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Database Protection – Not So Protected

A recent Australian case has put the spot light on what has always been the limited protection afforded to database owners. Some misreporting of the case has suggested it has reduced this protection and that wholesale changes to the law and trans-Tasman business relations may follow. While this may be an overstatement, the case still serves to reiterate the law as it is, and to point out the limitations which have always been placed on the rights of the owner of a database.

Currently the only options available to an owner of a database are to either keep it secret or to rely on the limited protection afforded by copyright law. Often it is impossible to keep the information contained in a database a secret, leaving copyright as the only form of protection.

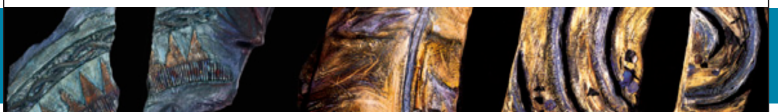
Databases are treated as a compilation for the purposes of copyright law. All works require an element of originality for copyright to subsist in the work. In the case of a compilation where the sum of its parts is either made up of copyrighted material owned by someone else or statements of fact, the originality comes from how that information is put together and presented. It is only from this originality in arranging the information that a database can attract copyright protection.

It was this point on which the recent Australian High Court decision of Ice TV Limited v Nine Network Australia Limited turned. In that case the Nine television network (Nine) brought an action against a digital television listing guide (Ice TV) for infringing the copyright Nine believed it held in its weekly programming schedules. Nine was in the business of selling its programming schedules to various press companies that would publish the schedules. Ice TV would then essentially copy the time and programme name information for inclusion in its own programme guide.

Nine believed that by claiming protection over its entire database (of which the weekly schedule only formed a small part) it would have a better chance of proving its claim. Instead it had the opposite effect. The Court found that the use of a small amount of information from a large database lacked the requisite amount of originality required for copyright to be infringed by the use of that information. This was due to the fact that such a small amount of information lacked the ability to be arranged in an original way.

In some cases copyright may not subsist in a database at all. An extreme example of this was the American case of Feist v Rural which found that no copyright subsisted in a telephone book. This was due to the fact that a telephone book contains only statements of fact and the information requires no originality in arranging it alphabetically.

The core concept that database owners must come to terms with is that they do not own the information contained in their database, only the way that the database is arranged. Understanding this will assist a database owner in assessing how best to protect their database as an asset and plan the best way to use it.



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Trade Marks (International Treaties and Enforcement) Amendment Bill

The Trade Marks (International Treaties and Enforcement) Amendment Bill ("Bill") recently passed its first reading in Parliament. The Bill seeks to bring New Zealand law into line with two international Treaties as well as giving two government departments more enforcement powers by amending the Trade Marks Act 2002 ("Act") as well as parts of the Copyright Act 1994.

The most striking change that the Bill will bring about is the ability for trade mark owners to apply for trade mark protection in other countries as well as New Zealand as part of making an application for the same trade mark in New Zealand. This is a result of New Zealand's commitment to the Madrid Protocol.

Currently if a New Zealand company wishes to register their trade mark in another country they must make a separate application in that country which usually involves engaging lawyers in that country. These amendments mean that they can use their local lawyers to apply to the New Zealand authorities for protection in these countries at the time they apply in New Zealand.

Another point of interest is the wider powers to prosecute, and search and seize infringing trade marked and copyright material. The Bill will empower Customs and the Ministry of Economic Development to seize items which infringe a registered trade mark or copyright with the use of a warrant, and in certain circumstances without a warrant.

The Bill also seeks to clarify the law around parallel imports by making it clear that the advertising of parallel imported goods using the registered trade mark does not constitute trade mark infringement.

The Bill has been referred to the Foreign Affairs, Defence and Trade Committee who's report is due in October 2009. It is likely that the Bill will not be passed into law until some time in 2010 at the earliest.

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