

Random case notes

Lancôme Parfums et Beauté et cie SNC v Kefoca BV (HR), 16 June 2006, LJN AU8940

In 1993, the small Dutch company Kefoca launched its perfume "Female Treasure".

Shortly thereafter, rival Lancôme (of the world-renowned "Trésor") commenced proceedings to have "Female Treasure" withdrawn from the market, initially on the basis of mark infringement, then, when this was unsuccessful, for breach of copyright.

On 18 April 2002, the Dutch Rechtbank held that a perfume was capable of being protected by copyright if: (a) the perfume met the criterion of "work", namely that it is subject to human perception and has an original character carrying the personal stamp of the maker; and (b) the competing perfume was an infringing copy.

On 8 June 2004, the Dutch Court of Appeal held that the unique combination of 26 olfactory ingredients making up the "Trésor" scent were both original and personal to Lancôme, and that Kefoca, by using 24 of the same 26 ingredients, had produced an infringing copy.

The Court further determined that, while scent itself was "too fleeting and variable" to be copyrightable, the material which gives off the scent is "sufficiently concrete and stable to be considered a 'work'" under Dutch copyright law.

Kefoca appealed and, in a landmark decision on 16 June 2006, the Dutch High Court not only upheld the decision of the appellate court, but suggested that scent itself is capable of being protected by copyright, as the composition of the perfume and resulting scent together are concrete, stable and "measurable by the senses".

This decision is particularly important because the law and language interpreted are not necessarily jurisdictionally unique. The *Copyright Act 1968* (Cth), for example, also provides for copyright protection for "work", which includes "work of artistic craftsmanship" capable of reduction to material form.

Lyndal Turner, Frenkel Partners

Burge v Swarbrick [2007] HCA 17 (26 April 2007)

"Beauty is at once the ultimate principle and the highest aim of art," mused Goethe.

The High Court of Australia, sitting with six men who have witnessed the evolution of art to the point where exhibitions include Tracey Emin's "My Bed" and the penis-nosed, vagina-mouthed child mannequins of the Chapman Brothers, has formed an understandably different view.

The modern opinion of what constitutes art is enunciated in the decision of *Burge v Swarbrick*, in which the High Court found that the ultimate principle in defining art is not beauty, but the extent to which a work is "unconstrained by functional considerations".

The case involved an application to set aside a Federal Court

finding of copyright infringement resulting from, firstly, the reproduction of a hand-crafted scale model of the hull and deck sections of a yacht (the plug); and, second, the manufacturing of moulds using specific yacht hull and deck mouldings designed by the respondent.

The respondent had failed to register any designs in accordance with the *Designs Act 1906* (Cth) and was therefore relying on intellectual property protection under the *Copyright Act 1968* (Cth) (the Act).

To qualify for such protection under the Act, the respondent was required to show that the plug and the hull and deck mouldings were "works of artistic craftsmanship".

It is important to note that the High Court's definition of art (or "works of artistic craftsmanship") is applicable only to items that fall outside the traditional mediums. In legislation that could have been drafted by Stuckists, paintings, sculptures, drawings, engravings, photographs, buildings and models of buildings are, by default, defined as artistic works in the Act, irrespective of their quality.

With the modern divergence from traditional artistic practices, it would therefore appear that the ultimate word in the term "contemporary art" may now have to be considered with reference to the High Court's decision.

In determining whether the items in question were works of artistic craftsmanship, the High Court pointed out that there would be questions of fact and degree when applying the term.

More helpfully, however, the Court dismissed any notion of beauty or aesthetic appeal being paramount in determining whether a work is a work of artistic craftsmanship.

The Court also appreciated the diminution of the historical divide between art and utilitarian concerns, and found that utility, or lack thereof, of a piece of work provided little guidance as to whether the provision in the Act would afford protection.

Rather, the degree to which the scope for artistic effort in producing a work is constrained by functional considerations will form the conclusion as to whether there exists a work of artistic craftsmanship. In applying this test to the case in question, the Court found that although matters of visual and aesthetic appeal were part of the range of considerations taken into account in designing the model and the hull and deck mouldings, these considerations were subordinated to the functional aspects required to produce and market a sports boat for commercial purposes.

What may be worrying for those engaged in what would otherwise be considered (not least by themselves) as artistic endeavours is the fact that, in determining whether a work of artistic craftsmanship has been created, little weight is given to the opinion of the author of the work.

Given that an artist is one who creates art, and yet it is now the courts that decide whether a work is in fact art, the nation's many unemployed artists may now find themselves referred to as merely "unemployed".

Perhaps it says as much about the unstoppable reach

of the legal fraternity as it does about the lack of appreciation of academics in Australia, that defining art has fallen into the hands of judges, as opposed to the traditional custodians – philosophers and art historians.

Edward Consett, PricewaterhouseCoopers

Amar Nath Sehgal vs Union of India [2005 (30) PTC 253]

In this landmark decision, the Delhi High Court upheld an artist's moral rights in his work against the government of India.

In 1959, Amar Nath Sehgal was commissioned to create a mosaic sculpture to adorn the walls around a central arch of the Vigyan Bhawan, a venue for important government functions in Delhi.

The mural measured 40 feet by 140 feet; it received international acclaim and was an icon in the cultural life of Delhi.

In 1992, the Vigyan Bhawan was renovated and the mural was ripped off the walls and placed in storage.

Upset by this, the world famous Mr Sehgal brought an action against the government for violation of his moral rights. Mr Sehgal's claim was based on an "author's special rights" under s57 of the Indian Copyright Act 1957, which protects an author's right, independent of any assignment of copyright, to claim authorship of the work and the right to restrain, or claim damages in relation to, any distortion, mutilation or modification of the work which would be prejudicial to the artist's honour or reputation.

Mr Sehgal claimed: ripping the mural apart was mutilation; reducing the mural to junk (by putting the pieces of the mural in storage) was prejudicial to his honour and reputation; and the obliteration of his name on the work violated his rights to claim authorship.

The government claimed that Mr Sehgal had assigned his copyright to it by an agreement dated 31 October 1960 and that the government had purchased all rights from Mr Sehgal. The government claimed that as a result it was free to do what it pleased with the mural.

The Court rejected the government's arguments and held that the author had a right to protect his creation. The court found that "[a]ll rights in the mural shall henceforth vest with Mr Sehgal" and ordered the government to return the pieces of the mural.

In addition, the Court ordered the government to pay Mr Sehgal R.500,000 (\$US12,000) to compensate for the loss of honour and reputation.

This case should strengthen an Indian artist's right to claim "special rights" in his/her work, and will hopefully assist in the recognition of moral rights in other jurisdictions.

P. Anand and K. S. Dhakad, "India: Key milestones for intellectual property", Anand and Anand Advocates, 2007.

P. Anand, "The Emerging Frontiers of Intellectual Property Law in India", *Asian Legal Business*, Issue 6.3, 2007.

Indian Copyright Act 1957.

B. Kalra, "Copyright in the Courts: How Moral Rights Won the Battle of the Mural", *World Intellectual Property Organization*, Volume 2, 2007.

Fiona Batten, Baker & McKenzie

Australian Competition and Consumer Commission v Advanced Medical Institute Pty Ltd (No.3) (2007) ATPR (Digest), at 46-269

Celebrities beware, or else your impo(r)tence will be broadcast far and wide. This case involved proceedings that were commenced against Advanced Medical Institute Pty Ltd (AMI), Phillip Somerset and Ian Bruce Turpie.

Mr Turpie has made a career in the Australian entertainment industry over the past 50 years.

The ACCC alleged misleading and deceptive conduct in contravention of s52 of the *Trade Practices Act 1974* (Cth). AMI, among other things, provides treatment for premature ejaculation in men.

In this regard, AMI published advertisements in newspapers relating to their patented Nasal Delivery System.

The advertisement suggested that Mr Turpie had endorsed the product. The purported endorsement arose from the fact that the advertisement suggested that Mr Turpie had given an interview to AMI.

That interview was then quoted in the advertisement published by AMI.

The ACCC argued that the advertisements were misleading and deceptive in that Mr Turpie had never used the Nasal Delivery System and the interview alleged to have taken place between AMI and Mr Turpie and reported in the advertisement in fact never occurred.

In order to avoid any potential liability remaining solely with AMI, AMI brought a cross-claim against Mr Turpie for a declaration that it was in fact Mr Turpie who had engaged in the misleading and deceptive conduct.

The basis for making the cross-claim was that AMI alleged that Mr Turpie had represented to AMI that he had used the Nasal Delivery System, and that the Nasal Delivery System had the desired effect of alleviating his condition.

AMI went further and alleged that Mrs Turpie had attended the alleged interview and had endorsed the representation that Mr Turpie had used the Nasal Delivery System and that as a result of such use his condition had been successfully overcome.

On behalf of AMI, Mr Somerset, who was responsible for preparing and publishing the advertisements, admitted that the advertisements contained the representations as claimed by the ACCC but that, as a result of Mr Turpie's conduct, the AMI representation did not amount to misleading or deceptive conduct.

AMI were unsuccessful in their cross-claim and the Court held that the representations contained in the advertisement contravened s52.

Of significance is the Court's decision in relation to AMI's attempt to rely on the representations made by Mr Turpie.

An advertiser should exercise caution when relying on statements made by individuals who will form the subject of the advertisement.

In particular, advertisers should pay attention to the truth of the comments made by the individual concerned.

Claude Harran, Dibbs Abbott Stillman ■

from page 5

Mitch leans back and grins. "They said, 'No worries. Just come and join us when you're done'." Mitch is a diehard Aussie Rock fan who recalls singing into the clothesline handle as a young kid in the backyard, as his mother pegged out the washing.

Mitch explains that The Choir helped with his recovery, enabling him to make friends and reinvigorate his love of music. "I've always dreamt that one day I'd sing with Jimmy Barnes, and now it's happening." Jimmy Barnes is the patron of The Choir and has recorded some songs with them on the new album.

Jane, a bright and well-spoken woman, says that The Choir has given her back her self-esteem and confidence.

"For me, it's been very rewarding because I went through a stage where I became very reclusive due to things that had happened in my life, to the point where I wouldn't even answer the phone, let alone go out the door. [Since joining The Choir] I came to the conclusion that no matter what happened, no one can take away my morals and intelligence."

Jane recalls the beginning – when she first began singing at The Choir. She thought, "This is ridiculous. I sound stupid! It sounds bloody awful." Now, with the after-effects of the adrenaline from rehearsing with The Choir, Jane confesses, "You'll sing on the train all the way home".

The pizza has dried up and lunch winds to a close. Members begin trickling back into the studios, and Esther invites me to watch from the mixing booth.

From my new position, behind the wide glass plates, I can see the bassists assembling.

They stand attentively, watching Jonathan, waiting for a cue. Their chanting begins. The lights on the soundboard quiver up and down, like little worms, dancing to the sound.

Outside, thunder threatens a storm. But inside, behind the glass, Jonathan carries The Choir to the final line of *Amazing Grace*: "I once was lost, but now I'm found, was blind but now I see."

He shakes his head in disbelief: "You sound like angels." ■

from page 7

Despite continuing opposition to graffiti, especially to tagging, its popularity is likely to rise with the growth of hip-hop and the media that promotes it.

If the Victorian government is serious about reducing graffiti, it will need to resist the seductive powers of superficial punitive responses, and adopt a more sophisticated conceptual and empirical framework for the study of cultural criminology in graffiti.

Only then can an effective response be delivered. As Eric Schneider wrote, "The representations of the urban poor . . . are a forceful reminder of the existence of a large number of young people who are only partially incorporated into the legitimate labour market.

The most pressing issue for policy makers is the inability of the latte economy to create promising jobs for people with limited skills . . . While scholars read the signs, like urban tea leaves, for a glimpse into the future, the city can only scrub the walls."

Conclusion

Over thirty-five years since John Lindsay's reign as mayor of New York ended, it is still transport companies who

have the most at stake in the anti-graffiti crusade. While the Bill seeks to up the ante against graffitiists, it fails to address the main causes of graffiti-marking behaviour, threatens to damage current programs that aim to engage graffitiists rather than criminalise them, and represents a disproportionate response to the graffiti problem. The Victorian government can do better. ■

Endnotes

1. Artoday, Edward Lucie-Smith, 1995, p308.
2. Eric Schneider, "And whose streets are they anyway? Signs from the underground", (2006) 33 *Journal of Urban History* 1, 120-129.
3. Schneider, note 2 above, at 121.
4. Schneider, note 2 above, at 129.
5. See the Bill, Part 2.
6. See the Bill discussion paper, p11.
7. See submission of the Federation of Community Legal Centres, p4.
8. See submission of the Fitzroy Legal Service, p2.
9. See note 7 above, at 11.
10. See note 7 above, at 10.
11. See note 8 above, at 4.
12. See media release from the Minister for Police and Emergency Services, 4 January 2007.

from page 16

The plaintiff alleged that Craig Ruddy's winning painting of actor David Gulpilil was not, in fact, a "painting" but a "drawing" because Ruddy's principal medium was charcoal (curiously, there was no mention of postmodernism and semiotics, but I digress).

Hamilton J likewise held that the word "painting" did not have a technical meaning and so, in a painstaking process (of interest only to the most avowed and tragic etymologist) set forth numerous dictionary definitions. As a matter of objective fact, Ruddy's portrait could not be excluded from a "painting" and so the action failed.

In both the *Dobell* and *Ruddy* cases, the court ultimately deferred to the discretion of the AGNSW Trustees.

In closing, Hamilton J commented that "there is a certain appearance of strangeness in courts making determinations concerning the qualities of art. That matter is better left to those involved in the art world". An improbable circus indeed. ■

Endnotes

1. Edmund Capon in Ross, *Let's Face It*, 1999.
2. Robert Nelson, "The Art of Australian Mockery", *The Age*, 10 June 2006.
3. Justice Michael Kirby, "Hanging Judges and the Archibald Prize" (2006) 11 *Media and Arts Law Review* 308.
4. *Meskenas v Capon* (1993) DC(NSW).
5. *Bloomfield v Art Gallery of NSW Trust* [1983] NSWSC.
6. *Attorney-General v Trustees of National Art Gallery of NSW* (1944) 62 WN (NSW) 212.
7. *Johansen v Art Gallery of NSW Trust* [2006] NSWSC 577.
8. Robert Menzies in *Modernism and Australia*, 2006.