

Asia Pacific Publishing Pte Ltd
v
Pioneers & Leaders (Publishers) Pte Ltd

[2011] SGCA 37

Court of Appeal — Civil Appeal No 147 of 2010
Chao Hick Tin JA, Andrew Phang Boon Leong JA and V K Rajah JA
9 February; 27 July 2011

Copyright — Authorship — Whether incorporated entity could be author — Sections 27, 28 and 29 Copyright Act (Cap 63, 2006 Rev Ed)

Copyright — Authorship — Whether statutory presumptions applied as to authorship — Section 132 Copyright Act (Cap 63, 2006 Rev Ed)

Copyright — Groundless threat — Whether magazine publisher making groundless threats to bring legal proceedings for copyright infringement against rival magazine publisher — Section 200(1) Copyright Act (Cap 63, 2006 Rev Ed)

Copyright — Infringement — Whether there was infringement of work if copyright was found to subsist

Copyright — Subject matter — Compilations — Databases — Whether copyright subsisting in compilation of data

Tort — Passing off — Damage — Test for damage — Whether test of likelihood of damage or actual damage was required

Tort — Passing off — Goodwill — Whether there was goodwill in get-up of magazine

Tort — Passing off — Misrepresentation or confusion — Whether there was misrepresentation to relevant sector of public — Whether market survey could be relied on

Facts

The Respondent published a horse-racing magazine known as “*Punters’ Way*” in both English and Chinese. From January 2007, the Appellant published a horse-racing magazine known as “*Racing Guide*”. *Punters’ Way* contained horse-racing information in a set of four tables (“the Tables”) that was arranged in a specific sequence. From 30 June 2007 to 5 June 2008, *Racing Guide* contained the Tables in the exact same sequence. The Respondent claimed infringement of copyright in the Tables by the Appellant under the Copyright Act (Cap 63, 2006 Rev Ed) (“the Act”).

Punters’ Way also employed a colour coding scheme on its front cover. In January 2008, *Racing Guide* began to adopt similar colour coding. *Racing Guide* also employed the use of forward-facing pictures of horses and placed its advertisements panels on the bottom of the front cover, similar to that of *Punters’ Way*. The Respondent additionally claimed against the Appellant under the law of passing off.

The High Court Judge (“the Judge”) found that copyright subsisted in the Tables with the Respondent as the author. The Judge also found that a substantial part of the Tables had been copied and therefore the Appellant had infringed the Respondent’s copyright and an injunction was granted to restrain the Appellant from further infringement. In addition, the Judge found that the Appellant had passed off *Racing Guide* as *Punters’ Way*. The Respondent thus succeeded in both claims in the High Court. The appellant appealed against the Judge’s decision.

Held, allowing the appeal:

(1) The Tables clearly constituted a compilation. However, in order for any copyright to subsist in the compilation, the selection or arrangement of its contents had to be the product of intellectual creation. The Respondent had unequivocally pleaded that it alone was the original author of the Tables in *Punters’ Way*. No human individuals were identified. The Respondent had not pleaded ownership of the Tables. Authorship and ownership were not synonymous terms: at [32] and [41] to [43].

(2) Section 27 of the Act did not provide a definition of who could be an author of a subsisting copyright under the Act. However, this did not mean that the definition of “qualified person” could be extended to include non-living “persons” such as incorporated bodies. The duration of copyright protection had always been based on the author’s life expectancy. Authors had to be living persons. Should companies qualify as authors, they would be entitled to claim a perpetual monopoly over their work: at [51], [60] and [64].

(3) It was clear that the historical origins of the Act envisaged rights to be accorded to natural persons and not corporate bodies, and that legal rights flowed only from human authorship. Section 2 of the Interpretation Act ought not to be incorporated into the rubric of copyright law, and an “author” had to be a natural person in copyright law: at [65], [67] and [72].

(4) Originality was closely related to the author. An author had to first be identified before the work in question could be deemed to be original. Without the identification of a human author from whom the work originated, there could be no “original work” capable of copyright protection: at [73], [75] and [82].

(5) The statutory presumptions, such as s 132 of the Act, have little or no role to play where the question of subsistence of copyright in each of the works was the central issue between the parties. As the Appellant adduced evidence that copyright did not subsist in the Tables since there was no author, the s 132 presumption was displaced. The necessary elements of authorship, ownership, validity and subsistence had to be adequately pleaded for cases involving copyright infringement. The Respondent could not now rely on an alternative claim of ownership which was not pleaded in the proceedings below: at [90] to [93].

(6) Despite the fact that the material used in the Tables was easily accessible to all, the information was presented in a distinct form which would attract copyright protection. The Tables in *Racing Guide* incorporated a substantial part of the Tables found in *Punters’ Way* but as no copyright subsisted in the work,

there was no infringement of the Respondent's copyright by the Appellant: at [104], [113] and [114].

(7) The "classical trinity" of goodwill, misrepresentation and damage had to be established by the party seeking to claim passing off before an action could succeed. Whether a get-up had acquired the necessary distinctiveness was a question of fact. The Respondent had been publishing *Punters' Way* for around 30 years and the Appellant's witness acknowledged *Punters' Way* was the market leader in Singapore at various stages in its history. Goodwill was therefore attached to the get-up of *Punters' Way*: at [116], [119] and [120].

(8) Little reliance ought to be placed on the market survey as it was conducted by approximating the two issues which were most similar which was not a fair test. Additionally, the survey was conducted with the masthead removed. The punting audience to which both publications were targeted were circumspect and discerning. The large mastheads were significant distinguishing facts and there would be no confusion caused to the public. The cover pages of the two magazines were sufficiently distinct and were not likely to be confused by the relevant sector of the public: at [125], [126], [130] and [132].

(9) The right test that should be applied for damages was that of "actual damage" and not "likelihood of damage" as the infringement period had long since ended. However, as the trial was bifurcated on the Appellant's application, it was not just to penalise the Respondent for not leading evidence of actual damages at the trial. However, the test for damages in situations where the period of infringement had passed should be proof of actual damage and nothing short of that: at [136] to [139].

(10) The Respondent had made groundless threats against the Appellant for the purposes of s 200(1) of the Act as the Respondent's Tables did not have copyright subsisting: at [142].

[Observation: The Statute of Anne (8 Anne c 19) (UK) was the first copyright statute in the world. Ever since the enactment of the Statute of Anne, the objective of copyright law was to encourage the creativity of natural authors. The identification of the author was therefore a key function of copyright law as that was the person who was entitled to the benefits conferred by law. Authorship by a company could never have been contemplated by the Statute of Anne as companies operating as distinct legal entities were not a typical feature of commerce when it was enacted: at [41], [64] and [65].]

Case(s) referred to

Alteco Chemical Pte Ltd v Chong Yean Wah [1999] 2 SLR(R) 915; [2000] 1 SLR 119 (distd)

Aron Salomon (pauper) v A Salomon and Co Ltd [1897] AC 22 (refd)

Chilton v Progress Printing and Publishing Co [1895] 2 Ch 29 (refd)

CIR v Muller & Co's Margarine Ltd [1901] AC 217 (refd)

Creative Purpose Sdn Bhd v Integrated Trans Corp Sdn Bhd [1997] 2 MLJ 429 (refd)

Feist Publications Inc v Rural Telephone Service Co Inc 499 US 340 (1991) (refd)

Fortuity Pty Ltd v Barcza (1995) 32 IPR 517 (refd)

IceTV Pty Ltd v Nine Network Australia Pty Ltd [2009] HCA 14 (refd)

- Interfirm Comparison (Australia) Pty Ltd v Law Society (NSW)* [1977] RPC 137 (refd)
- Microsoft Corp v DHD Distribution Pty Ltd (t/as Austin Computers)* (1999) 45 IPR 459 (refd)
- Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216; [2009] 3 SLR 216 (refd)
- Pioneers & Leaders (Publishers) Pte Ltd v Asia Pacific Publishing Pte Ltd* [2010] 4 SLR 744 (refd)
- Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 (refd)
- Telstra Corp Ltd v Phone Directories Co Pty Ltd* [2010] FCA 44 (folld)
- Telstra Corp Ltd v Phone Directories Co Pty Ltd* [2010] FCAFC 149 (folld)
- Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903; [1991] SLR 133 (refd)
- University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 (refd)
- Waterlow Publishers Ltd v Rose* [1995] FSR 207 (distd)

Legislation referred to

- Copyright Act 1987 (Act 2 of 1987)
- Copyright Act (Cap 63, 1988 Rev Ed)
- Copyright Act (Cap 63, 1999 Rev Ed)
- Copyright Act (Cap 63, 2006 Rev Ed) ss 7, 7A, 27, 28, 29, 131, 132 (consd); ss 27(2)(d), 27(4), 28(3), 28(5), 29(2)(d), 30, 92, 93, 94, 95, 96, 200(1)
- Interpretation Act (Cap 1, 2002 Rev Ed) s 2
- Copyright Act 1911 (c 46) (UK)
- Copyright Act 1956 (c 74) (UK) s 20(4)
- Copyright Act 1968 (Cth) ss 32, 33, 34, 128
- Copyright Act 1987 (Act 332) (M'sia)
- Copyright Amendment Act 1980 (Cth)
- Copyright Amendment Act 1984 (Cth)
- Copyright, Designs and Patents Act 1988 (c 48) (UK) ss 9, 9(1), 104(4)
- Joint Stock Companies Act 1844 (c 110) (UK)
- Second Charter of Justice 1826 (c 85) (UK)
- Statute of Anne (c 19) (UK)

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[Editorial note: The decision from which this appeal arose is reported at [2010] 4 SLR 744.]

27 July 2011

Judgment reserved.

V K Rajah JA (delivering the judgment of the court):**Introduction**

1 This is an appeal by the appellant, Asia Pacific Publishing Pte Ltd (“the Appellant”), against the decision of a High Court Judge (“the Judge”), allowing the claim by the respondent, Pioneers & Leaders (Publishers) Pte Ltd (“the Respondent”) for copyright infringement and passing off. The Judge had also ordered an injunction to restrain the Appellant from infringing the Respondent’s copyright.

2 A novel issue raised in this appeal is whether an incorporated body can be considered an “author” for the purposes of copyright law. The Judge found that a company could indeed be an author of an original work that attracted copyright protection. Her detailed reasons can be found in *Pioneers & Leaders (Publishers) Pte Ltd v Asia Pacific Publishing Pte Ltd* [2010] 4 SLR 744 (“the Judgment”). Before we analyse the legal issues that have arisen in this appeal the facts ought to be set out to give those issues context.

The facts

3 The Appellant was incorporated in Singapore in 2006, while the Respondent was incorporated in Singapore in 1983. Both the Appellant and the Respondent have been, at all material times, in the business of books and magazines publication.

4 The Respondent has been publishing a horse-racing magazine known as “*Punters’ Way*” in both English and Chinese since its incorporation in December 1983. Prior to 1983, *Punters’ Way* had been published and sold since March 1977 by Pioneers & Leaders Co, a partnership registered in Singapore that is related to the Respondent. *Punters’ Way* caters to horseracing punters, and contains all types of horse-racing information, including race cards, the names and description of the horses participating in each race, the pedigree of each horse and the particulars of trainers and jockeys and their performance history.

5 The Appellant, which was incorporated in November 2006, has, on its part, been publishing a horse-racing magazine known as “*Racing Guide*” only from January 2007. *Racing Guide* was first published in 1986, and was thereafter published by several different companies. The Appellant acquired the right to publish *Racing Guide* from Racing Guide Publications Pte Ltd soon after it was incorporated. The contents of *Racing Guide* are essentially similar to that of *Punters’ Way* and it is also published in both English and Chinese. It is pertinent to note that both magazines obtain all their race information from the same source, that is to say, the Singapore Turf Club (“the Turf Club”).

The dispute between the parties

6 From 30 June 2007 to 5 June 2008, both the Appellant's and Respondent's horse-racing magazines, *Racing Guide* and *Punters' Way* respectively, contained horse-racing information in a set of four tables ("the Tables") that was arranged in the same sequence. The Tables adopted the following sequence:

- (a) Table 1 Race Card;
- (b) Table 2 Results Panel;
- (c) Table 3 Track Work; and
- (d) Table 4 Records of Past Performances.

7 The Race Card consists of the line-up of the horses competing in each race, and readers are able to read about the horses that are participating in the race, their recent physical status, their performance and how they are to be equipped; the jockeys and their recent performances; and trainers' strike rates. The Results Panel consists of the choice selection of potential winning horses picked by the Respondent's tipsters. It also has blank spaces to allow readers to fill in the actual result of the race.

8 The Track Work table shows the preparation that each horse has been put through by its trainer. It includes particulars of the horses' performance before the race day for up to 21 days and is specially designed to give readers additional information on the recent physical state or condition of the horse. Finally, the Records of Past Performances table has a detailed history of each horse, including its pedigree, owner and stable; the stake money it has won; and the horses' past performances for the last six runs.

9 The Respondent alleged that as *Racing Guide* contained the Tables in the same sequence from 30 June 2007 to 5 June 2008, the Appellant had infringed the Respondent's copyright by way of the copying and reproduction of the compilation of the Tables as they were materially similar to those in *Punters' Way*.

10 Additionally, the Respondent claimed that since 1993, *Punters' Way* employed a different colour on the front cover to identify the various editions for each race day in Malaysia and Singapore. The Respondent also contended that the colour coding scheme has become a unique feature of the Respondent's publication and is in fact a badge of origin, which the Respondent uses to distinguish its products from the other products in the market. On or about 4 January 2008, the Appellant began to adopt similar colour coding for both its English and Chinese editions of *Racing Guide*. A comparison of the colour coding for both magazines is as follows:-

| Race Day | Punters' Way | Racing Guide |
|--------------------|--------------|--------------|
| Singapore Friday | Maroon | Maroon |
| Singapore Saturday | Purple | Dark Purple |
| Singapore Sunday | Orange-red | Orange-red |
| Malaysia Saturday | Purple | Light Purple |
| Malaysia Sunday | Gold | Gold |

11 The Appellant also changed the pictures of the horses on the front cover page of *Racing Guide*, such that the horses were forward-facing, instead of the horses' side profile being shown, as was the case previously. In addition, the Appellant also placed an advertisement panel on the bottom of the front page from January 2008, which was similar to *Punters' Way*. Prior to January 2008, the Appellant used to place its advertisement panels in the middle left hand side of the front page.

12 Because of all these similarities, the Respondent claimed that the Appellant had misrepresented to members of the public that *Racing Guide* was connected to or associated with *Punters' Way*, causing confusion, and had attempted to pass off *Racing Guide* for *Punters' Way*. On 25 April 2008, a demand letter was issued by the Respondent to the Appellant. In the letter, the Respondent alleged that the Appellant had infringed the Respondent's copyright in the Tables, and had also passed off *Racing Guide* as *Punters' Way*. The Respondent claimed for a sum in lieu of damages as well as for the Appellant to cease and desist from the alleged infringement of copyright and passing off. The Appellant responded to the demand letter, rejecting the Respondent's assertions and claims. It bears mention that not long after the demand letter was sent the Appellant modified the Tables in its publication. The Respondent accepts that infringement ceased on 5 June 2008. Legal proceedings against the Appellant commenced on 12 November 2008 and the trial was heard in February and March 2010.

The decision of the High Court

13 The Judge found that copyright subsisted in the Tables in *Punters' Way* and that a company could indeed be the author of a copyright protected work as there was nothing in principle that would prevent an incorporated company from authoring a work. In the Judge's view, who an "author" was ultimately depended on the facts of each case – more specifically, the rights that were sought to be protected, and the factual context from which the relevant work arose. In the present case, the Respondent was presumed to be the author of the Tables under s 131 of the Copyright Act (Cap 63, 2006 Rev Ed) ("the Act"). The Judge further found that there was no difficulty with determining the duration of the copyright owned by an incorporated entity as time will start to run from the moment the copyrighted works are published, consistent with ss 28–29 of the Act,

and the relevant period would be 70 years from the expiration of the calendar year in which the work was first published.

14 In addition, the Judge found that there was originality in the compilation of the Tables found in *Punters' Way* as there was skill and creativity expended in the selection of information to be presented in the Tables, which had been arranged in a way the Respondent believed was most useful to its readers. The Judge also held that the evidence showed that the presentation of horse-racing information in *Racing Guide* was substantially similar to that in *Punters' Way* and that a substantial part of the Tables had been copied. The court granted an injunction to prevent the Appellant from infringing the Respondent's copyright in *Punters' Way*.

15 In relation to the claim in passing off, the Judge found that without relying on any expert evidence, there was more than sufficient objective evidence to establish a compelling case that the Appellant had deliberately made changes to the cover page of *Racing Guide* to pass it off as *Punters' Way*. The Judge concluded that the similarities between the Chinese editions were also undeniably apparent. The expert evidence based on surveys conducted on readers of horse racing magazines further served to reinforce the court's findings. The court therefore found that the Respondent was entitled to damages resulting from the Appellant's passing off and/or infringement of copyright.

The issues

16 Three main issues arise for consideration before us in the present appeal, namely:

- (a) Is the Respondent entitled to assert copyright protection as the author of its publication? ("the First Issue");
- (b) If the Respondent is entitled to copyright protection, has the Appellant infringed its rights? ("the Second Issue"); and
- (c) Has the Respondent established the constituent elements to ground a passing off action? ("the Third Issue").

Copyright protection in Singapore

17 Before we examine the issues it would be apt to outline the current copyright legislative scheme in Singapore. As this was grandfathered in the United Kingdom ("the UK"), it will be useful to briefly narrate the historical evolution of copyright there. Interestingly, though the concept of copyright was born in the late 15th century, following the invention of printing, which made it possible to produce multiple copies of books quickly and cheaply, the very first Copyright Act was only passed in 1709 in the UK – the Statute of Anne 1709 (8 Anne c 19) (UK) ("the Statute of Anne"); see Kevin

Garnett *et al*, *Copinger and Skone James on Copyright* vol 1 (Sweet & Maxwell, 16th Ed, 2011) (“*Copinger*”) at para 2-08.

18 The Statute of Anne was the first copyright statute in the world and it is the basal foundation on which the modern concept of copyright has been built. As pointed out in *Copinger* at para 2-16, two of the principles established by the Statute of Anne were revolutionary at the time: recognition of the author as the fountainhead of protection; and adoption of the principle of a limited term of protection for published works.

19 The Statute of Anne gave authors copyright protection for all existing printed books for a period of 21 years, and a maximum of 28 years for new works. It envisaged rights to be accorded to natural persons who created a work, balanced with the public interest of maintaining a robust public domain in which original literary, musical and artistic works are produced. The object of copyright protection was to encourage human progress through the sharing of learning and writings while safeguarding the potential economic benefits through the grant of monopoly rights of a limited duration. The social contract created protected original creativity without reference to literary merit.

20 The UK Copyright Act 1911 (c 46) (UK) (“the UK Copyright Act 1911”) subsequently codified the modern law on copyright. Additionally, it abolished common law copyright in unpublished works and conferred copyright protection on a number of works previously unprotected. Here, for the first time, the common law requirement that a literary work had to be “original” to secure copyright protection was acknowledged. To qualify as an original work, the work had to originate from an author without copying.

21 In Singapore, the Statute of Anne applied pursuant to the Second Charter of Justice of 1826 (c 85) (UK). This was then replaced by the UK Copyright Act 1911. However, in response to vastly changed circumstances, the UK Copyright Act 1911 was eventually repealed and replaced by the Singapore Copyright Act 1987 (Act 2 of 1987) (“the 1987 Act”). The 1987 Act was modelled on the Australian Copyright Act 1968 (Act No 63 of 1968) (Cth) (“the Australian Copyright Act 1968”), as amended by the Copyright Amendment Acts 1980 (Act No 154 of 1980) (Cth) and 1984 (Act No 43 of 1984) (Cth). The 1987 Act was later revised in 1988, by way of the Copyright Act (Cap 63, 1988 Rev Ed), and 1999 by way of the Copyright Act (Cap 63, 1999 Rev Ed) (“the 1999 Act”), before becoming the Act as it exists today.

22 The Act governs the law of copyright in Singapore and copyright prevails only when permitted by the Act. As we will show below, the concepts of authoring and authorship take centre-stage in the Act. The general framework of copyright law in Singapore encompasses the following:

- (a) the subject matter of protection;
- (b) the scope of protection granted;
- (c) the term of protection; and
- (d) formalities.

The subject matter of protection

23 The subject matter accorded protection falls into two principal categories. The first, protected under Part III and more specifically found in s 27 of the Act, includes traditional types of subject matter such as literary, dramatic, musical and artistic works which are original. The second category, protected under ss 97–101 in Part IV of the Act, relates to “SUBJECT-MATTER OTHER THAN WORKS” and includes sound recordings, television broadcasts and cinematograph films amongst others.

24 Section 27 of the Act is *in pari materia* with s 32 of the Australian Copyright Act 1968, which has its origins in the UK Copyright Act 1911. Thus, both English and Australian cases are useful reference points on the issue of originality. However, while the cases are helpful in illuminating the application of the legal principles, it has to be remembered that ultimately the originality of each particular work is everything in determining if copyright exists.

The scope of protection granted

25 The scope of protection accorded differs according to the type of subject matter concerned. Copyright protection is concerned with the unauthorised reproduction or dissemination by third parties of the form in which a person has chosen to express himself or herself, whether by way of a book, painting, or something else. Nevertheless this protection may be broader in some cases than in others, due to the nature of the subject matter in question. For example, for literary, dramatic and musical works, a person may prevent a wide range of unauthorised reproductions such as, *inter alia*, adaptations, public performances and other public communications of the work. However, for artistic works and subject matter other than works, the protection accorded is more limited and more narrowly interpreted.

The term of protection

26 In general, the term of protection for works is the author’s life plus 70 years as stated in s 28 of the Act; while the term of protection for other subject matter, as well as certain limited categories of works such as those published anonymously or pseudonymously is 70 years from the date of first publication, as seen in s 29 and ss 92–96 of the Act respectively.

27 The length that ought to be accorded to copyright protection has always been robustly debated. This stems from the difficulty of striking an

appropriate balance between the competing tensions of public and private interests. On one hand, there is the interest of the public in securing both new and established works freely and as early as possible, and, on the other, the need to ensure that authors receive a just return for their creative efforts and are thereby encouraged to keep on creating. The perennial problem has been to find the right period of protection which strikes the appropriate balance between these competing tensions.

28 As mentioned earlier in [19], the statutory protection provided by the Statute of Anne was a maximum period of 28 years. As an aside, it bears noting that the average human life span then was much shorter. The initial statutory period was enlarged in 1814 to the term of the author's life, if the author was still living at the end of 28 years. In 1842, it was changed to the life of the author plus seven years or 42 years, whichever was the longer. The rationale for this new term was based on the argument that the earlier legislation tended to penalise the author who published his work shortly before his death. This, coupled with the desire to secure rights which would benefit the heirs of the author, resulted in the new extended copyright period. Subsequently, the UK Copyright Act 1911 provided that the term for copyright would be the author's life plus 50 years. This was the position adopted in the 1987 Act when it was first enacted.

29 In May 2003, the United States - Singapore Free Trade Agreement was signed, obliging Singapore to add 20 years to the then-existing term for authors' works, performances and phonograms. The result was that in July 2004, the 1999 Act was amended to reflect the current copyright term for works as the author's life plus 70 years. The history and rationale of the term of copyright will be explicated further below at [57]–[60].

Formalities

30 There is no requirement of registration before copyright protection attaches under the Act. However, in order for copyright to subsist, s 27 of the Act requires that one of the following connecting factors must exist in relation to the work or subject matter in question, that is:

- (a) that the author or maker be a “qualified person”;
- (b) that the work or subject matter be first published in Singapore;
or
- (c) in the case of sound recordings, films and broadcasts, that they be made in Singapore.

This will be elaborated upon further below at [46]–[56].

31 As mentioned above, the sections in the Act are largely modelled on the Australian Copyright Act 1968, which was found to be the most compatible with Singapore's requirements bearing in mind “our legal system [and] our need to be up-to-date and comprehensive”: see *Singapore*

Parliamentary Debates, Official Report (5 May 1986) vol 48 at col 12 (Prof S Jayakumar, Second Minister for Law). However as we have earlier stated, English cases still have significance since both Singapore and Australia copyright law have deep English roots.

Copyright protection in compilations

32 It is necessary that the Tables fall under one of the categories of subject matter accorded protection. Section 7A of the Act reads as follows:-

Literary works include compilation and computer program

7A.—(1) For the purposes of this Act, ‘literary work’ includes —

- (a) a compilation in any form; and
 - (b) a computer program.
- (2) Any copyright subsisting in a compilation by virtue of Part III —
- (a) is limited to the selection or arrangement of its contents which constitutes an intellectual creation; and
 - ...
- (3) For the purposes of this section —
- ‘compilation’ means —
- ...
 - (c) a compilation, or table, of data other than relevant materials or parts of relevant materials,

which, by reason of the selection or arrangement of its contents, constitutes an intellectual creation;

Typically, provided a subject matter can reasonably be called a table, compilation or database, it will almost always fall within the statutory description: see *Copinger* ([17] *supra*) at para 3-27. The information in the Tables in *Punters’ Way* would clearly constitute a table of data other than relevant materials, capable of being termed a “compilation”, and by extension, the Tables would be a “literary work”. It has therefore been common ground that the Tables in *Punters’ Way* are indeed compilations. But, in order for any copyright to subsist in the compilation, the selection or arrangement of its contents must be the product of intellectual creation.

33 It has been rightly pointed out, in *George Wei, The Law of Copyright in Singapore* (SNP Editions, 2nd Ed, 2000) (“*George Wei*”) at p 1331, that the notion of “*intellectual creation*” ties in with the basic copyright principle that only “original” compilations are protected by copyright. The test for compilations remains the same as the general test for a literary work, namely that of originality – whether there is sufficient amount of skill, labour and judgment involved in the creative process.

34 This threshold is heavily fact-centric and it is often a problematic matter of “which side of the line the case falls”: see *Chilton v Progress Printing and Publishing Company* [1895] 2 Ch 29. Similarly, *George Wei* points out at p 54 that:

[while the] basic notion of originality is easy enough to understand and to apply at a broad level of abstraction; it is much more tricky at its margins, especially in the case of fact based works ...

In the same vein, it has also been observed in *Copinger* at para 3-130 that there is no guiding principle as to the precise quantum of labour, skill or judgment required, but rather it is a question of fact and degree and thus has to be determined on the facts of the particular case.

35 As an aside, it can be said that the Anglo-Australian requirement of originality, while taking account of the intellectual effort of the author, has traditionally placed greater emphasis on the time, labour and effort involved. However, we note that several of the cases where copyright was granted in respect of seemingly mundane compilations (such as a timetable index, street directories, football fixture lists and a racing information service) were decided predominantly in the early 19th century to the early 20th century, before computer usage became part of everyday life. With the proliferation of computers and the ready availability of software, the law on copyright ought also to evolve to take into account the ease and convenience that computers bring to the process of compiling in the 21st century. Tediously painstaking works when done manually, such as the tabulation of timetables, or broadcasting programmes, are now effortlessly completed with the touch of a computer key or two, without much exertion or skill being called for. Older decisions that had focussed on the gathering of information as the touchstone rather than the productive effort involved in expression may therefore require reconsideration one day.

36 For now, it can be said that where someone has expended effort in creating something that has some literary value, it is worthy of protection, irrespective of the precise quantum of intellectual input involved in producing it or the literary merits or novelty of the work product. Having stated this general proposition, we should caution that “[w]hen the particular form of expression contains facts and information, it is not helpful to refer to the “rough and practical test [in *University of London Press, Limited v University Tutorial Press, Limited* [1916] 2 Ch 601 (“*University Tutorial Press*”) at 610] that what is worth copying is prima facie worth protecting””: see *IceTV Pty Limited v Nine Network Australia Pty Ltd* [2009] HCA 14 at [31].

37 This is because the law of copyright does not protect ideas, facts or information. It is only the particular form in which the ideas, facts or information is presented after creativity has been added to the mix that may be protected. Similarly, it is not the preparatory efforts or process of

gathering facts that is protected. Rather it is the thought effort involved in creating the particular form of expression that is embraced by copyright. Not infrequently, the expression of data, say, through an alphabetical listing, will involve little ingenuity or skill beyond mechanical labour or routine programming. In such matters, it may be difficult to argue that copyright protection is called for.

38 In assessing copyright for compilations, in particular, we think it is always profitable to bear in mind the four key principles discerningly summarised in *Feist Publications Inc v Rural Telephone Service Company Inc* 499 US 340 (1991). First, facts are not copyrightable. Second, compilations of facts, however, are generally copyrightable. Third, the *sine qua non* of copyright is originality. Fourth, originality simply means that the work was independently created by the author and that it possesses some minimal degree of creativity, the level of creativity required being extremely low: see *George Wei* ([33] *supra*) at pp 84–85.

39 In this matter, the Second Issue of whether copyright subsists in the Tables in *Punters' Way* and if so whether the Appellant has infringed that copyright, rests primarily on the fourth principle – the existence of a minimum degree of creativity independently exercised by the author. However, before addressing the Second Issue, we turn now to the prior First Issue, which deals with whether the Tables were independently created by the Respondent as an author.

The First Issue: Is the Respondent entitled to assert copyright protection as the author of its publication?

40 A leading treatise on intellectual property, Staniforth Ricketson and Christopher Creswell, *The Law of Intellectual Property: Copyright, Designs & Confidential Information* (Lawbook Co, 2nd Ed (Revised), 2010 release) (“*Ricketson*”) at para 7.45 states that originality refers to “the contribution which is made by the author to the form in which the work is expressed”. This approach was underscored in the storied decision of Isaacs J in *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49, where it was noted (at 55–56):

in copyright law the two expressions ‘author’ and ‘original work’ have always been correlative; *the one connotes the other*. [emphasis added]

41 It seems plain to us after our brief overview of the copyright scheme above that ever since the enactment of the Statute of Anne, the objective of copyright law has been to encourage the creativity of natural authors. *The identification of the author is therefore a key function of copyright law as that is the person who is entitled to the benefits conferred by law*.

42 Returning to the facts, it is crucial to note that the Respondent unequivocally pleaded in its Statement of Claim (Amendment No 1) that it *alone* was the original author of the Tables in *Punters' Way*; and that the

Tables were the intellectual creation of the Respondent. No human individuals were identified. *Further, no copyright claim was made in respect of the software that was responsible for generating the relevant tables.* For ease of reference we reproduce the relevant portion of the pleading:

8. In particular, most of the information that was compiled in ‘Punters’ Way’ is specially tabulated according to its nature and contents. *Among other information, there is a set of four tables which is specially compiled by the [Respondent].* This set of tables is compiled in a sequence after very careful consideration and trial runs. It gives [readers] quick reference and useful guides. *The [Respondent] creates this compilation and is its author. It is the [Respondent’s] original literary work and there are no similar horse-racing publications either within Singapore or outside Singapore that has compiled the four tables in such a manner.* [emphasis added]

43 It should be noted that the Respondent had not pleaded *ownership* of the Tables. *Authorship and ownership are not synonymous terms.* The former refers to the concept of creating and the latter to one of possessing proprietary rights. An author need not be an owner and the converse is equally true. Further, the authorship of the Tables was not pleaded as one of joint-authorship by the Respondent’s employees. The crucial issue which therefore arises is whether the Respondent, as a body corporate can indeed legally be considered an author of a copyrighted work assuming that this was factually what happened. We shall now consider this issue.

Who is an author?

44 First, the Act, and similarly the Australian Copyright Act 1968, is silent as to the definition of “author”, except to say in s 7 that an author, in relation to a photograph, means the person who took the photograph. As a result, the answer to who an author is can only be deduced from other sources.

45 A useful starting point is s 9 of the UK Copyright, Designs and Patent Act 1988 (c 48) (UK) (“the 1988 UK Act”). Section 9(1) of the 1988 UK Act provides that an “author”, in relation to a work, means the person who creates it. This definition is reiterated in *Words and Phrases Legally Defined* vol I (David Hay gen ed) (LexisNexis, 4th Ed, 2007) at p 212.

46 Second, a closer examination of s 27 of the Act seems obligatory (in the light of the Appellant’s arguments) in order to ascertain the legislative intent of who an “author” might be. Section 27 provides the following:

Original works in which copyright subsists

27.—(1) ...

...

(2) Subject to the provisions of this Act, *where an original literary, dramatic, musical or artistic work has been published —*

- (a) copyright shall subsist in the work; or
- (b) if copyright in the work subsisted immediately before its first publication, copyright shall continue to subsist in the work,

if, but only if —

- (c) the first publication of the work took place in Singapore;
- (d) the author of the work was a qualified person at the time when the work was first published; or
- (e) the author died before that time but was a qualified person immediately before his death.

...

(4) In this section, ‘*qualified person*’ means a citizen of Singapore or a person resident in Singapore.

[emphasis added]

47 The Appellant argued that s 27 of the Act requires an author to be a “qualified person”, and as “qualified person” has been defined to mean “a citizen of Singapore or a person resident in Singapore” in s 27(4) of the Act, the Respondent as a body corporate cannot claim to be an author under the Act. We have difficulties with this contention.

48 The Judge, in our view, was correct in holding that sub-ss 27(2)(c), (d) and (e) of the Act are disjunctive, and not conjunctive. This is also the settled Australian position: see below at [49]. Australia, as a signatory to the Berne Convention for the Protection of Literary and Artistic Works (“the Berne Convention”) had to give effect to Art 3(1) of the Berne Convention, which sets out alternative connecting factors based on an author’s personal status and the place of first publication of the work. Protection will be accorded where one of the connecting factors is established. Having acceded to the Berne Convention in December 1998, Singapore has also unambiguously agreed to comply with the minimum terms set out by the Berne Convention. In any event, as s 27 of the Act was modelled on s 32 of the Australian Copyright Act 1968, we do not think it can be seriously argued that the position in Singapore differs from the Australian one on this.

49 *Ricketson* ([40] *supra*) at para 5.10 confirms that only one of the “connecting factors” is required by s 32 of the Australian Copyright Act 1968 to be present, at the time the type of work or subject matter in question is created or made, for copyright to subsist. These connecting factors refer either to the personal status of the author or maker of the work or other subject matter at the time of making (“the personal criterion”) or to the place of first publication of the subject matter (“the territorial criterion”). It is therefore abundantly clear that the personal criterion and the territorial criterion are meant to be alternatives, and fulfilling either criterion would suffice.

50 We note that *George Wei* ([33] *supra*) at p 288 n 118, also takes the same view that:

s 27(2) essentially sets out two *alternative* connecting factors for published works, namely, first publication in Singapore (s 27(2)(c)) and the personal status of the author as a qualified person (s 27(2)(d) & (e)). It is submitted that it is not necessary under s 27(2) for published works to be both first published in Singapore and made by a qualified person at the relevant time. Either factor will do ... ***It is submitted that limbs (c), (d) and (e) of s 27(2) do not set out cumulative requirements.*** [emphasis in original in italics; emphasis added in bold italics]

Satisfying either the personal criterion or the territorial criterion is sufficient for the work to acquire copyright in Singapore. The Judge, therefore, quite correctly rejected the Appellant's submissions at trial that the author must be a qualified person, as this would make s 27(2)(d) mandatory, contrary to the intent of the statute.

51 The Judge was also correct when she held that the purpose of s 27(2) was only to ensure that a claim for copyright had sufficient connection with Singapore in order to warrant protection under the Act, rather than to provide a definition of who could be an author of a subsisting copyright under the Act: see [26] of the Judgment.

52 However, the Judge erred in declaring subsequently (at [25] of the Judgment) that "although the author of the work must be a qualified person *for the purposes* of meeting the criteria of s 29(2)(d), there is no statutory provision that exhaustively states that the only 'author' relevant for all purposes of the Copyright Act *must* be a qualified person" [emphasis in original]. The Judge relied on s 2 of the Interpretation Act (Cap 1, 2002 Rev Ed) ("the Interpretation Act") (which defines "person" to include any company or association or body of persons, corporate or unincorporated) to substantiate her point, and added, for good measure, that there are also no statutory provisions in the Act which state that an author must necessarily be a living person: see [25] of the Judgment.

53 While it is true that s 2 of the Interpretation Act defines "person" as including a company, it must be remembered that the words and expressions defined in the Interpretation Act only have the meanings respectively assigned to them in the absence of anything in the subject or context of the relevant statute that is inconsistent with such meanings. As a matter of principle, in interpreting statutes, the general ordinarily gives way to the special or particular.

54 It is also interesting to briefly digress and note that an altogether different position has been statutorily adopted in Malaysia. In the Malaysian Copyright Act 1987 (Act 332) (Malaysia), the term "qualified person" has been expanded to include:

(a) in relation to an individual, ... a person who is a citizen of, or a permanent resident in, Malaysia; and (b) in relation to a body corporate, ... a body corporate established in Malaysia and constituted or vested with legal personality under the laws of Malaysia ...

The Malaysian definition of “qualified person” is thus fundamentally different from the definition in the Act and the Australian Copyright Act 1968, both of which do not explicitly provide for a body corporate. It therefore does not come as a surprise that the Malaysian courts have had no difficulty in interpreting the word “author” as referring not only to natural persons, but also to companies: see *Creative Purpose Sdn Bhd v Integrated Trans Corp Sdn Bhd* [1997] 2 MLJ 429. However, since the Act is silent on this point, can it similarly be inferred that non-living “persons” could be authors for the purposes of copyright?

55 Returning to the legal position here, it is also noteworthy that leading treatises in Australia and England take the view that only natural persons can be qualified persons. *Ricketson* ([40] *supra*) at para 5.20 unequivocally points out that:

In the context of s 32 of the *Copyright Act 1968* (Cth) [(equivalent to s 27 of the Act)] (which is concerned with works), it is clear that ‘qualified person’ applies only to natural persons. [emphasis in original]

56 Likewise, Kevin Lindgren QC *et al*, *Copyright and Designs* vol 1 (LexisNexis, 2004) at para 12,040, states:

It is important to note that a body corporate cannot be a ‘qualified person’ in relation to original works. The reason for this is that the ‘qualified person’ and first owner of copyright in an original work is the ‘author’, and although a body corporate may be the copyright owner by virtue of the operation of a contract of employment, an assignment, or in any of the other ways expressly provided for in [the Australian Copyright Act 1968], *it cannot be an author*. [emphasis added]

We also note that *Copinger* ([17] *supra*) at para 4-10 has taken the view that:

[w]ith very limited exceptions [such as computer-generated works and old photographs], *the ‘author’ of these categories of work must be a natural person*. The fact that one person is acting as employee of another cannot affect the question of authorship, nor can the fact that one person is an agent for another ... [emphasis added]

With these views in mind we will now excavate further the historical and legislative policy considerations undergirding this issue.

A non-living author?

57 The 19th century saw the emergence of the European doctrine of *droit moral* under which authors’ intellectual and creative rights in their works were recognised in addition to their purely economic rights. Continental jurisdictions therefore regarded an author’s work as an emanation or

extension of his or her personality, inseparably linked with his or her honour and reputation and thus deserving of a long period of protection: see *Ricketson* at para 6.55. This concept naturally leads to the conclusion that an author must be a human being.

58 Hugh Laddie *et al*, *The Modern Law of Copyright and Designs* vol 1 (Butterworths, 3rd Ed, 2000) (“*Laddie*”) points out at para 10.8 that the Berne Convention is concerned with the rights of human authors to their original literary, dramatic, musical and artistic works. As a consequence, Laddie further observes, that the Continental legal tradition has always been to regard the author’s right to his property as the starting point, and to look upon limitations to its term as a regrettable necessity. It is because of this that Art 7 of the Berlin Revision of the Berne Convention in 1908 provided that the term of protection should include the life of the author plus 50 years after his death. The extension of the term of copyright was inextricably linked to increased life expectancies at that time.

59 The UK’s approach to the duration of copyright has been slightly different from that of the Continental jurisdictions in that “those who seek legislation in favour of exclusive privileges which restrain trade and freedom of communication ought to show that they are justified in the public interest”: see *Laddie* at para 10.8. This approach equally takes into account the fact that the starting point of copyright is a human author. Both the UK Copyright Act 1911 and the 1988 UK Act have provided for the term of protection as the author’s life plus 50 years. This was supposed to reflect two generations of heirs of the author. However, with increased life expectancy in developed countries, especially in regional groupings where the majority of member countries are developed with relatively high standards of living such as the European Union, it was unsurprising that the European Commission issued a directive in 1993 which increased the *post mortem auctoris* period to 70 years, and this has been implemented in the UK since 1995.

60 Since the duration of copyright protection has always been based on the author’s life expectancy and the rationale for the *post mortem auctoris* term was so as to benefit two generations of the author’s heirs, it is patently clear that incorporated bodies were never contemplated to have been “authors” for the purposes of copyright. It would be absurd to suggest that a company could have a lifespan, let alone generations of heirs. Thus, it must follow that authors have to be living persons.

61 However, the Judge found that there was no difficulty in accepting that an incorporated body could be the author of an original work: see [31] of the Judgment. The Judge considered that it would be (at [32] of the Judgment):

consistent with the statutory regime found in [the Act] if the copyright in the work is found to expire 70 years after the expiration of the calendar year in which the work was first published.

This is provided for in ss 28(3) and 29 of the Act in situations where a work is unpublished before the death of the author, or where it is an anonymous and pseudonymous work.

62 In our view, the Judge plainly erred on this point. Neither of these scenarios is present in this case. There was no posthumous publication because if the Respondent qualifies as the “author” of the Tables, *Punters’ Way* would have been published during the “lifetime” of the Respondent. Similarly, if the Respondent was the author of the Tables, then the Tables cannot possibly be an anonymous or pseudonymous work and s 29 does not apply. The prerequisites for the operation of either section have not been satisfied by the Respondent.

63 Sections 28 and 29 of the Act are *in pari materia* with ss 33 and 34 of the Australian Copyright Act 1968. It has been established that the rationale of these provisions is to encourage the ultimate disclosure and dissemination of protected works and the information and knowledge that they contain. This objective would not be achieved if such works remain protected indefinitely and are withheld from the public domain. Superimposing ss 28(3) and 29 onto the factual matrix at hand would be wrong as these provisions plainly do not contemplate scenarios where an incorporated body is an author. Since it is not possible to rely on the date of publication as the litmus test for the expiry of the copyright, it appears that if a company qualifies as an author it would possess an indefinite and extraordinary perpetual copyright to its work. Pertinently, we should add, sub-ss 28(3) and 28(5) of the Act expressly refer to the “death of an author” as the reference event for copyright protection in certain instances. Why would this be the case if non-living authors were intended to be embraced by the Act?

64 The rationale underpinning copyright protection is not about the utility of the work, but rather the protection of the originality of the expression employed to communicate ideas. It is therefore unhelpful to say that the contents in a compilation will become obsolete, irrelevant or useless after some time, and therefore not worth copying or protecting, for as long as there is evidence of originality in the work, protection is conferred. Even if the work becomes obsolete after time, the copyright owner would still be able to bring an action against anyone who utilises the work for an infringement of copyright, regardless of the relevancy of the work at that time. Should companies and like entities qualify as authors, they would be entitled to claim a perpetual monopoly over their works to maximise the economic returns of copyright protection. This would be contrary to the underlying policy of the Act which is to accord copyright

protection for a limited duration that best strikes a balance between the competing public and private interests: see above at [26]–[29].

65 It also seems obvious that authorship by a company could never have been contemplated by the Statute of Anne as companies operating as distinct legal entities were not a typical feature of commerce when it was enacted. In the UK, prior to the mid-19th century, incorporation was only done by way of royal charter or by private Act of Parliament. However, the Crown and Parliament were usually suspicious of lending their dignity and the benefits of separate personality to commercial organisations. As a result, most joint-stock companies did not have separate legal personality. Parliament finally permitted the incorporation of companies by registration when it passed the Joint Stock Companies Act 1844 (7 & 8 Vict c 110) (UK).

66 It was only in the late 19th century that there was a proliferation of incorporated entities in the UK and whereupon a registered company could acquire separate personality upon registration. This principle of separate legal corporate personality was affirmed in the celebrated case of *Aron Salomon (pauper) v A Salomon and Company, Limited* [1897] AC 22.

67 From the foregoing, it is clear that the historical origins of the Act envisaged rights to be accorded to natural persons and not corporate bodies, and that legal rights flowed only from human authorship. In addition, it is telling that the duration of copyright in subject matter other than works is merely stated as continuing to subsist until the expiration of 70 (or 50) years after the expiration of the calendar year in which the recording/film/broadcast was first published/made. Our views are further fortified by the recent decision of the Australian Federal Court of Appeal in *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2010] FCAFC 149 (“the *Telstra Appeal*”), where two members of the quorum stated unequivocally (at [100] and [134]) that under Australian law an author had to be a human author.

68 We note that the Judge also relied on the case of *Alteco Chemical Pte Ltd v Chong Yean Wah* [1999] 2 SLR(R) 915 (“*Alteco*”), to support the proposition that an incorporated body could be the author of a copyright protected work. In that decision, it appears that a “modern” interpretation of authorship was created, suggesting that the author had become the person who made the necessary arrangements and paid for the creation of the work. A company could therefore be the author of the work if its employees created the work product.

69 However, the High Court in *Alteco* did not expressly declare that a company could be an author of a work, a point acknowledged by the Judge. Further, the decision in *Alteco* seemed to have blurred the distinctions between the concepts of authorship and ownership. In *Tan Tee Jim and Ng-Loy Wee Loon, “Intellectual Property Law”* (2000) 1 SAL Ann Rev 230 at 235–237, 251 (“*Tan and Ng*”), the authors observe that the *Alteco* case

failed to make the distinction between authorship and copyright ownership in s 30 of the Act. As *Tan and Ng* rightly point out, in essence what the Court did was to imply a constructive trust against the author of the work, thereby allowing the parent company to own the work, and there was no necessity for a “modern” interpretation of the word “author”.

70 This view has been similarly reiterated in *George Wei* ([33] *supra*) at pp 1391–1393. He points out that the Act adequately governs the law on ownership, even for foreign works which enjoy copyright in Singapore. Additionally, it is observed that the person who made arrangements for the production of a work, or who paid for the work – as in the case of *Alteco* – would not be entitled to claim to be the author of the work as this did not generally relate to authorship skills. We agree. *Alteco*’s innovative tailoring of the term “author” ought not to be followed.

71 It must be emphasised that a work created by an employee author has a limited duration dependent on the life of the employee even if first ownership vests in the employer. Thus while the law accepts that a person other than the author may be a first owner, the question of who the author is remains a distinct and an important one.

72 We therefore reject the Respondent’s argument that an “author” for the purposes of copyright law can and should extend to corporate entities. It would clearly be against public policy to allow copyright protection in perpetuity. This would be the scenario should a company be deemed capable of being an author for the purpose of copyright. Section 2 of the Interpretation Act ought not to be incorporated into the rubric of copyright law, and an “author” must be a natural person in copyright law.

Can a natural author be identified?

73 The identification of an author is still pertinent as s 27 of the Act provides that in order for copyright to subsist in a work, the work must be original. As mentioned in [40] above, originality is closely related to the author. This principle was recently affirmed in *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2010] FCA 44 (“*Telstra*”). Gordon J masterfully condensed the position thus at [20]:

... ‘originality’ under [the Australian Copyright Act 1968] ‘means that the creation ... of the work required some independent intellectual effort’ and/or the exercise of ‘sufficient effort of a literary nature’. ... [E]ach phrase confirms that for a work to be sufficiently original for the subsistence of copyright, ‘substantial labour’ and/or ‘substantial expense’ is not alone sufficient. More is required. What that more is will, of course, vary from case to case but *must involve ‘originality’ by an identified author in an identified work.* [emphasis added]

74 In the *Telstra Appeal* ([67] *supra*) at [32], Keane CJ heartily affirmed Gordon J’s *dicta*:

Authorship and originality are correlatives. The question of whether copyright subsists is concerned with the particular form of expression of the work. You must identify authors, and those authors must direct their contribution (assessed as either an ‘independent intellectual effort’ of a ‘sufficient effort of a literary nature’) to the particular form of expression of the work. *Start with the work. Find its authors.* They must have done something, howsoever defined, that can be considered original. [emphasis added]

75 We agree with this approach. An author must first be identified before the work in question can be deemed to be original. In fact, the Respondent’s counsel acknowledge in the Respondent’s skeletal submissions, that all that is required for the test for originality is that “the work originates with an author or joint authors from some independent intellectual effort”. Since the Respondent is unable to assert that it is the author of the work as a body corporate, the remaining question at this juncture is whether the Respondent is even able to identify specific human authors of the Tables. To avoid doubt, we should add that it is not necessary to name each and every author to make out a claim for copyright protection but it has to be shown that the work product in question has been generated from human author(s) working alone or collaboratively, *ie*, the existence of such persons must be clearly established.

76 The Respondent’s witness Phan Tjun Sern (“Phan”) had stated in his Affidavit of Evidence in Chief (“AEC”) that *Punters’ Way* was a continuing project, developed from ideas and valuable contributions by racing professionals and readers. However, ideas and contributions put forward by the readers and horse racing experts would not be protected by the scope of copyright, as copyright protects the material form of a work, and not the ideas in the work. Even if the suggestions could be protected, the readers and horse racing experts were not employees of the Respondent, and correspondingly, the Respondent would not be able to claim copyright ownership of the Tables, if any.

77 Further, relying on a passage in *Laddie* ([58] *supra*) at para 3.94, the Respondent submits that the definition of a literary work includes a compilation, and the author of such a work is the person who gathers or organises the collection of material and who selects, orders and arranges it. The Respondent then contends that as its employees were the people who gathered, organised, selected, ordered and arranged the information and data, they were the authors of the Tables, which was an original work capable of being protected by copyright.

78 However, we hesitate to accept this definition of authors in this situation. Although the contributions of these individuals may have led to the compilation of the work, they were not part of the actual process of compilation. In this context, the *Telstra Appeal* at [92] is instructive. It affirmed that where the work of individuals was not collaborative, but was

instead merely organised to facilitate the production of the work, this would not be collaboration of the kind contemplated by the definition of joint authorship.

79 Here, the collection of the horse-racing data, such as the horses' and jockeys' names, as well as their track work records, and the organisation and selection of such data were either computerised, or done by separate people. However, each individual's responsibility and contribution (which has not been particularised) was, based on the evidence before us, insufficient to render the individual an author, or joint author of the Tables.

80 It certainly cannot be said that a reader who writes in with suggestions for the improvement of the publication can be considered an "author". Neither can the IT employee who entered the names of the horses in a race be considered an "author" of the compilation. Although it is undeniable that both contributed to the end product, data aggregation or input is not creativity.

81 Not infrequently, in cases involving a high degree of automation, there will be no original work produced for the simple reason that there are no identifiable human authors. This may well be the reason why the Respondent was unable to identify any particular individual or individuals or a specific group of people as being the human authors of the Tables. However, whatever the case may be, it is clear that copyright cannot subsist without a human author, and the Respondent is unable to even begin to satisfactorily identify any author, let alone, authors. It remains unclear who was responsible for the compilations. Even assuming *arguendo* that the Respondent's employees had some authorship role in the compilations, the evidence did not satisfactorily establish when copyright protection attached.

82 In the circumstances, without the identification of a human author from whom the work originates, there can be no "original work" capable of copyright protection. We therefore find that the Respondent's claim that copyright subsists in the Tables that were "authored" by it fails.

The statutory presumptions

83 Additionally, the Act contains statutory presumptions designed to assist a claimant in a copyright action for infringement of copyright. We now examine these presumptions to determine if they can assist the Respondent's claim.

84 The Judge found (at [35] of the Judgment) that the presumption under s 131 of the Act applies – where a name purporting to be that of the author of a literary work appeared on copies of the work as published, then it shall be presumed unless the contrary is established that the person is the author of the work. The Judge therefore accepted that the Respondent was

the author of the Tables as its name appeared on *Punters' Way* and the onus was on the Appellant to disprove the Respondent's authorship.

85 It is pertinent, however, that the Respondent itself acknowledges that s 131 of the Act is not applicable in the present circumstances, as the Respondent's name appears only as "Publisher" in *Punters' Way*, and not as the author.

86 The statutory presumption which the Respondent might be entitled to rely on would be s 132 of the Act, which provides:

Presumptions in relation to publisher of work

132. Where, in an action brought by virtue of this Part in relation to a literary, dramatic, musical or artistic work, section 131 does not apply, but it is established —

(a) that the work was first published in Singapore and was so published during the period of 70 years that ended immediately before the commencement of the calendar year in which the action was brought; and

(b) that a name purporting to be that of the publisher appeared on copies of the work as first published,

then, unless the contrary is established, copyright shall be presumed to subsist in the work and the person whose name so appeared shall be presumed to have been the owner of that copyright at the time of the publication.

As the Respondent is identified as the publisher in *Punters' Way*, the Respondent contends that copyright subsists in the Tables, and the Respondent would be presumed to be the owner.

87 Section 128 of the Australian Copyright Act 1968 is *in pari materia* with s 132 of the Act, and this issue was comprehensively dealt with in *Telstra* ([73] *supra*). We agree fully with Gordon J's analysis on s 128 of the Australian Copyright Act 1968 (equivalent to s 132 of the Act) at [37]:

In my view, the Applicants' reliance upon ss 128 and 129 is misplaced. Each section reinforces the importance of identifying the author or authors of the work in suit. In understanding the operation of the presumptions it is important to note the distinction between identifying an author or authors of the original work and the identity of the author or authors of the original work. Lest it be overstated, the [Australian Copyright Act 1968] fixes on the author or authors If an author or authors (within the meaning of the [Australian Copyright Act 1968]) cannot be identified at all, in contradistinction to a situation where the author's or authors' exact identity cannot be identified, copyright cannot subsist. On a reading of ss 128 and 129, it is the latter situation to which the [Australian Copyright Act 1968] is directed. [emphasis in original in italics; emphasis added in bold italics]

88 The Respondent also relies on the case of *Waterlow Publishers Ltd v Rose* [1995] FSR 207 (“*Waterlow*”), which referred to the presumption in s 20(4) of the UK Copyright Act 1956 (4 & 5 Eliz 2 c 74), which is similar to s 132 of the Act. In *Waterlow*, the fact that the publisher’s name appeared on the copies of the work was enough to justify a finding that the presumption applied, in accordance with the intention of s 20(4). Even though there were no identifiable authors, copyright was held to nonetheless subsist in the relevant work, with the publisher being the owner of the copyright.

89 However, cases which have relied on the equivalent of the s 132 presumption, such as *Waterlow* and *Microsoft Corporation v DHD Distribution Pty Ltd (t/as Austin Computers)* (1999) 45 IPR 459, did not deal with the scenario where the very fact of authorship took centre-stage. Further, the presumption was also not decisive in the dispute and it was not argued in those cases that an author could not be identified at all. These cases are therefore of limited assistance here. We also note that *Waterlow* appears to be an *ex tempore* decision. This is another reason why undue deference should not be accorded to it.

90 *Laddie* ([58] *supra*) at para 3.94 states that where no name purporting to be that of the author appears on the work as first published, but that of the publisher appears, there is potentially available under s 104(4) of the 1988 UK Act a presumption that the named person was the owner of the copyright at the time of publication. However, Gordon J in *Telstra* (at [39]) thought that at its highest, this passage merely suggests that it may be necessary in particular instances to rely upon the statutory presumptions. Further, these presumptions have little or no role to play where the question of subsistence of copyright in each of the works is the central issue between the parties.

91 Pertinently, it has also been observed in *Laddie* at para 39.85:

All that the presumption does is to compel the court to reach the appropriate conclusion in the absence of evidence to the contrary. If the opponent does offer evidence in rebuttal (sufficient to satisfy the legal requirement of *some* evidence) the presumption disappears, and the case is in the court’s hands free from any rule. [emphasis in original]

As authorship is in dispute in the present case and the Appellant has adduced evidence that copyright does not subsist in the Tables since there is no author, the s 132 statutory presumption has been displaced.

92 We round up our analysis of this issue by emphasising that it is settled practice that the necessary elements of authorship, ownership, validity and subsistence must be adequately pleaded for cases involving copyright infringement: see *Bullen & Leake & Jacob’s Precedents of Pleadings* vol 2 (Lord Brennan and William Blair gen eds) (Sweet & Maxwell, 14th Ed, 2001) at para 66-Q1. The Respondent has found itself in a quandary having

pleaded that the company is the author of the Tables and having maintained this stance throughout the High Court proceedings. Had the Respondent merely pleaded to be the owner of the copyright, as the presumed owner of the copyright assigned to it by its employees, the Respondent would still have had the *locus standi* to maintain a claim of infringement against the Appellant. The Respondent tried to salvage its case by initially submitting to this Court that the Respondent is both the author *and* owner of the Tables. However, in the course of the hearing of this appeal, the Respondent abruptly changed tack and submitted that it was primarily arguing its case on the basis of ownership; and *alternatively*, authorship.

93 Regrettably, such a course was no longer open to the Respondent on the basis of its pleaded case and the conduct of the proceedings below. It had unequivocally nailed its colours to the mast and the Appellant had contested the case on that basis. The Respondent cannot now rely on an alternative claim of ownership which was neither pleaded nor advanced in the proceedings below.

Summary of the First Issue

94 In summary, the concept of authorship is integral to copyright, and no such protection can be accorded without an author from which an original work emanates, and from which the legal rights flow. We can do no better than to reiterate the views of Gordon J in *Telstra* ([73] *supra*) at [35]:

[A]uthorship is central to the determination of whether copyright subsists. To suggest that copyright does not require the identification of authors where a work is sufficiently original ... puts the cart before the horse. It ignores the fact that it is the original work of an author or authors who contribute to the particular form of expression of the work and reduce the work to a material form that is the act giving rise to the statutory protection of copyright.

95 As the Respondent could not identify a human author or authors and we find that an incorporated body cannot be an author of a copyrighted work; we reject the Respondent's assertion that it was entitled to copyright protection *qua* author. Accordingly, we do not find that copyright subsists in the Tables.

The Second Issue: If the Respondent is entitled to copyright protection, has the Appellant infringed its rights?

96 As we disagreed with the Judge that the Respondent is entitled to copyright protection, it is, strictly speaking, unnecessary for us to delve into the issue of copyright infringement at all. However, out of deference to counsel, who have made extensive submissions on this issue, we shall briefly give our views on this as well.

97 To start with, it is common ground that the information in the Tables is freely available in the public domain. The Respondent acknowledges that the information is “mostly, if not all, provided in raw form by the related Turf Club. Publishers usually obtain these data from the Turf Club”.

98 The Judge found that the Respondent had organised the information that was to be included in *Punters’ Way*; set up tables of the information and decided how best the tables should be presented in a reader-friendly manner; studied, experimented and compiled the information to be placed in *Punters’ Way*; and constructed the tables found in *Punters’ Way*. The Judge noted (at [40] of the Judgment) that the threshold for originality was not set at an exceedingly high level. She also found that there was sufficient skill and labour applied to the Tables, and agreed with the Respondent that there was originality in terms of the selection, arrangement and presentation of the information in the Tables: see [41]–[43] of the Judgment.

99 More specifically, the Judge eventually (at [41] of the Judgment) held that the transformation of such “intangible and unexpressed ideas given by different personnel ... into the manifested forms as shown in the publications naturally gave rise to an inference that some effort and labour had been involved”.

100 We agree with the Judge in so far as she held that the Respondent’s copyright claim cannot be in the information or data itself, as this is freely available in the public domain. Copyright, if any, would only exist in the selection, arrangement and presentation of the information. It is trite that there cannot be a monopoly in facts or information, but only in the way of presenting or expressing them and it is always a question of fact whether the skill and labour involved in the presentation or expression justifies the incidence of copyright: see [33]–[37] above.

101 We also agree with the Judge that the threshold for originality is traditionally low: see [36] and [38] above. In *University Tutorial Press* ([36] *supra*) at 608–609, Peterson J summarised the meaning of originality in the following classical passage:

The word ‘original’ does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and, in the case of ‘literary work’, with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work—that it should originate from the author.

102 The threshold of originality in compilations has also been helpfully summed up in *Ricketson* ([40] *supra*) at para 7.60:

[S]omething more is required by way of original authorial contribution than simply the act of giving material expression to something. ... [This poses problems] where the work is of a factual or informational kind, and the author's contribution consists of an ordering, arrangement or summarising of that information. ... In such a case, ... the requirement of 'originality' assumes a heightened importance It is only the author's presentation of the data that is protected, and this must display or reflect the application of some identifiable element of skill and labour on the part of the author. The final work therefore must be more than a bare recital of facts or figures.

103 In the present situation, while the Tables published in *Punters' Way* contain information extracted from the Turf Club, the Respondent had not merely reprinted the horse-racing data wholesale or in alphabetical order, but had selected information it thought relevant and arranged it in a manner that was thought to be most conducive for readers.

104 We find in this context the approach adopted in *Interfirm Comparison (Australia) Pty Ltd v Law Society (NSW)* [1977] RPC 137 instructive. In that case, Bowen CJ held that despite the fact that the work exhibited little material that could be regarded as having much novelty or originality in the ordinary sense of that term, it was specifically drawn for a particular profession and for a particular purpose and, although it used much old and publicly-known material, it presented it in a new form as the work of the author. Similarly, despite the fact that the material used in the Tables was easily accessible to all, the information was *presented* in a distinct form which would attract copyright protection.

105 We therefore accept that the Tables in *Punters' Way* had a "quality of character not possessed by the raw material": see *Fortuity Pty Ltd v Barcza* (1995) 32 IPR 517. This is evident as the raw information provided by the Turf Club is distinct from what was eventually published in *Punters' Way* which was more comprehensible.

Was there a causal connection?

106 The Judge found (at [45] of the Judgment) that as the Appellant's managing director and sole witness, Levar Steven Michael ("Levar"), was employed by the Respondent, he had access to the Tables. However we pause to note that the Judge incorrectly found Levar to have been previously employed by the Respondent. In actual fact, Levar had set up his own consultancy services to race clubs and to those who transact in the sale and purchase of horses. He had done this consultancy work for the Respondent in June 2006. Additionally, although he was also the horse-racing expert on the Respondent's website, <<http://www.winner21.com>>, for around six months, he was never an employee of the Respondent.

107 Nevertheless this distinction is merely technical, as Levar's connection with the Respondent was immaterial since *Punters' Way*, as well as the raw data were freely available in the public domain and Levar could

easily have access to *Punters' Way*. As long as there is substantial similarity between the Appellant's and Respondent's work, and it can be shown that the Appellant had access to the Respondent's work, this will give rise to a *prima facie* inference of copying by the Respondent. But it must be remembered that this is not just a quantitative assessment, it is essentially a qualitative test.

108 It is established that so long as a causal connection can be established between the two works, it is not consequential if the copying is direct or indirect. It is clear in this situation that Levar, or any of the Appellant's employees could easily purchase a copy of *Punters' Way* and adopt its presentation in subsequent publications of *Racing Guide*.

109 It is also apparent that over time, *Racing Guide* publications morphed and began to appear somewhat similar to *Punters' Way*. While there used to be an additional "Selections" feature between Table 1 (Race Card) and Table 2 (Results Panel) of *Racing Guide*, this was subsequently altered such that this feature was incorporated into Table 2, resulting in identical sequential arrangements of the Tables in both publications. Additionally, the Appellant had included a "J-1-2-3" feature in Table 1 (Race Card) of *Racing Guide*, which mimicked the "R-1-2-3" feature in *Punters' Way*. These were only added after Levar had joined the Appellant as managing director in 2007. Further, the column for the total runs of the horses was not featured in *Racing Guide* prior to Levar's taking over the helm of the Appellant.

110 From the above, it is apparent that the Tables in *Racing Guide* were derived from the Tables in *Punters' Way*.

Was a substantial part of the work copied?

111 We agree with the Judge that the Tables in *Racing Guide* were arranged in a sequence that was exactly the same as that found in *Punters' Way*. However, although the Judge had found that there was copying and infringement of the Tables in *Punters' Way* by *Racing Guide* from June 2007–June 2008, no copies of the *Punters' Way* editions from June 2007–December 2007 were exhibited. In fact, the earliest copy we have for comparison would be the January 2008 issue. Thus, no finding of copying ought to have been made for the months of June 2007–December 2007.

112 On a comparison of the January 2008 issues of both publications, we agree with the Judge that the eight columns of Table 1 (Race Card) found in *Racing Guide* were arranged in substantially the same sequence as that in *Punters' Way*. There was only a slight difference in that the last two columns of Table 1 were interchanged. In addition, Table 2 (Results Panel) was substantially similar in that both publications included the exact sequence of the top four horses, followed by the "time" column, with a

dollar sign found in each column. Further, both Tables 3 (Track Work) and 4 (Results of Past Performances) were sequentially identical.

113 We also agree with the Judge that the existence of dissimilarities did not necessarily mean that there was no copying. The dissimilarities between *Racing Guide* and *Punters' Way* were either *de minimis* or merely cosmetic. In essence, looking at the manner of presentation and compilation of the horse-racing information as a whole, the Tables in *Racing Guide* incorporated a substantial part of the Tables found in *Punters' Way* even with the minor additions in *Racing Guide*: see the Judgment at [58]. We do not find it necessary to depart from the Judge's finding that, *prima facie*, a substantial part of the Tables had been copied and that this had not been rebutted by the Appellant.

114 Nonetheless this finding of copying by the Appellant is now moot as we have pointed out above that no copyright subsisted in the work. It follows, therefore, that there was no infringement of the Respondent's copyright by the Appellant.

The Third Issue: Has the Respondent established the constituent elements for a passing off action?

115 Apart from pursuing a claim for copyright infringement, the Respondent also claimed that the Appellant had committed the tort of passing off by copying the get-up of *Punters' Way*, which includes the colour code of the front covers, the picture of forward-facing racehorses and the advertisement panel across the bottom of the cover. The Respondent claimed that goodwill existed in the get-up of *Punters' Way* as it had been selling copies since 1977, and the colour code had been in place since 1993. Consequently, the Respondent alleged misrepresentation by the Appellant in adopting a remarkably similar colour coding and using a similar picture featuring forward-facing racehorses on the cover of *Racing Guide*. The Respondent also alleged that it had suffered damage as a result of the passing off.

116 *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 (“*Amanresorts*”) affirmed (at [37]) that the “classical trinity” of goodwill, misrepresentation and damage must be established by the party seeking to claim passing off before an action can succeed. We now proceed to examine whether each of these elements have been satisfied by the Respondent in the present case.

Goodwill

117 The Respondent is required to establish that it had acquired goodwill at the relevant date, which is the date on which the conduct of the Appellant that the Respondent complained of started. The classic definition of goodwill may be derived from *The Commissioners of Inland Revenue v*

Muller & Co's Margarine, Limited [1901] AC 217 at 223–224, which held that goodwill “is the benefit and advantage of the good name, reputation, and connection of a business”.

118 In the present circumstances, the Respondent claimed goodwill in: (a) the colour code for the different race days over a weekend; (b) the picture of forward-facing racehorses; and (c) the advertisement panel across the bottom of the cover. According to the Respondent, the colour code has been in use by *Punters' Way* since 1993 in order to allow punters and readers to easily identify the particular race day they were interested in by the colour of the book. In addition, the Respondent alleges that since 1977, *Punters' Way* has been selling an average of 31,000 copies weekly.

119 Whether a get-up has acquired the necessary distinctiveness is a question of fact. Here, the Respondent has been publishing *Punters' Way* for around 30 years, since 1977. It has also been shown in a market survey done by Nielsen Company in March 2007, that overall the Respondent enjoyed 80% of the market share in the horse-racing industry in Singapore. In addition, Levar acknowledged “that *Punters' Way* was the market leader in Singapore at various stages in its history”. With the Appellant’s own witness acknowledging the dominant presence of the Respondent’s products in the horse-racing market, it ought to be accepted that there is indeed a business within the jurisdiction of Singapore in which goodwill can attach.

120 We agree with the Judge that the Respondent had built up considerable goodwill in the business and overall get-up of *Punters' Way* as *Punters' Way* had adopted the unique colour-coding since 1993, had been sold in a substantial number of stores and newsstands in Singapore, and had been advertised with considerable effort: at [73] of the Judgment. We therefore find that goodwill is attached to the particular get-up of *Punters' Way*.

Misrepresentation

121 The Respondent is also required to show that:

- (a) the Appellant has made a misrepresentation to the relevant sector of the public; and
- (b) such misrepresentation has resulted in or is likely to result in damage to the Respondent’s goodwill.

122 As noted by this court in *Amanresorts* ([116] *supra*) at [69], the elements of misrepresentation and damage are very closely linked, and it is crucial to appreciate that both the misrepresentation and the damage must relate to the Respondent’s goodwill. A misrepresentation is actionable as a tort of passing off only if it causes (or is likely to cause) damage to the Respondent’s goodwill.

123 The essential question is whether the Appellant has made a false representation that led to deception or confusion amongst the relevant sector of the public. The relevant sector of the public would, in this situation, clearly be punters, and people with a keen interest in the horse races. In the case of a claim of adoption of get-up, the real question is whether the get-up adopted by the offending party is sufficiently similar to that of the plaintiff as to give rise to confusion. In proving misrepresentation, it has been previously established in *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903 (“*Tong Guan*”) at [24] that the court is not concerned with the “moron in a hurry” being confused. Rather, the test that is to be applied is whether ordinary sensible members of the public would be confused. It is sufficient that a substantial proportion of persons who are probably purchasers of the goods of the kind in question would in fact be confused.

124 The Judge found that on a perusal of the cover pages of *Racing Guide* and *Punters’ Way*, there was a compelling case that the Appellant had consciously and deliberately made changes to the cover of *Racing Guide* to misrepresent *Racing Guide* as *Punters’ Way*: at [76] of the Judgment. This was especially so since the same colours for the covers were used for the same specific function as those devised by the Respondent. Further, the Judge found that the Appellant had changed the position of its advertisement panel such that it was similar to the Respondent’s publication and that there was also striking similarity between the Chinese titles for both publications. The Judge made her observations on the similarities between the two publications without regard to the market survey done by the Respondent’s expert witness Greg Coops (“Coops”) but nevertheless found that Coops’ evidence only served to reinforce her findings: at [77]–[79] of the Judgment.

125 However, we find that little reliance ought to be placed on the market survey due to the lack of objectivity in the way the survey was conducted. The survey included the comparison of issues of *Punters’ Way* and *Racing Guide* which were published on different days – 19 October 2008 for *Punters’ Way* and 27 April 2008 for *Racing Guide*. The two issues appear to have been deliberately chosen as they were most similar in their get-up – including the colour of the cover page, and the pictures of the horses. The survey was therefore conducted by approximating the two issues which were most similar. However, the stubborn fact remains that these two issues were not published on the same day. Such a comparison would not be a fair test.

126 Additionally, the survey was conducted with the masthead removed. The masthead accounts for one-third of the magazine and would be a key distinguishing feature for punters seeking to purchase a particular magazine. The target survey audience were also questioned as to whether

they could identify the magazines without the name and title of the magazines. This would not be a fair comparison.

127 Further, one of the questions asked in the survey was “how likely would it be for you to confuse these two magazines if you were in a hurry and you were selecting one of them?”. This question would lead to an inaccurate finding of misrepresentation to the public as it approximates the “moron in a hurry” test. Therefore, we disagree with the Judge that the survey conducted by Coops was appropriate and representative of the public’s view.

128 With respect, we also find that the scenario described by the Judge, that race-goers who were “less educated or who were late and/or were in a hurry to get into the grounds of the race track” (at [87] of the Judgment) would be confused and would buy a racing guide thinking it was *Punters’ Way* when it was actually *Racing Guide*, was flawed, as this similarly approximated the “moron in a hurry” test.

129 The correct test that should be applied is that of the imperfect recollection test – not to compare both publications side by side, but to take into account the fact that the “confusion which may occur will take place when the customer has in his mind his recollection of the plaintiff’s mark, which may well be only an idea of the whole or actual mark”: see *Tong Guan* ([123] *supra*) at [26].

130 It appears unlikely to us, in the absence of cogent evidence, that the punting audience to which both publications are targeted are undiscerning. They would know precisely which publication they wanted to purchase and would ask for either *Punters’ Way* or *Racing Guide*, two very dissimilar names, when purchasing the magazine. The assumption that customers purchase the magazines on the basis of colour has not been proved by the Respondent, and may in fact not be true. The colour-coding may have been irrelevant to the customers and, if so, there would be no misrepresentation. It was also unpersuasive that the picture of forward-facing racehorses on the front cover was misleading as every horse-racing guide would logically feature horses on its cover page. The Respondent cannot be said to have a monopoly over pictures of commonplace horses or even forward-facing racehorses. Additionally, the titles of the publications are prominently displayed on the magazines. We are of the opinion that the large mastheads are significant distinguishing factors and as such, there would be no confusion caused to the public.

131 In the case of *Tong Guan*, illiteracy was seen as “an evaporating consideration” (at [30]) in Singapore by 1991, and the court took the view that a purchaser would use ordinary care to read (whether in English or Chinese) the brand names of the products in order to distinguish between two different brands. In the present circumstances, it can be said that the problem of illiteracy is even more removed than it was in 1991.

Furthermore, punters and race-goers are likely to be a circumspect and discerning audience. As in *Tong Guan*, where the court held that the brands “Tong Guan” and “Deer Brand” were sufficiently distinguishable, it can also be similarly argued that “Punters’ Way” and “Racing Guide” are phonetically and visually different and thus a customer using ordinary care would not be confused.

132 We therefore disagree with the Judge and find that no misrepresentation leading to confusion of the public has been proven by the Respondent on the present facts. The cover pages of the two magazines are sufficiently distinct and are not likely to be confused by the relevant sector of the public.

Damage

133 Even if the Appellant could be shown to have misrepresented *Racing Guide* as *Punters’ Way*, thereby causing confusion between the Respondent’s racing guide and that of the Appellant, such misrepresentation is not in itself actionable unless it has caused, or is likely to cause, damage to the Respondent’s goodwill.

134 The Respondent claimed the net loss of profits that it suffered from 30 June 2007 to 5 June 2008, as well as continuing damages and loss from 5 June 2008 to the date of filing of the Statement of Claim for the Respondent’s continued infringement. The Respondent also sought the costs incurred in conducting market surveys to verify the extent of the damage caused, as well as an injunction to restrain the Appellant from infringing the Respondent’s copyright. However, the Respondent only invited the court to infer damage or the likelihood of damage that had been suffered by the Respondent as a result of the misrepresentation by the Appellant. The Respondent did not lead any evidence on a loss of sales, or a decline in the growth of sales of *Punters’ Way*.

135 The Judge found (at [82] of the Judgment) that where parties are in direct competition with one another, the court will readily infer the likelihood of damage to the Respondent’s goodwill, not merely through the loss of sales, but also through the loss of the exclusive use of his get-up.

136 We do not agree that the test for damages has been correctly applied by the Judge on the established facts. While it is accepted that the common test applied in proving damage is “actual damage or a real likelihood of damage”, it must be noted that the period of infringement alleged by the Respondent was a limited one – from 30 June 2007 to 5 June 2008. This was not a situation where the infringement by the Appellant was ongoing or impending and therefore unquantifiable. In actual fact, the infringement period had long since ended. The Respondent ought therefore to have been able to prove a decline in sales of *Punters’ Way*, or a reduced growth in sales of *Punters’ Way*, if this had indeed taken place. In such a situation, the right

test that should be applied would be that of “actual damage” and not “likelihood of damage”.

137 *Prima facie* proof of damage is essential in the present situation in establishing the Appellant’s liability. However, the Respondent had failed to lead any evidence on the damage that it had suffered to its goodwill from the Appellant’s alleged misrepresentation of *Punters’ Way*. The Respondent had merely relied on a “logical” inference that as the Appellant and the Respondent’s publications were in a common field of activity, it would therefore not be far-fetched to conclude that the Respondent had suffered losses.

138 The Respondent had submitted at the hearing of the appeal, that because the trial had been bifurcated, no evidence of damages was led at trial. The application for bifurcation had in fact been taken out by the Appellant and it was heard on 9 November 2009 before an assistant registrar. During the bifurcation hearing, the Appellant’s counsel had argued that the trial should be bifurcated as all that the Respondent was required to prove was a likelihood of damage and not the quantum of the damage. The assistant registrar subsequently allowed a bifurcation of the trial.

139 In these circumstances, since the Appellant’s counsel himself was of the opinion that a likelihood of damage was all that was required to prove the tort of passing off, we do not find it just to penalise the Respondent for not leading evidence of actual damages at the trial. However we reiterate that, ideally, the test for damages in situations where the period of infringement had passed should be proof of actual damage and nothing short of that.

Our conclusion on the passing off claim

140 We therefore respectfully disagree with the Judge, and conclude that the element of misrepresentation in the tort of passing off has not been successfully proven by the Respondent and therefore the claim of passing off cannot succeed.

Consequential relief

141 The Appellant, in the court below, counterclaimed against the Respondent under s 200(1) of the Act for making groundless threats of legal proceedings. Section 200(1) of the Act provides that where a person threatens another person with a copyright infringement action, the latter may bring an action against the former for, *inter alia*, a declaration that the threat is unjustifiable, unless the former satisfies the court that the alleged infringing acts “constituted, or if done, would constitute, an infringement of copyright”. The full text of s 200(1) reads as follows:

Groundless threats of legal proceedings

200.—(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding in respect of an infringement of copyright, then, whether the person making the threats is or is not the owner of the copyright or an exclusive licensee, a person aggrieved may bring an action against the first-mentioned person and may —

- (a) obtain a declaration to the effect that the threats are unjustifiable;
- (b) obtain an injunction against the continuance of the threats; and
- (c) recover such damages, if any, as he has sustained,

unless the first-mentioned person satisfies the court that the acts in respect of which the action or proceeding was threatened constituted, or, if done, would constitute, an infringement of copyright.

142 Having regard to our findings that copyright did not subsist in the Tables in *Punters' Way*, and that the Appellant therefore could not have infringed any copyright of the Respondent's, it must follow that the Respondent has made groundless threats against the Appellant for the purposes of s 200(1) of the Act.

Conclusion

143 In the result, we find that the Respondent's threats to bring an action for copyright infringement against the Appellant are unjustifiable. The Respondent's claim for the tort of passing off is similarly untenable. Accordingly, the present appeal against the Judge's decision is allowed. The injunction granted by the Judge to restrain the Appellant from infringing the Respondent's copyright in its publications of *Punters' Way* is discharged. The Appellant is entitled to damages against the Respondent for groundlessly threatening the Appellant with copyright infringement under s 200(1) of the Act (which shall be assessed by an assistant registrar), and an injunction restraining the Respondent from making further threats against the Appellant in respect of the subject matter of these proceedings. Because the Appellant has not succeeded in several of its arguments (here and below) we invite the parties to make written submissions on the appropriate costs order we should make for the entire proceedings. The parties have seven days from the date of this judgment to make these submissions.

Reported by Seraphina Fong.
