TENTH EDITION

INTELLECTUAL PROPERTY

DAVID I. BAINBRIDGE

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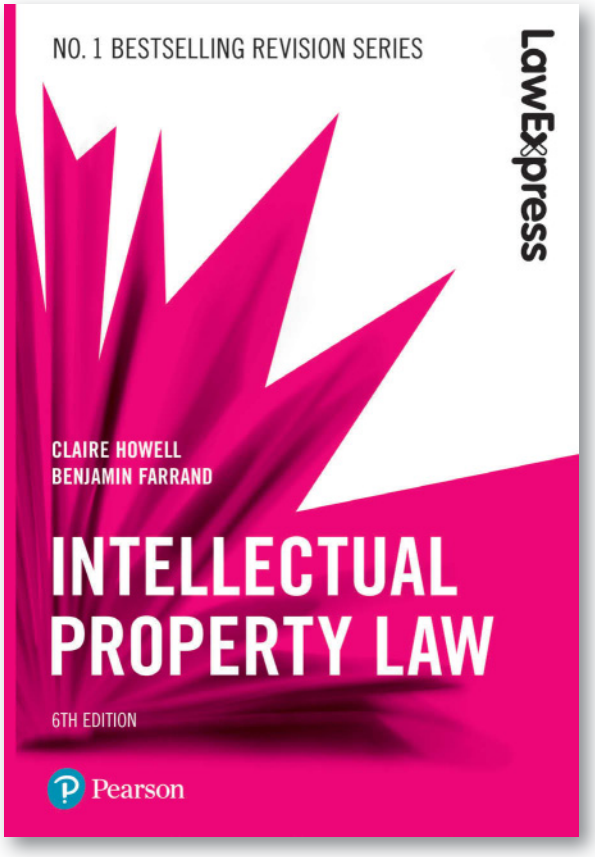

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which BSB intended to include in its broadcasts. Nevertheless, the BBC's application for an interim injunction was refused.

There have been a number of changes over the years to the fair dealing provisions. At one time it appeared that fair dealing for the purposes of research could extend to commercial research providing, of course, that it was 'fair'. Now, fair dealing for research purposes is limited to a non-commercial purpose. Another change was a requirement for a sufficient acknowledgement for fair dealing for the purposes of research. Previously, this was required only in respect of fair dealing for the purposes of criticism, review and reporting current events.[96] The meaning of 'sufficient acknowledgement' is given in s 178 and this, together with the nature of the acknowledgement, is discussed in the section covering fair dealing for the purposes of criticism, review and reporting current events.

We now consider the remaining provisions in the 'General' section of the permitted acts under ss 29–31, bearing in mind that there is no requirement for fair dealing under new s 29A (text and data analysis) and s 31 (incidental inclusion).

96 Though not in all cases; *see* the discussion of this permitted act later.

Research and private study (s 29)

This section has been modified a number of times in the past, for example, to except certain acts in relation to computer programs from the provisions of the section and to restrict research to research for a non-commercial purpose. Further changes took effect during 2014 to take further advantage of the exceptions and limitations permitted under the Directive on copyright and related rights in the information society. Thus, s 29 now applies to all forms of works of copyright, not just literary, dramatic, musical and artistic works.[97] Changes are made to copying by librarians and others to reflect modifications to such copying. Finally, a new subsection controls contractual attempts to exclude or restrict acts permitted under s 29.

The permitted act of fair dealing for research or private study is now available for all forms of copyright work.[98] Where the purpose is research, it must be for a non-commercial purpose and there must be a sufficient acknowledgement except where this would be impossible for reasons of practicability or otherwise.[99] Section 178 contains a definition of 'sufficient acknowledgement' and requires that it identifies both the work by its title or other description, and the author. However, if the work is published anonymously,[100] or if the work is unpublished and the author's identity cannot be ascertained by reasonable inquiry, there is no requirement for the author's name to be included in the acknowledgement. In *Sillitoe* v *McGraw-Hill Book Co (UK) Ltd*,[101] it was held that a sufficient acknowledgement must recognise the position or claims of the author.

Commercial activity does not need to be concurrent with the research to negate the permitted act, it is sufficient if the commercial purpose is contemplated or intended to be carried out in the future at the time of the research.[102] There is no requirement for a sufficient acknowledgement where the purpose is research for private study. It is not fair dealing to perform the acts permitted in relation to computer programs in s 50B (decompilation), removing any possible compromise of the effects of s 50B. It is not fair dealing to observe, study and test the functioning of a computer program in order to determine the ideas and principles which underlie any element of the program as permitted under s 50BA.[103] The reasons for this is that there is a specific permitted act covering this and, again, this removes the possibility of it being compromised by the fair dealing provisions.

Until changes brought in during 2003,[104] fair dealing for the purposes of commercial or industrial research was a distinct possibility, although each case will turn on its particular facts. For example, it would not have been considered to be fair dealing to perform an act restricted by the copyright in a work for the purposes of producing a competing work. In *Independent Television Publications Ltd* v *Time Out Ltd*,[105] the defendant copied details of forthcoming television programmes from the *TV Times* and the *Radio Times*. The defence

97 Bearing in mind the specific exceptions for computer programs (which have their own equivalent exceptions under ss 50B and 50BA, discussed in the following chapter).

98 Copyright, Designs and Patents Act 1988 s 29(1).

99 Section 29(1B).

100 *See PCR Ltd* v *Dow Jones Telerate Ltd* [1998] FSR 170.

101 [1983] FSR 545.

102 *Controller of Her Majesty's Stationery Office* v *Green Amps Ltd* [2007] EWHC 2755 (Ch).

103 Section 29(4A). As with decompilation of computer programs, these exceptions prevent the possibility of doubling up some of the permitted acts for computer programs.

104 Section 29(1) was substituted by reg 32 of the Copyright and Related Rights Regulations 2003, SI 2003/2498.

105 [1984] FSR 64.

of fair dealing (in this case under the head of fair dealing for criticism and review) failed because the purpose was to provide a television programme listing service and had nothing to do with criticism or review.[106]

It may be fair dealing to make a copy for research or private study but it is not fair dealing to publish copies of works in order to facilitate research or private study by others. In *Sillitoe* v *McGraw-Hill Book Co (UK) Ltd*,[107] the defendant had published 'study notes' intended to assist students taking GCE 'O' level examinations in literature, and had reproduced a substantial part of the claimant's works in the study notes. The defendant contended, *inter alia*, that the study notes fell within the equivalent fair dealing provisions under the Copyright Act 1956.[108] This submission failed to find favour. The defendant was not engaged in research or private study, but was merely facilitating this for others, being the students purchasing the defendant's copies of the study notes.

In relation to fair dealing for research or private study, factors to determine whether it is fair may be the nature of the research or study and the funds available to the researcher or student. Questions such as whether the person concerned is copying simply to save himself the expense of buying a copy of the work, or whether it is reasonable to expect a copy to be purchased, are important. Take, for example, a postgraduate research student. He may need to refer to hundreds of journal articles and books. The student will not be able to purchase more than a handful of these; he will have to be selective. The student may decide to purchase those materials which he will need to use over and over again during the research. But many of the articles and books will be used less frequently and only small portions will be referred to. It would not be realistic to expect the student to purchase a book when he wants to refer to only a small part of it. Similarly, in the case of an article in a journal – the student would not be expected to buy the issue of the journal or have to subscribe to the journal just to have access to and refer to one particular article.[109]

It is difficult to draw the limits of fair dealing for private study; perhaps it can be suggested, partly on the basis of the permitted acts in respect of librarians, that copying the whole of one article from an academic journal could be fair dealing. It could also be fair dealing to copy of part of a book for private study, certainly no more than one chapter. Any more would not be fair dealing. However, it must be noted that a great deal of copying in relation to private study is carried out by students, and it is difficult to control and monitor the use that students make of online and photocopying facilities in libraries. Although downloading from the internet immediately springs to mind, it should be remembered that copyright can be infringed by making a handwritten copy. It is less likely that a substantial part will be taken because of the effort and time required. Making handwritten notes is a selective process, and only the materials that are of direct use to the student are likely to be copied out in this way. Also, the materials are read and, usually, analysed by the student during the process. It may be that the notes taken by the student have their own copyright because of the student's expenditure of skill, effort or judgment in adding comments and supplemental notes.

Section 29(3) applies where the copying is not done by the researcher or student himself. There are two possibilities covered by s 29(3): first, where the copying is done by a librarian or on behalf of a librarian. Such copying must not exceed that permitted under s 42A (copying by librarians: single copies of published works). This would apply, for example, where, in response to a written declaration, a librarian supplies a single copy of one article from a single issue of a periodical or a reasonable proportion of any other published work.[110]

The second possibility is set out under s 29(3)(b) and is poorly worded. It applies in any other case[111] and is designed to prevent multiple copies being made to persons for the same purpose. It is not fair dealing if the person carrying out the copying knows or has reason to believe that the copying will result in copies of substantially the same material

106 But now, as a result of the Broadcasting Act 1990 s 176, there is a duty to make information about forthcoming programmes available to other publishers. European Union law also may be appropriate here, especially Article 102 of the Treaty on the Functioning of European Union (formerly Article 82 of the EC Treaty): *see RTE & ITP* v *EC Commission*, Joined Cases C-241/91P and C-242/91P, EU:C:1995:98.

107 [1983] FSR 545.

108 Section 6(1) of the Copyright Act 1956.

109 In some cases, a blanket licence scheme will be in operation allowing more extensive copying, such as that administered by the Copyright Licensing Agency.

110 The declaration must comply with s 42A(2) and (3).

111 That is, where the copying is not made by a librarian or person acting on behalf of a librarian.

being provided to more than one person at substantially the same time and for substantially the same purpose. This could apply where a class of students are each provided with a copy of the same work.[112]

Under s 29(4B) to the extent that a term of a contract purports to prevent or restrict doing an act which would not infringe copyright under s 29, that term is unenforceable. Thus, the right to perform the permitted act of fair dealing for research or private study cannot be compromised contractually, for example, in a term in a licence agreement under which the work in question has been obtained. In the context of the section, this is most likely to apply in the case of online access to the work or where the work has been obtained by a library.

112 If this exceeds that permitted under any relevant licensing scheme.

Copies for text and data analysis for non-commercial research (s 29A)

Among the many recommendations of the Hargreaves Report was that an exception to copyright infringement be introduced to allow text and data mining.[113] It was considered that the existing fair dealing exception was not wide enough to cover this. As a result, a new s 29A was introduced with effect from 1 June 2014.[114] Basically, it permits making a copy of a work for the purpose of carrying out computational analysis for non-commercial research.

Section 29A(1) states that making a copy by a person who has lawful access to the work does not infringe copyright, provided:

- the copy is made in order to carry out computational analysis of anything recorded in the work for the sole purpose of research for a non-commercial purpose, and
- the copy is accompanied by a sufficient acknowledgement unless this would be impossible for reasons of practicality or otherwise.

If a copy made under s 29A is transferred to any other person or used for any other purpose, in either case, without the authorisation of the copyright owner, it becomes an infringing copy.[115] Subsequent dealing of a copy made under s 29A by way of sale or letting for hire (or offering or exposing for sale or hire) results in the copy being treated as an infringing copy for the purpose of that dealing and, if that dealing infringes copyright, it is to be treated as an infringing copy for all subsequent purposes.[116]

Under s 29A(5) to the extent that a term of a contract purports to prevent or restrict doing an act which would not infringe copyright under s 29A, that term is unenforceable.

Section 29A applies to all forms of work but will be especially relevant in the context of databases,[117] as defined under s 3A. Where a database is subject to the *sui generis* database right, there is a broadly equivalent permitted act under reg 20 of the Copyright and Rights in Databases Regulations 1997.[118] However, there are some differences and, where both rights subsist in a database, it is possible that the database right is infringed in a case where the copyright is not. For example, the source must be indicated for the database right under reg 20 but there is no excuse should it prove impossible so to do. Furthermore, for reg 20, the database must have been made available to the public.

113 *Digital Opportunity: A Review of Intellectual Property and Growth* ('The Hargreaves Report'), 2011, para 5.26.

114 It is arguable that the exceptions falls within the teaching or scientific research exception under Article 5(3)(a) of the Directive on copyright and related rights in the information society.

115 Section 29A(2).

116 Section 29A(3). This is not entirely clear. If the copy dealt with is to be treated as an infringing copy, then it could be argued that the dealing itself infringes copyright and that copy must be an infringing copy for all subsequent purposes. However, the second limb might be intended to apply in a case where a copy is made for the purposes of the initial dealing.

117 Of course, the permitted act is not limited to databases and could apply, for example, to a collection of related text documents.

118 SI 1997/3032.

Fair dealing for the purposes of criticism, review, quotation and reporting current events (s 30)

Quotation was added to the list of purposes as from 1 October 2014. It is treated slightly differently to the purposes of criticism and review and will be discussed after these.

Criticism or review

Criticism may be negative or positive. An academic may write a learned article and include extracts of other works: to challenge some of them and to use others which support his

own article. The use of an extract of a work might be acceptable where the work in question is being reviewed, such as in the case of a newly-released film or play.

Fair dealing for the purpose of criticism or review[119] applies to any form of work or a performance of a work and does not infringe copyright provided that is accompanied by a sufficient acknowledgement, *unless this would be impossible for reasons of practicality or otherwise*.[120] Section 30(1) makes it clear that the criticism or review may be directed towards the work in question or another work or the performance of a work. For example, it is fair dealing to include extracts from a work by H.E. Bates in a work which is a critical analysis of the work of E.M. Forster.[121] But otherwise the work must be subjected to criticism or review. The equivalent defence under the Copyright Act 1956 was held not to apply when correspondence between the Duke and Duchess of Windsor was published without any such criticism or review.[122] This form of fair dealing may also apply where an extract from a dramatic work is used in the criticism or review of a stage play based on the dramatic work.

The requirement for the works to have been made available to the public was inserted by the Copyright and Related Rights Regulations 2003 and, under s 30(1A), this applies where the work has so been made available by any means, including:

(a) the issue of copies to the public;
(b) making the work available by means of an electronic retrieval system;
(c) the rental or lending of copies of the work to the public;
(d) the performance, exhibition, playing or showing the work in public;
(e) the communication to the public of the work;

but no account is to be taken of any unauthorised act.[123]

Of course, now, a person taking advantage of fair dealing for the purposes of criticism or review is not required to accompany his criticism or review with a sufficient acknowledgement if it would be impossible for reasons of practicality or otherwise.[124] The same applies in relation to fair dealing for the purpose of quotation.

A sufficient acknowledgement does not have to be express and may be implied where some of a series of works used are acknowledged and a reasonably attentive person would infer that the others were by the same author. In *Fraser Woodward Ltd* v *British Broadcasting Corporation*,[125] of the 14 photographs used in the television programme, some were acknowledged expressly on screen (for example, by panning down to the author's name at the bottom of the photograph), for some the commentator verbally identified the author. It was held that a moderately attentive person would realise all the photographs were by the same author and, consequently, there was a sufficient acknowledgement for the purposes of s 30.

In giving a sufficient acknowledgement, it is not necessary to give the author's full name, or even any part of his or her name, provided the acknowledgement is sufficient to convey his or her identity to a reasonably alert member of the audience to which the work, including the copyright work, is directed. So it was held at first instance in *Pro Sieben Media AG* v *Carlton UK Television Ltd*,[126] where the defendant had included in its television programme a 30-second video of a woman who was then pregnant with eight foetuses. The extract contained the initials of the claimant's television programme, TAFF, and its logo, a pale, stylised number 7. It was also held that it is not necessary for criticism or review to be the only or the predominant purpose, provided that it was a significant purpose. The purpose itself is something to be tested subjectively from the point of view of the person relying on the permitted act.[127] However, in *Pro Sieben*, the defendant's purpose was to show that the defendant was above the cheque-book journalism allegedly carried on by the claimant. In the Court of Appeal,[128] it was accepted that transmission of a company's television logo could be a sufficient acknowledgement, especially if that was the manner in which the company tended to identify itself. Furthermore, in holding that

119 Copyright, Designs and Patents Act 1988 s 30(1). Criticism may be positive or negative: *David Geva* v *Walt Disney Corp* [1995] 2 EIPR D-39, Sup Ct of Israel.

120 The italicised words were added by reg 3(3) of the Copyright and Rights in Performances (Quotation and Parody) Regulations 2014, SI 2014/2356, with effect from 1 October 2014.

121 Both authors are deceased but literary copyright still subsists in their works.

122 *Associated Newspaper Group plc* v *News Group Newspapers Ltd* [1986] RPC 515.

123 This definition of making available to the public also now applies in relation to fair dealing for the purpose of quotation.

124 1 October 2014.

125 [2005] EWHC 472 (Ch), [2005] FSR 36.

126 [1998] FSR 43.

127 This was doubted in the Court of Appeal, where it was said that motive was more likely to be relevant to the question of whether the dealing might be fair: *Pro Sieben Media AG* v *Carlton UK TV Ltd* [1999] FSR 610 at 620.

128 [1999] FSR 610.

the extract was fair dealing under s 30(1) (criticism or review) and fair dealing under s 30(2) (reporting current events), it was held that criticism need not be directed at the style of the copyright work but could go beyond that and be criticism of the ideas contained within it and the social and moral implications. Walker LJ said (at 620):

> 'Criticism or review' and 'reporting current events' are expressions of wide and indefinite scope. Any attempt to plot their precise boundaries is doomed to failure. They are expressions which should be interpreted liberally, but I derive little assistance from comparisons with other expressions such as 'current affairs' or 'news'.

If the work copied is not criticised, the criticism must be directed at another work rather than the actions of a particular person. In *Ashdown* v *Telegraph Group Ltd*,[129] Paddy Ashdown, then leader of the Liberal Democrats, attended a meeting with the Prime Minister and others. He later dictated a minute of that meeting. Substantial extracts from the minute were copied by the defendant in a newspaper article about secret plans to form a coalition with the Labour Party. In granting summary judgment for Paddy Ashdown, it was held that it was not necessary to publish the minute at all as the criticism was directed at the claimant and the Prime Minister, not at the minute itself. As the Vice-Chancellor stated (at para 24):

> . . . I accept that it is necessary to have regard to the true purpose of the work. Is it 'a genuine piece of criticism and review or is it something else, such as an attempt to dress up the infringement of another's copyright in the guise of criticism, and so profit unfairly from another's work'?

Criticism can be scathing and can involve a substantial part of another work, and yet still be fair dealing.[130] In *Hubbard* v *Vosper*,[131] the defendant had been a member of the Church of Scientology for some 14 years. After leaving, he wrote a book which was highly critical of the cult of Scientology and used in his book substantial extracts from books, bulletins and letters, some of which were confidential, written by the claimant. The defence of fair dealing for the purposes of criticism and review was successfully raised as regards the copyright issues.

In criticising a work other than the one reproduced under the permitted act, it seems that it must relate to a work in the copyright sense. This does not, however, prevent the criticism being levelled at the underlying ideas or philosophy manifested in the work. In *Fraser Woodward Ltd* v *British Broadcasting Corporation*,[132] the defendant screened a programme called *Tabloid Tales*: it used 14 photographs of David Beckham and his family which had been taken by Mr Fraser and published in newspapers. The purpose was to criticise or review tabloid journalism. Mann J confirmed that it was acceptable in this case to use the photographs to criticise or review the tabloid press, being the newspapers and ideas behind them. He confirmed that there was no need specifically to identify the other works and also rejected a submission that a valid test was whether the criticism or review could be carried out without using the works in question. Nor was this a case of copyright infringement dressed up to look like criticism or review. Although the use by the defendant was a commercial use as could have competed with the claimant's exploitation of the photographs, there was no evidence to show that the commercial value of the photographs was seriously diminished by their use in the programme.

The motive behind the use of the claimant's work is an important factor. As Lord Denning confirmed in *Hubbard* v *Vosper*, it would not be fair dealing for a rival to take copyright material belonging to someone else to use as his own. In *Time Warner Entertainments Co Ltd* v *Channel 4 Television Corp plc*,[133] the claimant obtained an injunction to prevent the screening of a programme entitled *Forbidden Fruit* which contained extracts of scenes from the notorious film *Clockwork Orange*, which was withdrawn in the UK some 20 years earlier for fears of copycat violence. The defendant's programme was based on a criticism of the decision to continue to refuse to allow the film to be shown.

129 [2001] RPC 34, appeal dismissed by the Court of Appeal [2002] EWCA Civ 1142, [2002] RPC 5.

130 *See* also *Pro Sieben Media AG* v *Carlton UK TV Ltd* [1999] FSR 610. However, although a defendant may avail himself of the fair dealing defence in such a case, the claimant's remedy may lie in an action for defamation or malicious falsehood.

131 [1972] 2 QB 84.

132 [2005] EWHC 472 (Ch), [2005] FSR 36.

133 [1994] EMLR 1.

The Court of Appeal lifted the injunction on the basis that the defendant could rely on the defence of fair dealing for criticism or review under s 30 of the 1988 Act. The court held that the criticism or review need not be directed primarily at the work itself, and this is confirmed in s 30(1). Although the copy of the film had been obtained, in the claimant's words, 'in an underhand manner' (it had been bought legitimately in Paris), this was not a case where it had been obtained in breach of confidence. In any case, of more relevance was how the work was treated, not how it had been obtained. An argument by the claimant for limiting review by third parties to a total of four minutes' duration failed to impress the court, which confirmed that, in order to criticise a film seriously, sufficient time must be spent showing extracts from the film.

Quotations

Article 5(3)(d) of the Directive on copyright and related rights in the information society allows Member States to provide an exception or limitation to the right of reproduction in the case of 'quotations for purposes such as criticism or review . . .'.[134] The language implies that quotations may be permissible in cases other than criticism or review. That being so, the UK has introduced a new permitted act of the use of a quotation from a work, whether for criticism or review *or otherwise* (emphasis added). Apart from criticism or review, this could include a case where a quotation is used from another work simply as a quotation. For example, some authors of books like to include an appropriate quotation at the beginning of each chapter. An example is:[135]

> 'Make-up can only make you look pretty on the outside but it doesn't help if you're ugly on the inside. Unless you eat the make-up.'*Audrey Hepburn*

Section 30(1ZA) permits the use of a quotation from the work in question, whether for criticism or review or otherwise, provided that:

- the work has been made available to the public (this has the same meaning as in the case of criticism or review, above)
- the use of the quotation is fair dealing with the work
- the extent of the quotation is no more than is required by the specific purpose for which it is used and
- the quotation is accompanied by a sufficient acknowledgement (unless this would be impossible by reason of practicality or otherwise).

The inclusion of the third point is unnecessary. If the extent of the quotation used is greater than required for the specific purpose for which it is used, it cannot be said to be in accordance with fair dealing.

As in some other cases, the permitted act cannot be compromised by a contractual term. To the extent that a contractual term purports to prevent or restrict doing an act within s 30(1ZA), that term is unenforceable.[136]

Reporting current events

In terms of fair dealing for reporting current events, the events in question do not have to be very recent but they must still be related to other events which are of current interest. In *Hyde Park Residence Ltd* v *Yelland*,[137] the publication was of stills taken from video footage recorded by security cameras which showed Diana, Princess of Wales, and Dodi Fayed arriving at and later leaving the Villa Windsor in Paris. The date of publication was nearly one year after. However, and for the purposes of the appeal, Aldous LJ held that the media coverage could be described as current events as the purpose of the reporting was to attempt to discredit what had been said, much more recently, by Mohammed Al Fayed.[138]

Fair dealing for the purpose of reporting current events does not apply in the case of a photograph. It is common practice for newspapers to copy extracts from reports in other

134 Article 10(1) of the Berne Convention for the Protection of Literary and Artistic Works 1886 allows the use of quotations in accordance with fair practice.

135 Although not beyond doubt, this may be just sufficient for copyright protection.

136 Section 30(4).

137 [2000] RPC 604.

138 However, the defendant failed as the purpose was not to report the events shown in the stills.