

Proof of Copying

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Introduction

Hero Sportswear was a well-known New Zealand women's fashion designer and manufacturer. One of its very successful garments was a woman's fashion parka. The parka had been a very successful seller in the New Zealand market for about ten years and had also been sold in Australia.

The garment had two highly unusual features:

- The first was an indented placket.
- The second was a pocket on the outside back of the garment.

It is unusual to put a pocket on the very back of a jacket because it is hard to reach.

The lining of the garment was a distinctive mattress ticking style in blue and white with the word HERO written inside the stripes.

Hero was very surprised to discover one day that one of its competitors, Underground Fashions, had launched a woman's parka at a much reduced price. Hero was also surprised to discover that Underground's garment (which was sold under the brand GET USED) had:

- The same indented placket.
- A pocket on the outside back of the garment.

In addition, the lining of the garment was in a mattress ticking style with the words GET USED on the lining. The swing ticket label produced by Underground had almost identical wording to that on the HERO swing ticket.

But Hero also had a feeling that the GET USED label on the Underground product had a familiar ring. Inquiries confirmed that, yes indeed, there was a US company which had initiated the GET USED label. Further inquiries showed that Underground had no connection with the US company and that a second GET USED swing ticket on Underground's parka had the identical graphics to the original US GET USED swing tickets.

I propose to use this case as a convenient example for discussing several aspects of the requirement in cases of primary infringement to show copying by the defendant. The issues raised are, of course, much broader than the fashion industry and apply to all cases where the infringing act is reproducing or copying a work. Some of the difficult issues arise equally in respect of musical works.

The Requirements to Show Copying or a Causal Connection: A Copyright Printer

In order for there to be infringement by copying there must be some causal connection between the copyright work and the infringing work. The copyright work must be the source from which the infringing work is derived. The flip side of this proposition is that if the work was created independently or was derived from an independent source, there can be no infringement - no matter how closely the alleged infringement resembles the original.

Direct evidence of copying a work is rare. As one New Zealand judge has observed "people who are copying drawings do not normally do so in public": *PDL Plastics Limited v Labplas*. See also *Sifam Electrical Instrument Co v Sangamo Weston Limited*. So proof of copying is almost done by demonstrating:

- (a) That the defendant had access to the plaintiff's copyright works or reproductions of it; and
- (b) That there are substantial similarities between the copyright work and the alleged infringement.

In such circumstances an evidential onus of proof falls on to the defendant to explain how these similarities came about: King Feature Syndicate v Kleeman ; LB (Plastics) Limited v Swish Products Limited.

This paper looks at issues in proving copying and in particular:

1. Fingerprints.
2. Similar fact evidence.
3. Subconscious copying.

(1) Fingerprints: Copying of “Inessentials” often the most cogent evidence

Similarities between a copyright work and the alleged infringement can be significant. But it is always critical to consider such similarities in conjunction with the originality and provenance of the copyright work. Obviously if the copyright work is not particularly original or is drawn from stock or commonplace designs which have been around for years, then similarities may be of little significance. But if the copyright work is highly original, then similarities in the alleged infringement will be highly significant. In the Hero Sportswear example, the features of indented placket and the outward facing pocket on the back of the garment in combination had considerable originality. Add to this the same swing ticket wording and the very similar lining and there were clear fingerprints.

One New Zealand judge has referred to the cumulative effect of similarities as the “multiplication of coincidences”.

The copying of mistakes or errors in the copyright work are the most cogent form of fingerprint. In the New Zealand case, AHI v New Lynn Metalcraft the defendant had copied a mistake in the design of a filing cabinet. In Billhöfer Maschinenfabrik GmbH v Dixon Hofman J noted that:

“It is the resemblance in inessentials, the small redundant even mistaken elements of the copyright work which carry the greatest weight. This is because they are least likely to have been the result of independent design.”

Sometimes copyright owners build in deliberate mistakes to a design. In the field of compilations such as trade directories, publishers will often “seed” the directory with fictitious names which are in fact care of the publisher’s address. When a competitor canvasses for its own directory by circulating requests using the plaintiff’s directory, there is proof of copying.

(2) Similar fact evidence

My Hero Sportswear example squarely raised the issue of similar fact evidence. One of the swing tickets on the defendant’s products looked to have been copied from the copyright label of an unrelated party in the US. The aim in bringing such evidence as part of an infringement claim is obviously to bolster the plaintiff’s case that there has been copying. In particular, its purpose can be to counter defences such as that similarities are coincidental or the result of quite independent creativity on the part of the defendant.

The criminal law has always approached similar fact evidence with caution - particularly to guard against the risk of prejudice to the accused. The risk is that if the jury were to learn of the accused’s bad character as a result of other unsavory instances or prior convictions, then the unfair inference may be made that the accused was capable of and did commit the crime alleged. Concerns over this sort of prejudice have led the criminal courts to specify rules for the admissibility of similar fact evidence including:

- The need to show a striking similarity or underlying unity between the similar fact and the alleged criminal offence or elements of the offence - something which tends to defy coincidence.
- The need to ensure that the probative value of the similar fact evidence outweighs its prejudicial effect.

In the civil context the concern to avoid prejudicial effect is not nearly so severe, particularly in copyright, given that such litigation does not involve a jury but is decided by a judge alone. In one New Zealand case, *Cunneen v Bate*, McGechan J queried the need in a civil case to adopt the more cautious approach of the criminal law.

One of the earliest copyright cases involving similar fact evidence was the UK case *Mood Music v De Wolfe Limited*. The case concerned infringement of copyright in a musical work *Sogno Nostalgico*. The defendant denied copying and alleged that any similarity was purely coincidental. The plaintiff sought to rebut the claim of coincidence by producing evidence of three other recordings by the defendants which closely resembled copyright works of other parties. The similar fact evidence was admitted and this was upheld on appeal. Lord Denning MR said:

"In civil cases the courts have followed a similar line but have not been so chary of admitting it. In civil cases the court will admit evidence of similar facts if it is logically probative, that is, if it is logically relevant in determining the matter which is in issue: provided that it is not oppressive or unfair to the other side: and also that the other side has fair notice of it and is able to deal with it."

The matter in issue in this present case is whether the resemblance which Girl in the Dark bears to Sogno Nostalgico are mere coincidences or are due to copying. Upon that issue, it is very relevant to know that there are these other cases of musical works which are undoubtedly the subject of copyright, but that the defendants have nevertheless produced musical works bearing close resemblance to them. Whereas it might be due to mere coincidence in one case, it is very unlikely that there would be coincidences in four cases. It is rather like R v Sims [1946] KB 531, 540 where it was said 'the probative force of all the acts together is much greater than one alone'. So the probative force of four resemblances together is much better than one alone."

In the New Zealand case, *PDL Packaging v Labplas*, Hillyer J accepted that in proper cases evidence of copying of other products by a defendant may be logically probative of the fact that the defendant has copied in the instant case. The similar fact evidence in that case was held not to be probative. The court found nothing in the evidence of other alleged copyings to induce it to believe that the defendants had copied the rim of the plaintiff's bottle in the case in issue.

In *Perrin v Drinnan* the plaintiff alleged infringement of copyright in an angler's rod rest. The defendant claimed copying and alleged independent design. It also claimed that prototypes of its design were used in public and its design drawings were made at a time when it could not have had any knowledge of the plaintiff's design. The plaintiff then sought to amend his pleadings to allege that the defendants "made a practice of copying the products of others in infringement of the rights of others" and alleged six separate allegations that the defendant copied fishing tackle. The court granted the plaintiff leave to amend the pleadings on the basis that the facts, if proved, would be relevant.

The plaintiff's case was that the similarities of the two designs could not be coincidental and that the defendant's evidence of previous design must be false. The similar fact evidence was relevant to throw light on the claim of coincidence - the more the cases of copying, the less likely it was that there had been coincidence.

"One case of similarity of design may be coincidental but two or more become less likely and therefore the evidence is relevant to assess whether the defendant's denial of copying is correct."

A very legitimate concern in the civil context is that similar fact evidence may lead to collateral and tangential issues and therefore involve greater costs and a longer trial.

In *Perrin v Drinnan* the defendants complained that the allegations would require them to investigate, give discovery of and prepare witness statements of alleged copying going back eight years. Aldous J was not deterred. There was no evidence of specific prejudice such as witnesses having died or documents being destroyed. To prevent the plaintiff from providing the evidence could cause injustice.

A recent English decision involving copyright in the design of fabrics show the extent to which similar fact evidence can raise collateral issues. In *Designers Guild Limited v Russell Williams (Textiles) Limited* the court declined leave to cross-examine the defendant's witnesses in relation to the non-infringing copying of two other designs. It was held oppressive to seek to turn a case about infringement

of copyright in one design into a case concerning copying of two other designs - especially if these were not contended to amount to actual infringement. The probative value was reduced and perhaps even eliminated if the allegedly similar act was disclaimed to be an act of infringement. However, the court did allow cross-examination in relation to allegations of copyright infringement by a third party wallpaper and fabric designer which had been settled out of court involving the defendants making a small payment and providing undertakings not to use the design again. This was held to be irrelevant in deciding the issue whether any similarity in the instant case was coincidental or as a result of deliberate copying.

It is instructive to read the substantive decision. The trial judge held that if it were necessary to rely on the similar fact material, he would have no hesitation in deciding that the conduct in that episode would provide very strong support for conclusion that the defendants were engaged in a similar exercise in relation to the copyright work in the instant case.

(3) Unconscious or subconscious copying

The final issue which requires exploring is the issue of subconscious or unconscious copying.

The psychiatrist C G Jung in his book *Man and His Symbols* outlines that the brain never forgets an impression, no matter how slight. The mind has an ability to recall old impressions particularly during a creative process and what is perceived as a "new" creation can in fact be past memories subconsciously recalled. This can give rise to subconscious plagiarism or what psychiatrists call cryptomnesia.

Those with left brain creativity such as artists, composers or fashion designers can all be particularly susceptible to subconscious copying. Professor David Vaver in the second edition of his Canadian text *Copyright Law*, which has just been published, comments that cryptomnesia "is not uncommon today when so much of the manufactured environment to which everyone is daily exposed is protected by copyright". He highlights the defendant's lack of moral culpability since it is the subconscious, not the defendant, which is in control without the defendant knowing or being able to influence it.

An early example of subconscious copying arose in the case of the famous composer Jerome Kern who had composed an accompaniment to the refrain of *Kalua*: *Fred Fisher Inc v Dillingham*. Judge Learned Hand found that Jerome Kern's work contained a musical figure which was identical to the plaintiff's work *Dardanella* which had become popular before Kern's death. The court held that the similarity could not be the result of coincidence:

"Whether he unconsciously copied the figure, he cannot say, and does not try to. Everything registers somewhere in our memories, and no-one can tell what may evoke it. On the whole, my belief is that, in composing the accompaniment to the refrain of Kalua, Mr Kern must have followed, probably unconsciously, what he had certainly often heard a short time before."

In the leading decision *Francis Day & Hunter v Bron* Diplock LJ said this about subconscious copying:

"We know not whether it is rare or common, general or idiosyncratic, nor indeed whether it is possible to remember, not a mere isolated phrase, but a 'substantial' part of the remembered work without remembering that one is remembering."

Where there is an objective similarity between the copyright work and the alleged infringement, but no real evidence of copying in the form of access to or use of the plaintiff's work, a plaintiff may often raise a claim of subconscious copying as a means of meeting the need to show a causal link to the copyright work. In each case, careful factual analysis is required:

(a) Where there is evidence of access to plaintiff's work

If the case is one where there is credible evidence of access to the plaintiff's work, then the fact that the defendant may believe and have reasonable grounds for believing there was no causal connection is no defence. Knowledge has never been a requirement for this primary act of infringement. The fact that a defendant was not conscious or directly aware of the plaintiff's work is no defence.

So in *John Richardson Computers Limited v Flanders* Ferris J held that evidence had not shown any deliberate copying by the defendant. However, there was a causal connection in that the defendant had

an intimate knowledge of the plaintiff's software program "and it is possible that he had unconsciously or unintentionally or in some other way which he did not consider to be objectionable, made use of that knowledge in a way that amounts to copying in the context of breach of copyright".

Perhaps one of the most cited examples is the US decision, *Bright Tunes Music Corporation v Harrisongs Music Limited*) in which George Harrison's song *My Sweet Lord* (written in 1970) was found to have plagiarized the Chiffon's 1962 hit *He's so fine*. George Harrison gave a detailed description of how he had composed *My Sweet Lord* including working with other musicians such as Billy Preston. There was striking similarity between the two songs including a tell tale grace note in both. Also there was access because *He's so Fine* had been a No. 1 hit in the US and No. 12 in the UK. Owen J clearly believed George Harrison's version of the facts but held that nonetheless subconscious copying was still infringing copying :

"What happened? I conclude that the composer, in seeking musical materials to clothe his thoughts, was working with various possibilities. As he tried this possibility and that, there came to the surface of his mind a particular combination that pleased him as being one he felt would be appealing to a prospective listener; in other words that this combination of sounds would work. Why? Because his subconscious knew it had already worked in a song his subconscious mind did not remember. Having arrived at this pleasing combination of sounds, the recording was made, the lead sheet prepared for copyright and the song became an enormous success. Did Harrison deliberately use the music of *He's So Fine*? I do not believe he did so deliberately. Nevertheless it is clear that *My Sweet Lord* is the very same song as *He's So Fine*, with different words, and Harrison had access to *He's So Fine*.

Under US law, this too was held to constitute infringement.

(b) Where there is no evidence of such access

But a plaintiff's claim that there has been unconscious or subconscious copying does not prove infringement where there is no evidence of access to the plaintiff's copyright work.

A Canadian case in 1982 provides a striking example of the need for causal connection. In *Gondos v Harvey* . The plaintiff musician and composer alleged that in the 1960s he composed a song "Variations on a Theme in A Minor". He claimed to have written it out in 1962 and to have distributed copies to friends and students in the late 1960s. He also alleged that the defendants on separate occasions had an opportunity to overhear the song when he performed it in a nightclub in the 1970s. The case against the defendants was that each, acting separately, unconsciously copied portions of the plaintiff's song when they composed their own songs *The Homecoming* and *Moment of Love* respectively.

There was no evidence of direct copying. The plaintiff relied on a striking similarity between his work and each of the defendants and claimed unconscious copying. Carruthers J held that the plaintiff's work and *The Homecoming* were strikingly similar whereas the similarity between the plaintiff's work and *Moment of Love* was less.

Despite the urgings of the plaintiff's counsel that a striking similarity was enough to find infringement, Carruthers J was not prepared to do so without evidence of access or causal connection. He particularly was influenced by evidence as to musical cliches and commonplace features of modern Western music. Tellingly, one of the defendant's expert witnesses played a cassette of 11 other musical works which had been independently written. Two or three of these (one of which was by Vivaldi) were also found by the court to be strikingly similar to the plaintiff's work.

Carruthers J held that the playing of these passages was relevant not to support any defence of public domain but rather coincidence. There was no evidence of causal link and the action was dismissed.

The facts of *Francis Day & Hunter v Bron* also demonstrate this point. At first instance, Wilberforce J was not prepared to find from the close objective similarity of two songs that the defendant had copied, even subconsciously, the plaintiff's work. The Court of Appeal was not prepared to interfere with that finding.

Wilberforce J had rejected any claim to conscious copying and this was not challenged on appeal. The defendant composer's evidence was that he had not been aware of the plaintiff's song. It was then a case of whether the similarities were the result of either unconscious copying or coincidence. Both

songs made use of the musical cliché and Wilberforce was not satisfied that the similarities between the songs were due to conscious copying. Diplock LJ rejected the plaintiff's claim that objective similarity plus the mere possibility of access raised an irrefutable presumption of copying. To do so he held, would be to rule out the possibility that similarities could be due to coincidence (or indeed in other cases common influences on the two). It would also mean that proof of a causal connection was no longer part of copyright infringement. The court was not prepared to remove that requirement.

Overall, when assessing cases of subconscious copying, the court must make a judgment of the veracity of the parties and the evidence. Perhaps one of the most helpful checklists was provided by Wilberforce J at first instance in *Francis Day & Hunter*. Whether there is copying is a judgment of fact to be assessed upon a number of composite elements:

1. The degree of familiarity (if proved at all or properly inferred) with the plaintiff's work.
2. The character of the work - particularly its qualities of impressing the mind and the memory.
3. The objective similarity of the defendant's work.
4. The inherent probability that such familiarity, as is found, could be due to the existence of other influences on the defendant.
5. The quality of the defendant's own evidence on the presence or otherwise in his mind of the plaintiff's work.

In cases where the subconscious copier or cryptomnesiac is found to have infringed - for example, a defendant in the position of George Harrison - interesting questions arise as to the range of remedies which should be available. Professor Vaver argues that it is hard to justify the full schedule of remedies against such infringers. He notes that sleepwalkers, automatons and the insane are not usually liable for assaults or trespasses because they cannot appreciate the nature or quality in what they are doing. Professor Vaver argues that the same sort of uneasy compromises may need to evolve for cryptomnesiacs.

Some remedies such as additional damages will be affected by circumstances of subconscious copying. It may be possible for the infringer to argue that the copying is not flagrant so that additional damages should not be awarded. Professor Vaver suggests that with the remedy of an account of profits, perhaps the added value created by the subconscious copier should be deducted from the sum awarded to the plaintiff.

In addition the UK Copyright Act (section 97(1)), the New Zealand Copyright Act 1994 (section 121(1)) and the Australian Copyright Act 1968 (section 115(3)) contain provisions which may assist the cryptomnesiac or subconscious copier in respect of a damages claim. There is a slight difference between the wording of these different provisions. However, in essence if it is proved or admitted that at the time of the infringement the defendant did not know and had no reason to believe that copyright existed in the work to which the proceedings relate, the plaintiff is not entitled to damages but is only entitled to an account of profits. This raises some interesting issues. If the defendant subconsciously copied a work and was not ever knowingly aware of it, let alone that copyright subsisted in it, then conceivably the provision may confine the plaintiff's remedy to an account of profits.

The onus of proving the defence is on the defendant, New Zealand cases have held that a mistake of law or ignorance of the law will not suffice to establish the defence. However, this looks to the position where there is ignorance of the existence of protection in the form of copyright. Subconscious copying involves a different issue namely that the defendant may not have had any conscious awareness of the plaintiff's work in the first place - let alone that copyright might subsist in it.