

7 Jan 10

DREW & NAPIER LLC

LEGAL UPDATE

A DREW & NAPIER PUBLICATION

CASE UPDATE

WEBSITE OFFERING ONLINE RECORDING SERVICES FOUND LIABLE FOR COPYRIGHT INFRINGEMENT

RecordTV Pte Ltd v Mediacorp TV Singapore Pte Ltd and Others [2009]
SGHC 287

Executive summary

RecordTV Pte Ltd, an internet company which owns, operates and designs www.recordtv.com, a website which allows end-users to watch certain Mediacorp broadcasts and films online, has been found liable for copyright infringement by authorising the copying of and communicating Mediacorp's broadcasts and films to the public through its website.

Davinder Singh, SC, Dedar Singh Gill and **Paul Teo** of Drew & Napier LLC acted for Mediacorp.

Background

The Plaintiff is the owner, operator and designer of an internet-based service at <http://www.recordtv.com> (the "**Website**"). The Defendants are the copyright owners of various broadcasts and films (collectively, the "**Mediacorp Broadcasts and Films**").

The RecordTV system

The Website provided members of the public with the equivalent functionality of a brick- and-mortar digital video recorder. Any member of the Singapore public with access to a computer (the "**end-user**") could use the Plaintiff's services by signing up at the Website.

The Plaintiff obtained television scheduling information from the public websites of Mediacorp. This information was then processed with the Plaintiff's proprietary programme and stored in its internal database to show end-users which programmes were available. The end-user may then request, via the Website, that a programme be recorded for viewing at a later date.

Once the end-user's request was put through via the Website, the Plaintiff's proprietary programme would instruct the system to record the programme. After a recording was made, the recording would be made available by the Plaintiff, for viewing to the end-user for a period of 15 days.

MAIN OFFICE

20 Raffles Place
#17-00 Ocean Towers
Singapore 048620

t +65 6535 0733

f +65 6535 4906

mail@drewnapier.com
www.drewnapier.com

Co. Reg. No. 200102509E

The Plaintiff's action and the Defendants' counterclaim

In 2007, the Defendants issued cease and desist letters to the Plaintiff for copyright infringement. In response, the Plaintiff commenced an action for groundless threats of copyright infringement and conspiracy against the Defendants. In their Defence and Counterclaim, the Defendants alleged that there had indeed been copyright infringement with respect to the Mediacorp Broadcasts and Films.

The High Court's decision

The court dismissed the Plaintiff's claims. It held that, while the Plaintiff was not primarily liable for infringement of the Defendants' copyright by making copies of the Mediacorp Broadcasts and Films, it was liable for *authorising* the making of copies of the same by the end-users. The Plaintiff was also liable for *communicating* the Mediacorp Broadcasts and Films to the public.

Authorising copyright infringement

In finding that the Plaintiff had authorised the infringement of the Defendants' copyrights in the Mediacorp Broadcasts and Films, the court placed emphasis on the fact that the Plaintiff had represented, in the "Frequently Asked Questions" section of the Website, that it had the *actual* authority to provide its service to the end-users. By doing so, it had purported to authorise the copies of the Mediacorp Broadcasts and Films which were subsequently made at the request of the end-users.

The court also took into account the following factors in finding that the Plaintiff had authorised infringement:

- (i) that there was an ongoing relationship between the Website and the end-users; and
- (ii) that the Plaintiff selected the material for recording which consisted *solely* of the Defendants' copyrighted broadcasts and films.

Communication of the Mediacorp Broadcasts and Films

To determine whether there had been copyright infringement by communicating the Mediacorp Broadcasts and Films under the Copyright Act (the "**Act**"), the court had to ascertain whether:

- (i) the Plaintiff's acts amounted to "communication";
- (ii) such communication was made "to the public"; and
- (iii) the Plaintiff, and not the end-user, was responsible for the communication.

Whether the Plaintiff's acts amounted to "communication"

It was not seriously disputed that the Plaintiff's RecordTV system transmitted, by electronic means, the relevant television programme to the end-user who asked to view it. This amounted to a "communication" of the Mediacorp Broadcasts and Films.

Whether the "communication" was made "to the public"

In the court's view, it did not matter that the Plaintiff's service was available only to registered end-users when any member of the public with an internet connection could register for free on the Website. Where a copyrighted work was made available to the end-users via the Website, the end-users would qualify as "the public".

Whether the plaintiff was responsible for the "communication"

For the purposes of the Act, a communication other than a broadcast is taken to have been made by the person responsible for determining the content of the communication at the time the communication is made.

While the court accepted that the end-user was the one who had control over what programmes he chose to record, the subsequent transmission of that content was effected by a process governed entirely by the Plaintiff. In this case, the end-user had communicated its preference to the Plaintiff before the recording or transmission. The Plaintiff then became responsible for determining the content of the communication upon playback. The Plaintiff was therefore the person responsible for infringing the Defendants' copyright in communicating the Mediacorp Broadcasts and Films to the public.

No valid defences available to Plaintiff

The Plaintiff argued that it was entitled to rely on two main defences to escape liability – first, that it was a network service provider within the definition of section 193A of the Act and secondly, that it fell within the ambit of the fair dealing defence under section 109 of the Act. The court dismissed both arguments.

"Network service provider" defence

The Plaintiff argued that it fell under the definition of "network service provider" in section 193A of the Act, which entitled it to rely on any or all the defences available under Part IXA of the Act.

The court held that the term "network service provider" in the Act was intended only to cover network service providers which provide the *service* of enabling a person to connect to a *network*, and not the Plaintiff (which provided a website which made copies of copyrighted material).

The Plaintiff also claimed that it was entitled to rely on section 193B of the Act which, *inter alia*, offers network service providers protection if the transmission of copyrighted material is carried out through an “automatic technical process”. In the court’s view, the operation of the Website could hardly be said to be an “automatic technical process” without any selection of the electronic copy of the material by the Plaintiff. On the contrary, “a great amount of volition must have gone into the very human choices of what and which programmes to record”.

“Fair dealing” defence

The “fair dealing” defence is encapsulated in section 109 of the Act. After considering all the factors in section 109(3) of the Act, the court found that the Plaintiff failed to qualify for the “fair dealing” defence. In the court’s view, the Website was set up primarily for “*private profiteering*”. Any social benefit wrought by the Website had, in the court’s opinion, largely already been provided by technology such as video recorders, which would enable end-users to view recorded programmes at a later time.

If you would like more information about this case or wish to discuss how it may potentially affect you or your business, please feel free to contact the intellectual property lawyers in Drew & Napier LLC (please refer to the Directors’ profiles on our [website](#)), or:

Davinder Singh, SC

Director (Litigation & Dispute Resolution)

T: +65 6531 2403

E: davinder.singh@drewnapier.com

Dedar Singh Gill

Director (Intellectual Property)

T: +65 6531 2506

E: dedar.singh@drewnapier.com

Paul Teo

Director (Intellectual Property)

T: +65 6531 4158

E: paul.teo@drewnapier.com

The contents of this update are only intended to provide general information on the subject covered. Nothing in this publication should be treated as specific professional legal advice concerning any particular business, operational or other situations with which you might be faced. Drew & Napier LLC accepts no liability for, and does not guarantee the accuracy of, the information contained in this publication, and does not accept any liability for any loss or damage arising from any reliance thereon.

OUR BUSINESS GROUPS AND PRACTICE AREAS

BANKING/GENERAL FINANCE

David Ang
T +65 6531 2236
F +65 6535 4864
E david.ang@drewnapier.com

Valerie Kwok
T +65 6531 2222
F +65 6535 4864
E valerie.kwok@drewnapier.com

Sandy Foo
T +65 6531 4118
F +65 6535 4864
E sandy.foo@drewnapier.com

BIOMEDICAL SCIENCES

Tony Yeo
T +65 6531 2512
F +65 6220 0324
E tony.yeo@drewnapier.com

BUILDING & CONSTRUCTION

Tan Liam Beng
T +65 6531 4139
F +65 6533 3591
E liambeng.tan@drewnapier.com

CAPITAL MARKETS

Sin Boon Ann
T +65 6531 2206
F +65 6535 4906
E boonann.sin@drewnapier.com

Petrus Huang
T +65 6531 2208
F +65 6535 4906
E petrus.huang@drewnapier.com

CHINA BUSINESS GROUP

David Chin
T +65 6531 2304
F +65 6535 1952
E david.chin@drewnapier.com

COMPETITION LAW

Cavinder Bull, SC (contentious)
T +65 6531 2416
F +65 6533 3591
E cavinder.bull@drewnapier.com

Lim Chong Kin (non-contentious)

T +65 6531 4110
F +65 6535 4864
E chongkin.lim@drewnapier.com

CORPORATE

David Ang
T +65 6531 2236
F +65 6535 4864
E david.ang@drewnapier.com

Gary Pryke
T +65 6531 4104
F +65 6535 4864
E gary.pryke@drewnapier.com

OTHER OFFICES

Drewmarks Patents & Designs (Malaysia) Sdn Bhd
9th floor
Bangunan Getah Asli (Menara)
148 Jalan Ampang
50450 Kuala Lumpur, Malaysia
T +603 2162 2522/2162 2529
F +603 2162 2804
E drewmark@tm.net.my

CORPORATE (cont'd)
Sin Boon Ann
T +65 6531 2206
F +65 6535 4906
E boonann.sin@drewnapier.com

Yeo Wee Kiong
T +65 6531 2500
F +65 6535 4864
E weekiong.yeo@drewnapier.com

CORPORATE INSOLVENCY & RESTRUCTURING

Sushil Nair
T +65 6531 2410
F +65 6533 9029
E sushil.nair@drewnapier.com

Manoj Sandrasegara
T +65 6531 4156
F +65 6533 9029
E manoj.sandra@drewnapier.com

EMPLOYMENT & IMMIGRATION

Indranee Rajah, SC
T +65 6531 4100
F +65 6532 7149
E indranee.rajah@drewnapier.com

FAMILY & MATRIMONIAL

Randolph Khoo
T +65 6531 2418
F +65 6532 7149
E randolph.khoo@drewnapier.com

FUND MANAGEMENT, REIT & PRIVATE EQUITY

Petrus Huang
T +65 6531 2208
F +65 6535 4906
E petrus.huang@drewnapier.com

INSURANCE & REINSURANCE

Gary Pryke
T +65 6531 4104
F +65 6535 4864
E gary.pryke@drewnapier.com

INTELLECTUAL PROPERTY

Dedar Singh Gill (Trade Marks)
T +65 6531 2507
F +65 6533 0694
E dedar.singh@drewnapier.com

Morris John (Patents)

T +65 6531 2503
F +65 6533 0694
E mj@drewnapier.com

INTERNATIONAL ARBITRATION

Davinder Singh, SC
T +65 6531 2403
F +65 6532 7149
E davinder.singh@drewnapier.com

Jimmy Yim, SC
T +65 6531 2504/2505
F +65 6533 9029
E jimmy.yim@drewnapier.com

LITIGATION
Davinder Singh, SC
T +65 6531 2403
F +65 6532 7149
E davinder.singh@drewnapier.com

Jimmy Yim, SC
T +65 6531 2504/2505
F +65 6533 9029
E jimmy.yim@drewnapier.com

Indranee Rajah, SC
T +65 6531 4100
F +65 6532 7149
E indranee.rajah@drewnapier.com

PROJECT FINANCE
Gary Pryke
T +65 6531 4104
F +65 6535 4864
E gary.pryke@drewnapier.com

Valerie Kwok
T +65 6531 2222
F +65 6535 4864
E valerie.kwok@drewnapier.com

Sandy Foo
T +65 6531 4118
F +65 6535 4864
E sandy.foo@drewnapier.com

PROPERTY
Zennifa Rahim
T +65 6531 2392
F +65 6535 1952
E zennifa.rahim@drewnapier.com

SHIPPING & INT'L TRADE
Ian Koh
T +65 6531 2436
F +65 6533 3591
E ian.koh@drewnapier.com

TAX & PRIVATE CLIENT SERVICES
Ong Sim Ho
T +65 6531 2250
F +65 6535 4864
E simho.ong@drewnapier.com

TMT
Lim Chong Kin
T +65 6531 4110
F +65 6535 4864
E chongkin.lim@drewnapier.com

TRANSNATIONAL & CROSS-BORDER WORK
Julian Kwek
T +65 6531 2485
F +65 6533 9029
E julian.kwek@drewnapier.com

PT Drewmarks Konsultama
Correspondence address:
20 Raffles Place
#17-00 Ocean Towers
Singapore 048620
T +65 6531 2503/6531 2504
F +65 6533 0694
E ip@drewnapier.com

DrewCorp Services Pte Ltd
20 Raffles Place
#09-01 Ocean Towers
Singapore 048620
ROC No. 200102492H
T +65 6531 2266
F +65 6533 1542 / 6533 7649
E services@drewcorpservices.com