Virtual Map (Singapore) Pte Ltd v Suncool International Pte Ltd
[2005] SGHC 19

Case Number : MC Suit 40057/2003, RAS 37/2004

Decision Date : 01 February 2005

Tribunal/Court : High Court

Coram : Lai Kew Chai J

Counsel Name(s) : Low Chai Chong and Jonathan Seng (Rodyk and Davidson) for the plaintiff; Wong Siew Hong and Michelle Angelique Armand (Infinitus Law Corporation) for the defendant

Parties : Virtual Map (Singapore) Pte Ltd — Suncool International Pte Ltd

Civil Procedure – Summary judgment – Plaintiff successfully applying for summary judgment against defendant for infringement of copyright in digital map images – Defendant appealing against granting of summary judgment to plaintiff – Whether triable issues existing

Copyright – Infringement – Defendant reproducing plaintiff's digital map image without plaintiff's consent – Plaintiff alleging defendant infringing copyright in digital map images – Defendant arguing copying insubstantial part of whole – Whether copying sufficient to constitute infringement

Copyright – Ownership – Plaintiff co-owning copyright in digital map images with party supplying vector data used to create map images – Whether plaintiff entitled to apply for summary judgment against defendant for infringement of copyright in digital map images without joining co-owner – Whether plaintiff having independent copyright in digital map images – Section 124 Copyright Act (Cap 63, 1999 Rev Ed)

Copyright – Ownership – Plaintiff using cartographic raw materials to create digital map images – Copyright in cartographic raw materials owned by third party – Whether plaintiff owning independent copyright in map image

1 February 2005 *Judgment reserved.*

Lai Kew Chai J:

1 On 25 June 2004, the district judge dismissed the defendant's appeal against the decision of the deputy registrar dated 26 March 2004. The defendant appealed against the district judge's decision ([2004] SGDC 190). I heard and dismissed the appeal on 2 September 2004. On the defendant's application, I heard further arguments on 17 November 2004, after which I reserved judgment.

Basic facts

2 The facts of this appeal are not complicated. The plaintiff is in the business of, *inter alia*, creating and licensing the reproduction and/or use of digital raster street maps of Singapore. These digital raster maps are contained in the plaintiff's website at www.streetdirectory.com. The defendant is a company in the business of installing solar control films, security and fire-fighting equipment.

3 It is not denied that the defendant reproduced a map image[1] from the plaintiff's website without its consent. The map image, which discloses the location of the defendant's premises, was reproduced on the defendant's website at www.suncool.com.sg. The defendant has admitted to copying the map image.

4 Not unexpectedly, the plaintiff obtained summary judgment against the defendant. The defendant appealed.

The district judge's findings

5 I will first summarise the arguments before the learned district judge. Before her, the defendant submitted that:

(a) the plaintiff had no *locus standi* to maintain the action since it did not own the copyright in the copied map;

(b) the Singapore Land Authority ("SLA") owned the copyright;

(c) the plaintiff's maps lacked the requisite originality;

(d) the defendant was entitled to rely on the defence of fair dealing under ss 35 and 37 of the Copyright Act (Cap 63, 1999 Rev Ed) ("the Act");

(e) there was no substantial copying; and

(f) there was no knowledge of copying on the part of the defendant.

The learned district judge was indeed correct not to find any merit to these arguments raised by the defendant. I will only draw attention to the findings which are relevant to the issues raised in the defendant's latest appeal. These findings principally traverse copyright ownership and originality in the plaintiff's product.

6 The defendant failed to satisfy the learned district judge that the plaintiff was deprived of any *locus standi* to maintain the present suit in its sole name by reason of s 124(1) of the Act. Section 124(1) states:

> Where –
>
> (a) an action is brought by the owner of the copyright or by the exclusive licensee; and
>
> (b) the action, insofar as it is brought under section 119, relates in whole or in part, to an infringement in respect of which the owner and the licensee have concurrent rights of action under that section,
>
> the owner or licensee, as the case may be, shall not be entitled, except with the leave of the court, to proceed with the action, insofar as it is brought under that section and relates to that infringement, unless the other party is joined as a plaintiff in the action or added as a defendant.

7 The learned district judge held that s 124(1) only applied to proceedings in relation to a copyright in respect of which an *exclusive* licence had been granted and was in force at the time of the events to which the proceedings related. This was also clarified by s 122. The plaintiff in this action brought the suit as an independent copyright owner in its own right. On the evidence, there was no mention of the existence of any exclusive licence.

8 The learned district judge did not find any merit to the argument that the copyright in the maps resided in the SLA and that the SLA had merely granted the plaintiff a non-exclusive licence. In

my view, she correctly drew the distinction between the vector data used as a starting point for the maps, and the finished products themselves. The former, which represents the raw material in the map enhancement process, was the basis of a non-exclusive licence agreement between the SLA and the plaintiff. It is the case that, where existing subject matter is used in creating a work, copyright can vest in the creator of the work if he expended skill and labour that were sufficient to make the work original: see *MacMillan Publishers Limited v Thomas Reed Publications Limited* [1993] FSR 455 ("*MacMillan*"). The learned district judge made the following finding (at [9] of her Grounds of Decision):

> The result of the creative work process can be seen in the significant differences between the raw geographical material obtained by the plaintiffs from the SLA (an example of which is exhibited at pages 36 to 37 of Eugene Lim's affidavit of 13 February 2004) and the final product displayed on the plaintiffs' website (in this case, the Work exhibited as Schedule A to the statement of claim). According to the plaintiffs, to date some S$3 million has been invested by them in developing, creating and maintaining their online map provision services; and they also incur regular costs in upkeeping and maintaining these services.

9 Accordingly, the learned district judge agreed with the deputy registrar's view that this was a case where sufficient work and skill were expended in:

(a) the creation of a map which was visually functional and pleasing as well as being highly readable and manipulable; and

(b) the compilation of selected information such as building names and locations.

10 A significant observation made by the learned district judge was that the SLA did not, in fact, deny the plaintiff's claim to ownership of the copyright in the maps. Reference was made to an affidavit filed by the SLA in another proceeding ("the SLA affidavit"). Even if it was the case that the SLA claimed to be a co-owner of the copyright in the maps, co-owners of copyright are, at law, treated as tenants in common, and each is entitled to bring proceedings without joining the other: see *Acorn Computers v MCS Microcomputer Systems Pty Ltd* (1984) 57 ALR 389 at 395. The SLA affidavit did not mention any unauthorised use by the plaintiff of SLA's raw material (the vector data). Even if one were to assume that there was copyright infringement of the vector data, as a matter of law, any original work which is thereafter derived from the infringement may nevertheless enjoy copyright. In this respect, I found the learned district judge's reliance on Lightman J's decision in *ZYX Music GmbH v Chris King* [1995] FSR 566 at 576–577 particularly useful. Two principles may be gleaned. First, a plaintiff's work, even if it infringes the copyright in another's work, may nonetheless enjoy copyright, and the fact that the plaintiff's work does so infringe a third party's work does not constitute a defence to proceedings instituted by the plaintiff. Second, copyright is still enforced in such a situation where only an incidental (let alone an unintentional) civil wrong involving no moral obloquy by the plaintiff against a third party is involved.

Issues in this appeal

11 In the appeal before me, the following issues were raised:

(a) The plaintiff is not entitled to enjoy independent copyright in its maps.

(b) The plaintiff is not entitled to pursue this action independent of the SLA, the other joint owner.

(c) Copying is not sufficiently substantial to constitute infringement in this case.

I will deal with each issue in turn.

Does the plaintiff own the copyright in the map images?

12 The defendant resurrected its argument that the plaintiff is not entitled to own an independent copyright in its maps. The plaintiff will be entitled to copyright in its work[2] if it satisfies the court that it has expended skill, effort and labour in creating the work. I note that the input of the plaintiff resulted in a visually significant alteration of existing subject matter. Comparing the cartographic vector data and the plaintiff's work, the contrast is marked. Unlike the cartographic vector data, the plaintiff's maps are fully coloured, readable and interactive. It is apparent that much skill and labour was expended to assimilate various fragments of raw material into a usable map[3]. Additions to the cartographic raw material included a set of building names and locations, road networks, traffic directions, a scale and full colour. It is significant that this evidence was not challenged by the defendant.

13 The question of how far a work, which has been copied from an earlier work, can be regarded as original is a matter of fact and degree. What is needed is an addition of some element of material alteration or embellishment which suffices to make the totality of the work an original work: *per* Lord Oliver of Aylmerton in *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 262 *et seq*. On the evidence before me, I am satisfied that the plaintiff has expended the kind of skill, labour and judgment which is rewarded with originality in the copyright sense.

14 Once it has been established that skill and labour has been expended in the plaintiff's work, it follows that the plaintiff would be the copyright owner of the work in its own right. Such copyright is independent of any copyright which may separately exist in relation to the cartographic raw material.

15 The case of *MacMillan* ([8] *supra*) is instructive. Its facts are apposite to the present case. The plaintiff and defendant in *MacMillan* were both publishers of almanacs for the use of yachtsmen. In these almanacs were smaller charts, or chartlets, which depicted various specific areas of coastline. The chartlets comprised outlines of coasts together with geographical features, and other information. The chartlets had been created in stages. Draft drawings were first prepared from selected features from the admiralty charts; thereafter they were annotated, and then sent to the cartographers. The plaintiff successfully obtained summary judgment in respect of the defendant's copying of 22 chartlets in its almanac. It was held that the plaintiff could claim originality in the creation of the chartlets. Sufficient skill and labour had been expended. The work which was done on the admiralty charts was done with the permission of the Hydrographer of the Navy, who was the agent that managed permissions for the use of Crown copyright subsisting in the admiralty charts. On the issue of originality, Mummery J held that this was a case where sufficient work and skill had been done, both in the creation of the simplified form of artistic work, showing the outlines of the coast and geographical features, and in the compilation of selected information on depth soundings, buoys, *etc*. The point was that as a starting point, the plaintiff worked from admiralty charts, which were the subject of Crown copyright. The parity of reasoning with present facts is too obvious to ignore.

16 The defendant compared the plaintiff's work with the maps found in the *Singapore Street Directory* (SNP Publishing Ltd) and the NTUC I-Map, and argued that given the high degree of similarity between the works, and similar licence terms apropos SLA, it had clearly raised a triable issue as to the originality of the plaintiff's work. It is a false premise, because one can always expect a degree of similarity of cartographic outlines and raw data among different map publications. It is these cartographic outlines that form the basis of a non-exclusive licence between the SLA and

various map publishers. Having analysed the plaintiff's maps and affidavit evidence, I have concluded that through additional improvements and embellishments (the additions to the cartographic raw material included a set of building names and locations, road networks, traffic directions, a scale and full colour), the plaintiff has created an independent copyright work in its own right.

17 By way of further arguments, the defendant relied on the French Court of Appeal decision in *SA Editions du May v La Manufacture des Pneumatiques Michelin* [1992] ECC28, ("the *Michelin* decision") which it said discusses the self-evident proposition that a defendant who alleges that the plaintiff's work is not original bears the burden of proving that allegation. In the case of maps, the defendant contended that based on the *Michelin* decision, that burden could be met by the production of earlier, similar maps, and further, from proof that the publishers of those other maps had used the same combination of data as the plaintiff. For many years, Michelin published maps and guidebooks, including a 1:1,000,000 map of the whole of France. In 1987, Du May published a road map of France on a scale of 1:1,000,000. Michelin took the view that this map was a reproduction of its own map and subsequently commenced proceedings. The Tribunal de Commerce held, *inter alia*, that Du May's map was an imitation of Michelin's map. In dismissing the appeal, the Cour d'Appel held that a geographical map of France on the scale of 1:1,000,000 was no doubt in itself not an original work and there were necessarily data which were common to *all* maps. The court held that the Michelin map was the result of Michelin's creative endeavours, and reflected its individuality by virtue of the combination and choice of several types of information. The Michelin map could be distinguished from other 1:1,000,000 maps in the way the distances were divided up, the choice of localities, curiosities and symbols, the selection and classification of roads and the plotting of forests (at 330, [2]). The court also held that whilst Du May had the onus of showing that the Michelin map was not original, it did not produce any documents of earlier date and did not prove that other map publishers reproduced the *same* combination of data. On the evidence, Michelin was able to prove that it was possible to make different selections from the road network and to make a choice of localities (at 330–331, [3]).

18 The defendant tried to develop its argument that the plaintiff's map was clearly not original because of the substantial similarity it bore to the maps found in various editions of the *Singapore Street Directory*, maps published by SingTel Yellow Pages Pte Ltd, and the NTUC Income I-Map. It claimed that the points of similarity arose out of the individual elements of the map, including the placement and font used in the road names, building numbers, building names, resulting in a similarity of identity in the overall look and feel.

19 The *Michelin* decision is of no assistance to the defendant in this appeal. It is misguided to compare the plaintiff's maps to other sources as the defendant has done. The comparison should be made with the basic material which has been licensed from SLA. In the *Michelin* decision, Michelin only made comparisons with other publishers' maps to prove that it was possible to make different selections from, *inter alia*, the road network. The court held that "the Du May map uses the same data as Michelin for the choice and classification of roads by colour, the way in which road distances are divided up, the different scale used to show Corsica, the plotting of forests, selection of localities and curiosities, and even the selection of airports shown" (at 331, [5]). What was also apparent was that mistakes and imperfections in the Michelin map appeared in the Du May map. In the present case, the plaintiff has demonstrated in evidence that other online maps adopt a different colour scheme, building outlines, building and road names and level of detail.[4] As stated earlier, the plaintiff has demonstrated sufficient skill and labour in the embellishment of the vector data, as well as in making choices as to the selection of different information, to lead me to conclude that it is deserving of protection. In the same way, the Michelin map was held to be a result of the respondent's "creative endeavours" and "reflects its individuality by virtue of the combination and choice of several types of information" (at 330, [2]). I hesitate to adopt similar language, as it is apparent that the

threshold of originality in French copyright law may be considerably higher than that in Singapore copyright law.

20 For the reasons stated above, I agree with the learned district judge that the plaintiff has demonstrated sufficient skill and labour to merit copyright protection, in respect of its "virtual" maps.

Is the plaintiff entitled to commence proceedings in its own right?

21 Once the court is satisfied that the plaintiff has established independent copyright credentials in its work, then it must follow that it can commence proceedings without joining any other party. I agree with the learned district judge that this is not a case where s 124 of the Act applies. It is not a triable defence. Even if the court were to take the defendant's case at its highest, that both the SLA and the plaintiff co-owned the copyright, the plaintiff would be entitled to proceed as it has done, without joining the SLA as co-plaintiff: see *Copinger & Skone James on Copyright* (Sweet & Maxwell, 14th Ed, 1999) at para 5-165; *Lauri v Renad* [1892] 3 Ch 402.

Is the copying in this case substantial or de minimis?

22 The defendant tried to argue that its copying, though admitted, was not a substantial taking, when compared with the total land area of Singapore. The copied portion covered less than one grid out of six grids on any given page of the printed *Singapore Street Directory*. According to the defendant, its copying totalled less than 0.15%, which is *de minimis*.

23 This argument is without merit. The work that was copied by the defendant is a discrete map that was created in the form that it was copied. It joins with other maps to form what is the entire map of Singapore. From the affidavits filed, it is also apparent that much skill, effort and labour have been expended in creating each map, and thereafter further skill and labour have been expended to crop and arrange individual maps so as to form a seamless collection. It is an established principle that where the work is a collection of separate works, each work must be considered individually, and the measurement of substantiality cannot be made against the entire collection. It is furthermore a trite principle that the determination of the substantiality of the taking is as much a qualitative as a quantitative exercise. Even if the entire collection of maps can be regarded as one collective work, which I consider a dubious proposition on the present facts, the work that has been taken by the defendant, whilst small in percentage terms, is nevertheless a substantial taking, given its importance to anyone who wishes to locate a particular address in the area covered by the copied map. In *Macmillan*, I also note that a comparison was made between respective individual chartlets, from which it was determined that the plaintiff's chartlets and the defendant's chartlets were substantially the same.

24 In the course of argument I was referred to the unreported decision of *Hyperion Records Ltd v Warner Music (UK) Ltd* (17 May 1991, High Court (Chancery Division), England) ("*Hyperion*"). The defendant relied on this case to support its proposition that the admitted copying of the plaintiff's maps should be measured against the entire printed *Singapore Street Directory*. In *Hyperion*, the defendant had reproduced approximately eight notes of a sound recording. The same eight notes were reproduced repeatedly throughout the infringing track. At issue was whether copyright should be taken as existing in the whole sound recording, or in the eight notes that were copied. If it was the latter, then the defendant could be said to have copied the work in its entirety. No issue of substantiality would arise. Mr Hugh Laddie QC (as he then was), sitting as deputy judge of the High Court, took the view that there was a triable defence as to whether these eight notes formed a substantial part of the recording, opining that if the copyright owner was allowed to "redefine his copyright work so as to match the size of the alleged infringement, there will never be a requirement

for substantiality". The learned deputy judge also said this did not mean that "a recording of eight notes could not be a copyright sound recording: it is possible that it could". He did not accept that it was legitimate to arbitrarily cut out of a large work that portion which had been allegedly copied and then to call that the copyright work. He was inclined to grant leave to defend on the basis that a judge might well be assisted by evidence as to relative importance or otherwise of the four seconds to the whole of the plaintiff's recording.

25 In copyright terms, a map is in a different categorisation of work altogether. The difficulties faced by the deputy judge in *Hyperion* is best expressed by what his Honour said about it:

> A piece of a sound recording may be taken by a defendant and used in a number of ways. It may be repeated once softly, as a barely audible part of the background to a long and very different sound recording; or it may be given great prominence in the defendant's sound recording and repeated many times, as, in my judgment, is the case here. But the importance of the copied part to the defendants' recording is a poor guide to whether or not it is a substantial part of the work from which it was taken, particularly where, as here, the plaintiffs' and the defendants' recordings are so utterly different in style and content.

26 I am unable to accept that where the work in question is a discrete and distinct map, as is the case here, a similar parallel can be drawn with the eight notes in *Hyperion*. As pleaded, it is quite capable of acquiring its own copyright. It is apparent that the difficulties of evaluating the substantiality of taking would accordingly vary with different kinds of copyright work. In *Hyperion*, the court did recognise that in the case of a film that was shot over many days, copyright resided in each day's footage as a discrete work and in the film as a whole. The deputy judge's words of caution, with reference to Fox LJ's remarks in *Leco Instruments (UK) Ltd v Land Pyrometers Ltd* [1982] RPC 133 at 143, should also be alluded to for present purposes:

> In my judgment, the Court of Appeal did not mean to say in the passage that I have just quoted that all a defendant has to do in order to avoid an O 14 judgment is to say that he disputes substantiality and wishes to call evidence. That would be to frustrate the effect of O 14 in relation to copyright cases, and *it is just as important that O 14 should be available to nip in the bud unmeritorious defences in copyright actions, as in any other type of action. The decision on substantiality is a jury question for the judge and in very many cases the judge will be able to make up his mind without the aid of any evidence*. Nevertheless, in some cases – ... particularly borderline cases – expert evidence may assist the court, and in such cases O 14 procedure would be inappropriate. [emphasis added]

27 I would not consider the distinctive and individual character of the plaintiff's maps, nor the admitted reproduction of the plaintiff's work to be constituted a "borderline" case in the present proceedings.

28 In [17] of her Judgment, the learned district judge was quite right in saying that the defendant's argument could not be correct because that would mean that by the plaintiff expending extra skill, effort and labour in joining the individual maps to form a seamless collection of maps, it would actually have destroyed the copyright that attaches to each individual map. I am in complete agreement with her.

No other triable issues

29 In the course of further arguments, the defendant tried to make the submission that the mere change of medium, from a street directory in the form of a book to an online street directory,

should not result in the change of copyright ownership. As I understand it, the plaintiff has never proceeded on obtaining copyright on the basis of rendering an online version of its maps. A considerable amount of unreadable data had to be converted, accompanied by selection and assimilation.

30 The defendant referred me to the decision of the Federal Court of Australia in *Universal Press Pty Ltd v Provest Ltd* (1989) 87 ALR 497. The applicant was a publisher of three Sydney street directories. It claimed that the respondent had infringed its copyright in: (a) each edition; (b) each individual map; and (c) each base map of the street directories. The respondent brought a motion to strike out claims (a) and (b) from the Statement of Claim. The application was not granted. The court was of the view that the question should first be settled between the parties as to the identification of the original literary or artistic work in which the copyright infringed was said to subsist. The court did remark (at 500) that:

> It is beyond dispute that as each initial base map was prepared, copyright existed in that base map as an original artistic and perhaps literary work. Where an original map is subsequently altered there will be a question of fact involved in determining whether the map as altered has become a new original work or whether it remained the old work.

31 Applying this principle, for the reasons stated above, it is obvious that a new original work had been created based on SLA's base material.

32 The defendant argued that each of the layers of information (which was provided by the SLA) was in fact a "map", and through a process of superimposition (layering), the final image was created. This was another futile attempt to challenge the originality of the plaintiff's work. The argument runs against the evidence contained in the first Affidavit filed on behalf of the plaintiff[5] (which went unchallenged by the defendant). None of the data sets can be properly described as a "map".

33 The defendant further argued that because the notation "© 2003 SLA" was inserted by the plaintiff into its maps, the copyright in the maps should belong to SLA. The affixing of the copyright notation is not required under the Act, and the court is certainly not precluded from making any findings on ownership and subsistence of copyright, nor clarifying the terms of a licence between parties, notwithstanding the existence of any copyright notation to the contrary.

34 Two other defences were pleaded, which in my view carry no merit whatsoever. The first is the defence that the admitted copying was carried out by a website designer, and the defendant was unaware that the plaintiff's map image had been copied. There is no evidence to support this, and the defendant has, by its own admission, copied the plaintiff's work. Secondly, the defendant also pleaded fair dealing under ss 35 and 37 of the Act. These were non-starters, and were not seriously pursued in the appeal.

35 For the decision of the lower court to stand the court must be satisfied that the defendant has not, in the course of argument, raised triable issues in response to the plaintiff's application for summary judgment. In my view, against the backdrop of admitted copying by the defendant, it has not crossed the threshold. For these reasons, I dismiss the defendant's appeal with costs.

Defendant's appeal dismissed.

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[1]Schedule A to the Statement of Claim

[2]As pleaded in Schedule A of the Statement of Claim

[3]Paras 16–29 Eugene Lim's first Affidavit, paras 22–23 Eugene Lim's second Affidavit

[4]p 53, Eugene Lim's second Affidavit

[5]Eugene Lim's first affidavit

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