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Author(s): Ian Robertson, Linda Luu and Nicholas Riordan
(of Holding Redlich)
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Australian court upholds assignee's ownership of 75-year-old classic Australian tune

The song *Down Under* by the Australian band Men at Work is an iconic Australian pop song and one of the most prominent Australian songs of all time. From the time of its release in 1981 and through to early 1983, it went to number one in Australia, the UK and the USA.

One of the most memorable elements of the song, its flute riff, has now become the subject of infringement of copyright proceedings, and the hearing on this issue commenced on October 26, 2009. This comment covers a related question already decided in these proceedings on the issue of the plaintiff's ownership of copyright in the work that it claims has been infringed.

Tracing the chain of title in the ownership of copyright in old works is often a task plagued with evidentiary difficulties, particularly where the work has been the subject of a number of assignments. In *Larrikin Music Publishing Pty Ltd v EMI Songs Australia Pty Limited* [2009] FCA 799, Justice Peter Jacobsen of the Federal Court of Australia was asked to decide whether the plaintiff was the owner of copyright in a popular Australian song called *Kookaburra Sits in the Old Gum Tree* ("the *Kookaburra* song"). The song was written by Ms Marion Sinclair in 1934 and was entered into a competition run by the local chapter of the Girl Guides Association of Victoria. Over the course of the *Kookaburra* song's 75-year history, the copyright subsisting in it is claimed to have been assigned on five occasions.

This judgment in the wider context of the proceedings

The full hearing in the proceedings was due to take place late June 2009. However, upon it becoming clear that the parties were not sufficiently prepared for the full hearing to take place, Jacobsen J. part heard the matter on the question of whether Larrikin took an effective assignment of copyright subsisting in the *Kookaburra* song.

Larrikin's substantive claim is that the composers of *Down Under*, Colin Hayes and Ronald Strykert, and the copyright owner, EMI Songs Australia Pty Ltd, infringed Larrikin's copyright in the *Kookaburra* song by reproducing the song's refrain in the prominent flute riff in *Down Under*.

The alleged assignment of 1934

The *Kookaburra* song was composed by Marion Sinclair in about 1934 and was entered into a competition held by the Girl Guides Association of Victoria. The entries were sought so that the entry fees and any proceeds from the sale of winning entries could help raise a fund for the Association to build a new hall. Relevantly, the competition rules, which were published in a journal leading up to the event, imposed rule (d):

"all matter entered to become the property of the Guide Association".

To enter the competition, Ms Sinclair submitted a signed manuscript of her work, which contained the sheet music and lyrics of her composition. EMI claimed that her entrance into the competition created a contract between the parties that incorporated rule (d), and this was sufficient to effect the assignment of her copyright in the composition to the Girl Guides. If EMI's argument was successful, Larrikin's ownership claim would fail, as a successful assignment to the Girl Guides would render all subsequent assignments invalid under the *nemo dat quod non habet* principle, literally, no person can give what he or she does not own.

Jacobsen J.'s analysis of the alleged 1934 assignment

The relevant law in force in Australia at the time of the competition was the Copyright Act 1911 of the UK. In relation to assignment of copyright, the Act required the assignment to be evidenced in writing and signed by the copyright owner.

Jacobsen J. outlined the elements that EMI needed to prove to establish that a valid assignment had occurred, namely that a contract had been formed between the Girl Guides and Ms Sinclair incorporating rule (d) as a term, that the contract was in writing, that there was an intention to assign and that the words in rule (d) were apt to effect an assignment of copyright in the work.

EMI failed to prove any of these elements.

In relation to whether a contract existed in writing between Ms Sinclair and the Girl Guides, EMI was unable to locate Ms Sinclair's entry form, if one even existed, to adduce at the hearing. Instead, it argued that Ms Sinclair ought to be taken to have had knowledge of the competition's rules and that the contract was in writing because she had signed her manuscript. Jacobsen J. dismissed this argument, noting that it was mere conjecture that Ms Sinclair knew of the rules before submitting her song to the competition, and that her act of signing the manuscript was plainly done so as to identify her manuscript from those of the other entrants. Accordingly, he found that there was no *written* contract between the parties and that rule (d) was not incorporated into the contract that did exist. Accordingly, it followed that there was no assignment in writing to satisfy the requirements in the statute.

Was there an intention to assign?

In order for EMI to prove that Ms Sinclair intended to assign her copyright in the *Kookaburra* song to the Girl Guides, it attempted to rely on a statement of Ms Sinclair in her autobiography that she wrote and published in 1984. Her statement was that the winning entry in the competition "would be sold to help the fund". His Honour held that the statement from the autobiography was inadmissible, although even if it were admissible, it could be given little to no weight because it came more than 50 years after the competition and other inaccurate statements also made in the autobiography tainted the reliability of her reminiscences.

Other letters from third parties to Ms Sinclair seeking her permission to broadcast the *Kookaburra* song were adduced by Larrikin to support the proposition that Ms Sinclair did not intend to assign the copyright in her song in 1934. However, His Honour also ruled these letters inadmissible because they amounted to post-contract correspondence with a stranger to the contract, giving them little to no probative value.

Instead, His Honour based his finding that there was no intention to assign by relying on three contemporaneous sources: two Girl Guides publications and a letter from the Girl Guides to Ms Sinclair.

The construction of rule (d) of the competition

Although otherwise given the above findings, His Honour also considered the construction question, namely whether the words used in rule (d) are apt to effect an assignment on the assumption that the other elements had been proven. He held that in the circumstances they were not.

One of the reasons on which he based this finding is the distinction between the incorporeal right to the intellectual property and the right to physical property in a work: *Interstate Parcel Express Co Pty Limited v Time-Life International (Netherlands) BV* (1977) 138 CLR 534 at 550. On the basis of this principle, he construed the word “matter” in rule (d) as referring to the physical right of possession in the manuscripts, but not the intellectual property also attaching to those items.

Although ordinarily there is no special formulation of words needed to effect an assignment, because of the absence of an intention to assign, very unambiguous words would have been necessary in order for EMI to achieve the result that it was contending.

Chain of title

Given that the alleged assignment of 1934 was held to have been ineffective, it was then necessary for His Honour to consider the validity of the subsequent alleged assignments.

In 1987, Ms Sinclair donated all copyright owned by her to the State Library of South Australia. Furthermore, by her last will and testament of 1984, she appointed the Public Trustee as her sole executor and trustee and left all her estate to a number of charitable organisations. At the time of her death, the Public Trustee, unaware of her donation of records to the State Library of South Australia, invited tenders for the purchase of the copyright in the *Kookaburra* song. Larrikin was the winning tenderer and subsequently entered into a deed of assignment with respect to the copyright in the composition.

In 2000, after the Public Trustee was made aware by the solicitor for the State Library of South Australia that the *Kookaburra* song never formed part of Ms Sinclair's estate, Larrikin, the Public Trustee and the State Library of South Australia entered into a tripartite deed of assignment assigning to Larrikin all rights in respect of the *Kookaburra* song. This state of affairs was further confirmed by the three parties in a deed of confirmation entered into in 2008 at the commencement of the proceedings.

Given the parties to the tripartite agreements, it was evident that, regardless of which institution was the owner of the rights capable of assignment and which agreement actually effected the transfer of ownership to Larrikin, Larrikin had received an effective assignment of the rights in the *Kookaburra* song under either one of the agreements.

Accordingly, His Honour held that Larrikin owned the copyright in the *Kookaburra* song. It therefore follows that Larrikin was able to contest its substantive infringement claim.

Comment

The case is significant for a number of reasons. From an evidentiary aspect, it is interesting to observe His Honour's comments in respect of the admissibility of correspondence as to contractual relations which post-dated the formation of the contract it refers to, as well as his understandable reluctance to draw inferences in respect of the events of 1934 where contemporaneous evidence could not be admitted. The treatment of the question of assignment raised by the competition rules against the statutory requirements of a valid assignment is another interesting aspect of the case, although His Honour's findings in this respect are straightforward.