

Australian Intellectual Property Journal

Volume 36, Number 2

2025

EDITORIAL – *Editor: Dianne Nicol* 63

ARTICLES

Development of the Australian Works of Artistic Craftsmanship Doctrine – Resolving Tensions Created in *Burge* – *Yisheng R Chen*

This article presents an analysis and re-evaluation of the High Court judgment in *Burge v Swarbrick*, the principal Australian authority on “works of artistic craftsmanship”. A close re-examination reveals that *Burge* is best understood to have advanced two fundamentally irreconcilable tests for what amounts to a work of artistic craftsmanship – Denicola’s functional-constraint test and Lord Simon’s product-of-an-artistic-craftsman test. The reliance on Denicola’s test seems, at first sight, reasonable; but, as this article explains, it was based on an interpretation of the separability principle under US law, which effectively excludes copyright protection for the expression of functional aspects of a work of artistic craftsmanship. Lord Simon’s approach was, however, founded on the Anglo-Australian legal tradition, and does not explicitly exclude the expression of functional aspects of a work from copyright protection. It is therefore undesirable for courts to continue to apply two mutually inconsistent tests. There is therefore a good case for Parliament to intervene to provide guidance as to how to interpret the current law (or to make necessary legislative amendments) to clarify whether copyright protection should be extended to the expression of functional aspects of a work of artistic craftsmanship which will, in turn, determine which of the two tests advanced in *Burge* should apply. 65

Whose Trade Mark Is It Anyway? A Critical Examination of the Meaning of Trade Mark Ownership and the Role of s 58 of the Trade Marks Act – *Isobel Taylor*

Section 58 of the *Australian Trade Marks Act 1995* (Cth) provides a ground of opposition to the registration of a trade mark, or cancellation of a registered mark, on the basis that the applicant is not the “owner” of the mark. A critical examination of this seemingly unremarkable ground, which derives its meaning from 19th-century common law conceptions of trade mark proprietorship, illustrates a range of problems with both its legal foundation and its potential practical impact. This article examines the background and history of s 58 and its recent application in the case law by way of illustration of its suboptimal application. It then poses a number of potential solutions to the issues identified, from the revolutionary – the removal of the section entirely – to the evolutionary – narrowing its operation through judicial interpretation or more minor legislative amendments. 95

Topics of Interest: Copyright and Condemnation – *David J Brennan*

In a recent decision, the Full Court of the Federal Court of Australia declared a constructive trust over a trespassing filmmaker’s copyright to effect specific restitution of that copyright to the landowner victim of the trespass. This provided a basis to grant permanent

injunctive relief to suppress the film. Given that the filmmaker was an animal liberationist organisation, and the landowner was an abattoir, the trust raises complex issues of civics. After considering the character and consequences of the declared trust, this piece argues that the issues of civics the trust implicates can only be properly addressed if its imposition is governed by judicial discretion. 117