

- 43 *Migros Genossenschaftsbund v. Centro Consulenze Kim Paloschi*, WIPO Case No. D2000-1171 (6 Nov, 2000).
- 44 *British Nuclear Fuels Plc v. Greenpeace International*, WIPO Case No. D2001-1318 (10 Jan, 2002).
- 45 *Yüksel İnşaat A.Ş. v. Erdogan Koparal*, WIPO Case No. D2002-0285 (28 May, 2002).
- 46 *Tridos Bank NV v. Dobbs*, WIPO Case No. D2002-0776 (3 Oct, 2002).
- 47 *Supra* n.11.
- 48 This category was identified *FMR Corp*, *supra* n.6.
- 49 See for example *National Collegiate Athletic Ass'n v Brown*, *supra* n.9; *American Lubefast Franchising, Inc v Chung Rigby*, WIPO Case No. D2004-0329 (26 July, 2004); *Justice for Children v R neetso/Robert W. O'Steen*, *supra* n.15.
- 50 *Supra* n.6.
- 51 *Nat'l Collegiate Athletic Ass'n v Brown*, *supra* n.9.
- 52 *Universal City Studios, Inc. v David Burns and Adam-12 Dot Com*, WIPO Case No. D2001-0784 (1 Oct, 2001).
- 53 *Covance, Inc. and Covance Laboratories Ltd v The Covance Campaign*, *supra* n.37.
- 54 *Supra* n.6.
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## Confidentiality and copyright: Emails covered too

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Woolworths were able to effectively protect themselves against the misuse of confidential information by a director, in the case of *Woolworths Ltd v Olson*.<sup>1</sup>

### Facts

Olson, a Woolworths director in Australia, was involved in a project to streamline the supply chain of Woolworths (project). The implementation of the project had already cost a billion dollars, and information about it was highly sensitive. Olson signed a confidentiality agreement in respect of the project, and was repeatedly told at meetings that the project was confidential.

However, Olson was also secretly negotiating with a competitor of Woolworths to take up employment with them. When he received an offer from the competitor, he sent two emails, containing several confidential project documents, to his wife's home email address. Woolworths discovered the emails, obtained an Anton Pillar order, and removed Olson's wife's computer before the emails had been opened.

The case raised a number of issues, but the ones regarding confidentiality and copyright are of note.

### Confidentiality

The court looked at the confidentiality agreement signed by Olson, which stated that Olson couldn't disclose confidential information to a third party. Interestingly, the court took pains to satisfy itself that the project documents in the emails were in fact confidential, even though Olson had admitted at trial that they were. This was partly because of the court's concern to have absolute clarity about what information would be protected, and by what means. The court then held that sending the project documents to his wife's account (ie a third party) was a clear breach of the agreement.

### Copyright

In relation to copyright, the court made an interesting conclusion about emailing documents. It held that by sending the emails, a 'reproduction' of the project documents had been made on Olson's mail server (which was capable of a further reproduction when the sent emails were either downloaded or (as in fact happened) deleted). Therefore, Olson had infringed copyright even though the emails were never opened.

Woolworths also claimed that Olson had infringed their copyright under the

Act because he had made a 'communication to the public'. However, the court disagreed, holding that two emails to the same account did not constitute the 'public'.

In respect of damages, the Act makes 'additional damages' available where an infringement of copyright has been particularly brazen. However, the court denied additional damages to Woolworths in this case, because it held that although Olson had flagrantly breached his duty of confidentiality, he hadn't flagrantly infringed copyright (ie there had only been two emails sent to one person). Nevertheless, the court was quick to grant an injunction against Olson to prevent him from using the project documents again.

### Conclusion

This case is a good example of how valuable a strong confidentiality agreement can be: Woolworths were able to prevent Olson from leaking the confidential documents, and even from opening the email he'd sent to a private inbox.

It is also an interesting example of how copyright can be breached by merely sending an email, even if it's never opened.

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<sup>1</sup> 63 IPR 258.