

LEGALUPDATE

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CASE UPDATE**HIGH COURT GIVES REASONS FOR ORDERING DISCLOSURE OF IDENTITIES OF ANIME DOWNLOADERS*****Odex Pte Ltd v Pacific Internet Ltd* [2008] SGHC 35****Executive summary**

An agent of a copyright owner does not have the right to apply for pre-action discovery of the identity of copyright infringers or to commence an action for substantive relief on behalf of its principal. The victim of the wrongdoing, ie. the copyright owner or an exclusive licensee, should lend its name to the proceedings.

Background

Odex Pte Ltd (“**Odex**”) is a company in the business of providing various *anime* video titles to local television stations for broadcasting, as well as distributing authorised copies of these programmes to retailers for public sale. It alleged that its sales of *anime* video titles had begun to drop by more than 80% due to illegal internet downloads of these titles by individuals.

In a bid to address this problem, Odex applied to the courts for pre-action discovery of documents from, among others, a major internet service provider (the “**ISP**”), in order to identify the downloaders.

The court at first instance (the District Court) dismissed Odex’s application. Odex appealed to the High Court.

Pending the hearing of the appeal by the High Court, some of the *anime* copyright owners were added as plaintiffs to the pre-action discovery application.

Decision of the High Court

The High Court allowed the appeal. It noted that there was evidence of wrongful downloading of the applicants’ *anime* video titles and, hence, a *prima facie* case of copyright infringement.

The court also made certain observations on the right of an agent of copyright owners to apply for pre-action discovery to identify copyright infringers, and the standard of proof required to succeed in such an application.

Right of agent of copyright owner to apply for pre-action discovery

Before the High Court, Odex argued that it was entitled, as an authorised agent of the *anime* copyright owners, to bring an application in its own name for pre-action discovery of identity.

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The High Court rejected this argument. As an authorised agent, Odex did not have the *locus standi* to apply in its own name for pre-action discovery to identify the copyright infringers. The Singapore Copyright Act and its regulations currently do not give agents like Odex such rights. While a copyright owner may use the services of an agent to track down infringers, “[t]he point is that when it comes to civil court proceedings, [the principals] have to use their own names, as the law currently stands, for pre-action discovery and for formal action for substantive relief”. This is because the copyright owners are the victims of the wrongdoing, and not the agent.

On the present facts, however, because a number of *anime* copyright owners had been added as additional plaintiffs, the High Court eventually allowed discovery of documents which identified the persons who had downloaded the applicants’ *anime* video titles.

The standard of proof

The judge at first instance had taken the view that the applicant had to show an “*extremely strong prima facie case of wrongdoing*” in order to succeed in its pre-action discovery application. This is largely due to the fact that the ISP owed a contractual as well as a regulatory duty (*via* the Code of Practice for Competition in the Provision of Telecommunication Services 2005 under the Telecommunications Act) to keep the identities of its subscribers confidential.

The High Court disagreed with this reasoning. Any duty of confidentiality which the ISP may owe to other persons is but one factor to be considered by the court and should not, in and of itself, give rise to a higher standard of proof. In any event, an internet service provider’s duty of confidentiality to its customers is subject to any order which a court might make. The High Court judge noted that it “*could not seriously be suggested that [the ISP] would be in breach of either duty if it made disclosure pursuant to a court order*”.

The ultimate guide as to the applicable standard of proof should still be “*the interest of justice*”.

Comment

Pre-action discovery is often employed by intellectual property owners to find out the identities of infringers. With this decision, foreign intellectual property owners must now be prepared to be named as a party to any such Singapore proceedings. A Singapore representative company, or an authorised agent of the intellectual property owner, cannot be appointed to commence such proceedings.

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 or dispute resolution lawyers in Drew & Napier LLC (please refer to the Directors’ Profiles on our [website](#)), or either of the following lawyers:

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The content of this article does not constitute legal advice and should not be relied on as such. Specific advice should be sought about your specific circumstances.

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