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**PRE-COMMENCEMENT DISCOVERY AND THE ODEX
LITIGATION: COPYRIGHT VERSUS CONFIDENTIALITY
OR IS IT PRIVACY?**

This article examines whether internet service providers are under any duty to disclose the names of subscribers whose accounts can be shown to be associated with infringing activity. This question involves tension between the economic interests of copyright owners/licensees, the privacy interests of internet users and the economic interests of the internet service provider. This tension in turn raises age-old problems of balance and proportionality between privacy, confidentiality and other competing rights and freedoms as well as the interests of society at large. The article concludes by briefly touching on privacy areas from outside of copyright and the Internet: including the increasingly important area of biomedical privacy.

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I. Introduction

1 The opening decade of the new millennium has witnessed new life in a very old and venerable social concept: individualism and rights of privacy. For some, privacy may be rather formless or amoebic in appearance. Indeed, amoebas are shapeless, simple and ubiquitous: but, perhaps from an evolutionary point of view, this is also their strength. Amoebas probably evolved fairly early in the development of the evolutionary tree of life: they were likely around during the age of dinosaurs and unless mankind destroys all life on earth will still be around at the end of time when our planet is consumed by the sun or some such similar cosmic disaster. Similarly, however hard it may be to pin privacy down, few will doubt that the basic premise of a right to be let alone has been around since the dawn of modern civilization.

2 Individualism, privacy, freedoms, rights, obligations, responsibility and society: this is the perennial melting pot of ideas, values and principles in which privacy has been bubbling these many years. In recent years, hardly a day goes by without some reference in news media to privacy driven issues: up skirt photographs of

unsuspecting members of the public, bedroom scenes exposed on the Internet, personal contact data and mass marketing, digital shadows, spam, data banks, CCTV cameras, DNA profiling, industrial espionage, computer hacking, cookies and other types of internet usage profiling, medical databases and so forth.¹

3 Individuals complaining have ranged from those who are famous by choice (actors, fashion models) to those who have had fame thrust on them (princes and princesses) all the way through to those who choose to live in blissful anonymity. All are individuals or those who claim to represent interests of individuals.

4 That famous unemotional Human/Vulcan, Commander Spock of the starship Enterprise, who had been asked by his very human and emotional friend/philosopher, Captain James T Kirk why he was sacrificing his life to save the Enterprise, replied to the effect: “because the needs of the many outweigh the needs of the few or the one.” Yet later, when Kirk and his brave crew had made enormous sacrifices including the destruction of the Enterprise to restore Spock’s “spirit” to his reborn body and Kirk was asked by Spock why he did this, Kirk was able to get in the proverbial and very human last word: “because sometimes the needs of the one, outweighs the needs of the many!”²

5 Much has been written on the relative importance of privacy and other rights, freedoms and the interests and needs of society as a whole. Society of course depends on social interaction and social intercourse. It requires the building of a community and collective responses and responsibilities and sacrifices for the good of the whole. No man is an island entire of itself.³ We are all connected to and part of the greater whole. And yet, perhaps the most powerful argument in favour of privacy and individual self-autonomy, including informational self-autonomy, is that it creates the conditions necessary for social intercourse, social interaction and the development of individual potential leading towards the advancement of society and civilization. Great leaders in politics, government, business, science, industry and society at large tend to be unique special individuals: persons who were

1 See, for example, Tan Weizhen, “Your Digital Shadow lets Others Pick up Data about You” *The Straits Times* (18 April 2008) at p H3.

2 See *Star Trek II: The Wrath of Khan* and *Star Trek III: The Search for Spock*.

3 John Donne, *Meditation XVII* and quoted by Warren Chik, “The Lion, The Dragon and the Wardrobe Guarding the Doorway to Information and Communications Privacy on the Internet: A Comparative Case Study of Hong Kong and Singapore – Two Differing Asian Approaches” (2006) 14 *Int’l J.L. & InfoTech* at 47. Chik explains that the statement “encapsulates the human need for contact and social interaction. The eternal tension between co-habitation and the desire for personal space between humans has led to compromises in what is known as the social contract ...”.

there at the right time with the right personal history, character, abilities and idiosyncrasies.

6 This is not the time and place to rehearse all the arguments as to why privacy is important. It is perhaps enough to recall that privacy, together with all the other rights and freedoms that we have come to expect as an individual in society, come with responsibilities and duties to our fellow human beings and indeed society as a whole. No right or freedom is absolute or free from corresponding duties and responsibilities. Privacy is not the enemy of freedom of expression or freedom of information. Privacy, in some senses, is an individual's ultimate freedom of expression. Social relationships do not develop on the basis of the principle: all human relationships are equal in terms of their intimacy and degrees of trust. Some social relationships, by individual choice are more equal than other social relationships. In other cases, duties and responsibilities to society as a whole may require greater informational transparency in the name of the needs of the many.

7 With perhaps one exception, nowhere is the debate over privacy and social responsibility greater than in connection with that mighty engine of the modern information technology age, the Internet and the World Wide Web! The exception comprises that other great science driven "ology" of the 20th century: biotechnology, life sciences and personally identifiable genetic information. Marry these together and the need for balanced and proportionate responses in the 21st century becomes deeply underscored.

8 What the *Odex* litigation⁴ in Singapore amply demonstrates is that the absence of a stand alone recognised right of privacy does not mean that privacy does not play an important (possibly increasing) role in shaping and encouraging the evolution of legal principles or by being taken account of simply as an important factor in exercising and guiding judicial discretion.

9 This article discusses privacy and confidentiality in the context of applications by aggrieved persons to discover the identity of intellectual property ("IP") infringers. The cloak of anonymity afforded by the Internet has made the task of enforcing intellectual property (and other rights such as those protecting reputational interests) increasingly problematic. The intellectual property right ("IPR") owners and those whose business depends on commercial exploitation of IP assets demand access to information as to the identity of infringers. Efficient and effective procedures are needed. Home subscribers to the Internet and internet access service providers may beg to differ: citing privacy,

4 *Odex Pte Ltd v Pacific Internet Ltd* [2007] SGDC 248; [2008] 3 SLR 18 ("*Odex*").

confidentiality, business inconvenience and in some cases a philosophical or jurisprudential disagreement with the notion of strong copyright and the information society. Given judicial recognition of the importance of privacy as a public policy or public interest factor in the resolution of the conflict between these competing interests, this article concludes by identifying some other areas (including some from within biomedical research) where privacy is becoming a hotly debated issue.⁵

II. What was the *Odex* litigation about?

10 *Odex* concerns copyright, confidentiality, privacy and the Internet. *Odex* is about the Internet as a tool for disseminating information, as a vehicle for commerce and as a community of users. The internet community is huge: at once both national and international and made up of the same range of disparate but connected and overlapping interests that make up the international real world community of individuals, businesses and societies.

11 There are creators, authors, publishers, traders and businesses that see the Internet as a tool to reach a worldwide audience. There are educators who see the Internet as a valuable educational tool capable of providing a more level playing field in this information rich world. There are students and individuals who see the Internet as a means of self-expression as well as a means of providing or accessing entertainment and fun orientated products/services. There are, indeed, many more groups of users within the community of the Internet with different needs, interests and wants.

12 Shorn of the technicalities, *Odex* is ultimately about rights and responsibilities: about freedom and obligations. It is about the need for proportionality and balance: respect for all the different needs, interests and wants of different groups within society.

A. *Odex, the users and Pacific Internet: The copyright setting*

13 *Odex* is a Singapore company claiming to have acquired the rights to distribute “*anime* titles” in the Singapore (and regional) market. These *anime* titles were assumed to enjoy copyright in Singapore as species of cinematograph films (videos). The copyright in Singapore belonged to Japanese owners and much time was spent determining the precise legal relationship between *Odex* and the

5 This article arises from a presentation on *Norwich Pharmacal: Intellectual Property Rights and Privacy* made at Singapore Academy of Law Expert Series Seminar/Conference (with the Singapore Bioethics Advisory Committee) on 15 May 2008 dealing with Biomedical Research and Privacy.

Japanese copyright owners.⁶ Various permutations were possible: that *Odex* was an exclusive licensee for the Singapore market; that *Odex* was a non-exclusive licensee; that *Odex* was a sub-licensee of the main licensee for Singapore; that *Odex* was generally empowered to act as agent to protect the interests of the Japanese copyright owners.

14 The relationship issue in the *Odex* case was important as it dealt with the question as to whether *Odex* enjoyed the legal standing (*locus standi*) to sue for copyright infringement in its own name and to apply to the court for discovery orders. Whilst the matter of *locus standi* is largely a question of “internal” copyright law, it will be touched on briefly below as it does impact on the need to ensure a proper balancing of the rights and interests of copyright owners, copyright business interests and the interests of users and the public in general.

15 What then were the alleged wrongdoings? The complaint essentially was that individual home users/subscribers of the Internet had infringed the copyright in the video titles: essentially by making/uploading unauthorised copies in individual computers linked to the Internet, resulting in further copies being downloaded and copied by other users of the Internet. *Odex* concerned “file swapping” similar to the copying which has given rise to litigation in other countries in connection with the use of P2P software. On the information available (bearing in mind that no final determination was made), it is reasonably clear that some of the individual users/subscribers uploading/downloading the *anime* copies were likely to have committed copyright infringement and that (at least on first sight) there was probably no applicable defence. Some of these users/subscribers might have also committed a criminal offence under the Copyright Act (whether in respect of uploading and/or downloading of copies).⁷

6 In some cases, it may be that the licensee has created some derivative material associated with the licensed use: such as translations or subtitles. Query whether in some of these cases, the licensee can assert an independent copyright in the translation/subtitles as literary works and/or compilations?

7 Copyright Act (Cap 63, 2006 Rev Ed). Note AP Burton Ong has said that questions may arise over the fair dealing defence if it can be shown that the downloads do not undermine the commercial viability of the *anime* industry (taking account of all other relevant considerations). Doubtless this will be contested by the copyright owners and will need very careful consideration. See the entry in Wikipedia (accessed April 2008), *Odex's actions against file-sharing* at http://en.wikipedia.org/wiki/Odex's_actions_against_file-sharing. Nevertheless, Professor Ong is quite right to raise the fair dealing issue. As for possible criminal responsibility under s 136(3A) of the Copyright Act (based on wilful and significant infringement), this is a complex provision whose interpretation is not entirely free of doubt. In particular, there must be some ambiguity as to when infringement is “significant” for the purposes of the criminal provisions. Note also that, in some cases, the user who uploads the copy for other users (including those in Singapore) to download using P2P software may well be located overseas. For articles on s 136(3A), see Saw Cheng Lim & Susanna Leong, “Criminalising
(cont'd on the next page)

16 What then was the harm caused to Odex? Even if Odex did not have legal standing to bring civil proceedings for copyright infringement, it is clear that their commercial interests in distributing licensed copies of the video titles in Singapore was at risk. Irrespective of whether they were exclusive licensees or just plain licensees, they had a genuine commercial interest in seeing the copyright in the *anime* titles enforced over and above the interest that any law abiding member of the public has in seeing laws properly enforced. Thus, even if as a matter of copyright law, they did not have title to sue, they were not idle “busy bodies” acting without any genuine economic grievance or interest at stake.

17 What then was the role of Pacific Internet? Pacific Internet, were the internet service provider (“ISP”) who had “unwittingly” facilitated the file swapping and downloads by providing internet access to the users/subscribers concerned. The infringing users were essentially the customers of Pacific Internet for internet access services. Pacific Internet was under a contractual duty to keep the identity of its subscribers’ confidential (private) and they were also under a statutory duty to comply with the Telecommunications Act Code of Practice. This Code also requires confidentiality of end user subscriber information.

18 What then was the order that Odex sought against Pacific Internet? Odex wanted discovery of the identity of the subscribers who had uploaded/downloaded the alleged infringing copies. Armed with that information, those subscribers could then be sued for copyright infringement and possibly, in some cases, prosecuted for the relevant copyright offences. Pacific Internet could provide the names but refused to do so, on account of the contractual confidentiality obligation and the statutory duty.

B. The clash of rights

19 *Locus standi* aside, Odex claimed the right to protect its commercial interests arising from or in connection with the copyright licence agreements. Whilst it accepted that Pacific Internet was not personally liable for the infringements committed by the uploaders/downloaders, they asserted that Pacific Internet should be

Primary Copyright Infringement in Singapore: Who are the Real Online Culprits” [2007] EIPR 108 and also “Defining Criminal Liability for Primary Acts of Copyright Infringement – The Singapore Experience” JBL 2008 4. Saw and Leong rightly point out the difficult question of construction that arises under s 136(3A) as to when infringement may be regarded as significant. This is an important issue which, whilst deserving of a full airing, will only be briefly touched on later in this article.

compelled to do the “right thing” by them and to identify the infringing subscribers.

20 Pacific Internet, on the other hand, asserted their interest in avoiding potential liability to the subscribers for breach of contract (confidentiality) as well as to protect their licence as an ISP by complying with the Code of Practice.

21 In this context, a clash arises: the IP interests and the interests of the subscribers to protect their identity (confidentiality/privacy) as well as the interest of Pacific Internet to protect their telecommunications licence as well as their commercial relationship with their customers.

III. Fundamental rights and privacy interests: Some background documents

22 Before delving into the legal issues (privacy, IPR, *etc*) that arose in the *Odex* litigation, a brief summary of some of the key international (and regional/domestic) documents in the area of privacy and basic rights may be helpful to set the scene for the discussion of balancing of rights.

A. *The Universal Declaration of Human Rights 1948 (“UDHR”)*⁸

23 Several Articles are worth highlighting in the context of the above mentioned clash of rights. These are as follows.

Article 12

No one shall be subjected to *arbitrary* interference with his privacy, family, home or correspondence or to attacks upon his honour or reputation.

Article 17

Everyone has the right to own property ... no one shall be *arbitrarily* deprived of his property.

Article 18

Everyone has the right to freedom of thought, conscience and religion.

Article 19

8 See Thio Li-Ann, “Pragmatism and Realism Do not Mean Abdication. A Critical and Empirical Inquiry into Singapore’s Engagement with International Human Rights Law” (2004) 8 SYBIL 41. Professor Thio explains at p 50 that Singapore accepts the UDHR as a primary referent. Citing K Tan, “Fifty Years of UDHR: A Singapore Reflection” (1990) 20 Sing LR 265. See also Michael Hwang, “Think Public, Think International” *Law Gazette*, March 2008 that Singapore subscribes to the UDHR.

Everyone has the right to freedom of opinion and expression... to seek, receive and impart information.

Article 29

Everyone has *duties to the community* in which alone the free and full development of his personality is possible.

In the exercise of his rights and freedoms, everyone shall be subject only to such limitations as are determined by law solely for the purpose of securing *due recognition and respect for the rights and freedoms of others* and of meeting the just requirements of morality, public order and general welfare in a democratic society.

[emphasis added]

24 Even a cursory glance at these provisions reveals a very carefully crafted balance indeed! Whilst interferences with rights/freedoms must not be arbitrary, clearly the UDHR accepts that on occasion interferences with even basic rights must be allowed. After all, important though we all are as individuals, we all have duties to the community as a whole and must find expression of our own personality through or as part of the wider community: by paying due respect to rights and freedoms of others.

25 Odex might well pray in aid Art 17 of the UDHR. Pacific Internet and the user/subscriber on the other hand will pray in aid Art 12. Both will assert Art 29 and demand due recognition and respect!⁹

B. *The European Convention on Human Rights and Fundamental Freedoms 1950 ("ECHR")*

26 Whilst the ECHR is not applicable to Singapore, it may be worth mentioning that if it were a number of Articles would bear repeating in the context of the *Odex* dispute.

Article 8

1. Everyone has the right to respect for his private and family life, his home and his correspondence.

2. There shall be no interference by a public authority with the exercise of this right except such as is in accordance with the law and is necessary in a democratic society in the interests of national security, public safety or the economic well-being of the country, for the prevention of disorder or crime, for the protection of health or morals, or for the protection of the rights and freedoms of others.

9 Pray in aid in the loose sense of referring to the rationale behind the provision to support their case.

Article 10

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.

27 Thus, if legislation based on the principles of ECHR were enacted in Singapore: it is to be noted that the same proportional balanced response will be required as in the case of the UDHR. On this basis, *Odex* might point to Arts 8(2) and 10(2) whilst Pacific Internet and its subscribers would underscore Art 8(1).

C. *Singapore provisions on telecommunication user privacy and data protection*

28 Pursuant to s 26(1)(a) to (e) and (g) of the Telecommunications Act,¹⁰ the Info-communications Development Authority of Singapore has issued a Code of Practice which provides (amongst other things):

3.2.6 Duty to Prevent Unauthorized Use of End User Service Information

Licensees must take reasonable measures to prevent the unauthorized use of End User Service Information (EUSI)

3.2.6.2 Prohibition on Unauthorized Use

A licensee must ... not use EUSI for any purpose other than ... providing assistance to law enforcement, judicial or other government agencies.¹¹

29 Once again, we see the delicate balancing of rights and obligations. *Odex* will claim in aid of release of EUSI data for the purpose of providing assistance to judicial authorities in the sense of

¹⁰ (Cap 323, 2000 Rev Ed).

¹¹ Query whether it will be helpful to expressly clarify that this proviso includes revelation of subscriber identity where there is a credible allegation of copyright infringement?

enabling legal proceedings to be brought before the court. Pacific Internet and its subscribers on the other hand pray in aid of the prohibition against unauthorised use.

D. National Internet Advisory Committee (“NIAC”)

30 In 2001, the NIAC issued its report on a Model Data Protection Code for the Private Sector. Whilst some countries have already introduced new statutory regulation of data collections comprising personally identifiable information, Singapore has elected to proceed down the path (as an interim measure) of voluntary data protection (self-regulation). In opting for this as an interim measure, it is worth stressing that the Committee did accept that effective protection of personal data is desirable in the Singapore private sector. That said, the need for a balanced approach was clearly recognised by the Committee in its support for exemptions where the processing of personal data is necessary to safeguard national security, defence, public security, prevention, detection and prosecution of criminal offences or of breaches of ethics for regulated professions, *etc*, including the protection of the data subject or the rights and freedoms of others.¹²

IV. Internet: Copying anonymity: The dilemma of copyright owners

31 Whilst IPR are very important for the business/commercial community, they are not sacrosanct property rights that demand unqualified protection without exception or limits. Not only are there permissible limitations and exceptions built into each IPR (such as fair dealing defence and copyright), it is worth pointing out that the now venerable TRIPS Accord expressly recognises that IPR must take their place alongside other community interests and needs. Thus, Art 7 states:

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

32 One of the most pressing challenges to the IPRsystem of late has been the exponential growth of “home” or “domestic” piracy of copyright subject-matter. Gone are the days when only sophisticated commercial copyists had access to technology capable of making quick accurate multiple copies of copyright subject matter. The electronics

12 A brief summary of data protection legislation is set out towards the end of this article.

and computer revolution of the past 50 years has now spawned what is sometimes called “the mother of all copying technologies”: the Internet and associated computer peripherals and P2P type software programs. Home copyists linked to the Internet are here, there and everywhere. Individually, home copyists may make very few infringing copies of any given work: collectively, the volume may well be massive. As commentators have said:

[I]n light of the rapid advancements in computer, digital and Internet technologies, consumers and other end-users have begun to take things into their own hands. Instead of purchasing illegitimate copies of copyright material from the street vendor, they now discover that it is far more efficient and cost-effective to acquire digital copies for themselves in the privacy of their own rooms from certain Internet websites or through peer-to-peer (P2P) file-sharing networks. They may further decide to share these digital copies with others in the Internet or P2P file-sharing community. In the process, however, they inadvertently expose themselves to civil action for having committed primary acts of copyright infringement, and, in Singapore at least, they may also face criminal prosecution if primary infringers like themselves are found guilty of wilful infringements of copyright.¹³

33 Whilst not all copying of copyright subject matter for individual use is necessarily infringement, it can be assumed that a good deal, probably the greater bulk, will constitute copyright infringement under existing copyright law in Singapore as well as in most WTO Member States. In some cases, as noted by the commentators referred to above, it may even be that the individual copyist will be liable under criminal provisions.

34 Copyright owners and their exclusive licensees have a statutory right to sue for copyright infringement to secure and protect their commercial interests. But, for this to be effective, they must first be able to identify the infringers and then subsequently to bring an action and obtain meaningful remedies. It has sometimes been said that home digital piracy is prevalent not just because it is “cheap and accurate” but also because the chances of detection are slim and the practical problems of enforcement severe.

35 This is not a new problem. In 1977, the English Whitford Committee (on copyright law reform) commented that the then new “hi-tech” nemesis of copyright, the now humble photocopying machine, had led to an explosion of illicit copying of printed material. Detection was said to be virtually impossible and that unless something was done

13 Saw Cheng Lim & Susanna Leong, “Criminalising Copyright Infringement in Singapore: Who are the Real Online Culprits” [2007] EIPR 108.

soon, there was a serious danger that in some fields, publication would cease.

36 Ten years later in 1988, the UK House of Lords had to deal with the impact of cheap easy to use cassette tape recorders on the sound recording and music industry. Imagine the collective shudder and groan reverberating through the music industry when the twin/quad-deck high speed stereo cassette tape copier was introduced. Lord Templeman remarked that:

[F]rom the point of view of society, the ... position is lamentable. Millions of breaches of the law must be committed by home copiers every year ... Whatever the reason for home copying, the beat of Sergeant Pepper ... from unlawful copies, are more powerful than law abiding instincts or twinges of conscience. A law which is treated with such contempt should be amended or repealed.¹⁴

37 But, on the other hand, the closing decade of the last millennium has also seen the rise of groups advocating less rather than more copyright protection: these range from “copyleft” groups to “open source software” advocates to supporters of the “creative commons” to groups who simply argue for the legalisation of all copying for private/personal use.

38 This is not the time or place to address the merits or otherwise of arguments to the effect that the answer to mushrooming illicit copying in the Internet is to simply make much of the copying lawful.

39 The reality is that the world trade community has responded over the past 15 years with a deliberate strengthening of the rights of IPR owners in general and copyright owners in particular. One thinks, for example, of the extension of the copyright term to life plus 70 years, new enhanced criminal provisions as well as new legal measures designed to protect copy lock protection and electronic rights management.

40 There are of course those who strongly argue that the pendulum has now swung far too much in favour of IPR owners and that the carefully crafted minimum standards required in international agreements such as TRIPS have been steadily “ratcheted” up on the back of bi-lateral free trade agreements.

41 Whatever view one takes of these comments, enthusiastic support, ambivalence or disagreement, the impact of the Internet on the commercial interests of copyright owners is obvious and the danger to their commercial interests clear and present.

14 *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] 2 All ER 484.

42 If copyright is emasculated by copying technology and the Internet, copyright industries will have no choice but to try and develop other business models which permit free personal use/access and which still enable them to turn their copyright into performing assets. Whether this can be done, remains to be seen. What is clear is that as the law currently stands in Singapore, there is little doubt that many of the individuals who download copyright material such as films, sound recordings or music through the P2P system are committing copyright infringement. Resort to fair dealing defence will require very careful study and investigation of the facts and is likely to be difficult in most cases. In many of these cases, it is also probable that the ISPs will have access to the necessary information to identify the individuals concerned. The copyright owners and their licensees, on the other hand, will not have access to this information.

43 Whether or not the ISPs are personally liable for the infringement by the subscribers and even if they bear no legal responsibility at all for the acts of their subscribers, the ISPs at the very least will have “facilitated” the infringing acts by providing the internet access service which enabled the infringement. Is this enough to generate a duty to assist the victims of the wrongdoing?

V. The US-Singapore Free Trade Agreement (“FTA”): Subscriber anonymity and copyright

44 Given the problems highlighted above, it should come as no surprise to find that the US-Singapore FTA attempts to deal with the problems faced by many copyright owners in identifying infringing internet users. Article 16.9.22(b) provides that:

Each Party shall establish an administrative or judicial procedure enabling copyright owners ... to obtain expeditiously from a service provider, information in its possession identifying the alleged infringer.

45 The intent and spirit of this provision is clear. ISPs in Singapore must lift the veil and provide information identifying alleged copyright infringers.

46 Is this consistent with international norms safeguarding individual rights of privacy and/or confidentiality? Clearly the answer must be an unqualified yes!

47 Article 17 of the UDHR recognises the right to own property: that an individual should not arbitrarily be denied his property. Copyright is a species of property. And whilst Art 17 may be more concerned with unilateral compulsory acquisition by the State, the

provision does underscore the importance of upholding property interests.

48 Whilst Art 12 of the UDHR does underscore privacy as a human right, this is subject to Art 29 which provides that an individual also owes duties to the community at large and that he is to respect the rights and freedoms of others.

49 Article 8(2) of the ECHR similarly recognises that whilst there shall be no interference by a public authority with the exercise of the right of privacy, that this is except such as is “in accordance with the law and is necessary ... for the prevention of disorder or crime, for the protection of health or morals, or for the protection of the rights and freedoms of others”.

50 Similarly, The Code of Practice for Competition in the Provision of Telecommunication Service 2005 as well as the NIAC Model Data Protection Code for the Private Sector supports the view that personal information may sometimes be justifiably released to relevant parties in order to provide assistance to judicial agencies or to protect the rights and freedoms of others.

51 What then of the common law (and equity) in general in Singapore (and elsewhere)? What has been the response of the Judiciary to the need for a balance of rights and freedoms in the context of the privacy debate? The short answer must be that the need for a balancing of rights and freedoms for the greater good of society as a whole permeates much of the common law and rules of equity.

52 A few examples suffice to illustrate the point. At a very early stage, the common law recognised the right of an individual to protect his bodily integrity: that he/she should enjoy physical self-autonomy. Hence, the early development of the tort of trespass to the person: battery and assault. Then there was the expansion of trespass to cover false imprisonment as well as intentional/reckless infliction of psychiatric harm. As is well known, battery comprises the intentional and direct application of force to the body of another person. An unwanted kiss on the cheek is as much battery (as well as invasion of privacy) as a punch to the face. An individual’s right to protect his body (to be let alone) is perhaps the most basic and fundamental of the rights that he may enjoy under the law. But even here, the tort of battery must take account of wider social interests.

53 Ordinary social intercourse and interaction, especially in an ever more crowded world, necessarily involves some direct intentional physical contact. Imagine trying to take a bus home at rush hour in a crowded city without having to “push” past another passenger. In some

cases, to avoid all physical contact one may have to be a contortionist or perhaps wait for the next and hopefully less crowded bus. Is it any wonder that the law¹⁵ recognises that intentional bodily contact is not battery if that type of contact was generally acceptable in everyday life? Life in any community and especially a densely populated city necessarily demands that individual members accept some degree of physical contact that is incidental and a routine part of day-to-day life. A balance is achieved within the generally accepted practices of the community in question.¹⁶

54 Second, even in the case of property interests, whilst the owner will enjoy a powerful right of self-determination in respect of the property and a right to exclude all others, the right is not absolute or unqualified. Take for example that most pervasive of IPR, copyright. Copyright provides a deep and broad right to prevent the making of unauthorised copies of the protected work. But, in some countries, aside from statutory exceptions such as fair dealing or fair use or use in judicial proceedings, a broad based public interest defence may exist to justify the making of copies when necessary to protect some other public interest (such as crime investigation).¹⁷

55 If copying and dissemination in the name of the public interest can sometimes (if not a little controversially) justify copyright infringement, it should come as no surprise to find that the most important qualification to a person's right to protect his confidential information (including trade secrets and sensitive commercial information) is also to be found in the public interest defence.

56 Much has been written on this defence in actions for breach of confidence. It is enough to remind ourselves that from its humble start as a rule founded on public policy and a refusal to protect (or grant relief to) information regarding serious crimes, misdeeds and iniquities, the defence has developed into a free ranging inquiry that seeks to balance the public interest in preserving the confidence against any public interest that is asserted as providing just cause for breaking the confidence. Public interest is not just an exercise of discretion to refuse grant of relief; it now operates as a true defence to liability. In its modern free ranging form, the defence has become a powerful tool

15 See *Collins v Wilcock* [1984] 1 WLR 1172. See also *Wilson v Pringle* [1987] QB 237.

16 But note that the courts in Singapore generally take the view that Singapore is still a conservative society and that unwanted contact, even slight contact, especially between males and females, may well be unacceptable. See *Soh Yang Tick v PP* [1998] 2 SLR 42 at [80] *per* Yong Pung How CJ in connection with a prosecution under s 354 of the Penal Code (Cap 224, 1985 Rev Ed) (outraging modesty).

17 See Saw Cheng Lim, "Is There a Defence of Public Interest in the Law of Copyright in Singapore?" (2003) Singapore Journal of Legal Studies at pp 519–556.

aiding freedom of information type arguments under the banner of public interest.

57 Whilst the goal of protecting the sanctity of *any* confidential relationship clearly falls within the public interest, arguably the most important confidential relationship is the one which exists between a doctor and his/her patient. And yet, even here, courts in England and elsewhere have allowed disclosures of medical records where necessary to safeguard some competing public interest. Thus, disclosure of an adverse confidential psychiatric report to the relevant authorities (to the effect that the patient was still a danger to the public) was justified even though it was accepted that doctor/patient confidentiality was a very important facet of the public interest.¹⁸

58 In yet another case, what was in issue was the identity of doctors who had contracted HIV and who were still practising medicine under the NHS. Whilst, the public interest defence failed, the point to be made is that the court was deeply concerned to balance the public interest in a free press and an informed public debate (about spread of HIV within society including the medical profession) against the public interest in that AIDS sufferers should be able to resort to medical treatment without fear of his/her identity being revealed. On the facts of that case, the balance came down in favour of maintaining confidentiality.¹⁹ This decision might be contrasted with cases where there is a need to publicise the identity of a patient (possibly in national media) in an attempt to control the spread of a vicious highly infectious virus through aggressive contact tracing.²⁰

59 In more recent times, the identity of a famous well-known fashion model undergoing treatment for addiction to narcotics was justified in the name of the public interest. But, by the narrowest of margins, the House of Lords also held that the newspaper went too far when details of that treatment were also disclosed.²¹ What was the balancing public interest in issue in this case? It was the need to correct the false public impression (created by the plaintiff) that she was not involved with drugs. In short, the English courts appear to accept that with the deepening and expanding protection offered by the law of confidence to private personal information that a more robust recognition of competing public interests, including the need to correct a false role model image, had to be developed.²² This did not mean that

18 *W v Egdell* [1989] 2 WLR 689, [1990] Ch 1.

19 *X v Y* [1988] 2 All ER 648.

20 Recall the SARS epidemic in Singapore and the need for urgent public contact tracing.

21 *Campbell v MGN Ltd* [2004] 2 WLR 1232.

22 In the UK, the Human Rights Act 1998 brings into UK domestic law, the provisions of the ECHR 1950. To ensure adequate protection of the Art 8 right of
(cont'd on the next page)

the plaintiff's privacy interest was ignored. The House of Lords took pains to stress the importance of confidentiality of medical information of patients. Given the public interest in seeing the plaintiff complete her drug rehabilitation treatment at her chosen clinic, the majority of the House came to the view that disclosure of the details of her treatment (and photograph of her leaving the clinic) was excessive and outside of the public interest in correcting the false impression.

60 There is in fact nothing new in this "scales of balance" approach. Of course, opinions can differ on where the balance lies in any given case. As long ago as 1977, Lord Denning MR, in permitting disclosure of personal information which showed certain famous pop stars in a bad light, remarked: if a group seek publicity which is to their advantage, they cannot complain if a servant chooses to tell the truth. If the image which they fostered is not a true image, it is in the public interest that it be corrected. Just as there should be truth in advertising, so there should be truth in publicity. The public must not be misled!²³ Since then the courts in England have had to grapple with a diverse range of cases where confidentiality/privacy interests have come up against various competing public interest issues (from role model arguments to abuse of position) including extra marital affairs and football stars,²⁴ visits to a prostitute and a well-known broadcast personality²⁵ and information about possible misuse by a CEO of a public listed company of corporate facilities for the benefit of his companion.²⁶

privacy, the English courts have taken the view that the better approach is to expand the protection afforded by the law of confidence. That said, it is important to note that the law of confidence from its earliest days was always capable of protecting confidential personal information as well as trade and business secrets. What has happened in the UK is that with the Human Rights Act 1998, the English courts have felt obliged to comply with Art 8 by broadening the protection by recognising that the action can protect any personal information which a reasonable person would regard as private. See *Campbell v MGN Ltd* [2004] 2 WLR 1232 and *Murray v Express Newspapers and Big Pictures Ltd* [2007] EWHC 1908 and on appeal at [2008] EWCA Civ 446. That being so, free speech advocates assert that it will be even more important now to balance that right against public interests that may support disclosure.

- 23 *Woodward v Hutchins* [1977] 1 WLR 760, [1977] 2 All ER 751. Perhaps this case represents an extreme application of the public interest defence? There are those who would argue that the balance should have come down in favour of the plaintiffs. In a different context, Wright J (Supreme Court Tasmania) once stated in connection with a claim for invasion of privacy and press freedom that he "had a healthy scepticism about the application of such glib clichés as freedom of speech which are so often relied on to justify the dissemination of material which powerful controllers of the mass media choose to place before the public". See *Lenah Game Meats Pty Ltd v ABC* [1999] TASSC 114 at para 18.
- 24 *A v B* [2002] 1 All ER 449.
- 25 *Theakston v MGN* [2002] EMLR 22. See also *Max Mosley v News Group Newspapers Ltd* [2008] EWHC 1777.
- 26 *Lord Browne of Madingley v Associated Newspapers* [2007] 3 WLR 289.

VI. The need for checks and balances: Proportionality, legal principles and the pursuit of justice

61 The pursuit of truth and justice is not limited to the substantive rules (laws) which govern individual behaviour in society. Of course, rights and freedoms, especially fundamental rights and freedoms, are important in establishing the framework and structure of the house of justice. Equally important is access to the state agencies so that disputes can be adjudicated, complaints investigated and the rights and freedoms developed, explained, qualified and, of course, enforced.

62 Inefficient, ineffective or unnecessarily cumbersome judicial procedures may be just as bad, or even worse, than systems where no rights are granted in the first place. In the realm of IP law, this has long been a problem – one that has been greatly exacerbated by the explosion of digital copying facilitated by the computer and the Internet. This has been alluded to already in this article.

63 Professor David Vaver, in his typically witty paper, *Intellectual Property: The State of the Art*, identifies this problem as “the intellectual crisis of intellectual property”. The clarion call of supporters of free internet and file swapping programs is that information and knowledge wants to be free and that any attempt by copyright holders to halt the free movement of digital data are doomed to fail. Professor Vaver continues:

Digital technology is just the latest manifestation of intellectual property’s continual crises. While business and governments have put much effort in trying to strengthen the copyright system – tightening copyright owner’s control over electronic activity, adapting copyright rules to achieve that goal, and shrinking the scope of the public domain – the technology itself has questioned the practicality of these endeavors ... But as existing works are digitized, with or without authorization, or new works are made available solely in digital format, copyright becomes less able to cope with the manipulation and movement of intangible electronic streams. Detection and enforcement become difficult, sometimes impossible ... In this world, every user is a potential re-author and re-distributor of material made available electronically to her. In this world, the only way in which an initial provider of a work or information can practically profit from its investment may be through reliance on shared ethical understandings, encryption and password technology, click-on contracts and good marketing ...²⁷

64 These remarks give all IP lawyers and users of IP subject matter much to think about. What is the long-term solution to the apparent

27 LQR 2000 116 (October) 621.

mismatch between the needs of copyright owners and the wants of individual users of the Internet? Can copyright holders find new (profitable) ways of exploiting (marketing) the material so as to provide for free (or cheap and convenient) personal use on the Internet? In the case of music, should the industry move to a platform or business model where distribution on the Internet is regarded as advertising and branding: the more distribution the better? After all, with popularity comes the prospect of lucrative live tours, film synchronisation rights and so forth. Is there a realistic marketing model which will enable creators of commercial copyright material to earn a satisfactory remuneration and which still meets the public "hunger" for free (cheap and convenient) access for private enjoyment on the Internet? If movies and films are seen as an attractive vehicle whereby internet popularity of a literary or musical work can be turned into account, will this still hold true if those movies and films are in turn copied and distributed for free on the Internet? Will screenings in cinemas be enough given the huge costs of movie production?

65 Whatever view is taken on the marketing response that the copyright industry should take to the Internet, the question remains as to how their present rights are to be enforced. As Lord Templeman states: a law which is ignored with abandon and treated with contempt should either be amended or repealed!

66 Repealing the law against digital copying (even if limited to digital copying for personal use) will require a major shift in the thinking underlying TRIPS, WCT and WPPT treaties²⁸ and will also require a rethink of the terms of the US-Singapore FTA!

67 Quite a daunting proposition! But, that is not to say that the time has not come for such a rethink by the international community as a whole. Indeed, as mentioned already, there is a building body of opinion that the problem with IPR as a whole and copyright in particular is that the law has become, especially since 1995, overly pre-occupied with rights and with only lip service being paid to the question of matching responsibilities.

68 Has the time come when responsibilities and duties of IPR owners need to be re-examined and underscored if broader societal acceptance of IP is to be achieved in this new information age? Maybe so, but, in the meantime, life must go on in accordance with the current balance as set out in the existing laws. TRIPS and the US/Singapore FTA require not only that the rights be granted but that there should be

28 Agreement on Trade Related Aspects of Intellectual Property Rights 1994 ("TRIPS"); WIPO Copyright Treaty 1996 ("WCT") and WIPO Performances and Phonogram Treaty 1996 ("WPPT").

expeditious means made available for enforcement. Thus, Art 41 of TRIPS requires Members to ensure that enforcement procedures are available so as to permit effective action against any act of infringement including expeditious remedies to prevent and deter infringements.

69 Similarly, Para 16.9.7 of the US-Singapore FTA requires that each Party make available to right holders (including exclusive licensees) civil judicial procedures concerning enforcement of any IPR. Further, Para 16.9.22(a) goes on to state that each Party shall provide legal incentives for service providers to co-operate with copyright owners in deterring the unauthorised storage and transmission of copyrighted materials.

70 Article 16.9.22(b), quoted already, then goes on to provide that each Party “shall establish an administrative or judicial procedure enabling copyright owners ... to obtain expeditiously from a service provider, information in its possession identifying the alleged infringer”.

71 In Singapore, there are in fact two well-established procedures relevant to discovery of identity of subscribers from ISPs. These are dealt with below.

VII. Equitable discovery: *Norwich Pharmacal* orders

72 *Norwich Pharmacal v Customs and Excise Commr*²⁹ (“*Norwich Pharmacal*”) concerned an age-old problem: identifying the individual responsible for infringing a person’s rights so that a claim can be brought before the courts. There is little point in knowing that the law has created substantive rights that can be asserted to protect legally recognised interests if the would be claimant is unable to identify or find the wrongdoer.

73 The same problem arises in criminal law. It is usually obvious that a crime has been committed. The identity of the victim seldom creates any difficulty. But the answer to the question, who then is the perpetrator, is often far more problematic. A horse is stolen, but by whom? If the wrongdoer is identified, the victim (owner of the horse) may be able to sue in the courts for its return or compensation and the public prosecutor will be able to indict the wrongdoer for theft. The victim’s civil rights are enforced by the civil courts whilst society’s interest in law and order is safeguarded by the prosecution in the criminal courts.

29 [1974] AC 133, [1973] 3 WLR 164.

74 Suppose that there is a witness to the commission of the wrongful act: can the witness be compelled to reveal the identity of the wrongdoer to the victim and/or the authorities so that appropriate civil and/or criminal proceedings can be instituted?

75 This is a very old problem that involves balancing competing interests and rights. The witness is not personally liable or responsible for the commission of the wrongdoing and whilst he could help the victim, he asserts his right to be left alone. Beyond wanting to be left alone, the witness may even assert that he is in a confidential relationship with the wrongdoer and that the revelation of the wrongdoer's identity may expose him to some legal liability. The victim, on the other hand, pleads his plight: a wrong has been committed and if the witness does not assist, that wrong will go unremedied and/or unpunished. Surely the witness as a fellow member and beneficiary of the society in which they both live owes a duty to that society and its members to assist – or so the victim may argue. But, just as the common law recognises that a bystander cannot (generally) be compelled to assist a person in trouble (drowning in a swimming pool is a common example), so too it does not generally compel a mere witness to assist a victim by revealing the name of the wrongdoer. As one commentator has said in the context of developing a philosophy for the law of evidence, the trial process is not simply about finding the truth in order to do justice, the fundamental concern should be to do justice in the search for truth!³⁰

76 Where a person is a mere witness, the balance has come down in favour of the witness.³¹ Whether or not there are good arguments to change the balance and order disclosure (either in general or in certain areas) against a mere witness, the position is different where the witness has facilitated the commission of the wrongdoing. Even if that individual is not personally liable for the wrongdoing (as where he innocently lends a kitchen knife to the assailant), does the fact that he has unwittingly facilitated the wrongdoing mean that he should be under some legal duty to assist the victim by revealing the identity of the

30 Ho Hock Lai, *A Philosophy of Evidence Law, Justice in the Search for Truth* (OUP, 2008).

31 Note s 121(1) of the Criminal Procedure Code (Cap 68, 1985 Rev Ed) provides that a police officer making a police investigation under this Chapter may examine orally any person supposed to be acquainted with the facts and circumstances of the case and shall reduce into writing any statement made by the person so examined. Subsection (2) also states that such a person shall be bound to state truly the facts and circumstances with which he is acquainted concerning the case except only that he may decline to make with regard to any fact or circumstance a statement which would have a tendency to expose him to a criminal charge or to a penalty or forfeiture. The author is grateful to Professor Ho (n 30) for drawing his attention to this provision.

wrongdoer? Does this depend on the degree to which the witness has in fact facilitated the commission of the wrongdoing and/or whether the victim has any other reasonable means of identifying the wrongdoer? If so, what if the individual has provided the “essential” means by which the wrongdoing was committed in circumstances such that it would be difficult (or much more difficult) for the wrongdoer to commit the wrongdoing if the witness had not been so involved: is there a case for saying that in such circumstances, the law should place an affirmative duty on the facilitator to assist the victim by doing the right thing? The assertion that he should assist arises not so much because he has witnessed a wrongdoing but because he has unwittingly facilitated its commission in circumstances such that the victim has no other reasonable means of discovering the identity of the wrongdoer.

77 In the area of IPR, the owners of the rights have long complained of the practical problems that they encounter in enforcing their rights. In some cases, the evidence is destroyed or assets against which any judgment may be executed transferred, hidden or otherwise disposed of in an attempt to make the defendant “judgment proof”. In other cases, the real perpetrator or “master mind” may be hidden behind many layers of “paper” companies and other individuals who are willing to “take the rap” for the infringements. These are well-known problems that have been around for quite some time.³²

78 Then there is the question of the innocent facilitator who knows the identity of the infringer but who is unwilling or is reluctant to come forth. How this last problem is best dealt with is the question of law and policy that lies at the heart of the *Norwich Pharmacal* principle and the decision in the *Odex* case. But, before the rule in *Norwich Pharmacal* is summarised, it may be interesting to query what alternatives a law maker might have when faced with the quandary described above in the context of copyright infringement.

32 It should come as no surprise to find that some of the most innovative developments in procedural law have arisen out of intellectual property litigation. These include the now well established (but initially highly controversial) *Anton Piller* order dealing with *ex parte* applications to preserve evidence. See *Anton Piller KG v Mfg Processes Ltd* [1976] Ch 55. This case concerned copyright infringement and breach of confidence. Similarly, *Norwich Pharmacal v Customs and Excise Commr* [1974] AC 133, [1973] 3 WLR 164 is a case concerning patent infringement. Mention should be made of another powerful procedural development (with the modern form developing in the 1970s): the *Mareva* injunction. Whilst many of the early *Mareva* cases involved Admiralty/shipping disputes, there is no doubt that the *Mareva* injunction is also available in suitable cases concerning IPR. The *Mareva* is essentially concerned with pre-trial protection of assets. See *Mareva Compania Naviera SA v International Bulkcarriers SA* [1975] 2 Lloyd's Rep 509.

79 The first will be to do nothing, which may well mean that the victim is unable to enforce his rights as he cannot identify the wrongdoer.

80 The second will be to re-examine whether the victim should have been granted the rights in the first place. If these rights are infringed with great abandon and in circumstances whereby it is very hard for the victim to enforce his rights, is there a case for saying that perhaps it would be better to remove the right, for example, by legalising all private, non-commercial copying of copyright material?

81 The third option may be to expand the rights of the victim by creating a cause of action against the person who facilitated the commission of the wrongdoing. For example, there is the possibility that the facilitator may be liable with the actual wrongdoer on the basis of joint tortfeasorship: participation in a common design and so forth. In other cases, it may be that the statute creating the right provides that a person who authorises another to commit infringement is liable together with the person who actually commits the infringement. In such cases, it will not be surprising if copyright owners try to cast liability on the shoulders of he or she who facilitates by arguing for an expansion of joint tortfeasorship principles or by arguing that the facilitator has impliedly authorised the infringement. However, these attempts have rarely succeeded.³³

82 The fourth option will be to try and persuade the legislators to introduce legislative controls over the technology or “the means” that the facilitator makes available to the actual infringer; for example, by making ISPs liable for infringement committed through use of their services if they continue to allow the infringer access to those services after the ISP is notified of the infringement.³⁴ This may also be combined with attempts to use technology to make copying more difficult, such as through the use of encryption and other forms of copy prevention technology including electronic rights management information.³⁵

33 See *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] 2 All ER 484 where the copyright owner tried unsuccessfully to argue that a manufacturer of a twin deck cassette tape machine was liable for authorising infringement or under joint tortfeasorship principles. In Singapore, see also *Ong Seow Pheng v Lotus Development Corp* [1997] 3 SLR 137. These cases demonstrate just how difficult it is to establish liability under either authorisation or joint tortfeasorship against a person who merely facilitates the commission of a wrongdoing.

34 In Singapore, see Pt IXA of the Copyright Act (Cap 63, 2006 Rev Ed) which sets out special provisions on the liability and protection of network service providers.

35 In Singapore, see Pts XIII and XIII A of the Copyright Act (Cap 63, 2006 Rev Ed) on rights management information and circumvention of technological measures.

83 The fifth option which may well be combined with the fourth option will be to develop legal principles which enable the victim to compel the innocent facilitator to come to his/her assistance by revealing the identity of the wrongdoer. Perhaps as a *quid pro quo* for not extending the substantive liability driven principles of joint tortfeasorship, infringing authorisation and vicarious liability, innocent facilitators should accept an obligation to reveal the identity of the wrongdoer. This can be achieved either by means of judicial development of some common law or equitable rule (as in the *Norwich Pharmacal* case) or by means of statutory provisions.

A. *The Norwich Pharmacal order*

84 The *Norwich Pharmacal* case concerned an owner (patentee) of the patent rights in a chemical compound. One of the exclusive rights that they enjoyed under the English Patents Act was the right to import copies of the chemical compound into the UK. Unknown persons had been importing quantities into the UK without the licence of the patentee. If they could be identified, actions for patent infringement could be brought. This, however, was a problem as the patentee did not know the identities of the importers. But since custom duties had been paid on the imports, it followed that the Customs and Excise Office possessed information from which the importers could be identified. On these facts, there was no question of the Customs and Excise Commissioners being personally liable for the infringing importations. At best, they had innocently facilitated the commission of the wrongdoing (importation) by processing the shipments. Were they now under a duty to disclose the identity of the importers to the patentee?

85 The House of Lords (unanimous) were of the view that the innocent facilitator should be under a duty in equity to reveal the identity of the importers.³⁶ Lord Reid explained that whilst discovery as a remedy in equity had a long history and was primarily used to assist a party to *existing* litigation, that this jurisdiction included discovery for the purpose of identifying *other* defendants who might be joined in.

86 Did this mean (applying the mere witness rule) that discovery should be limited to persons against whom the plaintiff enjoyed a substantive cause of action? Lord Reid noted that the point behind the rule that discovery should not be granted against a “mere witness” was the assumption that the testimony of that witness would in due course be presented at trial. May be so, but this creates an obvious problem where the witness is the only person who can identify the wrongdoer for

36 *Norwich Pharmacal v Customs and Excise Commr* [1974] AC 133, [1973] 3 WLR 164.

the plaintiff to sue! Even so, Lord Reid accepted that it would not be proper, either as a matter of authority, principle or public policy, to order discovery against a mere witness so that the person who suffered damage might be able to find and sue the wrongdoer.

87 However, the position was different where, but for the action taken by the innocent defendants, “the infringements could never have been committed.” Lord Reid explained that in such cases it was a very reasonable principle that:

[I]f through no fault of his own a person gets mixed up in the tortious acts of others so as to facilitate their wrong doing he may incur no personal liability but he comes under a duty to assist the person who has been wronged by giving him full information and disclosing the identity of the wrongdoers ...³⁷

88 On the facts, Lord Reid was satisfied that the defendants should be required to reveal the information “unless there was some consideration of public policy” that prevents disclosure. In deciding this, Lord Reid held that it was necessary to “weigh the requirements of justice” to the victim against any considerations put forward by the defendant. An argument that the disclosure might hamper the efficient conduct of the defendant’s statutory duties was not accepted. Neither did Lord Reid accept that disclosure should be refused on account of the prejudice that it may cause to those whose identity would be disclosed. To this Lord Reid commented, if we could be sure “that those whose names are sought are all tortfeasors, they do not deserve to be protected”.³⁸

89 Lord Morris whilst expressing similar views noted that the Commissioners had acted properly in declining to voluntarily give the names of the importers. After all, the information was confidential and acquired by the Commissioners under statutory compulsion for limited purposes. Whilst there is an obvious public interest in safeguarding confidentiality obligations, it is well established that any duty of confidentiality must be balanced against any public interest in favour of disclosure. Since Lord Morris agreed with the disclosure of the names of the importers, it follows that Lord Morris accepted that the public interest justified any breach of confidentiality that might arise from the release of the names.

37 [1974] AC 133 at 175.

38 [1974] AC 133 at 176. More difficult would be a case where there was a reasonable possibility that the persons whose names were sought were not in fact tortfeasors. In such cases, Lord Reid stated that the court should only order discovery if satisfied that there is no substantial chance of injustice being done. On the facts, the possibility that the persons whose names were sought were not tortfeasors was so remote that it could be ignored.

90 The issue of confidentiality was also addressed by Viscount Dilhorne. The Court of Appeal had taken the view that the information was received in confidence and that the balance of the public interest demanded that the Commissioners keep the names and addresses of the importers a secret. Viscount Dilhorne agreed that discovery could be granted “against a person who is not a mere witness to discover the fact of some wrongdoing being established, who was responsible for it”. The mere witness rule did not apply to someone who was “involved in the transaction”. To this, Viscount Dilhorne added that it did not matter if that “someone” could have been sued by the plaintiff or whether the “involvement or participation was innocent and in ignorance of the wrongdoing”. Given that the Commissioners were involved in the wrongdoing of the importers, the court enjoyed the power to compel disclosure of the identity of the importers. The question then was whether, given the discretionary nature of the remedy, the court should decline to grant the relief on account of some counterbalancing public interest. On this balancing exercise, Viscount Dilhorne underscored the importance to the public interest of protecting the right of patent holders. Against this was the public interest in upholding duties of confidence. The Commissioners argued that the identity of the importers was confidential and that “exceptionally strong reasons must exist to permits its disclosure to” outside persons.

91 An important point of proportionality arises in determining the balance of competing interests. The law of confidence covers an enormously diverse range of information: from information that is highly valuable, unique and secret to information which, whilst confidential, lies close to the public domain. Even where a piece of information is highly secret and known only to a few persons, it may possess relatively little value or importance. The same is true, if not more so, of private information. Much development has taken place in UK and Europe these past years to broaden protection for an individual’s right of “informational privacy”. The universe of private facts protected under an expanded law of confidence may be broad, but not all private facts are equal in terms of their sensitivity or importance. Medical information will almost always be near the top end of the scale. Information concerning a “routine” family shopping trip in a public shopping centre will likely come in lower down the scale. But even here, not necessarily always so, as much may depend on the circumstances.³⁹ Names and addresses may well be confidential or private information, but the importance of the identity from a privacy perspective will depend on the facts and the nature of the information in respect of which his/her identity has arisen.

39 See, for example, *Murray v Big Pictures Ltd* [2008] EWCA Civ 446 (infant plaintiff who was the son of a famous parent photographed in a stroller in a public road with his parents).

92 Not only will there be varying degrees of confidentiality/privacy, it is important to bear in mind that there will be varying degrees of trust inherent in different types of relationships. The relationship between a doctor and his patient will be near the top end of the spectrum; indeed, in some countries, the doctor/patient relationship is said to be of a fiduciary nature. In other cases, there may be statutory obligations re-enforcing equitable obligations of confidentiality and which may even expressly prohibit disclosure.

93 On the facts of *Norwich Pharmacal*, Viscount Dilhorne, whilst accepting that some of the information which came into the hands of the Commissioners would be highly confidential, held that the information as to the identity of the importers attracted a low degree of confidentiality that was outweighed by the interests of justice – a factor that operated in the national interest.⁴⁰

B. *Main conditions and scope of the modern Norwich Pharmacal order*

94 Since the original decision in 1973, a considerable body of case law has developed in England on the conditions and scope of the order. In brief, the main points are set out below.

(a) The person against whom discovery is sought must have become mixed up with the wrongdoing of another: for example by facilitating the commission of the wrongdoing or by participation in that wrongdoing.⁴¹

(b) It does not matter whether the facilitation or participation is done innocently and irrespective as to whether there is knowledge of the wrongdoing.⁴²

40 Similar points were made by Lord Cross and Lord Kilbrandon. Lord Cross noted that there was no statute that prohibited disclosure of the names by the Commissioners. Lord Cross also stresses that in exercising its discretion, the court should look at the strength of the applicant's case against the unknown alleged wrongdoer, the relation between the alleged wrongdoer and the respondent, whether the information could be obtained from another source and the degree of inconvenience that the respondent would be put to if the order was made and whether this could be compensated by an award of costs/expenses.

41 *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29. Lord Slynn at para 1 stated that the order “does not depend on whether the person against whom the order is sought has committed a tort, a breach of contract or other civil or criminal wrong. It is sufficient but, it is also important to stress, also necessary that that person should be shown to have participated or been involved in the wrongdoing ...”.

42 Questions must remain over the degree of participation/facilitation for the “mere witness” rule to be displaced.

(c) In most cases, the purpose of the order is to enable the applicant to commence civil proceedings against the wrongdoer. That said, the House of Lords in UK has since held that the jurisdiction is founded on enabling the applicant to obtain relief for the wrongdoing and that in some cases this may take the form of dismissal of the wrongdoer (for example under a contract of employment).⁴³

(d) The original decision concerned the identity of patent infringers (breach of statutory duty). In England, the order is now predicated on the notion of “wrongdoing” rather than “tortious” conduct. Wrongdoing includes all torts as well as breach of contract and equitable obligations of confidence. There is also support from the House of Lords for an extension of the *Norwich Pharmacal* jurisdiction to include criminal offences (even if there is no parallel civil cause of action).⁴⁴ Such an approach would be consistent with the shift in the centre of gravity of the jurisdiction away from a civil suit for a tort and to the broader concept of enabling the victim of a wrongdoing to seek a remedy in the law.⁴⁵ Remedy in this sense may include the initiation of criminal proceedings, possibly by way of a private prosecution. In the *Ashworth* case, Lord Woolf strongly supported extending *Norwich Pharmacal* to cover victims of a crime. With respect, his Lordship rightly concludes that if a victim of a wrongdoing is content that the wrongdoer be prosecuted by the appropriate prosecuting authority, there is no objection to his obtaining the identity to enable that to happen.⁴⁶ If there was a danger that a claim to exercise a

43 *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29. See also *Carlton Film Distributors Ltd v VDC Ltd* [2003] EWHC 616 where the court ordered disclosure of information intended to assist the plaintiff formulate his claim. The equitable jurisdiction was described in terms of assistance in the attainment of justice.

44 See *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29 and also *David Edward Hughes v Carratu International Plc* [2006] EWHC 1791.

45 See *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29. Lord Woolf at para 45 cited with approval the views of Lord Denning in *British Steel Corp v Granada Television Ltd* [1981] AC 1096 that there was no ground to limit the order to cases where the injured person wanted to sue the wrongdoer. The order could be made to enable him to obtain redress or to protect himself against further wrongdoing. Similarly, Templeman LJ (as he then was) stated that: “The remedy of discovery is intended in the final analysis to enable justice to be done. Justice can be achieved against an erring employee in a variety of ways and a plaintiff may obtain an order of discovery provided he shows that he is genuinely seeking lawful redress of a wrong and cannot otherwise obtain redress ...” But see also for a contrary view, Sedley LJ in *Interbrew SA v Financial Times Ltd* [2002] EWCA Civ 274.

46 *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29 at para 53. Lord Woolf also points out that the more restrictive approach attaches excessive significance to the historical origins of the jurisdiction and that if such an approach had been taken to injunctions in general, the *Mareva* jurisdiction would never have developed.

Norwich Pharmacal jurisdiction might be made by someone who was not a victim, Lord Woolf makes the obvious response that the answer is not to artificially limit the jurisdiction but to confine the remedy to the victim of the crime.

(e) The order should only be made if the applicant has established that a wrongdoing (for example a tort or possibly a crime) has been committed. The stronger the case against the alleged (but unidentified) wrongdoer, the stronger the case for grant of the order. That said, it does not appear that the minimum threshold standard should be that which applies in the case of *Anton Piller* jurisdiction: namely, an extremely strong *prima facie* case. *Anton Piller* orders are usually sought to prevent the defendant defeating the course of justice through destruction/concealment of the material evidence. It permits the applicant and his lawyers to enter the defendant's premises to search, seize and make copies of the relevant material. *Anton Piller* orders are concerned with the substantive cause of action against the defendant. The *Norwich Pharmacal* order is different in that the respondent is not being compelled to allow search for evidence that may be used against the respondent as such. The order (at least as originally developed) is limited to the identity of the third party wrongdoer.⁴⁷ This is not to say that the strength of the case is irrelevant. Once the threshold of a good arguable case of infringement by the wrongdoer is met, the strength of the case may be relevant (as one factor) to the exercise of the court's discretion. As Lord Reid put it: the court should only grant the order if satisfied that there is no substantial chance that an injustice will be done.⁴⁸

(f) Factors relevant to the exercise of the discretion to grant the relief includes the strength of the case against the wrongdoer, the nature of the relationship between the wrongdoer and the respondent and, it is suggested, the nature of the wrongdoing and the harm suffered by the applicant. There are torts and then there are torts: some may cause severe harm to the applicant, others may be far less serious.⁴⁹ Another important factor will be whether the applicant has any other

47 Note also that the threshold for *Mareva* injunction (pre-trial *in personam* order over the defendant's personal assets to prevent the defendant making himself judgment proof) appears to be founded on a strong or good *prima facie* case.

48 See also *Eli Lilly v Neopharma Ltd* [2008] EWHC 415 where the court held that there is a power to order disclosure of names of customers where those customers are *arguably* wrongdoers.

49 See, for example, the discussion in *Sheffield Wednesday Football Club Ltd v Hargreaves* [2007] EWHC 2375 (different levels of defamatory statements and the view that a *Norwich Pharmacal* order may be disproportionate and unjustifiably intrusive in some cases).

means for acquiring the identity of the wrongdoer as well as the degree of inconvenience that the respondent will be put to if the order is made.

(g) In the normal case, a successful applicant will be required to pay the costs of the respondent.

C. *Impact of the Human Rights Act 1998 and the European Convention on Human Rights and Fundamental Freedoms*

95 The last ten years or so have seen a spate of cases before the English courts and also the European Court of Human Rights on the extent to which English law is consistent with the ECHR. In brief, and as noted already, Arts 8 and 10 specifically recognise individual rights to privacy as well as freedom of expression. The rights in the ECHR, however, are not absolute and there is a clear need to balance conflicts between the rights by reference to a principle of proportionality. Neither the right of privacy or freedom of expression has automatic pre-eminence although, on the facts of any individual case, where both are engaged, one right may be of greater significance than the other.

96 In addition, the UK also has special statutory provisions in the Contempt of Court Act 1981. Section 10 of that Act provides that no court is to require a person to disclose the source of information contained in a publication for which he is responsible unless this is necessary in the interests of justice or national security or for the prevention of disorder or crime. In *Ashworth Hospital Authority v MGN Ltd* (“*Ashworth*”),⁵⁰ Lord Woolf explains that s 10 has the purpose of enhancing freedom of the press by protecting journalistic sources. However, even s 10 is not sacrosanct for as Lord Woolf points out:

The judge’s task will always be to weigh in the scales the importance of enabling the ends of justice to be attained in the circumstances of the particular case on the one hand against the importance of protecting the source on the other hand. In this balancing exercise it is only if the judge is satisfied that disclosure in the interests of justice is of such preponderating importance as to override the statutory privilege against disclosure that the threshold of necessity will be reached.⁵¹

97 In the *Ashworth* case, the applicant was a hospital seeking a *Norwich Pharmacal* order against a newspaper which had published an

50 [2002] UKHL 29.

51 *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29 at 39. For discussion of the special policy arguments that arise where *Norwich Pharmacal* orders are sought against newspapers to compel disclosure of sources (essentially freedom of information/free press arguments), see Janice Brabyn, “Protection Against Judicially Compelled Disclosure of the Identity of News Gatherers’ Confidential Sources in Common Law Jurisdictions” (2006) 69(6) MLR 895.

article revealing confidential observations about a convicted murderer who had gone on a hunger strike. These observations had been placed into a database by staff at the hospital. The applicant wanted information as to who was the intermediary who had supplied the information to the journalist. The purpose was to try and identify the hospital staff member who had broken confidence by revealing the information to the intermediary. On these facts, a clash arose between the hospital's interest in seeking a remedy against the wrongdoer and the newspaper interest in protecting its sources in the name of freedom of speech (Art 10) and s 10 of the Contempt of Court Act 1981.

98 Was the disclosure by means of the *Norwich Pharmacal* order necessary, proportionate and such as to meet a "pressing social need"? What was the pressing social need to support the grant of the relief? The need was not simply the interests of the hospital in asserting its contractual rights against its disloyal staff member, it was also felt important to underscore the importance of safeguarding personal data, especially medical data. Respect for the privacy of medical data was of "fundamental importance" to a person's enjoyment of his/her right to respect for private and family life. Lord Woolf had no doubt that this was the case. Indeed, his Lordship cited the decision of the European Court in *Z v Finland*⁵² that respecting confidentiality of health data "was crucial not only to respect the sense of privacy of a patient but also to preserve his or her confidence in the medical profession and in the health services in general". Lord Woolf concluded in words that bear repeating:

The care of patients at Ashworth is fraught with danger and difficulty. The disclosure of patients' records increases that danger and difficulty and to deter the same or similar wrongdoing in the future it is essential that the source should be identified and *punished*. This was what made the orders proportionate and justified... The source's disclosure was wholly inconsistent with the security of the records and the disclosure was made worse because it was purchased by a cash payment.⁵³ [emphasis added]

99 The *Ashworth* case is immensely important in the UK for it signals a judicial willingness to develop and expand the *Norwich Pharmacal* jurisdiction. It is significant for a number of reasons:

52 (1998) EHRR 371 at 95.

53 *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29 at 66. See also Lord Hobhouse in the same case at para 73 that the *Norwich Pharmacal* jurisdiction was consistent with the ECHR provided that it is only used to obtain disclosure of journalist sources when it is proportionate to do so. See also a paper by Bellamy & Dunlop, "Norwich Pharmacal Proceedings and Human Rights" available at: http://www.39essex.co.uk/documents/JB_RDU_Norwich_Pharmacal_paper_060207.pdf (accessed 16 August 2008).

- (a) First, for rooting the jurisdiction on the public interest in seeing that justice is done by granting the discovery order so that the victim can seek a remedy in the law.
- (b) Second, because of the acceptance that the remedy may not necessarily be initiation of civil proceedings: it can also include self-help legal action such as termination of a contract with the wrongdoer and initiation of criminal proceedings (possibly by means of a private prosecution).
- (c) Third, because it is strong English authority to the effect that the *Norwich Pharmacal* order is not inconsistent with the ECHR or the English Contempt of Court Act. Even journalists who may have a strong claim to protect sources (freedom of expression) may be subject to disclosure orders where this is necessary and proportionate.
- (d) Fourth, because the decision underscores the importance of medical confidentiality even where the patient is a criminal who has been convicted of murder.
- (e) Fifth, because it demonstrates how obligations of confidentiality/privacy may be protected in appropriate cases through judicious use of the *Norwich Pharmacal* jurisdiction. On the facts of *Ashworth*, the claim by the journalist to protect the “confidentiality” of his sources as part of his assertion of free speech was outweighed by the need to safeguard the confidentiality interests of the hospital and of course the public interest in keeping medical records confidential and private.

100 Important though the *Ashworth* case is, it did not, however, address the interface between IPR and discovery of the identity of the wrongdoer in the light of the privacy provisions in Art 8 of the ECHR. But there is now the very important decision of the European Court of Justice (“ECJ”) in the case of *Productores de Musica de Espana Promusicae v Telefonica de Espana (“Espana”)*⁵⁴ on discovery and European Community law.

101 *Espana* concerned an application by a Spanish music organisation (applicant) which appears to represent the interests of music copyright owners in respect of use of music on the Internet. The complaint was that Spanish internet subscribers who had used the services of a Spanish ISP (respondent) had committed copyright infringement by downloading and distributing songs using P2P software. The problem was that whilst the applicant knew the IP addresses of the subscribers and the date and time when the internet connection and downloads had occurred, they were unable to see

54 Judgment of the Court (Grand Chamber), 29 January 2008. Case C-275/06.

behind the IP address so as to identify the subscribers whose internet account had been used. Without this information, it would have been very difficult, if not impossible, to enforce the copyright. The respondent refused to supply the information on the basis that Spanish law only permitted such disclosures in criminal investigations or in matters of public security and national defence. In this context, the applicant referred the matter to the ECJ for a ruling as to whether EU Member States were bound, in order to ensure the effective protection of copyright, to recognise an obligation to communicate personal data for use in civil proceedings.

102 The European Community Law framework behind the reference is complex involving several EU Directives:

- (a) Directive 2000/31/EC: Legal Aspects of Information Society Services (E-Commerce).
- (b) Directive 2001/29/EC: Harmonization of Copyright and Information Society.
- (c) Directive 2004/48/EC: Enforcement of Intellectual Property Rights.
- (d) Directive 1995/46/EC: Data Protection
- (e) Directive 2002/58/EC: Personal data and privacy.

103 *The E-Commerce Directive (2000)* is concerned with the proper functioning of the internal market by ensuring the free movement of information society services between the Member States. To this end, it sets out provisions relating to the establishment of service providers, commercial communications, electronic contracts, the liability of intermediaries, codes of conduct, out-of-court dispute settlements, court actions and co-operation between Member States.

104 Article 15(1) provides that there is no general obligation on ISPs to monitor the information which they transmit or store, nor a general obligation actively to seek facts or circumstances indicating illegal activity. Article 15(2) then goes on to state that: "Member States may establish obligations for information society service providers promptly to inform the competent public authorities of alleged illegal activities undertaken or information provided by recipients of their service or obligations to communicate to the competent authorities, at their request, information enabling the identification of recipients of their service with whom they have storage agreements."

105 *The Harmonization of Copyright and Information Services Directive (2001)* is primarily about legal protection of copyright and related rights in the context of the development of the EU internal market with particular emphasis on the information society. The

Directive deals with matters ranging from the nature and range of exclusive rights to be granted to copyright owners such as reproduction, communication and/or making available to the public, distribution, exceptions and limitations, protection of technological measures and rights-management information and so forth. Of especial importance were the provisions in Art 8 on sanctions and remedies and the requirement that Member States were to provide remedies and sanctions which would be effective, proportionate and dissuasive. It is also provided that the Directive is without prejudice to (amongst other things) laws on confidentiality and privacy.

106 *The Directive on Enforcement of Intellectual Property Rights (2004)* deals with measures, procedures and remedies necessary to ensure enforcement of IPR. As in the case of the 2001 Harmonization Directive, measures are required that will be effective, proportionate and dissuasive. In particular, Art 8 states that judicial authorities in Member States may order information on the origin of goods and services to be provided, *inter alia*, by a person who was involved in the provision of the services. Once again, this is without prejudice to laws governing confidential information or the processing of personal data.

107 *The Data Protection Directive (1995)* requires Member States to protect the fundamental rights and freedoms of natural persons especially in respect of their claim to privacy and the processing of personal data. Personal data refers to any information relating to an identified or identifiable natural subject. Article 13 allows Member States to adopt legislative measures to restrict certain rights when the restriction is necessary to safeguard, *inter alia*, the prevention, investigation, detection and prosecution of criminal offences or of breaches of ethics for regulated professions as well as for the protection of the rights or freedoms of others.

108 *The Directive on Privacy and Electronic Communications (2002)* has a similar general objective (protecting privacy and personal data) but with special reference to the electronic communication sector. These include duties to protect the confidentiality of the communications. Article 15 allows restrictions to some of the rights where the restriction is necessary, appropriate and proportionate to safeguard, *inter alia*, national security, investigation of criminal offences or of unauthorised use of the electronic communication system.

109 Given the above framework, was there an obligation on Spain under EU law to provide a procedure whereby IPR holders can obtain the identity and real world addresses of internet service subscribers whose IP address had been used in connection with copyright infringement by means of the Internet? Under Spanish domestic law, it appeared that communication of the requested information was only

permitted in connection with criminal investigations or for purposes connected with public security or national defence. Was this consistent with the requirements of Community law? The ECJ accepted that there was nothing in the 2002 Directive that compelled Spain to lay down an obligation to disclose information in the context of civil proceedings. Spanish law was, therefore, consistent with Community Law. This did not mean, however, that Member States could not choose to introduce such a provision as the ECJ also held that the 2002 Directive “did not preclude the possibility for the Member States of laying down an obligation to disclose personal data in the context of civil proceedings”.

110 The question then arose as to whether Community IP law which after all did require effective protection of IP would demand or permit the creation of such an obligation. On this, the ECJ again came to the view that there was nothing in the copyright Directives or indeed TRIPS that compelled Member States to lay down an obligation to communicate personal data in the context of civil proceedings. However, this did not mean that a Member State could not introduce or develop such an obligation. This could be done so long as a proportionate and balanced approach was taken in respect of the competing interests: the property interests of the right holder, the right to effective judicial protection as weighed against the fundamental right of protection for personal data and private life.⁵⁵

111 On this basis, whilst the copyright owners effectively lost in Spain, the decision of the ECJ supports or at least permits other Member States such as the UK to require disclosure of names and addresses of internet subscribers in an attempt to provide effective remedies – provided that a balanced and proportional approach was taken that takes account of the competing privacy interests at stake. Whilst there has yet to be a decision by the ECJ on the compatibility of the *Norwich Pharmacal* jurisdiction (as applied to internet subscriber identity), there is every reason to believe that the balancing exercise to be carried out within the equitable (discretionary) nature of the relief will be found consistent with Community law. Further, it seems to follow that the balanced approach taken by *Norwich Pharmacal* is also consistent with the ECHR.

112 Indeed, there have been cases before the English courts where *Norwich Pharmacal* orders were sought in the context of defamation

55 Note that Advocate General Kokott in his Advisory Opinion (18 July 2007) took a different view, namely, that Community law only permitted communication of personal data traffic to competent state authorities and not directly to copyright holders who wished to commence civil proceedings. For an interesting online discussion as to whether IP addresses are in themselves personal information, see <http://googlepublicpolicy.blogspot.com/2008/02/are-ip-addresses-personal.html> (accessed 16 August 2008).

proceedings in respect of material hosted on Internet websites. In *Totalise plc v Motley Fool Ltd*,⁵⁶ the applicant was an English ISP whose complaint was that websites operated by the defendants and which hosted discussion boards (open to the public) contained defamatory material posted by an anonymous contributor called “Z Dust”. The applicant sought a *Norwich Pharmacal* order to compel the website operators to disclose the identity of Z Dust. Neither defendant disputed the applicability of the *Norwich Pharmacal* jurisdiction: what was in issue was whether the court should exercise its discretion in favour of the applicant.

113 One website operator took a neutral stance that whilst it neither consented to nor opposed the application it was concerned over the impact of disclosure on its obligation to protect the privacy of the information in question.

114 The second website operator objected to the order on the basis of its obligations under the Data Protection Act and the privacy policy incorporated into the terms and conditions of access to the website by members of the public. These terms were said to prohibit disclosure of personal details about any account holder to a third party in these circumstances.

115 At first instance, Owen J decided in favour of the application even though the applicant did not know at this stage whether it would in fact launch civil proceedings against the wrongdoer. An attempt by one of the website operators to assert that the applicant was effectively on a fishing expedition failed. If the applicant was merely trying to find out if a wrong had been committed, that would be an abuse of the jurisdiction. But that was not the purpose of the application. As Owen J put it: “... the problem facing the claimant is that it does not know, and has no means of discovering the identity of Z Dust. If and when the identity of Z Dust is established it will be necessary for the claimant to consider with its legal advisers the most effective means of protecting its legal rights. That may or may not involve legal proceedings.”⁵⁷

56 [2001] EWCA 1897.

57 As for the argument that s 10 of the Contempt of Court Act 1981 only allowed disclosure in the technical sense of administration of justice in the course of legal proceedings, Owen J opined that this was too narrow a reading. What was required was disclosure in the interests of justice: that persons should be enabled to exercise important legal rights and to protect themselves from serious legal wrongs, whether or not resort to legal proceedings in a court of law would be necessary to attain these objectives. In any case, s 10 of the 1981 Act was only concerned with protection of journalist sources and that it was directed towards resolving tensions between the public interest in a free press and in enabling justice to be attained by a party seeking to enforce or protect its legal rights. Owen J explains that a journalist is responsible at law for the material which he publishes. The operators of the website did not take responsibility and exercised no editorial control over material
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116 Whilst the website operators had a policy of confidentiality with regard to the personal information of those using its websites, the court had no doubt that the balance of interests, on the facts, came down in favour of granting relief. “To find otherwise would be to give the clearest indication to those who wish to defame that they can do so with impunity behind the screen of anonymity made possible by the use of websites on the Internet.”⁵⁸

D. The Hong Kong position: Norwich Pharmacal and identity of subscribers

117 The leading decision is that of Ma J. (as he then was) in *A Co v B Co*.⁵⁹ In that case, a *Norwich Pharmacal* order was sought to assist the applicant in respect of tracing claims. The applicant was a US company in the footwear business and who had engaged one SB as its Vice President of Global Sourcing. Evidence was put before the court which pointed to SB receiving secret commissions in respect of his work and that these had been deposited into an account opened at the defendant’s bank. In short, the court was satisfied that there was “clear evidence of a breach of fiduciary duty on the part of SB on a very significant scale”. The defendant had become involved in the wrongdoing as “monies

posted. That being so, s 10 was not relevant to the case at hand. As for the Data Protection Act 1998, s 35 allows disclosure of personal data in connection with legal proceedings including prospective legal proceedings. This essentially preserved the *Norwich Pharmacal* jurisdiction. On potential substantive liability of an ISP for defamatory material hosted on a website by users when the ISP had knowledge of the content, see *Godfrey v Demon Internet Ltd* [2001] QB 201. See also a successful claim in *Sheffield Wednesday Football Club Ltd v Hargreaves* [2007] EWHC 2375.

58 Much of the material posted was clearly defamatory and the applicant had established a strong *prima facie* case against Z Dust. Owen J also ordered the defendants to pay the costs of the application. On appeal, the decision on costs was reversed. The Court of Appeal held that the normal rule in *Norwich Pharmacal* applications is that the applicant should pay the costs of the disclosing party including the costs of disclosure. This was because the proceedings were not truly adversarial. Whilst in some cases it may be appropriate to award costs against the discloser, this was not so where: (a) the discloser had a genuine doubt as to whether the applicant was entitled to disclosure; (b) the discloser was under an appropriate legal obligation not to reveal the information or where the legal position was not clear or the party had a reasonable doubt as to the obligations; (c) the party could be subject to proceedings if the disclosure was voluntary; or (d) the party would or might suffer damage if it gave voluntary disclosure; or (e) the disclosure would or might infringe a legitimate interest of another. For other cases where *Norwich Pharmacal* orders have been granted against website administrators, see *Sunderland Housing Company and Peter Walls v Baines* (2006) decision of Eady J and discussed at: *Law in Business: Libel, Netting Slanders* at: <http://www.legalweek.com/Company/360/Navigation/18/Articles/130177/Law+In+Business+Libel+Netting+slanders.html> (accessed 16 August 2008). See also *Sheffield Wednesday Football Club Ltd v Hargreaves* [2007] EWHC 2375.

59 High Court, HK SAR 2002, HCMP336/2002.

which may well represent secret commissions have passed in and out of accounts held in the defendant bank in the names of companies associated with SB”.

118 Ma J in granting the relief made a number of significant observations of the scope and purpose of the *Norwich Pharmacal* jurisdiction:

(a) The jurisdiction is founded in equity and is essentially concerned with the duty of innocent persons who have become caught up or involved in tortious or wrongful activities of others (in the sense of facilitation) to assist the victim of the tort or wrongful activities by provision of *full information*.⁶⁰

(b) The jurisdiction is a wide one and is not restricted to disclosures of names of wrongdoers.⁶¹

(c) Though founded on notions of justice, the relief is extraordinary and one which should not be granted lightly. “Powerful factors” were said to be needed because of the characteristics (effect) of the order. These included the very salient point that there will often be a legal relationship between the innocent party (the bank) and the wrongdoer (bank customer) which involves strict duties to be observed on the innocent party’s part. Disclosure of customer information outside of a court order might expose the innocent party to civil and/or criminal liability (including breach of confidentiality).

(d) There must be “cogent and compelling evidence” to demonstrate that “serious tortious or wrongful activities have taken place. Where allegations of fraud (and similar serious allegations) are made, the degree of proof must correspondingly be high.”⁶²

60 This is significant because originally the jurisdiction was confined to information as to the identity and address of the wrongdoer. On the facts, the applicant knew who the wrongdoer was: what was needed was assistance to trace where the funds have been moved to so as to mount tracing claims by way of restitutionary relief.

61 Citing the English case of *Bankers Trust Co v Shapira* [1980] 1 WLR 124. See also *Carlton Film Distributors Ltd v VDC Ltd* [2003] EWHC 616 and also *Mitsui & Co Ltd v Nexen Petroleum UK Ltd* [2005] EWHC 625 per Lightman J that the *Norwich Pharmacal* relief was a flexible remedy capable of adaptation to new circumstances.

62 This is an important point as it relates to the threshold standard required (proof of wrongdoing) to activate *Norwich Pharmacal* jurisdiction. Indeed, this became a point of contention in the *Odex* case in Singapore. Note that Ma J was not necessarily holding that the standard required is the same as is needed in *Anton Piller* cases (extremely strong *prima facie* case). Indeed, later on in his judgment, the learned judge observed that to some extent all applications for *Norwich Pharmacal* relief involve the plaintiff fishing for information and he also noted that in *P v T Ltd* [1997] 1 WLR 1309, the court granted the order even though it could not be ascertained without the information sought whether or not a third party
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(e) It must be demonstrated that the order “will or will likely reap substantial and worthwhile benefits for the plaintiff”. In the case of information for tracing claims, there must be a serious possibility that the discovery will allow the plaintiff to preserve or to discover the whereabouts of his assets.⁶³

119 More recently, the HK courts have considered the availability of *Norwich Pharmacal* relief in two related cases that concern identity of subscribers to internet services. Both of these cases involve infringement of copyright in musical works on the Internet through use of P2P technology. Would the HK courts set aside the cloak of anonymity and compel the ISPs to reveal the identity of the subscribers whose IP addresses were associated with the infringements? Unsurprisingly, the ISPs were concerned that if they voluntarily made disclosure they would be exposed to liability under the Personal Data (Privacy) Protection Ordinance as well as be in breach of the confidentiality provisions set out in their internet licences granted by the Telecommunications Authority.

120 The first was the decision of Poon J in *Cinepoly v Hong Kong Broadband Network Ltd.*⁶⁴ Given that the threshold standard (described by Ma J) had been met, should the discretion be exercised in favour of relief? The principal counterbalancing interest was the right of the subscribers to protect their personal data under the Data Protection legislation.⁶⁵ Important though this legislation was, Poon J rightly underscored the principle that the protection afforded was not absolute. A balance had to be struck between administration of justice and protection of privacy in personal data.⁶⁶ In granting the relief, Poon J made some general observations on internet piracy by way of a timely reminder. These are worth repeating. The learned judge states:

had committed a tort against the plaintiff. In England, it seems that the test is whether a wrong has been carried out or arguably carried out by the wrongdoer. *Mitsui & Co Ltd v Nexen Petroleum UK Ltd* [2005] EWHC 625 and *Hughes v Carratu International plc* [2006] EWHC 1791.

63 Citing the English case of *Arab Monetary Fund v Hashim (No 5)* [1992] 2 All ER 911.

64 HCMP 2487/2005. The second case is *Cinepoly v HK Broadband* HCMP 943/2006 (Chan J).

65 The other interest was the confidentiality obligation set out in its telecommunications licence. Poon J found that where an innocent person makes discovery voluntarily under *Norwich Pharmacal* principles, whether voluntarily or compelled by the court exercising its equitable jurisdiction, the discovery is authorised and required by the law.

66 Section 58(1)(d) of the Personal Data (Privacy) Protection Ordinance (Cap 486) in particular exempted disclosure in connection with the prevention, preclusion or remedying (including punishment) of unlawful or seriously improper conduct or dishonesty or malpractice by persons.

The Internet is invaluable and even indispensable, some would suggest to the free communication, dissemination and sharing of information in modern societies. For my part, I have no intention whatsoever to restrict, obstruct or otherwise frustrate the free flow of communication and information on the Internet. My determination in this action does not and should not be understood to have such effect. What I do hope is that it can serve as a timely reminder. Users of the Internet, like any individuals, must abide by the law. And the law protects users' rights as much as others' legitimate rights, including those of copyright owners. Some online copyright infringers may well think that they will never be caught because of the cloak of anonymity created by the P2P programs. They are wrong. And from now on they should think twice. They can no longer hide behind the cloak of anonymity. The court can and will upon a successful application pull back the cloak and expose their true identity. It is not an intrusion into their privacy. It does not even lie in their mouths to say so. For protection of privacy is never and cannot be used as a shield to enable them to commit civil wrongs with impunity.

121 The Hong Kong courts clearly have embraced and developed the *Norwich Pharmacal* jurisdiction in a way that recognises the difficulty that IPR owners have encountered in enforcing their rights against internet users.

E. Norwich Pharmacal: *The Singapore position and the Odex litigation*

122 Substantial reference to *Norwich Pharmacal* jurisdiction in Singapore arose in 1992 when Chan Sek Keong JC (as he then was), in discussing the existence and basis of the *Anton Piller* jurisdiction (pre-trial preservation of evidence), noted the relationship between the two forms of relief. The point being made was that the *Anton Piller* order whilst originally concerned with preservation of evidence of liability had since expanded to include a secondary purpose: namely, to obtain evidence with a view to bringing proceedings against third parties who might also be involved in the infringements. In this way, it was said that the *Anton Piller* jurisdiction was itself founded on the right to discovery of information which had been revived in England by the decision in *Norwich Pharmacal*.⁶⁷ If the Singapore courts accepted an *Anton Piller*

⁶⁷ *Reebok International Ltd v Royal Corp* [1992] 2 SLR 136. Since then, there have been a number of Singapore cases involving *Norwich Pharmacal* relief including: *KLW Holdings Ltd v Singapore Press Holdings Ltd* [2002] 4 SLR 417 (decision of Choo Han Teck JC as he then was); *Re E* [2003] SGDC 84 (decision of District Judge Lim); *UMCI Ltd v Tokio Marine & Fire Insurance Co* [2006] 4 LR 95 (decision of Sundaresh Menon JC as he then was) and of course *Odex Pte Ltd v Pacific Internet Ltd* [2007] SGDC 248 (District Judge Earnest Lau) and also [2008] 3 SLR 18 (Woo Bih Li J.) Note that in *Abraham v Law Society of Singapore* [1991] 3 MLJ 359, Rajendran J held that the Rules of the Supreme Court 1970 only allowed
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jurisdiction, did it not follow by necessary implication that a *Norwich Pharmacal* jurisdiction also existed?

(1) *Source/nature of Norwich Pharmacal jurisdiction in Singapore*

123 It has been said that the *Norwich Pharmacal* jurisdiction in England originated in the old Chancery Bill of Discovery, the purpose of which was to enable A to obtain information from B to pursue his remedies against C.⁶⁸ The common law courts lacking the power to order pre-trial discovery, litigants before the courts of common law had to turn to the Court of Chancery for equitable orders of discovery, inspection and interrogatories.⁶⁹ Equity not only spawned equitable principles/doctrines that affected the substantive rights of parties such as the trust, equitable ownership, fiduciary duties, obligations of confidence and equitable remedies such as accounting of profits, it also developed procedures such as discovery to aid litigants. In this way, it appears that the guiding spirit, that conscience is equity, gave birth to a mix of substantive as well as procedural innovations.

124 In terms of its substantive law, Singapore can trace much of its law all the way back to the Second Charter of Justice (1826). The Second Charter set up a new court system for Singapore, Penang and Malacca and was directed to hear cases according to “justice and right”: an expression that was interpreted to refer to the law of England.⁷⁰ English law (common law and equity) became part of the fabric of Singapore law.⁷¹

125 If the Chancery Bill of Discovery is properly regarded as a “cause of action” that affects the substantive rights of individuals (as for example the concept of trust), a case might be made for saying that the

discovery where there was a cause or matter pending and that the *Norwich Pharmacal* decision was of little assistance as s 18 of the Supreme Court of Judicature Act (Cap 322, 1985 Rev Ed) allowed the High Court to order discovery only in accordance with written law or Rules of Court. No argument appears to have been made as to the possibility of an inherent jurisdiction to grant *Norwich Pharmacal* relief.

68 *Reebok International Ltd v Royal Corp* [1992] 2 SLR 136 at [19] *per* Chan Sek Keong JC (as he then was).

69 Graphically described by Sir Jack I H Jacob as “scraping the conscience of the defendant” in his work: *The Fabric of English Civil Justice* and quoted by the District Court of Singapore in *Odex Pte Ltd v Pacific Internet Ltd* [2007] SGDC 248.

70 *R v Willans* (1858) 3 Ky 16 at 37.

71 See also Helena Chan, *The Legal System of Singapore* (Butterworths, 1995) at p 19 that s 3 of the Application of English Law Act (Cap 7A, 1994 Rev Ed) provides that English common law and equity so far as it was a part of Singapore law immediately before the commencement of the Act continued to be part of the law of Singapore subject to a “local circumstances” type proviso. Reception of English rules of equity effectively dates back to the Second Charter of Justice.

Second Charter of Justice is the source of the applicability of that equitable principle in Singapore.⁷²

126 But, on the other hand, as seems much more likely, at least at first glance, the *Norwich Pharmacal* jurisdiction may be regarded as a procedural innovation in aid of a cause of action established by reference to some other substantive right, such as those within tort law. If so, then it seems that the source of the Singapore courts' power to grant *Norwich Pharmacal* discovery orders would have to be found in the "constitutional" documents of the current Singapore court system.

127 The current superior court system (High Court and Court of Appeal) in Singapore derives from the Supreme Court of Judicature Act.⁷³ Section 18 provides that the High Court shall have such powers as are vested in it by written law in force in Singapore including those set out in the First Schedule. This in turn leads us to r 12 which in its current form provides that the High Court has the power *before or after* any proceedings are commenced to order discovery of facts or documents by any party to the proceedings or by any other person in such manner as may be proscribed by Rules of Court (emphasis added).

128 Order 24 rule 6 now contains specific provisions dealing with discovery against other persons. It provides that: "An application for an order for the discovery of documents before the commencement of proceedings shall be made by originating summons and the person against whom the order is sought shall be made defendant to the originating summons."

129 Order 24 rule 6(5) then states: "An order for the discovery of documents before the commencement of proceedings or for the discovery of documents by a person who is not a party to the proceedings may be made by the Court for the purpose of or with a view to identifying possible parties to any proceedings in such circumstances where the Court thinks it just to make such an order, and on such terms as it thinks just."

130 Finally, O 24 r 7 provides that: "On the hearing of an application for an order under Rule 1, 5 or 6, the Court may, if satisfied that discovery is not necessary, or not necessary at that stage of the cause or matter, dismiss or, as the case may be, adjourn the application and

72 *Norwich Pharmacal v Customs and Excise Commr* [1973] 3 WLR 164. In argument, counsel for the applicants asserted that there was a long line of English case law supporting discovery of the name of a prospective litigant starting with *Heathcote v Fleete* (1702) 2 Vern 442 and also the 1876 decision of *Orr v Diaper* (1876) 4 Ch D 92.

73 Supreme Court of Judicature Act (Cap 322, 2007 Rev Ed).

shall in any case refuse to make such an order if and so far as it is of opinion that discovery is not necessary either for disposing fairly of the cause or matter or for saving costs.”

131 In the *Odex* case, the District Court explained that the provisions on discovery against other persons found in O 24 r 6 date back to legislative amendments made in 1993 and that “pre-action discovery of wrongdoer identity was codified in what is now O 24 r 6(5)”.

132 Important though O 24 r 6(5) clearly is, the question of a “lingering” *Norwich Pharmacal* jurisdiction that flows from the inherent power of the court to control its court procedure so as to achieve justice remains; after all what if the applicant seeks information that is designed to enable him to formulate his case against a known defendant or to take/initiate appropriate criminal proceedings or to simply take appropriate self-help disciplinary proceedings against the wrongdoer?

133 Does the Singapore High Court retain an inherent jurisdiction at least over its own procedure? This is an important question that deserves full airing. Fortunately, there are the seminal articles of Professor Pinsler to which readers are referred for a thorough analysis of the question.⁷⁴ For our purposes, it is perhaps enough to point out that the existence of an inherent jurisdiction has been accepted by the Singapore High Court in at least two recent decisions.

134 The first is the decision of Phang J (as he then was) in *Wellmix Organics (International) Pte Ltd v Lau Yu Man*.⁷⁵ This case which concerned the interpretation and enforcement of “unless consent orders” raised an issue over whether the court retained a residuary discretion over the enforcement of such an order. Phang J. had no doubt that such a residuary jurisdiction existed. To begin with, the learned judge agreed that the existence of such a jurisdiction drew support from “the inherent powers of the court to govern what is, in the final analysis, procedure that is peculiar to the governance of its own process – all with a view towards attainment of both procedural as well as substantive justice”. Further support for the recognition (*cf* source) of inherent jurisdiction was said to be found in the saving provisions of O 92 r 4 which expressly refers to the inherent powers of the court to make orders to prevent injustice or to prevent abuse of process.⁷⁶ Whilst it has

74 Pinsler, “The Inherent Powers of the Court” [1997] SJLS 1; Pinsler, “Inherent Jurisdiction Revisited: An Expanding Doctrine” (2002) 14 SAcLJ 1.

75 [2006] 2 SLR 117.

76 Earlier cases on inherent jurisdiction referred to include: *Four Pillars Enterprises Co Ltd v Beiersdorf Aktiengesellschaft* [1991] 1 SLR 737; *Tan Kok Ing v Tan Swee Meng* [2003] 1 SLR 657; *Wee Soon Kim Anthony v Law Society of Singapore* [2001] 4 SLR 25; and *Roberto Building Material Pte Ltd v OCBC* [2003] 2 SLR 353.

been said that O 92 r 4 does not confer a *carte blanche* to create any procedural device that it thinks fit, there is strong support for a limited inherent jurisdiction that can be invoked in exceptional cases where there is a clear need for it and the justice of the case so demands.

135 The second is the decision of S Menon JC (as he then was) in *UMCI Ltd v Tokio Marine & Fire Insurance Co (Singapore) Pte Ltd*.⁷⁷ In this case, the learned Judicial Commissioner stated that: “The Rules of Court ... spell out many of the powers of our courts to manage and regulate civil cases. The powers contained there are complemented by the courts’ inherent jurisdiction, an amorphous source of power to do that which is deemed appropriate in the circumstances to secure the ends of justice.” The court agreed that the touchstone for exercising an inherent jurisdiction is one of necessity, as assessed in a sensible manner in respect of all the circumstances of the case. The court also observed that the procedure set out in O 24 r 6 overlaps with the *Norwich Pharmacal* jurisdiction and it also accepted that if the application fell outside the scope of the O 24 r 6 that the court might be able to exercise an inherent jurisdiction to make the order requested.⁷⁸

136 Given these decisions, the approach taken in the *Odex* litigation in Singapore was to first examine whether the application fell within O 24 r 6. Alternatively, if the application fell outside of O 24 r 6, the question was whether it was necessary to exercise the residual inherent *Norwich Pharmacal* jurisdiction in the circumstances before the court.

(2) *Who has the right to seek discovery under O 24 r 6 and/or Norwich Pharmacal in Singapore? The locus standi issue*

137 The crux of the issue here was whether it was necessary for the applicant to establish that it had the legal right to initiate legal proceedings against the wrongdoers for the wrongdoing that lay at the heart of the application. Alternatively, would it be sufficient if the applicant was an interested party (in the sense that its economic interests were at stake) and that they intended to pass the information to the persons who had sufficient legal status to initiate proceedings?

138 Both the District Court and the High Court came to the view that the applicant had to establish that it possessed the necessary standing to bring proceedings for the wrongdoing in question. In the case of O 24 r 6, the District Court noted that O 24 did not apply to

77 [2006] 4 SLR 95.

78 Note that S Menon JC, referring to the English *Mitsui* decision of Lightman J underscored the fact that the *Norwich Pharmacal* jurisdiction had been extended to cover a variety of situations and that those categories are not closed. *Mitsui & Co Ltd v Nexen Petroleum UK Ltd* [2005] EWHC 625

criminal proceedings. Thus, the fact that the information might be helpful for a prosecution for copyright infringement was irrelevant. What was needed was a connection to relevant civil proceedings.

139 The difficulty here was that the right to bring proceedings for copyright infringement under the Copyright Act of Singapore⁷⁹ is given to the copyright owner and his exclusive licensee.⁸⁰ A non-exclusive licensee is not given a statutory right of suit even though his commercial interests (in the non-exclusive licence) will depend on effective legal action being brought against the infringers.

140 If Odex was neither the copyright owner nor the exclusive licensee of the *anime* titles in question, could it claim on behalf of the copyright owners on the basis that it was an agent or representative of the owners? Before the District Court, it appears that the application was formulated on the basis that Odex was applying in its own right as a licensee. In only one instance did it appear that Odex was an exclusive licensee. That being so, the application failed in most of the cases because of lack of *locus standi*. In the one case where the District Court found that Odex was an exclusive licensee, the application failed as the District Court was not satisfied that a sufficiently strong case on infringement had been established.

141 On appeal, it was argued that the applications were in fact made by Odex as an authorised agent of the copyright owners and not in their capacity as a licensee. But, even if this was so, this did not help as the High Court held that Singapore law did not permit an agent of a copyright owner to apply in the agent's name for pre-action discovery in order to identify infringers. The reasons, in brief, were as follows.

142 First, whilst Art 16.9.22(b)(xi) of the US-Singapore FTA required Singapore to establish procedures to enable copyright owners to obtain expeditiously from an ISP, information identifying alleged infringers, there was nothing in that Article which related to applications by authorised agents.⁸¹

79 (Cap 63, 2006 Rev Ed).

80 See *Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck* [2007] 2 SLR 869.

81 References to statements made by the Singapore Government in respect of the FTA to persons acting on behalf of the copyright owner in respect of the notice take down procedure protecting ISPs were also found (rightly) to be irrelevant. But see Note 16-15 of the FTA which states that for the purpose of enforcement of IPR, right holder includes exclusive licensees as well as federations and associations having the legal standing to assert such rights. Does this help? Probably not since (i) the federation, *etc*, must have the legal standing to assert the right (which begs the question ...) (ii) the FTA is not self executing under Singapore law.

143 Second, whilst a practice direction⁸² had been issued which referred to applications for discovery “by or on behalf of an owner or exclusive licensee of copyright material against a network service provider for information relating to the identity” of an alleged infringing user, this practice direction did not and could not purport to create additional rights since practice directions did not have the force of law and were merely directions issued for administrative purposes.⁸³

144 Third, under the Copyright Act (and its regulations) there is no provision allowing an agent to apply for discovery on behalf of the copyright owner.

145 Tricky issues also arose as to whether Odex could claim in its “capacity” as the victim of a crime that needed redress. The point has been made earlier that the English courts have extended the *Norwich Pharmacal* jurisdiction to include discovery of identity of wrongdoers in aid of possible criminal proceedings. It will be recalled that in *Ashworth Security Hospital v MGN Ltd* (“*Ashworth*”),⁸⁴ Lord Woolf stressed that the prosecution may achieve for the victim the very remedy that is needed and that new situations will arise where it will be appropriate for the jurisdiction to be exercised where it has not been exercised before. Fears that the jurisdiction might be abused in the sense of claims being brought by a person who is not a victim of the wrongdoing was best dealt with by confining the remedy to the victim of a crime. Clearly, the public interest would not support applications for *Norwich Pharmacal* orders under the Singapore court’s inherent jurisdiction where the applicant is a member of the public who has not been specifically impacted by the crime. But, as noted by Lord Woolf, the simple answer would be to confine the remedy to the victim of the crime.

146 Who then is the victim of a crime for these purposes? This is by no means an easy question to answer. It cannot be limited to the person who is entitled to bring parallel civil proceedings for the relevant tort. If this were so, what would happen if there was no civil right of action created by a statutory provision that imposes criminal liability? Would it make sense to limit the expansion of *Norwich Pharmacal* to criminal offences only when there was a parallel matching civil cause of action even though the victim does not intend to make use of his civil right of action? Neither can it mean any individual member of the public on the basis that all members of society are “victims” of a crime.

82 ePractice Direction 4 of 2005 on Discovery/Interrogatories and Network Service Providers.

83 Citing Lai Siu Chiu J in *BNP v Polynesia Timber Services Pte Ltd* [2002] 4 SLR 933 and also Pinsler, *Supreme Court Practice 2006* (Butterworths).

84 [2003] FSR 17.

147 The District Court comments that the *Ashworth* decision was an important one which gave victims of crime access to the civil courts for the purposes of identifying wrongdoers so that criminal action can be taken. District Judge Earnest Lau certainly accepts that if the victim of the crime also enjoyed a civil right of action in respect of the same wrongdoing that he would have sufficient *locus standi* to apply under O 24 r 6(5). The District Court felt that in such cases, the information could be used to initiate criminal proceedings.⁸⁵

148 But what if, as in the *Odex* case, the applicant has no *locus standi* to assert O 24 r 6(5) because he is a mere licensee of the copyright? Can such a person pray in aid of the residual inherent jurisdiction to grant *Norwich Pharmacal* relief on the basis of necessity and justice and because he is the victim of a crime? The District Court answered this in the negative because criminal prosecutions, it was said, had to be brought by “the Attorney General (either directly or by issue of a fiat) or the person aggrieved by the offence”.

149 On appeal, the High Court took a slightly different approach (because of the way the appeal was argued). Given that before the High Court, the applicant had argued that it made the application as agent of the copyright owners, Woo Bih Li J held that:

[I]t seemed to me that the agent is not the victim of the wrongdoing. Accordingly, under the *NP* jurisdiction as extended by *Ashworth*, assuming *Ashworth* to apply in Singapore, *Odex* would still not be the right party entitled to relief ...⁸⁶

150 A number of points arise on this conclusion. First, if the application proceeded on the basis that *Odex* was acting as agent for the copyright owner, would it follow that the equivalent assertion for extending the *Norwich Pharmacal* jurisdiction (outside O 24 r 6) is that “the victim of the crime” is to be taken as a reference in this context to the copyright owner? Second, is there not in any case some justification for regarding *Odex* as the victim of the crime (commercial copyright infringement)?

85 Applying *Microsoft Corp v SM Summit Holdings Ltd* [1999] 4 SLR 529, *Riddick v Thames Board Mills* [1977] QB 881 and *Ransome Tempil Inc v Romar Positioning* (Singapore High Court No 705 of 1990). The District Court felt that discovery information obtained in civil proceedings should not be subject to the *Riddick* principle provided the public interests in both criminal and civil proceedings are the same. The *Riddick* principle was explained by the District Court as preventing use of documents disclosed in criminal proceedings in unrelated civil proceedings. Reference should also be made to the decision of Chan Sek Keong J (as he then was) in *Reebok International Ltd v Royal Corp* [1992] 2 SLR 136.

86 *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [50].

151 The fact that Odex's legal status as the holder of a "non-exclusive contractual license" was insufficient to confer *locus standi* to sue in the civil courts for copyright infringement does not mean that they did not have a genuine commercial interest to stop the infringements over and above the interest that any law abiding member of the public has in seeing copyright law followed. If Odex had applied or intended to apply to the Attorney General for a fiat to prosecute the offenders (once identified) under the Copyright Act, would a fiat have been granted?⁸⁷

152 If a fiat could have been obtained under the provisions of the Criminal Procedure Code, would it be outside of the policy of the extended *Norwich Pharmacal* jurisdiction to grant the relief requested, especially given the "unique self help regime" in Singapore which places great responsibility on IPR owners to resort to the civil and criminal system to protect their rights? Of course, Odex were not the copyright owners; but then again, neither are criminal provisions intended only to protect the specific/direct victim of a crime.

153 These are hard questions that admit of no easy answer. The fact that a person has the right to lay a complaint that a crime has been committed cannot of course make that person a victim of the crime for these purposes. But does it follow that if *any* person can make a complaint that anyone is also entitled to seek a fiat to prosecute, and that if he/she does, that the fiat will be granted even though the complainant is not directly affected by the crime (over and above his position as a member of the public)? Will it make a difference if fiats are only granted in those cases where the applicant has a real interest (over and above the interest that any law abiding citizen has) in securing compliance with the criminal law? If so, might such a person be regarded as a victim with a sufficient connection so as to support an application under the extended *Norwich Pharmacal* jurisdiction?⁸⁸

87 Criminal Procedure Code (Cap 68, 1985 Rev Ed) s 336(4): "The public prosecutor or the Solicitor-General or a person appointed a deputy ... may authorize any advocate to act for him as Public Prosecutor in the conduct of any case or prosecution in court or in any part of such conduct." See also AIPPI Reports. Report Q169: Criminal law sanctions with regard to infringement of intellectual property rights (Singapore) available at: <http://www.aippi.org/> (accessed 16 August 2008). See also *The Enforcement of Intellectual Property Rights by Means of Criminal Sanctions: An Assessment*, by Louis Harms JA for the Advisory Committee on Enforcement, WIPO November 2007, WIPO/ACE/4/3.

88 If a thug stabs a person in the thigh resulting in a period of hospitalisation, the person stabbed is clearly a victim – but what then of his wife? Is she also a victim in the sense that she has an interest over and above that of any member of the public to see justice done? Similarly, given that Odex were the contractual licensee for Singapore, did they have a special interest such that they could be regarded as a victim of the copyright offences? If offences were committed by the subscribers under s 136(3A) of the Copyright Act (Cap 63, 2006 Rev Ed), it is at least arguable
(cont'd on the next page)

Would not the spirit of justice and respect for the law that underlies *Norwich Pharmacal* support grant of relief?

(3) *Possible law reform: The position of a copyright licensee in Singapore*

154 As matters currently stand, a non-exclusive contractual licensee of copyright subject matter appears to be in a rather “exposed” position in Singapore so far as copyright infringements are concerned. Such a licensee has no title sufficient to bring proceedings for copyright infringement and he also lacks any equitable title/interest that might enable him/her to apply for interlocutory relief. He may be able to lay a complaint before the authorities in those cases where the infringement involves commission of a crime but will not be able to pray in aid the extended *Norwich Pharmacal* jurisdiction to discover the identity of the wrongdoers. He can, of course, have recourse to his licensor and to persuade/require (depending on the terms of the licence) the licensor to sue for infringement and obtain injunctive relief (assuming the licensor is the copyright owner or the exclusive licensee). Whether substantial damages can be obtained given that the licensor may have suffered no loss is quite another matter. Is this a satisfactory position? Those who support less copyright and free or freer access to copyright subject matter online are likely to agree with the position. However, arguments for and against copyright control of subject matter on the Internet and private use take the debate to a different and higher plane. Given the existing copyright law, is there a case for strengthening the rights of non-exclusive licensees and, if so, how?

that Odex were victims (in a broad sense) in their own right. Note that the High Court also made the point that if Odex were allowed to obtain information for the purpose of criminal proceedings, then the court would have to confine the use to those criminal proceedings. But, see *Ransome/Tempil Inc v Romar Positioning Equipment* (Singapore High Court No 705 of 1990) and also *Reebok International Ltd v Royal Corp* [1992] 2 SLR 136. Would it be against the public interest to allow the identity information to be used by the copyright owners to sue for the parallel civil copyright infringement that founded the assertion of criminal wrongdoing? Although this is not an easy question to answer, a good argument can be made that the *Riddick* principle has limited application in such a case. See later for a fuller discussion. Finally, compare also the remarks in *OBG Ltd v Allan* [2007] 2 WLR 920 that an exclusive licensee of an IP right who finds that the value of his licence is reduced by the defendant’s infringing activity has no claim against the defendant for his losses under the economic torts of inducing breach of contract or causing loss through use of unlawful means as the exclusive licence is not as such interfered with. See Lord Hoffmann at 943, 944 and 960. Lord Walker at 994. Citing *RCA Corp v Pollard* [1983] Ch 135 and also *Isaac Oren v Red Box Toy Factory Ltd* [1999] FSR 785. However, the problem in those cases was that exclusive licensees under the Dramatic and Musical Performers Protection Act 1958 (“RCA”) and the Registered Designs Act 1949 did not enjoy a right of suit. Indeed, under the former, there was no civil cause of action at all. This does not mean that the licensees did not suffer direct real economic losses as a result of the defendants’ activities.

155 One possibility will be to grant a non-exclusive licensee a right of suit for copyright infringement. This is already the law in the UK. In 2003, the UK amended its copyright legislation so as to permit a non-exclusive licensee to bring proceedings for infringement in respect of an infringing act directly connected with a prior licensed act of the licensee.⁸⁹

156 Another possibility will be to directly address the issue of internet user/subscriber anonymity by introducing a specific statutory provision which allows the copyright owner or *a person authorised to act on the owner's behalf* to request an ISP to reveal the identity of alleged infringing subscribers.⁹⁰ Another approach may be to revisit the question as to whether *Norwich Pharmacal* jurisdiction extends to aiding the victim of a crime. If the Singapore Court of Appeal endorses this extension, then the issue as to who is a victim for this purpose will need careful examination.⁹¹

157 The question as to whether changes should be made in the light of the *Odex* litigation is unlikely to go away anytime soon; if anything, it may become more urgent in the context of the US-Singapore FTA. On this, it is perhaps worth mentioning that the International Intellectual Property Alliance ("IIPA") in its 2008 Special 301 Submission to the US Trade Representative ("USTR") has cited the *Odex* litigation as a point of concern. The IIPA makes a number of points. First, that in Singapore, it is generally hard to obtain information on infringing subscribers from ISPs as the latter insist on a court order before release of information. Does this meet the requirement of an "expeditious" mechanism for right holders to use? Second, complaint is also made of the fact that Singapore law does not at present allow representatives of the copyright owner to initiate civil proceedings. These are clearly difficult points

89 See now s 101A of the Copyright, Designs, Patents Act (UK) 1988. The licence must be in writing and must expressly grant the non exclusive licensee a right of action.

90 See, for example, s 512(h)(i) of the US Circular 92 Copyright Law of USA contained in Title 17 of the US Code and mentioned in *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [36]. Indeed, it appears that the concept of allowing a person to be authorised to act on behalf of the copyright owner is not alien to the US-Singapore FTA (see the correspondences referred to in the *Odex* case at [31] *et seq*).

91 Of course, another self-help measure will be to insist on an exclusive licence or assignment of the rights in issue or to join in the copyright owners/exclusive licensees. Requiring an exclusive licence or assignment instead of a non-exclusive licence depends on the bargaining position of the parties and a myriad of other commercial considerations. Requiring the copyright owner/exclusive licensor to assist by suing and enforcing the rights may work in some cases but not all. Often times, the copyright owner will be a foreign rights holder whose main interest in Singapore is exploitation via contractual licences. It may make far more sense in such a case for the non-exclusive licensee to be given a right of suit in his own name: a step which the UK took in 2003.

which may be taken up by the USTR at some stage. It should be said that the 2008 Special 301 Report did not in fact take up these points. Singapore was not listed in the 2008 Report. That said, it is perhaps understandable that Singapore's ISPs have taken a "cautious" approach on requests for information about subscribers. Given the uncertainties in the law and the existence of confidentiality/privacy obligations (whether contractual or in respect of regulatory telecommunication licence terms), it is not surprising that ISPs will require a court order before release of the information. Indeed, even in the UK, it is noted that the stance taken in some cases by website administrators is to insist on a court order whilst adopting a neutral stance in the application. ISPs and website administrators who are innocent of the commission of the wrongdoing by their subscribers naturally feel a "caught in the middle" syndrome.⁹²

(4) *The threshold to activate Norwich Pharmacal in Singapore*

158 In the *Odex* case, the District Court applied the standard required in *Anton Piller* applications: demonstration of an "extremely strong prima facie case of wrongdoing". On this basis, even if the applicant was an exclusive licensee for some of the copyright subject matter in issue, he held that there was insufficient proof of wrongdoing.⁹³ In coming to this conclusion, the learned District Judge stressed that the "plaintiff must put forward their best evidence for the Court to decide if there is a strong enough case of wrongdoing meriting the discovery order". This, with respect, must be right and where the evidence comprises use of technical software and usage analysis, some

92 In Hong Kong, Ma J (as he then was) in *A Co v B Co* HCMP336/2002 observed that where the innocent facilitator is in some legal relationship with the wrongdoer (as will usually be the case), any discovery made by the innocent party may well apart from a court order expose that innocent party to liability – civil or criminal and at the very least a breach of confidentiality. See also the discussion of a similar point in the context of costs in *Totalise plc v Motley Fool Ltd* [2001] EWCA 1897. At first instance, the judge had held that whilst the innocent party had to carry out a balancing exercise (within *Norwich Pharmacal*) that on the facts (perfectly plain defamatory postings) they should have complied with the requests made for the identity of the wrongdoer. But on appeal, the Court of Appeal came to a different view at para 28 that "it is legitimate for a party who reasonably agrees to keep information confidential and private to refuse to voluntarily hand over such information". That said, the position would be different if the party was actually implicated in the wrongful act. In Singapore, see also *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [62] where Woo Bih Li J makes the point that whilst Pacific Internet may have been subject to contractual and regulatory duties of confidence, it could not be seriously suggested that they would be in breach if it made disclosure pursuant to a court order. See also *Sheffield Wednesday Football Club Ltd v Hargreaves* [2007] EWHC 2375 where the defendant to a *Norwich Pharmacal* application (website administrator) neither opposed nor consented to the application (in respect of defamatory postings).

93 *Odex Pte Ltd v Pacific Internet Ltd* [2007] SGDC 248 at [25] *et seq.*

independent support as to the reliability of that evidence may well be very important indeed. That said, the standard required, namely, an extremely strong *prima facie* case, does not sit well with the policy behind the jurisdiction. In some cases, the fact that a wrongdoing has been committed may well be obvious; but as the cases have shown, there will be cases where the information is needed precisely to determine whether or what range of wrongdoings have been committed and how the claim is to best advanced or formulated. Where there is doubt as to whether any wrongdoing has been committed, this should tell against grant of the order. But where there is a good arguable case that some wrongdoing has been committed and there is uncertainty as to how the case is best formulated or what approach is best taken to remedy the wrongdoing, the position is rather different. In such cases, the better approach, with respect, is that taken by Woo Bih Li J in the appeal: the strength of the case is one of the factors to be considered in totality in deciding how to exercise the discretion.⁹⁴

(5) *The alleged wrongdoings*

159 In the *Odex* litigation, the claim was founded on the assertion that the *anime* titles enjoyed copyright in Singapore as a species of cinematograph film. Under s 83 of the Copyright Act,⁹⁵ film copyright includes the exclusive right to make copies of the film and also to communicate the film to the public. Users who made and stored copies of the titles in their computers (uploading) so that these were available to other users via P2P access, might well have been liable for the making of unauthorised copies as well as for making available to the public.⁹⁶ Users who downloaded copies to their own computers would also be liable for infringing the exclusive copying right.⁹⁷

94 *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [61] citing *Kuah Kok Lim v Ernst & Young* [1997] 1 SLR 169 and *KLW Holdings v Singapore Press Holdings Ltd* [2002] 4 SLR 417. In the latter case, Choo Han Teck J stated that generally in pre-action discovery the guide to be applied was “the interest of justice”. See also above at n 67. Note also that in the *Odex* case, the High Court allowed an application by some copyright owners to be added as plaintiffs. This overcame the *locus standi* problem. Some additional evidence was also submitted to the court on the matter of proof of wrongdoing. On this basis, the High Court allowed disclosure in respect of the video titles (copyright subject matter) of which the successful applicants were the copyright owners.

95 (Cap 63, 2006 Rev Ed).

96 See s 103(1) and s 83 of the Copyright Act (Cap 63, 2006 Rev Ed). Note that for the purposes of this discussion it will be assumed that no defence (such as fair dealing) is applicable.

97 An attempt to argue the defence in s 114(1) of the Copyright Act (Cap 63, 2006 Rev Ed) did not get far in the *Odex* litigation. That section provides that the copyright, *inter alia*, in a cinematograph film that is included in a broadcast or cable programme is not infringed by the making of a film of the broadcast or cable programme for the private domestic use of the person making the copy. Woo Bih Li J’s tentative view was that a cause of action had been established on the available
(cont’d on the next page)

160 What then of the criminal provisions? Section 136(3A) provides that an offence is committed by certain types of wilful infringement of copyright so long as the extent of the infringement is significant or the person commits the infringing act so as to obtain a commercial advantage.⁹⁸

161 To what extent is an infringing uploader caught by this criminal provision? The uploader is making a copy of each film title into his computer and he may also be making that copy available to the public, all without the consent of the copyright owner. Although he may not be committing these acts for the purpose of sale or hire, might he still be caught by the penal provisions of s 136(3A)? It seems improbable that the infringement will be regarded as one resulting in any commercial advantage and much will therefore depend on whether the infringement is significant. Section 136(6A) lists four factors for the court to take account of: the volume of articles that are infringing copies; the value of those articles; whether the infringement has a substantial prejudicial impact on the owner of the copyright; and finally, all other relevant matters. Suppose an uploader has copied 100 film titles into his computer and that these are then made available on the Internet for swapping, *etc*, is the infringement significant? This is a deceptively simple question that admits of no easy answer. Significant by reference to what standard or from which perspective:

- (a) the number of *articles* which contain infringing copies;
- (b) the number of *infringing copies* in any given article;
- (c) the number of infringing copies where the copyright belongs to the *same person*;
- (d) the number of infringing copies of the *same work or subject matter*; or
- (e) the number of infringing copies of works or other subject matter *irrespective* of who the copyright owners are?

162 An infringing uploader/downloader may well have scores or even hundreds of illicit copies in his hard drive. In many cases, they will

evidence notwithstanding s 114. See *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [71]. There is much to be said for this as it does not appear that s 114 is relevant to the facts of the case.

98 Note that s 136(5) extends these provisions to cinematograph film copyright. For an example of a prosecution based on commercial advantage see *PP v PDM International Pte Ltd* [2006] SGDC 91. Note that s 136(3A) was enacted in 2004 as part of the measures to implement the US-Singapore FTA. See also the discussion by the Industry Functional Advisory Committee on IP Rights for Trade Policy Matters available at: http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Singapore_FTA/Reports/asset_upload_file273_3234.pdf (accessed 16 August 2008).

be copies of different works, films and other copyright subject matter. In many cases, the copyright in the works and other subject matter may belong to many different owners. It may even be possible that for the copyright film in issue, he only has one infringing copy that is stored in his hard drive. So far as that copyright film is concerned, is the infringement significant given that there is only one electronic copy of that film in one hard drive controlled by the user? The number of articles appears to be just one hard drive! The number of infringing copies in that hard drive is voluminous, if we ignore the fact that they are copies of different works/subject matter. However, the number of infringing copies of the film in question is just one copy! But even so, the effect of that one infringing copy on the interests of the copyright owner is significant in that it leads to considerable downstream prejudicial impact. Given that s 136(6A) is a criminal provision of general application and given that the copyright law is intended to apply to the Internet, it seem unlikely that Parliament would have intended s 136(6A) to be limited to cases where the volume of physical hard copies is high. After all, the problem that copyright owners face is that in the world of electronic communications and the Internet, physical copies are no longer relevant in the distribution/making available pathway. A single electronic copy made available on one hard drive linked to the Internet may spawn a thousand daughters: many more infringing copies than would otherwise have been made and distributed, *etc*, by means of physical copies.⁹⁹

163 But what of the downloader who “simply” makes infringing copies of many films which he then stores on his computer hard drive or on CD/DVD-Discs? The home downloader may not be making any of these copies available to others, whether on the Internet or by other means. They may all be made for his personal/family pleasure. Leaving aside any possible application of a fair dealing defence, has such a downloader committed a criminal offence under s 136(6A)? This is no easy question to answer. Certainly, Professor Jayakumar speaking in Parliament opined that the section was not intended to catch a person who commits infringement by occasionally downloading an article or song from the Internet for his own personal enjoyment.¹⁰⁰ But what if that person is downloading regularly large amounts of copyright material without consent? What if the downloader has only made a single copy of any particular copyright work or subject matter (*eg*, a film) on his hard drive or on some storage device, is the infringement

99 See the example given by Professor S Jayakumar, Deputy PM and Minister for Law in Parliament and set out in *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [74].

100 Referred to in *Odex Pte Ltd v Pacific Internet Ltd* [2008] 3 SLR 18 at [74]. Note that the Minister for Law stressed that even here the home downloader may still be liable in a civil action for infringement.

significant? If the downloader is not making that infringing copy available to others on the Internet, the impact on the copyright owner of that single infringing download in respect of the copyright in that film is unlikely to be significant. Does it matter that he has also downloaded and made copies of many other copyright films (whether these all belong to the same copyright owner or not)? Whilst this is clearly a matter that requires careful appraisal, there is something to be said for the view that any ambiguity here should be interpreted against criminal liability.¹⁰¹ In the case of uploading and making available to the public, a single infringing copy can result in substantial prejudice. In the case of downloading which does not lead (or perhaps cannot lead) to any further making available, the question as to whether the infringement of any given copyright is criminally significant seems much less certain.¹⁰²

(6) *Scope of Norwich Pharmacal in Singapore*

164 Leaving aside the issue of *locus standi* to apply under O 24 r 6 and/or the residual inherent jurisdiction to grant *Norwich Pharmacal* orders where necessary in the interests of justice, questions remain over the scope of the inherent jurisdiction to grant pre-commencement discovery orders. Earlier, the extension and current scope of the *Norwich Pharmacal* jurisdiction in England has been briefly touched on and will not be repeated here. It seems probable that the Singapore courts accept that the jurisdiction is not confined to torts and will extend to wrongdoings in general. Whether this will include crimes (in the absence of matching civil wrongs) has not yet been authoritatively determined although the indications certainly point in that direction.¹⁰³

165 An important point that arises from the *Odex* litigation in Singapore concerns the applicability of the *Riddick* principle to documents/information discovered pursuant to a *Norwich Pharmacal* order. The principle states a general rule that documents discovered

101 See the very helpful discussion by Saw Cheng Lim & Susanna Leong, "Criminalising Copyright Infringement in Singapore: Who are the Real Online Culprits" [2007] EIPR 108 and especially at 113.

102 Saw Cheng Lim & Susanna Leong, "Defining Criminal Liability for Primary Acts of Copyright Infringement-The Singapore Experience" JBL 2008, 4, 304. The authors make the point that an individual downloader who habitually downloads copies for his own use might in aggregate leave an overall prejudicial impact on the entertainment industry as a whole. That said, the authors assert that this is not relevant as the inquiry is directed towards the impact on particular copyright owners.

103 Other issues will include use of *Norwich Pharmacal* to obtain information to assist in the formulation of the claim against a known wrongdoer as well as whether orders can be obtained to help enforce or obtain remedies against a known wrongdoer such as by means of tracing or other claims for restitution. As in England, *Norwich Pharmacal* relief will not be available against a mere witness. See *Sim Leng Chua v Manghardt* [1987] SLR 205.

under court order must not be used for some ulterior or alien purpose. To this end, the successful applicant for discovery will usually be required to limit the use of the material to the proceedings in respect of which discovery was sought.¹⁰⁴ For example, in *Sim Leng Chua v Manghardt*, the plaintiff brought an action for breach of contract against a company. In the course of that action, he obtained discovery of certain documents which contained alleged defamatory statements made by the “director-general adjoint” of the company. A defamation action was commenced against the director-general who then applied to strike the defamation action out on the basis that it was caught by the *Riddick* principle. The *Riddick* case concerned use of documents discovered in proceedings for wrongful dismissal, in subsequent proceedings, against the same defendants for defamation. Chan Sek Keong JC (as he then was), after surveying the English case law, found in favour of the striking out application. The point made was that if the contest was characterised as one between a private interest to protect reputation and the public interest in administration of justice which required that the confidentiality of discovery documents be protected, the defendant was bound to win as there was no authority where a court has allowed a private interest to outweigh a public interest.¹⁰⁵ But was the plaintiff’s assertion of a right to protect his reputation purely a matter of private concern? The court rightly accepted that there may be a genuine public interest in upholding private rights; after all, society must benefit from the protection of individual rights.¹⁰⁶ Even so, the court’s view was that even “if there were a public interest in his being allowed to litigate or enforce his rights in court, it would not override the public interest in full and frank disclosure in discovery proceedings”.¹⁰⁷

166 Full and frank disclosure in discovery proceedings has often been said to be “a most valuable aid in doing justice”. That said, the *Riddick* principle demands a balancing of the competing rights and interests and requires respect for the public interest in privacy and confidentiality. Thus, it has been said that discovery under compulsion is an invasion of a private right to keep one’s documents to oneself and that “discovery should not be pressed further than the course of justice requires”. If the court permitted the use of the documents for some ulterior or alien purpose, there was a real danger that the “courts themselves would be doing injustice”.¹⁰⁸ The *Riddick* principle arises where the discovery is under compulsion pursuant to a court order; it

104 *Riddick v Thames Board Mills Ltd* [1977] QB 881 (“*Riddick*”).

105 [1987] SLR 205 at 213.

106 Indeed, this lies at the heart of *Norwich Pharmacal* jurisdiction: a point referred to by Chan Sek Keong JC (as he then was) at p 213.

107 [1987] SLR 205 at 214.

108 *Riddick v Thames Board Mills Ltd* [1977] QB 881 and cited by Chan Sek Keong JC at [1987] SLR 205 at 214.

does not apply where one party has voluntarily disclosed documents in the course of legal proceedings.¹⁰⁹

167 Does the *Riddick* principle apply to documents/information discovered pursuant to a *Norwich Pharmacal* order? Several points may be worth noting. To begin with, in its original form, the *Norwich Pharmacal* order was concerned with discovery of the identity of the wrongdoer against whom the plaintiff/applicant wished to commence civil proceedings for a specific tort (patent infringement). Thus confined, there appears to be no good reason not to apply the *Riddick* principle. The discovery is under compulsion to enable, in the interests of justice, specific proceedings to be brought against the wrongdoer. The interference with the innocent facilitator's right of privacy is balanced against the interest of justice. However, the *Norwich Pharmacal* jurisdiction has since developed into a broader form covering cases where the information is needed to help the plaintiff/applicant formulate his claim and to decide which of several paths he will take to remedy the wrongdoing, from bringing legal proceedings to taking self-help action such as dismissal of the errant wrongdoer, *etc.* If the policy that moves *Norwich Pharmacal* is to assist a victim of a wrongdoing to find relief in the law, there may be something to be said for greater exercise of discretion when considering *Riddick* type restraints.

168 Second, there is the point that in Singapore, copyright and trade mark owners are often granted *fiats* to conduct private prosecutions alongside civil proceedings for copyright and trade mark infringement. That being the case, does it make sense to require the copyright owner to restrict his use of the information to the initiation of civil proceedings given that public policy in Singapore strongly supports copyright owners instituting criminal proceedings to protect their rights and given also the tentative movement in Singapore towards accepting *Norwich Pharmacal* relief so as to enable a victim of a crime to initiate criminal proceedings?

109 See *Hong Lam Marine Pte Ltd v Koh Chye Heng* [1998] 3 SLR 833. Singapore Court of Appeal. L P Thean JA delivering the grounds of decision referred to the view of Browne-Wilkinson VC in an earlier English case that a litigant who voluntarily uses documents in the litigation has himself destroyed the privacy of the document: not the plaintiff or the court. The earlier English case was *Derby & Co Ltd v Weldon (No 2)* *The Times* (20 October 1988). But query whether in the light of recent developments in confidentiality and privacy (pursuant to the Human Rights Act 1998 UK) a document that has been used in litigation no longer possesses any quality of privacy? See, for example, *Campbell v MGN Ltd* [2004] 2 WLR 1232. Even if privacy is not necessarily destroyed by such a disclosure, the fact remains that the *Riddick* principle is founded on an implied undertaking from the party who seeks and obtains court ordered discovery. Where disclosure was voluntary, L P Thean JA rightly notes at p 844 that the other party would not be subject to an obligation express or implied to the court not to use the documents save for the proceedings in question.

169 An important decision that touches on this point is *Microsoft Corp v SM Summit Holdings Ltd.*¹¹⁰ In that case, copyright/trademark owners had obtained search warrants under s 62(a) of the Criminal Procedure Code¹¹¹ in respect of alleged criminal offences under the Copyright Act¹¹² and Trade Marks Act¹¹³ of Singapore. Subsequently, the copyright/trademark owners were ordered to return all the items that had been seized from the alleged infringer. Later, the alleged infringer commenced proceedings for defamation arising out of statements made at a press conference held soon after the search raid. The copyright/trademark owners wished to use some of the documents and information obtained pursuant to the IP search warrants in the defence to the defamation proceedings.

170 The argument was made that the *Riddick* principle was inapplicable to copyright and trademark infringements because of the “self-help” regime of enforcement of IPR in Singapore whereby fiats were commonly granted to the IPR holder to commence criminal proceedings.¹¹⁴ These arguments were accepted by L P Thean JA who stated that:

I[In] Singapore there is this unique regime of self help where civil and criminal proceedings are part and parcel of the enforcement of an owner’s intellectual property rights, and not infrequently they are initiated in parallel proceedings by owners of intellectual property to enforce their rights. In such cases, it would be unrealistic and overly technical to say that documents and information obtained by owners in criminal proceedings are subject to an implied undertaking analogous to the *Riddick* principle and the owners are precluded from using them in civil proceedings, and vice versa, when both sets of proceedings are taken to enforce the same intellectual property rights
...¹¹⁵

171 Whilst this important qualification to the *Riddick* principle was accepted, the Court Appeal did not think that it was relevant in the actual circumstances. The documents and information obtained pursuant to the IP search warrants were not going to be used in parallel civil suits for copyright or trademark infringement. Instead, they were to be used in civil proceedings unrelated to the enforcement of IPR. The Court of Appeal rightly concluded that the same considerations of public interest in protecting privacy and confidentiality of documents

110 [1999] 4 SLR 529.

111 (Cap 68, 1985 Rev Ed).

112 (Cap 63, 1999 Rev Ed).

113 (Cap 332, 1999 Rev Ed).

114 These arguments were made by Mr V K Rajah (as he then was) citing *Ransome/Tempil Inc v Romar Positioning Equipment* (22 October 1990) and also *Novell Inc v Ong Seow Pheng* [1993] 3 SLR 700.

115 [1999] 4 SLR 529 at 548.

and information and in ensuring full and frank disclosure in the administration of justice, which are present in the application of the *Riddick* principle, should apply to the case then at hand.¹¹⁶

172 Thus, coming back to the *Odex* litigation, if the plaintiff/applicant was properly to be regarded as a victim of criminal copyright infringement, would a *Riddick* type restraint arise if a *Norwich*

116 LP Thean JA explains that the execution of the search warrants was a clear invasion of privacy and confidentiality and was subject to an implied undertaking on the part of the recipients of such documents and information not, without leave of the court, to use them other than in proceedings for the enforcement of the IPR. See [1999] 4 SLR 529 at 548. That said, LP Thean JA stressed that the duty was owed to the party who gave discovery and to the court and that it is for the court to control, modify or release (if the interest of justice so requires) a party from the implied undertaking. The implied undertaking even where it arises is not absolute and can be varied in an appropriate case. To complete the *Summit* saga, applications were then made to the court to vary and/or release the defendants to the defamation suit from the implied undertaking so that the documents and information could be used in the defence to the defamation suit. (In essence, it appears that the defendants wanted to rely on the defence of justification and that the documents and information in question were apparently helpful in that context.) These applications (by criminal motion) came before Yong Pung How CJ and were dismissed. See *Microsoft Corp v SM Summit Holdings Ltd* [2000] 1 SLR 343. Chief Justice Yong, in denying the applications, noted that the burden lay on the applicants to provide cogent and persuasive reasons and that a very important consideration was the overall interests of justice. The Chief Justice rightly stressed that the purpose of the implied undertaking was to protect privacy and confidentiality and that exceptional circumstances were needed before the court would exercise its discretion in favour of variation. Note that the Chief Justice also noted that at close of pleadings in the defamation suit, the defendants would be entitled to discovery in those proceedings which discovery might well give them the very documents in question. That being so, the Chief Justice felt there was no reason why the applicants should not have to go through the ordinary discovery procedure without using the prohibited information before its time. An appeal was subsequently dismissed on grounds of want of jurisdiction. See [2000] 2 SLR 137. Finally, in the defamation action, the defendants applied for discovery and the application eventually reached the Court of Appeal in February 2000. The crux was whether the defendants were entitled to discovery of any documents falling within the ambit of Chief Justice Yong's original order and/or implied undertaking in respect of the criminal search warrants. This was a tricky issue and decided in favour of the defendants on the basis that the documents were now sought as a result of some other information acquired independently of the search warrant raids. The reliance on such independent information did not in any way infringe the plaintiff's right to privacy and confidentiality which the implied undertaking sought to protect. See *Business Software Alliance v SM Summit Holdings Ltd* [2000] 2 SLR 733 and also at [2001] SGHC 94. Other cases touching on the court's discretion to vary the implied undertaking include: *Mopi pte Ltd v Central Mercantile Corp (S) Ltd* [2004] SGHC 41 (Tan Lee Meng J); *Beckett Ltd v Deutsche Bank AG* [2005] 3 SLR 39 (Woo Bih Li J) and on appeal at [2005] 3 SLR 555 holding that there were two requirements before a variation might be granted: cogent and persuasive reasons and absence of injustice or prejudice to the person who had given discovery. There was no need to demonstrate some overriding public interest.

Pharmacial order was granted so as to enable the initiation of criminal proceedings? Suppose that the applicant wanted to pass on the information to the copyright owners so that the latter could bring civil proceedings for infringement, would this be caught by an implied undertaking, given that the applicant had a real commercial interest in the copyright owner's action which was closely related to the criminal proceedings?¹¹⁷

(7) *Impact of Odex litigation on IPR*

173 The *Odex* litigation clearly raises an important question as to the status of non-exclusive licensees of copyright subject matter. Beyond this, it raises an important question of policy that goes to the heart of copyright and the information age: how should we address the economic and commercial needs of creators and authorised exploiters/distributors of copyright subject matter in the face of substantial copying by individual internet users who have the advantage of anonymity and in some ways consumer/public sympathy? Copyright owners assert that the number of infringing copies made and/or disseminated by individuals are enormous and translate into huge losses. Just how large those losses are may be quite hard to establish for it does not follow that every home copyist would necessarily purchase a licensed original even if unauthorised copies were not readily available through the Internet.

(8) *Impact of Odex on privacy and IPR*

174 Whether or not Singapore recognises a "right to privacy", the *Norwich Pharmacial* cases and the *Odex* litigation clearly demonstrate the need for a proportionate balancing of competing interests. Even if the threshold is met and a case made out for the grant of pre-trial discovery against an innocent party, it bears repeating that the jurisdiction is discretionary. In the case of applications under O 24 r 6, this is subject to O 24 r 7 which provides that the court should only grant the order if necessary for disposing fairly of the cause or matter or saving costs. In the case of applications under residual inherent jurisdiction, the *Norwich Pharmacial* line of cases clearly stresses the importance of looking at all the circumstances before deciding how equity's discretion is to be exercised. These must include the nature of the relationship between the innocent party and the alleged wrongdoer and the weight of any confidentiality obligation that the innocent party is subject to.¹¹⁸ This is not to say that confidentiality obligations have

117 In any case, once the prosecution takes place, the identity of the criminals will be known and presumably a matter of public record.

118 See, generally, *Beckett Pte Ltd v Deutsche Bank Aktiengesellschaft Singapore Branch* [2003] 1 SLR 375 and also *KLW Holdings Ltd v Singapore Press Holdings Ltd* (cont'd on the next page)

primacy, for it must be borne in mind that the public interest that supports confidentiality duties also recognises the importance of allowing victims of wrongdoings to remedy the wrong. Equitable principles of confidentiality as well as international conventions such as the ECHR recognise that important though obligations of confidentiality and/or privacy are, these cannot be used as a shield to mask serious wrongdoings.

VIII. Privacy revisited: Some concluding thoughts

175 Much ink has been spilt on privacy by philosophers, sociologists, ethicists, lawyers and members of the public in general. Have we now reached a position where we can say with confidence that there is a “right of privacy”? In some respects, the answer will depend on who is asking the question and in what context.

176 Privacy as a social expectation or as a rule of ethical behaviour or as a social norm is clearly very much in evidence. Privacy, it has been said, protects the moral capital in inter-personal relationships and enables an individual to develop different relationships with different degrees of informational intimacy. Privacy, it has also been said, is important, not just because it forms the basis of individual respect and social cohesion, but it also permits or encourages an individual to explore and develop his or her character, personality and capabilities to the full.¹¹⁹

177 Much more difficult is the question whether there is a legally enforceable general right to privacy that imposes broad based

[2002] 4 SLR 417. Both these cases raised issues concerning discovery and confidential information/relationships. In the latter case, Choo Han Teck JC held at [10] that confidentiality obligations may have more significance in pre-action discovery applications and that “prima facie, in such circumstances, the courts are entitled to lean in favour of confidentiality. What is spoken in confidence ought to be kept in confidence. Confidentiality must, therefore, be observed unless the greater interests of justice demand otherwise. The burden of proof lies with the applicant.” But, where the information is necessary to enable the victim of a wrongdoing to identify the wrongdoer, the balance starts to shift in favour of discovery (bearing in mind other factors such as the severity and nature of the wrongdoing, *etc*). For discussion, see Jeffrey Pinsler, “Analysis of Recent Cases on discovery and Interrogatories” *Law Gazette*, July 2003 (1).

119 See N W Barber, “A Right to Privacy” [2003] Public Law, Winter 602–610 and also generally Wei, “Milky Way and Andromeda: Privacy, Confidentiality and Freedom of Expression” (2006) 18 SAclJ 1. See also Disa Sim, “The Right to Solitude in the United Kingdom and Singapore: A Call for a Fundamental Reordering” *Loyola of Los Angeles Entertainment Law Review*, 2002, Vol 22:443 at 446 that the right to solitude helps to promote important social functions. It buffers individuals from societal pressures to conform and protects from ridicule and censure. It gives individuals the opportunity to relax, reflect and experiment.

obligations on members of society individually or as a whole. Not all countries with written constitutions expressly recognise a right of privacy as one of the fundamental liberties of its citizens. Many will, of course, recognise freedom of expression or freedom of speech alongside other “fundamental” rights such as freedom of religion, but what of a right to privacy? If privacy is fundamentally about the right of an individual to live his/her life “in peace”, to be left alone, then in some senses the fundamental liberties safeguarded in Part IV of the Singapore Constitution are precisely about putting flesh on this principle.¹²⁰ There are of course significant international documents recording the importance attached to a right of privacy (alongside freedom of speech, etc). These include Art 12 of the UDHR 1948 and Art 8 of the ECHR 1950.

178 In Europe and the UK, much attention has been paid to developing/expanding protection for informational privacy in recent years. In fact, the European framework for this derives from the ECHR 1950, a convention born in the immediate aftermath of World War 2: a war that epitomises abuse of human rights! The current urgency, however, has much to do with the development of the information society and the impact of information technology and electronic databases on the ability of an individual to retain control of his/her personal information. Then too there have been the tremendous advances in medicine, genetics and the unravelling of the human genome. Developments in modern life sciences have helped open the door to many new lines of therapeutic medical research, many of which will require the use of genetic information and disease profiling/distribution that will depend in turn on access to medical databases and patient information. It is no surprise that protection and exploitation of personal data has become a major industry in Europe (as well as many other countries) and has spawned a host of data protection laws.¹²¹

120 By this what is meant is that even though the Constitution makes no express reference to a right of privacy, the value of privacy permeates many of the identified fundamental liberties. But see Wacks, “The Poverty of Privacy” [1980] LQR 96 who makes the point that part of the problem with commonly cited privacy arguments (such as abortion) is precisely that privacy has become confused with other issues. See also Thio Li-Ann, “Pragmatism and Realism Do not mean Abdication. A Critical and Empirical Inquiry into Singapore’s Engagement with International Human Rights Law” (2004) 8 SYBIL 41 at 46 that there is no constitutional right to privacy. See also Eric Barendt, “Privacy as a Constitutional Right and Value” in *Privacy and Loyalty* (P Birks ed) (OUP, 1997) ch 1 and M Beloff QC, “Fundamental Freedoms in a Written Constitution” *Law Gazette*, January 2008.

121 In Europe, see Data Protection Directive 95/46/EC, Electronic Commerce Directive 2000/31/EC and Directive on Privacy and Electronic Communications 2002/58/EC. In the UK, see the Data Protection Act 1998.

179 This does not mean that countries like the UK now recognise a general stand alone legally enforceable right of privacy.¹²² Instead, the approach taken has been to recognise that privacy as a value can and should be used to shape and develop the law in a manner that is consistent with her obligations under the ECHR 1950 and the Human Rights Act 1998 (UK). In the area of informational privacy and Art 8 of the ECHR, the English approach has been to “shoehorn” Art 8 (privacy) into the equitable action protecting confidential information. This has required significant expansion or adjustment of the action so far as private information is concerned; a matter that has been explored in a number of significant cases of late and which will not be explored here.¹²³

180 The question that arises for us in Singapore is whether deeper broader protection for privacy as a social value is needed and, if so, how this is best achieved. This is a huge question that goes well beyond the confines of this article. What follows, by way of conclusion and overview, is a list of some points that have arisen or which are bound to arise for consideration.

181 First, in the area of spatial privacy (the right of quiet enjoyment), is there a need to introduce legislation so as to create a statutory tort of harassment? At present, aside from actions in nuisance, the High Court in Singapore has responded affirmatively with the exciting development of a common law tort of harassment in *Malcomson Nicholas Hugh Bertram v Naresh Kumar Mehta* (“*Malcomson*”).¹²⁴ Will this development be affirmed by the Court of Appeal or will the contrary view that the decision, though laudable in terms of policy, is a step too far or too fast and one that is better taken by Parliament win the day? Perhaps the time has now come to move on and to focus on refining the principle set out in *Malcomson* (for example, available defences or exceptions) than to question the basic premise of the decision.¹²⁵

122 Whilst it may be appropriate to use loose terminology (a right to be let alone) to describe privacy as a social value, it is quite another matter to use that loose terminology to carve out legally enforceable rights of wholly uncertain scope and application.

123 G S S Wei, “Milky Way and Andromeda: Privacy, Confidentiality and Freedom of Expression” (2006) *Singapore Academy of Law Journal*, 18, 1-58. See also Disa Sim, “The Right to Solitude in the United States and Singapore: A Call for a Fundamental Reordering” *Loyola of Los Angeles Entertainment Law Review*, 2002, Vol 22: 443. The most recent English cases being *Murray v Big Pictures Ltd* [2008] EWCA Civ 446 and *Max Mosley v News Group Newspapers Ltd* [2008] EWHC 1777.

124 [2001] 4 SLR 454.

125 See Tan Keng Feng, “Harassment and Intentional Tort of Negligence” [2002] *Sing JLS* 642. Note that the Senior Minister of State for Home Affairs and law, AP Ho Peng Kee stated in Parliament on 12 March 2004 that the Government’s view was that no new laws were needed at that stage to deal with harassment and stalking.

(cont’d on the next page)

182 Second, given the views expressed in the *Malcomson* case, will the Singapore courts in general take the view that even though Singapore is not subject to the imperatives of European law, that privacy as a socially important value can and should be recognised in developing existing legal principles (where necessary and on a proportional basis)?

183 Third, in the area of informational privacy, how will the Singapore courts and law makers respond to the developments that have taken place in the UK, Australia and New Zealand where the action to protect confidential information has acquired a broader role to protect personal private information as opposed to confidential personal information? In particular, will Singapore law move to a position where the litmus test for protection of personal information under the law of confidence is founded on some notion of a reasonable expectation of privacy?¹²⁶

184 Fourth, leaving aside expansion of the equitable action to protection confidential information, provisions against unauthorised access to computers in the Computer Misuse Act,¹²⁷ specific statutory provisions governing particular industries such as banking and so forth, is there a case for a general statute on data protection governing the

The Minister points out that there are penal provisions already such as those found in s 506 of the Penal Code as well as ss 13A and 13B of the Miscellaneous Offences (Public Order and Nuisance) Act as well as the Computer Misuse Act. So far as civil remedies are concerned the Minister noted the *Malcomson* decision as an important point since Lee Seiu Kin JC (as he then was) in that case underscored the importance of safeguarding privacy in this crowded world and the need for the common law to respond. See http://www.mha.gov.sg/news_details.aspx?nid=790 (accessed 16 August 2008).

126 In Europe, see in particular *Von Hannover v Germany* [2004] EMLR 21 and also *Peck v United Kingdom* (2003) 36 EHRR 719. In England, see *Campbell v MGN Ltd* [2004] 2 AC 457; *Douglas v Hello!* [2001] QB 967, [2001] 2 All ER 289, [2006] QB 125, [2005] EWCA 595 and [2007] 2 WLR 920; *A v B* [2002] EWCA 337; *HRH Prince of Wales v Associated Newspapers Ltd* [2006] EWHC 522; and *Murray v Express Newspapers* [2007] EWHC 1908 and on appeal at *Murray v Big Pictures Ltd* [2008] EWCA Civ 446. In Australia, see *Grosse v Purvis* 2003 QDC 151; *Australian Broadcasting Corp v Lenah Game Meats Pty Ltd* (2002) 208 CLR 199 but see also *Giller v Procopets* [2004] VSC 113 and *Kalaba v Commonwealth of Australia* [2004] FCA 763. In 2006, the County Court of Victoria held that a right to informational privacy existed in Australia. See *Jane Doe v ABC* [2007] VCC 281. Whilst it has been reported that the case has been appealed, the author understands that the litigation has been settled on confidential terms. In New Zealand, see *Hosking v Runting* [2005] 1 NZLR 1. In the UK, the leading text is now Tugendhat & Christie, *The Law of Privacy and the Media* (Oxford University Press, 2002). For discussion of the *Campbell* decision, see Saw Cheng Lim & Gary Chan, "The House of Lords at the Cross Roads of Privacy and Confidence" (2005) 35 HKLJ 91.

127 (Cap 50A, 2007 Rev Ed).

collection, processing, use and dissemination of personally identifiable data?¹²⁸

185 Aside from the various common law actions and specific statutory provisions that have an impact on privacy, some countries have already put into place elaborate legislation to specifically protect the privacy of data subjects where personal data is collected and compiled. The immediate advantage of such data protection legislation is that the law can be made of general application (as opposed to specific statutory provisions that only deal with confidentiality/privacy in a specific context).¹²⁹

186 The first time data protection laws were given serious consideration in the UK was by the Younger Committee Report on Privacy.¹³⁰ This was in connection with the growing impact of computer systems on privacy. The Younger Report led to a Government White paper¹³¹ and a further Lindop Committee Report¹³² – all of which were in favour of some form of data protection legislation. At the same time, movement was taking place in Europe. In 1981, the Council of Europe Data Protection Convention came into being.¹³³ Failure to ratify would have placed the UK at a disadvantage as other countries which had ratified were allowed to refuse the transfer of data (personal information) to other countries who did not provide comparable

128 Data protection legislation should not be confused with database laws. The latter is concerned with protecting the effort and labour that goes into the making of a database: the interests of the compiler dominates the landscape here. Data protection laws, on the other hand, are concerned with safeguarding the privacy interests of the data subjects.

129 For a discussion of privacy and the Internet (with a good description of use of cookies to garner personal information from the Internet), see Lim Yee Fen, *Cyberspace Law, Commentaries and Materials* (Oxford University Press, 2002). The first international document on data privacy is the Guidelines Governing the Protection of Privacy and Transborder Flows of Personal Data formulated by the OECD. In Europe, the first attempt to deal with data privacy dates back to the Council of Europe Convention on the Automated Processing of Personal Data 1981. See notes at p 138 that problems arising from different levels of implementation within the EU countries resulted in fears that Members with strong protection would move to restrict data flows to members with less protection. This led to calls for a Directive to harmonise the position in the EU. See Directive 95/46/EC 1995 on the Protection of Individuals with regard to processing of Personal Data and on Free Movement of Such Data. For an article supporting Data Protection legislation for Singapore, see Vili Lehdonvirta, "European Union Data Protection Directive: Adequacy of Data Protection in Singapore" [2004] SJLS 511. For a New Zealand perspective, see Gunasekara, "The Final Privacy Frontier? Regulating Trans-Border Data Flows" 2007 15 Int'l J.L & InfoTech 362.

130 Cmnd 5012, 1972.

131 Cmnd 6533, 1975.

132 Cmnd 7341, 1978.

133 The Convention only came into force later upon ratification by five States.

protection. The UK accordingly needed to pass data legislation so as to ratify the Convention.

187 The current UK Data Protection Act 1998 sets out further toughened standards intended to protect the rights of data subjects in respect of the collection, use and dissemination of personal data.¹³⁴ The interface with privacy in general is clear. Indeed, married with a broader privacy driven approach to personal/private confidential information and a statutory law on harassment, it would be fair to say that a higher level of protection for privacy is now available in the UK.

188 The Data Protection Act 1998 is also to be seen as part of the efforts to harmonise the law within the EU. The Directive and the Act make it expressly clear that so far as other countries are concerned, a principle of material reciprocity is to be applied where personal data from the European Economic Area is to be transferred to a foreign country. Such transfers are to be prevented unless the receiving country provides adequate protection under its own laws. This is also one of the new data principles.¹³⁵ Thus far, there has yet to be any adjudication under the Directive as to whether Singapore is a country whose laws and professional standards offer equivalent (adequate) levels of protection for personal data.¹³⁶

134 For a discussion of the impact of data protection legislation on biobanks containing personally identifiable biological material under Danish law, see Johnny Petersen, "Biobanks and the Law in Denmark, Opinion" [2004] EIPR 383.

135 The European Economic Area is defined in s 70 as a State that is a contracting party to the Agreement on the European Economic Area signed in 1992 and amended in 1993. See also Art 25(1) of the Data Protection Directive. This provides that Member States can only allow transfer to a third country of personal data undergoing processing if the third country provides an adequate level of protection. Factors as to whether the level of protection is adequate are set out in Art 25(2). These are the nature of the data, the purpose and duration of the proposed processing operation or operations, the country of origin and country of final destination, the rules of law, both general and sectoral, in force in the third country in question and the professional rules and security measures which are complied with in that country. It is understood that the European Commission has set up a working commission on Art 25 charged with the task of developing guidelines as to adequacy of data protection laws in third countries. See generally the EU Data Protection website at: http://europa.eu.int/comm/internal_market/privacy/index_en.htm (accessed 16 August 2008).

136 See, generally, Johanna Tan, "A Comparative Study of the APEC Privacy Framework – A New Voice in the Data Protection Dialogue?" (2008) Vol 3 Issue 1 Asian Journal of Comparative Law. Tan argues (rightly) that the EU approach to data protection is top down with privacy and human rights being the governing principle behind strong protection whereas the APEC Privacy Framework, whilst based on OECD Guidelines 1980, places greater stress on free flow of information and global commerce as opposed to protection of privacy *per se*. In this way, Tan explains that the APEC Framework has been criticised by some commentators as being "OECD Lite".

189 Aside from the various common law and equitable actions which are capable of protecting certain aspects of privacy and personal data, there is no general law on privacy as such. In particular, no specific legislation has been passed on data protection, although there have been government sponsored industry based self-initiated moves in that direction.

190 The Infocomm Development Authority in Singapore (“IDA”), for example, explains that in February 2002, the National Internet Advisory Committee (“NIAC”) released a draft “Model Data Protection Code for the Private Sector” which is modelled on internationally recognised standards.¹³⁷ The IDA and the National Trust Council (“NTC”) conducted a public consultation on the code. Based on comments from the industry and members of the public, the Model Code was fine-tuned and released in December 2002 for private sector adoption. The Model Code is said to be a “generic code” that is available for adoption by the entire private sector.¹³⁸

191 The Model Code applies to any private sector organisation that collects and installs personal data in electronic form, online or offline, using the Internet or any other electronic media. Further, in the e-commerce area, the NTC has aligned its trust mark programme with the principles of the Model Code.¹³⁹ The Trustsg mark is administered by the

137 <http://www.ida.gov.sg> (in particular OECD Guidelines) (accessed 16 August 2008).

138 The Model Code (version 3.1) is based on ten principles: (i) Accountability (an organisation is responsible for personal data in its possession/custody). (ii) Specifying purposes (the purposes for which personal data are collected shall be specified). (iii) Consent (knowledge and consent of the individual is required for collection, use and disclosure subject to certain exclusions). (iv) Limiting collection (collection of data to be limited to the specified purposes). (v) Limiting use, disclosure and retention (subject to certain exemptions, personal data not to be used or disclosed to a third party for purposes other than those for which it was collected, unless consent is obtained). (vi) Accuracy (personal data to be accurate, complete and up to date). (vii) Safeguards (personal data to be protected by appropriate security safeguards). (viii) Openness (to make readily available information about its policies and procedures for handling personal data). (ix) Individual access and correction (the right subject to conditions for the individual to be informed on request of the existence, use and disclosure of his personal data and to challenge accuracy and to require amendments). (x) Challenging compliance (an individual to be able to address a challenge concerning compliance with the principles to the designated person or persons accountable for the organisation’s compliance).

139 A report on the NIAC model code is available at: http://www.agc.gov.sg/publications/docs/Model_Data_Protection_Code_Feb_2002.pdf (accessed 16 August 2008). See also at: <http://www.wvlegal.com/module-subjects-viewpage-pageid-48.html> (accessed 16 August 2008). Note also that in 1998, Singapore’s National Internet Advisory Board issued an E-Commerce Code for Protection of Personal Information and Communications of Consumers of Internet Commerce. This voluntary self-regulation code controls collection and use of information on consumers. This code was adopted by CaseTrust as part of

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NTC and is awarded to online traders who meet the NTC standards for sound ecommerce standards and practices.¹⁴⁰

192 The issue as to whether Singapore needs to go beyond self-regulation and codes of practice is likely to resurface on an increasingly frequent basis in the years to come. The Singapore e-Government push to accelerate and broaden the use of the Internet to facilitate social intercourse in the 21st century, whilst welcomed, has raised concerns over the privacy of personal data. This concern has been recognised with the Government explaining that measures would be taken to “prevent information being spread around without the permission of the user”.¹⁴¹ To this end, it has been reported that the Government has adopted a data privacy protection code. The code prevents government officers passing data to commercial companies without the explicit approval from the relevant individuals. Further, stored data is only to be used for the purpose for which it is collected.¹⁴² Whether a Data Protection Act will eventually be enacted in Singapore still remains to be seen.¹⁴³

its code of practice. The latter is a joint project of Consumers Association of Singapore, CommerceNet Singapore Ltd and the Retail Promotion Centre Singapore. See <http://www.cnsng.com.sg/archive/000410.html> (accessed 16 August 2008).

140 Whilst the voluntary codes of good practice and self-regulation are important initiatives, it remains to be seen how these work in practice, the level of compliance and whether the EU will take the view that, overall, Singapore provides an adequate level of protection for personal data.

141 See *The Straits Times* Singapore, 29 October 2004 at H4.

142 A cursory visit to some Singapore Government websites also reveals that Data Protection Privacy statements are often set out for the user. See, for example, the Data Protection Privacy Statement of the National Environment Agency at: <http://app.nea.gov.sg/cms/htdocs/article.asp?pid=1315> (accessed April 2008). For a recent extensive discussion of the APEC Privacy Framework, see Johanna Tan, “A Comparative Study of the APEC Privacy Framework – A New Voice in the Data Protection Dialogue?” (2008) Vol 3 Issue 1 Asian Journal of Comparative Law. Tan notes at p 28 that in 2006, the Minister for Information Communication and the Arts, Mr Lee Boon Yang recognised in Parliament the increasing importance and impact of data protection in Singapore and the need to protect personal data. The Minister explained that the Government was reviewing Singapore’s laws on data protection and stressed the need to balance protection of personal data against adoption of new technologies.

143 See Lim Yee Fen, *Cyberspace Law, Commentaries and Materials* (Oxford University Press, 2002). At p 158, Professor Lim explains that in the US, the Department of Commerce adopted the Safe Harbour Privacy Principles in July 2000 in the expectation that these would satisfy the principles of the EU directive. Prior to this, different States within the Union employed different measures including legislation and self-regulation. The US Safe Harbour principles were promulgated so as to reduce the level of uncertainty and fears in respect of personal data flows from Europe. It is significant to note that the Safe Harbour Privacy Principles essentially uses the approach of self-regulation. The idea being that US companies choosing to comply would be treated as providing adequate protection for the purposes of the EU Directive. It is noted, however, that US companies that sign up might also be subjected to enforcement actions by the US Federal Trade Commission under the
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193 Fifth, in the area of bio-medicine and life sciences, are there adequate safeguards for individual privacy bearing in mind the public interest in advancing medical therapeutic research and also disease control? This is clearly a very important area that comes close to the heart of the work of the Singapore Bioethics Advisory Committee. Some of the areas where privacy concerns may need to be addressed (indeed many have already been touched on by the Bioethics Advisory Committee) include the following:

(a) The need for discussion, consensus building and possible regulation of unacceptable uses of genetic information (usually evidence of some genetic pre-disposition to disease) in the area of employment and insurance (genetic discrimination).¹⁴⁴

(b) Where medical databases are used to further research, discussion and consensus on the need to ensure adequate protection for patient identity in respect of medical and genetic information by removing personal identifiers and only allowing the use of anonymised data.¹⁴⁵

Federal Trade Commission Act. It is unclear as to how effective this has proven to be. As an alternative to signing up to the safe harbour provisions, US companies can also enter contracts with EU data providers that contain Directive compliant clauses. How effective these will be (especially *viz* privacy of contract issues) also remains to be seen. For background information, see http://ec.europa.eu/justice_home/fsj/privacy/index_en.htm (accessed April 2008). See also the useful summary and discussion by Morrison and Foerster LLP at <http://www.mofo.com/news/updates/bulletins/bulletin1184.html> (accessed April 2008). In 2004, only four countries had been determined as providing adequate data protection: Switzerland, Canada, Hungary and the US. By April 2008, the list covered: Switzerland, Canada, Argentina, Guernsey, Isle of Man, the US Department of Commerce's Safe Harbor Privacy Principles, and the transfer of Air Passenger Name Record to the US Bureau of Customs and Border Protection as providing adequate protection. See http://ec.europa.eu/justice_home/fsj/privacy/thridcountries/index_en.htm (accessed April 2008).

144 Wei, *Introduction to Genetic Engineering, Life Sciences and the Law* (Singapore University Press, 2002) at para 2.21 *et seq*. See also the Recommendations of the BAC, Personal Information in Biomedical Research, May 2007. See also the moves in the US to regulate genetic discrimination: <http://news.bbc.co.uk/go/pr/fr/-/2/hi/americas/7366264.stm> (accessed 16 August 2008). The US Senate has recently passed legislation banning genetic discrimination. This has now been passed by Congress and signed by President Bush. See Genetic Nondiscrimination Act (GINA) 2008 signed in May 2008.

145 See Wei, *Introduction to Genetic Engineering, Life Sciences and the Law* (Singapore University Press, 2002) at para 2.12. For an interesting English case, see *R v Department of Health ex parte Source Informatics Ltd* [2001] FSR 74. See also the extensive discussion by the BAC in its 2007 *Report on Personal Information in Biomedical Research*. Important questions as to effect of non-compliance with the rules governing de-identification will also have to be addressed. Will the patient/individual be given a cause of action for breach of statutory duty? Other issues relating to the degree of anonymization are bound to arise.

(c) Discussion and consensus building on when and under what circumstances it is acceptable for the identifiable patient information to be made known (in the name of the public interest).¹⁴⁶

(d) Discussion and consensus building on centralised patient medical report/test databases with the goal of improving the quality of patient health care (where the patient is consulting several medical practitioners) and so as to reduce wastage and unnecessary repeat medical tests.¹⁴⁷

194 These then are some of the questions that will need to be addressed in Singapore and indeed by the international community as a whole. The *Odex* case is important, not just because of the hard questions of black letter copyright law that had to be dealt with, it is also important because it underscores the difficult and complex balancing act that the law is required to perform between competing interests and rights in society. In the area of IPR, the *Odex* case clearly recognises the

146 Under the law of confidence, there is a well-established defence that permits unauthorised use of confidential information where this is necessary to protect some counter balancing public interest. For examples see *W v Egdell* [1990] 2 WLR 1990 (psychiatric report) and also *Campbell v MGN Ltd* [2004] 2 AC 457 for lengthy discussion of the need to disclose information regarding a drug addiction in the context of the public interest and role models. In the area of infectious and communicable diseases, consider also the need to disclose patient information to the Health authorities for disease control and also to facilitate contact tracing, etc, such as for severe acute respiratory syndrome or HIV infection. See Infectious Disease Act Cap 137. Consider also the need for a national disease registry to facilitate research on disease prevention and control such as cancer. In these cases, use of patient identifiable information may be necessary. See National Registry of Diseases Act 2007.

147 It has been said that with a graying population, health care costs are going to rise considerably in Singapore and other countries. The argument has been advanced that a centralised patient medical report/test database will do much to stream line medical treatment and reduce costs. Clearly under such a system, great care will be needed to build robust safeguards to protect patient confidentiality against unauthorised use. Tricky questions also arise here as to whether the benefits of such a system justify the reduction of patient anonymity *vis-à-vis* medical practitioners. What if the patient has his/her own reasons for not wanting his "new" doctor to have access to his previous medical reports/tests taken at a different clinic? Will this include psychiatric tests that a patient has voluntarily undergone? Will any such scheme be applied also to dentists? What about other service professions where second or third opinions are sought? Is there a risk that such a system may result in some patients who would otherwise seek treatments in Singapore, moving to other medical hubs where centralised patient databases are not kept? How will a centralised medical database be regarded in Europe where even stronger protection is generally required for special categories of personal data including health information. See Johanna Tan, "A Comparative Study of the APEC Privacy Framework – A New Voice in the Data Protection Dialogue?" (2008) Vol 3 Issue 1 Asian Journal of Comparative Law at n 26. In raising these issues, the author notes that he has no knowledge/experience of the actual practice in Singapore or elsewhere on the compilation and use of medical databases.

need to balance the “right of privacy” against Singapore’s interest in protecting IPR. As the District Court judge rightly stated: “the right to privacy can never be equated to a right to steal intellectual property in secret.”¹⁴⁸ In the area of bio-medical research, the need is to balance patient privacy against the need for access to information for medical therapeutic research, disease control and any other wider public interest that may be relevant, such as crime control and so forth. The balance is complex for it involves the privacy interests of the individual, the commercial interests of bio-medical research bodies as well as the interests of the public at large whose contributions may well include public funding/support for some areas of commercial medical research.

148 *Odex Pte Ltd v Pacific Internet Ltd* [2007] SGDC 248 at [38].