

**IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

[2023] SGHC 255

Originating Claim No 466 of 2022 (Summons No 2172 of 2023)

Between

Tiger Pictures Entertainment
Ltd

... Claimant

And

Encore Films Pte Ltd

... Defendant

GROUND S OF DECISION

[Intellectual Property — Copyright — Infringement]
[Intellectual Property — Copyright — Licences]

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Tiger Pictures Entertainment Ltd

v

Encore Films Pte Ltd

[2023] SGHC 255

General Division of the High Court — Originating Claim No 466 of 2022
(Summons No 2172 of 2023)

Dedar Singh Gill J

14 August, 6 September 2023

11 September 2023

Dedar Singh Gill J:

Introduction

1 This was an application to strike out a copyright claim on the ground that the claimant had no standing to sue for infringement. I dismissed the application.

Facts

The parties

2 The claimant, Tiger Pictures Entertainment Ltd, is a company incorporated in the People's Republic of China. It is engaged in the business of

selling and distributing films around the world.¹ The defendant, Encore Films Pte Ltd, is a company incorporated in Singapore that distributes films in Singapore and other countries in Southeast Asia.²

Background to the dispute

3 Originating Claim No 466 of 2022 (“OC 466”) is a claim for copyright infringement brought by the claimant against the defendant. The dispute revolves around the rights to a top-grossing Chinese film titled “Moon Man”.³ The owner of the copyright in “Moon Man” is a Chinese company known as Kaixin Mahua (“Kaixin”).⁴

4 On 19 August 2022, Kaixin entered into a licence agreement with the claimant (the “19 August Agreement”). This rendered the claimant the exclusive licensee in respect of the relevant rights to “Moon Man” in all jurisdictions worldwide except for the People’s Republic of China and the Republic of Korea. The arrangement was set to last from August 2022 to August 2033.⁵ I reproduce the relevant parts of the 19 August Agreement:⁶

2.4 Content of license:

2.4.1 Exclusive licensing: The Licensor grants the Licensee the right of exclusive distribution of the licensed work during the license term in the licensed territories under the premise that the copyright is safely protected, which shall specifically include:

¹ Statement of Claim dated 16 December 2022 (“SOC”) at para 1; Claimant’s written submissions dated 8 August 2023 (“CWS”) at para 6.

² SOC at para 2; Defence and Counterclaim dated 6 January 2023 (“DCC”) at para 6.

³ CWS at paras 5 and 8.

⁴ CWS at para 8.

⁵ CWS at para 9; Affidavit of Lee Huei Hsien dated 21 July 2023 (“Lee’s Affidavit”) at p 92.

⁶ Defendant’s written submissions dated 8 August 2023 (“DWS”) at pp 21–24.

- (1) The right of distribution for screening: ...
- (2) Right of reproduction: ...
- (3) Right of distribution of audio-visual products ...
- (4) The right of television broadcasting and screening ...
- (5) The right of communication on information network: ...
- (6) Right of VOD screening: ...

2.4.2 The Licensee has the right to conduct the essential excisions of the licensed work pursuant to restrictions or requirements of the laws, rules and policies of the specific country or region provided that the said amendments shall not change the theme of nor distort the licensed work. Where the Licensee or a third party licensed by the Licensee referred to as Licensee B fails to use the licensed work and publicity materials according to provisions of this License Agreement, the Licensee shall rectify the defaulting act and eliminate its impact within 10 working days upon being notified by the Licensor in written form (including in form of email). If the Licensee fails to rectify the defaulting act and eliminate its impact within 10 working days, it shall bear the losses thus caused to the Licensor and undertake the related legal responsibilities.

2.4.3 Right of publicity: ...

2.4.4 Independent rights protection against theft: ...

2.5 Nature of licensing: Exclusive licensing, which means for the licensed content under Clause 2.4.1 of this License Agreement, the Licensor shall not further exercise them on its own or permit any third party to do so.

2.6 Right of transfer of license or/and sub-license: The Licensee has the right to sign an agreement on transfer of license or/and sub-license regarding the content licensed under this agreement and license the third party to carry out all or/and part of the licensed matters under this License Agreement within the areas and timeframes (or other periods as the parties agreed) of the regions for distribution without exceeding the scope permitted by this license.

5 Pursuant to cl 2.6 of the 19 August Agreement, the claimant was granted the right to sub-licence the copyright in “Moon Man” without exceeding the scope permitted by the 19 August Agreement.

6 According to the claimant, on 20 August 2022, it granted an exclusive licence to its related entity in Hong Kong, also known as Tiger Pictures Entertainment Ltd (“HK Tiger”), in respect of the relevant rights to “Moon Man” (the “20 August Agreement”).⁷ Aside from the names of the parties to the agreements, the terms of the 19 August Agreement and the 20 August Agreement are identical.

7 Following a series of events, which I set out in detail in my earlier judgment, *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2023] SGHC 138 (“*Tiger Pictures*”) at [7]–[15], the claimant commenced OC 466. In brief, the claimant’s case is that (*Tiger Pictures* at [14]):

... the defendant had infringed its copyright in “Moon Man” by authorising third parties to cause the visual images and sounds of “Moon Man” to be seen and heard in public, by communicating “Moon Man” to the public, by making copies of “Moon Man” and/or authorising third parties to make copies of “Moon Man”. ...

8 These acts of infringement are alleged to have taken place from 15 September 2022 to 26 October 2022, both dates inclusive.⁸ The defendant denies infringing the copyright in “Moon Man” (*Tiger Pictures* at [15]). It raised two counterclaims against the claimant, which I summarily dealt with in *Tiger Pictures* at [29] and [30].

⁷ CWS at para 10; SOC at para 7; Claimant’s Bundle of Documents at Tab 12.

⁸ SOC at para 28.

Procedural history

Summons 926 of 2023 (“Summons 926”)

9 In Summons 926, filed on 31 March 2023, the defendant sought an order that the simplified process under Part 2 of the Supreme Court of Judicature (Intellectual Property) Rules 2022 (“SCJ(IP)R”) did not apply to OC 466. On 21 April 2023, I dismissed the application and allowed OC 466 to proceed under the simplified process (*Tiger Pictures* at [1] and [37]). The full grounds explaining my decision are set out in *Tiger Pictures*.

Summons 2171 of 2023 (“Summons 2171”) and Summons 2172 of 2023 (“Summons 2172”)

10 On 21 July 2023, the claimant filed Summons 2171, its Single Application Pending Trial (“SAPT”).⁹ On the same date, the defendant also filed its SAPT, *ie*, Summons 2172. Among other things, the defendant applied to strike out the entirety of the claimant’s claim, pursuant to O 9 r 16 of the Rules of Court 2021 (“ROC 2021”).¹⁰

The parties’ cases in Summons 2172

11 This judgment deals only with the defendant’s striking out application in Summons 2172.

12 The defendant submitted that OC 466 should be struck out because the claimant did not fulfil the requirements under s 153(1) of the Copyright Act 2021 (2020 Rev Ed) (“Copyright Act 2021”), and therefore had no *locus standi*

⁹ HC/SUM 2171/2023 dated 21 July 2023.

¹⁰ HC/SUM 2172/2023 dated 21 July 2023 at para 6.

to sue.¹¹ The defendant claimed that at the time of the alleged copyright infringement, the claimant was not the exclusive licensee of the copyright in “Moon Man”. This was because it had wholly licensed its exclusive right of distribution, as well as other rights to the film, to HK Tiger, pursuant to the 20 August Agreement.¹² The defendant relied on the English case of *Dendron GmbH v Regents of the University of California* [2004] FSR 43 (“*Dendron*”) to argue that the claimant’s position as the exclusive licensee was supplanted by HK Tiger and that it ceased to be the exclusive licensee in respect of the copyright in “Moon Man” at the time of the alleged infringement.¹³ Therefore, pursuant to O 9 r 16 of the ROC 2021, OC 466 ought to be struck out in its entirety.

13 Conversely, the claimant argued that the striking out application was wholly unmeritorious and found no support, whether from a legal or policy standpoint.¹⁴ According to the claimant, it was a statutory “exclusive licensee” of the copyright in “Moon Man” within the meaning of s 103 of the Copyright Act 2021. The claimant’s exclusive licence was granted by the owner of the copyright in “Moon Man”, *ie*, Kaixin.¹⁵ On the other hand, while the licence granted to HK Tiger by the 20 August Agreement purported to be an “exclusive” licence, it was not a statutory “exclusive licence”.¹⁶ The claimant submitted that the facts and decision in *Dendron* were inapplicable to the present case.

¹¹ DWS at paras 7 and 22.

¹² DWS at paras 12–13.

¹³ DWS at paras 15–21.

¹⁴ CWS at paras 35, 38–43.

¹⁵ CWS at para 38.

¹⁶ CWS at para 36.

Issue

14 The sole issue for my determination was whether the claimant fulfilled the *locus standi* requirement set out in s 153(1) of the Copyright Act 2021, *ie*, whether the claimant was an exclusive licensee of the copyright in “Moon Man” at the time of the infringement.

The law

The law on striking out

15 An application to strike out a claim is governed by O 9 r 16 of the ROC 2021, which provides as follows:

Striking out pleadings and other documents (O. 9, r. 16)

16.—(1) The Court may order any or part of any pleading to be struck out or amended, on the ground that —

- (a) it discloses no reasonable cause of action or defence;
- (b) it is an abuse of process of the Court; or
- (c) it is in the interests of justice to do so,

and may order the action to be stayed or dismissed or judgment to be entered accordingly.

16 Order 9 r 16(1) of the ROC 2021 sets out three grounds under which a claim may be struck out. It is identical in effect to O 18 r 19(1) of the Rules of Court 2014 (“ROC 2014”), except that O 9 r 16(1)(c) replaces O 18 r 19(1)(b) and 19(1)(c) of the ROC 2014 to build in the Ideals set out in O 3 r 1 of the ROC 2021, *ie*, to do what the interests of justice requires (*Singapore Rules of Court: A Practice Guide* (Chua Lee Ming *et al* eds) (Academy Publishing, 2023) at para 09.051). The test for establishing each ground was summarised by the Court of Appeal in *Iskandar bin Rahmat and others v Attorney-General and another* [2022] 2 SLR 1018 at [17]–[19]:

17 Under O 9 r 16(1)(a) ROC, the test is whether the action has some chance of success when only the allegations in the pleadings are concerned: *Gabriel Peter & Partners (suing as a firm) v Wee Chong Jin and others* [1997] 3 SLR(R) 649 (“*Gabriel Peter*”) at [21]. If that is found to be the case, then the action will not be struck out.

18 Order 9 r 16(1)(b) allows the court to strike out pleadings which constitute an abuse of process of the court. The inquiry here includes considerations of public policy and the interests of justice, and signifies that the process of the court must be used *bona fide* and properly and must not be abused; the court will prevent improper use of its machinery and the judicial process from being used as a means of vexation and oppression in the process of litigation: *Gabriel Peter* at [22].

19 In addition, O 9 r 16(1)(c) allows the court to strike out pleadings when it is in the interests of justice to do so. The [High Court] Judge agreed with the [Attorney-General] that this gives effect to the court’s inherent jurisdiction to prevent injustice, such as where the claim is plainly or obviously unsustainable: *The Bunga Melati 5* [2012] 4 SLR 546 at [33] ([Judge’s] Oral Grounds at [21]).

17 The defendant did not but should have made explicit which ground(s) under O 9 r 16(1) it relied on in its striking out application (see *The “Bunga Melati 5”* [2012] 4 SLR 546 at [30] and [31]). The defendant tendered an accompanying affidavit in support of its striking out application. However, according to O 9 r 16(2) of the ROC 2021, no evidence is admissible on an application under O 9 r 16(1)(a) of the ROC 2021. For completeness, I considered all the grounds set out in O 9 r 16(1) of the ROC 2021. There was no dispute that if the claimant lacked *locus standi*, the claim had to be struck out. In *Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck and another* [2007] 2 SLR(R) 869 (“*Alliance Entertainment*”), the plaintiff was not an exclusive licensee within the meaning of the Copyright Act (Cap 63, 2006 Rev Ed) (“Copyright Act 2006”) and did not have title to bring an action for an alleged infringement of copyright. Therefore, Sundaresh Menon JC (as the Chief Justice then was) allowed an application by the defendants to strike out

the action on the ground that the plaintiff had no title to maintain the action (*Alliance Entertainment* at [68]).

The law on standing to claim copyright infringement

18 The *locus standi* requirements for an action for copyright infringement are set out in s 153(1) of the Copyright Act 2021:

Action for copyright infringement

153.—(1) Subject to the provisions of this Act, an action against a person for an infringement of copyright may be brought in the Court by —

- (a) the copyright owner; or
- (b) if an exclusive licence of the copyright is in force at the time of the infringement — the exclusive licensee.

(2) The exclusive licensee’s right of action under subsection (1)(b) is concurrent with the copyright owner’s right of action under subsection (1)(a).

(3) This section does not —

- (a) give an exclusive licensee any right against a copyright owner; or
- (b) affect any right that an exclusive licensee has against a copyright owner.

19 In short, a claim for copyright infringement can only be made by the copyright owner or the exclusive licensee of the copyright. Sections 103(1) and (2) of the Copyright Act 2021 set out the definitions of an “exclusive licence” and “exclusive licensee” in relation to a copyright:

What is an exclusive licence

103.—(1) An “exclusive licence”, in relation to a copyright, is a licence —

- (a) granted by the owner or prospective owner of the copyright; and
- (b) authorising the licensee, to the exclusion of any other person, to do an act that, by virtue of this Act, the

owner of the copyright would, but for the licence, have the exclusive right to do.

(2) “Exclusive licensee” has a corresponding meaning.

The decision

20 In my judgment, the claimant was a statutory exclusive licensee within the meaning of s 103 of the Copyright Act 2021. Therefore, I was satisfied that the claimant had standing to maintain the present action and I dismissed the defendant’s application to strike out the action.

The position taken in local case law

21 It was undisputed that Kaixin is the owner of the copyright in “Moon Man”. Therefore, in order for the claimant to have standing to sue, it must have been an exclusive licensee of the copyright in “Moon Man” at the time of the alleged infringing acts, *ie*, from 15 September 2022 to 26 October 2022 (*per* s 103(1) of the Copyright Act 2021). As elaborated above (at [12]), the defendant claimed that the claimant was no longer an exclusive licensee at the material time, as it had granted an exclusive licence to HK Tiger via the 20 August Agreement.

22 In my view, the main difficulty in the defendant’s case was that s 103(1)(a) of the Copyright Act 2021 requires that the exclusive licence be “granted by the owner or prospective owner of the copyright”. Pursuant to the 20 August Agreement, HK Tiger’s licence was granted by the claimant, and not the owner of the copyright, *ie*, Kaixin. Therefore, this begged the question of *how* HK Tiger satisfied the statutory requirements of being an exclusive licensee and why the claimant was no longer the statutory exclusive licensee.

23 In the case of *Alliance Entertainment*, the High Court considered the interpretation of the term “exclusive licence” in the earlier Copyright Act 2006. For context, in *Alliance Entertainment*, the plaintiff contended that by virtue of a chain of contractual arrangements it was the exclusive licensee in Singapore of copyright in various television series and films (*Alliance Entertainment* at [2]). Before the commencement of the trial, the defendants filed an application to strike out proceedings contending that the plaintiff did not have title to maintain the action because it was not an exclusive licensee within the meaning of the Copyright Act 2006 (*Alliance Entertainment* at [7]). The definition of an “exclusive licence” was set out in s 7 of the Copyright Act 2006:

“exclusive licence” means a licence in writing, signed by or on behalf of the owner or prospective owner of copyright, authorising the licensee, to the exclusion of all other persons, to do an act that, by virtue of this Act, the owner of the copyright would, but for the licence, have the exclusive right to do, and “exclusive licensee” shall have a corresponding meaning;

24 The Copyright Act 2021, which replaced the Copyright Act 2006, adopts a definition of an exclusive licence that is the same in substance as s 7 of the Copyright Act 2006, except that the formality requirements have been set out separately in s 142 of the Copyright Act 2021.

25 In response to the contention of the defendants in *Alliance Entertainment*, one of the plaintiff’s submissions was initially that the phrase “on behalf of the [copyright] owner” in the definition of an “exclusive licensee” found in s 7 of the Copyright Act 2006 ought to be given a robust interpretation and so encompass the plaintiff. This argument was based on the parliamentary intention behind the statutory amendment that enacted s 124 of the Copyright Act 2006 (*Alliance Entertainment* at [7(b)]). Similar to the present case, there was no dispute that the instruments relied on by the plaintiff had *not* been issued by the copyright owners to the plaintiff. Upon further reflection, the plaintiff

dropped this argument and conceded that it was not an exclusive licensee within the meaning of the Copyright Act 2006 (*Alliance Entertainment* at [7] and [10]). Menon JC agreed with this concession by the plaintiff, describing it as well-advised (*Alliance Entertainment* at [11]).

26 Menon JC also set out some detailed observations on this issue (*Alliance Entertainment* at [10]–[11]). He began by citing an extract from *Copinger and Skone James on Copyright*, vol 1 (Kevin Garnett *et al* eds) (Sweet & Maxwell, 15th Ed, 2005), which is now reproduced in its latest edition, *Copinger and Skone James on Copyright*, vol 1 (Gwilym Harbottle *et al* eds) (Sweet & Maxwell, 18th Ed, 2021) at para 5-247:

Two matters ... follow from the requirement that the licence be signed “by or on behalf of the copyright owner” – first, that *a statutory exclusive licensee cannot himself grant a statutory exclusive licence by way of sub-licence*. If such a grant is permitted by the terms of the head licence, it will of course create a valid contractual sub-licence, giving the sub-licensee protection in an infringement action brought by the copyright owner and contractual rights against his own licensor.

[emphasis added]

27 Menon JC stated that these statements were correct (*Alliance Entertainment* at [11]). In my judgment, this passage continues to reflect the position under Singapore law, notwithstanding that the formality requirements for an exclusive licence are now set out in a separate provision in s 142 of the Copyright Act 2021. A statutory exclusive licensee cannot himself grant a statutory exclusive licence by way of sub-licence. Instead, as Menon JC rightly commented, “[w]hen an exclusive licensee grants a sub-licence, he is acting on his own behalf and not as agent or on behalf of the copyright owner” (*Alliance Entertainment* at [11]). In this case, the claimant, as the statutory exclusive licensee, had the right to sub-licence its rights in “Moon Man”, pursuant to cl 2.6 of the 19 August Agreement. However, the claimant could not grant a statutory

exclusive licence to HK Tiger by way of sub-licensing its rights in “Moon Man” pursuant to the 20 August Agreement. At best, the licence granted to HK Tiger was a contractual sub-licence.

28 Menon JC also considered whether in granting the sub-licence, the plaintiff’s sub-licensors had been acting on behalf of the copyright owners, rather than on their own behalf. He held that there was no indication of this, because “there [was] no suggestion at all that the consideration paid or payable by [the plaintiff] under the instrument pursuant to which it claims its licence is payable to the copyright owners” (*Alliance Entertainment* at [11]). Similarly, in this case, there was no suggestion that any consideration paid by HK Tiger to the claimant was payable to Kaixin. There was nothing else before me to show that the claimant had acted *on behalf of* Kaixin to grant the licence to HK Tiger. Menon JC further observed (*Alliance Entertainment* at [11]):

... Indeed, it would be illogical for them to be acting on behalf of the copyright owners rather than on their own behalf. This is because there would then be more than one licensee with rights in Singapore unless the rights granted to the sub-licensor had been revoked and there is no suggestion of this being the case at all. This was also the effect of the judgment of Booysen AJ in *Kinekor Films (Pty) Ltd v Movie Time* [1976] 1 SA 649, where it was held that a licence granted by a prior licensee rather than by the copyright owner was not an exclusive licence within the meaning of the equivalent South African statutory provision, but only a contractual licensee. Faced with these arguments by Mr Tan Teng Muan, who appeared for the defendants, [counsel for the plaintiff’s] concession on this issue seemed well-advised.

[emphasis added]

29 Applying s 103 of the Copyright Act 2021, in light of the observations in *Alliance Entertainment*, the claimant could not have granted HK Tiger an exclusive licence through the execution of the 20 August Agreement. Therefore, there was nothing to suggest that the claimant lost its status as the statutory exclusive licensee.

Dendron is inapplicable

30 In order to overcome the difficulty in interpreting s 103 of the Copyright Act 2021, the defendant simply relied on the outcome in *Dendron*, a patent case. In *Dendron*, the High Court of England and Wales held that the sub-licensee supplanted the exclusive licensee as the statutory exclusive licensee. The case appears to lay down the principle that a licensee with power to grant sub-licences has the power to consent on behalf of the proprietor and act as a duly authorised agent to grant a statutory exclusive licence (*Dendron* at [21] and [22]). However, on closer scrutiny of the judgment in *Dendron*, I found it did not assist the defendant. The reasoning was simply not relevant to the present case.

31 I first set out the facts of *Dendron*. The case concerned a counterclaim for patent infringement brought by the Regents of the University of California (“UC”), the proprietor of the patent in dispute, as well as Boston Scientific Ltd (“Boston”). Boston claimed to be entitled to sue for infringement as exclusive licensee under the patent (*Dendron* at [1]). The defendants to the counterclaim, Dendron, claimed that another company, Target Therapeutics, Inc (“Target”), was the exclusive licensee. Dendron therefore sought to dismiss Boston’s claim and join Target as a claimant. On 30 June 1990, UC had conferred upon Target an exclusive licence under the patent to make, use and sell the licensed product and to practise the licenced method (*Dendron* at [13]). The exclusive licence granted Target a power to grant sub-licences (*Dendron* at [14]). Subsequently, on 2 April 2003, UC, Target and Boston entered into a further agreement in relation to the patent. By the recital to that agreement, Target, as the “existing exclusive licensee” granted and agreed, with the consent of UC, to appoint Boston as the exclusive licensee (*Dendron* at [17]). By virtue of the subsequent

agreement, Pumfrey J decided that Target had been supplanted by Boston as the exclusive licensee (*Dendron* at [26]):

26. In my judgment, the preliminary issue is to be decided in favour of Boston. It seems to me to be clear from clause 1 of the Boston licence that Target described as “existing exclusive licensee” in the recitals, has been supplanted as the recital suggests by Boston. Thus, Target cease entirely to be exclusive licensee in respect of the patent. For the reasons that I have given, this is a permissible manner of making Boston the exclusive licensee under the patent.

Therefore, Boston had legal standing to initiate infringement proceedings against *Dendron*.

32 The applicable statutory regime in *Dendron* was the Patents Act 1977 (c 37) (UK) (the “UK Patents Act”). Under s 67 of the UK Patents Act, “the holder of an exclusive licence under a patent [was to] have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence”. Section 130(1) of the UK Patents Act defines the term “exclusive licence” as:

a licence from the proprietor of or applicant for a patent conferring on the licensee, *or on him and persons authorised by him*, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates, and “exclusive licence” and “non-exclusive licence” shall be construed accordingly.

[emphasis added]

33 In my judgment, Pumfrey J’s reasoning for concluding that Boston supplanted Target as the exclusive licensee was not applicable to the present dispute. This was because the reasoning was based on the specific language in s 130(1) the UK Patents Act, whereas the present dispute was governed by an entirely different statutory regime, *ie*, the Copyright Act 2021. The definitions of an “exclusive licence” in s 130(1) of the UK Patents Act and s 103(1) of the

Copyright Act 2021 are materially different. In particular, under s 130(1) of the UK Patents Act, an exclusive licence is a licence “from the proprietor ... conferring on the licensee, or *on him and persons authorised by him*, ... any right in respect of the invention ... and ‘exclusive licence’ and ‘non-exclusive licence’ shall be construed accordingly” [emphasis added]. The phrase, “or on him and persons authorised by him”, is noticeably absent in s 103(1) of the Copyright Act 2021.

34 In *Dendron*, Pumfrey J considered the argument that Boston had not been granted an exclusive licence within the meaning of s 130(1) of the UK Patents Act because Boston was a sub-licensee of Target. It was contended that s 130(1) of the UK Patents Act required the licence to be “from the proprietor of a patent”, and the licence granted to Boston was not such a licence (*Dendron* at [20]). He held that “as a matter of construction of the definition the words ‘from the proprietor of or the applicant for a patent’ mean[t] ‘granted by the proprietor *or by a person duly authorised by the proprietor for that purpose*’” [emphasis added] (*Dendron* at [22]). Pumfrey J reasoned that the words “from the proprietor of or the applicant for the patent” in s 130(1) of the UK Patents Act “[o]bviously ... [could not mean] a licence *signed by* the patentee”. Further, “[i]t [could not] have been the intention of the draughtsman to exclude the possibility that the licence might be granted by an agent of the patentee duly authorised for the purpose or of the patentee’s attorney”.

35 Crucially, however, these holdings were premised on the presence of the words “or on him and persons authorised by him” in s 130(1) of the UK Patents Act. When this phrase is read in context, s 130(1) of the UK Patents Act essentially states that a licence from the patent proprietor conferring on the licensee and *persons authorised by the licensee* any right in respect of the invention to the exclusion of all other persons is regarded as an exclusive

licence. In *Dendron* (at [11]), the High Court of England and Wales made the observation that “[t]he words ‘or on him and persons authorised by him’ seem ... to contemplate a licence which confers upon the exclusive licensee a power to sub-licence”. Applying this observation, s 130(1) of the UK Patents Act appears to contemplate that a patent proprietor is able to confer a statutory exclusive licence on a licensee who is then entitled to confer a statutory exclusive licence on a sub-licensee. To get around the problem of the definition which required a licence to only be granted by the proprietor, Pumfrey J held that an exclusive licence need not be *signed* by the patentee. Instead, another party could act as a duly authorised agent on behalf of the patentee to grant a statutory exclusive licence in accordance with s 130(1) of the UK Patents Act. Further, it was held that “a licensee with power to grant sub-licenses is a licensee who has the power to consent *on behalf of* the patentee” (*Dendron* at [21]). Therefore, by virtue of the wording “or on him and persons authorised by him” in s 130(1) of the UK Patents Act, Pumfrey J was able to conclude that Target, who had the power to grant sub-licences, could be duly authorised by UC to grant a statutory exclusive licence to Boston. In contrast, as the phrase “or on him and persons authorised by him” does not appear in s 103(1) of the Copyright Act 2021, the reasoning in *Dendron* is simply not relevant to our local copyright regime. The phrase “granted by the owner or prospective owner of the copyright” cannot be reasonably interpreted in a manner that allowed the licence granted to HK Tiger to be brought within the concept of the statutory exclusive licence in Singapore. This is because even though Kaixin had granted its licensee, via the 19 August Agreement, the right to grant sub-licenses, these sub-licenses were *not* licences “granted by the owner or prospective owner of the copyright” (see s 103(1)(a) of the Copyright Act 2021). Additionally, as elaborated above, interpreting s 103(1) of the Copyright Act 2021 this way

would be inconsistent with the observations made by Menon JC in *Alliance Entertainment*.

36 The authors of Adrian Speck *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis Butterworths, 5th Ed, 2018) (“*The Modern Law of Copyright*”) adopt a similar viewpoint when comparing the definition of an “exclusive licensee” of rights in copyright works in s 92(1) of the Copyright, Designs and Patents Act 1988 (c 48) (UK) with the definition of an “exclusive licensee” in the UK Patents Act (*The Modern Law of Copyright* at p 1173 footnote no 1). The learned authors observe that the definition of an “exclusive licensee” in s 92(1) “appears to exclude the possibility of exclusive sub-licences being regarded as exclusive licences for the purposes of this legislation”. The authors directly contrast this with the position under s 130(1) of the UK Patents Act, citing *Dendron* as the relevant legal authority. I reproduce s 92(1) of the Copyright, Designs and Patents Act 1988 in full:

92 Exclusive licences.

In this Part an “exclusive licence” means a licence in writing signed by or on behalf of the copyright owner authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the copyright owner.

...

[emphasis added]

37 The definitions of an “exclusive licence” set out in s 92(1) of the Copyright, Designs and Patents Act 1988 and s 103(1) of the Copyright Act 2021 are similar in substance. In any event, like s 103(1) of the Copyright Act 2021, the definition of an exclusive licence in s 92(1) of the Copyright, Designs and Patents Act 1988 omits the phrase “or on him and persons authorised by him”. Therefore, s 103(1) of the Copyright Act 2021 cannot be interpreted by

importing the wording of s 130(1) of the UK Patents Act and applying the reasoning in *Dendron*.

38 In my view, there was nothing before me to suggest that HK Tiger had supplanted the claimant as the statutory exclusive licensee and that the claimant was no longer the statutory exclusive licensee at the material time. The 20 August Agreement only granted a sub-license to HK Tiger, and the claimant retained its status as the exclusive licensee. Therefore, the claimant satisfied the standing requirement set out in s 153 of the Copyright Act 2021.

Conclusion

39 For all the foregoing reasons, I dismissed the defendant's striking out application in Summons 2172. I made no order for costs at this stage of the proceedings pursuant to r 9(2) of the SCJ(IP)R.

Dedar Singh Gill
Judge of the High Court

Toh Jia Yi (Allen & Gledhill LLP) for the claimant;
Tan Tee Jim SC and Lee Junting, Basil (Lee & Lee) for the
defendant.