

JAMAICA

IN THE COURT OF APPEAL

SUPREME COURT CIVIL APPEAL NO 16/2011

BEFORE: THE HON MR JUSTICE PANTON P  
THE HON MR JUSTICE DUKHARAN JA  
THE HON MR JUSTICE HIBBERT JA (AG)

BETWEEN	CABLE & WIRELESS JAMAICA LIMITED	APPELLANT
AND	MOSSELL (JAMAICA) LIMITED (T/A DIGICEL)	1 <sup>ST</sup> RESPONDENT
AND	OCEANIC DIGITAL JAMAICA LIMITED	2 <sup>ND</sup> RESPONDENT

**Mrs Sandra Minott-Phillips and Mrs Alexis Robinson instructed by Miss Hilary Reid of Myers Fletcher & Gordon for the appellant**

**Paul Beswick and Christopher Dunkley instructed by Ballantyne Beswick & Co and Richard Fraser for the first respondent**

**Harold Brady instructed by Brady & Co for the second respondent**

**25, 26, 27 October 2011; 20 December 2013 and 11 April 2014**

**PANTON P**

[1] This appeal was aimed at reversing the judgment of Rattray J and substituting therefor declarations that:

- a) The appellant owns the copyright and all related rights in its customer and directory database/listings;

- b) The appellant's customer and directory database/listings qualify as original intellectual creations, protected by the Copyright Act; and
- c) The respondents are not entitled to copy the information in the appellant's directory database/listings.

However, on 20 December 2013, we dismissed the appeal, with costs to the respondents, and affirmed the judgment of Rattray J with a promise to provide our reasons in writing. These are the promised reasons of the court.

### **The claim by Cable & Wireless**

[2] By an amended fixed date claim form, dated 3 May 2005 and filed on 11 January 2006, the appellant (Cable & Wireless) sought a declaration that it "owns the copyright and all related rights in its customer and directory database/listings". It listed several grounds as the basis for the granting of this declaration. On 17 February 2006, the first respondent (Digicel) entered appearance, claiming to be a party affected. On 6 March 2006, Sinclair-Haynes J ordered that service be effected on Centennial Digital Jamaica Limited. On 22 March 2006, service was acknowledged by Oceanic Digital Jamaica Limited. Sinclair-Haynes J also ordered that evidence in the proceedings was to be by affidavit.

### **Digicel's application**

[3] On 26 April 2006, Digicel filed a notice of application for court orders that Cable & Wireless' claim be dismissed for uncertainty of the subject matter and rights being sought. Alternatively, Digicel sought declarations that the customer and directory database/listings did not qualify as original intellectual creations and that the facts or data in the database were not protected by way of copyright, and that the Copyright Act did not apply to the situation.

## **The judge's decision**

[4] When the matter came before Rattray J for trial, he had two affidavits for consideration – one from Ms Nicole Bertram, Directory Publishing and Internet Administrator of Cable & Wireless, the other from Ms Stacey Mitchell, Digicel's Legal Counsel. Having read the affidavits and considered the submissions made by the attorneys-at-law for the parties, the learned judge refused Cable & Wireless' application and granted declarations that:

- a) The Copyright Act does not accord by way of copyright or related rights to facts or data comprised in the claimant's directory database/listings or at all; and
- b) Cable & Wireless' customer and directory database/listings do not qualify as original intellectual creations and as such are not protected by the Copyright Act.

[5] In arriving at his decision, it is clear that the learned judge examined the evidence thoroughly. He then reasoned that "the starting point in this matter" was the Copyright Act. He examined section 6 and the relevant definitions in section 2, and duly noted that there had been an amendment to the Act in 1999, the effect of which, he said, was to extend copyright protection to compilations such as databases. The learned judge also considered the English cases *University of London Press, Limited v University Tutorial Press, Limited* [1916] 2 Ch. D. 601 and *Macmillan and Co Limited v Cooper* [1923] 40 TLR 186. He felt that some assistance could also be had from considering the American case *Feist Publications Inc v Rural Telephone Service Co* 499 US 340 (1991) and the Canadian case *Tele-Direct (Publications) Inc v American Business Information, Inc* [1997] 76 CPE (3d) 296 FC Canada.

[6] Having considered those authorities and the legislation, the learned judge said he was of the opinion that it was the satisfaction of the requirement of original intellectual creation in the

selection or arrangement of a compilation that gave rise to copyright protection. Accordingly, he said, in this jurisdiction "it is the creative school of thought which ought to be applied when considering whether or not to confer copyright protection in a compilation". He found that the American and Canadian cases cited to him were of more relevance to the issue and particular circumstances before him, and indicated that he was prepared to be guided by them in his determination of the matter.

[7] In the instant case, the judge concluded that copyright did not extend to the actual facts, mere data or factual information, which formed the substance of the customer information system in question. The burning issue in the case, he said, was whether Cable & Wireless' customer and directory database/listings qualify for copyright protection. The answer, he said, depended on "whether the compilation constituted original intellectual creation by reason of the selection or arrangement of its contents". The evidence, he said, disclosed that there was a mere collection of factual information which did not attract copyright protection. He saw no originality or intellectual creativity in the situation. Consequently, he said, he was not satisfied that Cable & Wireless had made out a case for copyright protection with respect to the database or the factual information contained therein.

### **The grounds of appeal**

[8] Cable & Wireless relied on the following grounds of appeal:

- "i. The learned judge erred in law and/or misdirected himself as to the meaning to be given to the phrase 'intellectual creation' as used in the Copyright Act for the following reasons:
  - a. Having acknowledged that the term 'original' does not require original or inventive thought, the learned judge failed to recognize the distinction between an 'intellectual creation' and a requirement for 'intellectual creativity' and therefore fell into error by

requiring originality of ideas in relation to the selection and arrangement of the information. It is a well-known principle and express provision of the Jamaican copyright law that it is not concerned with the originality of ideas, concepts or processes. It would therefore be contrary to this principle to require originality in the method of selection or arrangement as a prerequisite for copyright protection.

- b. Having misconstrued the reference to 'intellectual creation' the learned judge fell into error in trying to assess the 'sufficiency of the skill and judgment' employed by the Appellant without recognizing that the assessment of the skill and judgment is only so as to determine whether it has resulted in imparting to the final product a quality or character which as a result of the selection or arrangement of the material is different in character from the raw material.
  - c. Further, the learned judge erred in finding that the focus was to be on 'originality and intellectual creativity applied in the selection or arrangement'. There was no requirement that the method of arranging the information needed to be novel or new, the focus ought to have been on the character of the final product having been ordered in the manner selected by the Appellant into its directory/database and not on any question of originality or creativity.
- ii. The learned judge fell into error in finding that because no copyright protection can be given to facts that no copyright protection can be extended to the Appellant's database. The Appellant's Customer Information System is itself a compilation in electronic form which constitutes an intellectual creation by reason of the way in which the information contained in that database was selected and arranged and is therefore also entitled to copyright protection.

- iii. The learned judge wrongly applied authorities from the USA and Canadian jurisdictions which do not embrace the concept of 'intellectual creation' as used in the Jamaican Copyright Act and were therefore irrelevant to the proper interpretation and application of the Jamaican legislation. The learned judge ought to have found as was done in the UK, that the amendments to specifically recognize compilations did not alter the state of the then existing law and consequently the use of the phrase 'intellectual creation' means 'original' that is 'not copied from another'. Consequently, there being no dispute that the database/listing was not copied from any other person and involved a process of selection and arrangement was therefore an intellectual creation by reason of the selection or arrangement of the data and therefore copyright protection extended to both the directory listing and the electronic database in which the listing was stored.
- iv. The learned trial judge erred in disaggregating the compilations."

### **The evidence**

[9] Cable & Wireless was formerly the Telephone Company of Jamaica Limited. Before then, it was the Jamaica Telephone Company Limited. It provides telephone services to the people of Jamaica. In 1927, it was responsible for publishing Jamaica's first telephone directory. This publication is now an annual event, and the information relates to those customers who agree to the publication of their details. Since 1992, Cable & Wireless has established a central database called the Customer Information System. The database contains the names, telephone numbers and addresses of all the customers of Cable & Wireless, and the transactions relevant to each customer and each account.

[10] As time passed, Cable & Wireless segmentalized its publication, by classifying the entries into white pages, yellow pages, blue pages, residential directory and business directory. Cable & Wireless has also developed a directory assistance service which is provided from information

contained in the database, derived from the customer information system. The total directory product offering to subscribers consists of the directory assistance service, the telephone directory and the internet phone book. In creating its directory databases, Cable & Wireless asserts that it has invested considerable time, capital skill, labour and judgment.

[11] The evidence presented by Digicel was through Ms Stacey Mitchell, its legal counsel. She said in her affidavit that Digicel is a telecommunications and GSM mobile provider which has been operating in Jamaica since April 2001. Digicel claimed to have a vested interest in obtaining access to the factual contents of Cable & Wireless' database, namely the names, addresses and telephone numbers of Cable & Wireless' subscribers. This facility, she said, is generally available to other telecommunications providers in a liberalized market, it having been found to be in the public interest.

[12] Digicel claimed that the information in Cable & Wireless' directory was submitted by subscribers on their application for telephone service; so, at all material times, those subscribers were the originators of the factual information. Digicel also claimed that during the existence of the Jamaica Telephone Company, the numbers allocated to subscribers were allocated by the Government. Since the liberalization of the telecommunications industry in 2000, the numbers have been allocated by the Office of Utilities Regulation (OUR).

[13] Digicel stated that the selection of the listings in Cable & Wireless' directories is in accordance with universally accepted, commonplace standards of selection in the industry. Digicel exhibited extracts from the yellow pages of United Telecommunications Services Directory for Curacao to support this point.

## **The legislation**

[14] As would have been expected, given the grounds of appeal that were filed, counsel for the appellant concentrated their efforts on what they perceived to have been errors by the learned judge in his interpretation of certain provisions of the Copyright Act. Therefore, it is necessary at this stage to set out the provisions of section 6, so far as they are relevant to this case. That section relates to the category of works eligible for copyright. It reads in part:

“6. – (1) Copyright is a property right which, subject to the provisions of this section, may subsist in the following categories of work –

- a) original literary, dramatic, musical or artistic works;
- b) sound recordings, films, broadcasts or cable programme;
- c) typographical arrangements of published editions,

and copyright may subsist in a work irrespective of its quality or the purpose for which it was created.

(2) A literary, dramatic or musical work shall not be eligible for copyright protection unless it is recorded in writing or otherwise; and any reference in this Act to the time at which a work is made is a reference to the time at which it is so recorded.

(3) ...

(3A) 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.”

[15] Section 2 of the Act defines “literary work” as meaning -

“any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes –

- a) a written table or compilation;
- b) a computer programme,

and for the purpose of paragraph (a) of this definition, "compilation" means "a collection of works, data or other material, whether in machine-readable form or any other form, which constitutes an intellectual creation by reason of the selection or arrangement of the works, data or other material comprised in it".

### **The submissions**

[16] Mrs Sandra Minott-Phillips, for the appellant, submitted that Cable & Wireless had never claimed copyright to the raw data. The claim, she said, is in respect of "a listing". The law, she said, does not require the appellant to hand over its database to someone else. She complained that the learned judge preferred American authorities to the English and Canadian authorities, but, said she, he did not give an explanation for the preference. On this aspect, Mrs Alexis Robinson who appeared with Mrs Minott-Phillips submitted that Jamaica and England did not have the limitations that the United States of America had, as the American constitution had imported "creativity" in the requirements for copyright.

### **Ground one – The learned judge erred as to the meaning to be given to the term "intellectual creation" in the Copyright Act.**

[17] Mrs Minott-Phillips submitted that the learned judge either misunderstood or misinterpreted the legislation, by finding that there must be an element of "intellectual creativity" in the selection or arrangement of the compilation of the database or directory for there to be copyright protection. She contended that "intellectual creativity" was not a requirement. She submitted that the learned judge had confused "creation" with "creativity". She expressed the view that the judgment of the Supreme Court of Canada in ***CCH Canadian Ltd v Law Society of Upper Canada*** [2004] SCC 13, ably illustrates her point that "creativity" is an entirely different concept from "intellectual creation", and that "creativity" has

no place in the law of copyright. The issue, she said, was whether sufficient skill, industry or experience has been employed in the selection or arrangement of the facts that the final product taken as a whole constitutes a product which is original to the author. In the instant case, according to counsel, the appellant had directed significant skill, industry or experience in determining the subjects for classification and reviewing the contents of its yellow pages. There was also skill in arranging the data for the CIS database and the various "Pages" as well as the residential and business directories.

[18] An examination of the Canadian case (referred to in para. [17] by Mrs Minott-Phillips) shows that it was a consolidated appeal involving several publishers and the Law Society of Upper Canada. In the action, the publishers had sought a declaration of subsistence and ownership of copyright in specific works and a declaration that the Law Society had, through a reference and research library operated by them, infringed that copyright by reproducing a copy of each of the works. Among the issues that the court felt necessary to address was this: are the publishers' materials "original works" protected by copyright? In discussing the issues, McLachlin, CJ referred to the Copyright Act 1985 as amended and made some statements which will be set out later, in view of the attention that Mrs Minott-Phillips gave to that judgment.

[19] Mr Paul Beswick for Digicel submitted that there was no evidence that the work involved in the compilation required any great deal of intellectual work. The actual work done, he said, should have been placed before Rattray J for him to assess it. "Intellectual creativity", he said, "results in intellectual creation". The term "intellectual creation", he submitted, infers that compilations of data are to be measured by standards of intellect and creativity. He contended that there was nothing creative about the arrangement of the directory. Indeed, he said that the exhibits placed before the court demonstrated the lack of intellectual creativity. Mr Harold

Brady who appeared for the second respondent adopted these and the other submissions made by Mr Beswick.

**Ground two – The learned judge erred in finding that copyright cannot be extended to database seeing that no copyright protection is given to facts.**

[20] Mrs Minott-Phillips submitted that the directory database is a systematic arrangement of its customer information. This arrangement involves several determinations and the creation and use of different programmes and software. The database is an original literary work, involving the appellant's skill and experience. Hence, she said, the database is entitled to copyright protection.

[21] Mr Beswick, in answer, submitted that to hold that Cable & Wireless has copyright in its "customer and directory database/listings as pleaded" would be to grant the appellant a potential monopoly over material which is information in the public domain. Mr Beswick pointed out that Cable & Wireless, by its own admission in its claim, has stated that the white pages telephone directory was arranged in the only universally accepted mode of arrangement of the information of subscribers. Accordingly, he said, there can be no claims of originality in the selection or arrangement of the contents. As regards the submission that the database involves the application of skill, Mr Beswick submitted that the skill employed in implementing a standard arrangement of data is insufficient to render the arrangement original or the compilation an original work. He said that given that the arrangement of the data in the telephone directory was based on previously universally accepted standards (the white pages) and pre-existing classifications (yellow pages), it could be argued that there was very little skill if any and clearly no taste or judgment involved in the selection or arrangement of the contents.

[22] Finally, Mr Beswick submitted that even if copyright was found to exist in any of the component parts, such protection would not extend to the facts or data comprised therein. The

granting of copyright in the appellant's databases would mean the granting of perpetual proprietary right over facts which could also infringe on third party rights in respect of other component parts. The Copyright Act, he submitted, cannot be used to perpetuate a monopoly in facts.

**Ground three – The learned judge erred in applying authorities from the United States of America and Canada which do not embrace the concept of “intellectual creation” as used in the Copyright Act.**

[23] Mrs Minott-Phillips submitted that the legislation in the United States does not refer to “intellectual creation”. In addition, the meaning of “original” in the said legislation is different from the meaning ascribed to it in the common law cases. The United States and Canadian case law is different from that “in England and Jamaica, where the legislation and rights are similar”, she said. In this regard, she was joined by Mrs Alexis Robinson who submitted that “Jamaica and England do not have the limitations of the United States, so United States law is not to be applied”. She said that “the appeal is substantially in relation to the law to be applied, and how it is to be applied”. It may be inferred that Mr Beswick did not think that these submissions were relevant given the fact that he expressed the view that the learned judge did not follow any American judgment in arriving at his conclusion.

**Interpretation of the Copyright Act**

[24] The relevant portions of the Copyright Act have already been set out at paragraph [14] above. We understand the legislation to be providing that copyright is a property right which may subsist in original literary works. The term “literary works” includes a written compilation. However, copyright subsisting in a compilation does not extend to data or other material comprised in the compilation. The word “compilation” for present purposes means a collection of data which constitutes an intellectual creation by reason of the manner of the selection or

arrangement of the data comprised in the compilation. It was therefore clear that the learned judge was statutorily required to determine whether Cable & Wireless had produced an original literary work which fell into the category of an intellectual creation, by virtue of the method of selecting and arranging the compilation. In our view, he made that determination, and we agreed with his reasoning and conclusion.

[25] As mentioned earlier, we now set out certain statements made by the Chief Justice in the case ***CCH Canadian Ltd v Law Society of Upper Canada***. The statements bear on the questions of “original literary work” and “intellectual creation”. They are contained in the following paragraphs from the judgment:

- “15: There are competing views on the meaning of ‘original’ in copyright law. Some courts have found that a work that originates from an author and is more than a mere copy of a work is sufficient to ground copyright. See, for example, *University of London Press, Ltd. v. University Tutorial Press, Ltd.*, [1916] 2 Ch. 601; ... Other courts have required that a work must be creative to be ‘original’ and thus protected by copyright. See, for example, *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); ... It has been suggested that the ‘creativity’ approach to originality helps ensure that copyright protection only extends to the expression of ideas as opposed to the underlying ideas or facts.
16. For a work to be ‘original’ within the meaning of the *Copyright Act*, it must be more than a mere copy of another work. At the same time, it need not be creative, in the sense of being novel or unique.
- ...
18. The plain meaning of the word ‘original’ suggests at least some intellectual effort, as is necessarily involved in the exercise of skill and judgment. ... ‘Original’s plain meaning implies not just that something is not a copy.

It includes, if not creativity *per se*, at least some sort of intellectual effort.

19. The idea of 'intellectual creation' was implicit in the notion of literary or artistic work under the *Berne Convention for the Protection of Literary and Artistic Works* (1886), to which Canada adhered in 1923, and which served as the precursor to Canada's first *Copyright Act*, adopted in 1924."

[26] Whereas paragraph 15 of the Chief Justice's judgment gave the interpretation of the Courts in England and the United States of America in relation to the meaning of "original", paragraphs 16, 18 and 19 gave the Canadian position. The Chief Justice said that for a work to have the tag of "original", it was required that it be more than a mere copy of another work. At least, there ought to be some intellectual effort, even if there was no "creativity" in the work. However, the idea of "intellectual creation" was implicit in the notion of literary or artistic work under the Berne Convention to which Canada adhered in 1923.

[27] In the instant case, we were satisfied that Rattray J correctly assessed the material that was before him and quite properly concluded that there was no "intellectual creation" displayed. It was necessary for him to make a pronouncement on this aspect seeing that the legislation requires that for a compilation to qualify for copyright status, it must constitute an intellectual creation. We were unable to see how the judge's determination could be faulted as we formed the view that the compilation by Cable & Wireless was a mechanical collection and reproduction of information that had been mostly supplied by subscribers in the first place. In addition, the evidence that was presented to the learned judge made it clear that international precedents were faithfully followed in the making of the compilations.

[28] The appellant stressed that the learned trial judge did not give sufficient attention to the English way of thinking in arriving at his decision. However, the decision of the House of Lords

in *Cramp & Sons v Smythson* [1944] AC 329, when compared with the judgment of Rattray J, does not seem to support the appellant's view. The facts of that case are set out in the headnote thus:

"The appellants and the respondents were both publishers of pocket diaries. The respondents complained that the appellants, in a diary published by them, had infringed the copyright in their 'Liteblue' diary. The issue published by the respondents in 1932 for 1933 contained the usual diary pages and these were [sic] accompanied by pages containing information of the kind usually found in diaries – a calendar for the year, postal information, a selection of 'days and dates' for the year, tables of weights and measures, comparative time tables, a percentage table, and the like. In 1938 a former employee of the respondents, then employed by the appellants, copied seven of the tables in the respondents' diary and inserted them in a diary published by the appellants. The respondents brought an action against the appellants alleging infringement of their copyright:-

Held, that copyright was not established, since the commonplace matter of the tables left no room for taste or judgment and their selection did not constitute an original literary work."

[29] Viscount Simon LC made the point that copyright "subsists under the conditions mentioned in the section 'in every original literary. ... work' and this expression includes 'compilations': ... nobody disputes that the existence of sufficient 'originality' is a question of fact and degree." Lord Porter, in his judgment, had this to say:

"Bearing these considerations in mind, the question to be answered is, have the appellants succeeded in showing that the almanac in question is not susceptible of copyright? I think they have. It is conceded that, if the work, labour and skill required to make the selection and to compile the tables which form its items is negligible, then no copyright can subsist in it. Whether enough work, labour and skill is involved, and what its value is, must always be a question of degree. Different minds will defer, as may be seen in the

present case from the divergence of opinion in the courts below.

Speaking for myself, it appears to me that it is of the smallest. Like Uthwatt J. and Luxmoore L.J., I think that 'apart from any evidence, the compilation for which copyright is claimed is nothing more than a commonplace selection or arrangement of scraps of information, neither of which has involved any real exercise of labour, judgment or skill'. And this is so whether one considers any individual table or the whole of them in combination."

The thinking of the House of Lords in *Cramp & Sons* was certainly not at variance with the reasoning of Rattray J.

[30] Mrs Minott-Phillips submitted that "creativity" has no place in copyright law, and that "creativity" was different from "intellectual creation". In our respectful view, that was a mere splitting of hairs. This is so, given the definitions provided in the Concise Oxford Dictionary. "Creative" is defined thus: "1. Inventive and imaginative. 2 creating or able to create", whereas "creation" is defined as "1. the act of creating" and "a product of human intelligence, esp. of imaginative thought or artistic ability". It is logical that creativity results in creation so there can be no valid point made by attempting to separate them.

## **Conclusion**

[31] In view of the failure of Cable & Wireless to show that their compilation of customer and directory database/listings was a literary work constituting an intellectual creation, we concluded that the learned judge was correct in denying the declarations sought by Cable & Wireless, and in making the declarations that he did. For these reasons, we dismissed the appeal. We feel constrained, however, to add that we did not see much difference in the approach of the courts in the United States and Canada, on the one hand, and the courts of England and Jamaica, on the other hand, as regards the issues that were up for determination

in this case. It seemed to us that the appellant tried to make too much of the minor dissimilarities that may exist.

[32] Finally, we did not think it prudent to conclude our deliberations in this appeal without considering the Telecommunications Act which came into operation on 1 March 2000. Its objects are stated in section 3 as follows:

- “(a) to promote and protect the interest of the public by –
  - (i) promoting fair and open competition in the provision of specified services and telecommunications equipment;
  - (ii) promoting access to specified services;
  - (iii) ensuring that services are provided to persons able to meet the financial and technical obligations in relation to those services;
  - (iv) providing for the protection of customers;
  - (v) promoting the interests of customers, purchasers and other users (including, in particular, persons who are disabled or the elderly) in respect of the quality and variety of telecommunications services and equipment supplied;
- (b) to promote universal access to telecommunications services for all persons in Jamaica, to the extent that it is reasonably practicable to provide such access;
- (c) to facilitate the achievement of the objects referred to in paragraphs (a) and (b) in a manner consistent with Jamaica’s international commitments in relation to the liberalization of telecommunications; and
- (d) to promote the telecommunications industry in Jamaica by encouraging economically efficient investment in, and use of, infrastructure to provide specified services in Jamaica”.

It seems that, in any event, a claim to copyright in the customer and directory database/listings is wholly inconsistent, if not with the objects of the Act, at least with the spirit of the legislation, and so cannot be entertained.