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Legal protection of databases: Jamaican litigants test the bounds of the Copyright Act

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Jamaica

Legal protection of databases: Jamaican litigants test the bounds of the Copyright Act

In early 2011 Jamaica's Supreme Court issued a critical ruling on the Copyright Act which directly impacts on the telecommunications industry, as well as developers and users of databases in Jamaica.

Database protection has come a long way internationally since the 1995 World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). The agreement's framers sought to make it explicit that only databases that, by reason of the selection and arrangement of their contents, constitute intellectual creations can qualify for copyright protection; such protection is independent of any protection that may exist over the database's contents.

Since then, several jurisdictions – in particular the United Kingdom and other members of the European Union – have effectively created a new database right through the implementation of the EU Database Directive (1996). This protects databases which would be disqualified from copyright protection by virtue of the TRIPs standard.

Although Jamaica's prevailing Copyright Act 1993 – which repealed the century-old Imperial Copyright Act 1911 insofar as it applied in Jamaica – was modelled on the copyright provisions of the UK Copyright Designs and Patents Act 1988, it has not kept pace with the numerous revisions that the UK act has undergone and does not recognise a *sui generis* database right. However, its only substantive amendment in 1999 to implement the TRIPs obligations recently took centre stage in a legal battle that sought to determine whether copyright extends to factual databases.

The claims

In May 2005 former monopoly telecommunications provider Cable and Wireless Jamaica Ltd (C&WJ), which held sole access to its directory services and products database, sought a declaration from the Supreme Court that it was the owner of the copyright and related rights in its customer and directory database/listings. The move was precipitated by the introduction of

competition in Jamaica's telecommunications market and steps taken by the regulator, the Office of Utilities Regulation, to liberalise access to related directory services and products which included C&WJ's directory database. C&WJ claimed that such access would infringe its copyright and related rights in the database and information.

One of two new entrants in the mobile telecommunications market, Mossel (Jamaica) Limited (trading as Digicel), challenged C&WJ's claim and asked the court to dismiss it for uncertainty of subject matter and uncertainty of the rights sought by the claimant. It also sought a number of alternative orders – namely, that the court should find that the Copyright Act did not accord protection by way of copyright or related rights to facts or data comprised in the claimant's directory database/listings, and/or that the claimant's customer and directory database/listings did not qualify as original intellectual creations and as such were not protected by the Copyright Act. Finally, in the event that the court found that any copyright existed in the customer and directory database/listings, Digicel sought a declaration that such protection did not extend to the factual information or data comprised therein, and that accordingly, access to that information by Digicel ought not to be impeded by virtue of the Copyright Act. The other new entrant, Oceanic Digital Jamaica Limited (then trading as MiPhone), joined with Digicel in its challenge to C&WJ's claim.

The arguments

In its claim C&WJ referred to different products comprising its customer and directory database listings, including the first telephone directory made available to the public in 1927 comprising:

- the White Pages, embodying subscriber information;
- the Yellow Pages listings; and
- the continuous updating of the first directory, including the rearrangement of the data in 1987 and 2004/2005.

C&WJ argued that all of these products were protected by copyright, relying on, among other things, its financial investment in their development.

However, Digicel argued that the subject matter “customer and directory/database listings” over which C&WJ sought to claim ownership rights was too vague as it encompassed a number of outputs, including factual information, and could include proprietary material belonging to third parties. However, its strongest arguments were that the factual subscriber information – such as names, addresses and telephone numbers – included in the claimant’s database would not attract copyright, and that the database did not constitute an original intellectual creation based on the Copyright Act. If the court were to grant the declaration sought by C&WJ that copyright vested in its customer and directory database/listings, including continual updates, Digicel argued that “the practical effect... would be the grant... of perpetual proprietary rights in facts and other non-copyrightable material”. This would also be “inimical to public interest”.

No copyright in ideas

Digicel relied on Section 6(8) of the Copyright Act, which provides that “Copyright protection does not extend to an idea, concept, process, principle, procedure, system or discovery or things of a similar nature”, to support its assertion that a person who uncovers facts or makes a discovery cannot claim authorship of the facts so uncovered. Comparisons were drawn between Section 6(8) and an equivalent provision in the US Copyright Act 1976 (§ 102(b)) which excludes ideas, procedures, processes systems, methods of operation, concepts, principles and discoveries from copyright protection. This provided a basis for Digicel to rely on US cases such as *Feist Publications Inc v Rural Telephone Service Co* (1991), the celebrated US authority that no copyright exists in a White Pages telephone directory, and *Harper & Row, Publishers, Inc v Nation Enterprises* (1985). In *Feist v Rural* it was stated that copyright is not to be “used as a tool by which a compilation author may keep others from using the facts or data he or she has collected”, while it was reiterated in *Harper & Row* that no author may copyright facts or ideas.

These cases were contrasted with the approach taken by the English High Court in *Waterlow Directories Ltd v Reed Information Services* (1992), relied on by C&WJ. The court in that case held that copying entries in a directory infringed copyright. However, Digicel submitted that *Waterlow Directories* pre-dated the 1998 amendment of the UK copyright provisions, which expressly excludes ideas and mere data from copyright.

Copyrightable databases

In considering whether the database itself qualified for copyright protection, the court was referred to Article 10.2 of TRIPs, which outlines that copyright protection is to be afforded to: “compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself.”

The 1999 amendment to the Copyright Act provides in Section 2 that: “A literary work includes ‘a compilation’ which means a collection of works, data or other material, whether in machine readable or other form, which constitutes an intellectual creation by reason of the selection or arrangement of the works, data or other material comprised in it.” Section 3 (A) goes on to limit protection to the compilation itself by providing that: “Copyright subsisting in a literary work that is a compilation does not extend to any works, data or other material comprised in the compilation and does not affect any copyright which may exist in such works, data or other material.”

Digicel argued that Section 6 of the Copyright Act outlines that copyright may subsist in ‘original literary works’, and that ‘original literary’ has been interpreted as being a composite term in that neither can qualify for protection standing alone. It was submitted that it would therefore follow that a compilation of data would qualify for copyright protection under the Copyright Act only where, by virtue of the selection and arrangement of its contents, it constituted an original intellectual creation. Where copyright protection is found to exist by virtue of this criterion, such protection will be independent of the actual data found in the compilation.

C&WJ countered that the words “intellectual creation” ought to be interpreted as meaning that the compilation must be original – that is, that it is the author’s own creation and not copied from someone else. In submitting that the labour, skill and capital it employed in canvassing, selecting and arranging raw material would justify copyright protection in the output, C&WJ relied on *MacMillan and Co Limited v Cooper* (1923), where Lord Atkinson opined that: “To secure copyright for this product it is necessary that labour, skill and capital should be expended sufficiently to impact to the product some quality or character which the raw material did not possess, and which differentiates the product from the raw material.”

C&WJ also referred to the 1868 case of *Morris v Ashbee*, where copyright in directories was found to

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exist. In that case Vice Chancellor Giffard stated that: *the Plaintiff incurred the labour and expense first of getting the necessary information for the arrangement and compilation of the names as they stood in her directory, and then of marking the actual compilation and arrangement,... that in a case such as this no one has a right to take the results of the labour and expense incurred by another for the purpose of a rival publication, and thereby save himself the expense and labour of working out and arriving at those results by some independent road. If this was not so, there would be practically no copyright in such a work as a directory.*

Digicel countered that C&WJ was attempting to claim and import a right – namely the *sui generis* database right – which is not conferred under the Copyright Act or the laws of Jamaica, and that, moreover, the cases relied on by C&WJ pre-dated the TRIPs Agreement and the 1998 amendments to the UK copyright provisions.

The nature of the copyright in a database, it was argued, lies in the selection or arrangement of its contents and not in the nature of the contents themselves. It therefore follows that copyright in databases under the TRIPs definition, as implemented in Jamaican and UK law, is infringed where the selection or arrangement is copied, not where the content itself is copied. The post-TRIPs scenario has therefore impacted on previous compilation cases, particularly in the United Kingdom.

Digicel sought to persuade the judge to consider cases from other jurisdictions, such as the United States and Canada, and referred to the different approaches to the protection of databases which prevailed prior to TRIPs, highlighting distinctions between:

- jurisdictions which deemed non-creative or factual databases (also termed ‘sweat of the brow’ databases) copyrightable by virtue of the level of effort or investment in their creation; and
- those which followed the so-called ‘creativity school’ by conferring copyright only on databases that were original and creative.

The US case of *Feist v Rural* followed the creativity school and consequently works resulting out of “effort”, “industry” or “sweat of the brow” only will not qualify for copyright protection. Digicel also relied on the 1997 Canadian case of *Tele-Direct Publications v American Business Information*, where the Court of Appeal upheld the lower court’s finding that there was no copyright in the information contained in a Yellow Pages directory as there was “not a sufficient degree of originality in the sub-compilation”. There was only “a minimal degree of skill, judgment or labour in its overall arrangement which was insufficient to support a claim of originality in the compilation” so as to warrant copyright protection.

Digicel went on to argue that TRIPs laid out a higher originality test for copyright protection in databases and had the effect of nullifying the ‘sweat of the brow’ test as a definitive criterion, and that consequently factual databases which are purely the product of sweat of the brow efforts were no longer protected by copyright.

The judgment

Justice Rattray, who heard the matter, found merit in the submissions of counsel for Digicel and dismissed C&WJ’s application, stating as follows:

I do not accept the submissions of Counsel for C&WJ that the words ‘intellectual creation’ ought to be interpreted as meaning that the compilation must be original, that is, that it is the author’s own creation, not copied from someone else. That in my view is too restrictive an approach to take. True it is that the compilation cannot belong to someone else or be copied from someone else. However, copyright subsists in original literary works. Literary works include a compilation, which is a collection of data, works or material which constitute an intellectual creation by reason of the selection or arrangement of the contents of the compilation. If the phrase ‘intellectual creation’ is taken to mean that the compilation must be original, the only prerequisite for a compilation to be afforded copyright protection would be that the work in question ought not to be copied from someone else. Apart from originality in the selection or arrangement of the works

contained in the compilation there must also be an element of intellectual creativity in that selection or arrangement for the compilation... to be entitled to copyright protection under the Act.

The judge went on to state that: “I am further satisfied that in an instance where copyright subsists in such a compilation, the protection afforded by that copyright does not extend to the actual contents of the compilation.”

The court thus granted a declaration that the Copyright Act did not accord by way of copyright or

related rights to facts or data comprised in the claimant’s directory database/listing or at all, and that the claimant’s customer and directory database/listings did not qualify as original intellectual creations and as such were not protected by the Copyright Act.

The ruling, which was handed down almost six years after the hearing – while not yet affirmed by an appellate court, having been appealed by C&WJ – should give pause to those who are heavy on investment but lacking in creativity in their development of databases in Jamaica.



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