# 1. Introduction

Many people have misconceptions about copyright. Originality, substantial taking, fair dealing are some of the many copyright concepts which appear simple, but are quite abstract. Some think parallel imports and pirated copies are the same, some confuse the requirement for originality with novelty, some take copyright for registered designs, some believe that there is no infringement if copying is not for trading purposes; the list goes on and on. **3.001**

This chapter is designed to guide readers through the various aspects of copyright. It then moves on to registered designs, which overlaps with the protection copyright gives to certain artistic works, and then to the protection for layout-designs (topography). The case study aims to bring out and analyse some usual practical aspects in handling copyright and registered design infringements, and includes considerations for an interlocutory injunction and issues of enforcement of a court order. **3.002**

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# 2. Copyright

## (a) General

### (i) *Legislation*

The Copyright Ordinance (Cap.528) came into effect on 27 June 1997. The Ordinance incorporates a substantial part of the United Kingdom Copyright, Designs and Patents Act 1988, although those sections relating to registered and unregistered design rights have not been included. Prior to that, copyright law in Hong Kong was principally derived from the Copyright Act 1956 which was extended to Hong Kong by the Copyright (Hong Kong) Order 1972. **3.003**

In addition to the Copyright Ordinance, legislation relating to copyright in Hong Kong includes the Prevention of Copyright Piracy Ordinance (Cap.544), the controversial Intellectual Property (Miscellaneous Amendments) Ordinance 2000 (No 64 of 2000), the Copyright (Suspension of Amendments) Ordinance (Cap.568), the Intellectual Property (Miscellaneous Amendments) Ordinance 2001 (No 2 of 2001), the Copyright (Amendment) Ordinance 2003 (No 27 of 2003), Copyright (Amendment) Ordinance 2004 (No 4 of 2004), Copyright (Amendment) Ordinance 2007 (No 15 of 2007) and Copyright (Amendment) Ordinance 2009 (No 15 of 2009). Unless otherwise stated, references to statutory sections in this chapter are to the Copyright Ordinance. **3.004**

### (ii) *Property right*

Section 2(1) defines copyright as a property right. Section 101(1) provides that copyright is transmissible by assignment, by testamentary disposition or by operation of law, as personal or moveable property. An assignment may be partial[1] and is effective **3.005**

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[1] Section 101(2).

when it is in writing signed by or on behalf of the assignor.[2] An assignment may also be for future copyright if it is signed by or on behalf of the prospective owner of the copyright.[3] However, it should be noted that moral rights are not assignable.[4]

**3.006** According to s.3, copyright comprises both economic rights (rights to reproduce and moral rights (right to be identified as author or director and right to object to derogatory treatment of work). Copyright also covers performers' rights which, according to s.215(1), recognises a performer's economic rights as property rights and includes the rights of reproduction, distribution and making available to the public.

### (b) Basic requirements

**3.007** In general, copyright only subsists in a work if the work:

(1) Is original;[5]

(2) Is recorded, in writing or otherwise;[6]

(3) Falls within any of the following descriptions of work:[7]

(a) Literary, dramatic, musical or artistic works;

(b) Sound recordings, films, broadcasts or cable programmes; or

(c) The typographical arrangement of published editions;[8] and

(4) Is created by an author who satisfies the qualification requirements, is published in Hong Kong or elsewhere; or in the case of a broadcast or cable programme, is made or sent from Hong Kong or elsewhere.[9]

#### (i) *Originality*

**3.008** There is no definition in the Ordinance of the word "original", but the classic statement of the law by Peterson J in *University of London Press Ltd v University Tutorial Press Ltd*, said in *Interlego AG v Tyco Industries Inc*[10] explains the concept:

> The word "original" does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of

[2] Section 101(3).
[3] Section 102.
[4] Section 105.
[5] Section 2(1)(a).
[6] Section 4(2). See also s.198 "writing" includes any form of notation or code, whether by hand or otherwise and regardless of the method by which, or medium in or on which, it is recorded and "written" is construed accordingly.
[7] Section 2(1).
[8] See for musical works, s.4(1); for artistic works, s.5; for sound recordings, s.6(1); for films, s.7(1) and (2); for broadcasts, s.8(1); for cable programmes, s.9; and for typographical arrangements of published editions, s.19(1).
[9] Section 177.
[10] [1989] AC 217.



"literary work", with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.[11]

**3.009** Hence it is often said that copyright subsists not in ideas, but in the form in which the ideas are expressed. Lord Hoffmann gave this analysis in the House of Lords case *Designers Guild Ltd v Russell Williams (Textiles) Ltd*:

> My Lords, if one examines the cases in which the distinction between ideas and the expression of ideas has been given effect, I think it will be found that they support two quite distinct propositions. The first is that a copyright work may express certain ideas which are not protected because they have no connection with the literary, dramatic, musical or artistic nature of the work. It is on this ground that, for example, a literary work which describes a system or invention does not entitle the author to claim protection for his system or invention as such. The same is true of an inventive concept expressed in an artistic work. However striking or original it may be, others are (in the absence of patent protection) free to express it in works of their own: see *Kleeneze Ltd v DRG (UK) Ltd* [1984] FSR 617. The other proposition is that certain ideas expressed by a copyright work may not be protected because, although they are ideas of a literary, dramatic or artistic nature, they are not original, or so commonplace as not to form a substantial part of the work. *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99 is a well-known example.[12]

**3.010** An author needs to show that he has expended his skill and judgment in order to justify protection. In a Canadian case *CCH Canadian Ltd v Law Society of Upper Canada*,[13] "skill" is said to mean the use of one's own knowledge, developed attitude or practised ability in producing the work and "judgment" the use of one's capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work. This exercise of skill and judgment necessarily involves intellectual effort. There is no judicial minimum amount of time or effort required in the creation of a work for it to attract protection but it could not be too trivial. In *CCH Canadian Ltd v Law Society of Upper Canada*, headnotes of a judgment are held to constitute "original" works. The court held that although headnotes were inspired in large part by the judgment which they summarised and referred to, they were not an identical copy of the reasons. The authors had to select specific elements of the decision and could arrange them in a number of different ways. The authors had to use their knowledge of the law and developed ability to determine the legal ratios to produce headnotes and they also had to use their capacity for discernment to decide which parts of the judgment warranted inclusion in the headnotes.[14]

[11] (1916) 2 Ch 601, 608–609.
[12] [2001] FSR 113, 121.
[13] [2004] 1 SCR 399.
[14] *Ibid.*, [30].

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**3.011** In *Sawkins v Hyperion Records Ltd*,[15] the plaintiff worked on the works of Lalande (whose copyright had expired) to produce modern performing editions. His intention was to produce more faithful and better copies of Lalande's original music and to make it playable. He admitted that, save for one piece, he had not composed anything new. Nonetheless, the plaintiff claimed that his editions were original musical works as he originated the performing editions by his own expert and scholarly exertions, the editions did not previously exist in that form and the contents of his editions affected the combination of sounds produced by the performers. He did not claim copyright in the musical composition by Lalande, or an arrangement, transcription or interpretation of Lalande's music, or a compilation of Lalande's music or a typographical arrangement of Lalande's music. He claimed copyright in the performing editions he created. It was adduced as evidence that the work was laborious and painstaking and extended over a considerable period of time as both manuscript and printed sources of Lalande's works were incomplete and inconsistent. The plaintiff had spent over 300 hours on each edition and made more than 3,000 editorial interventions in the works. Both the first instance court and the Court of Appeal (unanimously) held that the effort, skill and time which the plaintiff spent in making the performing editions were sufficient to satisfy the requirement that they should be "original" works.

**3.012** The Hong Kong case of *Tai Shing Diary Ltd v Maersk Hong Kong Ltd*[16] again demonstrated that the threshold to satisfy originality is a low one and simplicity did not prevent from passing the low threshold for claiming originality. There, the defendants argued that the plaintiff's diaries lacked sufficient originality in that they were common to all diaries and calendars. The plaintiff successfully entered summary judgment against the defendants (one of them was given leave to defend the claim for damages). The court expressed:

> Based on [the plaintiff's] very detailed account of authorship of the works in question, there could be no doubt that the requirement of originality had been satisfied, and thus the question of subsistence of copyright overcome. The author might draw on existing material, so long as more than negligible or trivial effort or relevant skill and judgment had been expended in the creation of the work. The standard required was a low one, but the effort must not be so trivial as to be characterised as a purely mechanical exercise. The skill and effort protected was not only that expended on its manner of presentation, but of collecting, selecting, arranging and presenting the available information in an intelligible manner.[17]

**3.013** To assess the subsistence of copyright in a work, it is wrong to make that assessment by dissecting the whole into separate parts and then submitting that there is no copyright in the parts.[18] The work must be assessed as a whole.

[15] [2005] RPC 4.

[16] [2007] 2 HKC 23.

[17] *Ibid*., [23]. See also *GA Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329 where copyright in a diary was denied by the House of Lords. Lord Porter, agreeing with the trial judge and the dissenting judge of the Court of Appeal held that "the compilation for which copyright is claimed is nothing more than a commonplace selection or arrangement of scraps of information neither of which involved any real exercise of labour, judgment or skill".

[18] See *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 (HL) followed in *Baigent v Random House Group Ltd* [2007] RPC 24.



### (ii) *Subject matters*

*Literary works*

**3.014** It is worth noting that a literary work does not need to have any particular literary merits: for example, this book is a literary work! In *Linda, Chih Ling Koo v Lam Tai Hing*,[19] the court accepted that a lot of time, considerable skill, judgment and labour had been exercised in formulating a questionnaire with a view to conducting interviews most effectively. The questionnaire was therefore a literary work. Case law has also established that examination papers, pools coupons, directories and trade catalogues etc are protectable as literary works.[20]

Literary works are defined under s.4(1) to mean any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes:

(1) a compilation of data or other material, in any form, which by reason of the selection or arrangement of its contents constitutes an intellectual creation, including but not limited to a table;

(2) a computer program; and

(3) preparatory design material for a computer program.

**3.015** There is no definition of "computer program" in the Ordinance. In *HKSAR v Chan Tak Kuen*,[21] the Court of Appeal discussed and analysed the approach to source and object codes in the United Kingdom and Australia and held that object codes cannot be a literary work because electrical impulses in a silicon chip could not be perceived by the senses and were not intended to convey any message to a human being. Although a copy of a computer program is regarded as a true copy of the program for the purpose of a s.121 affidavit,[22] this does not confer copyright on the object codes.[23] Object codes are however protected as adaptations. In relation to a computer program, "adaptation" means "an arrangement or altered version of the program or a translation of it".[24] "Translation" includes a version of the program in which it is converted into or out of a computer language or code or into a different computer language or code.[25]

**3.016** Likewise, "compilation" is not defined. According to its dictionary meaning, to compile something means to write or produce something by collecting and putting together many pieces of information. Like all other copyright work, it requires originality and the emphasis as stated in the subsection is on the selection or arrangement

[19] [1992] 2 HKLR 314.

[20] See *University of London Press v University Tutorial Press* [1916] 2 Ch 601; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273; *Kelly v Morris* [1866] LR 1 Eq 697; and *Davis v Benjamin* [1906] 2 Ch 491.

[21] [2004] 3 HKLRD 112 (CA).

[22] See paras.3.165–3.170.

[23] Cheung JA cautioned at para.62: "In my view the absence of a statutory definition of computer program is a potential pitfall in copyright enforcement in this area. If Hong Kong is to keep its competitive edge as a world class city, I would urge immediate steps be taken to introduce amendments to the Ordinance along the Australian model".

[24] Section 29(3) of the Ordinance.

[25] Section 29(4) of the Ordinance.

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