

Odex Pte Ltd
v
Pacific Internet Ltd

[2008] SGHC 35

High Court — Originating Summons No 159 of 2007
(Registrar's Appeal from the Subordinate Courts No 89 of 2007)

Woo Bih Li J

28 November 2007; 7 March 2008

Civil Procedure — Discovery of documents — Internet piracy — Internet service provider — Application for discovery to identify infringers — Whether sub-licensee or sub-agent of copyright owner having locus standi to apply — Standard of proof required to succeed in application — Interest of justice as a guide — Order 24 r 6(5) Rules of Court (Cap 322, R 5, 2006 Rev Ed)

Copyright — Infringement — Downloading of material from the Internet without licence of copyright owner — Whether such action statutorily criminalised — Whether infringement was significant — Whether infringement was to obtain commercial advantage — Section 136 Copyright Act (Cap 63, 2006 Rev Ed)

Facts

Odex provided anime programmes to local television stations and retailers. It applied for pre-action discovery of documents to identify subscribers (to Pacific Internet) who had downloaded some of these programmes illegally. The district judge below held that: (a) Odex did not have *locus standi* to make the application for most of the programmes as it was only a sub-licensee of those programmes; and (b) where Odex was the exclusive licensee of a programme, it had to show an extremely strong *prima facie* case of wrongdoing before the order could be made, but it failed to do so. At the appeal, some of the copyright owners of the anime programmes applied to be added as plaintiffs.

Held, dismissing the appeal and allowing the application to add plaintiffs:

(1) Only copyright owners and exclusive licensees had the right to take action against copyright infringers. Odex tried to circumvent this rule by arguing that it was not seeking substantive relief but failed because neither: (a) the Copyright Act (Cap 63, 2006 Rev Ed); (b) the Subordinate Courts practice directions; nor (c) the United States-Singapore Free Trade Agreement supported its contention that an authorised agent of a copyright owner had *locus standi* to make the application for discovery: at [18], [23] to [35], [37] and [38].

(2) Since Odex had no *locus standi* to make the application under the Rules of Court (Cap 322, R 5, 2006 Rev Ed), it had no *locus standi* to rely on the jurisdiction of *Norwich Pharmacal Co v Customs and Excise Commissioners* [1974] AC 133 (“NP”) to obtain information with a view to commencing civil proceedings by copyright owners, assuming that the NP jurisdiction had not been superseded by O 24 r 6 of the Rules of Court. Even if the information was used to undertake criminal proceedings and *Ashworth Hospital Authority v*

MGN Ltd [2002] 1 WLR 2033 applied to Singapore, Odex was not a victim of wrongdoing as it had expressly disavowed making the application in its capacity as a licensee: at [42] to [54].

(3) Prior to amendments in 2004, the Copyright Act had criminalised only commercial activities of copyright infringement. Under the new s 136(3A), there was also criminal liability if the infringement was wilful and either or both of certain situations applied under s 136(3A)(c). It was less clear whether the alleged infringement was significant and the evidence did not suggest which of the infringing internet protocol addresses would have committed an offence under s 136(3A): at [72] to [75].

(4) Where Odex was the exclusive licensee, the district judge had imposed the wrong standard of proof. Where the plaintiff asserted a cause of action and was seeking discovery to ascertain the identity of the wrongdoer, the strength of his case was one of the factors to be considered in the totality of the facts. Any contractual and regulatory duty of confidentiality owed by Pacific Internet to its subscribers was another factor, but this factor should not in and of itself give rise to a higher standard of proof. Ultimately, the guide should still be the interest of justice: at [61].

(5) The application by the copyright owners who had applied to be added as plaintiffs was allowed (but for one), and disclosure to those owners was allowed: at [76].

Case(s) referred to

Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck [2007] 2 SLR(R) 869; [2007] 2 SLR 869 (refd)

Ashworth Hospital Authority v MGN Ltd [2002] 1 WLR 2033 (refd)

BNP Paribas v Polynesia Timber Services Pte Ltd [2002] 1 SLR(R) 539; [2002] 4 SLR 933 (fold)

Chan Kern Miang v Kea Resources Pte Ltd [1998] 2 SLR(R) 85; [1999] 1 SLR 145 (refd)

Dollfus Mieg et Compagnie SA v Bank of England [1951] Ch 33 (refd)

KLW Holdings Ltd v Singapore Press Holdings Ltd [2002] 2 SLR(R) 477; [2002] 4 SLR 417 (refd)

Kuah Kok Kim v Ernst & Young [1996] 3 SLR(R) 485; [1997] 1 SLR 169 (refd)

Megastar Entertainment Pte Ltd v Odex Pte Ltd [2005] 3 SLR(R) 91; [2005] 3 SLR 91 (refd)

Microsoft Corp v SM Summit Holdings Ltd [1999] 3 SLR(R) 465; [1999] 4 SLR 529 (refd)

Norwich Pharmacal Co v Customs and Excise Commissioners [1974] AC 133 (refd)

UMCI Ltd v Tokio Marine & Fire Insurance Co (Singapore) Pte Ltd [2006] 4 SLR(R) 95; [2006] 4 SLR 95 (refd)

Legislation referred to

Copyright Act (Cap 63, 1999 Rev Ed) s 136(9)

Copyright Act (Cap 63, 2006 Rev Ed) ss 136(1), 136(2), 136(3), 136(3A),
136(3A)(c), 136(6A), 136(6B) (consd);
ss 83, 103(1), 114(1), 123
Copyright (Network Service Provider) Regulations 2005 (S 220/2005) reg 3(2)
Rules of Court (Cap 322, R 5, 2006 Rev Ed) O 24 r 6(5) (consd);
O 15 r 6(2), O 24, O 24 r 6, O 26A
Telecommunications Act (Cap 323, 2000 Rev Ed)
Copyrights Act 17 USC (US) § 512(h)(1) (1998)

Lau Kok Keng and Charissa Soh (Rajah & Tann) for the appellant;
Koh Chia Ling and Arthur Yap (Alban Tay Mahtani & de Silva) for the respondent.

7 March 2008

Judgment reserved.

Woo Bih Li J:

Background

1 In this matter, Odex Pte Ltd (“Odex”) applied for pre-action discovery of various documents from Pacific Internet Limited (“Pacific Internet”).

2 Odex is a private limited company in the business of providing foreign television programmes, in particular, various anime titles (*ie*, cartoon animations originating from Japan) to local television stations for broadcasting, as well as distributing authorised copies of these programmes to retailers for sale to the public.

3 Odex alleged that with the proliferation of internet piracy, facilitated by the technological ease of obtaining DVD-quality movie files for free through broadband networks, Odex’s sales of anime video titles had begun to drop progressively and significantly by more than 80%. Television stations also bought fewer anime titles from Odex as they were allegedly losing viewership to illegal downloaders.

4 In late 2006, Odex engaged BayTSP.com Incorporated (“BayTSP”), an American company which is the developer and owner of patented technology that tracks instances of uploading and/or downloading of digital files on the Internet in real time, and displays the internet protocol (“IP”) address of the relevant internet users, to provide Odex with an online tracking solution that would enable Odex to collect details relating to instances of unauthorised uploading and downloading of copies of the video titles.

5 Odex alleged that it discovered through BayTSP’s tracking solution that there had been more than 474,000 unique downloads over an 11-month period, based on searches conducted on only 50 out of more than 400 authorised titles. Odex reported these findings to its Japanese

principals, some of whom expressed dismay, in a letter (that was apparently prepared for each of them to sign) that “Singapore ranked number 10 in the world for total number of illegal downloads, and was ranked number 1 in the world for highest level of illegal downloads per capita of population”. Action in one form or another had to be taken to address this problem.

6 Odex said that it had approached the Intellectual Property Rights Branch (“IPRB”) of the Criminal Investigation Department to raid the homes of illegal downloaders but to no avail. According to Odex, the IPRB declined its request but advised Odex to carry out criminal enforcement through co-operative enforcement action – meaning that Odex had to gather evidence itself, apply for pre-action discovery, apply for search warrants and apply for a fiat from the Attorney-General and institute prosecution privately.

7 Odex had also approached the Intellectual Property Office of Singapore (“IPOS”) to develop a campaign to educate the public on online piracy. Odex was prepared to fund the project but wanted illegal downloaders to pay a small sum to charity as a penalty. However, IPOS decided not to embark on such a campaign as it felt that the timing was not right. Odex then initiated an education campaign targeted at five tertiary institutions in Singapore, as well as anime focus groups, at which the blithe responses garnered were along the lines of “catch me if you can” and “why buy when I can download for free and get away with it”. The general attitude of these people was that they would not stop downloading even if they received a warning letter. At most, they would just lie low for a while and resume downloading when the coast was clear.

8 In these circumstances, Odex said it proceeded, as a last resort, to the courts. In doing so, it applied under O 24 r 6(5) of the Rules of Court (Cap 322, R 5, 2006 Rev Ed) for the pre-action discovery of documents from Pacific Internet, a public company and local internet service provider licensed under the Telecommunications Act (Cap 323, 2000 Rev Ed), in order to identify the downloaders in question.

9 Several affidavits were filed by Go Wei Ho (“Go”), Odex’s Managing Director, in support of this application. Paragraph 4 of Go’s first affidavit of 30 May 2007 asserted that Odex required discovery from Pacific Internet “to ascertain the proper party(ies) against whom Odex should commence legal proceedings in order to enforce and protect Odex’s rights and interests”.

10 Paragraph 7 of Go’s first affidavit asserted that Odex and the Anti-Video Piracy Association, Singapore (“AVPAS”), of which Go was the vice-president, were at all material times authorised by “the relevant copyright owners and/or licensees to take all necessary steps to protect and enforce their respective copyrights subsisting in the cinematograph films comprised in more than 200 animation video titles, including but not limited to the 53

animation video titles” set out in a list (“Video Titles”). Various documents purporting to be authorisation letters from the copyright owners and/or licensees were exhibited.

11 In his first affidavit, Go also explained that he had engaged BayTSP to provide Odex with an online tracking solution to track down and collect details of instances of uploading and downloading of copies of the Video Titles. The tracking solution allows tracking of uploading and/or downloading of digital files on the Internet in real time and displays the IP address of each internet user who carries out such uploading and/or downloading. Go had used the tracking solution to track down instances of uploading and/or downloading of the Video Titles by internet users using the BitTorrent protocol to record details of each instance of uploading and/or downloading. Go also explained that the BitTorrent protocol works “by engaging its users in a ‘tit-for-tat’ file sharing system. As each user downloads a file, he / she also uploads his / her BitTorrent files to the network for other users to download. Generally, the larger the amount of bandwidth is set for uploading, the faster the downloading process will be. Each BitTorrent user who downloads files using the BitTorrent protocol therefore also simultaneously uploads his / her downloaded files to other users”.

12 Between 29 January 2007 and 6 May 2007, Go operated the tracking solution continuously. He then sorted out the results and compiled a table setting out “some of the highest instances of downloading/uploading of the Video Titles” where the downloaders and/or uploaders (“the downloaders”) had IP addresses that were issued by Pacific Internet. Apparently, there were 981 of such addresses.

13 Go asserted in para 20 of his first affidavit that “the unauthorised reproduction and/or communication to the public” by each of the downloaders constituted infringement of the copyright in the cinematograph films comprised of the Video Titles under “s 103(a)” (meaning actually s 103(1)) read with s 83 of the Copyright Act (Cap 63, 2006 Rev Ed). He also believed that the wilful infringement of the Video Titles to a significant extent by any of the downloaders also constituted an offence under s 136(3A) of the Copyright Act.

14 In para 24 of his first affidavit, Go asserted that Pacific Internet was not likely to be a party to subsequent proceedings.

15 Below in *Odex Pte Ltd v Pacific Internet Limited* [2007] SGDC 248 (“the GD”), the district judge (“the DJ”) was of the view that Odex did not have the *locus standi* to make the application for most of the Video Titles as Odex was a sub-licensee. Where Odex was the exclusive licensee of a Video Title, Odex had the *locus standi* but the DJ was of the view that Odex had to show an extremely strong *prima facie* case of wrongdoing before the order sought would be made in its favour. The DJ concluded that Odex had failed

to establish such a case. Accordingly, he dismissed Odex's application with costs.

16 Odex then filed an appeal against this decision. It also sought to introduce additional affidavit evidence on the *locus standi* point and to address the DJ's concern about the lack of evidence to establish an extremely strong *prima facie* case, without accepting that the DJ had applied the correct standard of proof. I allowed the admission of such additional evidence.

Locus standi

17 As regards the DJ's conclusion that Odex did not have the *locus standi* for most of the titles in question, the DJ said at [11(a)]–[11(d)]:

The answer lies in the Plaintiff's authority to act. The Plaintiff claimed they have authorization by the relevant copyright owners and/or licensees to make this application. 13 separate letters of authority were produced in GWH-2 in Go's 1st affidavit.

(a) Out of these 13 letters, only 3 parties, namely Gonzo Digimation Holding (GDH), GDH K.K. (GDH KK) and Media International Corporation (MICO) directly appointed the Plaintiff to act for them. Common to GDH, GDH KK and MICO is the fact that they themselves are distributors appointed by undisclosed copyright owners (see pages 17, 35 and 41 of Go's 1st affidavit).

(b) The other 10 letters of authorization were letters authorizing the Anti Video Piracy Association (Singapore) (AVPAS). These 10 letters were from the following parties:

- (i) Toshiba Entertainment Inc dated 1 October 2006.
- (ii) Dentsu Tec Inc 1 October 2006.
- (iii) Sunrise Inc dated 17 October 2006.
- (iv) TV Tokyo Medianet Inc 1 October 2006.
- (v) King Record Co. Ltd dated 1 April 2007.
- (vi) Yomiuri telecasting Corp. dated 25 January 2005.
- (vii) Toei Animation Enterprises Limited dated 18 November 2006.
- (viii) Kodansha Ltd dated 1 August 2006.
- (ix) Geneon Entertainment Inc dated 1 March 2007.
- (x) Kadokawa Pictures Inc dated 1 March 2007.

(c) By a 2nd affidavit at page 21, Go produced a letter by AVPAS dated 1 November 2004 signed by himself as the Vice-President of AVPAS. This letter purported to authorize the Plaintiff "to take such steps as may be necessary to protect and enforce Copyrights". These "Copyrights" refer to the copyright

belonging to “various members of AVPAS”. AVPAS, however, is not a party to this application but Go in his 1st affidavit at GWH-1 discloses the above ten parties to be members of AVPAS.

(d) In relation to all these 13 parties, the Plaintiff is a sub-licensee. This is a point conceded by the Plaintiff’s counsel.

18 The DJ was of the view that in *Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck* [2007] 2 SLR(R) 869 (“*Alliance Entertainment*”), Judicial Commissioner Sundaresh Menon had decided that only the copyright owner and an exclusive licensee (under s 123 of the Copyright Act) had the right to take action against copyright infringers. In so far as Odex was neither the copyright owner nor an exclusive licensee, the DJ concluded that Odex had no *locus standi* to apply for pre-action discovery.

19 However, as regards one letter, *ie*, a letter of authority from Sunrise Inc who claimed to be the copyright owner of one video title, Mobile Suit Gundam Seed, the DJ said that it appeared that Odex was the exclusive licensee in respect of this video title.

20 Before me, Odex criticised these findings of the DJ as follows:

(a) As regards the letter from Sunrise Inc to Odex in respect of Mobile Suit Gundam Seed, Odex asserted that the DJ had wrongly characterised this letter as an exclusive licence when it was actually a letter of authorisation to carry out various acts on behalf of the copyright owner.

(b) As regards the letter from GDH KK, Odex asserted that GDH KK was in fact one of the copyright owners of each of the titles mentioned in its letter and a letter of clarification. GDH KK was not merely a distributor as the DJ had concluded and it had the authority of other copyright owners to issue a letter of authorisation to Odex to carry out acts on behalf of the copyright owners. As regards the letters of authorisation from copyright owners to AVPAS, AVPAS had in turn authorised Odex to carry out all steps to protect and enforce the copyright in various titles. It was wrong of the DJ to categorise these letters of authorisation from AVPAS to Odex as sub-licences. Even Pacific Internet’s counsel had not categorised them as such.

(c) The DJ had also wrongly categorised Media International Corporation (“MICO”) as merely a distributor because in the letter of authorisation, MICO had identified the copyright owners of various titles and had expressly stated that Odex was authorised to take steps to protect and enforce the copyright on behalf of MICO and/or the copyright owners. However, I would just mention at this point that this letter was not well drafted and it did mention expressly that MICO had been appointed by the copyright owners as their “sole international distributor”.

(d) There was one letter of authorisation from Kodansha Ltd to AVPAS. Although Kodansha Ltd was not the copyright owner, it subsequently claimed in a letter of clarification that it was authorised by various copyright owners who had in turn authorised AVPAS to carry out various actions on behalf of the copyright owners.

21 Before me, Odex was emphasising that it was making the application in its capacity as an authorised agent of copyright owners and not in its capacity as licensee, whether exclusive or otherwise, even though it was the exclusive licensee of some, but not all, of the Video Titles. In so doing, Odex was hoping to avoid the consequences of the decision in *Alliance Entertainment*. Odex's said position was not so clearly asserted when it first started on its application *vis-à-vis* Pacific Internet. As I mentioned in [9] above, para 4 of Go's first affidavit had asserted that Odex was intending to commence legal proceedings to protect its own interests. The reference to its status as an agent was only mentioned in para 7 of Go's first affidavit (see [10] above). Even then, the letters of authority were said to be from "copyright owners and/or licensees". The licensees were not even referred to as exclusive licensees then. It seemed to me that Odex might have been unaware of the decision in *Alliance Entertainment* and/or was less than careful when it first started on its application. Perhaps its success in earlier applications against internet service providers known as Singnet and Starhub might have lulled it into complacency. I have taken the trouble to mention this because I am of the view that applicants who seek such discovery, especially in the minefield of copyright law, should tread more carefully lest they confuse or distract themselves, the internet service providers and the court.

22 I would also add that while Odex was correct in asserting that it was not a sub-licensee, it seemed to me that in many instances it was a sub-agent in that it did not receive its authority to act directly from the copyright owners. Be that as it may, I will, for convenience, refer to its status as that of an agent of the copyright owners to make the application for pre-action discovery as it mattered not whether it was an agent or sub-agent.

23 Odex did not dispute the correctness of the decision in *Alliance Entertainment* but sought to distinguish the present application from the facts in that case. It submitted that the present application was for pre-action discovery whereas in that case, substantive relief based on a cause of action was being sought. It relied on a practice direction to support its contention that it had the *locus standi* to make the application notwithstanding the decision in *Alliance Entertainment*. For the Subordinate Courts, the relevant practice direction was ePractice Direction 4 of 2005. The heading was "Applications for discovery or interrogatories against network service providers in relation to specific intellectual property issues". The relevant provisions are paras 1 and 2 which state:

1. Pursuant to Singapore's obligations under Article 16.9.22(b)(xi) of the United States-Singapore Free Trade Agreement, applications made under Order 24, rule 6(1) or Order 26(A), rule 1(1) against network service providers for information relating to the identity of a user who is alleged to have:

- (a) infringed copyright in relation to an electronic copy of material on, or accessible through, the network service provider's primary network; or
- (b) made unauthorised use of a performance in relation to an electronic recording of material on, or accessible through, the network service provider's primary network

will, if made in the proper form, be fixed for hearing within 5 days from the date of filing of the application.

2. This Practice Direction puts into effect the above procedure by introducing a new Paragraph 23A and by making the necessary updates to Appendix D.

24 Paragraph 23A states:

23A. Applications for discovery or interrogatories against network service providers

(1) This paragraph applies to an application made under Order 24, Rule 6(1) or Order 26A, Rule (1) of the Rules of Court -

- (a) by or *on behalf of* an owner or exclusive licensee of copyright material against a network service provider for information relating to the identity of a user of the network service provider's primary network who is alleged to have infringed the copyright in the material in relation to an electronic copy of the material on, or accessible through, the network service provider's primary network; ...

[emphasis added]

25 The above practice direction was dated 21 September 2005 and took effect from 22 September 2005. Earlier, a similar practice direction for the Supreme Court dated 12 August 2005 was issued and this took effect from 15 August 2005. It is unnecessary for me to set out the terms of the earlier practice direction as it is substantially the same, if not identical, to the one for the Subordinate Courts and I need refer only to the latter. I would add that O 24 and O 26A of the Rules of Court relate to applications for discovery and for interrogatories respectively.

26 Odex relied heavily on the phrase in para 23A(1)(a) referring to applications "on behalf of" an owner or exclusive licensee. It submitted that this phrase supported its position that Odex, as an authorised agent of copyright owners, could make the application for pre-action discovery in its own name and that the application need not be in the names of the copyright owners or of the exclusive licensees, if any.

27 Odex also stressed that the practice direction was issued to comply with Singapore's obligation under Article 16.9.22(b)(xi) of the United States-Singapore Free Trade Agreement (dated 6 May 2003) ("the USS FTA"). However, that provision did not assist Odex in its primary assertion. That provision states:

Each Party shall establish an administrative or judicial procedure enabling copyright owners who have given effective notification of claimed infringement to obtain expeditiously from a service provider information in its possession identifying the alleged infringer.

28 As can be seen, that provision does not say that Singapore must allow an authorised agent of a copyright owner to make an application to obtain information from a service provider. It seemed to me that the focus of Article 16.9.22(b)(xi) was in the obtaining of information expeditiously and it was towards this end that the practice direction was passed. In other words, the purpose of the practice direction was to stipulate that the appropriate application would be fixed for hearing within five days from the date of filing of the application.

29 It seemed to me that the reference to "on behalf of" in para 23A(1)(a) was an assumption that such an application could be made on behalf of a copyright owner or exclusive licensee. The practice direction did not purport to create additional rights. Even if it did, it did not have the force of law (see *BNP Paribas v Polynesia Timber Services Pte Ltd* [2002] 1 SLR(R) 539 where Justice Lai Siu Chiu held at [37] that a practice direction is not law but merely a direction for administrative purpose).

30 The *Singapore Court Practice 2006* (Jeffrey Pinsler gen ed) (LexisNexis, 2006) states at para 1/1/6:

Although practice directions may not have the force of substantive law (see *Hume v Somerton* (1890) 25 QBD 239, at 243; *Barclays Bank International v Levin Bros (Bradford)* [1977] QB 270; *Jayasankaran v PP* [1983] 1 MLJ 379 (concerning a practice note: court said that it is not intended to be more than a direction for administrative purposes and 'cannot be exalted into a rule of law')), non-compliance may result in adverse orders against the defaulting party. ...

In a case concerning the effect of practice directions, *Ooi Bee Tat v Tan Ah Chim & Sons* [1995] 3 MLJ 465, at 470, Zakaria Yatim JCA, who delivered the judgement of the Supreme Court, stated that practice directions 'are intended to be no more than a direction for administrative purposes' (also see *Jayasankaran v PP* [1983] 1 MLJ 379, at 380, which is cited for this proposition). Therefore, it is clear that a practice direction does not have the force of a rule of court and cannot vary the force of the latter.

31 Odex also relied on Article 16.9.22(b)(ix) of the USS FTA and certain letters between the governments of Singapore and the US. Article 16.9.22(b)(ix) states:

For purposes of the notice and take down process for the functions referred to in clause (i)(C) and (D), each Party shall establish appropriate procedures for effective notifications of claimed infringement, and effective counter-notifications by those whose material is removed or disabled through mistake or misidentification. Each Party shall also provide for monetary remedies against any person who makes a knowing material misrepresentation in a notification or counter-notification that causes injury to any interested party as a result of a service provider relying on the misrepresentation.

32 A letter dated 6 May 2003 from Mr George Yeo (“Mr Yeo”), the Minister for Trade and Industry, Singapore, to Mr Robert B Zoellick (“Mr Zoellick”), the US Trade Representative, states:

In connection with the signing on this date of the United States-Singapore Free Trade Agreement (the “Agreement”), I have the honour to confirm the understanding reached, by our two Governments, in relation to Chapter 16 (Intellectual Property Rights) of the Agreement as follows:

In meeting the obligations of Article 16.9.22(ix), the Government of Singapore agrees to adopt requirements for: (a) effective written notice to service providers with respect to materials that are claimed to be infringing and (b) effective written counter-notification by those whose material is removed or disabled and who claim that it was disabled through mistake or misidentification, as set forth below. Substantial compliance with the elements listed below shall be deemed to be effective written notice or counter-notification.

(a) Model of an effective notice, by a copyright owner or person authorized to act on behalf of an owner of an exclusive right, to a service provider’s publicly designated representative

In order for a notice to a service provider to be compliant with Article 16.9.22(ix), it must be a written or electronic communication that includes substantially the following items:

1. The identity, address, telephone number and electronic mail address of the complaining party (*or its authorized agent*);

....

6. Statement with sufficient indicia of reliability (such as a statement under penalty of perjury or equivalent legal sanctions) that the complaining party is the owner of an exclusive right that is allegedly infringed or *is authorized to act* on the owner’s behalf;

...

[emphasis added]

33 The substance of this letter was confirmed by Mr Zoellick in his reply dated 6 May 2003.

34 In addition, Odex submitted that Article 16.9.22(b)(ix) of the USS FTA led to the promulgation of the Copyright (Network Service Provider) Regulations 2005 (S 220/2005). Regulation 3(2) states:

A notice under section 193C(2)(b) or 193D(2)(b)(iii) or (4)(b)(iii) of the Act shall be in, or substantially in accordance with, Form A in the Schedule, shall be signed by the complainant and shall contain the following:

- (a) the name and address of the complainant;
- (b) where the complainant is acting *on behalf* of a copyright owner or an exclusive licensee, the name and address of the copyright owner or exclusive licensee;
- ...
- (k) a statement that the complainant —
 - (i) is the owner or exclusive licensee of the copyright in the material referred to in sub-paragraph (e)(i); or
 - (ii) *is authorised to act on behalf* of the owner or exclusive licensee of the copyright in the material referred to in sub-paragraph (e)(i); ...
- ...

[emphasis added]

35 Odex submitted that because the letter from the Minister made references to a notice by a person authorised to act on behalf of an owner and to the authorised agent of a complaining party and because reg 3(2) contained similar provisions, these lent weight to its argument that Odex could, as an authorised agent of copyright owners, make the application in its own name. I did not agree. The letter from Mr Yeo referred to Article 16.9.22(ix) and not to Article 16.9.22(xi). The latter was the provision pursuant to which the practice direction was issued. Likewise, reg 3(2) was in relation to provisions in the Copyright Act which had nothing to do with discovery.

36 Odex also relied on § 512(h)(1) of the US Copyrights Act 17 USC (1998) which states:

A copyright owner or a person authorised to act on the owner's behalf may request the clerk of any United States district court to issue a subpoena to a service provider for identification of an alleged infringer in accordance with this subsection. [emphasis added]

37 However, as Singapore does not have such a provision, it did not assist Odex to rely on a provision applicable in another jurisdiction. The point was not whether the US or Singapore has a rigorous copyright regime or whether in other areas of copyright law or enforcement a person may be authorised to act on behalf of a copyright owner or an exclusive licensee. The point before me was whether, in Singapore, an agent of a copyright

owner could apply in the agent's own name for pre-action discovery in order to identify infringers. *Prima facie*, an agent could not. This is why there is a need for primary or subsidiary legislation to allow this. At present the Copyright Act and its regulations do not allow for this. As for the practice direction, it also does not allow this and, in any event, it cannot create such a right for the reason I have stated at [29] and [30] above. Whether the law should be amended to allow this is a separate matter.

38 Therefore, although Odex was correct in arguing that it was not a sub-licensee in the situation referred to before the DJ, this was immaterial. As an authorised agent, it did not have the *locus standi* to make the application in question.

39 Paragraph 25 of Go's fourth affidavit of 30 October 2007 sought to justify why Odex's name was used. He said, *inter alia*:

Most importantly, if the copyright owners were to each individually spend months tracking down the infringers and making separate applications to court through their respective solicitors in Singapore, the number of illegal downloads every month would continue to snowball unabated, not to mention that multiple applications would likely be made, possibly in relation to the same defendants, resulting in unnecessary consumption of resources, time (including court time) and money. The solution to dealing with this situation more effectively was for the many copyright owners and exclusive licensees to come together and take concerted action through one party in Singapore. This also has the advantage of enabling us to identify the most significant and persistent downloaders and dealing with them appropriately, because anime downloaders often do not download one anime title, but several, each belonging to different copyright owners. If an application were to be confined to the titles owned by only one copyright owner, the resulting data would not provide a complete picture of that downloader's infringing activities.

40 I was of the view that Odex and its Japanese principals had missed the point. The Japanese principals may use the services of an agent to track down infringers. The point is that when it comes to civil court proceedings, they have to use their own names, as the law currently stands, for pre-action discovery and for the formal action for substantive relief. There need not be multiple applications. There may be one application in the names of the various copyright owners. Indeed, eventually that was done when an application was made to add some of the copyright owners as additional plaintiffs, an application which I allowed.

41 It seemed to me that the truth of the matter was that although various Japanese copyright owners had appeared to be supportive of the steps taken by Odex, they were nevertheless reluctant to be named as plaintiffs. That is why even up to the late stage of the hearing of the appeal before me, only some of them had applied to be added as plaintiffs. Their reluctance may be

due to cultural and/or corporate and/or other reasons but, at present, if they wish to fully support Odex's efforts, they will have to lend their names as well. I would add that where their names are used, they may authorise someone to sign affidavits on their behalf so long as that person has the requisite knowledge or information to do so. It is not necessary for a corporate officer of each copyright owner to execute a separate affidavit.

42 During arguments before me, Odex also relied on the court's jurisdiction to allow the discovery sought as expounded in *Norwich Pharmacal Co v Customs and Excise Commissioners* [1974] AC 133 ("NP"), aside from O 24 r 6. I should mention that its original application was made under O 24 r 6 and not under the NP jurisdiction but the DJ had discussed the latter as well.

43 In *UMCI Ltd v Tokio Marine & Fire Insurance Co (Singapore) Pte Ltd* [2006] 4 SLR(R) 95, Sundaresh Menon JC was of the view that such an inherent jurisdiction overlapped with O 24 r 6. Assuming that such a jurisdiction has not been superseded by O 24 r 6, I was of the view that it was still not open to Odex to rely on that jurisdiction. Since it had no *locus standi* to make the application under O 24 r 6, it seemed to me to follow that it also had no *locus standi* to rely on the NP jurisdiction to obtain information with a view to the commencement of civil proceedings by copyright owners.

44 However, Odex submitted that it could apply for an order for discovery under the NP jurisdiction in order to use the information disclosed to undertake criminal proceedings under the Copyright Act. For this proposition, Odex relied on *Ashworth Hospital Authority v MGN Ltd* [2002] 1 WLR 2033 ("Ashworth"). In that case, the defendant was a newspaper publisher. One of its newspapers published an article which included extracts from the medical records of a patient at a hospital. The source was an employee of the authority administering the hospital and had apparently supplied the records to an intermediary who in turn supplied them to a journalist of the newspaper. The authority applied for and obtained an order requiring the defendant to explain how it had obtained the records and the identity of the employee and others involved. The authority had obtained the order to enable it to dismiss the source rather than to bring proceedings against him. The defendant's appeals to the Court of Appeal and to the House of Lords were unsuccessful. The House of Lords held that for disclosure to be ordered, it was not necessary for a claimant to intend to bring legal proceedings against the wrongdoer, provided some other legitimate purpose in seeking disclosure was identified.

45 Lord Woolf CJ suggested that the court's NP jurisdiction could be used to obtain information to identify a wrongdoer. He said at [50], [53] and [54]:

50 In this connection, it is necessary to refer to the recent case of *Financial Times Ltd v Interbrew SA* [2002] EWCA Civ 274. Sedley LJ's interesting judgment, to which I have already made reference, looked again at the history of the bill of discovery. Having done so, he came to the conclusion that the detection of crime is not a proper object of the *Norwich Pharmacal* jurisdiction for both historical and contemporary reasons. He recognised that he was taking a different view from the Master of the Rolls in this case, but he considered the issues were different. This is to adopt an unduly restrictive approach to this case. Sedley LJ went on to state, in para 20:

“Even in the period before the mid-19th century, when the majority of prosecutions were privately brought, the identification of criminals does not feature in the reported cases as a proper purpose of the bill of discovery. Today, when prosecution, subject to rare exceptions, is the task of the state, I can see no justification for introducing it. The prosecution of offences, notably in the field of financial services, is the business of specialised agencies equipped with statutory powers of search and seizure. Each of these powers, none of them unlimited, represents a carefully struck balance between the needs of the community and the rights of the individual. To undercut them with a civil right to compel production of documents or data at the instance of a person claiming to be the victim of a crime would be to court catastrophe. For what purpose would the documents be exigible? If prosecution, that will rarely be the applicant's intent. Here, for instance, Interbrew say that they are entirely content to leave the question of criminal proceedings to the [Financial Services Authority]. If the purpose is civil process, what is the relevance of the commission of a crime? If it has to be crime of which the applicant is a victim, there is almost bound to be a civil cause of action. If it were able to be a crime of which the applicant is not a victim, the limited *Norwich Pharmacal* purpose would be replaced by a practically untrammelled right to disclosure.”

53 However, I do not agree with the views of Sedley LJ set out in the passages of his judgment I have cited. His views on the legitimacy of requiring the identification of the wrongdoer so that he can be dismissed are inconsistent with the statement of the position expressed in the *British Steel* case. In relation to crime, I would not accept the distinction Sedley LJ makes. As Sedley LJ recognises, it is likely that in the great majority of circumstances, if the wrongdoing constitutes a crime, it will also constitute a civil wrong so the different treatment is unjustified. In addition the jurisdiction, as it has developed, enables an individual who has caused harm by wrongdoing, wrongdoing with which the defendant has become involved, to be identified. If the law has developed so as to enable, in the appropriate circumstances, the wrongdoer to be identified if he has committed a civil wrong I can find no justification for not requiring the wrongdoer to be identified if he has committed a criminal wrong. To draw a distinction between civil

and criminal wrongs can only be justified if, contrary to the views I have already expressed, disclosure can only be ordered to enable civil proceedings to be brought against the wrongdoer. If the victim of the wrongdoing is content that the wrongdoer should be prosecuted by the appropriate prosecuting authority I cannot see any objection to his obtaining the identity of the wrongdoer to enable that to happen. The prosecution may achieve for the victim the remedy which the victim requires just as dismissal of an employee can do so. The more restrictive approach attaches excessive significance to the historic origins of the jurisdiction. If this approach had been adopted to the jurisdiction to grant injunctions, freezing orders (*Mareva* injunctions) would never have been developed from the late 1970s onwards.

54 As I understand Sedley LJ's reasoning, he is concerned that a claim to exercise the *Norwich Pharmacal* jurisdiction might be made by someone who is not a victim of the wrongdoing. The answer to this concern is not to limit artificially the *Norwich Pharmacal* jurisdiction but to confine the remedy to the victim of the crime. It is true that crimes are usually offences against the public as a whole but the courts and the law are now progressively showing greater concern for the protection of individual victims of crimes. Certainly, I would agree that an individual who has not suffered in consequence of a crime would not be entitled to bring proceedings. Such proceedings would have to be brought on behalf of the public by the Attorney General. What would be the outcome of such an application I do not have to anticipate. However, allowing the victim of a crime to obtain the identity of the wrongdoer should not involve the dramatic consequences that Sedley LJ fears.

46 As can be seen, Lord Woolf's view was not confined to a situation where the applicant was intending to undertake criminal prosecution himself. It was sufficient if he intended to obtain information to identify the wrongdoer and leave the prosecution to the usual prosecuting authority.

47 Lord Woolf went on to say at [55]–[57]:

55 In the case of a proposed private prosecution surprisingly, having regard to the views he had already expressed, Sedley LJ accepted the position could be different. He said, in para 22:

“Private prosecutions are still permissible and from time to time prove their value as a longstop behind an inert public authority. I would want to leave open the situation where an applicant can show a genuine need or wish to bring a private prosecution but requires the respondent's help in identifying the wrongdoer. It is not this case. In a case such as this, which is the ordinary case, I would hold that it is immaterial to the *Norwich Pharmacal* jurisdiction that the wrongdoer may have been guilty of a crime. What matters is that the applicant means to bring a civil action, or otherwise to assert its legal rights (see the *British Steel* case, per Lord Wiberforce, at p 1174), as soon as it knows who the correct defendant is.”

56 Sedley LJ refers to Lord Wilberforce's speech, at p 1174. There Lord Wilberforce stated: "Now I would be prepared if necessary to hold that, given a cause of action, an intention to seek redress—by court action or otherwise—would be enough ..." Clearly Lord Wilberforce anticipated that there would be a cause of action as there will be in the case of most crimes. However, I would not myself regard Lord Wilberforce's remark as meaning that in the appropriate circumstances wrongdoing which amounted to a crime would not suffice, albeit that it did not involve a cause of action. The very fact that Sedley LJ leaves open the situation where an applicant wishes to bring a private prosecution does indicate that the situation is not quite as black and white as his earlier remarks indicated. I do, however, find it just as objectionable to require a person who has been wronged to bring a private prosecution in order to obtain the identity of the source of the wrongdoing when the Crown Prosecution Service would prosecute as it is to require the victim to have to bring civil proceedings when this is unnecessary.

57 The *Norwich Pharmacal* jurisdiction is an exceptional one and one which is only exercised by the courts when they are satisfied that it is necessary that it should be exercised. New situations are inevitably going to arise where it will be appropriate for the jurisdiction to be exercised where it has not been exercised previously. The limits which applied to its use in its infancy should not be allowed to stultify its use now that it has become a valuable and mature remedy. That new circumstances for its appropriate use will continue to arise is illustrated by the decision of Sir Richard Scott V-C in *P v T Ltd* [1997] 1 WLR 1309 (where relief was granted because it was necessary in the interests of justice albeit that the claimant was not able to identify without discovery what would be the appropriate cause of action).

48 Thus, Lord Woolf left open the question whether there was jurisdiction to order disclosure when there was no cause of action. However, this is different from a situation where there is a cause of (civil) action but the applicant is not the one who has *locus standi* to bring the action.

49 Going back to criminal wrongdoing and assuming that Lord Woolf's view was to be applied in Singapore, would Odex be considered a victim of the wrongdoing? On this point, Odex claimed that it was the exclusive licensee in Singapore of about 118 titles and its business was suffering significantly as a result of internet piracy. I would add that on Odex's argument about being a victim of a crime, even a bare licensee could claim to be a victim of the wrongdoing as its business too would have suffered. In any event, the problem for Odex was that it had expressly disavowed making the application in its capacity as a licensee, whether exclusive or otherwise (see for example paras 21 and 22 of Go's fourth affidavit and Odex's submission before me).

50 Odex could have made its application in different capacities. However it chose to make its application only in its capacity as an agent of the copyright owners. In such a situation, it seemed to me that the agent is not the victim of the wrongdoing. Accordingly under the *NP* jurisdiction as extended by *Ashworth*, assuming *Ashworth* to apply in Singapore, Odex would still not be the right party entitled to relief. In any event, the copyright owners themselves would have the *locus standi* to claim such relief without even having to rely on *Ashworth*.

51 Odex also stressed that it could make a criminal complaint. It cited, as an example, *Megastar Entertainment Pte Ltd v Odex Pte Ltd* [2005] 3 SLR(R) 91 (“*Megastar*”). In that case Odex had made seven complaints under s 136(9) of the Copyright Act as a result of which the court issued search warrants in relation to six units in a building occupied by Megastar Entertainment Pte Ltd. It is true that under s 136(9), there is no restriction on the person who may give the information leading to the issuance of a search warrant but, if the warrant is issued, it is not the informant who undertakes the search but a police officer. In *Megastar*, the search was conducted by officers from the IPRB of the Criminal Investigation Department of the Singapore Police Force accompanied by various persons including Odex’s solicitors. The seized items were retrieved and retained by the IPRB. In the present case before me, Odex mentioned that they had requested the assistance of the IPRB. However, the IPRB declined Odex’s request and advised Odex that it could carry out its own criminal enforcement (see [6] above).

52 Odex submitted that since it could give information leading to the issue of search warrants under s 136(9) and it could also carry out private prosecutions through a fiat issued by the Attorney-General, it was incongruous that it could not obtain discovery under the court’s *NP* jurisdiction.

53 However, the criminal jurisdiction is a different one. If Odex’s argument was valid, then because anyone could make a complaint, it would follow that pre-action discovery would be available to anybody. Secondly, the counter-argument may also be advanced that it is incongruous for Odex to be entitled to obtain pre-action discovery when it could not mount the substantive action in its own name.

54 Furthermore, assuming that the court could allow Odex to obtain the information for the purpose of criminal proceedings, then the court would have to confine the use of such information to criminal proceedings. There was no suggestion that Odex was prepared to have any information obtained so confined.

55 Odex also relied on *Microsoft Corp v SM Summit Holdings Ltd* [1999] 3 SLR(R) 465 (“*Microsoft*”). In that case, the Court of Appeal said at [33]:

We accept that in Singapore there is this unique regime of 'self-help' where the civil and criminal proceedings are part and parcel of the enforcement of an owner's intellectual property rights, and not infrequently they are initiated as parallel proceedings by owners of intellectual property to enforce their rights. In such cases, it would be unrealistic and overly technical to say that documents and information obtained by the owners in criminal proceedings are subject to an implied undertaking analogous to the *Riddick* principle and the owners are precluded from using them in the civil proceedings, and the *vice versa*, when both sets of proceedings are taken to enforce the same intellectual property rights. That was the position in *Ransome/Tempil*.

However, *Microsoft* did not involve a situation where an agent of copyright owners was applying for pre-action discovery. As I have mentioned, the present case is not a situation where copyright owners are without recourse. They need only lend their names to the action but have chosen not to do so, at least initially for some of them. As for the assertion about using the information sought for criminal proceedings, this was on the premise that an offence had been committed. Likewise, the intended use of such information for civil action is also on the premise that there was copyright infringement. I will deal with these points below.

Standard of proof

56 In dealing with the evidence before him for the isolated situation where he considered Odex to be an exclusive licensee, the DJ first considered the standard of proof which Odex had to discharge. He noted the requirements for applications for interim injunctions and for Anton Pillar orders and applied one requirement for applications for Anton Pillar orders. He concluded that Odex had to demonstrate an extremely strong *prima facie* case of wrongdoing. Based on the evidence before him, he concluded that Odex had not discharged this burden. He considered Pacific Internet to be in a special relationship *vis-à-vis* its subscribers and the regulator. Pacific Internet had a contractual and regulatory duty respectively to keep the information sought confidential. The DJ also considered such a test to be applicable to others who are in possession of confidential information arising from similar special relationships, for example, priest-penitent, physician-patient and journalist-source.

57 Odex criticised the DJ's standard of proof. It submitted that even Pacific Internet did not advocate such a high standard and no such standard was mentioned in two other earlier unrelated cases.

58 The first case was *Kuah Kok Kim v Ernst & Young* [1996] 3 SLR(R) 485 ("*Ernst & Young*"). In that case, the pre-action application was made by minority shareholders against a firm of accountants to seek discovery of the documents and working papers which the firm had referred to or used in their valuation of shares in a company. The firm had valued the shares, which the plaintiffs were selling to the majority shareholders, at a price

lower than the valuation obtained by the plaintiffs subsequently from another accounting firm. The Court of Appeal allowed the application. They said at [59] and [60]:

It was not the court's function, at this stage of the application, to dwell into the merits of the case and to determine, based on what little available evidence, whether there is a good claim or not. The court's duty is only to ensure that the application was not frivolous or speculative or that the applicants were on a fishing expedition.

It is precisely because the appellants feel that they have a claim that they are seeking pre-action discovery to determine whether the documents would ground their cause of action. As Denning MR said in *Dunning*, the object of pre-action discovery would be defeated if the appellants had to show in advance that they had already got a good cause of action before they saw the documents.

59 The second case was *KLW Holdings Ltd v Singapore Press Holdings Ltd* [2002] 2 SLR(R) 477. In that case, the application for pre-action discovery was made against the owners of a newspaper which had published a story that allegedly created the impression that the plaintiffs had defaulted in its payment to the founders of a home furnishing store. The plaintiffs sought pre-action discovery in respect of notes of interviews and working drafts for the story to identify the source of information in the story. Judicial Commissioner Choo Han Teck had to deal with the "newspaper role" which purportedly exempted newspapers from disclosing sources of information in a pre-action process. However, on pre-action discovery generally, he thought that the guide should be the interest of justice. On the facts before him, he dismissed the plaintiff's appeal.

60 So, in the case before me, the application was made to obtain the identities of alleged wrongdoers and it was only to that limited extent that one could say it was an exercise in gathering evidence. In *NP*, Lord Cross of Chelsea did not even think that the asking for the name of a person who was to be made a defendant had anything to do with the collection of evidence (see 199D of the law report).

61 Nevertheless, although the information sought by Odex was not to establish any wrongdoing, the DJ was not wrong to consider whether there was evidence of wrongdoing in the first place. However, with respect, I am of the view that he erred when he imposed the standard of proof that he did. In many instances of pre-action discovery, the plaintiff would clearly not be able to meet such a test as in *Ernst & Young*. As regards the situation where the plaintiff asserts that he has a cause of action and is seeking discovery to ascertain the identity of the wrongdoer, then it seemed to me that the strength of his case is one of the factors to be considered in the totality of the facts before the court as suggested by Lord Cross in *NP* (at 199E). Any duty of confidentiality which the defendant may owe to other parties is yet

another factor and should not, in and of itself, give rise to a higher standard of proof. Ultimately, the guide should still be the interest of justice.

62 As for the contractual and regulatory duty of confidentiality which Pacific Internet might have, it was clear to me that such a duty would be subject to any order of court which a court might make. It could not seriously be suggested that Pacific Internet would be in breach of either duty if it made disclosure pursuant to a court order and counsel for Pacific Internet stopped short of making such a suggestion. The prospect that Odex's subscribers may be subject to civil and/or criminal proceedings was neither here nor there. That was the purpose of pre-action discovery, especially in the context of copyright infringement.

Evidence

63 As for the evidence adduced by Odex, the DJ was of the view that such evidence was lacking. He said at [34] and [35] of the GD:

Overall, the Plaintiff has only shown is [*sic*] that BayTSP is *prima facie* a reputable internet investigation agency with documented successes in tracking illegal downloaders. But the evidential connection between BayTSP and the Plaintiff is missing. There is no proof that the Plaintiff had engaged the services of BayTSP. Critically, BayTSP has not testified nor published any report on behalf of the Plaintiff to say that the Defendant's subscribers have downloaded the Video Titles. If BayTSP performs the role of the private investigator, then the Plaintiff ought to have supported their application with an affidavit from BayTSP. Without a report from BayTSP, the Plaintiff's allegations of wrongdoing against the Defendant's subscribers are largely unsubstantiated.

I am also uncomfortable with the expediency by which the Plaintiff has approached this case. This is an application that will impact potentially thousands of persons. The Plaintiff's allegation of copyright infringement is to be inferred from how the Bit Torrent protocol works. In other words, one must know how the Bit Torrent protocol works before deriving the conclusion that it involves downloading and uploading activity. It is the Plaintiff's case that the alleged wrongdoers are also distributing the Video Titles via the Bit Torrent protocol. The function and effect of the Bit Torrent protocol is a subject matter for expert opinion. It is not sufficient for the Plaintiff to adduce website information before a court of law or for Go (without furnishing his qualifications and expertise) to explain the mechanics of Bit Torrent protocol. The Plaintiff could have asked BayTSP or such other technical expert to address this point.

64 It was partly to address these observations that Odex applied to admit additional evidence which I allowed, as I mentioned above. The additional evidence included an affidavit from Mark M Ishikawa, the Chief Executive

Officer of BayTSP, which in turn exhibited a report from him. The report addressed the points raised by the DJ.

65 As mentioned in [13] above, Odex had asserted that the unauthorised reproduction and/or communication to the public by each of the downloaders constituted copyright infringement under s 103(1) read with s 83 of the Copyright Act. Before me, Odex confined its complaint to unauthorised reproduction.

66 Section 103(1) states:

Subject to the provisions of this Act, a copyright subsisting by virtue of this Part is infringed by a person who, not being the owner of the copyright, and without the licence of the owner of the copyright, does in Singapore, or authorises the doing in Singapore of, any act comprised in the copyright.

67 Section 83 states:

For the purpose of this Act, unless the contrary intention appears, copyright, in relation to a cinematograph film, is the exclusive right to do all or any of the following acts:

- (a) to make a copy of the film;
- (b) to cause the film, insofar as it consists of visual images, to be seen in public;
- (c) to communicate the film to the public.

As there was evidence of wrongful downloading of the Video Titles, there seemed to me to be a *prima facie* case of copyright infringement.

68 On the other hand, Pacific Internet mentioned that there might not be any copyright infringement in view of s 114(1) of the Copyright Act which states:

The copyright in a television broadcast or a cable programme, or in a literary, artistic, dramatic or musical work or a cinematograph film included in the broadcast or programme, insofar as it consists of visual images, is not infringed by the making of a cinematograph film of the broadcast or the cable programme for the private and domestic use of the person by whom the cinematograph film is made.

69 Odex's response on s 114(1) was that s 114(1) was confined to copyright in a television broadcast or a cable programme and did not apply to copying from the Internet.

70 From the speeches in Parliament (see *Singapore Parliamentary Debates, Official Reports* (16 November 2004) vol 78 at cols 1041–1071), when the Copyright (Amendment) Bill 2004 (Bill 48 of 2004) was being read in Parliament the second time, it seemed quite clear to me that the downloading from the Internet of material whose copyright belonged to someone else, without licence from the copyright owner, was an

infringement of copyright. However a different threshold was intended and stipulated for an offence under s 136(3A) of the Copyright Act.

71 I also noted that Pacific Internet did not press the point about s 114(1) too vigorously. Indeed, with the new evidence, its counsel said that he would not say that clearly there was no cause of action for a civil action. Pending full arguments from alleged wrongdoers, if it should come to that, I need only say that my tentative view for the purpose of the pre-action discovery application was that there was a cause of action and such a cause of action had been established on the evidence so far, although without the identity of the wrongdoers.

72 As for an offence under s 136(3A) of the Copyright Act, the evidence was much less clear. Prior to the amendments in 2004, the Copyright Act had criminalised only commercial activities of copyright infringement as set out in ss 136(1), 136(2) and 136(3) of the Copyright Act. Under the new s 136(3A), there is also criminal liability if the infringement is wilful and either or both of certain situations apply under s 136(3A)(c):

- (i) the extent of the infringement is significant;
- (ii) the person does the act to obtain a commercial advantage ...

73 The new ss 136(6A) and 136(6B) state:

(6A) For the purposes of subsection (3A)(c)(i), in determining whether the extent of the infringement is significant, the court shall have regard to —

- (a) the volume of any articles that are infringing copies;
- (b) the value of any articles that are infringing copies;
- (c) whether the infringement has a substantial prejudicial impact on the owner of the copyright; and
- (d) all other relevant matters.

(6B) For the purposes of subsection (3A)(c)(ii), a person does an act for the purpose of obtaining a commercial advantage if the act is done to obtain a direct advantage, benefit or financial gain for a business or trade carried on by him.

74 It seemed to me that there would be more difficulty in determining whether the infringement was significant than in determining whether the infringement was to obtain a commercial advantage. For example, if a person were to download copyrighted material without licence for his personal use, it would seem that that is not to obtain a commercial advantage under s 136(6B) since it would not be for a business or trade carried on by him. However it is less clear whether it can be caught under s 136(6A). How many copies and what value would suffice so as to constitute significant infringement? These points were raised in Parliament but they could not be definitively addressed. In responding to such points,

Prof S Jayakumar, the Deputy Prime Minister and Minister for Law, said at cols 1066–1067:

Ms Indranee Rajah also spoke about section 136 – the guidelines for the courts to determine whether the extent of the infringement is significant – and I think Mr Zainudin also mentioned that in connection with the other limb of commercial advantage. What we have tried to do in this section, and with parallel sections elsewhere, is to provide guidelines. Because of the concerns of Ms Indranee Rajah and Mr Zainudin that the way it is drafted may catch the odd home user who in good faith innocently downloads some items, I think I should assure them that the way it is drafted is unlikely to have that result. Because, if you look at the guidelines, this end-user criminalisation provision applies where a person infringes a copyright work and the infringement of the copyright is wilful and the extent of the infringement is either significant or the person does it to obtain a commercial advantage. And in determining whether it is significant or not, the courts will have a set of guidelines. They look at the volume of the articles. They look at the value of the articles. They will then examine whether that person’s infringement has a substantial prejudicial impact on the owner of the copyright. So, you can imagine that, if someone at home is downloading some items for personal use, these guidelines will give sufficient guidance.

For commercial advantage, the person is said to obtain a commercial advantage if the act is done to obtain a direct advantage, benefit or financial gain for a business or trade carried on by him. You have to look at these two limbs in totality to the provision. So, it is really what is intended to catch and what it is not intended to catch. If someone uploads many popular films, if I may give an illustration, such as the Lord of the Rings or Spiderman II and so on, without the authorisation of the copyright owner, and he uploads it into a website, before these films are commercially released so that it pre-empted theatrical release, then, of course, many people will just download the movies and, as a result, the copyright owner suffers because the people do not go to the cinemas or buy the films. While the person who uploaded the films may not have personally benefited, he would have definitely caused substantial impact on the owner of the copyright. But it is not intended to catch a person who commits an infringement by occasionally downloading an article or song from the Internet for his own personal enjoyment.

But let me add that it does not mean that he is scot-free because, legally, that is still an infringement but attracting a civil action.

75 Mr Go had said that he had compiled a table setting out “some of the highest instances of downloading/uploading of the Video Titles” where the downloaders had IP addresses issued by Pacific Internet. Apparently, there were 981 of such addresses (see [12] above). However he did not opine which of those downloaders would also have committed an offence under

s 136(3A). That was another reason why I was not inclined to grant Odex's application for the purpose of criminal enforcement.

76 In the circumstances, I would have allowed the application had the copyright owners (or the exclusive licensees) made the application themselves. Indeed, at the appeal stage before me, there was an application by some copyright owners to be added as plaintiffs as I have said. It was not disputed that the court had the power to allow the application to be added as plaintiffs even at this late stage in view of O 15 r 6(2) of the Rules of Court and *Chan Kern Miang v Kea Resources Pte Ltd* [1998] 2 SLR(R) 85 at [19], which in turn relied on *Dollfus Mieg et Compagnie SA v Bank of England* [1951] Ch 33. Initially, Pacific Internet had not objected to the application, save for one of the applicants. In turn, the counsel for the applicants agreed not to pursue the application for that one applicant. Eventually, I saw no reason to disallow the application. To do so would have merely meant that the copyright owners would have to restart all over again. Accordingly, I allowed the application to be added as plaintiffs for all but one of the applicants. I also allowed disclosure for the Video Titles which the successful applicants were the copyright owners of.

Reported by Chen Siyuan.
