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## Addressing the Impediments Copyright Imposes on the Use of Patent Specifications and Prior Art Documents to Improve Patent Quality

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N O R T H W E S T E R N  
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INTELLECTUAL PROPERTY

**Addressing the Impediments Copyright Imposes on the Use of  
Patent Specifications and Prior Art Documents to Improve  
Patent Quality**

*Ben McEniery*



# Addressing the Impediments Copyright Imposes on the Use of Patent Specifications and Prior Art Documents to Improve Patent Quality

By Ben McEniery\*

*This article considers from an Australian perspective the impediments that copyright law places in the path of those who seek to use patent specifications and non-patent prior art documents in ways that are necessary to the proper functioning of the patent system. Until recently, copyright law in Australia had limited the uses to which members of the public could put patent specifications in that country. Those impediments have been removed as a result of an important legislative change to the way in which copyright in patent specifications can be enforced. The change gives the public a greater freedom to make use of patent specifications than it enjoyed before, and removes unwarranted restrictions upon the ways in which the public can reuse valuable information. However, what the amendment does not address is the impediments copyright imposes on using non-patent prior art documents in ways that advance the public interest.*

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## I. INTRODUCTION

¶1 Patent specifications are the means by which a patent applicant discloses an invention to the public. In exchange for the monopoly protection granted, a patentee must disclose fully the workings of the invention and the best-known method for operating it at the time a complete application is filed. That information is later published by the patent office for the benefit of the public.

¶2 The public benefits from this disclosure in two ways. First, the public is given access to a description of the invention. This is a boost for follow-on inventors, who can use the information disclosed as a foundation upon which further (non-infringing) research and innovation can occur during the patent term.<sup>1</sup> Second, the public gets to use the invention at the expiry of the patent term, free of charge, when the patent falls into the public domain and becomes free for all to use without restriction.<sup>2</sup>

¶3 Even though patent specifications are the means by which inventions are disclosed to the public, they are works protected by copyright. This copyright protection continues well after the patent expires and the patentee has had the opportunity to take full advantage of the patent monopoly period. However, there has been a legislative change in Australia to the way in which copyright in patent specifications can be enforced. The change is an amendment to section 226 of the *Patents Act 1990* (Cth) (“Patents Act”), which gives the public greater freedom to make use of patent specifications than it enjoyed before.

¶4 Previously, section 226 allowed a person to make a two-dimensional reproduction of a patent specification without needing the authorization of the copyright holder. The object of the provision was ostensibly to facilitate the disclosure of knowledge and information a patent applicant is obliged to make in exchange for being granted the monopoly protection that a patent provides by allowing a person to make copies of the specification. However, while the provision went some way to achieving its objective, it was deficient because it did not allow for persons other than the copyright owner to exercise rights other than the right of reproduction. For this reason, the protection given by this section was too narrow in an age where people can do many more useful things with information than just copying it. The section now allows a person other than the copyright owner to exercise a broader range of rights with respect to patent specifications without the authorization of the copyright holder; namely, to reproduce, communicate to the public, and translate a patent specification that is open to public inspection.<sup>3</sup>

¶5 However, while beneficial, the amendment gives no respite from the effects of copyright law on other works that members of the public might legitimately wish to use to engage with the patent system. In this regard, the amendment gives the public no rights with respect to documents that are read in conjunction with patent specifications, such as prior art documents. Prior art documents are the standard against which patents are measured to determine whether they are novel and involve an inventive step, and are

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<sup>1</sup> See Suzanne Scotchmer, *Standing on the Shoulders of Giants: Cumulative Research and the Patent Law*, 5 J. ECON. PERSP. 29, 31 (1991).

<sup>2</sup> *CCOM Pty Ltd. v Jiejing Pty Ltd.* (1994) 122 ALR 417, 433 (Austl.); see also *American Cyanamid Company (Dann’s) Patent (Dann’s Patent)* [1971] R.P.C. 425, 436 (Lord Reid) (Austl.).

<sup>3</sup> The amendment was brought into effect by the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) on April 15, 2012. Although most changes wrought by the Act came into effect on April 15, 2013, this change took effect immediately upon the amending Act coming into force.

thus patentable. Prior art can include patents filed in Australia or overseas; printed publications such as books, theses, journals and technical reports; public lectures or discussions; or public use of a product or process occurring anywhere in the world. Like patent specifications, prior art documents are works protected by copyright, provided the necessary conditions for the subsistence of copyright are met. As a consequence, members of the public are prevented from making certain uses of prior art documents in ways that advance the public interest unless they obtain permission from the copyright owner, which may be refused or difficult to obtain.

¶6 This article argues that it is in the public interest to allow people to reproduce, communicate, and translate prior art documents for the purpose of investigating, discussing, or forming an opinion as to whether a particular invention is deserving of a patent. As such, it is asserted that it is necessary that people have a right to use prior art documents in ways that benefit the proper functioning of the patent and innovation systems similar to the rights they have with respect to patent specifications.

## II. PUBLIC INTEREST PROJECTS AFFECTED

¶7 The restrictions that copyright law imposes impact public interest projects that collate patent information in the public interest. One example is CAMBIA's Patent Lens. CAMBIA is an independent non-profit research institute that has the stated aim of encouraging innovation in the life sciences by making research freely available to anyone who wants to use it.<sup>4</sup> CAMBIA's Patent Lens is an open-access, full-text patent informatics resource. It is designed to make the documents that describe the state of the art in various fields available in one place, and to demonstrate the links that exist between those documents. It also helps people understand where there is freedom to operate with respect to patent laws in different parts of the world. It does this by providing "patent landscapes," which are collocations of patent, scientific, technical and business data organized in a navigable form around particular topics or research areas.

¶8 CAMBIA's Patent Lens was developed to bring a transparency to the patent system by making available information that will allow people to know the patents that are in force over specific technologies, and by whom they are held. Patent Lens was designed to prevent unwitting patent infringement, and to help people in areas where they previously feared incomplete information about which rights have been allocated and who they are held by.<sup>5</sup> All of this information is available online and provided to the public free of charge on the Patent Lens web site. However, despite its great value to the public, the project is arguably threatened by the limitations copyright law places on the uses of prior art documents.

¶9 Another example of the impact upon public interest projects is the stifling effect copyright protection has on projects such as Peer-to-Patent, which seeks to improve the quality of issued patents. The Australian Peer-to-Patent project—Peer-to-Patent Australia—is a non-profit public interest project designed to improve the patent

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<sup>4</sup> See generally CAMBIA, <http://www.cambia.org/daisy/cambia/home.html> (last visited July 13, 2010); Richard Jefferson, *Science as Social Enterprise: The CAMBIA BiOS Initiative*, INNOVATIONS: TECH., GOVERNANCE, GLOBALIZATION, Fall 2006, at 13.

<sup>5</sup> *Why Are We Doing This?*, PATENT LENS, <http://www.patentlens.net/daisy/patentlens/search/faq-plens.html> (last visited July 28, 2013).

examination process and the quality of issued patents.<sup>6</sup> Peer-to-Patent is a response to complaints that the patent system is a threat to existing business and innovation because patent offices regularly grant patents for inventions that are neither novel nor non-obvious.<sup>7</sup> These are criticisms of patent offices and the rigor of their examination processes, but are also a reflection of the difficulty of the work performed by patent examiners. Patent examiners are required to read and understand a patent application, research the prior art, determine whether a patent is to be granted, and draft a report. Patent applications are often long, detailed, and written in complicated technical language. The relevant prior art may be hard to locate, poorly expressed, difficult to comprehend, poorly indexed, or written in a foreign language. Further, it is unlikely a patent examiner will be an expert in every type of technology that comes across his or her desk.

¶10 Peer-to-Patent Australia facilitates the provision of focused and targeted information from citizen experts to government as a means of assisting patent examiners. It involves members of the public reviewing participating patent applications on a publicly available website prior to examination and submitting relevant prior art documents. The top ten prior art documents submitted, as voted by the community of reviewers, are forwarded in accordance with section 27 of the Patents Act to the patent office and are put before the patent examiner to be considered in examination.<sup>8</sup> Only ten prior art documents are forwarded to avoid the patent office being overburdened with prior art references. The aim is to allow the public to assist the examination process by using the Web to supply the patent office with information relevant to the novelty and inventiveness of pending patent applications. This process in no way affects the patent examiner's responsibility to assess a patent application. The view is that the better the prior art resources a patent examiner has at his or her disposal, the more likely a patent application will be assessed properly in terms of novelty and inventive step.

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<sup>6</sup> Peer-to-Patent Australia is operated by the Queensland University of Technology (QUT) and is run in conjunction with, and with the support of, IP Australia. It is also the result of the collaborative efforts of the Queensland University of Technology Faculty of Law and New York Law School. Peer-to-Patent Australia ran initially as a six-month pilot project which commenced on December 9, 2009. The Peer-to-Patent Australia project website is located at <http://www.peertopatent.org.au>. The project is currently in hiatus as its initial pilot is under review. The Peer-to-Patent concept is the brainchild of Professor Beth Noveck and an initiative of New York Law School's Center for Patent Innovations. New York Law School launched its Peer-to-Patent project in collaboration with the United States Patent and Trademark Office (USPTO) in June 2007 to open the patent examination process to public participation for the first time. The United States Peer-to-Patent project website is located at <http://www.peertopatent.org>. See Beth Simone Noveck, "Peer to Patent": *Collective Intelligence, Open Review, and Patent Reform*, 20 HARV. J.L. & TECH. 123 (2006); BETH SIMONE NOVECK, WIKI GOVERNMENT: HOW TECHNOLOGY CAN MAKE GOVERNMENT BETTER, DEMOCRACY STRONGER, AND CITIZENS MORE POWERFUL (2009). Peer-to-Patent pilots have run in the United States, Japan, Australia, Korea, and the United Kingdom.

<sup>7</sup> See, e.g., ADAM B. JAFFE & JOSH LERNER, INNOVATION AND ITS DISCONTENTS: HOW OUR BROKEN PATENT SYSTEM IS ENDANGERING INNOVATION AND PROGRESS, AND WHAT TO DO ABOUT IT 22 (2004); BRIAN FITZGERALD ET AL., INTERNET AND E-COMMERCE LAW: TECHNOLOGY, LAW AND POLICY 370 (2007); JAMES BESSEN & MICHAEL J. MEURER, PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK 2-3, 236 (2008); Carl Shapiro, *Patent System Reform: Economic Analysis and Critique*, 19 BERKELEY TECH. L.J. 1017, 1018, 1027-31 (2004).

<sup>8</sup> *Patents Act 1990* (Cth) s 27 allows the Commissioner of Patents to receive information submitted by third parties relevant to the novelty and inventiveness of an invention disclosed in an application for a standard patent.

¶11 The Peer-to-Patent Australia pilot project ran before the amendment to section 226 of the Patents Act was made. As such, the first copyright law barrier the project encountered was that the copyright owner's consent was needed before a patent specification could lawfully be uploaded to a publicly available web site to be peer reviewed.<sup>9</sup> That difficulty has now been overcome with the amendment to section 226. The second barrier was that a member of the public might not have been authorized by the copyright owner, or might not have known of such authorization, if it had been given, to reproduce, publish, communicate to the public, or make a translation of a prior art document for the purpose of having that document put before a patent examiner to be considered in a patent examination. That barrier remains.

¶12 Finally, and similar to the USPTO and Google Patents,<sup>10</sup> there is the communication to the public by the Australian government of patent specifications filed in Australia. The Australian Patents Office (which forms part of IP Australia) publishes patent specifications that have been laid open to public inspection on IP Australia's AUSPAT website (<http://www.ipaustralia.gov.au/auspat/index.htm>).<sup>11</sup> This is an important means of widely disseminating the technological information disclosed in patent specifications and publicizing the existence of patents.

### III. COPYRIGHT IN PATENT SPECIFICATIONS

#### A. *Subsistence of Copyright in Patent Specifications*

¶13 In Australia, the law of copyright is found primarily in the *Copyright Act 1968* (Cth) ("Copyright Act"). That Act provides for the subsistence of copyright in various forms, and subject to any prerogative right or privilege of the Crown, copyright does not subsist in a work other than by virtue of the Copyright Act.<sup>12</sup> Part III of the Copyright Act provides for the subsistence of copyright in an original unpublished literary, dramatic, musical, or artistic work<sup>13</sup> of which the author was a qualified person at the time the work was made.<sup>14</sup> Copyright subsists in an original published literary work if it was first published in Australia.<sup>15</sup> The duration of copyright in a literary, dramatic, musical or artistic work is the life of the author plus 70 years,<sup>16</sup> unless the work is unpublished at the time of the author's death, in which case copyright continues to subsist

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<sup>9</sup> A total of 31 patent applications were put forward by eight distinct entities to be peer reviewed. Consenting applicants were, for the most part, large multinational companies with considerable patent portfolios. In this respect, the Peer-to-Patent Australia project was able to draw heavily on the goodwill and contacts established by the organisers of the United States Peer-to-Patent project. See Brian Fitzgerald, Ben McEniery, & Jimmy Ti, *Peer-to-Patent Australia: First Anniversary Report 20* (2010), available at [http://www.peertopatent.org.au/P2PAU\\_1st\\_Anniversary\\_Report.pdf](http://www.peertopatent.org.au/P2PAU_1st_Anniversary_Report.pdf).

<sup>10</sup> Google Patents is located at <http://www.google.com/patents/>.

<sup>11</sup> IP Australia's AUSPAT website is located at <http://www.ipaustralia.gov.au/auspat/index.htm>.

<sup>12</sup> *Copyright Act 1968* (Cth) s 8.

<sup>13</sup> *Id.* s 32(1).

<sup>14</sup> *Id.* s 32(4) (providing that "[i]n this section, *qualified person* means an Australian citizen or a person resident in Australia.").

<sup>15</sup> *Id.* s 32(2).

<sup>16</sup> *Id.* s 33(2). This complies with Australia's requirements under international law under the *Australia – United States Free Trade Agreement 2004* (entered into force January 1, 2005).

until 70 years after the work is first published.<sup>17</sup> Ownership of any copyright subsisting in a literary, dramatic, musical or artistic work vests in the author,<sup>18</sup> unless the work is made by the author in the course of employment and pursuant to the terms of his or her employment under a contract of service, in which case ownership vests in the employer,<sup>19</sup> subject to any agreement to the contrary.<sup>20</sup>

¶14 Copyright arises when a work is made, and, unlike patents, its existence does not depend on registration. Copyright law requires that literary, dramatic, musical, or artistic works must be “first reduced to writing or to some other material form” to be eligible for copyright protection.<sup>21</sup> This means there must be some tangible embodiment of the work.<sup>22</sup> This is the essence of the idea/expression dichotomy: the principle that copyright does not protect ideas or information, only an idea that is expressed in “material form” from which accurate copies or reproductions can be made. Accordingly, what copyright protects is not the idea behind a particular work, but the particular form of expression in which an idea or information is conveyed.<sup>23</sup>

¶15 The subsistence of copyright also depends on originality—that the work originated from the author. It demands that the author has exercised skill, judgment, and effort in the creation of the work and that the work has not been copied.<sup>24</sup>

¶16 The ordinary meaning of the term “literary work” suggests the need for the work to be in print or writing, but when read in conjunction with the definitions of “material form” and “writing,” it takes a broader scope.<sup>25</sup> Use of the word “literary” is not a reference to literary quality, but rather to the fact that the work is expressed in print or writing. In *Hollinrake v Truswell*,<sup>26</sup> Lord Herschell observed that copyright protection is afforded to “the particular form of expression in which an author convey[s] ideas or information to the world.”<sup>27</sup> In the same case, Lord Justice Davey perceived that a literary work is one “intended to afford either information and instruction, or pleasure, in

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<sup>17</sup> *Copyright Act 1968* (Cth) s 33(3).

<sup>18</sup> *Id.* s 35(2).

<sup>19</sup> *Id.* s 35(6).

<sup>20</sup> *Id.* s 35(3).

<sup>21</sup> *Id.* s 22(1).

<sup>22</sup> *Id.* s 10(1) (providing that “*material form*, in relation to a work or an adaptation of a work, includes any form (whether visible or not) of storage of the work or adaptation, or a substantial part of the work or adaptation, (whether or not the work or adaptation, or a substantial part of the work or adaptation, can be reproduced)” and that “*writing* means a mode of representing or reproducing words, figures or symbols in a visible form, and *written* has a corresponding meaning”).

<sup>23</sup> See *Donoghue v Allied Newspapers, Ltd.* [1938] Ch 106 (Austl.); *Blackie & Sons Ltd. v Lothian Book Publ'g Proprietary Ltd.* (1921) 29 CLR 396, 400 (Starke J) (Austl.); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991). See also Article 9.2 of the *Agreement on Trade-Related Aspects of Intellectual Property Rights* and Article 2 of the *World Intellectual Property Organization Copyright Treaty 1996* (“WCT”), which both state that copyright protection extends “to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.”

<sup>24</sup> See *Univ. of London Press Ltd. v Univ. Tutorial Press, Ltd.* [1916] 2 Ch 601, 608–10 (Peterson J) (Austl.); *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.* [1964] 1 WLR 273 (H.L.) 277–78; *Sands & McDougall Proprietary Ltd. v Robinson* (1917) 23 CLR 49 (Austl.).

<sup>25</sup> *Copyright Act 1968* (Cth) s 10(1) (Austl.). The statute does not exhaustively define “literary work,” but states in section 10(1) that it includes “a table, or compilation, expressed in words, figures or symbols” and “a computer program or compilation of computer programs.”

<sup>26</sup> [1894] 3 Ch. 420 (Eng.).

<sup>27</sup> *Id.* at 424 (Lord Herschell L.C.) (quoted with approval in *IceTV Pty. Ltd. v Nine Network Australia Pty. Ltd.* (2009) 239 CLR 458 (Austl.) (French CJ, Crennan & Kiefel JJ)).



the form of literary enjoyment.”<sup>28</sup> The High Court of Australia in *IceTV Pty. Ltd. v Nine Network Australia Pty. Ltd.*,<sup>29</sup> emphasized that copyright protection focuses on the form of expression:

Copyright does not protect facts or information. Copyright protects the particular form of expression of the information, namely the words, figures and symbols in which the pieces of information are expressed, and the selection and arrangement of that information. That facts are not protected is a crucial part of the balancing of competing policy considerations in copyright legislation. The information/expression dichotomy, in copyright law, is rooted in considerations of social utility. Copyright, being an exception to the law’s general abhorrence of monopolies, does not confer a monopoly on facts or information because to do so would impede the reading public’s access to and use of facts and information. Copyright is not given to reward work distinct from the production of a particular form of expression.<sup>30</sup>

¶17 An “artistic work” is, among other things, “a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not.”<sup>31</sup> Relevantly, a “drawing” includes a diagram, map, chart, or plan and includes functional drawings.<sup>32</sup>

¶18 The economic rights of the owner of copyright in literary, dramatic, musical, and artistic works include the following rights: reproducing the work in a material form; publishing the work; performing the work; communicating the work to the public; making an adaptation of the work, such as a translation; and entering into a commercial rental arrangement, where the work is a computer program or is reproduced in a sound recording.<sup>33</sup>

¶19 The principal right that copyright gives the owner of an original literary work is the exclusive right to reproduce the work in a material form.<sup>34</sup> This includes reproduction of a “substantial part” of the work.<sup>35</sup> Infringement occurs when “a person who, not being the owner of the copyright, and without the licence of the owner of the copyright, does in Australia, or authorises the doing in Australia of, any act comprised in the copyright.”<sup>36</sup> Infringement will occur where the act is done in relation to the whole of the protected work or a substantial part.<sup>37</sup> What is “substantial” is a question of fact and degree, to be determined according to the circumstances.<sup>38</sup> Knowledge is not an element; it is not necessary for the copyright owner to prove that the infringer knew the act to be an infringement.<sup>39</sup> Making a work available on the Internet would constitute a reproduction

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<sup>28</sup> *Id.* at 428.

<sup>29</sup> (2009) 239 CLR 458 (Austl.).

<sup>30</sup> *Id.* at 472 (citations omitted).

<sup>31</sup> *Copyright Act 1968* (Cth) s 10(1).

<sup>32</sup> *British Leyland v. Armstrong* [1986] R.P.C. 279 (H.L.) 289 (appeal taken from Eng.); *see also id.* at 379.

<sup>33</sup> *Copyright Act 1968* (Cth) s 31(1).

<sup>34</sup> *Id.* ss 31(1)(a)(i), 31(1)(b)(i).

<sup>35</sup> *Id.* s 14.

<sup>36</sup> *Id.* s 36.

<sup>37</sup> *See id.* s 14(1)(a).

<sup>38</sup> *S.W. Hart & Co. Proprietary Ltd. v Edwards Hot Water Sys.* (1985) 159 CLR 466 (Austl.).

<sup>39</sup> *See Copyright Act 1968* (Cth) ss 36, 101; *Mansell v. Valley Printing Co.* [1908] 2 Ch 441 (Eng.).

in a material form because copies of the work are necessarily created when the file containing the work is uploaded.

¶20 The right to publish the work<sup>40</sup> is an important exclusive right of the copyright owner. A literary, dramatic, musical, or artistic work is deemed to be published if reproductions of the work have been supplied to the public.<sup>41</sup> The right to publish a work is the right “to make public that which has not previously been made public in the copyright territory” and does not extend to any subsequent distribution of the work.<sup>42</sup> Making a work available on the Internet that has not previously been made publicly available would constitute publication, since members of the public could download the work, thereby satisfying the need for reproductions to be supplied.

¶21 The right to communicate the work to the public<sup>43</sup> is an important right in the online environment. In relation to a work, to “communicate” is a technology neutral right to “make available online or electronically transmit (whether over a path, or a combination of paths, provided by a material substance or otherwise).”<sup>44</sup> A communication may be to the public within or outside Australia.<sup>45</sup> There may be a communication “to the public” where a communication is made to an individual, even if taking place in a private or domestic setting.<sup>46</sup> Making a work available on the Internet or through a computer network constitutes a communication to the public.

¶22 There are, of course, defenses to copyright infringement, including the fair dealing defenses. Unlike United States copyright law, which provides a flexible and open-ended fair use defense to copyright infringement,<sup>47</sup> the Australian law contains more restrictive fair dealing defenses to infringement claims.<sup>48</sup> The fair dealing defenses provide that an otherwise infringing dealing with copyright-protected material is not actionable if the act is done for one or more stated purposes. Dealing with copyright-protected material is not actionable if the dealing is fair and done for the purpose of: research or study (section 40); criticism or review (section 41); reporting news (section 42); professional advice given by a legal practitioner or patent attorney (section 43(2)); and parody and satire (section 41A). There are also other defenses contained in Pt III, Div 3 of the Copyright Act, which concern things such as reproduction for the purpose of judicial proceedings or professional advice, or temporary reproductions made in the course of communication.<sup>49</sup>

¶23 A patent specification describes inventions using words, or a combination of words and diagrams or images. It is protected by copyright, and in copyright terms is either a literary work or combination of a literary work and one or more artistic works. However,

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<sup>40</sup> *Id.* s 31(1)(b)(ii).

<sup>41</sup> *Id.* s 29(1)(a).

<sup>42</sup> *Avel Proprietary Ltd. v Multicoin Amusements Proprietary Ltd.* (1990) 171 CLR 88, 93 (Austl.).

<sup>43</sup> *Copyright Act 1968* (Cth) s 31(1)(b)(iii).

<sup>44</sup> *Id.* s 10(1) (defining “communicate”). In Australia, the right to communicate to the public was enacted as part of the reform agenda introduced by the *Copyright Amendment (Digital Agenda) Act 2000*, which implemented Article 8 of the World Intellectual Property Organization (“WIPO”) *Copyright Treaty* of 1996 (effective March 6, 2002).

<sup>45</sup> *Id.* (defining “to the public”).

<sup>46</sup> *See Telstra Corp. Ltd. v. Australasian Performing Right Ass’n Ltd.* (1997) 191 CLR 140, 140 (Austl.) (discussing the definition of “to the public”); *id.* at 141–42 (discussing a situation where transmission to private individuals could count as a broadcast to the public).

<sup>47</sup> 17 U.S.C. § 107 (2006).

<sup>48</sup> *See Copyright Act 1968* (Cth) ss 40–43.

<sup>49</sup> *See id.* ss 43–44F.

unlike a patent holder, a copyright owner does not have a monopoly over knowledge, but merely has rights with respect to the way that knowledge has been expressed in material form.<sup>50</sup> Bearing in mind the effect of section 226 of the Patents Act, the owner of copyright in a patent specification has the exclusive right to publish the specification, communicate the specification to the public, and make a translation of the specification. Those acts cannot be performed by someone other than the copyright owner unless the copyright owner gives permission.

### B. *Ownership of Copyright in Patent Specifications*

¶24 It is important to realize that ownership of copyright in a patent specification does not necessarily follow ownership of the invention disclosed in the specification. As such, it cannot be assumed that the patentee or patent applicant owns that copyright.

¶25 The first owner of copyright in a patent specification will be the author (usually the inventor or a patent attorney). However, that copyright may vest in an entity whose copyright is derived from the author (such as an employer), or may be assigned voluntarily to another. Alternatively, copyright may vest in the Crown by virtue of the Crown Copyright provisions in the Copyright Act, or a Crown prerogative in the nature of copyright.<sup>51</sup> Given these possibilities, it is difficult to identify the copyright owner of any given patent specification. This is a problem for anyone who might wish to seek permission to disseminate or otherwise use patent specifications. If permission is needed to use a patent specification, use without permission might amount to a copyright infringement.

¶26 The following sections consider the general provisions in Part III of the Copyright Act relating to copyright ownership in works, along with the Part VII provisions that relate to Crown Copyright, in order to identify whether copyright ownership in lodged patent specifications ever vests in the Crown.

#### 1. General Provisions Relating to Copyright Ownership

¶27 Under Part III of the Copyright Act, copyright subsists in literary, dramatic, musical and artistic works provided certain conditions are met.<sup>52</sup> The default position is that the first owner of copyright in Part III works is the author, who must be a natural person.<sup>53</sup> Relevantly, section 32(1) provides that the work must be “an original literary . . . work that is unpublished and of which the author . . . was a qualified person.” A qualified person is an Australian citizen or a person resident in Australia.<sup>54</sup> Section 35 of the Copyright Act provides that, subject to exceptions provided in the section, the

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<sup>50</sup> *IceTV Pty. Ltd. v. Nine Network Austl. Pty. Ltd.* (2009) 239 CLR 458, 472 (Austl.).

<sup>51</sup> The question of whether copyright in a patent specification vests in the Crown by virtue of a Crown prerogative in the nature of copyright is beyond the scope of this article.

<sup>52</sup> *Copyright Act 1968* (Cth) s 32. Part IV governs subsistence of copyright in sound recordings, cinematograph films, television and sound broadcasts, and published editions of works (“subject-matter other than works”).

<sup>53</sup> *Id.* s 35(2). See also *Copyright Act 1968* (Cth) s 32(4) (defining a qualified person as an Australian citizen or person resident in Australia). The *Copyright (International Protection) Regulations* extend these provisions to citizens, nationals, and residents of *Berne Convention* countries, World Trade Organization countries, and other countries that are parties to the *Universal Copyright Convention 1952*.

<sup>54</sup> *Copyright Act 1968* (Cth) s 32(4).

author of the work in which copyright subsists is the owner of copyright in the work. This general rule is subject to several exceptions. One exception is that copyright in works made during the course of employment will generally vest in the employer.<sup>55</sup>

¶28 Who copyright vests in depends on the circumstances. Applying the general provisions relating to copyright ownership, the owner of copyright in a patent specification will, in most cases, be one of the following: the author or authors of the specification; the author's or authors' employer (as a result of the express or implied terms of an employer-employee relationship or a written assignment of copyright); or anyone else to whom the first owner of copyright has assigned that copyright.

¶29 In some cases, the applicant will own the copyright. This may be the case when the applicant is the inventor and has drafted his or her own patent application but has not assigned that copyright to another. It may also be the case where the applicant is the employer of an inventor who has drafted the application. While only a registered patent attorney may "carry on business, practise or act as a patent attorney,"<sup>56</sup> and thereby draft patent applications for others, there is nothing that prohibits an inventor from drafting his or her own patent specification. In other cases, the applicant will not own the copyright.

¶30 In the absence of any agreement to the contrary, copyright in commissioned works remains with the author, rather than vesting in the person who commissioned the work, unless the commissioned works are photographs taken for a private or domestic purpose, or paintings or drawings of a portrait or engravings. Where this is the case, the person who commissioned the work is usually assumed to have an implied license to use the work.<sup>57</sup> Therefore, where a patent attorney is engaged to draft a patent application, the attorney or the attorney's firm will own copyright in the specification, in the absence of any agreement to the contrary.

¶31 In cases where an applicant has authored a specification, rights to an invention and copyright in the specification may be separated where the inventor assigns the right to an invention to another and no provision is made for an assignment of copyright in the specification. In the absence of an assignment of that copyright, the copyright will remain with the author. There is nothing to suggest that it is common practice for a patent assignment to be coupled with assignment of copyright in the associated patent specification.

¶32 The Copyright Act also recognizes the possibility of joint authorship, where two or more authors jointly author a work.<sup>58</sup> A patent specification may be a work of joint authorship—one or more persons many have contributed to the authorship and creation of a patent specification and its reduction to material form, and therefore hold copyright jointly. A further complication is that a patent specification might contain works which themselves are separately protected by a copyright that vests in another entity; for example, illustrations or text which describes the background of the invention.

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<sup>55</sup> *Copyright Act 1968* (Cth) section 35(6) provides that, subject to Part VII, copyright in literary, dramatic, musical and artistic works created pursuant to terms of employment under a contract of service or apprenticeship is owned by the employer, subject to any contrary agreement and subject also to certain exceptions set out in sections 35(4) and 35(5). Subsection 35(4) concerns work done by employees of a newspaper, magazine or similar periodical. Subsection 35(5) concerns contracts for portraits, photographs for private or domestic purposes and engravings.

<sup>56</sup> *Patents Act 1990* (Cth) s 201.

<sup>57</sup> *Copyright Act 1968* (Cth) s 35.

<sup>58</sup> *Id.* s 10(1) (defining "work of joint authorship").

## 2. Crown Copyright

¶33 The possibility that ownership of copyright in a patent specification may vest in the Crown arises by virtue of the need to register a patent to obtain monopoly protection, coupled with the need to maintain secrecy by preventing disclosure of the invention prior to filing a patent specification.<sup>59</sup>

¶34 There are three avenues by which ownership of copyright may vest in the Crown: (1) the general ownership provisions, particularly those under which copyright in an employee's work vests in the employer by virtue of the employer-employee relationship (which apply to authors employed by the Crown);<sup>60</sup> (2) the specific Crown ownership provisions in Part VII of the Copyright Act; and (3) any Crown prerogative in the nature of copyright.<sup>61</sup> The focus of this article is the Crown copyright provisions in Part VII of the Copyright Act.

¶35 The Crown copyright provisions vary the general provisions in Parts III and IV that regulate the ownership of copyright, insofar as they relate to the Crown. "Crown copyright" refers to copyright held in right of "the Commonwealth or a State."<sup>62</sup> This is, at the very least, a reference to the exercise of executive power by the Crown in right of the Commonwealth or a State.<sup>63</sup> The provisions in Part VII arguably place the Crown in a more favorable position than others who are not authors or creators, who only become copyright owners under an assignment in writing, or subject to the terms of a contract of employment (implied or otherwise).

¶36 There are two relevant aspects of Crown copyright in original literary, dramatic, musical or artistic works. The first concerns ownership of copyright by the Crown, which is regulated by sections 176 and 177 of the Copyright Act. The second provides the Crown with the right to perform acts comprised in the copyright in a work owned by another, and is regulated by sections 183 and 183A.

¶37 Section 176 provides that the Commonwealth or a State is the owner of copyright in any work, film, or sound recording made by, or under the direction or control of, the

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<sup>59</sup> The need to maintain secrecy stems from the patentability requirement that an invention must be novel in order for a patent to be granted. The requirement for novelty is found in *Patents Act 1990* (Cth) s 18(1)(b)(i). An invention will be novel unless all of its essential features have been made available to the public either in a document or documents published anywhere in the world, or through doing an act or acts which disclose the invention. *Patents Act 1990* (Cth) s 7. For the purpose of deciding whether an invention is novel or involves an inventive step, the person making the decision must disregard any disclosure of the invention made in the circumstances described in section 24.

<sup>60</sup> *Copyright Act 1968* (Cth) s 35(6).

<sup>61</sup> Crown copyright may arise by virtue of the operation of one or more of these avenues. By way of example, in *Director-General of Educ. v Public Serv. Ass'n of New South Wales* (1985) 4 IPR 552, in continuing an interlocutory injunction to restrain copying or communicating the contents of a departmental committee report, Justice McLelland of the Supreme Court of New South Wales stated that the State of New South Wales owned copyright in the report under either subsection 35(6) or section 176 of the *Copyright Act 1968* (Cth).

<sup>62</sup> *Copyright Act 1968* (Cth) s 176.

<sup>63</sup> *Copyright Act 1968* (Cth) s 10(1) relevantly provides: "the Crown includes the Crown in right of a State." Under Chapter II of the Australian Constitution, the executive authority of the Commonwealth is vested in the Crown and is exercisable by the Governor-General on advice from the Federal Executive Council, which comprises Ministers of State selected from either the House of Representative or the Senate. See AUSTRALIAN CONSTITUTION SS 61, 62, 64. For the position with respect to State constitutions, see *Kable v Director of Public Prosecutions* (1996) 189 CLR 51, 138 (Gummow J) (Austl.).

Commonwealth or the State.<sup>64</sup> As to the subsistence of copyright, where apart from section 176(1) copyright would not subsist in an original literary work made by, or under the direction or control of, the Commonwealth or a State, copyright subsists in the work by virtue of the section.<sup>65</sup> Section 178 contains a similar provision in relation to sound recordings and cinematograph films.

¶38 By virtue of section 177, the Commonwealth or a State is also the owner of copyright in any work first published by, or under the direction or control of, the Commonwealth or the State.

¶39 Publication of an original literary, dramatic, musical or artistic work affects both the subsistence and duration of copyright in the work. Subsistence of copyright arising from first publication of the work in Australia is conferred by Part III.<sup>66</sup> Section 29, which is located in Part II of the Act, provides that a literary, dramatic, musical, or artistic work is to be deemed to be published if, but only if, reproductions of the work have been supplied to the public.<sup>67</sup> When determining whether a work has been published or whether a publication of the work was the first publication of the work, any unauthorized publication or act is to be disregarded.<sup>68</sup> Publication is to be taken as unauthorized if, but only if, copyright subsisted in the work and the act concerned was done otherwise than by, or with the license of, the owner of the copyright.<sup>69</sup> Section 179 provides that the operation of sections 176, 177 and 178 may be modified by agreement with the author of the work.

¶40 Sections 183 and 183A concern the use of copyright material for the services of the Crown. These provisions permit the Crown to perform acts comprised in the copyright in a work owned by another without infringing copyright, provided remuneration is paid to the copyright owner. Subject to the provisions of Pt VII, the Copyright Act “binds the Crown.”<sup>70</sup> As a consequence, the Crown can infringe copyright. However, Pt VII, Div 2 provides the Crown an exception (and defense) to infringement provisions which would otherwise apply to its conduct.

¶41 Subsection 183(1) provides that copyright in a literary, dramatic, musical or artistic work is not infringed by the Commonwealth or a State doing any acts comprised in the copyright, if the acts are done for the services of the Commonwealth or State.<sup>71</sup> The Act further provides that if the Commonwealth or a State so acts, it shall inform the copyright owner of the doing of the act, unless it appears that it would be contrary to the

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<sup>64</sup> *Copyright Act 1968* (Cth) s 176(2).

<sup>65</sup> *Copyright Act 1968* (Cth) s 176(2) operates independently of its preceding subsection, such that it exists to ensure that copyright subsists in all material produced under the direction or control of the government irrespective of other requirements in the Copyright Act. It does not read down the operation of sections 176(2) and 178(2) respectively. *Commonwealth of Australia v Oceantalk Australia Pty. Ltd.* (1998) 39 IPR 520, 524 (Burchett J) (Austl.).

<sup>66</sup> *Copyright Act 1968* (Cth) s 32(2).

<sup>67</sup> *Id.* s 29(1)(a).

<sup>68</sup> *Id.* s 29(6).

<sup>69</sup> *Id.* s 29(7).

<sup>70</sup> *Id.* s 7.

<sup>71</sup> According to the Full Court, *Copyright Act 1968* (Cth) s 183(1) has its genesis in the *Gregory Committee Report* (London, 1952). The Gregory Committee considered it anomalous that, whilst the Crown was permitted to use patented inventions and registered designs and was permitted to use copyright material ancillary to such use, there were no corresponding allowances permitting Crown use of any copyright material. See *Copyright Agency Ltd. v State of New South Wales* (2007) 159 FCR 213, 239-240 (Austl.). For exploitation of patented inventions by Crown, see *Patents Act 1990* (Cth) s 163.

public interest to do so.<sup>72</sup> It also provides that the terms for the doing of the act (including the remuneration payable) are to be agreed between the Commonwealth or the State and the copyright owner.<sup>73</sup> Subsections 183(1) and (5) of the Copyright Act provide:

(1) The copyright in a literary, dramatic, musical or artistic work or a published edition of such a work, or in a sound recording, cinematograph film, television broadcast or sound broadcast, is not infringed by the Commonwealth or a State, or by a person authorized in writing by the Commonwealth or a State, doing any acts comprised in the copyright if the acts are done for the services of the Commonwealth or State.

...

(5) Where an act comprised in a copyright has been done under subsection (1), the terms for the doing of the act are such terms as are, whether before or after the act is done, agreed between the Commonwealth or the State and the owner of the copyright or, in default of agreement, as are fixed by the Copyright Tribunal.

¶42 However, any act done pursuant to section 183(1) is deemed under section 183(8) to not constitute publication of a work. Acts done by the Commonwealth or a State for the services of the Commonwealth or State do not affect the duration or ownership of copyright in the work. Thus, section 183(8) preserves the ownership of copyright in works or other subject matter which otherwise would vest in the Commonwealth or a State.

¶43 The expression, “for the services of the Crown” is not defined in the Copyright Act. Notably, the Act does not distinguish between Crown use required by statute or which might be considered essential to the public interest on the one hand, and Crown use in the nature of a commercial use on the other.

¶44 Section 183A, which applies to “government copies” of copyright material, was introduced as a means of streamlining the process by which owners of copyright are to be paid when their materials are copied by governments.<sup>74</sup> It provides that there will be payment of equitable remuneration on the basis of sampling, rather than individual notices to copyright owners, where a declared collecting society is operating.<sup>75</sup> Under section 183A, if a “relevant collecting society” is in operation in relation to a government copy, the interests of the copyright owner are instead afforded protection by section 183A(2), and not sections 183(4) and (5). Section 183A(2) provides that the government must pay the collecting society equitable remuneration for the making of government copies during a particular period using a method: “(a) agreed on by the collecting society and the government; or (b) if there is no agreement—determined by the Tribunal under section 153K.”

<sup>72</sup> *Copyright Act 1968* (Cth) s 183(4).

<sup>73</sup> *Id.* s 183(5). In default of agreement, the Copyright Tribunal fixes the terms for the doing of the act.

<sup>74</sup> *Copyright Act 1968* (Cth) s 183A was introduced in amendments to the statutory license scheme for government use in *Copyright Amendment Act (No 1) 1998* (Cth) sch 4.

<sup>75</sup> The remuneration for government copies is as agreed between government and the relevant collecting society or as determined by the Tribunal. *Copyright Act 1968* (Cth) ss 153K, 183A.

¶45 The Crown also has a prerogative right in the nature of copyright, which is preserved under section 8A of the Act and not affected by other provisions of the Act. The scope of the Crown's prerogative right in the nature of copyright is unclear, but it is generally considered to apply to certain primary legal materials such as statutes. Where any prerogative right or privilege of the Crown in the nature of copyright exists, any infringement of that right or privilege is placed on the same footing as an infringement under the Act.<sup>76</sup>

¶46 Interestingly, the duration of copyright under Part VII remains unaffected by the *Australia – United States Free Trade Agreement*. Copyright of the Commonwealth or a State under Part VII subsists in an unpublished work for so long as the work remains unpublished,<sup>77</sup> and where published, for 50 years after the end of the year of publication.<sup>78</sup>

### 3. CAL v. NSW

¶47 The operation of the Crown copyright provisions was considered in *Copyright Agency Limited v State of New South Wales (CAL v NSW)*,<sup>79</sup> a decision of the Full Court of the Federal Court of Australia that was heard on appeal by the High Court of Australia.<sup>80</sup>

¶48 *CAL v NSW* involved a consideration of the ownership of copyright in survey plans lodged for registration at the Department of Lands in New South Wales and later reproduced and communicated to the public by the department. Survey plans are artistic works under the Copyright Act. Copyright in these works includes the exclusive rights to reproduce the survey plans in a material form and to communicate them to the public.<sup>81</sup> The question to be determined was whether the surveyors who create them, or the Crown, under Crown copyright provisions, own the copyright in registered survey plans. The case also involved the question of what, if any, remuneration is payable by the State for making digital copies of the plans. This case is instructive because there are parallels that can be drawn between the survey plans considered and patent specifications filed with IP Australia when a patent application is lodged. The Appellant, Copyright Agency Limited (CAL), had applied to the Copyright Tribunal to settle upon a method of calculating equitable remuneration payable to it by the State for making digital copies of survey plans under section 183A(2), and to set the terms upon which the State may communicate the survey plans to the public under section 183(5).

¶49 The Full Court of the Federal Court held that surveyors, not the Crown, own copyright in survey plans, and that the Crown copyright provisions do not vest copyright ownership in the Crown.<sup>82</sup> The High Court did not disturb this finding on appeal.<sup>83</sup> In reaching this outcome, the Full Court considered whether the survey plans in question were “work[s] made by, or under the direction or control of, the State” for the purposes of

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<sup>76</sup> *Id.* s 8A.

<sup>77</sup> *Id.* s 180(1)(a).

<sup>78</sup> *Id.* s 180(1)(b).

<sup>79</sup> (2007) 159 FCR 213 (Lindgren, Emmett, and Finkelstein JJ) (Austl.).

<sup>80</sup> (2008) 233 CLR 279 (Gleeson CJ, Gummow, Heydon, Crennan and Kiefel JJ) (Austl.).

<sup>81</sup> *Id.* at 286.

<sup>82</sup> *CAL v NSW* (2007) 159 FCR 213, 243 (Austl.).

<sup>83</sup> *CAL v NSW* (2008) 233 CLR 279, 286 (Austl.).



section 176; whether the survey plans were “first published” by the Crown for the purposes of section 177; and whether the Crown’s dealings with the survey plans were acts done “for the services of the Crown” for the purposes of section 183.

¶50 *a) Works made by or under the direction or control of the state (section 176).*—The Federal Court held that the survey plans in question were not works made under the direction or control of the State. It took the view that section 176 envisages the Crown causing a work to be made, but does not extend to circumstances where the Crown merely specifies that a work is to be made in a particular way or in accordance with particular requirements, without creating any obligation to make the work. The Court was of the opinion that Parliament did not intend that the Crown would assume ownership of copyright as a consequence of a person lodging an application in writing to obtain a statutory or other regulatory approval or license from the Crown.<sup>84</sup> While the Crown, through the relevant legislation, sets requirements for how survey plans are to be organized and what they must contain, it does not provide specific direction as to how each individual plan is to be drafted.<sup>85</sup>

¶51 The court held that, as there was nothing in the relevant statutory and regulatory provisions that compels a surveyor to prepare a survey plan, there was no basis for finding that the works were made by, or under the direction or control of, the State. Instead, the court recognized that surveyors prepare survey plans to satisfy contractual obligations owed to their clients.<sup>86</sup>

¶52 *b) First publication (section 177).*— The Federal Court also held that none of the survey plans in question were first published by or under the direction or control of the State within the meaning of section 177 of the Copyright Act.<sup>87</sup>

¶53 As far as the survey plans are concerned, the State of New South Wales has a legal obligation, once a survey plan is registered and becomes a registered plan, to make copies of the registered plan available to the public.<sup>88</sup> However, the court was of the view that fulfilling this obligation would not necessarily amount to publication, or even first publication, for the purposes of copyright.

¶54 In relation to ownership as a result of first publication of a work under section 177, the court recognized that this involves the Crown determining whether or not the work is to be published. However, while the court considered that this might occur by operation of a regulatory provision that requires publication, the critical question will be when such a work is first published. The court took the view that survey plans are necessarily published prior to lodgement, registration and publication by the State. Thus publication occurs when a surveyor provides a survey plan to the owner of the land to be signed prior to lodgement. This is the act of first publication. As such, any publication by State is not first publication.<sup>89</sup>

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<sup>84</sup> *CAL v NSW* (2007) 159 FCR 213, 237-38 (Austl.).

<sup>85</sup> *Id.* at 238.

<sup>86</sup> *Id.* at 240–41.

<sup>87</sup> *Id.* at 243.

<sup>88</sup> According to the Full Court in *CAL v NSW* (2007) 159 FCR 213, 241 (Austl.), the position at law at the time of judgment was as follows: “Such an obligation is imposed by s 96B(1) of the *Real Property Act* and s 199 of the *Conveyancing Act*. Under s 115 of the *Real Property Act*, the Registrar-General is obliged to provide certified copies of any registered instruments affecting land under the provisions of the *Real Property Act*.”

<sup>89</sup> *CAL v NSW* (2007) 159 FCR 213, 242 (Austl.). The court also noted that, in so far as plans effect

¶55 *c) Acts done ‘for the services of the crown’.*— Section 183(1) of the Copyright Act is a statutory defense to infringement where acts are done for the services of the Crown. However, the Federal Court noted that the Copyright Act in section 183(8) provides that an act performed under section 183(1) does not constitute publication of a work. Thus, if the making available of a work to the public by the State is done under section 183 (for the services of the Crown), it does not constitute publication and therefore cannot be first publication.<sup>90</sup> In this regard, the court also noted that if the act done to make the work available is not performed under section 183(1), and no other license has been granted to the State to make a work available, it would follow that those acts of the State would be an unauthorized publication. Accordingly, under section 29(6) the act must be disregarded in determining whether the work has been published and whether the publication was the first publication of the work.<sup>91</sup>

¶56 The expression “for the services of the Commonwealth or a State” is not one that has been clearly explained by the courts. Despite this, the Full Federal Court in *CAL v NSW* was of the view that all of the acts that the State does in relation to registered survey plans are done for the services of the State within the meaning of section 183(1).<sup>92</sup>

¶57 *d) A license otherwise than under section 183.*— It is clear that a state government is authorized to copy and make registered plans available to the public. In all states, the relevant statutory framework includes a requirement that the Registrar-General (or equivalent) must provide and maintain public records of landholdings, which must be available for inspection, and from which certified copies of registered instruments must be given to the public upon request (ordinarily upon payment of a prescribed fee).<sup>93</sup>

¶58 The Full Court rejected the view that the only source of such authority is section 183(1) of the Copyright Act and that there is no basis for the law to imply any other license or authority for the State to do the acts in question.<sup>94</sup> Instead, it held that the surveyor impliedly authorized the State to do “everything that it was obliged to do” as a consequence of a survey plan having been submitted for registration.<sup>95</sup> The consequence of this finding was that there would be no basis for determining terms upon which the State could copy the above mentioned survey plans and communicate them to the public.

¶59 The High Court of Australia disagreed on this point and overruled. It held that the respondent state government did not have an implied license to do all that it was obliged to do as a consequence of a survey plan being submitted for registration. The Court found that a license will only be implied when it needs to be implied. The High Court held that surveyors who lodge survey plans for registration do not abandon their exclusive rights, particularly since “Pt VII, Div 2 of the Act lays out a comprehensive license scheme for government use of copyright material,”<sup>96</sup> which allows governments

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subdivisions, it is necessary to provide them to the local municipal council for a subdivision certificate, which also constitutes publication that precedes registration and publication by the State. *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 242.

<sup>92</sup> *Id.* at 243.

<sup>93</sup> *CAL v NSW* (2008) 233 CLR 279, 293–94 (Austl.).

<sup>94</sup> *CAL v NSW* (2007) 159 FCR 213, 243 (Austl.).

<sup>95</sup> *Id.*

<sup>96</sup> *CAL v. NSW* (2008) 233 CLR 279, 301 (Austl.).

to use copyright protected material “for the services of the Crown” without infringement.<sup>97</sup>

#### 4. Parallels Between Survey Plans and Patent Specifications

¶60 As noted above, *CAL v NSW* is instructive because there are parallels to be drawn between the survey plans considered in that case and patent specifications filed in Australia. As is the case with survey plans, no inventor is obliged to draft or lodge a patent application. Although the Patents Act requires that patent applications contain certain information,<sup>98</sup> it does not provide direction as to how each individual specification is to be drafted. Those drafting and design choices are left to the patent attorney and patent applicant. The decisions to draft a patent specification and lodge a patent application lie with the applicant.

¶61 The Crown copyright provision in section 176 envisages copyright vesting in the Crown where the Crown causes a work to be made, but does not extend to circumstances where the Crown merely specifies that a work is to be made in a certain way. A patent specification drafted with the intention that it forms the basis of a patent monopoly grant by the Commonwealth is not prepared by reason of any compulsion to the Commonwealth. A government instrumentality that prescribes criteria for the registration of a patent does not direct or control the making of a patent specification filed according to those requirements. Accordingly, it cannot be said that patent specification documents produced by, or on behalf of, a private individual or other entity are works made under the direction or control of the Commonwealth under section 176.

¶62 The issue of first publication is dealt with by the amendment to section 226 of the Patents Act. Subsection 226(3) provides that if a reproduction of an unpublished work is made as a result of a document being open to public inspection, the supply or communication of the reproduction does not constitute the publication of the work for the purposes of the Copyright Act. Were it not for the introduction of subsection 226(3), the position would be more complicated. In *CAL v NSW*, the Federal Court held that the survey plans in question were not first published by, or under the direction or control of the State within the meaning of section 177 of the Copyright Act, because survey plans are necessarily published prior to lodgement, registration, and publication by the State. Publication occurs where a surveyor presents the survey plan to his or her client for signing. Likewise, the provision of the relevant plans to a local municipal council for a subdivision is also considered a publication. Both acts of publication necessarily precede registration and publication by the State. As such, any publication by the State is not first publication.

¶63 The Commonwealth of Australia has a legal obligation under the Patents Act to make patent specifications available to be public by making them open to public inspection.<sup>99</sup> The argument can be made, analogous to *CAL v NSW*,<sup>100</sup> that where a patent

<sup>97</sup> *Id.* at 301, 304–06.

<sup>98</sup> *Patents Act 1990* (Cth) s 40.

<sup>99</sup> Patent specifications are placed on the public record when they are laid “open to public inspection.” In Australia, as in most jurisdictions, a patent application is made open to public inspection 18 months after the priority date by advertisement in the *Official Journal of Patents*. *Patents Act 1990* (Cth) ss 54–55; *Patents Regulations 1991* (Cth) regs 4.2–4.3.

<sup>100</sup> *CAL v NSW* (2007) 159 FCR 213, 242 (Austl.).

attorney drafts a patent specification, this is not a specification's first publication because first publication will have occurred when a patent attorney made the specification available to the client for perusal.

¶164 Alternatively, first publication may occur when the specification is filed with the patent office. There is support for this view in the Full Court's rationale in *CAL v NSW*, where it held that lodgement of survey plans with a local council for the purpose of seeking approval for a proposed subdivision would constitute publication.<sup>101</sup> The effect of this finding appears to be that lodging a document with a government instrumentality would amount to publication, precluding any opportunity for the government instrumentality in question to first publish the document. As a consequence, it appears that where an inventor drafts his or her own patent specification, the Crown copyright provisions do not have the effect of depriving the inventor or an assignee of copyright in the patent specification. Such a result is consistent with the views expressed in *CAL v NSW* that Parliament did not intend the Crown would assume ownership of copyright as a consequence of a person obtaining a statutory or other regulatory approval or license from the Crown.<sup>102</sup>

¶165 Putting aside for a moment the issue of copyright ownership, it can be reasonably argued that a patent office making patent specifications available to the public, either free of charge online or by making hard copies for a fee, constitutes acts done "for the services of the Crown" as envisaged by section 183. As the Federal Court in *CAL v NSW* noted, if an act making a work available to the public is done for the services of the Crown under section 183, it does not constitute publication and therefore cannot be first publication. As this reasoning applies equally to patent specifications, a patent office making patent specifications available to the public cannot constitute first publication, and therefore has no bearing on the ownership or duration of copyright in patent specifications.

¶166 In conclusion, it is the person who drafts a patent specification filed as part of a patent application, and not the Crown, that owns copyright, despite the existence of Crown copyright provisions. Further, it is unlikely that a court would find an implied license from the copyright owner in favor of the Commonwealth enabling it to do everything the Commonwealth is obliged or permitted by statute to do with, or in relation to, patent specifications. Such a license would not be implied by virtue of the applicant or the applicant's attorney lodging a patent application seeking patent registration, or the fact that the legislation expressly requires the patent office to make copies and disseminate the specification.

¶167 Owners of copyright in patent specifications would consequently appear to have a right to negotiate the terms upon which the Commonwealth may do any of the acts comprised in the copyright under section 183(5) and to receive equitable remuneration for any 'government copies' made by virtue of section 183A.

¶168 The situation is similar when patent applications are filed according to the terms of the *Patent Cooperation Treaty 1970* (PCT).<sup>103</sup> The PCT, which is administered by the United Nations World Intellectual Property Organization (WIPO), established an

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<sup>101</sup> *Id.*

<sup>102</sup> *Id.* at 237–38.

<sup>103</sup> Patent Cooperation Treaty 1970, *opened for signature* June 19, 1970, 28 U.S.T. 7645, 9 I.L.M. 978 (entered into force in March 31, 1980).

International Patent Cooperation Union for “cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services.”<sup>104</sup> The PCT is a means of streamlining the process of applying for patents in multiple jurisdictions. The PCT does not provide for the grant of an international patent, as there is no such thing. It instead provides a mechanism by which a single international patent application can be filed, thereby removing the need to file separate applications in each jurisdiction where patent protection is sought. A single application filed under the PCT acts as a national patent application filed in each designated state,<sup>105</sup> and is regarded as a national filing within the meaning of the Paris Convention.<sup>106</sup> The states in which patent protection is sought are designated in the application when it is made.

¶69 PCT applications are filed in a patent office that is designated as a “Receiving Office” (RO) under the PCT.<sup>107</sup> The international filing date is considered to be the filing date in each designated state.<sup>108</sup> After a Receiving Office receives an application, an International Searching Authority (ISA) performs a prior art search with the aim of identifying relevant prior art.<sup>109</sup> This is then optionally followed by a preliminary examination by an International Preliminary Examining Authority (IPEA).<sup>110</sup>

¶70 Unless the applicant requests an earlier publication, the international application, along with the international search report, is published eighteen months after its priority date.<sup>111</sup> This publication takes place prior to the application entering the national phase in each designated state. Once publication has taken place, any third party can request copies of documents in the international file.<sup>112</sup> The public may also search international patent applications online.<sup>113</sup>

¶71 The decision as to whether to grant a patent is the prerogative of each sovereign nation or various regional authorities to which that sovereign power has been designated. As such, the application and any search or preliminary examination results are then forwarded to the relevant national or regional authorities to be examined according to domestic law, in what is known as the “national phase.”<sup>114</sup>

¶72 It would seem that filing an international patent application with a PCT-approved Receiving Office would constitute publication. WIPO publishes patent specifications. As such, it is not the case that where a PCT application is filed, first publication can occur when the Crown in right of the Commonwealth of Australia publishes the specification through the patent office.

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<sup>104</sup> *Id.* at art. 1.

<sup>105</sup> *Id.* at art. 11(3); *Patents Act 1990* (Cth) s 88.

<sup>106</sup> Patent Cooperation Treaty 1970, *supra* note 103, at art. 11(4).

<sup>107</sup> *See id.* at art. 10.

<sup>108</sup> *Id.* at art. 11(3); *Patents Act 1990* (Cth) s 88(4).

<sup>109</sup> Patent Cooperation Treaty 1970, *supra* note 103, at arts. 15–16.

<sup>110</sup> *Id.* at ch. II. IP Australia acts as a receiving office, international searching authority and international preliminary examining authority under the PCT. *International Agreements*, IP AUSTRALIA, <http://www.ipaustralia.gov.au/get-the-right-ip/patents/international-patent/> (last visited August 15, 2013).

<sup>111</sup> *Id.* at art. 21.

<sup>112</sup> *Id.* at art. 30(2)(a)(i).

<sup>113</sup> To search patents online, see WIPO’s online search facility at <http://www.wipo.int/pctdb/en/index.jsp>.

<sup>114</sup> WORLD INTELLECTUAL PROPERTY ORGANIZATION, PCT APPLICANT’S GUIDE—NATIONAL PHASE (2010), available at <http://www.wipo.int/pct/guide/en/gdvol2/pdf/gdvol2.pdf>.

¶73 Thus, even though a patent application is submitted to a public institution (the patent office), which publishes it for the purpose of informing the public of the new technological information it discloses, it nevertheless appears that copyright in a patent specification does not vest in the Crown, but rather remains vested in the copyright owner.

¶74 While the application of first principles would appear to lead to the conclusion that copyright in a patent specification vests in the author of that specification and that copyright continues in existence for as long as the Copyright Act allows, there is contrary judicial authority, albeit obiter, that upon lodging a patent application, a patentee abandons any copyright in that specification. In this connection, Justice Whitford in *Catnic Components Ltd. v Hill & Smith Ltd.*,<sup>115</sup> expressed the following view:

In my view, by applying for a patent and accepting the statutory obligation to describe and if necessary illustrate embodiments of his invention, a patentee necessarily makes an election accepting that, in return for a potential monopoly, upon publication, the material disclosed by him in the specification must be deemed to be open to be used by the public, subject only to such monopoly rights as he may acquire on his application for the patent and during the period for which his monopoly remains in force, whatever be the reason for the determination of the monopoly rights. If this be correct . . . the plaintiffs must be deemed to have abandoned their copyright in drawings the equivalent of the patent drawings.<sup>116</sup>

¶75 It would seem that his Honour's statement was based on the understanding that a patentee owns copyright in a patent specification. However, as that will rarely be the case, this reasoning is unpersuasive. Although Justice Whitford favors freedom to use patent specifications without allowing restrictions to be imposed by copyright, on appeal<sup>117</sup> only Lord Justice Buckley referred to Justice Whitford's statement, and only to say that he did not wish to express any concluded view on the matter.<sup>118</sup>

¶76 Justice Whitford's view was also disapproved of in *Ogden Indus. Pty. Ltd. v Kis (Aust) Pty. Ltd.*<sup>119</sup> There Justice Kearney said, "On this basis I would have concluded that something more than the existence of the patent would be required to deprive a patentee of his concurrent copyright rights."<sup>120</sup>

¶77 The better view is that copyright subsists in patent specifications regardless of the fact that there may be concurrent patent protection, and that copyright vests in the author or authors of the specification. However, given that patent specifications are important capsules of technological information, Parliament has decided that the full suite of rights comprised in the copyright are not to be at the disposal of the copyright owner.

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<sup>115</sup> [1978] FSR 405, 427 (Austl.).

<sup>116</sup> *Id.* at 427. This passage was obiter given the finding that the plaintiffs' drawings had not been copied.

<sup>117</sup> [1979] FSR 619 (Austl.).

<sup>118</sup> *Id.* at 628.

<sup>119</sup> (1982) 2 NSWLR 283 (Austl.).

<sup>120</sup> *Id.* at 300.

*C. The Amendment to Section 226: Dealings with Patent Specifications*

¶78 In its previous form, section 226 provided as follows:

**226 Reproduction of published specifications does not infringe copyright**

The reproduction in 2 dimensions of the whole or part of a provisional or complete specification that is open to public inspection does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work.

¶79 While the object of the section is to facilitate the copying of information a patent applicant is obliged to disclose upon filing a patent application, prior to its amendment section 226 did so in only the narrowest of ways, and did nothing to encourage the sort of dissemination of information that is possible with today's communications technologies. The provision's scope was narrow because it only allowed a person to reproduce a patent specification and did not exempt other acts such as publishing, communicating to the public, or making an adaptation of the work. As drafted, the provision was not well suited to the way information is used, communicated and managed in an age where technology has allowed people to routinely and inexpensively disseminate documents to millions to download, copy, and view.

¶80 Given the important role of patent specifications as a medium for the dissemination of technological information, allowing the full suite of copyright protections to apply to patent specifications is inconsistent with the public's right to make use of the information that is the corollary of the patentee's disclosure obligations. Although a patent specification is protected by copyright, its value lies not in the manner in which it is expressed, but in the knowledge and information it contains above and beyond that which comprises the state of the art. As a patent applicant is required by law to disclose the workings of an invention in a specification, it seems incongruous that the owner of copyright in the specification has the right to impose limitations on the use to which it may be put. It also places unjustified restrictions on the extent to which patent specifications can be the subject of public debate and criticism, particularly in relation to whether the inventions they disclose satisfy the requirements for patentability. The fair dealing defenses found in the Copyright Act (fair dealing for purpose of: research or study, criticism or review, parody or satire, and reporting news) do not compensate for these deficiencies. Further, in cases where the owner of copyright in a patent specification is someone other than the inventor or patentee, the commercial interests of the copyright owner are satisfied when the specification is first published for the benefit of the patent applicant prior to lodgement.

¶81 This deficiency has been remedied by recent amendments to section 226 of the Patents Act. The new section 226 provides more broadly that it is not an infringement of any copyright to reproduce, communicate, or translate a patent specification.<sup>121</sup> Additionally, the amended section provides that laying open for public inspection a

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<sup>121</sup> *Patents Act 1990* (Cth) s 226(1).

previously unpublished work does not constitute a publication of the work for the purposes of the Copyright Act.<sup>122</sup>

Section 226 in its current form, as amended, is as follows:

**226 Documents open to public inspection do not infringe copyright**

(1) If a document mentioned in subsection (2) is open to public inspection, doing any of the following in relation to the whole or part of the document does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work:

(a) reproducing the document in two-dimensional form;

(b) communicating (within the meaning of that Act) the document to the public;

(c) translating (within the meaning of that Act) the document.<sup>123</sup>

(2) The documents are:

(a) a provisional specification; and

(b) a complete specification; and

(c) a prescribed document.<sup>124</sup>

(3) If a reproduction of an unpublished work is made as a result of a document being open to public inspection, the supply or communication of the reproduction does not constitute the publication of the work for the purposes of the *Copyright Act 1968*.<sup>125</sup>

¶82 By making this amendment, those wishing to further disseminate the information a patent applicant is required by law to disclose can do so without fear of copyright infringement or the need to seek a license from the copyright owner. Also, owners of copyright in patent specifications would not have the right to collect royalty payments, nor would collecting societies have the right to collect royalty payments on behalf of copyright owners, who would already have been rewarded, either for creating the specification or through having been granted a patent monopoly. It is possible that without the expanded protection contained in the amended section 226(1), the Commonwealth of Australia would be required to pay royalties to the copyright owners

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<sup>122</sup> *Id.* s 226(3).

<sup>123</sup> There is no definition of “translate” or “translating” in the Patents Act. It is presumed that this term refers to making translations from one language to another.

<sup>124</sup> It is not clear what will constitute a prescribed document. The term is not defined in the Patents Act.

<sup>125</sup> *Patents Act 1990* (Cth) s 226.



of any patent specifications that it communicates to the public via the AUSPAT patent database on IP Australia's web site. However, while the amendment was necessary to bring the patent specification copyright exception into the digital age, the amendment does nothing to alleviate the difficulties of the copyright possessor who seeks to use non-patent prior art for purposes that advance the public interest and benefit the patent and innovation systems.

#### IV. COPYRIGHT IN PRIOR ART DOCUMENTS

##### A. *Prior Art Documents and the State of the Art*

¶83 What the amendment to section 226 does not achieve is a form of protection for anyone who uses a prior art document (other than a patent document laid open to public inspection in Australia) for the purpose of making a third party prior art submission to the Australian Patent Office, either directly or via an intermediary such as Peer-to-Patent Australia. What is needed is an exception equivalent to section 226 for uses of prior art documents. Such an exception would shield from copyright infringement anyone who reproduces, communicates, or translates a prior art document for the purpose of forming an opinion, either individually or collectively with others, as to whether an invention is novel and involves an inventive step.

¶84 The information contained in prior art documents is the standard against which a patent is measured in terms of novelty and inventive step. An invention is novel if it has not been disclosed to the public through prior publication or use.<sup>126</sup> Novelty involves a comparison between the invention claimed and the existing known technology previously disclosed to the public. It requires comparing the invention and the prior art as it existed before the priority date. Where an invention has been disclosed in the publicly available prior art before the priority date of the claim in question, it is anticipated by that prior disclosure, except where disclosure arises in circumstances that impose an obligation of confidence on the recipient of the information.<sup>127</sup> An invention lacks novelty only if all its essential integers have been revealed to a member of the public in circumstances that leave that person free to make use of that information without any obligation of confidence.<sup>128</sup>

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<sup>126</sup> *Patents Act 1990* (Cth) ss 18(1)(b)(i), 18(1A)(b)(i).

<sup>127</sup> The novelty of each claim in a patent application is assessed against the "prior art base" that comprises publicly available "prior art information" as it existed at the priority date of the relevant patent claim. The prior art base includes information that is made publicly available in a document or a related series of documents, or through doing an act or a related series of acts, as well as information contained in a published patent application that has an earlier priority date than the application under examination. Disclosure of an invention in more than one document, or by more than one act, will only be considered together if the relationship between the documents, or the acts, is such that a person skilled in the relevant art would treat them as a single source of information. The test for novelty of standard and innovation patents is the same. See *Patents Act 1990* (Cth) ss 7, 18(1)(b)(i), 18(1A)(b)(i), sch 1 (definitions of "prior art base" and "prior art information").

<sup>128</sup> See, e.g., *Griffin v Isaacs* (1938) 12 ALJ 169 (Austl.); *Fomento Indus. S.A. v Mentmore Mfg. Coy., Ltd.* [1956] R.P.C. 87 (Austl.). The test for determining whether an invention lacks novelty is the reverse infringement test. Infringement of a claim occurs where "each and every one of the essential integers" of that claim have been taken. Thus, the test for novelty is that a piece of prior art will anticipate an invention if that prior art contains all the essential elements of the invention. If an essential feature is not disclosed in the prior art reference, the claim is novel. See *Meyers Taylor Pty. Ltd. v Vicarr Indus. Ltd.* (1977) 137

¶85 In Australia, a standard patent is to be granted only for an invention that involves an “inventive step.”<sup>129</sup> An invention involves an inventive step when compared with the prior art base unless the invention would have been obvious to a person skilled in the relevant art in light of the common general knowledge as it existed in the patent area<sup>130</sup> before the priority date.<sup>131</sup>

¶86 The person who decides at first instance whether a patent is novel and inventive is the patent examiner. A patent examiner’s job is a difficult one. Patent law is a complex and difficult area of the law to understand and apply. A large body of knowledge is needed to understand the prior art and what the common general knowledge of experts in the field is. This information is often difficult to locate and sometimes not knowable. Further, the state of the art is rapidly changing. With such a vast array and volume of new patent applications being filed, it is simply not possible for each and every patent examiner to be an expert in every piece of technology that comes across his or her desk. Similarly, patent examiners cannot feasibly locate every piece of prior art that is relevant to the issue of whether the application in question is novel and non-obvious. According to Adam Jaffe and Josh Lerner, “The patent office has been granting patents on old ideas because it has inadequate examination resources, and also because it is not very good at finding information about the relevant existing technologies, particularly in new, fast-moving technological fields.”<sup>132</sup>

¶87 With the sheer volume of patent applications being filed each year and the volume of potentially relevant prior art information in the world, it is likely that patent examiners will need to rely on input from the wider community to properly assess the novelty and inventiveness of many of the patent applications that come before them. For this reason, the law should facilitate endeavors like the Peer-to-Patent projects which enable people to form an opinion as to whether an invention is novel and inventive in light of the prior art documents they find.

#### B. *Subsistence and Ownership of Copyright in Prior Art Documents*

¶88 Prior art documents are either literary works, or a combination of literary works and one or more artistic works, and are protected by copyright if the requirements for the subsistence of copyright (such as originality and authorship) are satisfied.

¶89 Due to the effect of copyright protection, prior art documents, as useful as they are as a source of knowledge, cannot be freely reproduced, communicated, or translated without first seeking a license from the copyright owner. To perform these acts without consent is arguably a copyright infringement. Prior art documents may also contain other

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CLR 228, 235 (Aiken J) (Austl.) (“The basic test for anticipation or want of novelty is the same as that for infringement and generally one can properly ask oneself whether the alleged anticipation would, if the patent were valid, constitute an infringement.”); *Rodi & Wienberger AG v Henry Showell Ltd.* (1969) RPC 367, 391 (Austl.).

<sup>129</sup> *Patents Act 1990* (Cth) s 18(1)(b)(ii).

<sup>130</sup> The “patent area” under the *Patents Act 1990* (Cth) is the area that lies within the territorial limits of the Commonwealth of Australia. This means Australia, the Australian continental shelf, the waters above the Australian continental shelf, the airspace above Australia, and the Australian continental shelf. *See Patents Act 1990* (Cth) sch 1.

<sup>131</sup> *Patents Act 1990* (Cth) s 7(2). Section 7(2) tests whether an invention is obvious when compared with the “prior art base,” and section 7(3) tests whether information is to be included in the “prior art base.”

<sup>132</sup> JAFFE & LERNER, *supra* note 7.

copyrighted works or portions of copyrighted works, or adaptations of other works, included with or without license. Accordingly, reproducing, communicating, or translating a prior art document might also amount to an infringement of copyright in another work.

¶90 The ownership of copyright in prior art documents is comparatively uncomplicated. Insofar as copyright ownership is concerned, documents that contain information that may form the basis of the prior art information against which a patent application is to be assessed in terms of novelty and inventive step are treated like any other. The owner of copyright in prior art documents will be the author, the author's employer, or any entity to whom copyright has been validly assigned, and may be held jointly by two or more distinct legal entities.

### C. Sections 27 and 28: Notice of Matters Affecting Validity

¶91 The Patents Act presently allows a member of the public to have some input in the patent examination process by allowing a person to forward information to the patents office after a complete specification becomes open to public inspection that suggests that an invention is not patentable because it is not novel or is obvious.

¶92 Section 27(1), entitled, "Notice of matters affecting validity of standard patents", provides as follows:

A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with [the novelty and inventive step requirements in]paragraph 18(1)(b).

Section 28 allows a person to give the Commissioner notice of matters affecting an innovation patent's validity.<sup>133</sup>

¶93 Although neither section expressly permits a person to reproduce a document he or she asserts as having priority over the invention, the sections do provide that the Commissioner must inform the applicant in writing of any matter of which the Commissioner is notified, and must send the applicant a copy of any document accompanying the notice.<sup>134</sup> Further, *Patents Regulations 1991* (Cth) reg 2.7 provides as follows:

Notice of an assertion under subsection 27(1) or 28(1) of the Act must, if the assertion is based on a document, have with it:

(a) a copy of the document; and

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<sup>133</sup> The innovation patent is a second-tier patent designed to meet the needs of small and medium enterprises for inexpensive and easily acquired short-term patent protection for modest technological advances or incremental inventions. The maximum term of an innovation patent is eight years. For an overview of the merits of second tier patents, see Mark D. Janis, *Second Tier Patent Protection*, 40 HARV. INT'L L.J. 151 (1999).

<sup>134</sup> *Patents Act 1990* (Cth) s 27(2).

- (b) if the document is not in English, a copy of:
  - (i) a translation of the document into English; and
  - (ii) a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

¶94 It is plausible the enactment of sections 27 and 28 created an exception to copyright infringement in favor of any person who does an act with a view to providing a notice in accordance with the provisions. However, the sections do not expressly state that this is so, and there is no case law that confirms this interpretation. Regardless, it is doubtful whether the provisions permit a copy of a copyright-protected prior art document to be uploaded to a publicly available website. Likewise, whether the sections permit a person to reproduce a document for the purpose of sending the document to an intermediary, such as Peer-to-Patent Australia, is unclear.

¶95 As far as defenses to copyright infringement are concerned, it would not appear that any of the fair dealing provisions,<sup>135</sup> or any other provisions in Pt III, Div 3 of the Copyright Act,<sup>136</sup> are sufficient to permit this form of public use. Likewise, it would not appear that there is an implied license to engage in what would otherwise be infringing conduct, nor is otherwise infringing use of patent specifications to advance the common good a tolerated use that could be recommended or form the basis of an implied license.

## V. VESTING LEGITIMATE RIGHTS IN THE PUBLIC

### A. *Restrictions of the Use of Patent Specifications and Prior Art Documents*

¶96 Prior to the amendment of section 226, there were serious limitations on the uses which members of the public could make of patent specifications. Patent specifications could not be freely communicated to the public without first seeking the permission of a copyright owner. This was a serious impediment to the uses the public ought to be able to lawfully make of patent specifications—in the sense that it was an impediment to information dissemination and knowledge transfer, and as a consequence, innovation, all of which are arguably the objectives of patent law.

¶97 Similarly, prior art documents are treated by copyright like any another literary or artistic work. That being the case, there are barriers imposed by copyright law that restrict the uses of those documents. Those barriers limit the legitimate uses members of the public may make of those documents, even if those uses are non-commercial uses for the public benefit. Where copyrighted prior art documents are concerned, it may be difficult to identify or locate the copyright owner. It may be equally difficult to obtain

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<sup>135</sup> *Copyright Act 1968* (Cth) ss 40–43. These defenses are fair dealing for purpose of: research or study (section 40); criticism or review (section 41); reporting news (section 42); professional advice given by a legal practitioner or patent attorney (section 43(2)); and parody and satire (section 41A).

<sup>136</sup> *Copyright Act 1968* (Cth) ss 43–44F. These provisions include exceptions for things such as reproduction for the purpose of a judicial proceeding or giving legal advice (section 43), temporary reproductions made in the course of a making or receiving a communication (section 43A), and importing various articles (sections 44A–44F).

permission to copy, broadcast, transmit, or otherwise make use of the copyright material, especially where there is little incentive for the copyright holder to give such permission.

### *B. Access to Knowledge, Information and Other Public Goods*

¶98 In the absence of a movement by which copyright owners in patent specifications voluntarily license their works to the public, say under Creative Commons licenses,<sup>137</sup> there is little in the existing law to permit the use of patent specifications and prior art documents for the public good in the ways described in this Article. Given the restrictions that exist, there are good reasons why impediments to citizens weighing in on government decision-making processes or disseminating knowledge, information and other public goods imposed by copyright should be eliminated. The public interest is served when the public is able to freely access, use, reuse, communicate, reproduce, discuss, critique, and publish information that has been disclosed in a patent specification, as well as information in prior art documents that is ostensibly relevant to the assessment of an invention's novelty and inventiveness. Likewise, the public interest is served when individuals are permitted by law, without fear of infringing copyright, to create, collate, describe, publish, and communicate summaries or "landscapes" of patent data that demonstrate the state of the art in a particular field of technology. As such, these uses should be non-infringing.

¶99 Satisfying the public interest in this way ought not be a burden on the public purse or allow copyright owners to impose costs on those who use patent documents in these ways. Accordingly, there is a strong public interest in ensuring that patent specifications are freely accessible to the public once they have been laid open to public inspection. This is wholly consistent with the *quid pro quo* of the patent bargain, whereby in exchange for the monopoly rights granted by the State, the patentee is required to disclose the workings of the invention and the best method of operating the invention known to him or her. It is also consistent with the rights of someone who authors a patent specification. The author's efforts are ordinarily compensated when the specification is published to the person who requested it be drafted (usually the inventor or another person who has a right to the invention).

¶100 There is also a strong public interest in ensuring that the public has a liberal freedom to make use of prior art documents, which include both patent and non-patent literature, to disseminate information describing the state of the art. This is particularly important when members of the public volunteer to assist patent offices determine whether an alleged invention is truly novel and inventive when compared with the prior art.

### *C. Protecting the Legitimate Interests of Copyright Owners*

¶101 Copyright in patent specifications protects the form of expression of the person who authors a patent specification (ordinarily an inventor or a patent attorney). The

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<sup>137</sup> For information regarding Creative Commons generally, see the Creative Commons website at <http://creativecommons.org/>. See also LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* 15–30, 282–86 (2004); DAVID BOLLIER, *THE VIRAL SPIRAL* 1–22 (2008); *Cultivating the Public Domain*, CREATIVE COMMONS, [http://wiki.creativecommons.org/Cultivating\\_the\\_Public\\_Domain](http://wiki.creativecommons.org/Cultivating_the_Public_Domain) (last modified June 8, 2013).

default position assumes that copyright owners are in the best position to decide the uses to which their works may be put, who may exercise those rights, and under what conditions they may exercise them. It also provides patent holders with a shield to hide their patents from additional scrutiny to which the patent office puts them during examination. However, the true value in a patent specification lies not in any literary or artistic quality it possesses, but in the information it contains and its potential to inform the public of the workings of new technologies.

¶102 The argument for treating patent specifications in the same way as other literary and artistic works by allowing the copyright owner the right to exclude others from a wide range of uses is that the rewards copyright offers serve as an incentive to encourage authors and creators to draft new patent specifications. However, the incentive to draft patent specifications ordinarily comes from the fee a client is willing to pay for the service of producing such a document. The author's rights are satisfied when the specification is presented to the person who requested it. In turn, the incentive to have a patent specification produced that drives the inventor is the same incentive to invent and lies in the potential rewards of the patent monopoly.

¶103 It can hardly be claimed that any unauthorized use of a patent specification after it has been published by the patent office is an interference in the market that would adversely affect the legitimate interests of the copyright owner. In this regard, any demand for a patent specification after it is lodged with the patent office as part of a patent application is a demand for the information it possesses, rather than any literary quality in the form in which it is expressed. In cases where the owner of copyright in a patent specification is someone other than the inventor or patentee (e.g. a patent attorney), it can legitimately be said that the market for the specification is exhausted when the specification is first published to a client prior to lodgement at the patent office. Arguments in favor of a secondary market for patent specifications after publication are an impediment to information dissemination and knowledge transfer, and, as a consequence, innovation.

¶104 What is still needed is protection for those who use a prior art documents for the purpose of making a third party prior art submission to the patent office, either directly or via an intermediary such as Peer-to-Patent. This protection would shield from copyright infringement anyone who reproduces, communicates, or translates a prior art document for the purpose of a person forming an opinion, either individually or collectively with others, as to whether an invention is novel and involves an inventive step.

¶105 This would create an insignificant interference with the market for copyright-protected goods because only a small number of prior art documents would ever need to be submitted and patent offices do not use prior art submissions for their own commercial gain.

¶106 Allowing non-remunerated reproductions and communications of these kinds is in the public interest and outweighs any private detriment that might be suffered by the owners of copyright in patent specifications and prior art documents.

## VI. CONCLUSION

¶107 There are certain uses of patent specifications and prior art documents that people other than the copyright owners should be permitted to make as a matter of right. Such uses are necessary and essential to the proper functioning of the patent system. The

argument arises because copyright subsists in patent specifications and prior art documents and that copyright prevents people other than the copyright owner making unrestricted use of those documents. For these reasons, the amendments to section 226 of the Patents Act that allow for the communication to the public and translation of patent specifications are vital.

¶108 However, the amendments are only a step in the right direction. The same privileges should be extended to those who would legitimately reproduce, communicate, or translate prior art documents for the purpose of improving the patent system one patent at a time. What is still needed is an exception to copyright infringement in favor of anyone who reproduces, communicates, or translates a prior art document for the purpose of a person forming an opinion, either individually or collectively with others, as to whether an invention is novel and involves an inventive step. Such an amendment is in the public interest because the public will benefit from an improved patent system resulting from greater scrutiny of patent applications and greater awareness of where patent rights lie.

