

Flamelite (S) Pte Ltd and others

v

Lam Heng Chung and others

[2001] SGCA 75

Court of Appeal — Civil Appeal No 600054 of 2001
Yong Pung How CJ, L P Thean JA and Chao Hick Tin JA
25 September; 15 November 2001

Copyright — Infringement — Defendants not exactly reproducing copyright work (plaintiffs' drawings) — Copyright work involving simple principle of construction — Whether substantial similarity between defendants' products and copyright work — Meaning of "substantial part of the work" — Quality rather than quantity of part reproduced — Whether reproduction of non-original part could be substantial part of work — Level of reproduction necessary for infringement where copyright drawings rudimentary — Whether necessary that copying should be done consciously — Plaintiff to establish similarity and prove access to copyright work — Sections 10(1) and 15(3)(a) Copyright Act (Cap 63, 1988 Rev Ed)

Copyright — Infringement — "Non-expert" defence — Judge's role as notional non-expert — Whether external view or cross-section view of infringing object should be compared with copyright work — Section 69 Copyright Act (Cap 63, 1988 Rev Ed)

Copyright — Ownership — Locus standi — Copyright infringement — Copyright owner granting licence to third party to use design — No assignment of rights — Whether copyright owner has locus standi to sue for infringement

Words and Phrases — "Persons who are not experts in relation to objects of that kind" — Section 69 Copyright Act (Cap 63, 1988 Rev Ed)

Facts

The first and second plaintiffs (respectively, "Flamelite" and "Flametech") manufactured and installed fire-rated glass door/screen systems ("the framing systems"). Together with the third plaintiff ("Glaverbal"), they claimed copyright of certain preliminary sketches for framing systems ("the copyrighted works").

The first defendant ("Lam") was engaged by Flamelite as a subcontractor to fabricate and install the framing systems. The fourth defendant ("Wu") was employed by Flamelite. Both had access to the copyrighted works. Lam later incorporated the third defendant ("Swissflame"), whose business was similar to that of Flamelite, and employed Wu.

The plaintiffs sued the defendants for breach of copyright in their works, claiming that Swissflame's framing systems were substantially similar to or a near exact reproduction of theirs. The defendants denied the allegations, and also relied on s 69 of the Copyright Act (Cap 63, 1988 Rev Ed) ("the Act"). The judge held that there was no infringement. Firstly, the copyrighted works related only to a method of construction of a functional article and were not

proprietary. Secondly, there was no substantial similarity between Swissflame's products and the plaintiffs' works.

On appeal, the two main issues were: (a) whether there was infringement of the copyright works given that there was no exact reproduction; and (b) whether the s 69 defence was available to the defendants.

Held, dismissing the appeal:

(1) Glaverbal had the *locus standi* to sue as it did not cease to be the copyright owner of its design merely by consenting to, or licensing Flametech and Flamelite to use the design. Furthermore, s 31(1) of the Act expressly permitted the copyright owner to grant licences to third parties. The position would be different if Glaverbal had assigned its rights: at [21].

(2) Under the Act, an artistic work in two-dimensional form was deemed to be reproduced if a version of the work was produced in a three-dimensional form: s 15(3)(a). Infringement was established as long as a substantial part of the work was reproduced: s 10(1). To succeed in copyright infringement, the plaintiff must prove that copying had occurred by establishing similarity combined with proof of access to the plaintiff's work. On the facts, both Lam and Wu had access to the copyrighted works: at [26], [27], [29] and [30].

(3) To constitute infringement, what was copied must be a substantial part of the artistic work. Whether a part was substantial turned on the quality rather than the quantity of the reproduction, and the reproduction of a part, which by itself had no originality, would not normally be regarded as a substantial part of the copyrighted work. In addition, where very rudimentary drawings were concerned, infringement occurred only if there was an almost exact reproduction of the drawings: at [35], [37] and [45].

(4) There was no substantial reproduction and thus no infringement by the defendants. Firstly, the copyrighted works had little originality and were simple and obvious in view of the functional object to which they related. Secondly, Swissflame's products were not an exact copy of the plaintiffs' drawings as the material used and dimensions were different, and the variations were neither trivial nor cosmetic. Thirdly, the general shape and layout of Swissflame's products were largely dictated by functional requirements: at [46], [47] and [48].

(5) The issue of the s 69 defence was rendered academic as there was no infringement. However, a trial judge as a notional non-expert should be treated as having a cross-section piece of the object so that he might compare it with the copyrighted drawings. The term "persons who are not experts in relation to objects of that kind" meant persons of reasonable intelligence with sufficient ability to interpret drawings to enable them to perform their notional function intelligently: at [49] to [54].

[Observation: It was not necessary that the ideas or thoughts should be original or complex. Copyright protected the expression of ideas, not the ideas themselves: at [22].

It was not necessary that the copying should be consciously done. Subconscious copying was just as infringing. Since copyright was a proprietary right, ignorance was no defence to an infringement claim. If, therefore, the

defendant's work had been copied from the plaintiff's, either directly or indirectly, the fact that the defendant was unaware that the work he was copying in this way existed, or was the plaintiff's or was the subject of copyright, or whether he thought he had a licence, provided no defence to a claim for primary infringement: at [31].]

Case(s) referred to

- A Fulton Co Ltd v Grant Barnett & Co Ltd* [2001] RPC 257 (refd)
A-One Accessory Imports Pty Ltd v Off Road Imports Pty Ltd (1996) 34 IPR 306 (refd)
Beazley Homes Ltd v Arrowsmith [1978] 1 NZLR 394 (folld)
British Northrop Limited v Texteam Blackburn Limited [1974] RPC 57 (folld)
Catnic Components Limited v Hill & Smith Limited [1979] FSR 619; [1982] RPC 183 (refd)
Dixon Investments Pty Ltd v Hall (1990) 18 IPR 481 (refd)
Kenrick & Co v Lawrence & Co (1890) 25 QBD 99 (refd)
L B (Plastics) Limited v Swish Products Limited [1979] FSR 145 (refd)
Ladbroke (Football) Ltd v William Hill (Football) Ltd [1964] 1 WLR 273; [1964] 1 All ER 465 (refd)
Politechnika Ipari Szovetkezet v Dallas Print Transfers Ltd [1982] FSR 529 (refd)
S W Hart & Co Pty Ltd v Edwards Hot Water Systems (1985) 61 ALR 251 (folld)
Solar Thomson Engineering Co Ltd v Barton [1977] RPC 537 (folld)
University of London Press Limited v University Tutorial Press Limited [1916] 2 Ch 601 (folld)
Warwick Film Productions Ltd v Eisinger [1969] 1 Ch 508; [1967] 3 All ER 367 (refd)

Legislation referred to

- Copyright Act (Cap 63, 1988 Rev Ed) ss 10(1), 15(3)(a), 69 (consd);
 ss 26(b)(i), 31(1)
 Copyright Act 1956 (c 74) (UK) s 9(8)

Seah Sheng Lim Steven and Tan Teck San Kelvin (Drew & Napier LLC) for the appellants;
Wong Siew Hong and Chia Soo Michael (Infinitus Law Corp) for the respondents.

[Editorial note: This was an appeal from the decision of the High Court in [2001] SGHC 66.]

15 November 2001

Judgment reserved.

Chao Hick Tin JA (delivering the judgment of the court):

1 This is an appeal by the plaintiffs against a decision of the High Court dismissing their claims against the defendants for breaches of copyright in certain artistic works [sketches] relating to fire-rated glass doors and screens.

2 All the parties to the proceedings were at the relevant times in the business of manufacturing, sales and installation of fire-rated glass doors or glass screen systems.

3 The third plaintiff (“Glaverbel”), a Belgium company, claims copyright to certain artistic works set out in some preliminary sketches for a frame for fire-rated glass screens (“the Glaverbel works”). The preliminary sketches were created in 1985 by Robert Vanderstukken (“Vanderstukken”), an employee of the third plaintiff. The actual sketches were however not available at the trial as they were either lost or destroyed but Glaverbel averred that the works were instead illustrated in four test reports prepared for them by the University of Ghent in Belgium.

4 The first plaintiff (“Flamelite”) and second plaintiff (“Flametech”) claim copyright to certain preliminary sketches for a frame for both fire-rated glass doors and screens. The sketches were created in May 1991 by one Loke Gim Tay (“Loke”), an employee of Flametech. The sketches were an improvement on the Glaverbel works, adapting the frame depicted in the Glaverbel works to that for a fire-proof glass door. The sketches were likewise unavailable at the trial and a set of shop drawings (“Flamelite works”) were tendered to evidence their contents.

5 The third plaintiff (Glaverbel) was added as a party after the action had been instituted. Although the trial judge made some comments on account of this, the parties in their cases have not pursued the matter. Accordingly, nothing turns on this.

Background

6 Before the mid-eighties, nearly all the fire-rated glass doors were imported, fully assembled from Europe. From the mid-eighties, Glaverbel licensed, *inter alia*, “Flametech”, to produce steel frames for fire-rated glass screens. After Loke joined Flametech in 1991, he made further improvements in the design of Glaverbel’s fire-rated doors and they are in the following respects:

- (a) improving the frame: Under the Glaverbel design, the glass panel was supported by calcium silicate boards screwed to the steel frame. However, they cracked slightly when screws were applied through them, and might not be able to take the stress of normal usage of a door, which swung frequently and was exposed to rain, mechanical impact and constant cleaning. Moreover, the exposed calcium silicate boards were unsightly and needed to be covered. Loke therefore added a steel-capping (or armour-capping) to the calcium silicate boards, which would protect it from the elements and increase its resistance to fire. It was also stronger as the weight of the glass was now borne by the steel capping as well as the steel core of the frame.

(b) Connecting the door frame to the doorway frame using a hinge: The main problem Loke faced was how to attach the door strap of the pivot hinge to the door frame. He could not fix it onto the calcium silicate board which was too brittle to take the stress of swinging action. He decided to attach the door strap to the steel core. He removed a portion of the calcium silicate padding, and reinforced the link by placing steel plates on it so that the pivot would not just slip out. As for the gap between the frame and the glass, he added intumescent strips in such a manner that they would expand and fill the gaps when a fire occurred. He then added door handles and lock sets, and extended the design to include a fixed screen to the whole design so that the glass door could be part of a larger glass façade.

7 Based on the Flamelite works, Flametech proceeded to manufacture and sell such fire-rated glass doors and screens. In October 1992, Loke resigned from Flametech, though remaining its majority shareholder. He proceeded to set up Flamelite (S) Pte Ltd (“Flamelite”), the first plaintiff.

8 From January 1992 to May 1993, the first defendant (“Lam”) was engaged by Flametech, as a subcontractor to fabricate and install the fire-rated glass door and from December 1992 to June 1994, Lam was so engaged by Flamelite. For the purpose of enabling Lam to discharge his task, shop drawings of the Flamelite works were furnished to Lam. The fourth defendant, Wu Kam Fai (“Wu”), was from November 1992 to mid-1994 employed by Flamelite and his main responsibility was to liaise with the various subcontractors of Flamelite, including Lam. In June 1994, Flamelite terminated the engagement of Lam.

9 In August 1994, Lam and his wife, Sim Bee Hoon, the second defendant, incorporated a company, Swissflame Pte Ltd (“Swissflame”), the third defendant. The majority shares in Swissflame were held by Lam, who was also its controlling mind. It should be mentioned that the plaintiffs’ action against the second defendant was subsequently discontinued.

10 As stated before, the business of Swissflame was also in the manufacture and sale of similar fire-rated glass doors and screens. The fourth defendant, Wu, was from September 1995 employed by Swissflame as its technical services manager, and his main duties were to market Swissflame’s fire-rated glass doors and screens.

Present action

11 In the present action, the plaintiffs alleged that Lam, Swissflame and Wu have infringed their copyright which subsists in the Glaverbel works and the Flamelite works when the latter produced their Swissflame fire-rated doors and screens. The plaintiffs claim that the Swissflame’s framing system is substantially similar to or a near exact reproduction of the plaintiffs’ framing system.

12 Lam and Swissflame contended that while the general arrangement of the components is similar, Swissflame's framing system is not an exact reproduction nor is it a slavish copy of the plaintiffs' framing systems in terms of material and dimensions. Moreover, the drawings contained only non-proprietary principles or methods of creating such fire-rated doors and screens, and that the methods had been in common use in the industry for some 20 years already, being largely dictated by functions. Vanderstukken admitted that Glaverbel's design is elementary and set out a simple principle of construction.

13 As the preliminary sketches relating to the Glaverbel and the Flamelite works were not produced, there was no way to know what was contained therein even though it is alleged by the plaintiffs that annexures "A" and "B" to the statement of claim are illustrative of what the preliminary sketches depicted. Furthermore, the defendants relied upon s 69 of the Copyright Act (Cap 63, 1988 Ed) ("the Act") and asserted that these products do not infringe any copyright of the plaintiffs as the products would not appear to persons, who are not experts in relation to such doors, to be reproductions of the plaintiffs' alleged artistic works.

14 It should be mentioned that in the court below Flamelite and Flametech had also alleged that Lam and Wu had committed breaches of confidence. However, in this appeal, the claim based on breaches of confidence is no longer pursued by the two plaintiffs.

Agreed facts

15 During the course of the trial the parties also agreed, *inter alia*, to the following. The preliminary sketches of Vanderstukken, although no longer to be found, are nevertheless reflected in three University of Ghent Test Reports. Copyright in the preliminary sketches subsists in Singapore by virtue of the Copyright (International Protection) Regulations 1990 and 1996 and the copyright to the same vested in Glaverbel, as the employer of Vanderstukken.

16 The preliminary sketches of Glaverbel were not seen by Loke or the defendants. What Loke did in 1991, while in the employment of Flametech, was to use the Glaverbel's University of Ghent Test Reports (Nos 5592, 6223 and 5673) as precedents, made changes and created preliminary drawings of framework for a fire-rated glass and fixed screens. Loke, in turn, engaged a freelance draughtsman to reproduce the preliminary drawings into shop drawings. The preliminary drawings of Loke were never seen by the defendants and could no longer be found, having been destroyed or thrown away. The copyright in the preliminary drawings originally vested in Flametech. In April 1994, Loke acquired Flametech and Flametech in turn assigned its copyright in the preliminary drawings (the Flamelite works) to Flamelite.

17 While Lam was engaged by the plaintiffs he was given the shop drawings of the plaintiffs' framework. Wu also had access to the plaintiffs' shop drawings while he was employed by Flamelite. There is, however, a dispute as to whether Loke told Wu that the shop drawings were proprietary and confidential. Since joining Swissflame, Wu had quoted and sold Swissflame's fire-rated glass doors to various customers.

Decision below

18 In relation to Glaverbel works, the judge below found that they consisted really of only ideas. He also found that Glaverbel, having consented to the use of their drawings by Flametech, was thus not entitled to mount their claim against the defendants because it would create "unwitting duplication and double-counting".

19 In any case the judge found that there was no infringement of the plaintiffs' works because:

(a) The works related to a method of construction of a functional article. The works could not be proprietary and the court would not allow a claimant to establish a monopoly through a claim in copyright.

(b) The court accepted Lam's explanation that in the course of his employment with Flamelite and Flametech, he had not seen any of the plaintiffs' preliminary drawings but he had seen only some "rough hand drawn sketches" of Wu.

(c) There was no substantial similarity between the Swissflame products and the plaintiffs' works. The judge noted that besides differences as to materials and dimensions there were other differences in features between the plaintiffs' works and the defendants' product.

Issues

20 There are basically only two issues before us. The first is whether there had been any infringement of the copyright works as the defendants did not exactly reproduce the plaintiffs' drawings. The second is whether the defence in s 69 is available to the defendants in the circumstances of this case.

Locus of Glaverbel

21 Before we proceed to examine the two issues there is a need for us to briefly touch on two ancillary questions. The first is whether Glaverbel is entitled to bring the present claim. The judge seemed to hold that, in view of Glaverbel having consented to Flametech and Flamelite using its design, Glaverbel has, as a result, lost its right to sue for infringement. We do not think that view is correct. The fact that Glaverbel has consented or licensed

another to use the design does not mean that Glaverbel has ceased to be the copyright owner of the design. Such a licence cannot abrogate the rights of the copyright owner. Section 31(1) of the Act expressly permits the copyright owner to grant licences to third parties. Granting of a licence to a party does not mean granting a licence to the world at large. It would have been different if Glaverbel had assigned its rights to Flametech/Flamelite.

22 Turning next to the second ancillary question, the trial judge found that the Glaverbel works and the Flamelite works involved an elementary or simple principle of construction. While he thought they were mere ideas, he did not go on to expressly say that the works are thereby incapable of acquiring copyright. We would reiterate that to obtain copyright it is not necessary that the ideas or thoughts should be original or complex. Copyright protects the expression of ideas, not the ideas themselves. Mere simplicity does not mean that copyright is precluded. We are reminded of what Megarry J stated in the following passage in *British Northrop Limited v Texteam Blackburn Limited* [1974] RPC 57 at 68:

It may indeed be that some thing may be drawn which cannot fairly be called a diagram or a drawing of any kind: a single straight line drawn with the aid of a ruler would not seem to me to be a very promising subject for copyright. But apart from cases of such barren and naked simplicity as that, I should be slow to exclude drawings from copyright on the mere score of simplicity. I do not think that the mere fact that a drawing is of an elementary and commonplace article makes it too simple to be the subject of copyright.

Infringement

23 The primary concern of copyright is with the form in which an idea is expressed. The requirement of originality in copyright law relates solely to the form in which the work is expressed: *University of London Press Limited v University Tutorial Press Limited* [1916] 2 Ch 601. To determine the issue of infringement, it is essential to bear in mind that in the statement of agreed facts the parties agreed that “Swissflame’s framing system is not an exact reproduction nor a slavish copy of the plaintiffs’ framing system in terms of materials and dimensions”. This is further confirmed by a chart which the defendants submitted at the trial, where the Flamelite and Glaverbel works were compared with Swissflame’s products, and which highlighted that differences existed in relation to materials and dimensions.

24 The plaintiffs pointed out that the defendants’ expert witnesses acknowledged that there could be a variety of ways in which the fire-rated glass doors and screens could be designed. Although these experts maintained that the Flamelite and Glaverbel works comprised a common method of construction, they admitted that this was said from an engineering or technical point of view. Interestingly, the defendants had adduced evidence of a variety of designs adopted by other manufacturers.

So the plaintiffs contended that it is not true that functional reasons would require that the design of such doors/screens would all be the same. The plaintiffs submitted that there is much room for creativity within the common method of construction. The differences in materials, dimensions and features mentioned by the judge were trivial and do not render the infringement any less so.

25 The plaintiffs also emphasised the fact that the defendants had not really explained how they arrived at the designs for their fire-rated glass doors and screens which are so close to theirs. This, coupled with the fact that Lam and Wu had access to the shop drawings of the Flamelite and Flametech products, strongly suggests that the defendants must have simply copied the plaintiffs' works.

26 Under s 26(b)(i) of the Act, copyright confers upon the owner the exclusive rights to, *inter alia*, reproduce an artistic work in any material form. An artistic work in a two-dimensional form is deemed to be reproduced if a version of the work is produced in a three-dimensional form (s 15(3)(a)). Under s 10(1), infringement is established as long as a substantial part of the work is reproduced.

27 To succeed in copyright infringement, the plaintiff must prove that copying has taken place. Such proof can come in the form of establishing similarity combined with proof of access to the plaintiff's works.

28 We will first deal with the question of access as it can be disposed of shortly. As Park J said in *A Fulton Co Ltd v Grant Barnett & Co Ltd* [2001] RPC 257 at 284:

It is rare in intellectual property cases for there to be direct evidence of copying of someone's else copyrights or designs. Plagiarists do their copying in secret. The courts proceed on the basis that a close similarity between the claimant's design and the alleged infringing article, coupled with the opportunity for the alleged copier to have access to the claimant's design or work, raises an inference of copying. It is then up to the defendant to rebut the inference by evidence which shows that the apparent similarity arose in some other way. In *Ibcos Computers Ltd v Barclays Mercantile Highland Finance Ltd* [1994] FSR 275 at 297, Jacob J said that: 'the concept of sufficient similarities shifting the onus to the defendant to prove non-copying is well recognised in copyright law.' He added that he thought that the proposition 'is not so much one of law as of plain rational thought.'

29 In this case it is not in dispute that Lam had access to the shop drawings, incorporating the Flamelite and Glaverbel works. He was then a subcontractor fabricating the fire-rated glass doors and screens for Flametech and Flamelite. Wu also had access to the shop drawings of Flamelite. This is set out in para 16 of the statement of agreed facts. At all material times, Wu knew or was familiar with the framing system used in relation to Flamelite's fire-rated glass doors and screens.

30 In this connection we ought to mention that the trial judge seemed to have accepted Lam's evidence-in-chief that he received instructions through some "rough hand written sketches" and seemed to think that Lam did not have access to the shop drawings. But in cross-examination Lam admitted that he was shown shop drawings of the plaintiffs. More importantly, in para 15 of the statement of agreed facts it is stated that "in the course of his engagement as a subcontractor, Lam was given shop drawings of the plaintiffs' frames". Thus, the judge's finding on this is not correct.

31 It is not necessary that the copying should be consciously done. Subconscious copying is just as infringing as is apparent from the following passage from *Copinger & Skone James on Copyright* (14th Ed) vol 1, at p 402.

As already pointed out, since copyright is a proprietary right, ignorance is no defence to an infringement claim. If, therefore, the plaintiff's [*sic*] work has been copied from the plaintiff's, either directly or indirectly, the fact that the defendant was unaware that the work he was copying in this way existed, or was the plaintiff's or was the subject of copyright, or whether he thought he had a licence, provides no defence to a claim for primary infringement although in limited circumstances, it may affect the remedy ...

Similarity

32 We now turn to consider the question whether there is substantial similarity between the Swissflame products and the two copyright works. In the statement of agreed facts the parties have set out their positions on the point as follows:

The Plaintiffs claim that Swissflame's framing system is substantially similar to or a near exact reproduction of the Plaintiffs' framing system. Whilst the Defendants admit that the general arrangement of components is similar, Swissflame's framing system is not an exact reproduction nor a slavish copy of the Plaintiffs' framing system in terms of materials and dimensions. Further, the Defendants say that the frame design is a nonproprietary method of construction and is largely dictated by function.

33 The trial judge, having examined the comparison chart tendered to court by the defendants, came to the conclusion that:

In my view besides the differences as to dimensions, not all the features which appear in the plaintiffs' product can be found in the defendants' design. Besides, looking at the products from the standpoint of details, I am also in agreement with defendants' counsel that the design alluded to by the plaintiffs has been demonstrably elementary and this aspect, in so far as the fourth plaintiffs' designs are concerned, it had been conceded, albeit rather gingerly, by Vanderstukken (page 179 of the NE) that they were elementary. The addition of the much-talked

about armour cladding by Loke too does not take their case any further as it is not claimed that that feature forms part of the infringement. In my determination, annexures A and B illustrate nothing but a non-proprietary principle or method of constructing the fire-rated glass doors and structural frames. I agree in this regard with the testimonial assertions by the defendants, that the method referred to involves the commonplace mounting of fire-resistant glass on a hollow steel section between fireproof calcium silicate boards. The steel section and calcium silicate boards are then joined to form a structural frame. The gap between the fire resistant glass and the calcium silicate board is filled using fireproof materials. I must further mention that I accept as valid the opinion of Associate Professor Chew that the framing system alluded to illustrate the simplest and most fundamental method of constructing a fire-rated glass door from an engineering point of view. I also accept as valid, Mr Kettle's view that technically similar basic designs have been in existence for some time and have been previously tested by others in conjunction with other proprietary types of insulating glass. One other observation which requires inclusion here is that any likeness or close resemblance between the plaintiffs' and the defendants' drawings is mainly owing to the function and functionality of the method which I accept as elementary.

34 Counsel for the plaintiffs submitted that copyright protects against copying and that the judge did not identify the features of the plaintiffs' works which were copied; neither did he rule that what the defendants had copied did not constitute a substantial part of the plaintiffs' works. The chart produced by the defendants set out the differences between the Glaverbel works and the Flamelite works on the one hand and Swissflame works on the other and those differences are quite insignificant.

35 It is expressly provided in the Act that to constitute infringement what is copied must be a substantial part of the artistic work. What would constitute substantial part was stated rather eloquently by Buckley LJ in *Catnic Components Limited v Hill & Smith Limited* [1979] FSR 619 at 626–627 as follows:

I do not question the principle that in deciding whether what had been reproduced by an alleged infringer is a substantial part of the work allegedly infringed, one must regard the quality (that is to say the importance) rather than the quantity of the part reproduced (see *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, per Lord Reid at p 276 and per Lord Pearce at p 293); but what is protected is the plaintiffs' 'artistic work' as such, not any information which it may be designed to convey. If it is said that a substantial part of it has been reproduced, whether that part can properly be described as substantial may depend upon how important that part is to the recognition and appreciation of the 'artistic work'. If an 'artistic work' is designed to convey information, the importance of some part of it may fall to be judged by how far it contributes to conveying that information, but not, in my opinion, by how important the

information may be which it conveys or helps to convey. What is protected is the skill and labour devoted to making the 'artistic work' itself, not the skill and labour devoted to developing some ideas or invention communicated or depicted by the 'artistic work'. The protection afforded by copyright is not, in my judgment, any broader, as counsel submitted, where the 'artistic work' embodies a novel or inventive idea than it is where it represents a commonplace object or theme.

36 In *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 All ER 465; [1964] 1 WLR 273, which was a case concerning literary work, Lord Evershed explained ([1964] 1 All ER 465 at 473; [1964] 1 WLR 273 at 283) the concept of substantial reproduction as follows:

... what amounts in any case to substantial reproduction ... cannot be defined in precise terms but must be a matter of fact and degree. It will, therefore, depend not merely on the physical amount of the reproduction but on the substantial significance of that which is taken.

37 Lord Pearce, in the same case, also amplified the concept of substantial reproduction in these terms:

Whether a part is substantial must be decided by its quality rather than its quantity. The reproduction of a part which by itself has no originality would not normally be regarded as a substantial part of the copyright work and therefore will not be protected. For that which will not attract copyright except by virtue of its collocation will, when robbed of that collocation, not be a substantial part of the copyright and therefore the courts will not hold its reproduction to be an infringement.

38 This view was adopted by Plowman J in *Warwick Film Productions v Eisinger* [1969] 1 Ch 508; [1967] 3 All ER 367, a case where the plaintiff claimed that copyright in a book entitled "The Trials of Oscar Wilde" had been infringed by a film script. However, the book in question was in turn largely copied from an earlier publication. With respect to these copied portions, Plowman J said ([1969] 1 Ch 508 at 533–534; [1967] 3 All ER 367 at 385):

... it had no originality and attracted copyright, as part of the whole book, only by reason of its collocation. When robbed of that collocation it does not, in my judgment, represent a substantial part of the copyright and so does not involve an infringement of it.

39 A similar point also arose in the Australian Federal Court case of *A-One Accessory Imports Pty Ltd v Off Road Imports Pty Ltd* (1996) 34 IPR 306, where Drummond J said (at 330):

[W]here an original work comprises non-original material, whether pirated or not, and new material, the non-original material in the work attracts copyright protection only because of its collocation with the new material, so that, if the only part of such a composite work which

is copied is the non-original component, once that is robbed of its collocation with the new material, it cannot be regarded as forming a substantial part of the entire work in which copyright subsists.

40 Of course, the existence of dissimilarities does not necessarily mean that there is no infringement or that they destroy the notion of copying: see *Beazley Homes v Arrowsmith* [1978] 1 NZLR 394. The question in each instance is whether the defendant has incorporated into their plans and products, a substantial proportion of the plaintiff's plans. To answer this question, the whole of the work must be considered and in this exercise the originality and simplicity of the plan and its functional object must be borne in mind. All said, past cases are only illustrative of judicial approach in the light of the prevailing facts.

41 First, we will refer to an Australian High Court case relied upon by the plaintiffs: *S W Hart & Co Pty Ltd v Edwards Hot Water Systems* (1985) 61 ALR 251. The case concerned the infringement of drawings relating to a solar energy hot water system. There Gibbs CJ said (at 255):

Particular reliance was placed ... in argument before us by counsel for the respondent on the differences in the dimensions of certain parts manufactured by the respondent and the dimensions of corresponding parts shown on the drawings, but I agree with Franki J that it does not follow that the relevant similarity does not exist merely because the dimensions of a part shown in a drawing and those of the corresponding three-dimensional part differ somewhat. Minor differences of that kind may be deliberately made for the very purpose of disguising the fact that copying has occurred. It is true that there were a good many differences in detail between the respondent's products and the appellant's drawings, although they seem to me to be comparatively minor.

...

The question is not whether there are dissimilarities but whether the respondent's products closely resembled the appellant's drawings or a substantial part of them.

42 A case very much on point is *Dixon Investments Pty Ltd v Hall* (1990) 18 IPR 481, which concerned an alleged infringement of copyright in the design for a simple-storey residential house. Pincus J delivering the judgment of the Federal Court of Australia explained why there was no infringement in this manner:

The applicant is entitled to succeed if it can show that the house is a reproduction of the basic plan or of a substantial part of it. Nevertheless, the simplicity of the basic plan said to have been infringed creates a difficulty for the applicant. The simpler and more commonplace the copyright drawing, the more closely must the alleged infringer adhere to it, in order for liability to exist: *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99 at 102; *Ownit Homes Pty Ltd v*

D&F Mancuso Investments Pty Ltd (1988) AIPC 90-488 at 38,243 ... There are, of course, many houses of about the same size as those in issue here, and with similar facilities ... If one adheres to the idea of having a roughly rectangular shape with all the rooms all on one level, there is only a limited number of ways in which the rooms can sensibly be arranged.

43 In *Catnic Components v Hill & Smith* ([35] *supra*) the question was whether certain steel lintels manufactured by the defendants were copies of drawings of the plaintiffs and infringed the copyright in those drawings. The court found that the dimensional similarities between the defendants' lintel and the plaintiffs' drawings were due to the functions which the lintels were designed to perform and the normal dimensions of materials used in the building of walls.

44 In *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99 the copyright on which infringement was alleged was a simple drawing of a hand holding a pencil. The defendant's drawing showed the hand to be in a different position. This slight change was held to be sufficient to prevent an infringement from arising.

45 Another highly illustrative case is *Politechnika Ipari Szovetkezet v Dallas Print Transfers* [1982] FSR 529 which concerned, *inter alia*, infringements of the rights in the design for the container of the "Rubik Cubes" puzzle. The defendant's container was largely similar in that it was also cylindrical in shape, had a square indentation at the top of the plastic lid and a recess in the base to take the corners of the cube. There were only some differences in the square indentations and recesses. Dillon J held that copyright was not infringed and said, at 542:

Another way of putting this point is that the drawings of the cover and base are very rudimentary, and where very rudimentary drawings are concerned there would be an infringement of copyright only if there were almost an exact reproduction of the drawings.

46 Ultimately, the question of what is substantial is very much a question of fact and degree on which difficult decisions would have to be made. Reverting to the instant case, not only is there little originality in the copyright works, they are in fact simple and obvious, bearing in mind the functional object to which they relate. It is not in question that the Swissflame products do not copy exactly the copyright drawings. The material used is different; so are some dimensions. On first impression, one may think that these variations are trivial and insignificant. But they are not so, if we bear in mind the object the product is intended to serve. Here, we are reminded of what Loke said. In working out the modifications to be made to the Glaverbel works, Loke laid stress on the importance of the type of material used as well as the thickness and depth of such material in order that the end product would be strong and would effectively serve the intended purpose of the product. Thus, the variations in dimensions which

Swissflame introduced into their products cannot really be considered as inconsequential or merely cosmetic.

47 Here, we note that the trial judge accepted the expert opinion of Associate Professor Chew Chye Heng that the framing system of the plaintiffs was the “simplest and most fundamental method of constructing a fire-rated glass door from an engineering point of view”. The plaintiffs sought to diminish the significance of this piece of evidence by highlighting the fact that Assoc Prof Chew was looking at it from the engineering point of view. We are unable to see how that contention can be made. We would have thought this evidence underscores the defendants’ argument that the framing system of the plaintiffs is so basic that what was copied was not so much the expression but the idea. Where the work is simple, the idea embodied in the work becomes so closely identified with its expression that it is hard to separate the form of expression from the idea. In such a case there should be a much closer degree of copying before infringement can occur.

48 On balance, we are not persuaded that the trial judge was wrong to have come to the view that there was no substantial reproduction and thus no infringement. We are inclined to agree with the trial judge that the general shape and layout of the Swissflame products are dictated very much by functional requirements. In coming to this view, we have examined the two models of the plaintiffs’ product which were produced to the court below.

Section 69 defence

49 In the light of our decision above, the question whether the defence under s 69 is available will be quite academic. However, we think it is necessary for us to clarify certain views expressed by the trial judge.

50 Section 69, which is *in pari materia* with s 9(8) of the English Copyright Act of 1956, provides that:

the making of an object of any kind that is in three dimensions does not infringe the copyright in an artistic work that is in two dimensions if the object would not appear to persons who are not experts in relation to objects of that kind to be a reproduction of the artistic work.

51 The trial judge, in determining whether this defence was made out, took the approach advanced by the defendants of merely comparing the external view of the product with the copyright works. The defendants contended that the profiles and cross-sections of the defendants’ frames would be concealed once the fire doors and screens are fabricated and installed. A non-expert looking at the Swissflame products could not see the cross-section and hence would not be able to tell that the Swissflame products were copied from the plaintiffs’ copyright drawings. On this basis, the judge ruled that the non-expert defence was made out as the notional

non-expert would not be able to conclude that there had been copying from the copyright works.

52 The plaintiffs, relying upon *Solar Thomson Engineering Co Ltd v Barton* [1977] RPC 537, submit that the approach taken by the trial judge is wrong. There, Lord Justice Buckley LJ said (at 559):

If the notional unskilled observer postulated by s 9(8) should be treated as having a complete re-treaded cheek piece in his hand, it would, I think, be at least arguable that it would not appear to him that the rubber ring was necessarily a three-dimensional reproduction of the sectional drawing, for he would be unable to see what the contours of the rubber ring were on that side of it nearest to the steel ring; nor would he be able to see the contours of the hidden surface of the steel ring; nor could he be certain whether the surfaces of the rubber ring and the steel ring were actually in contact over the whole of that area.

It seems to me, however, that, the drawing being a sectional drawing, the notional unskilled observer should be treated as having a sectioned cheek piece in his hand for the purposes of s 9(8).

53 We agree with Buckley LJ. To hold otherwise would mean that s 69 affords a blanket defence to all to copy, so long as what has been copied cannot be seen from the external appearance of the product. However, this is not to say that the trial judge (as the notional non-expert) should repeat the process which he has gone through, with the assistance of experts and other witnesses, in deciding whether there has been copying or not.

54 For s 69, the comparison is to be visual only though the judge, in performing the task, must be entitled to compare the object with the drawings and must also be credited with some ability to interpret design drawings: see *LB (Plastics) Limited v Swish Products Limited* [1979] FSR 145. We also respectfully concur with the views expressed by Gibbs CJ in *S W Hart & Co v Edwards Hot Water Systems* ([41] *supra*) that the term “persons who are not experts in relation to objects of that kind” meant persons of reasonable intelligence with sufficient ability to interpret drawings to enable them to perform their notional function intelligently. Therefore, while a trial judge may do a cross-sectional comparison visually, he is not to undertake a detailed dissection of the product.

Judgment

55 In the result, the appeal is dismissed. Parties are requested to make their submissions in writing within seven days on the question of costs.

Headnoted by Tan Kheng Siong Stanley.
