

Pioneers & Leaders (Publishers) Pte Ltd v Asia Pacific Publishing Pte Ltd
[2010] SGHC 211

Case Number : Suit No 866 Of 2008
Decision Date : 30 July 2010
Tribunal/Court : High Court
Coram : Lai Siu Chiu J
Counsel Name(s) : Irving Choh, Lim Bee Li (KhattarWong) for the plaintiff; Lai Tze Chang Stanley SC, Vignesh Vaerhn, Lim Ming Hui Eunice (Allen & Gledhill LLP) for the defendant
Parties : Pioneers & Leaders (Publishers) Pte Ltd — Asia Pacific Publishing Pte Ltd

Copyright – Authorship – whether an incorporated body can be an author of an original work

Copyright – Infringement

Tort – Passing Off

30 July 2010

Judgment reserved

Lai Siu Chiu J:

Introduction

1 In this dispute, Pioneers & Leaders (Publishers) Pte Ltd (“the plaintiff”) claimed that Asia Pacific Publishing Pte Ltd (“the defendant”) had infringed the copyright of the plaintiff’s horse-racing publication known as “Punter’s Way”. The plaintiff also sued for passing off.

Factual Background

2 The plaintiff is a company incorporated in Singapore and has been publishing its magazine “Punter’s Way” (“PW”) since 1977. When the PW magazine was first launched, the plaintiff set up a Research and IT unit to: (i) organize horse-racing information that was to be included in the PW publications; (ii) set up tabulations of the horse-racing information and decide how best the tables should be presented in a reader-friendly manner; (iii) study, experiment and compile the information to be placed in the PW publications; and (iv) restructure the tables presented in the PW publications. The plaintiff contended that there was a set of four tables in PW specifically compiled to give readers “quick reference and useful guides”; the four tables are, (as set out in the sequence found in the PW publications): Table 1 Race Card, Table 2 Results Panel, Table 3 Track Work, and Table 4 Records of Past Performances (“the Tables”).

3 The defendant is also a company incorporated in Singapore. Like the plaintiff, it similarly publishes a horse-racing magazine known as “Racing Guide” (“RG”) which the plaintiff alleged copied many of the features of PW.

4 It was not in dispute that the plaintiff once employed Steven Michael Levar (“Levar”) who is the managing director of the defendant. After the incorporation of the defendant and shortly after his services with the plaintiff ceased in January 2007, Levar assumed his current position. Levar was the only witness for the defendant. In his affidavit of evidence-in-chief (“AEIC”), Levar deposed that he

was considered a horse-racing expert and was a recognised bloodstock agent of horses in Singapore and Malaysia, having had 24 years' experience in the industry including employment first as a racing broadcaster and then, as the chief racing broadcaster and manager of the Singapore Turf Club. Levar registered his sole-proprietorship Horse Racing International as a business in Singapore in June 2004 which provided (and still provides), consultancy services to race clubs in the buying and selling of horses. Levar purchased the RG from its previous owner/publisher after which he informed the plaintiff's managing-director in January 2007 that as he owned a rival to PW, he could not continue working for the plaintiff. Levar revealed that the RG was first published in 1987 and when he acquired it, it was a loss-making enterprise. Levar set about turning it around at which he succeeded.

5 The plaintiff alleged that from 30 June 2007 to 5 June 2008, the defendant's publications of RG had infringed the plaintiff's copyright in PW. Specifically, it was alleged that the horse-racing information and tables in RG had been arranged in the same sequence as that found in PW: Table 1 Race Card, Table 2 Results Panel, Table 3 Track Work, and Table 4 Records of Past Performances. It was alleged that the format and presentation of Tables 1 and 2 found in the RG was similar to those found in PW. It was further alleged that in the RG, there were 8 columns in Table 3 and 17 columns in Table 4 that were substantially similar to those found in PW.

6 In or about February 2007, the defendant added a 'Speed Map' feature to the RG. Sometime in November 2007, a Graphic Analysis table was included in the RG. The Speed Map and Graphic Analysis table were removed from the publications of the RG in or about late December 2007 and replaced with a "Fast Form" table placed in between Tables 1 and 2 in or about January 2008; this was designed to give the reader a comprehensive analysis of each and every race.

7 The plaintiff agreed that the defendant had ceased the copyright infringement after 5 June 2008.

8 With regard to its passing off claim, the plaintiff explained that since 1993, a different colour was used on the front cover of PW to differentiate race days. For example, maroon was used for Singapore Friday races, purple for Singapore and Malaysia Saturday races while gold was used for Malaysia Sunday races. PW also featured forward-racing horses on its cover page, and had placed an advertisement panel across the bottom of the cover page. It was alleged that since 4 January 2008, the defendant had passed off the RG as the PW by using the same colour coding on the front cover of RG (maroon for Singapore Friday races, dark purple for Singapore Saturday Races, light purple for Malaysia Saturday Races, and gold for Malaysia Sunday Races). Prior to January 2008, the defendant had featured the side profile of horses on the cover page of the RG. It had also placed an advertisement panel in the middle-left side of the cover page. However, since January 2008, the defendant changed the direction of the horses featured on the cover page of the RG to forward-racing horses similar to those shown on the cover page of the PW. The defendant had also changed the position of the advertisement panel by placing it across the bottom of the cover page of the RG similar to the PW.

9 The plaintiff's solicitors sent a letter of demand to the defendant on 25 April 2008 alleging copyright infringement and passing off. The defendant took exception to the letter which it considered "a groundless threat" in its pleadings.

The plaintiff's case

10 The plaintiff had five witnesses including its managing-director Phan Tjun Sern ("Phan"). In Phan's AEIC the plaintiff claimed that it owned the copyright in the *format, presentation and compilation* of horse-racing information in the Tables found in the publications of the PW (hereinafter

referred to as the “the alleged Works”). As stated earlier (at [5]), the plaintiff claimed that between 30 June 2007 and 5 June 2008, the defendant’s publications of the RG had infringed the plaintiff’s copyright in the PW. Specifically, it was alleged that the horse-racing information and tables in the RG had been arranged in the same sequence as that found in the PW: Table 1 Race Card, Table 2 Results Panel, Table 3 Track Work, and Table 4 Records of Past Performances. It was alleged that the format and presentation of the columns and headings found in Tables 1 and 2 of the RG was similar to those found in the PW. Specifically, the format of Table 2 in relation to the columns, headers, rows and names of horses were similar for each issue of each corresponding publication.

11 It was further alleged that in the RG, there were 8 columns in Table 3 that were substantially similar to those found in the PW (the columns are: 1. Saddle Number; 2. Horse Name; 3. Trackwork for horse for 2 weeks before; 4. Trackwork for horse for 1 week before; 5. Trackwork of horse during current week of race; 6. Results of horse when it raced 2 weeks before; 7. Results of horse when it raced one week before). In addition, the plaintiff alleged that there were 17 columns in Table 4 of the RG that were substantially similar to those found in the PW.

12 The plaintiff added that the alleged Works had been specifically designed so that horse-racing information was presented in a comprehensive and accessible manner to readers.

13 The plaintiff also alleged that the RG had passed itself off as the PW publications from January 2008 to 19 September 2008.

The defendant’s case

14 The defendant argued that any inference of copying of the alleged Works would be **premature** if copyright was shown **not to subsist** in the alleged Works.

15 The defendant made several contentions that copyright did not subsist in the alleged Works.

16 First, the defendant claimed that the plaintiff did not have **authorship** of the alleged Works because s 27 of the Copyright Act (Cap. 63, 2006 Rev Ed) (“the Copyright Act”) allows only natural persons and not an incorporated entity to be an ‘author’ of copyright protected works. The defendant argued that granting authorship to an incorporated entity would be contrary to public policy as this leads to an indefinite perpetual copyright term.

17 In addition, it was argued that the plaintiff cannot claim to be the author as “many ideas, suggestions and criticism” relating to the alleged Works came from many racing professionals and readers. Specifically, the persons who contributed ideas to the alleged Works (Chan Win Teng, Michael Ho and Clement Chan) were not employees of the plaintiff at the material time of the creation. It was Chan Win Teng who came up with the idea of a Past Performance Table while Michael Ho came up with the idea of having the Track Work Table after the Race Card. As such, they should arguably be the closest there was to an “author” of the alleged Works. It was undisputed that there was never any agreement between the plaintiff and Chan Win Teng and/or Michael Ho to assign the copyright in their ideas and suggestions to the plaintiff.

18 Second, the defendant disputed the **originality** of the alleged Works. The defendant made reference to the fact that all the races in Issue No 11 of the RG dated Monday, 10 February 1997 (“1997 RG”), showed a selection of the four tables (Race Card, Selections and Results Table, Track Work Table and Past Performance Table). The defendant asserted that the arrangement of tables cannot constitute an “intellectual creation” under s 7A of the Copyright Act, because the alleged Works were a **logical** sequence to arrange the horse-racing information. It was further argued that

there was no originality in the alleged works as the use of tables to display horse-racing information was commonplace in the industry as found in other horseracing publications; the plaintiff's arrangement of horse-racing information was described as "nothing more than a commonplace selection of publicly available horse-racing data". There was no originality because the arrangement of tables and selection of horse-racing information did not involve any exercise of knowledge, labour, judgment or skill; they were created *via* a process of data entry into a computer and as such, the "effort and labour" were negligible. The defendant further argued that since the horse-racing information contained facts, copyright did not subsist in them.

19 Even if copyright had subsisted in the alleged Works, the defendant argued that the RG publications were different from the PW publications and referred to the 'Fast Form' and 'Speed Map' features found in the RG publications.

20 In its submissions on the action in passing off, the defendant made reference to the fact that the plaintiff had admitted during the trial that it did not claim to have any monopoly in the "color coding" of PW's cover page, as well as in advertisements featured at the bottom of a cover page.

21 The defendant had a counterclaim on the basis that (as stated earlier at [\[9\]](#)), the letter of 25 April 2008 from the plaintiff's solicitors constituted a 'groundless threat of proceedings' for copyright infringement and the defendant was thereby aggrieved. Since Levar was the person behind the defendant, one can only assume that it was Levar who took exception to the plaintiff's solicitors' letter.

Issues

22 The main issues which this Court had to decide were:

- (a) Can an incorporated body be an author of an original work?
- (b) Are the alleged Works original?
- (c) Was the plaintiff's copyright infringed?
- (d) Does the plaintiff have a claim in passing off?

The Decision

Does the plaintiff have copyright ownership in the alleged Works?

23 The broad issue here is whether copyright subsists in the alleged Works. In determining this issue, the defendant raised an important question of law that has not been dealt with previously – must the author of an original work be a natural living person and not an incorporated entity such as the plaintiff? The *prima facie* difficulty, as will be explained in greater detail below, is that if the author is not a natural living person, the copyright may subsist in perpetuity (as the author would not 'die'); this situation would be contrary to public policy. The further question that has to be answered is, even if the 'author' is an incorporated company, when will the subsisting copyright expire? These issues are dealt with below.

Can an incorporated body be the author of an original work?

24 As stated earlier in [\[16\]](#), the defendant asserted that the plaintiff, being an incorporated entity and not a living person, cannot be an author of the alleged Works because s 27 of the Copyright Act

requires an "author" to be a "qualified person", where the latter has been defined as "a citizen of Singapore or person resident in Singapore". The defendant's argument is untenable given the clear wording of s 27, the material parts of which are reproduced below:

Original works in which copyright subsists

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

(a) copyright shall subsist in the work; or

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

if, but only if —

(c) the first publication of the work took place in Singapore;

(d) the author of the work was a qualified person at the time when the work was first published; *or*

(e) the author died before that time but was a qualified person immediately before his death.

...

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

[emphasis added]

25 It is clear that s 27(2)(c), (d) and (e) are in the disjunctive; it is mandatory that one requirement must be fulfilled for the copyright to subsist in the alleged Works. The defendant's argument that the author must be a qualified person assumes that s 27(2)(d) is the only requirement that is applicable. However, given that it is common ground between the parties that the first publication of the PW took place in Singapore, the requirement in s 27(2)(c) had been fulfilled. In addition, I find that although the author of the work must be a qualified person *for the purposes of* meeting the criteria of s 27(2)(d), there is no statutory provision that exhaustively states that the only "author" relevant for **all** purposes of the Copyright Act *must* be a qualified person. In this regard, it is pertinent to note that s 2 of the Interpretation Act (Cap 1, 2002 Rev Ed) defines 'person' to include any company or association or body of persons, corporate or unincorporated. Further, there are no statutory provisions in the Copyright Act which state that an author must necessarily be a living person.

26 In any event, the defendant's reference to s 27 was wholly irrelevant because the purpose of s 27(c), (d) and (e) is *not* to define who can be an author of a subsisting copyright for all purposes of the Copyright Act – the purpose of those provisions is to ensure that the alleged Works had sufficient connection with Singapore in order to warrant protection under the Copyright Act. The statutory provisions essentially reflect the territoriality principle that intellectual property rights granted in one country are protected within the territory of the country, subject to exceptions such as multinational agreements.

27 The more ingenuous argument made by the defendant was that the plaintiff cannot be the 'author' referring to s 28(2) of the Copyright Act which states that the copyright in a work shall continue to subsist until the expiration of 70 years after the expiration of the calendar year in which the **author of the work died** . Sections 28(1) and (2) are reproduced below:

Duration of copyright in original works

28. — (1) This section shall have effect subject to sections 27 (2) and 29.

(2) Subject to this section, where, by virtue of this Part, copyright subsists in a literary, dramatic or musical work, or in an artistic work other than a photograph, that copyright shall continue to subsist until the expiration of 70 years after the expiration of the calendar year in which the author of the work died.

28 The defendant argued that, if the plaintiff (being an incorporated entity and not a living natural person) was the author, it would have perpetual copyright in the alleged works as the 'author' will not die (bar the situation where the plaintiff is wound up). Such a situation would be contrary to public policy.

29 The plaintiff submitted that an incorporated company (such as the plaintiff) could be an 'author' of a copyright protected work. The plaintiff referred to the decision of *Alteco Chemical Pte Ltd v. Chong Yean Wah (trading as Yamayo Stationery Manufacturer)* [1992] 2 SLR(R) 915 ("Alteco") as support for its proposition. In *Alteco*, the plaintiff had sued for passing-off and copyright infringement of its 'get-up'. The 'get-up' was created by a design agency in Japan in pursuance of a commission from the plaintiff's parent company. Although there was no formal assignment of copyright between the design agency and the parent company, the latter had paid a fee to the design agency. The plaintiff had however executed an assignment of copyright from the parent company. The issue was whether the plaintiff had ownership of the copyright. The derivative issue was who was the 'author' of the 'get-up'? If the author was the Japan design agency, the plaintiff would have no ownership of the copyright. Since there was no assignment of copyright between the design agency and the parent company, the parent company had no property to pass on or assign to the plaintiff. Justice Selvam held that since the parent company had been the one who made arrangements and paid for the creation of the get-up, "common sense and the principles of common law as well as equity" dictate that the 'author' was the parent company. The Court observed (at [25]–[26]):

This is an age where artwork is often a result of teamwork and computer graphics. Often, and particularly in cases where an agency is commissioned to do a get-up or advertisement, the author has absolutely no interest in the get-up or advertisement. Given that scenario, it is often difficult, if not impossible, for an individual "author" to make a claim to copyright or identify him. This is conspicuously so when a corporate or unincorporated body undertakes to materialise an idea into an artistic work or computer graphics. The individual(s) art worker(s) are not identified or identifiable...

... When the agency handed over the finished product they had no profit to reap from its use. *Their only interest was their fee*. The work then had to be print-set for a prototype and then mass printed. That was how the SG-12 get-up was conceived, materialised and put into the production line. The finished product with the tubes would be completed in the manufacturer's factory. In those circumstances it would be impossible to identify a single person who could lay a claim to the copyright of the final work. In the result, common sense and the principles of common law as well as equity (constructive trust) combine to hold that the only "author" who could lay a rightful claim to copyright in the final product was Alpha Techno-Japan. *They were*

the ones who made the arrangements and paid for the creation of the get-up. That would be the modern meaning to the word "author". In the law of passing off the term "trader" is widely interpreted to include a person engaged in a professional, artistic or literary occupation. Likewise, having regard to the purpose of copyright law, the term "author" should be widely interpreted to include the only person whose interest it was intended to protect.

[emphasis added]

30 Although Justice Selvam did not expressly declare that an incorporated company (as opposed to a natural person) can be an author of a work, the implication of his decision was to that effect. In considering the same question, I make reference to the observations in Bently and Sherman, *Intellectual Property Law* (3rd ed Oxford University Press 2009) at p 120:

More problems arise...in relation to entrepreneurial works and computer generated works. In part, this is because the concept of authorship does not sit comfortably with the way we tend to think about such works. That is, we do not normally think of a sound recording, a typographical arrangement or a broadcast as having an author, even in the broad sense in which it is used in copyright law. In these circumstances, it is important to appreciate that the 'author' is an artificial construct, a legal fiction, which is used to allocate rights. This can be seen in the fact that, in relation to sound recordings, broadcasts, and typographical arrangements, the author is (effectively) defined as the person who made the work possible (as distinct from the creator). In the case of a literary, dramatic, musical or artistic work that is computer-generated (which by definition has no author), the 'author' is the 'person by whom the arrangements necessary for the creation of the work are undertaken'.

31 As the concept of 'authorship' was not defined in the Copyright Act, the burden lies on the defendant to convince this court that the Copyright Act prohibits an incorporated company from having authorship in an original work. Consider the situation where employees from different departments of a company contribute in creating small parts of a work, where each small part created is practically meaningless on its own and does not constitute an intellectual creation with copyright protection, and it is really the company as a whole that brings together all the parts to create a final product that is copyright protected; the company in such a situation would arguably be an 'author' of the work. I find that there is nothing in principle that would prevent an incorporated company from having authorship in a work. Nonetheless, Justice Selvam's observation that the author is the 'only person whose interest' the law had intended to protect should not be taken as an all encompassing principle of law. Who an 'author' is must ultimately depend on the facts of the case; specifically, the rights that were sought to be protected, and the factual context from which the alleged Works arose. In the determination of who an author is, the Court should be mindful of any executed assignments of copyrights; or any assignments of future copyright (see s 195 of the Copyright Act). The Court would in addition be sensitive to the terms of the employment contract (if any), and any protections found in s 30 of the Copyright Act (indeed, s 30(3) is wide enough to allow employees and employers to agree amongst themselves the scope of copyright that each is to have in the work created).

32 On the question of the duration of copyright where an incorporated entity is the 'author', I find that it would be consistent with the statutory regime found in the Copyright Act if the copyright in the work is found to expire 70 years after the expiration of the calendar year in which the work was first published. In this regard, I refer to ss 28(3) and 29 of the Copyright Act:

The duration of copyright in original works

28...

...

(3) If, before the death of the author of a literary, dramatic or musical work —

(a) the work had not been published;

(b) the work had not been performed in public;

(c) the work had not been broadcast;

(d) the work had not been included in a cable programme; and

(e) records of the work had not been offered or exposed for sale to the public,

the copyright in the work shall continue to subsist until the expiration of 70 years after the expiration of the calendar year in which the work is first published, performed in public, or broadcast, or included in a cable programme, or records of the work are first offered or exposed for sale to the public, whichever is the earliest of those events to happen.

(4) A reference in subsection (3) to the doing of an act in relation to a work shall be read as including a reference to the doing of that act in relation to an adaptation of the work.

Duration of copyright in anonymous and pseudonymous work

29. —(1) Subject to subsection (2), where the first publication of a literary, dramatic or musical work, or of an artistic work other than a photograph, is anonymous or pseudonymous, section 28 shall not apply in relation to the work but any copyright subsisting in the work by virtue of this Part shall continue to subsist until the expiration of the period of 70 years after the expiration of the calendar year in which the work was first published.

(2) Subsection (1) shall not apply in relation to a work if at any time before the expiration of the period referred to in that subsection, the identity of the author of the work is generally known or can be ascertained by reasonable inquiry.

33 Section 28(2) applies to the situation where the work was published after the death of an author, while s 29 applies where the author of a published work is unknown or cannot be ascertained by reasonable means. It is evident that the common period of duration for both situations starts to run from the time when the work had been published, and the stipulated period is that of 70 years from the (expiration of the calendar) year in which the work was first published. The rationale for this is that where the owner of the work chose not to make his work available to the public (that is, where the choice was made not to publish the work), the copyright regime conferred him the indefinite right to withhold that work from the public in relation to the rights associated with the copyright that subsisted in the work. This right was waived once the author made the choice to reveal his work to the public (through publication) and time started to run from that date.

34 In this regard, I find that there is no difficulty with the duration of the copyright owned by an incorporated entity. Time started to run from the moment the alleged Works had been published, and to be consistent with the regime set by the statutory provisions in the Copyright Act, the relevant period would be 70 years from the (expiration of the calendar) year in which the work was first published. I would add here that the defendant did not actually dispute that the alleged Works had expired. The defendant had only questioned whether an incorporated company could be a copyright

owner due to the potential situation where copyright would subsist in perpetuity.

35 In the present case, the presumption under s 131 of the Copyright Act applies. The section states:

Presumptions in relation to authorship of work

131. —(1) Where a name purporting to be that of the author of a literary, dramatic, musical or artistic work appeared on copies of the work as published or a name purporting to be that of the author of an artistic work appeared on the work when it was made, the person whose name so appeared, if it was his true name or a name by which he was commonly known, shall, in an action brought by virtue of this Part, be presumed, unless the contrary is established, to be the author of the work and to have made the work in circumstances to which section 30 (4), (5) and (6) does not apply.

36 There is a presumption that the plaintiff was the author of the alleged Works as the plaintiff's name appeared in the PW publications (usually at the last or second last page of the publications). The burden lies on the defendant to prove otherwise. Apart from mounting legal arguments to denounce the plaintiff's authorship, the defendant did not adduce any evidence to disprove that the plaintiff was the author of the alleged Works.

Are the alleged Works original?

37 The defendant disputed the originality of the alleged Works. Earlier (at [4] and [10]), I had made passing reference to the witnesses called by the parties. Besides Phan (PW1) and Coops (PW5), the plaintiff's other witnesses were Michael Ho (PW2) a former jockey with the Singapore Turf Club and a friend of Phan, who testified that he gave suggestions to the plaintiff as a reader, on how to improve the PW. Another witness of the plaintiff was Clement Chan ("Chan"). Chan (PW3) who is a racing consultant for a subsidiary of the plaintiff that owned a website www.winner21.com. Chan was a jockey until 1989 when an accident to his leg cut short his racing career. He too testified that he had also given recommendations to the plaintiff as a reader on ways to improve the PW.

38 The defendant (Levar) on the other hand claimed that many readers and horse-racing experts had *contributed ideas* to the PW publication. Specifically, he said Chan Win Teng came up with the idea of a Past Performance Table while Michael Ho came up with the idea of having the Track Work Table after the Race Card. The defendant also argued that there had never been any assignment of copyright between those people and the plaintiff. Such arguments are *misplaced*. The plaintiff was not claiming copyright protection in the unexpressed ideas in relation to the organization of horse-racing information. It is trite law that copyright law protects not the idea itself, but the *expression* of the idea. This principle was affirmed by the Court of Appeal decision in *Flamelite (S) Pte Ltd and others v. Lam Heng Chung and others* [2001] 3 SLR(R) 610 at [22]–[23] ("*Flamelite*"):

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.

...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.

39 The defendant further argued that the use of tables to display horse-racing information was

commonplace in the industry as it was found in other horse-racing publications; the plaintiff's arrangement of horse-racing information was described as "nothing more than a commonplace selection of publicly available horseracing data". There was no originality because the arrangement of tables and selection of horse-racing information did not involve any exercise of knowledge, labour, judgment or skill; they were created via a process of data entry into a computer and as such, the "effort and labour" were negligible. The defendant further asserted that the arrangement of tables could not constitute an "intellectual creation" under s 7A of the Copyright Act because the alleged Works were a logical sequence to arranging the horse-racing information.

40 The defendant's arguments were unconvincing. The threshold for originality was not set at an exceedingly high level, as can be seen from the decision in *Auvi Pte Ltd v. Seah Siew Tee and another* [1991] 2 SLR(R) 786, where Chao Hick Tin J said (at [32]–[33]):

The law on this is clear. Originality in this regard does not mean novelty or uniqueness; nor does it necessarily involve inventiveness. *All that needs to be shown is that the author created it and has not copied it from another, and that he has expended towards its creation a substantial amount of skill or labour.* What will be the exact amount of skill, labour or judgment required cannot be defined in precise terms: see Lord Atkinson in *Macmillan & Co Ltd v Cooper (K&J)* [1923] 40 TRL 186 at 190.

The cases would appear to show that simplicity *per se* does not prevent a work from acquiring copyright: see *British Northrop Ltd v Texteam Blackburn Ltd* [1974] RPC 57 and *KARO STEP Trade Mark*. Even drawings of things in common use such as engines and gear boxes are copyrightable: see *Nichols Advanced Vehicle Systems Inc v Rees* [1979] RPC 127. I think this statement of Megarry J in *British Northrop Ltd* at 68 says it all: "A single straight line drawn with the aid of a ruler would not seem to me a 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 common place article makes it too simple to be the subject of copyright." As I see it, where an author has made use of an existing subject matter in creating his drawing, it is always a question of determining whether he has put in sufficient skill and labour to justify copyright protection for his result.

41 In this regard, the skill and creativity expended in the selection, ordering and arrangement of the alleged Works was plainly evident from expressed form found in the PW publication, from the intangible and unexpressed ideas given by different personnel. The transformation of such intangible ideas into the manifested forms as shown in the publications naturally gave rise to an inference that some effort and labour had been involved. This inference was further supported by the detailed evidence. The plaintiff had at first created a prototype of the layout of horse-racing information; this prototype was sent to the plaintiff's directors, senior managers, IT consultants, the IT and Research Unit as well as the editorial team for modifications and suggestions. It was also undisputed that the plaintiff had, from July 1993 onwards, begun to computerize their Track Work information database and the information on 'Home-based and current track work' was introduced in the 3 July 1993 issue of the PW. The plaintiff also incorporated a column to indicate the training stints of horses and further included the additional feature of the 'finishing position and field size' (which showed the horse's finishing position for a race ran by the horse after a training stint), since the 19 June 2003 edition of the PW. These new features were added to provide readers with a quick assessment of how the specific horse had responded (as shown in the race performance) to a training stint. From and after the 29 April 2005 issue of the PW, the plaintiff improved the tabulations to include information which showed the horses' 'past performance records' for the previous four weeks.

42 I accept the plaintiff's evidence that the horse-racing information was specifically placed in accordance with what the plaintiff believed was most important to the readers of their publications. For example, the sequence of information was placed in the Race Card such that the most important information, being the saddle number, was placed first, followed by the latest race results and the horses' names. As such, I have no doubt that there had been sufficient skill and labour applied to the alleged Works. The 'originality' of the alleged Works cannot be disputed.

43 In addition to the above arguments, the defendant argued that since the horse-racing information was essentially facts, copyright does not subsist in the same. This argument is without merit. The plaintiff was not claiming copyright in the horse-racing information *per se*, but in the *selection and arrangement of the information*.

44 The defendant also made reference to the fact that all the races in Issue no. 11 of the RG dated Monday 10 February 1997 ("the 1997 RG"), showed a selection of the four tables (Race Card, Selections and Results Table, Track Work Table and Past Performance Table). This observation was raised by the defendant in cross-examination; it was not its pleaded case. This evidence of the 1997 RG was hardly relevant. That publication showed that it was only in Race 5 that the Track Work Table came after a Race Card. The defendant sought to argue that this showed that the defendant had already chosen to arrange the sequence of the Tables as early as 1997, and therefore the plaintiff could not claim originality to the sequence. This reliance on a one-off sequence cannot ignore the skill and labour that the plaintiff had put into its original work. The fact remains that out of all the races in a year, the defendant had chosen to arrange the sequence of the table as such on a single Race 5 on 10 February 1997. I hold that a one-off arrangement of the tables that coincidentally happened to be similar to the plaintiff's works did not erase the originality of the latter. To find otherwise would render the concept of originality to arbitrary exceptions.

Was the plaintiff's copyright infringed?

45 To establish that the copyright had been infringed, the plaintiff must show that copying had taken place, and this is proved by establishing substantial similarity combined with proof of access to the alleged Works.

46 As the defendant did not dispute the fact that Levar had access to the PW publications when he was employed by the plaintiff, there is no issue that the defendant had access to the alleged Works. The focus of this analysis will be on whether the works in the RG were substantially similar to those in the PW. In addition to showing *substantial similarity* (which aids in giving rise to a rebuttable inference of copying), s 10(1) read with s 31 of the Copyright Act requires that, to constitute infringement, what is copied must be a *substantial part* of the protected work. On the question of what constitutes "substantial part", the Court of Appeal in *Flamelite* had endorsed (at [35]) the observations by Buckley LJ in *Catnic Components Limited v Hill & Smith Limited* [1979] FSR 619 at 626-627:

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 evidence showed substantial similarity and that a substantial part of the work has been copied.

47 This was essentially a question of fact. In the publications of the RG between June to November 2007, the relevant tables were arranged in a sequence that was exactly the same as that found in the PW publications: Table 1 Race Card, Table 2 Results Panel, Table 3 Trackwork and Table 4 Past Performance, except that there was a 'Selections' feature found in between Table 1 and Table 2. The selections feature did not alter the substantially similar sequence of the Tables because it was Levar's own evidence that the selections feature was sometimes read together with Table 2 Results Panel as one table. I find that the selections feature was subsequently *incorporated* into the Table 2 Results Table and became part of Table 2 itself. Levar had admitted that the selections panel subsequently 'disappeared' as it was combined into the Result Panel. As such, the sequential arrangement of the 4 Tables in the RG publications from June to November 2007 was exactly the same as that found in the PW publications.

48 For publications of the RG between November and December 2007, the sequential arrangements of the relevant four Tables were exactly the same as those in the PW publications: Table 1 Race Card, Table 2 Results Panel, Table 3 Trackwork and Table 4 Past Performance. For the publications of the RG starting from January 2008, three of the relevant Tables were arranged in exactly the same manner as those in PW: Table 2 Results Panel, Table 3 Trackwork and Table 4 Past Performance. There was a Fast Form feature found in between Table 1 and Table 2 for the RG publications after January 2008.

49 With regards to the specific examination of the format, presentation and compilation of horse-racing information found in the Tables, counsel for both parties had focused their analysis on a comparison between the 5 January 2008 Issue No 3 of the PW with the corresponding RG Issue No 3 dated 5 January 2008. I find that the 8 columns of Table 1 found in the RG were arranged in substantially the same sequence. The only difference was that the 'weight' column was placed earlier in the RG, and the 'Trainer' and 'MPA' columns were interchanged as the last two columns. The Table 2 Results Panel in the RG was similar to that found in the PW. Where the RG could have placed the results of the race in other formats, (a *vertical* format would come to mind), the defendant had chosen a similar horizontal format for Table 2; it bears noting that the expression of the idea of allowing punters to write down their own results had been copied by the defendant *in toto*, even in the exact sequence of the top 4 horses, followed by the 'time' column, with a dollar sign ('\$') found in each column. The substantial similarity for Table 3 was undeniable. While the plaintiff had chosen to place the horse-racing information in the following sequence: 1. Saddle Number; 2. Horse Name; 3. Trackwork for horse for 2 weeks before; 4. Trackwork for horse for 1 week before; 5. Trackwork of horse during *current week* of race, the defendant had also done the same for the RG. It was particularly noteworthy that the RG had precisely the same combination and sequence of: Trackwork for horse for 2 weeks before followed by Trackwork for horse for 1 week before and then Trackwork of horse during *current week* of race. For Table 4, not only was the presentation of the information *within* the columns identical to those found in the PW, the sequence layout for 17 columns was also substantially similar.

50 The substantial similarity between the alleged works in the PW and the arrangement of horse-racing information in the RG gave rise to a *prima facie* inference that copying had taken place. The

burden of proof shifted to the defendant to rebut this inference. Apart from the substantial similarity between the works in both publications, I also find that a *substantial part* of the works in the PW had been reproduced in the RG.

Rebuttal of the inference of copying and that a substantial part of the work had been copied

51 The defendant maintained that between February 2007 and November 2008, it had improved its publications by incorporating some 'unique features' into the RG for 'easier and efficient reading'. Specifically, the RG's Race Card (Table 1) had a column of "J-1-2-3" which showed different horse-racing information from the "R-1-2-3" column found in that of PW. The defendant explained that the information in "J-1-2-3" showed the jockey's current form statistic over the last 20 races. The alphabet "J" represented the number of races the jockey had ridden. The number "1" represented the number of wins over the last 20 races, the number '2' represented the number of times the jockey achieved 2nd place out of the last 20 races. The defendant further highlighted that Table 1 in the RG showed the lowest, highest and current Malaysian Racing Association ("MRA") whereas the PW publications showed only the current MRA, ratings. It was also pointed out that the RG's Trackwork table (Table 3) had a 'stars' column for horses that were in form. As for Table 4 which was the Past Performance Table, the plaintiff asserted that the RG publication allowed readers to write the current week's track work, and had a 'proven weight' feature. It also provided readers with information concerning starts, firsts, seconds and thirds a horse had obtained overseas.

52 The Court of Appeal in *Flamelite* was quick to emphasize that the existence of dissimilarities did not necessarily mean that there was no infringement or that there was no copying. The real question in each instance was (at [40] of *Flamelite*):

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.

[emphasis added]

53 The Court of Appeal referred to the Australian High Court decision of *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.*

[emphasis added].

54 In relation to the sequential arrangement of the Tables, I find that the inference of copying had not been rebutted. As stated above in [46]-[47], the arrangements of the tables found in the RG publications from June to December 2007 were in an identical fashion to that found in the PW. For the RG publications (since January 2008), although there was a 'fast form' feature placed after the Race Card, the substantial sequential arrangement remained the same: Results Panel was followed by the Trackwork Table, which was in turn followed by the Past Performance Table. Indeed, there were times when the RG publications had even omitted fast form information (see as examples pages 10 and 20 of the RG issue no. 3 dated 5 January 2008). For the relevant set of Tables, the sequential arrangement would be exactly the same as those found in the PW.

55 With regards to the Race Card (Table 1), the column of "J-1-2-3" in the RG was identical to the "R-1-2-3" column found in PW's Race Card. The only difference was that the "J-1-2-3" column had standardised the jockey's information to 20 races for all jockeys, whereas the "R-1-2-3" column had different number of races for different jockeys such that the numbers below the "R" column changed. The standardisation of having the information of 20 races for all jockeys was a *de minimis* change; the fact remained that the format of presentation of the information was identical. The addition of 2 more sub-columns for the MRA ratings does not alter my finding that a substantial part of the plaintiff's work had been copied. Indeed, Levar himself admitted that prior to 21 April 2007, RG did not have any columns for *the total runs* of the horse. On the contrary, the total runs column found in PW's race card existed even before 21 April 2007. It cannot be overlooked that the person with access to the plaintiff's alleged Works was its former employee Levar, who became the defendant's managing director after leaving the plaintiff in January 2007. As such, Levar's admission would only reinforce the presumption of copying. Levar made a further admission (at N/E 78):

Q: the jockey column, J1, 2, 3 compared to the R1, 2, 3 column, that was also not there when you took over the Racing Guide. Correct?

A: Correct.

His admission reinforces the inference that the "J-1-2-3" column was copied from PW's "R-1-2-3" column.

56 The defendant did not (unlike for the other three tables) point out in its pleadings any 'unique features' for the results and selections panel. The inference of copying the format and presentation of the horse-racing information for the results and selections panel is therefore unrebutted. As I have said in [49], the results of the race and the names of the horse could have easily been placed in a vertical format; but the defendant had chosen to copy *in toto* the plaintiff's method of presenting such information.

57 It was also pointed out that the RG's Trackwork table (Table 3) had a 'stars' column for horses that were in form. I find this to be a mere fanciful and *cosmetic* addition. The fact remains that the defendant had copied the *exact* format of presentation of the horses' Trackwork, specifically in the sequence of Trackwork for horse for 2 weeks before, followed by Trackwork for horse for 1 week before; and then Trackwork of horse during *current week* of race. The defendant could have easily chosen a different method of presenting the information; or a different format of tabulating or presenting the same information. I would add that a defendant cannot evade the copyright regime, after it had copied a substantial part of the plaintiff's work into its works, by adding a cosmetic and fanciful feature (consciously or otherwise) to present a facade of difference.

58 As for Table 4 (the Past Performance Table), the plaintiff asserted that the RG publications allowed readers to write the current week's track work, and it had a 'proven weight' feature. It also provided readers with information concerning starts, firsts, seconds and thirds placings that a horse had obtained overseas. However, despite the apparent additions, it bears reiterating that the question of substantiality is not merely a matter of quantum, but that of quality (See *John Robert Powers School Inc and Others v Tessensohn Denyse Bernadette (trading as Clea Professional Image Consultants)* [1993] 2 SLR(R) 798 where the same principle was applied in a different context). The real question for *all four Tables* is, looking at the *manner* of presentation and compilation of the horse-racing information *as a whole*, whether the Tables in the RG incorporated a *substantial part* of the alleged works found in the PW publications, even after considering the input of those additions in the RG publications. I have no doubt that the answer to this is "Yes" for all four Tables.

59 A close perusal of the publications shows that the format, presentation and compilation of the horse-racing information remain the same. Specifically for Table 4, I find that the defendant had *slavishly* copied the *manner* of presentation *in toto* from the PW publications and had merely inserted a horizontal row at the end of each horse's table showing features such as its overseas performance, the 'yielding' statistic and track information (soft or heavy track). It is significant to note that the whole portion of the table *above* this new horizontal row remained identical to the Table found in the PW.

60 In fact, the evidence which convinced me that there had been a most ***blatant*** form of copying by the defendant, was the fact that the spaces (or gaps) between every 4 rows of the horses' names in the Race Card of the RG publication were identical to the spaces (or gaps) in the Race Card found in the PW publication. For example, in comparing the Race Card for race 2 of the 5 January 2008 Issue No 3 of PW (at page 10) with the corresponding RG Issue No 3 dated 5 January 2008 (at page 10), it could be seen that there was a space between the third horse 'Monopoly' and the fourth horse 'Wonderful Gift'. There was also the same gap between the eighth and ninth horses as well as between the twelfth and thirteenth horses. The *same gap was copied* onto the PG publications in between the same horses! It is plainly evident that there have been instances of blind copying by the defendant. It would take more than a lame denial that the spacing was due to the "computer programming" (neither documentary evidence was adduced by the defendant on this point, nor did any witnesses with computing expertise testify the same) for the defendant to discharge its burden of disproving blatant copying.

61 Indeed, Levar himself admitted (at N/E 66) that the horse-racing information can be presented in a different format from that found in the PW:

Q ...would you agree with me that racing data within a table can be arranged in different ways within a table?

A ...I generally find that each country has their own way of arranging data.

Q ...My question is really quite simple. The racing data within a table can be arranged in different ways.

A Not too many different ways.

Q Yes, yes. But "can" that means "yes". You are answering "Yes. They can be arranged in different ways."

A Slightly, yes.

62 The defendant did not produce any other publications to prove that there had been the same manner of presenting horse-racing information as that found in the PW publications. If the defendant had done so, it would have gone some way to rebut the presumption that the defendant had copied the presentation found in the PW. On the other hand, the plaintiff had adduced evidence of other racing publications (*viz* the Hong Kong Daily News Racing Booklet, the Malaysia and Hong Kong Turf Guide, and the Penang Turf Club Race booklet) which showed that the horse-racing information was arranged in *different ways*. Amongst the different formats that the defendant could have chosen to arrange the horse-racing information in the Tables, the fact that the defendant had the same arrangement as that found in the plaintiff's PW publications, coupled with the fact that both PW and RG's market are substantially in Singapore (therefore making them direct competitors in the market), gave rise to a very strong inference of copyright infringement.

63 Based on the totality of the evidence presented before this court, I find that the plaintiff has succeeded in its claim for copyright infringement. For the avoidance of doubt, I would add here that the question of whether the RG publications had originality is separate from the question of whether the contents of the RG publications had incorporated a substantial part of the plaintiff's works in PW. This Court is only concerned with the latter question. Once it was shown on the evidence that a substantial part of the alleged Works had been copied, the case of copyright infringement is made out. The other question only arises if the defendant wishes to assert that it has copyright in its works in the RG. That however is not the defendant's pleaded position (See *Virtual Map (Singapore) Pte Ltd v. Suncool International Pte Ltd* [2005] 2 SLR(R) 157 where Lai Kew Chai J held that any original work which is thereafter derived from the infringement may nevertheless enjoy copyright).

The plaintiff's claim in passing off

64 Contrary to the defendant's contentions, I find that the plaintiff had sufficiently pleaded its case in passing off. The plaintiff explained that since 1993, a different colour was used on the front cover of PW to differentiate different race days (maroon for Singapore Friday races, purple for Singapore and Malaysia Saturday races and gold for Malaysia Sunday races). PW publications had also featured forward-racing horses on the cover page and had an advertisement panel placed across the bottom of the cover page. It was pleaded that from 4 January 2008 onwards, the defendant had passed off the RG publications as the PW publications by using the same colour coding on the front cover of RG. Prior to January 2008, the defendant had featured the side profile of horses on the cover page of RG. It had also placed an advertisement panel in the middle-left side of the cover page. However, since January 2008, the defendant changed the direction of the horses featured on RG's cover page, to forward-racing horses similar to those shown on PW's cover page. The defendant had also changed the position of the advertisement panel and placed it across at the bottom of RG's cover page, similar to that of the PW.

65 The plaintiff pleaded the particulars relating to the goodwill of its business: Since 1977, PW has been sold in more than 130 7-Eleven stores and more than 600 newsstands in Singapore. An average of 31,000 copies were sold every week. The plaintiff further promoted the PW through video advertisements on all screens in the Singapore Turf Club, at the Off-Course betting centres of the Turf Club and on Channels 88 and 89 of Singapore Cable Vision. The plaintiff specifically pleaded that it had acquired goodwill in the "sale of Punters' Way by way of the overall planning and get-up of the magazine".

66 The plaintiff pleaded misrepresentation on the part of the defendant "by adopting a confusingly similar colour code, the defendant had misrepresented to members of the public that the defendant's publications were that of the plaintiff and/or connected to or associated with the plaintiff".

67 The plaintiff's pleadings also prayed for "an inquiry as to the damages caused to the plaintiff as a result of the copyright infringement and passing off".

68 It is evident that the plaintiff had pleaded the three main elements of an action in passing off which aspects were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 at p 460 ("*Reckitt*") and endorsed by our Court of Appeal in *CDL Hotels International Ltd v. Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ("*CDL Hotels*") at [86]:

The law of passing off can be summarised in one short general proposition — no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

Goodwill in the sale of PW by way of its overall planning and get-up

69 The plaintiff must establish that there was a "capricious addition" to its PW publications, and that the overall get-up of the PW had become distinctive of the publications themselves, such that members of the public associate or identify the PW publications with its overall get-up. This is a question of fact. It is apposite at this juncture, to make reference to the astute observations by the Court of Appeal in the decision of *Tong Guan Food Products Pte Ltd v. Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903 ("*Tong Guan*") at para [10]:

From our *overall impression* of the packaging, it is clear to us that the appellant is entitled to rely on the packaging as a whole as a distinctive get-up, and that there is *a capricious addition to the article* itself. This is only one aspect however of what the appellant must establish. The appellant must also show that *the get-up is well known in connection with its business, ie the reputation of the get-up must be established*. The appellant must prove that the mark, name or other indicia on which it relies is well known in connection with a business in which it has goodwill, or with goods connected with that business, and is *distinctive of those goods or that business*. In this case, the appellant is relying on the get-up of the cashew nuts and salted almonds packaging. The only way in which a person can acquire reputation in a mark, name or other indicia is by using it in connection with his business or goods. The precise extent of use required depends on the nature of the particular mark, name or indicia used and of the business or goods concerned.

[emphasis added]

70 The Court of Appeal had also emphasized on the factual nature of the enquiry by citing with approval the decision of *White Hudson & Co v Asian Organization Ltd* [1965] 1 MLJ 186 ,where the goods in question were "Hacks" sweets which were wrapped in red coloured cellophane paper on which the word "Hacks" was printed. Lord Guest said at p 188:

The essence of a passing-off action is that A is not entitled to represent his goods as the goods of B or enable someone else to do so. (*John Brinsmead & Sons Ltd v [Edward George Staleny] Brinsmead* 30 RPC 493). The first matter which a plaintiff must prove in a passing-off action is that the ***get-up of his goods has become distinctive of these goods and that it was associated or identified with them*** . This is a ***question of fact*** and upon this the appellants have the finding of the trial judge in their favour. Their Lordships are satisfied that the trial judge was justified in so finding. *The fact that non-English speaking customers were in the habit of asking for 'red paper cough sweets' shows clearly that to these customers the get-up of the red coloured wrapper had become associated or identified with the appellants' goods.* An attempt was made by the respondents to show that the red coloured wrappers were common to the trade. This attempt failed, as it was clear on the evidence that prior to 1953 no wrapper similar to that used on the appellants' sweets had ever been used in Singapore, and from 1953-1958 the appellants' sweets were the only sweets so wrapped which were sold in Singapore.

[emphasis in italics original, emphasis in bold added]

71 As pointed out by Lord Oliver in *Reckitt* at p 499 (*supra* [68]), it is sufficient if members of the public identified the get-up with the PW publications, there is no need for members of the public to identify the get-up with the plaintiff themselves:

[The plaintiff] must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff.

72 In this case the defendant had contended that the plaintiff failed to claim any goodwill in the *particular* colour coding; the plaintiff also did not claim to have the monopoly to feature advertisements at the bottom of its front cover page. The defendant's contentions are irrelevant because the plaintiff's get-up is the overall appearance of the PW publication; it would be artificial to analyse the *constituent parts* of PW's cover page in *isolation*. Such an approach would also be contrary to the plaintiff's pleaded position that it is claiming goodwill in the "sale of PW by way of its *overall* planning and get-up". The PW publication therefore has to be looked at as a whole, and the relevant get-up is the distinctive colours used for specific race dates *seen together with* the forward racing horses shown on the cover page *and* the advertisement panel placed at the bottom of the cover page.

73 I have taken into consideration the fact that PW had adopted the unique colour-coding since 1993, that PW has been sold in a substantial number of stores and newsstands in Singapore and that there had been considerable efforts in advertising, where the plaintiff promoted the PW through advertisements in the Singapore Turf Club, the Off-Course betting centres of the Turf Club and on Channels 88 and 89 of Singapore Cable Vision. I find that the plaintiff had built up considerable goodwill in the business and overall get-up of PW publications. My finding is reinforced by the evidence shown by the market research conducted by Greg Coops ("Coops") the managing director of Asian Strategies Pte Ltd) who has had 30 years' experience in quantitative and qualitative market research. Coops testified that a sample of 400 respondents had been interviewed and surveyed in

October 2008 and 83% of the respondents identified PW as the most widely read racing guide in Singapore, while 91% of those who have ever bought PW had done so in the previous six months from the date of survey.

Misrepresentation

74 The question here is whether there had been misrepresentation that had led or is likely to lead ordinary and sensible members of the public to confusion, in relation to the RG and PW publications. I must emphasize at this point that whether or not there had been misrepresentation is a question of fact to be determined by the Court. As was observed by the Court of Appeal in *Tong Guan* at [24]:

The law is settled and there is a series of cases for the following propositions from the last century to the present. The test to be applied has been stated in *Newsweek Inc v British Broadcasting Corporation* [1979] RPC 441 at 447 which is *whether ordinary sensible members of the public would be confused*. It is not sufficient that the only confusion would be to a very small unobservant section of society or as Foster J put it recently, if the only person who would be misled would be a moron in a hurry. It is sufficient that a *substantial proportion of persons who are probably purchasers of the goods of the kind in question would in fact be confused*. *Whether or not there is misrepresentation is always a question of fact to be determined by the court in the light of evidence of surrounding circumstances. The impression is entirely a matter for the judgment of the court and not that of the witnesses*. All that can be done is to ascertain in every case as it occurs whether there is such a resemblance as to deceive a purchaser using ordinary caution.

[emphasis added].

75 In this regard, there is no need to prove actual confusion amongst members of the public, as held in *CDL Hotels* at [68]:

It is not necessary that there should be any confusion occasioned by the misrepresentation, although confusion is of great evidential value in determining whether or not there has been any misrepresentation. If the names of two entities are confusingly similar, there is a great likelihood that the public will be misled into thinking that they or their businesses are connected with each other.

76 On a perusal of the cover pages of both RG and PW, I find that, even without the assistance of Coops' expert evidence (which I will elaborate upon below), there is little doubt that there had been misrepresentation that would result in confusion amongst members of the public. In fact, there is a *compelling* case that the defendant had *consciously and deliberately* made changes to the RG's cover page to misrepresent the RG's publication as that of PW. Levar left the plaintiff's employment in January 2007 and he subsequently started the defendant and its publication of RG. About a year later in January 2008, the RG publications adopted the colour coding used by PW for races. The defendant had the choice of other colours to use for the races, yet it chose to use the exact same colours as those used by the PW. The case becomes compelling when the *same colours* were used for the *same specific function* as those devised by the plaintiff.

77 Additionally, prior to January 2008, the defendant had featured the side profile of horses on the cover page of RG. It had also placed an advertisement panel in the middle-left side of the cover page. Since January 2008, the defendant changed the direction of the horses featured on RG's cover page, to forward-racing horses similar to those shown on PW's cover page. The defendant had also changed the position of the advertisement panel and placed it across at the bottom of RG's cover page, similar

to that of PW.

78 The similarities for the Chinese versions is even more obvious. It is pertinent that the Chinese title for RG is '**Punter's Luck**' in Mandarin, which bears a striking similarity to the Chinese title for PW which is '**Punter's Friend**' in Mandarin. This brings to mind the decision of *Associated Newspapers Ltd v. Express Newspapers* [2003] EWHC 1322, where the Court found that the titles of two newspapers, "The Mail" and "The Daily Mail", created a likelihood of confusion, given the possibility of consumer's imperfect recollection of the overall impression of the newspaper and its title:

The question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, the impressions given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources. Applying that approach here, it is clear that there is a likelihood of such confusion insofar as the defendant uses the name *The Mail* .

Given the similarities in the present case, there can be no doubt that the defendant had deliberately attempted to mislead readers and members of the public.

79 I make the above observations without regard to Coops' testimony. In any event, his evidence only served to reinforce my findings. The defendant made the argument that Coops' evidence was irrelevant because his report went beyond the pleaded case. The defendant noted that Coops' field report was conducted between 17 to 24 October 2008, while the pleaded case of passing off was for the period of 4 January 2008 to 19 September 2008.

80 The defendant's argument is illogical – the fact that the survey was conducted in October 2008 does not make it fall outside the pleaded case, so long as the survey was made in reference to publications and materials that fell within the pleaded time frame. It can be seen from Coops' report that an issue of RG dated 27 April 2008 was used in conducting the survey. This fell within the pleaded timeframe. The defendant's assertion that Coops was 'biased' borders on mischief. The defendant's counsel had the opportunity to establish in cross-examination the basis of such an assertion but failed to do so.

81 Coops had used publications of PW, RG and the Turf Guide (as a control) to conduct the market research. His research showed that 78% of readers above the age of 50 had mistaken the PW publication for that of RG (when shown a copy of PW); while 21% of readers above the age of 50 had mistaken the RG publication for PW (when shown a copy of RG). 25% of readers surveyed felt that they would definitely be, or that it was likely that they would be confused between the RG and PW publications. On the authority of *Lego System Altieselskab and Anor v Lego M. Lemelstrich Ltd* [1983] FSR 155, I accept and admit as evidence, the market research findings of Coops as being a properly conducted survey of public opinion.

Damage

82 It is a settled principle that where the parties are in direct competition with one another, the Court will readily infer the likelihood of damage to the plaintiff's goodwill, not merely through the loss of sales, but also through the loss of the exclusive use of his get-up. This principle had been accepted in the Court of Appeal decisions of *Tong Guan* at [31] and *CDL Hotels* (where the Court of Appeal endorsed at [83] the Trial Judge's reasoning). The parties in the present case are in direct competition with one another. As such, there is an inference of likelihood of damage caused to the plaintiff's goodwill. The burden is on the defendant to adduce evidence to convince the Court otherwise. Without evidence to the contrary, the inference remains unrebutted.

83 Besides the witnesses identified in [37], the plaintiff had another witness in Wang Twee Ham ("Wang") who has been a race presenter with the Singapore Turf Club since 2005. Wang was an assistant editor in the Chinese editorial team of the RG publications when he was working with Times Publishing House between 1989 and 1999. Between 2005 and December 2007, Wang worked for Racing Guide Publications Pte Ltd, the original publisher of the RG. He testified that he started seeing Levar in the office of Racing Guide Publications Pte Ltd in or about November 2006. Wang's suspicions that Levar intended to buy over the publication came true when the company made an announcement in due course that Levar had been appointed the managing-director.

84 Wang testified that after Levar came on board, the defendant made many changes (between March and December 2007) to its publication of the Race Cards which were almost identical to the features found in PW.

85 I would add that the testimony of the plaintiff's five witnesses was not challenged as to cast any doubts on their credibility.

86 As for the defendant's only witness Levar, he was combative and, notwithstanding the blatant copying by the RG of many of the features of the PW (in which he undoubtedly played a key role being an ex-employee of the plaintiff), he insisted (unreasonably I would add) that the plaintiff's claims were groundless and the defendant counterclaimed against the plaintiff on that basis. In his AEIC (at para 18) Levar had deposed as follows:

Most (if not all) customers are creatures of habit. Once they purchase a particular publication for a particular race meet, they will continue to buy the same publication for subsequent races.

87 I view Levar's above comment with considerable scepticism. The RG publications had deliberately copied over time, many of the features found in the PW publications. The motive was undoubtedly to confuse race goers especially those who were less educated or who were late and/or were in a hurry to get into the grounds of the race track. The unsuspecting punter would buy a racing guide thinking (based on his imperfect recollection of its colour and get-up) that he was getting the plaintiff's publication only to find upon a closer examination (when it was too late) that it was actually the defendant's RG publication. In this regard, it is apposite to refer to the observations made by the High Court in *Saga Foodstuffs Manufacturing (Pte) Ltd v. Best Food Pte Ltd* [1994] 3 SLR(R) 1013. The decision involved a common law action in passing off; and in determining whether the similar labels on the packaging of two products were likely to cause confusion, the Court rightly cautioned against adopting a narrow approach (at [31]):

...one must not consider the question by placing the two labels side by side. One must allow for *imperfect recollection* and for the fact that marks are remembered by their *general impression* and *not by a detailed comparison* of the differences and similarities. Although a listing of the differences and the similarities is a good starting point for purposes of discussion, in the end one has to place oneself in the position of a customer in a real marketing situation.

[emphasis added]

Indeed, consumers would not examine the get-up of PW and compare it with the overall impression created by RG in such exact detail as this Court would.

Conclusion

88 In the light of the evidence adduced, I find that the plaintiff has succeeded in its claims for

copyright infringement and passing off. Its claims for reliefs included an injunction for protection of its copyright. I am satisfied that the continued infringement of the plaintiff's copyright would cause substantial detriment to its goodwill that cannot be sufficiently remedied with an order of damages. As such, I exercise my discretion under s 119(2)(a) of the Copyright Act to grant an injunction to restrain the defendant, whether acting by itself or its servants and/or agents, from infringing the plaintiff's copyright in its publications of PW.

89 Consequently, there will be interlocutory judgment with costs to the plaintiff on its claim for infringement and passing off. Damages resulting from the defendant's passing off and/or infringement of the plaintiff's copyright or resulting in the plaintiff's loss of profits thereby will be assessed by the Registrar with the costs of such assessment reserved to the Registrar.

90 The defendant's counterclaim being completely unmeritorious is dismissed with costs which, as with the costs of the plaintiff's claim, shall be taxed on a standard basis unless otherwise agreed.