

# SUPREME COURT OF QUEENSLAND

CITATION: *Coles v Dormer & Ors* [2015] QSC 224

PARTIES: **STEPHEN VINCENT COLES**  
(Plaintiff)  
v  
**JAMES DORMER**  
(First Defendant)  
and  
**MICHAEL CLARK**  
(Second Defendant)  
and  
**JOHN ARTHUR BREDEN and**  
**EDITH MARY KATHRYN BREDEN**  
(Third Defendants)

FILE NO/S: SC 177 of 2014

DIVISION: Trial

PROCEEDING: Claim

ORIGINATING COURT: Supreme Court at Cairns

DELIVERED ON: 4 August 2015

DELIVERED AT: Cairns

HEARING DATE: 20, 21, 22 April 2015

JUDGE: Henry J

ORDERS:

1. Judgment for the plaintiff.
2. The defendants shall promptly take the following action in respect of the following external features of the third defendants' house at lot 23 The Sands Estate Port Douglas:
  - (a) Feature: Dormer roofs  
Action: Remove the dormer roofs.
  - (b) Feature: Arched and circular windows at the front of the house and such other exterior arched and circular windows as are ordinarily visible from public paths or streets.  
Action: Remove and replace with rectangular or square windows and any external remnant space, appearance or outline of the arched and circular window shapes be filled and concealed by rendering.
  - (c) Feature: Stone edge trim corners at the front of the house and such other stone edge trim corners

as are ordinarily visible from public paths or streets.

**Action: Grind, cut away or remove the areas of stone edge trim to the extent necessary to render those areas flush with the walls and fill and conceal by render any remnant appearance or outline of the stone edge trim.**

**3. I will hear the parties at 10 am on 28 August 2015 as to:**

- (a) any appropriate variations or additions to order 2;**
- (b) the plaintiff's election as to damages or an account;**
- (c) directions to advance the final determination of damages or the taking of an account, as the case may be, and costs.**

**CATCHWORDS:** INTELLECTUAL PROPERTY – COPYRIGHT – REMEDIES FOR INFRINGEMENT – where the plaintiff seeks an injunction and damages pursuant to s 115 and 116 of the *Copyright Act 1968 (Cth)* for breach of copyright - what remedies should be awarded if breach of copyright is established

INTELLECTUAL PROPERTY – COPYRIGHT – ORIGINAL WORK IN WHICH COPYRIGHT SUBSISTS – GENERALLY – whether the original house plans were an artistic work as defined in the *Copyright Act 1968 (Cth)* – whether copyright subsists in the original plans of the plaintiff's house

INTELLECTUAL PROPERTY – COPYRIGHT – ASSIGNMENTS, LICENCES AND ROYALTIES – ASSIGNMENT – GENERALLY – whether the original author owned the copyright in the house plans – whether the assignment of the plans to the plaintiff by the original author was effective

INTELLECTUAL PROPERTY – COPYRIGHT – INFRINGEMENT – ARTISTIC WORKS – whether the plans for the plaintiff's house had been converted by the first and second defendants to plans for the third defendants' house – whether the third defendants' house plans were a reproduction or substantial reproduction of the plaintiff's house plans – whether the construction of the third defendants' house was a reproduction or substantial reproduction of the plaintiff's house – whether the house plans and/or construction of the third defendants' house are an infringement of copyright

*Copyright Act 1968 (Cth)* s 14, s 21, s 31, s 32, s 35, s 36, s 78, s 115, s 116, s 196

*Beloff v Pressdream Ltd & Anor* [1974] 1 All ER 241, cited  
*Cescinsky v George Routledge & Sons Limited* [1916] 2 KB 325, cited

*Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd* (2011) 91 IPR 488, cited

*IceTV Pty Ltd v Nine Network Australia Pty Ltd* (2009) 239 CLR 458, applied

*Jaggard v Sawyer* [1995] 1 WLR 269, considered

*Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, applied

*Levy v Rutley* (1871) LR 6 CP 523 *Prior v Lansdowne Press Pty Ltd* [1977] VR 65, distinguished

*Powell v Head* (1879) 12 Ch D 686, cited

*Shelfer v City of London Electric Lighting Co* [1895] 1 Ch 287, cited

*Taypar Pty Ltd v Santic* (1989) 21 FCR 485, considered

COUNSEL: C Ryall for the Plaintiff  
 Dr M Jonsson for the First, Second and Third Defendants

SOLICITORS: Robert P Palethorpe for the Plaintiff  
 Williams Graham Carman for the First, Second and Third Defendants

## Introduction

- [2] James Dormer and Michael Clark, the first and second defendants, are builders trading in partnership as Port Douglas Builders (“PDB”). They built a house for Lance and Moniker Spicer. They used plans drafted for that purpose by building designer Gregory Skyring (“the Skyring house plans”).
- [3] The Spicers later put their house on the market for sale. The house was located at lot 16 The Sands, a gated estate in Port Douglas. The successful purchaser, at a price of \$1,150,000, was Stephen Coles, the plaintiff. He particularly liked the unique style of the house.
- [4] He was not alone. John and Edith Breden, the third defendants, disappointed prospective purchasers of the house, liked the house so much they decided to pay \$1,000,000 to PDB builders to build a house just like it for them in the very same estate. Mr Coles heard rumours of this and acquired the copyright in the Skyring house plans from Mr Skyring by assignment. In doing so he intended to make sure his house would be the only house of its design in the area.
- [5] Mr Coles put PDB on notice of the fact he held copyright of the Skyring house plans and that he objected to the construction of a house identical to his. This case would have been avoided had PDB and the Bredens then accommodated Mr Coles’ concerns and varied their proposed plans. Instead they pressed on regardless, constructing a house using the Skyring house plans.

- [6] The plaintiff seeks an injunction, damages for infringement of copyright including additional damages pursuant to s 115(4) of the *Copyright Act 1968* (Cth) and an order for delivery up of all infringing copies of the plans.

### **The parties' cases in brief**

- [7] The plaintiff alleges the defendants converted the Skyring house plans to their own use and infringed copyright both by reproducing or substantially reproducing those plans and constructing a house substantially based on those plans.
- [8] The defendants deny any conversion or copyright infringement, pleading that neither their production of the plans for construction of the Bredens' house ("the Breden house plans") nor the construction of the Bredens' house reproduced or substantially reproduced the Skyring house plans. Even if that did occur they allege it was not an infringement of copyright because Mr Skyring had no copyright in the Skyring house plans to assign to Mr Coles.
- [9] The defendants plead Mr Skyring merely transcribed plans prepared by Mr Spicer into usable form. They plead Mr Skyring was therefore not the true author of the works comprised in the Skyring house plans with the result those plans are either not an original artistic work within the meaning of the *Copyright Act* or that if they are it was Mr Spicer who originated the artistic expression comprised in those plans.

### **Relevant legislative provisions**

- [10] The plaintiff's claim seeks to enforce rights conferred by the *Copyright Act* ("the Act").
- [11] The Act provides at s 32 that copyright subsists in original artistic works by an author who is an Australian citizen or resident. Drawings, models of buildings and buildings, regardless of their artistic quality, are works within the definition of "artistic works" in s 10 *Copyright Act*. It follows building plans and houses are artistic works.
- [12] The Act provides at s 35 that the author of an artistic work is the owner of any copyright subsisting in that work. Copyright is personal property which, pursuant to s 196, is transmissible by assignment, as occurred here.
- [13] Section 31(1)(b) of the Act relevantly provides that copyright in the case of an artistic work is the exclusive right "to reproduce the work in a material form" and "to publish the work."
- [14] Section 36(1) provides that copyright is infringed by a person who is not the owner of the copyright doing or authorising the doing of any act comprised in the copyright without the licence of the owner of the copyright. Thus acts of publishing or reproducing artistic works in a material form without the consent of the copyright owner will infringe copyright.
- [15] Pursuant to s 14 the Act's references to the doing of an act and to reproduction include the doing of an act in relation to or reproduction of "a substantial part of the work". Thus proof of substantial rather than complete reproduction will suffice in proof of infringement. Moreover s 21(3) provides that artistic works in two dimensional form will have been reproduced if produced in three dimensional form and vice versa. Therefore reproduction of house plans as well as production of a house from those

house plans without the consent of the owner of the copyright in the plans will constitute an infringement of copyright. Both are alleged to have occurred here.

### **Issues for determination**

- [16] The issues for determination (and the short headings under which they will be considered when arrived at in the course of the analysis below) are:
- (1) Was Mr Skyring the owner of copyright in the plans produced? (“Originality of Skyring’s work?”)
  - (2) Was the purported assignment of copyright in the Skyring house plans to Mr Coles effective? (“Assignment effective?”)
  - (3) Were the Breden house plans a reproduction of the Skyring house plans? (“Breden house plans an infringement of copyright?”)
  - (4) Was the Breden house as constructed a reproduction of the Skyring house plans? (“Construction of Breden house an infringement of copyright?”)
  - (5) If there has been an infringement of copyright and or conversion, what remedies should be awarded? (“Remedies?”)

### **The creation of the Skyring house plans**

- [17] In August 2009 Mr Spicer contacted PDB seeking their quote to build a house for the Spicers at lot 16 The Sands.<sup>1</sup> This was confirmed by an email of 27 August 2009 to Mr Dormer and Mr Clark from the Spicers. The email purported to set out the Spicers’ “rough” ideas for their home and included proposed specifications, four pages of draft floor plans and two photographs of houses illustrating the architectural style sought by the Spicers (“the Spicer rough ideas email”).<sup>2</sup> PDB quoted for the project and were engaged as the Spicers’ builders by 7 September 2009.<sup>3</sup>
- [18] The Spicers also sought PDB’s recommendation of a suitable local architect to draft plans for their house.<sup>4</sup> PDB sought out Mr Skyring, a licensed building designer, and supplied him with the Spicer rough ideas email.<sup>5</sup> At the outset of the trial a bundle of documents was tendered by consent, becoming exhibit one. Tab 1 thereof is the Spicer rough ideas email. Tab 2 appears to be further plans drafted by Mr Spicer but there was no evidence that those plans were provided to Mr Skyring.<sup>6</sup> Mr Clark gave evidence that the documents in tab 2 were received “since” he had received the Spicer rough ideas email but he did not say when that was.<sup>7</sup> No other evidence was proffered to establish the relevance of the documents in tab 2. The Spicers did not give evidence.
- [19] While PDB enlisted Mr Skyring it is clear Mr Skyring dealt with and charged the Spicers as his client. In the residential building contract entered into between PDB

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<sup>1</sup> T2-2 L37.

<sup>2</sup> Ex 1 tab 1.

<sup>3</sup> Ex 1 tab 4.

<sup>4</sup> T2-3 L39.

<sup>5</sup> T2-3 L45, Ex 8 [13].

<sup>6</sup> T2-5 L26.

<sup>7</sup> T2-3 L30.

and the Spicers on 6 October 2009 Mr Skyring was named in item 5 as the preparer of the plans to be supplied by the Spicers.<sup>8</sup>

- [20] Mr Skyring traded as a building designer through a company named Greg Skyring Design and Drafting Pty Ltd. The relevant evidence of his actions in this case, including his authorship and assignment of plans, sometimes referred to him and sometimes to his company. It is obvious however that his actions were in his capacity as an agent of the company through which he conducted his business.<sup>9</sup> In referring to his actions I will for simplicity refer to his name only but those references are in effect references to actions of his company.
- [21] The plans and design ideas in the Spicer rough ideas email were quite detailed for the work of a lay person. For example, in evidence in chief Mr Clark asserted that the structure of the home eventually built for the Spicers was close to the design plan that appeared from the outset in the Spicer rough ideas email.<sup>10</sup> Nonetheless Mr Spicer's plans and design ideas were far short of the detailed plans required to build a house. As much is obvious from the extent of work engaged in by Mr Skyring.
- [22] After he was engaged Mr Skyring proceeded to:
- (1) re-scale the Spicers' floorplans;
  - (2) prepare ground and first floor plans using his computer assisted drafting programme, Revit CAD 3D, adapting Mr Spicer's provided dimensions to dimensions appropriate to construction of a residence involving masonry blocks as the prime construction material and determining appropriate heights and roof pitches appropriate to the construction method and Council requirements;
  - (3) prepare a site plan, ensuring compliance with Council requirements such as boundary setbacks;
  - (4) sketch windows and doors.<sup>11</sup>
- [23] Mr Skyring emailed his sketches to the Spicers. Suggestions for change from Mr Spicer and sketch revisions by Mr Skyring were exchanged between them during October 2009.<sup>12</sup>
- [24] Mr Skyring drew more detailed drawings, revised on 2 November 2009, including:
- (1) drawing in of detailed dimensioning, including the relative positioning of boundary and external structural components;
  - (2) two elevations with pictorial rendering of windows and doors, including arches and circles, drawing of stone finish corners and detailed notes of ceiling, head and floor lines;
  - (3) ground floor and first floor plans including scaled dimensioning of openings and walls, notations about door type and direction and pillar location and calculations of building and site cover.<sup>13</sup>

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<sup>8</sup> Ex 1 tab 9.

<sup>9</sup> The parties did not dwell on this point for it makes no material difference in the context of the present dispute.

<sup>10</sup> T2-8 LL6-28.

<sup>11</sup> Ex 8 [15]-[21].

<sup>12</sup> Ex 8 [21], Ex 1 tab 10.

<sup>13</sup> Ex 8 [22]-[29], Ex 1 tabs 14, 15.

- [25] Then on 10 November 2009 Mr Skyring issued plans in five sheets – the site plan and notes, elevation sheets one and two, the ground floor plan and the first floor plan.<sup>14</sup> He engaged in revisions of those plans, completing revisions B and C by 23 November 2009.<sup>15</sup> Those revisions took account of communications from Mr Spicer and some issues raised by the design review panel of The Sands estate body corporate. Mr Clark’s recollection was that the panel has some concerns about boundary proximity and wanted the added feature of two dormer roofs on the front elevation.<sup>16</sup>
- [26] Mr Skyring then produced a comprehensive set of architectural and structural plans, endorsed as revision C, consisting of 16 sheets, namely:
- (1) *3D views, drawing list;*
  - (2) *site plan, general notes* incorporating building standards notes from Mr Skyring’s library, setbacks details and additional dimension detail for roof overhangs;
  - (3) *elevations – sheet 1;*
  - (4) *elevations – sheet 2;*
  - (5) *ground floor plan* incorporating engineering details and specifications and cross references to other plans and lintel detailing;
  - (6) *ground floor plan – minor dimensions* showing all minor dimensions in sufficient detail for the purposes of builders for construction;
  - (7) *first floor plan* incorporating cross referencing to the ensuing engineering drawings and minor detailing such as for the balustrade and hallway wall niches;
  - (8) *first floor plan – minor dimensions, wall reinforcing;*
  - (9) *foundation and ground floor reinforcing plan* incorporating engineering and construction specifications;
  - (10) *foundation and fence details* incorporating engineering and construction specifications;
  - (11) *suspended slab plan views, notes;*
  - (12) *suspended slab details;*
  - (13) *section 1* incorporating engineering details for the footings, slab and ceiling;
  - (14) *sections 2 and 3, details* incorporating cross-references to sheet 10’s engineering details;
  - (15) *section 5, details, structural notes* incorporating detail from the footings to roof line and cross-referencing engineering detail in sheets 10, 12 and 14;
  - (16) *outdoor kitchen details* incorporating engineering specifications.<sup>17</sup>
- [27] Mr Skyring engaged engineer Graham O’Rourke to provide the necessary engineering construction information for the plans. Mr O’Rourke conveyed that information by handwritten endorsements upon Mr Skyring’s draft plans.<sup>18</sup> The incorporation of that information by Mr Skyring into his plans was time consuming, particularly in respect of his two dimensional plans.<sup>19</sup> In subsequently issuing his engineering certificate Mr O’Rourke identified further changes to be made to sheets 9 and 11 in respect of Mr

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<sup>14</sup> Ex 8 [30], Ex 1 tab 16.

<sup>15</sup> Ex 8 [32]-[33], Ex 1 tabs 17-21.

<sup>16</sup> T2-7 L13, Ex 1 tab 25.

<sup>17</sup> Ex 8 [34]-[49], Ex 1 tab 23.

<sup>18</sup> T1-29L13, ex 1 tab 29.

<sup>19</sup> T1-26 L40, T1-29 L45.

Skyring's plans.<sup>20</sup> Those changes were reflected in Mr Skyring's re-issue of his revision C set of architectural and structural plans on 14 December 2009.<sup>21</sup> By this time Mr Skyring had spent 112½ hours working towards the creation of the plans.<sup>22</sup>

- [28] Building work commenced on site on 21 December 2009.<sup>23</sup>
- [29] Mr Clark testified that in the course of the house being built the Spicers realised a garage roof had the potential to be altered to a balcony and the plans and approvals were varied to allow that to occur.<sup>24</sup>
- [30] Mr Skyring re-issued a further set of his plans on 29 April 2010, as revision D, incorporating changes for the balcony over the garage and to some trusses and batten fixing details.<sup>25</sup> As in the earlier versions, the ground and first floor plans (sheets 5, 6, 7 and 8) were endorsed, "To be read in conjunction with Owners Specification".<sup>26</sup> That did not relate to structural detail but to finishes and colours to be specified by the Spicers.<sup>27</sup>

### **Originality of Skyring's work?**

- [31] Having reviewed the nature of the work undertaken by Mr Skyring it is convenient to consider whether Mr Skyring was the owner of copyright in the plans he produced.
- [32] The defendants submit there was no copyright of Mr Skyring's subsisting in the Skyring house plans because they were not an original artistic work. If wrong about that they submit at worst for them that the Skyring house plans were a work of joint authorship.
- [33] The essential theme of the defendant's submission was that Mr Skyring's work was not original because it did not substantially transform or contribute to or depart from the underlying design concept already produced in the Spicer rough ideas email. The submission echoed opinions expressed by the defendants' expert witness, architect Dr Shaneen Fantin. In her report<sup>28</sup> she opined Mr Skyring had transcribed Mr Spicer's design intention into building plans that could be built<sup>29</sup> and that Mr Skyring's changes to Mr Spicer's overall plan and design did not result in Mr Skyring being the author of the artistic expression of the house on lot 16. Doctor Fantin's use of terms like "transcribe"<sup>30</sup> and "artistic expression" as if they held special meaning in copyright cases had the consequence of distancing her opinion from the applicable language of the Act.
- [34] Dr Fantin's opinion and the defendants' submission are implicitly premised on originality requiring some new underlying idea. Yet it is well established that the

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<sup>20</sup> Ex 8 [43]-[49].

<sup>21</sup> Ex 8 [50], Ex 1 tab 33.

<sup>22</sup> Ex 8 [55].

<sup>23</sup> T2-6 L5, ex 1 tab 9 p43.

<sup>24</sup> T2-8 L45.

<sup>25</sup> Ex 8 [51], Ex 1 tab 38, tab 40 (the set at tab 40 pp202-217, printed on 6 May 2010, is the complete set of revision D – T1-25 L42).

<sup>26</sup> Ex 1 tab 40.

<sup>27</sup> T1-33 L32.

<sup>28</sup> Ex 5.

<sup>29</sup> Ibid [4.1].

<sup>30</sup> A term she conceded may have been prompted by her instructions T1-61 L13.

concept of originality in the law of copyright does not connote or require originality in a sense of novelty or originality of thought and rather merely requires that the relevant work has originated in or with the author concerned rather than having been copied by the author.<sup>31</sup> In *IceTV Pty Ltd v Nine Network Australia Pty Ltd* French CJ, Crennan and Kiefel JJ observed of the requirement that copyright subsist in a work which is original:

“Originality for this purpose requires that the literary work in question originated with the author and that it was not merely copied from another work. It is the author or joint authors who bring into existence the work protected by the Act. In that context, originality means that the creation (i.e. the production) of the work required some independent intellectual effort, but neither literary merit nor novelty or inventiveness as required in patent law.”<sup>32</sup>

- [35] The above factual overview of the extent of work engaged in by Mr Skyring illustrates the very significant effort he put into drafting his plans. Perusal of the Skyring house plans demonstrates the obvious professional expertise or “independent intellectual effort” Mr Skyring applied to the task of producing plans from which a house could be constructed. Visual comparison of the Skyring house plans and the Spicer rough ideas email demonstrates the former is substantially different from the latter. It contains more plans, including elevations, and considerably more information, including technical information. Its spatial configuration of some parts of the house is also different to what was contemplated in the Spicer rough ideas email.
- [36] While not essential to proof of the Skyring house plans’ original quality it is also relevant to note the Skyring house plans contain elementary design features such as exterior arched windows and round windows which do not appear in the Spicer rough ideas email.<sup>33</sup> The Skyring house plans are clearly not a copy or transcription of the Spicer rough ideas email. They are an original artistic work and copyright therefore subsists in them.
- [37] This is not to deny that the Spicer rough ideas email, excluding the photographs, is also an original work of artistic expression in which copyright subsists. However that does not preclude the subsistence of copyright in Mr Skyring’s original work of artistic expression. This warrants emphasis because the defendants’ argument implicitly relied on a flawed construct that there were not two separate works and that the work involved in the Skyring house plans was really just a continuum of the existing original work of the Spicers.
- [38] Anticipating this construct, if accepted, might support a conclusion Mr Spicer was at least a joint author, the defendants drew upon the old English decision of *Levy v Rutley*<sup>34</sup> to argue that Mr Skyring’s contribution fell short of it amounting to a work of joint authorship. That argument is correct insofar as it relates to the Spicer rough ideas email as an original work of artistic expression. Was I to find that the Breden house plans later produced by PDB were reproductions of the work set out in the Spicer rough ideas email, the plaintiff’s case would inevitably fail. But it has never

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<sup>31</sup> *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 291.

<sup>32</sup> (2009) 239 CLR 458, 474 (citations omitted).

<sup>33</sup> Even if consideration is given to the front elevation in Ex1 tab 2 (overlooking the vagaries of proof of that tab) it has no circular windows and there is no arching atop the first floor windows. In any event Ex 1 tab 10 shows they were added once Mr Skyring was drafting.

<sup>34</sup> (1871) LR 6 CP 523.

been the plaintiff's case that Mr Skyring was joint author of the work contained in the Spicer rough ideas email. Its case is that Mr Skyring was the author of the Skyring house plans. It follows the pertinent joint authorship question is whether Mr Spicer's role in providing feedback and suggestions as Mr Skyring gradually produced the Skyring house plans<sup>35</sup> made Mr Spicer a joint author of those plans.

[39] Section 78 *Copyright Act* provides that its references to the author of a work "shall be read, in relation to a work of joint authorship, as a reference to all the authors of a work".<sup>36</sup> The Act defines a "work of joint authorship" as meaning:

"a work that has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of the other authors".

[40] In *Dynamic Supplies Pty Ltd v Tonnex International Pty Ltd*<sup>37</sup> Yates J observed of the Act's definition of a work of joint authorship:

"This definition makes it clear that collaboration and contribution are the central underpinning characteristics of a work of joint authorship. It also makes it clear that the contribution must be of a special type: it must be "not separate" from the contribution of others properly considered to be authors. The precise additional limit intended to be imposed by that requirement is not clear. ... However, one matter is clear: the contribution must be to the work that is the particular subject of copyright protection, not some other work."<sup>38</sup>

[41] Here the most significant contribution of the Spicers was a separate contribution to another work. It was to their rough ideas email, a different subject of copyright protection than the Skyring house plans.

[42] In *IceTV Pty Ltd v Nine Network Australia Pty Ltd*<sup>39</sup> the High Court explained where a work is brought into existence by the efforts of more than one individual it will be a question of fact and degree which one or more of them have expended sufficient effort to be considered an author of that work within the meaning of the Act.<sup>40</sup>

[43] Such contribution as the Spicers did make to the Skyring house plans took the form of Mr Spicer's occasional suggestions and feedback as a client. It may be accepted those contributions, being the wishes, perhaps even instructions, of Mr Skyring's client influenced the ultimate content of the plans produced by Mr Skyring. However Mr Spicer did not collaborate in the actual authorship of the work being produced. Nor as a matter of degree were his efforts sufficient for him to be considered an author of the work.

[44] The events that ensued after the production of the Skyring house plans therefore fall for consideration on the basis that Mr Skyring held copyright in those plans.

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<sup>35</sup> See, for example, Ex 1 tabs 10, 13, 25, 27, 28 and 32.

<sup>36</sup> Further s 79 provides the references to author in s 32, which provides that copyright subsists in original artistic works, shall "be read as references to any one or more of the authors of the work." (2011) 91 IPR 488.

<sup>37</sup> (2011) 91 IPR 488.

<sup>38</sup> Ibid [53], [56].

<sup>39</sup> (2009) 239 CLR 458.

<sup>40</sup> Ibid [99].

### A problem emerges

[45] Construction of the Spicers' home was completed by early October 2010.<sup>41</sup> They subsequently put their home on the market for sale.

[46] Mr Coles, a veterinary surgeon living in both Victoria and Port Douglas, had been living with his wife in rented accommodation in Port Douglas. Seeking more permanent residency in Port Douglas they came upon the Spicers' home for sale and were very taken by its unique style. Mr Coles testified:

“[W]e saw Lot 16 and it just overwhelmed us. It was such a unique, beautiful house...that we wanted to purchase it. ... [I]t's built in sort of French Provincial style with a Caribbean influence, if you like. It's the only one of its type in Port Douglas or looks anything like it. ... The layout of the opening – all the windows and doors with the half circles on top, the way the corbelling had been done around all those doors and windows in the house. The dormer lofts on top of the roof. Particularly there are full circle windows in the front. And just the façade at the front of the house is really quite unique.”<sup>42</sup>

[47] The Bredens, who were not called at trial, were also very impressed by the house and were rival bidders to Mr Coles.<sup>43</sup> Mr Coles succeeded in contracting to purchase the house in June 2013 and after a two month settlement period the sale to him for \$1,150,000<sup>44</sup> completed on 6 August 2013.<sup>45</sup>

[48] In the meantime the Bredens apparently developed the idea of buying a vacant block of land in the same estate and having the same builders as built the Spicers' house build them such a house. Mr Breden met on site at lot 23 with the agent selling that vacant block along with the first and second defendants. Mr Clark testified of that meeting:

“[Mr Breden] was just so impressed with the finishes in the house and the ambience of the house – the general spaciousness and finishes – that he was considering building a house in the same style. He wanted to build a house in the same style. ... We told him that we could have a look and see what we could come up with basically for his block. All blocks are obviously different. And we told him that we'd have a look and see – we'd mess around with some floor plans and see how we could make it work and if we could build something that was in the same sort of style.”<sup>46</sup>

[49] Mr Clark testified that he and Mr Dormer told the Spicers of the meeting with Mr Breden and ascertained they had no objection:

“[W]e went and told them that the guy was interested in building a house based on their design, and that he loved their finishes and regretted the fact that he hadn't managed to buy it in the first place. But he loved it so much – he loved the workmanship – that he'd like to replicate their design. So they congratulated us, said I hope you do

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<sup>41</sup> T2-29 L16.

<sup>42</sup> T1-15 L33 – T1-16 L18.

<sup>43</sup> T2-9 L29.

<sup>44</sup> T1-21 L8.

<sup>45</sup> T1-15 L23.

<sup>46</sup> T2-9 LL29-38.

well. We asked them if they had any problem with us doing that and they said, no, not at all, in fact, we're flattered that he likes our design that much that he'd like to build something like it. We'd already warned Mr Breden that we couldn't build exactly the same thing because it wasn't going to fit on the block."<sup>47</sup> (emphasis added)

- [50] Mr Clark testified that he and Mr Dormer subsequently met with Mr Breden discussing sketches they had done of site plans of the house. Mr Clark was uncertain of the whereabouts of those sketches although in re-examination he speculated that a general site plan dated 31 July 2013<sup>48</sup> – the date of the eventual contract with the Bredens – was the document he earlier showed the Bredens.<sup>49</sup>
- [51] On Mr Clark's own account PDB made "similar changes" to their design as "Mr Skyring had made to Mr Spicer's design" to fit a two storey house on the block.<sup>50</sup> That was not to suggest the changes were identical but rather to explain that in each instance some variation was necessary because of the configuration of each block.
- [52] On 31 July 2013 PDB entered into a residential building contract with the Bredens to build them a house for one million dollars at lot 23 The Sands.<sup>51</sup> According to item 5 of the contract the plans were to be prepared and supplied by PDB. On Mr Clark's account the plans and drawings for the dwelling had been completed by then although notations to them were still required.<sup>52</sup> The contract however indicated that they remained to be finalised.<sup>53</sup>
- [53] Mr Coles heard it rumoured that PDB had been engaged to build a replica of his house.<sup>54</sup> He did not want a replica of his house built. He contacted Mr Skyring, who agreed to sell the copyright in the building design of the Coles house to Mr Coles and gave Mr Coles a copy of revision C of his plans.

### **Assignment effective?**

- [54] By a signed letter dated 20 August 2013 Mr Skyring wrote:
- "This is to certify that I have sold and assigned the Copyright rights to the building design of Lot 16 The Sands Port Douglas  
To  
Stephen Coles  
Lot 16 The Sands Port Douglas  
for a period of two years from the above date effective immediately."<sup>55</sup>

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<sup>47</sup> T2-11 LL27-35 (emphasis added).

<sup>48</sup> Ex 1 tab 50 p245.

<sup>49</sup> T2-35 L25.

<sup>50</sup> T2-11 L42 – T2-12 L30.

<sup>51</sup> Ex 1 tab 56.

<sup>52</sup> T2-12 L43.

<sup>53</sup> T2-22 L10.

<sup>54</sup> T1-16 L45.

<sup>55</sup> Ex 1 tab 45 p239. While Mr Skyring physically gave Mr Coles version C of the plans the written assignment did not distinguish between versions C or D and on its terms is broad enough to encompass both versions. Nothing turns on the point in that the differences between versions C and D are not of such a nature as to alter the conclusions to be drawn about infringement when they are compared with the Breden house plans.

- [55] Mr Coles paid Mr Skyring \$110 for the sale of the copyright for two years from 20 August 2013.<sup>56</sup> Mr Coles gave evidence that on a date after the assignment he extended the assignment by another year.<sup>57</sup> No evidence was given of that being in writing but that is of no present concern for the initial assignment still has some further time to run.
- [56] An author's copyright is personal property which, pursuant to s 196 of the Act may be assigned to another.
- [57] Section 196 of the Act permits an assignment as here to be for only part of the (at least 70 year<sup>58</sup>) period during which copyright subsists. Section 196(3) of the Act requires that an assignment of copyright must be "in writing signed by or on behalf of the assignor". It was here.
- [58] The assignment appears to have been an effective assignment within the meaning of the Act. However the defendants submit that even if effective in law the assignment is of no relevant effect in the circumstances of the present case. That is supposedly because by the time of the assignment on 20 August PDB had already produced plans, which, if the plaintiff's case is correct, infringed copyright. A mere assignment of copyright does not carry with it a right to enforce any accrued rights of action for infringement prior to the effective point in time of the assignment.<sup>59</sup> In effect the defendants say the plaintiff's case must fail because he does not have the standing to sue for an infringement that had occurred before the assignment.
- [59] Exhibit one contains plans purportedly by PDB bearing issue dates variously of 31 July 2013,<sup>60</sup> 5 August 2013,<sup>61</sup> and 8 August 2013.<sup>62</sup> However it also contains a group of plans bearing the typewritten issue dates of 5 or 8 August in addition to handwritten notations, certification stamps and, on each page, the date 17 January 2014 endorsed in handwriting next to an initial.<sup>63</sup> These Breden house plans are obviously founded upon work produced prior to the date of that certification however the additional endorsements upon them demonstrate that they were reproduced in their eventual form after the assignment.
- [60] That evidence of post-assignment reproduction dispenses with the defendants' temporal argument. The argument was academic in any event because even if it was correct there remained the obstacle to the defendants' case that the building of the Breden house, also said to be an infringing reproduction, occurred after the assignment.
- [61] Another argument advanced as to why the assignment was ineffective turned upon the above discussed argument about joint authorship. In short the defendants submitted that because the Skyring house plans were a work of joint authorship any assignment of copyright in them required the authority of all not merely one of the joint authors.

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<sup>56</sup> Ex 1 tab 45 p240.

<sup>57</sup> T1-16 L34.

<sup>58</sup> See s 33.

<sup>59</sup> *Taypar Pty Ltd v Santic* (1989) 21 FCR 485. Cf *Beloff v Pressdream Ltd & Anor* [1973] 1 All ER 241, 256.

<sup>60</sup> Ex 1 tab 50 pp245, 260, 262, 266.

<sup>61</sup> Ex 1 tab 50 pp247-253.

<sup>62</sup> Ex 1 tab 50 pp254-259, 268-270.

<sup>63</sup> Ex 1 tab 51 pp271-284.

That argument relied upon reasoning in the English case of *Powell v Head*.<sup>64</sup> It is unnecessary to determine whether the reasoning in that case is apt to the statutory framework of Australia's *Copyright Act*<sup>65</sup> given my conclusion above that the Skyring house plans were not a work of joint authorship.

### **The defendants press on regardless**

[62] Mr Coles contacted PDB and Mr Dormer and Mr Clark met with Mr Coles at his house on 6 September 2013. Mr Coles told them he had heard they had been engaged to build a copy of his house at The Sands. He told them he had purchased the copyright in his house and would do what he could to make sure a copy of his house was not built. Mr Coles testified of their response:

“Initially what they said was, well, there’s nothing you can do about it. But then after discussion they agreed. What I said to them specifically that I didn’t want was the façade to look the same: the full circle windows at the front, the dormers, the corbelling, the colours. And that I didn’t want the half circle windows that are on each side of the house. And that I wanted to see a copy of the plans that they were proposing so that I would approve them before they were to submit them for building ... They said that they would send me a copy of the plans.”<sup>66</sup>

[63] Mr Clark’s recollection was that Mr Coles indicated he did not care about the appearance of the house inside but was determined to prevent exterior duplication.<sup>67</sup> While Mr Coles would not concede that he was untroubled about internal replication it is obvious external replication was his material and motivating concern. While not in the same street the two houses are physically close to each other, about three houses away, and as Mr Coles explained, he can see the Bredens’ house from his front doorstep.<sup>68</sup> He did not want the Bredens’ house to be recognisable as a copy of his house.<sup>69</sup> He did not want someone being able to look at his house and the Bredens’ house “and say that they’re exactly the same house like a project house”.<sup>70</sup>

[64] Mr Clark at one stage of his testimony asserted he mentioned in his conversation with Mr Coles that there was already another very similar house near Mr Coles’ house.<sup>71</sup> This was not put to Mr Coles, nor was the existence of such a residence alluded to elsewhere in the case. It was not credible evidence.

[65] Mr Clark’s account of the conversation with Mr Coles did not mention any concession by he or Mr Dormer that they needed Mr Coles’ approval of the plans but he did confirm they agreed with Mr Coles when the plans were ready for submission they would bring the plans to Mr Coles to put his mind at rest.<sup>72</sup>

[66] In a letter dated 10 September Mr Coles’ solicitor wrote to PDB:

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<sup>64</sup> (1879) 12 Ch D 686, also see *Cescinsky v George Routledge & Sons Limited* [1916] 2 KB 325, 330.

<sup>65</sup> Cf, eg, *Prior v Lansdowne Press Pty Ltd* [1977] VR 65.

<sup>66</sup> T1-17 LL32-44.

<sup>67</sup> T2-13 L33 – T2-14 L17.

<sup>68</sup> T1-20 L20.

<sup>69</sup> T1-23 L14.

<sup>70</sup> T1-23 L25.

<sup>71</sup> T2-14 L1.

<sup>72</sup> T2-14 L10.

“My client advises me that he has had a meeting with you, the result of which is that prior to commencing any construction of a dwelling on Lot 23 on SP 161479 you will produce to him the plans therefor [sic] for his approval. My client instructs me to advise you that his approval will not be given unless Mr Skyring’s plan is modified to such an extent that the building constructed therefrom cannot be mistaken for his dwelling.”<sup>73</sup>

- [67] Mr Dormer and Mr Clark did not provide the plans to Mr Coles, despite Mr Coles twice emailing their website indicating he was waiting for the plans and twice leaving telephone messages for them.
- [68] Mr Clark testified he received a text from Mr Coles that indicated Mr Coles was away and requested the drawings to be scanned and emailed to Mr Coles. Mr Clark testified they decided to not send such a copy. He testified, most unconvincingly, that their preference was to see Mr Coles face to face and that he anticipated Mr Coles would be in touch when he returned or once the plans were submitted for body corporate approval if he did not like them. I infer the unattractive reality is that knowing they had assured Mr Coles they would provide him with their proposed plans they decided to go back on their word, taking a calculated commercial decision to press on without further reference to Mr Coles.
- [69] There is no direct evidence that the Bredens knew of Mr Coles’ concern, his acquisition of copyright and PDB’s decision to press on without further reference to Mr Coles. However I infer they must have known of and agreed with the commercial course taken. As much seems inevitable, particularly given their commercial connection with PDB as their builder and the absence of any assertion by them as defendants that they did not know.
- [70] Mr Coles was absent from Port Douglas between mid-September 2013 and March 2014. On his return he saw the slab for construction at lot 23 had been laid. He observed the slab and its plumbing fittings involved a layout the same as his house. By letter dated 1 April 2014 he wrote to Mr Dormer and Mr Clark:
- “At our meeting in September last year you agreed to produce the plans for the house you are building in The Sands for my approval. The house proposed was a copy of my house, the plans of which I own copyright.  
As yet I have received no such plans.  
I note the construction has started and ask that you contact me within 7 days to arrange a time to show me the plans for the façade for my approval. ...”<sup>74</sup>
- [71] PDB did not respond to that letter either. On 24 April 2014 Mr Coles’ solicitor wrote to Mr Dormer and Mr Clark alleging that they were constructing an identical dwelling and requesting inter alia the production to Mr Coles of the plans and specifications for the dwelling they were constructing at lot 23 and that they cease the construction.<sup>75</sup> The letter unequivocally foreshadowed the commencement of these proceedings if its requests were not met.

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<sup>73</sup> Ex 9.

<sup>74</sup> Ex 10.

<sup>75</sup> Ex 11.

- [72] The defendants' pattern of unresponsiveness continued and the plaintiff filed its claim on 29 April 2014. The defendants still pressed on undeterred. By the time of the hearing construction of the exterior was finished<sup>76</sup> and work was at the final fix stage.

### **Breden house plans an infringement of copyright?**

- [73] The three works in the form of the Breden house plans, the Skyring house plans and the Spicer rough ideas email<sup>77</sup> were the subject of close scrutiny by the expert witnesses of each side. There were some academic and irrelevant disagreements between them stemming from their perceptions of copyright law. Nonetheless they were in agreement in their individual reports and their joint report that the Breden house plans are "a substantial copy" of the Skyring house plans.<sup>78</sup>
- [74] The extent of the copying is particularly obvious on perusal of Mr Gleeson's report which provides visual comparison overlays of the various works. Hard copies of some comparison overlays were tendered<sup>79</sup> although perusal of the comparison imagery accessible in the digital copy of the report<sup>80</sup> makes for more comprehensible reference. The visual comparison overlays demonstrate much more effectively than words that there are extensive and significant points of replication and similarity as between the Breden and Skyring house plans.
- [75] The elements of similarity are not merely found in the repeated coincidence of the lineal and spatial forms on the plans but also in identical notations upon the plans. In one instance identified by Mr Gleeson an error in the Skyring house plans about window height was replicated in the Breden house plans.<sup>81</sup> In another a reference to the location of a bathroom window in the Skyring house plans was replicated in the Breden house plans notwithstanding that a variation in the layout of the Breden house, necessitated by the nature of the block, meant the window should have been on the opposite side.<sup>82</sup> In short it is obvious copying on a substantial scale must have occurred.
- [76] The elements of similarity are so pervasive as to compel the conclusion that the Breden house plans are a reproduction of a substantial part of the Skyring house plans.
- [77] To remove doubt, the visual comparison overlays also demonstrate very clearly that the Breden house plans are not reproductions of the Spicer rough ideas email. A comparison of all three works by reference to hard copies of exhibits even without the aid of the visual overlay readily shows the Breden and Skyring house plans share many points of similarity not present in the Spicer rough idea email. For example common features in the Breden and Skyring house plans which are not present in the Spicer rough ideas email include the vanity unit recess in the master en suite, two rather than three verandah posts, a single rather than double swing doors into the living/dining room near the kitchen, a window in the living/dining room, a 900mm

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<sup>76</sup> T1-20 L24.

<sup>77</sup> It appears that Ex 1 tab 2 – the relevance of which has not been established - was included within their consideration but that could only have assisted the defendants' position, not prejudiced it.

<sup>78</sup> Ex 2 [44], Ex 5 p27, Ex 6 [6.1].

<sup>79</sup> Ex 7.

<sup>80</sup> Ex 3.

<sup>81</sup> Ex 2 [28(c)].

<sup>82</sup> Ex 2 [36(c)].

rather than 796mm wide kitchen bench, an island kitchen bench without sink and a rectangular rather than galley shaped WC near the stairs.<sup>83</sup>

- [78] Dr Fantin emphasised there was similarity in overall design intent as between the Breden house plans and the Spicer rough idea email but such a concept is not to the point. It does not mean the Breden house plans were not, as I have found, a reproduction of a substantial part of the Skyring house plans.

### **Construction of Breden house an infringement of copyright?**

- [79] The evidence of the above infringement of copyright implicitly proves that the construction of the Breden house was also an infringement of copyright. The inference that the builders would have built the house from the plans certified for that purpose is an obvious one. Mr Clark gave direct evidence that is what did occur.<sup>84</sup>

- [80] While not essential there is also some evidence of the apparent duplication in exterior appearance of the Bredens' constructed residence and the Coles' residence, a residence obviously constructed using the Skyring house plans. Mr Coles explained every time he walks out of his house he can see its uniqueness has been ruined.<sup>85</sup> Dr Fantin has seen both dwellings and her report included some photographs of obvious similarities between them. She observed:

“Both dwellings look very similar from the street in that each is two storeys in height, constructed of rendered concrete block with a stone-look edge trim, and contains arched windows in the same arrangement and proportion to each other.”<sup>86</sup>

- [81] Further to those observations it is noteworthy that the exterior of each residence also has the same arrangement of circular windows and the same arrangement of dormer roofs.

- [82] This provides further support for the undisputed evidence that the Breden residence was constructed from the Breden house plans. It follows the Breden house was also constructed in infringement of copyright. It was built from plans which were a reproduction of a substantial part of the Skyring house plans and therefore the Breden house is also a reproduction of a substantial part of the Skyring house plans.<sup>87</sup>

### **Remedies?**

- [83] The Act confers on owners of copyright the right to bring an action for infringement of copyright under s 115 and an action for conversion under s 116. However s 116(1C) provides that relief for conversion should not be granted “if the relief that the court has granted or proposes to grant under section 115 is, in the opinion of the court, a sufficient remedy”. My findings above as to the genesis of the Breden house plans demonstrate there was a conversion of the Skyring house plans. However, I would not grant relief for conversion because the relief allowed for by s 115 for infringement of copyright will provide sufficient remedy in this case. The more challenging issue is what form or forms of relief ought be granted under s 115.

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<sup>83</sup> Ex 1 pp7, 206, 252.

<sup>84</sup> T2-33 L40, T2-34 L39.

<sup>85</sup> T1-22 L24.

<sup>86</sup> Ex 5 p18.

<sup>87</sup> See ss 14 and 21(3) *Copyright Act* (1968) Cth.

- [84] The relief a court may grant for infringement of copyright pursuant to s 115(2) “includes an injunction ... and either damages or an account of profits”. Section 115(4) provides the court may award such additional damages as it considers appropriate in the circumstances having regard to considerations such as the flagrancy of the infringement, the need for deterrence and the conduct of the defendant after the infringement or after being informed of the infringement. The latter consideration is important in that even if the Bredens were not at first aware of what PDB had done in converting the Skyring house plans they had to have become aware of it when the claim was filed and thereafter did not stop or vary the construction of their home.
- [85] The effect of s 115(2) is that the remedies of damages and an account of profits are alternatives. The plaintiff must elect between those remedies. As is their right the plaintiffs have delayed their election as to damages or an account of profits in respect of the first and second defendants pending my decision as to whether an injunction will be granted. The plaintiff elected against an account of profits as regards the third defendant, seemingly contemplating I could proceed to assess the question of damages in respect of them. However any such assessment must involve consideration of to what extent damages and additional damages, if appropriate, ought be measured separately or jointly in respect of all defendants. Further if an injunction is granted it may, if promptly complied with, significantly reduce the proper quantum of any damages and additional damages orders.
- [86] A proper assessment of damages is not practicable until I determine whether an injunction will be granted. The appropriate course is to make that determination, await the plaintiff’s election and hear further submissions in the light of that determination and election.
- [87] In an oft cited passage as to whether damages ought be preferred to an injunction AL Smith LJ observed in *Shelfer v City of London Electric Lighting Co.*<sup>88</sup>
- “In my opinion, it may be stated as a good working rule that – (i) If the injury to the plaintiff’s legal rights is small, (ii) And is one which is capable of being estimated in money, (iii) And is one which can be adequately compensate by a small money payment, (iv) And the case is one in which it would be oppressive to the defendant to grant an injunction:- then damages in substitution for an injunction may be given.”
- [88] In Australia under the *Copyright Act* an injunction and damages are not mutually exclusive remedies but nonetheless the above considerations provide useful guidance in determining whether an injunction ought be granted in a case like the present.
- [89] There is obvious imprecision involved in quantifying the damage done to the plaintiff. The defendants submit the proper measure of damages is the diminution in value or the depreciation in value of the copyright by reason of the infringement. They placed reliance upon an observation to that effect by Spender J in *Taypar Pty Ltd v Santic*.<sup>89</sup> However that observation was obiter, his Honour having found against the plaintiff on the question of liability, and it involved no conclusion that the diminution of value or depreciation in value of the copyright is the sole potential measure for damages in a case such as the present.

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<sup>88</sup> [1895] 1 Ch 287, 322-323.

<sup>89</sup> (1989) 21 FCR 485, 494.

- [90] The plaintiff contends the damage occasioned includes the potential diminution in property value occasioned by the loss of his home's uniqueness but it will be at best difficult to make any informed assessment about that. This is not the sort of case in which damages can readily be calculated so as to compensate or serve the purpose of restoring the plaintiff to the position he would have been in but for the infringement.
- [91] On one view the assessment of additional damages is likely to be simpler. Having regard to the defendants' conduct in knowingly continuing with construction of a nearly identical residence and taking the commercial risk of not altering the external indicia of replication, it ought not be assumed the additional damages absent an injunction would be small.
- [92] This highlights the real vice in the infringement. It resulted in the very outcome the plaintiff took lawful steps to prevent. Is it too late to change that outcome by an injunction compelling the removal of the external indicia of replication?
- [93] At first blush the granting of an injunction might seem oppressive given the Bredens' house has already been built. But the defendants chose to press on and build the house after being warned of the consequences. Indeed they continued to build well knowing this action was afoot.
- [94] In *Jaggard v Sawyer*<sup>90</sup> Millett LJ observed:  
"The outcome of any particular case usually turns on the question, would it in all the circumstances be oppressive to the defendant to grant the injunction to which the plaintiff is prima facie entitled? Most of the cases in which the injunction has been refused are cases where the plaintiff has sought a mandatory injunction to pull down a building which infringes his right to like or which has been built in breach of a restricted covenant. In such cases the court is faced with a fait accompli. The jurisdiction to grant a mandatory injunction in those circumstances cannot be doubted, but to grant it would subject the defendant to a loss out of all proportion to that which would be suffered by the plaintiff if it were refused, and would indeed deliver him to the plaintiff bound hand and foot to be subjected to any extortionate demands the plaintiff might make."
- [95] However Millett LJ also went on to observe that the nature of the defendant's conduct in proceeding with knowledge of the plaintiff's asserted rights is a relevant consideration:  
"In considering whether the grant of an injunction would be oppressive to the defendant, all the circumstances of the case have to be considered. At one extreme, the defendant may have acted openly and in good faith and in ignorance of the plaintiff's rights, and thereby inadvertently placed himself in a position where the grant of an injunction would either force him to yield to the plaintiff's extortionate demands or expose him to substantial loss. At the other extreme, the defendant may have acted with his eyes open and in full knowledge that he was invading the plaintiff's rights, and hurried on his work in

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<sup>90</sup> [1995] 1 WLR 269, 288.

the hope that by presenting the court with a *fait accompli* he could compel the plaintiff to accept monetary compensation.”<sup>91</sup>

- [96] The present case is closer to the latter extreme. I would not categorise injunctive intervention as oppressive in circumstances where the adverse consequence for the defendants of that intervention is a consequence they had to know they were risking in acting as they did. They could have varied the planned construction by not including the external indicia of replication but chose not to do so.
- [97] In the present case restoring the plaintiff to the position he largely would have been in but for the infringement does not require the demolition of the Bredens’ home. It was not the presence of a home on the Bredens’ lot which was the problem the plaintiff sought to avoid by pursuing his lawful rights. Rather it was the prospect now arrived of the Breden house having such an identical exterior to the Coles house as to appear to be the same as it.
- [98] To the passing observer it is particularly the presence on the house’s publicly visible exterior of arched and round windows, stone edge trim on the corners and dormer roofs which now makes the Bredens’ house appear identical to the Coles house. It is true the general similarity in size or scale exacerbates the appearance of replication. Removal of the abovementioned elements would however eliminate or significantly reduce the appearance of replication without substantial interference with the structural integrity of the residence.
- [99] New windows and window frames could be installed so as to vary the arched windows and the round windows to rectangular or square shapes. This may require some associated cutting away and installing of block work and or other filling as well as rendering. The stone edge trim corners on the exterior could be ground or cut back to flush with the wall and the corners rendered in the same style as the rest of the exterior walls so as to remove or entirely conceal the edge trims. As with the windows some repainting may be needed. The dormer roofs, which serve no functional purpose,<sup>92</sup> could be removed and the affected area re-roofed consistently with the appearance of the rest of the roof.
- [100] No evidence has been led of the cost of such changes. However, given the overall cost of the home, the cost of such works if ordered by me would in a relative sense be minor and not oppressive in the circumstances of this case. I will order such works.
- [101] The injunctive relief I propose ordering does not coincide perfectly with the injunctive relief sought in this claim which was:  
 “An injunction to restrain the defendants ... from continuing construction of a house on lot 23 The Sands, Port Douglas ... based on the plans on which the house at lot 16 The Sands was based. ...”
- [102] The plaintiff submits he acted promptly upon discovering the infringement and he ought not lose his entitlement to injunctive relief merely by reason that the constructions of the Bredens’ house has in the interim continued close to completion. It cannot be said that the right to injunctive relief is invariably lost merely because events have progressed to a point not specifically contemplated by the form of the

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<sup>91</sup> Ibid 288,289.

<sup>92</sup> They were only introduced to the Skyring house plans because the body corporate’s review panel wanted them as a feature – T2-7 L15.

injunction initially applied for. That progression may give rise to a situation where it would be too oppressive to grant any injunctive relief but it could not logically eliminate a potential entitlement to an injunction in a form apt to the point to which the case has progressed since the commencement of proceedings.

- [103] The defendants do not submit the right to injunctive relief has expired merely because of the advanced state of the construction but rather refer to the draconian consequences which would result were an injunction granted. That is apparently a reference to an order requiring the house to be pulled down but as explained above the injunctive relief I consider apt does not have such extreme consequences.
- [104] The plaintiff has made good his entitlement to an injunction, albeit not in the form contemplated when proceedings began.
- [105] Finally the plaintiff seeks an order for delivery up of all infringing copies of the plans as are in the defendants' possession, power, custody or control. Such an order may appear uncontroversial given the plaintiff has prevailed but it has limited utility in the present circumstances given the house has been built and the case involves no suggestion the plans are likely to be used for repeat infringing construction.
- [106] Moreover it may here occasion disadvantage out of all proportion to its limited utility. The house has been built. I have not ordered its demolition. It is foreseeable the Bredens, their builders PDB and possibly other trades persons may need to perform future work on the house beyond the corrective work contemplated by the injunction. To perform that work effectively and safely they may need to refer to the house plans. The disadvantage of not being able to do so outweighs the limited utility of the order sought that I decline to make the order.

### **Conclusion**

- [107] Judgment should be given for the plaintiff and an injunction granted.
- [108] To avoid confusion and to ensure orderly compliance with the injunction I should allow the parties an opportunity to be heard as to any appropriate variation or addition to its terms. This is not an invitation to re-litigate the appropriateness of ordering the injunction but is intended to cater for developments or practicalities which if known of by me would likely have caused me to craft the order differently.
- [109] It will also be necessary to hear the parties as to the further conduct of the proceedings in respect of the making of the election and the determination of damages or the taking of an account and as to costs.

### **Orders**

- [110] My orders are:
1. Judgment for the plaintiff.
  2. The defendants shall promptly take the following action in respect of the following external features of the third defendants' house at lot 23 The Sands Estate Port Douglas:
    - (a) Feature: Dormer roofs  
Action: Remove the dormer roofs.
    - (b) Feature: Arched and circular windows at the front of the house

- and such other exterior arched and circular windows as are ordinarily visible from public paths or streets.
- Action: Remove and replace with rectangular or square windows and any external remnant space, appearance or outline of the arched and circular window shapes be filled and concealed by rendering.
- (c) Feature: Stone edge trim corners at the front of the house and such other stone edge trim corners as are ordinarily visible from public paths or streets.
- Action: Grind, cut away or remove the areas of stone edge trim to the extent necessary to render those areas flush with the walls and fill and conceal by render any remnant appearance or outline of the stone edge trim.
3. I will hear the parties at 10 am on 28 August 2015 as to:
- (a) any appropriate variations or additions to order 2;
  - (b) the plaintiff's election as to damages or an account;
  - (c) directions to advance the final determination of damages or the taking of an account, as the case may be, and costs.