasy Baseball's Fight to Use Major League Baseball Players' Names and Statistics' (2006) 29 *University of Hawaii Law Review* 301; JF Williams, 'Who Owns the Back of a Baseball Card? A Baseball Player's Rights in His Performance Statistics' (2002) 23 *Cardozo Law Review* 1705; S Ross Saxer, '*Baltimore Orioles, Inc v Major League Baseball Players Association*: The Right of Publicity in Game Performances and Federal Copyright Preemption' (1989) 36 *UCLA Law Review* 861, 861.
61 *Morris Communications Corp v PGA Tour, Inc*, 117F Supp 2d 1322 (MD Fla 2000) (Morris Communications' motion for a preliminary injunction denied); *Morris Communications Corp v PGA Tour, Inc*, 235F Supp 2d 1269 (MD Fla 2002) (PGA Tour's motion for summary judgment is granted).

value of this data until it became available to third parties beyond their control. Reflecting on both the cases, one commentator writes:

> The larger question raised by this entire discussion is to what extent good public policy supports giving sports event promoters the right to control the dissemination of information about their athletic contests . . . As a starting point there is always a public interest in disseminating anything of value as widely, easily, and cheaply as physically possible, whether the subject is tangible property, services, or intellectual property . . . The question is then whether there is some overriding reason why the public interest would be better served by restricting the public's access to the product.[64]

Copyright in events

There have not been too many cases concerning copyright in sporting spectacles following the definitive decision in *Victoria Park Racing*.[65] As television loomed on the horizon, however, lobbying for protection for sporting events increased. The Association for the Protection of Copyright in Sports (ACPS) lobbied the Beveridge Committee into Broadcasting (1949) for the promoter of any sporting event to be considered an author of a copyright protected work and thus able to control its reproduction. This was opposed by the British Broadcasting Corporation (BBC).[66] While property rights still cannot exist in the spectacle itself, specific rules relating to particular activities and events have emerged.

Following the lead of the Gregory Committee[67] in the UK, and the decision in *Victoria Park*, the Spicer Committee declared that a sporting spectacle was not protected by copyright, although the *Broadcasting and Television Act 1942* (Cth) was consequently enacted to protect against 'unauthorised' broadcasts.[68] Section 115 provides:

> The Commission or holder of a licence for a commercial television station shall not televise, either directly, or by means of any recording, film or other material or device or otherwise, the whole or part of a sporting event or other entertainment held in Australia, after the commencement of this section, in a place to which a charge is made for admission, if the images of the sporting event or other entertainment originate from the use of equipment outside that place.

Specific special events legislation has also been introduced, particularly when the sporting spectacle will take place in public, for example the *Australian Grand*

64 ibid., p. 186.
65 (1937) 58 CLR 479; 1A IPR 308; *Re South Queensland Broadcasting Pty Ltd* (1977) ATPR, 103.547; *Re Universal Telecasters Queensland Ltd* (1977) ATPR, Commission Decisions Authorizations and Notifications, 16757; *Re Brisbane TV Ltd* (1977) ATPR, Commission Decisions, Authorizations and Notifications, 16766; *Re Amalgamated Services Pty Ltd and the New South Wales Rugby Football League* (1980) ATPR, Commission Decisions, Authorizations and Notifications, 17076; *Re Australian Cricket Board, PBL Marketing Pty Ltd, World Series Cricket Pty Ltd and Publishing and Broadcasting Ltd* (1980) ATPR, Commission Decisions, Authorizations and Notifications, 17065; *Australian Broadcasting Commission v Parish et al* (1980) 40 FLR 311.
66 J-P Blais, 'The Protection of Exclusive Television Rights to Sporting Events Held in Public Venues: An Overview of the Law in Australia and Canada' (1992) 18 *Melbourne University Law Review* 503, 515.
67 *Report of the Copyright Committee*, Her Majesty's Stationery Office, London, 1952 (Gregory Report)

Prix Act 1995 (Vic). Section 35 states that during the race period a person must not, without consent and the payment of a fee, make a sound recording or audio recording of a Formula One event or any part of a Formula One event from a place inside or outside Albert Park for the purpose of profit or gain. Section 42B provides similar requirements for the Motor Cycle Grand Prix.[69]

The issue of broadcast rights in sporting spectacles has received a great deal of attention in the EU.[70] The rights of broadcasters to control coverage of events and other aspects of sporting or entertainment spectacles has become increasingly contested over recent years. The possibilities of the internet, which allows compilation of data such as statistics and the use of blogs, posted photographs and video, led to a series of actions, mainly in the US, to significantly restrict the use of widely available material. The National Football League recently announced significant restrictions on the use of online video clips. The league is attempting to restrict news organisations to no more than 45 seconds per day of video filmed at team facilities, including news conferences, interviews, practice sessions and the like.

One way of controlling this is to make rules that athletes, coaches and others associated with events such as the Olympics are not to blog or podcast during events. The International Olympic Committee warned athletes at the 2006 Turin Winter Olympics that they faced disqualification if they blogged during the Games.[71] These attempts to protect corporate sponsorship presumably would be difficult to enforce through the courts and rely instead on arrangements between organisations, athletes and others. Given the politically charged atmosphere of the 2008 Beijing Olympics, Australian athletes were allegedly required to sign an agreement that placed limits on what they could say in public, including the requirement that they ask permission to comment on human rights.[72] According to media reports, they were able to podcast and blog, as long as they followed rules set out by the International Olympic Committee that protect copyright,

69 Other examples include: *America's Cup Yacht Race (Special Arrangements) Act 1986* (WA); *Commonwealth Games Act 1982* (Qld); *Australian Formula One Grand Prix Act 1984* (SA); compare Blais, op. cit., pp. 66 and 511.
70 *Rudolph Mayer Pictures Inc v Pathe News Inc* 235 App Div 774, 255 NY Supp 1016 (1932); *National Exhibition v Teleflash* 24F Supp 488 (1936); *Twentieth Century Sporting Club v Tansradio Press Service Inc* 165 Misc 71, 300 NY Supp 159 (1937); *Pittsburg Athletic Co v KQV Broadcasting Co* 24F Supp 490 (1938); *Madison Square Garden Corp v Universal Pictures Co* 255 App Div 459, 7 NYS (2d) 845 (1938); *Johnson-Kennedy Radio Corp v Chicago Bears Football Club Inc* 97F (2d) 223 (1938); *South West Braodcasting Co v Oil Centre Broadcasting* 210 SW (2d) 230 (1948); *Gauthier v Pro-Football Inc* 304 NY 354, 107 NE (2d) 485 (1952); *United States v National Football League* 116F Supp 319 (1953); *Loeb v Turner* 257 SW (2d) 800 (1953); *National Exhibition v Fass* 133NYS (2d) 379, 136NYS (2d) 358 (1954), 143NYS (2d) 767 (1955); *Ettore v Philco Television Broadcasting* 229F (2d) 481 (1956), certiorari denied 351 US 926 (1956); *Zacchini v Scripps-Howard Braodcasting Co* 433 US 562 (1977); *Post Newsweek Stations-Connecticut Publishing Ins Inc v Travellers Ins Co* 510F Supp 81 (1981); *Eastern Microwave Inc v Double Day Sports Inc* 691F (2d) 125 (1982), certiorari denied 459 US 1226; *WT4'WV Inc v National Football League* 678F (2d) 142 (1982); *National Collegiate Athletic Association v Board of Regents of the University of Oklahoma* 468 US 85 (1984); *Baltimore Orioles Inc v Major League Baseball Players Association* 805F (2d) 663(1986), certiorari denied 480 US 941 (1987).
71 Geist, op. cit.
72 ABC, 'Olympic Officials to Vet Athletes' Political Comments', ABC, 10 March 2008

confidential information and security and prevent athletes from profiting from the 'Games' name.[73]

Unfair competition

The question of allowing copyright or some other form of property right in events has at times been merged with discussion of a broader doctrine of unfair competition or misappropriation. In *Victoria Park Racing*, Dixon J referred with approval to the dissenting judgment of Brandeis J in *International News Service*, which considered relevant US and English authorities and concluded that the law did not recognise any general proprietary right in knowledge or information nor any general action for unfair competition.[74] The decision of the majority of the US Supreme Court in that case, however, has generally been taken as founding a broadly framed tort in respect of unfair competition.

Recognition of a new general tort of unfair competition was rejected by the High Court in *Moorgate Tobacco v Philip Morris*[75] where Deane J, in the course of deciding that Australian law knows no general tort of unfair competition or unfair trading, referred with approval to Dixon J's comments in *Victoria Park Racing*. Deane J (with whom all the other judges agreed) pointed out that the majority judgment in *International News Service* assumed rather than sought to establish that 'unfair competition in business' was in itself an actionable wrong, and did not establish that 'published news as distinct from copyright in its presentation or arrangement, itself constitutes property, or provides any basis for a general cause of action for unfair competition'.[76]

In *Campomar Sociedad Limitada v Nike International*,[77] the Full Court of the High Court of Australia approved Dixon J's timeless statement that

> Courts of equity have not thrown the protection of an injunction around all the intangible elements of value, that is, value in exchange, which may flow from the exercise by an individual of his powers or resources whether in the organization of a business or undertaking or the use of ingenuity, knowledge, skill or labour.[78]

The court noted that this 'should be regarded as an authoritative statement of contemporary Australian law'.[79] Given that 'wide generalisations' of unfair competition, or protecting the 'sweat of the brow' because someone has worked to produce that sweat, are not allowed in Australian law, the issue in that case was whether the *Trade Marks Act*, *Trade Practices Act* or action for passing

73 L Tung, 'Aussie Olympian Blogs Muzzled, Not Censored', *ZDNet*, 19 February 2008, available at http://www.zdnet.com.au/news/communications/soa/Aussie-Olympian-blogs-muzzled-not-censored/0130061791339286027,00.htm.
74 (1918) 248 US 215, 624.
75 *Moorgate Tobacco Ltd v Philip Morris Ltd (No. 2)* (1984) 156 CLR 414; 3 IPR 545.
76 ibid., p. 441; 3 IPR 545, 563.
77 *Campomar Sociedad Limitada v Nike International Ltd* (2000) 202 CLR 45.
78 (1937) 58 CLR 479, 509; 1A IPR 308, 319.
79 (2000) 202 CLR 45, 55.

off were apt to deal with two parties using the name NIKE in the market place.[80]

In the US many states have a common law tort of misappropriation 'which does not require proof of deception but is aimed at preventing commercial free riding on the efforts of others in certain defined and quite limited circumstances'.[81] It is generally conceded that these circumstances need to be more than the principle that property rights are natural rights with no easily recognised limitations, or that 'misappropriation is contrary to good conscience';[82] 'intellectual property disputes, like all legal disputes, cannot be decided merely by invoking an idea as vague as the right to reap what one sows'.[83]

Despite the invitation to discover 'quasi-property' rights in a spectacle, the broad principles of the tort of misappropriation in *International News Service* have been reluctantly applied[84] and narrowly construed since the decision was handed down. *International News Service* has become a doctrine that 'lives at the margins of intellectual property law';[85] it was initially applied unenthusiastically by the judiciary in American states,[86] although admittedly with some 'oddball cases now and then'.[87] One such case occurred when copyright in Chicago Cubs games was argued in *Chicago NL Club v Sky Box on Waveland*.[88] The Cubs sued a group of nearby property owners who were allowing people to watch games from their rooftops and charging for admission. This 'old Chicago tradition' had become a significant money-making scheme. The case settled with the rooftop owners agreeing to pay the Cubs 17 per cent of their annual profits.[89]

In *Pittsburg Athletic v KQV Broadcasting*,[90] the plaintiff was successful in preventing a live broadcast of the Pittsburg Pirates baseball game by a commentator, who was overlooking the stadium from a vantage point on a roof across the street from Forbes Field. The judge in *Pittsburg Athletic* relied heavily on and expanded

80 The US Supreme Court also rejected a sweat of the brow doctrine for copyright protected in *Feist Publications, Inc v Rural Telephone Service Co* 111S Ct 1282 (1991). This is discussed in JC Ginsburg, 'No "Sweat"? Copyright and Other Protection of Works of Information After *Fiest v Rural Telephone*' (1992) 92 *Columbia Law Review* 338.
81 MJ Davison, AL Monotti and L Wiseman, *Australian Intellectual Property Law*, Cambridge University Press, Sydney, 2008, p. 4. See also MJ Davison, *Legal Protection of Databases*, Cambridge University Press, Cambridge, 2003, p. 162, and *National Basketball Association v Motorola Inc* 939F Supp 1071 (SDNY 1996), rev'd, 105F 3d 841 (2nd Cir 1997).
82 (1918) 248 US 215, 240–1.
83 Baird, op. cit. n. 34, p. 63.
84 *Cheney Bros v Doris Silk Corp* 35F 2d 279 (2nd Cir, 1929).
85 Baird, op. cit. n. 34, p. 34: citing RA Posner, 'Misappropriation: A Dirge' (2003) 40 *Houston Law Review* 621.
86 Davison, op. cit. n. 81, pp.160–1. See also DG Baird, 'Common Law Intellectual Property and the Legacy of *International News Service v Associated Press*' (1983) *University of Chicago Law Review* 411.
87 Baird, op. cit. n. 34, p. 34.
88 No 02C 9105 (ND Ill).
89 T Baldas, 'Pro Sports: Technology Changes Rules of the Game', *The National Law Journal*, 4 March 2005, available at http://www.law.com/jsp/article.jsp?id=1109128216973.
90 *Pittsburg Athletic Co v KQV Broadcasting Co* 24F Supp 490 (D PA 1934). See also *Loeb v Turner* 257SW 2d 800 (1953) where the opposite decision was made. Referred to in Davison, op. cit. n. 81, pp.183–4.

the Supreme Court's decision in *International News Service*. The court ruled that the radio station had violated Pittsburg Athletic's property rights and engaged in unfair competition, based on the production of an event as a result of expense and effort of the plaintiff on private property, and stated:

> The plaintiffs and the defendant are using baseball news as material for profit. The Athletic Company has, at great expense, acquired and maintains a baseball park, pays the players who participate in the game, and have, as we view it, a legitimate right to capitalize on the news value of their games by selling exclusive broadcasting rights to companies which value them as affording advertising mediums for their merchandise. This right the defendant interferes with when it uses its broadcasting facilities for giving out the identical news obtained by its paid observers stationed at points outside Forbes Field for the purpose of securing information which it cannot otherwise acquire. This, in our judgment, amounts to unfair competition, and is a violation of the property rights of the plaintiffs.[91]

A tort of privacy?

In *Victoria Park Racing*, Rich J stated: 'in the absence of any authority to the contrary I hold that there is a limit to this right of overlooking and that the limit must be found in an attempt to reconcile the right of free prospect from one piece of land with the right of profitable enjoyment of another'.[92] It is arguable that in this statement, which runs together the concept of personal privacy with the rights of those conducting a business, he foreshadowed the extension of nuisance to the point where it almost amounts to a right of privacy. Even more explicitly, Evatt J stated:

> A person who creates or uses devices for the purpose of enabling the public generally to overlook or spy upon the premises of another person will generally become liable to an action of nuisance, providing appreciable damage, discomfort, or annoyance is caused.[93]

Subsequent discussion of any emerging action has tended to limit the ambit of a right to privacy in that whatever development may take place will be for the benefit of natural persons, not corporations, and despite the hint in *Victoria Park Racing* that a right of privacy for commercial information might emerge, the weight of authority favours recognition of the privacy of personal information rather than 'proprietary' information. As the 'celebrity cases' mentioned below illustrate, these considerations are most often discussed in the context of a personal/private nexus; an example is the rights of public figures to protect private information such as rehabilitation from a drug habit.[94]

91 24F Supp 490 (D. PA 1934) at 492.
92 (1937) 58 CLR 479, 504; 1A IPR 308, 316 (Rich J).
93 ibid., p. 521; 1A IPR 308, 326 (Evatt J).
94 *Campbell v MGN Ltd* [2004] 2 AC 457.

The New South Wales Law Reform Commission has a current reference to inquire into and report on whether existing legislation in New South Wales provides an effective framework for the protection of the privacy of an individual. Consideration of a statutory tort of privacy and the question of uniformity of legislation across Australia are also relevant to the investigation. In a Consultation Paper released in May 2007,[95] *Victoria Park Racing* was the starting point for the discussion of the development of the common law of privacy in Australia. Referring to developments in the UK, the NSWLRC stated: 'The persuasiveness of the reasoning in many of the English cases leads us to believe, however, that the solutions proposed in those cases could be adopted as part of the common law of Australia.'[96] It should be noted that discussion of the emerging tort in English cases is in the context of the UK *Human Rights Act 1998* which incorporates into English law Art 8 of the European Convention for the Protection of Human Rights and Fundamental Freedoms.[97] It is also the case that the path to a tort of privacy is not an easy one, and among the 'stumbling blocks' are Australian cases where circumspection has been exercised, for example by the Chief Justice in the High Court.[98]

It was argued in *Australian Broadcasting Corporation v Lenah Game Meats*[99] that the Australian courts had not developed 'an enforceable right to privacy' because of what generally was taken to follow from the failure of the plaintiff's appeal in *Victoria Park Racing*. In *Lenah Game Meats* the High Court of Australia declined to grant a remedy purely on the basis that information had been obtained through what might be considered 'unconscionable actions', even involving allegedly unlawful conduct. In this case the plaintiffs were attempting to prevent the ABC from broadcasting film of the process used to slaughter possums for game meat. The film had been taken by animal rights activists and it was alleged that their activities were both surreptitious and involved a trespass and break-in to plaintiff's property. The High Court found, however, that there was no information clearly of a confidential nature to protect and so the action for breach of confidence did not apply. The judges observed that the plaintiff would need to ground an action in a general tort designed to protect against invasion of privacy, and the case contains some speculation that it might be time for the common law to recognise such an action.[100]

Strong support for a tort of invasion of privacy came from Callinan J, who stated:

95 NSW Law Reform Commission, *Invasion of Privacy*, Consultation Paper 1, May 2007. See also Australian Law Reform Commission, *For Your Information: Australian Privacy Law and Practice*, Report 108, August 2008, para. 74.61.
96 ibid., para. 2.16.
97 Entered into force 3 June 1952.
98 See R Wacks, 'Why There Will Never Be An English Common Law Privacy Tort' in A Kenyon and M Richardson, *New Dimensions in Privacy Law*, Cambridge University Press, 2006, p. 176.
99 (2001) 208 CLR 199; (2002) 54 IPR 161.
100 See D Lindsay, 'Playing Possum? Privacy, Freedom of Speech and the Media Following *ABC v Lenah Game Meats Pty Ltd*. Part II: The Future of Australian Privacy and Free Speech Law, and Implications for the Media' (2002) 7 *Media Arts Law Review* 161.

> It seems to me that, having regard to current conditions in this country, and developments of the law in other common law jurisdictions, the time is ripe for consideration whether a tort of invasion of privacy should be recognized in this country, or whether the legislatures should be left to determine whether provisions for a remedy for it should be made.[101]

Earlier in the judgment he also stated:

> Even if there be no, or there is to be no, tort of intrusion of privacy as such, the law may need to devise a remedy to protect the rights of the 'owners' of a spectacle at least against unauthorized reproduction of it by broadcast, telecast or publication of photographs or other reproductions of it, under the rubric of nuisance or otherwise.[102]

In *Victoria Park Racing* Latham CJ rejected the proposition that under the head of nuisance the law recognised a right of privacy. But that is not to say the decision precludes any proposition with respect to the existence or otherwise of a tort identified as unjustified invasion of privacy. According to Gummow and Hayne JJ in *Lenah Game Meats*, 'Victoria Park does not stand in the path of the development of such a cause or action ... nothing said in these reasons should be understood as foreclosing any such debate or as indicating any particular outcome, nor should the decision in Victoria Park'.[103] However, Gleeson CJ's circumspection (praised as 'wisdom') in being very cautious about declaring the emergence of a new tort is based on 'lack of precision in the concept of privacy'.[104]

Although *Victoria Park Racing* does not necessarily stand in the way of an action for unjustified invasion of privacy, it is relevant to the distinction made by some later cases between the rights that an individual might have as compared with a corporation. The 'privacy' in *Victoria Park Racing* concerned the opposition by the plaintiff to the turning to commercial account by the defendants of the business operations of the plaintiff, where the plaintiff was a corporation.

In addition to a corporate/individual distinction relevant to notions of protection of privacy, recent cases have focused on the distinction between public/private lives and tended to confine protection to the truly 'private' aspects. A recent Australian Law Reform Commission Report on privacy[105] focused on the protection of personal information as distinct from corporate information, and in fact one recommendation is that privacy legislation be named *Privacy and Personal Information Act*.[106] It can be difficult to distinguish between the private and public lives of famous people who, in some contexts, actually court publicity. In *Douglas v Hello!*[107] two celebrities objected to publication of 'unauthorised' photos of their wedding. Sedley LJ doubted that the surreptitious obtaining of

101 (2001) 208 CLR 199, 328; (2002) 54 IPR 161, 255–6.
102 ibid., p. 322; (2002) 54 IPR 161, 250–1.
103 ibid., pp. 248 and 258; (2002) 54 IPR 161, 191 and 199.
104 Wacks, op. cit., p. 176.
105 Australian Law Reform Commission, *For Your Information: Australian Privacy Law and Practice*, Report 108, August 2008.
106 Ibid., Ch 5.

personal information would always be protected by the action for breach of confidence even if the information was of a confidential nature. He was concerned about the requirement that an obligation of confidence should exist between the parties and, reflecting upon the artificiality of finding such a relationship in cases of snooping, paparazzi photographs or by way of found material, speculated that a more general tort of interference with privacy might be required. He said:

> What a concept of privacy does ... is accord recognition to the fact that the law has to protect not only those people whose trust has been abused but those who simply find themselves subjected to an unwanted intrusion into their personal lives. The law no longer needs to construct an artificial relationship of confidentiality between intruder and victim: it can recognise privacy itself as a legal principle drawn from the fundamental value of personal autonomy.[108]

The existence of such a tort was rejected in *Wainwright v Home Office*;[109] indeed the *Human Rights Act 1998* (UK) was there argued to pre-empt the need to develop a tort of invasion of privacy. A majority of the House of Lords in *Campbell v MGN*,[110] however, found that where private or personal information was of a confidential nature it could be protected from unauthorised publication where it had been obtained in a surreptitious fashion. This was in keeping with the broad formulation of the equitable obligation of breach of confidence by Lord Goff in *Attorney General v Guardian Newspapers*,[111] although this adherence to protecting private information as a breach of confidence rather than as a positive right to privacy is regarded as expanding the reach of the traditional action, rather than developing a new tort.[112]

Lenah Game Meats was referred to with approval by the court in *Campbell v MGN*, and Gleeson J's judgment in that case was also referred to approvingly in *David Murray v Big Pictures (UK)*.[113] In the *David Murray* case the parents of young David Murray, whose mother is the world-famous author JK Rowling, objected to the use of his photograph taken with a long-range lens by a paparazzi photographer while they were on a family outing. At trial Patten J had found that the parents were trying to establish privacy for themselves, even when in public, but on appeal it was considered relevant that they sought privacy for David, not for his mother, who had not hidden herself from the press and understood that the public was interested in her. Relying on *Campbell v MGN* but distinguishing the case on the basis that it concerned a child, the appeal court found that Art 8 of the European Convention on Human Rights, which provides the right to respect for family and private life, creates a greater onus for protection of children's interests:

> the law should indeed protect children from intrusive media attention, at any rate to the extent of holding that a child has a reasonable expectation that he or she will not

108 ibid., p. 320.
109 [2003] 4 All ER 969.
110 *Campbell v MGN Ltd* [2005] UKHL 61.
111 *Attorney-General v Guardian Newspapers Ltd (No. 2)* [1990] 1AC 109, 281.
112 Wacks, op. cit., p. 166.
113 *David Murray v Big Pictures (UK) Ltd* [2007] EWHC 1908 (Ch), para. 25 (Clarke MR, Laws and

> be targeted in order to obtain photographs in a public place for publication which the person who took or procured the taking of the photographs knew would be objected to on behalf of the child.[114]

The language of the courts is developing from use of proprietary analysis to words invoking privacy.[115] It is this fault line developing between property and privacy which means the likelihood of any action to protect 'private' information will be not be framed in terms of protecting commercial interests and is likely to be quite restricted. *Victoria Park Racing* provides an early example of the challenges of emerging technology to commercial and private interests, and illustrates the use of legal principle in consideration of this interaction.

114 ibid., para. 57.
115 M Richardson and L Hitchens, 'Celebrity Privacy and Benefits of Simple History' in Kenyon and Richardson, op. cit., p. 263.

5

We have never been modern: the High Court's decision in *National Research Development Corporation v Commissioner of Patents*

Stephen Hubicki and Brad Sherman

Introduction

On 17 December 1959, the High Court of Australia handed down its judgment in the decision of *National Research Development Corporation v Commissioner of Patents* (*NRDC*).[1] The decision considered the patentability of two herbicidal compositions and their uses.[2] In deciding the fate of NRDC's application, the High Court dealt with three doctrinal issues: whether the claims related to a mere new use of known substances; whether the claimed invention was a 'manner of manufacture'; and the patentability of agricultural and horticultural inventions generally.

The *NRDC* decision is widely regarded as a 'watershed' in Australia,[3] a Copernican-like moment that signalled the emergence of modern patent law. It is also seen as having established a template that has shaped Australian patent law over the course of the 20th century and beyond. There is no doubt that in certain respects this is the case. In other ways, however, the High Court decision is better seen as a classic common law decision, albeit applied to a new form of technology and by the highest court in Australia, which makes incremental changes to longstanding practices and traditions. It also can be seen as having reinforced a particular image of 'invention' – one that has recently been called into question, particularly in terms of its suitability to digital inventions. In this sense, the decision offers an important insight into some of the tensions and paradoxes that characterise modern patent law.

1 (1959) 102 CLR 252; 1A IPR 63.
2 Patent Application No. 10,301/55; Australian Patent No. 227457, 'Herbicidal Compositions', 16 March 1960.

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LANDMARKS IN AUSTRALIAN INTELLECTUAL PROPERTY LAW

Edited by
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Landmarks in Australian Intellectual Property Law

Edited by Andrew T Kenyon, Megan Richardson and Sam Ricketson

This authoritative text provides a picture of how Australian intellectual property law has developed as a distinctly Australian body of law during the century since Federation. The book takes a selection of key intellectual property law cases and tells their stories, situating each case in its social context, as well as providing factual details about the arguments made in each case and the evidence adduced. *Landmarks in Australian Intellectual Property Law* offers a closer legal analysis of selected cases, many of which have been central to the framing of Australian intellectual property law. It provides a fuller sense of each case as revealing and influencing wider understandings and practices.

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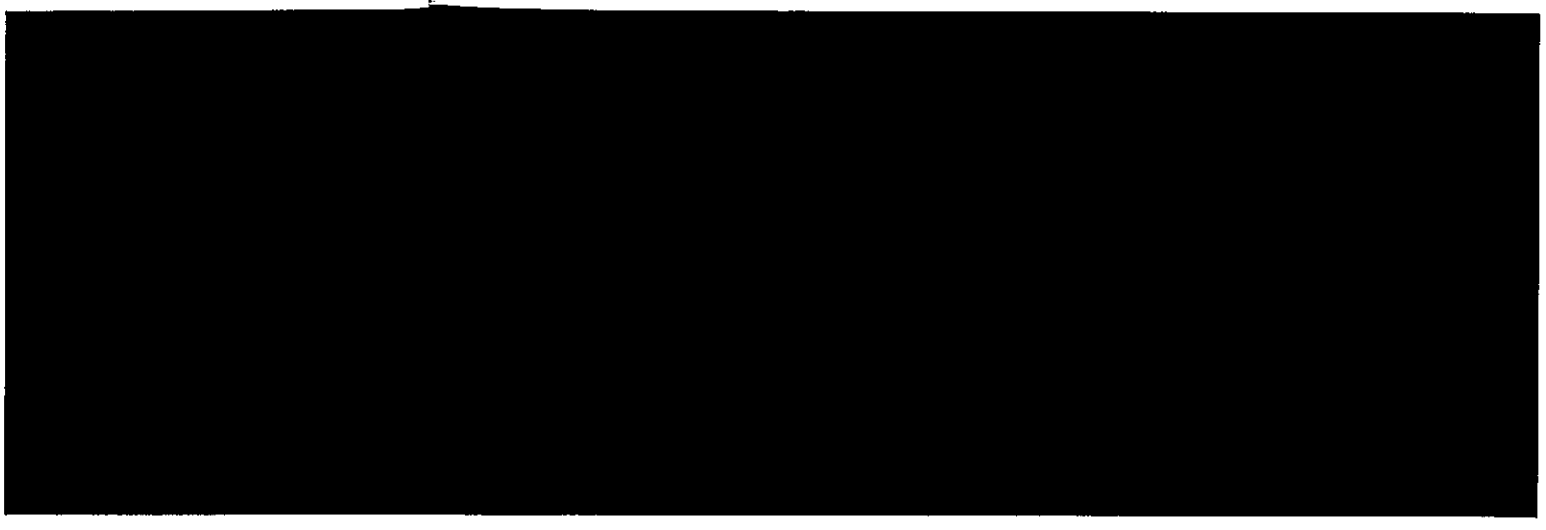

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