

IN THE SUPREME COURT OF THE DEMOCRATIC SOCIALIST

REPUBLIC OF SRI LANKA

1. C. Aloy W. Fernando,
No. 43/99, Poorwarama Mawatha,
Colombo 5

Plaintiff

- Vs -

SC/CHC/Appeal/30/2006

Commercial High Court (Civil) of the
Western Province (holden in Colombo)
No. HC (Civil) 06/99(3)

1. Anton Reginald Atapattu,
Director,
Department of Fisheries and Aquatic
Resources,
Maligawatta Secretariat,
Colombo 10.
2. M.T.K. Nagodawithana,
Acting Director,
Department of Fisheries and Aquatic
Resources,
Maligawatta Secretariat,
Colombo 10
3. Hon. Mahinda Rajapakse,
Minister of Fisheries and Aquatic
Resources,
New Secretariat Building,
Maligawatta,
Colombo 10

4. Attorney General,
Attorney General's Department,
Colombo 12.

Defendants

AND NOW

2. M.T.K. Nagodawithana,
Acting Director,
Department of Fisheries and Aquatic
Resources,
Maligawatta Secretariat,
Colombo 10

2nd Defendant-Appellant

- 2A. Mr. S. W. Pathirana,
Director General,
Department of Fisheries and Aquatic
Resources,
New Secretariat Building,
Maligawatta, Colombo 10

Substituted 2A Defendant-Appellant

- 2B. Mr. Nimal Hettiarachchi,
Director General,
Department of Fisheries and Aquatic
Resources,
New Secretariat Building,
Maligawatta, Colombo 10

Substituted 2B Defendant-Appellant

2C. Mr. M. Cristy Lal Fernando,
Department of Fisheries & Aquatic
Resources,
New Secretariat Building,
Maligawatta, Colombo 10

Substituted 2C Defendant-Appellant

- Vs -

C. Aloy W. Fernando
No. 43/99, Poorwarama Mawatha,
Colombo 05

Plaintiff-Respondent

1. Anton Reginald Atapattu,
Director,
Department of Fisheries and Aquatic
Resources,
Maligawatta Secretariat,
Colombo 10.

1st Defendant-Respondent (Deceased)

3. Hon. Mahinda Rajapakse,
Minister of Fisheries & Aquatic
Resources,
New Secretariat Building,
Maligawatta,
Colombo 10.

3rd Defendant-Respondent

- 3A. Felix Perera,
Minister of Fisheries & Aquatic
Resources,

New Secretariat Building,
Maligawatta,
Colombo 10.

Substituted 3A Defendant-Respondent

3A. Hon. Mahinda Amaraweera,
Minister of Fisheries & Aquatic
Resources,
New Secretariat Building,
Maligawatta,
Colombo 10

Substituted 3B Defendant-Respondent

4. Hon. Attorney General,
Attorney General's Department,
Colombo 12.

4th Defendant-Respondent

Argued before: Buwaneka Aluwihare, PC, J
Priyantha Jayawardena, PC, J
Nalin Perera, J

Counsel: Sanjeewa Jayawardena, PC with Nilshantha Sirimanne for the Plaintiff-
Respondent
Suren Gnanaraj, SC for the 2nd Defendant-Appellant

Argued on: 26th May, 2017

Decided on: 10th September, 2018

Priyantha Jayawardena, PC, J.

This is an appeal from a judgment of the High Court (Civil) holden in Colombo in respect of moral rights decided under the Code of Intellectual Property Act No. 52 of 1979 as amended.

Factual Background

On 17th September 1993, an advertisement was placed by the Department of Fisheries and Aquatic Resources (hereinafter referred to as 'the Department') in the Dinamina newspaper calling for bids for the compilation of a detailed list of craft and gear used in Sri Lanka's fishing industry for a project funded by the United Nations Development Programme (hereinafter referred to as the 'UNDP').

Several persons including Messrs. Neil Fernando and Company submitted bids for the aforementioned tender. In the bid submitted by Messrs. Neil Fernando and Company, C. Aloy W. Fernando (hereinafter referred to as 'the Respondent') and one Shantha Suraweera were named as two key personnel proposed to work on the project.

After discussions between the said Department and Messrs. Neil Fernando and Company, the tender was awarded to Messrs. Neil Fernando and Company by a letter dated 4th November, 1993.

On 19th November 1993, Messrs. Neil Fernando and Company and the Department entered into an agreement to conduct a descriptive all island survey of fishing crafts and gear in use, and prepare an inventory containing a written description supported by sketches, diagrams and photographs for a consideration of Rs. 731,543/- (hereinafter referred to as the 'Agreement'). The consideration under the Agreement was paid by the Department to Messrs. Neil Fernando and Company after the submission of the Final Draft.

The Agreement was negotiated and signed by the Respondent for and on behalf of Messrs. Neil Fernando and Company and A. R. Atapattu, the 1st Defendant, in his capacity as the Director of the Department (hereinafter the '1st Defendant').

Appendix B of the Agreement set out the Respondent as the Team Leader and Shantha Suraweera as the Craft and Gear Specialist.

Further, Clause 5 of the Standard Conditions of Contract in the said Agreement stated as follows:

“(b) Proprietary Rights of the Client in Reports and Records

The reports and all other relevant data including maps, diagrams, photographs, plans, statistics and supporting records or materials compiled or prepared in the course of the Services shall be the property of the Client and shall not be used by the Contractor for purposes unrelated to this Contract without the prior approval of the Client. The Contractor shall deliver all such materials to the Client upon the completion of the Services.” [Emphasis added]

Thus, by the aforementioned clause, the economic rights of the work were transferred to the said 1st Defendant for the purpose of the matters referred to in the contract in his official capacity as the Director of the Department. This position was conceded by both the Appellant and the Respondent.

Appendix A of the said Agreement set out the Terms of Reference which stipulated the activities that need to be carried out. Specifically, Activity 4 under the Terms of Reference stated that a catalogue-cum-field manual must be prepared.

After signing the said Agreement, the Respondent and Shantha Suraweera commenced work in terms of the Agreement and led teams to carry out field research in the country's coastal districts, excluding the Northern and Eastern Regions which was carried out by representatives on behalf of Shantha Suraweera and the Respondent. Those representatives used formats prepared by the Respondent. The research carried out involved conducting interviews and detailed studies, taking measurements, taking photographs, preparing the text, making sketches to scale, and compiling key materials that were required for the creation of an inventory of the fishing craft and gear used in Sri Lanka.

The staff of the said Department examined the draft using a Critique Sheet prepared by the UNDP. Subsequently the Respondent and Shantha Suraweera participated in a one day workshop to answer queries raised by the staff of the said Department and using the feedback, made minor changes to the draft.

The final version of the draft was delivered to the 1st Defendant in April 1994, titled "Fishing Craft, Gear and Methods in Sri Lanka" (hereinafter referred to as 'the Final Draft'). The cover page of the Final Draft that was handed over to the Department was as follows:

**“DEPARTMENT OF FISHERIES AND AQUATIC RESOURCES OF THE
REPUBLIC OF SRI LANKA**

FISHING CRAFT, GEAR AND METHODS IN SRI LANKA

April 1994

by

Aloy W. Fernando

&

Shantha Suraweera

CONSULTANT

NEIL FERNANDO & CO.

No. 10, Frances Road, Colombo 6,

SRI LANKA”

Through Messrs. Neil Fernando and Company, the Respondent requested from the Department a published copy of the "Fishing Craft and Gear of Sri Lanka" (hereinafter referred to as the 'Published Work'). The Respondent submitted that despite these requests, the 1st Defendant did not furnish a copy of the Published Work.

Later the Respondent managed to obtain a copy of the Published Work and found out that the body of the Final Draft had been reproduced with the new cover page which read as follows:

“FISHING CRAFT AND GEAR OF SRI LANKA

Department of Fisheries and Aquatic Resources

UNDP/FAO/SRL/91/022

Marine Fisheries Management Project”

Accordingly, the cover page did not indicate the Respondent and Shantha Suraweera as authors. Further, in the preface to the Published Work, the 1st Defendant had adapted the Respondent’s preface from the Final Draft and inserted his name in lieu of the Respondent’s name. The Respondent stated that he noticed his name and Shantha Suraweera’s had been removed only after he obtained a copy of the Published Work.

The Respondent further submitted that he also became aware that the Published Work had been translated into Sinhala and the authors’ names were not indicated in connection with the work and the preface was also adapted in the same manner.

The Respondent stated that he had written to the 1st Defendant and requested him to cease publishing further copies of the Published Work which did not indicate the authorship of the Respondent and Shantha Suraweera in connection with the work. Further, letters of demand were also sent by the Respondent through his attorneys-at-law but no response was received to any of those letters.

The Proceedings Before the High Court (Civil)

The Respondent instituted action in the High Court (Civil) (hereinafter referred to as the ‘Commercial High Court’) against the 1st Defendant, the Acting Director of the said Department as the 2nd Defendant, the Minister of Fisheries and Aquatic Resources as the 3rd Defendant and the Attorney General’s Department as the 4th Defendant.

The action was not filed against the 1st, 2nd and 3rd Defendants in their personal capacity but by virtue of the fact that they held the relevant of posts in the said Department and the Ministry, respectively. The 4th Defendant was made a party in terms of the Civil Procedure Code.

The Respondent prayed, *inter alia*, for the Court to make order for the following in his Amended Plaintiff:

- “(i) *Declaring that the Respondent and Mr. Suraweera are the authors of the book titled ‘Fishing Craft and Gear of Sri Lanka’ published in English, Sinhala and Tamil by the Department of Fisheries and Aquatic Resources and/or that the [Respondent] is the joint author of the same.*
- (iv) *Granting a Permanent Injunction restraining the Defendants and their servants and agents from distributing, selling or in any other way circulating any copy of the publication titled ‘Fishing Craft and Gear of Sri Lanka’ and/or its Sinhala/Tamil translation or any similar publication based on the data contained therein without*

appropriately acknowledging the joint authorship of the Plaintiff prominently on the cover and/or on each page on which the title of the publication appears and at the end of the preface of the publication.

- (vi) *Requiring the Defendants to display on the cover and/or on each page on which the title of the publication appears and at the end of the Preface, the name of the Respondent as the joint author of the said work titled, 'Fishing Craft and Gear of Sri Lanka' in every copy of the same published in English, Sinhala, Tamil or any other language.*
- (viii) *For judgment against the Defendants jointly and severally for a sum of Rs. 15 million together with legal interest thereon from the date of filing action, and further legal interest on the aggregate sum from the date of the decree until payment in full."*

The Respondent stated that Shantha Suraweera was not made a party to the action as he was unable to ascertain his whereabouts.

The 1st Defendant died during the course of the proceeding, but the proceeding continued as the case had been filed against him in his official capacity and subsequently, the successors of the 2nd Defendant were added as parties. No objections were raised for those substitutions.

The Commercial High Court delivered judgment in favour of the Respondent against the 1st and 2nd Defendants in terms of the said prayer (i), (iv), (vi) and (viii) and awarded a sum of Rs. 1.5 million together with legal interest.

Being aggrieved by the said judgment, the 2nd Defendant appealed to the Supreme Court, *inter alia*, on the following grounds:

- (b) *The Learned Trial Judge has misdirected himself in holding that the Plaintiff was the sole author of the publication which was only an inventory he had done with the help of others in the field and the Ministry of Fisheries;*
- (c) *The learned Trial Judge had misdirected himself in holding that the obligations of the Defendants in the case were not based the contract; and,*
- (e) *The learned Trial Judge had misdirected himself in holding that the Plaintiff's copyright was infringed.*

Submissions by the 2nd Defendant-Appellant

The learned State Counsel for the 2nd Defendant-Appellant (hereinafter 'the Appellant') submitted that the legal rights involved in this appeal arose from the said Agreement entered between Messrs. Neil Fernando and Company and the 1st Defendant on behalf of the Department.

The Final Draft submitted by the Respondent did not attract copyright as it was a detailed list of fishing crafts and gear used in Sri Lanka as stated in the advertisement calling for bids. It was further submitted that according to Black's Law Dictionary (7th Edition, 1999), an inventory was a detailed list of assets and thus, the work should be regarded as simply being an inventory. Thus, the Appellant argued that the Final Draft was not an 'original' work for the purposes of the Code of Intellectual Property Act No. 52 of 1979 as amended (hereinafter 'the 1979 Act').

The learned State Counsel further submitted that, as per the provisions of the Agreement, the Respondent and Shantha Suraweera participated in one day workshops where the Department staff evaluated and criticised the draft. Moreover, the Respondent was given access to facilities and ensured cooperation of the staff members of the Department. Thus, the work was primarily created by the said Department and not by the Respondent and Shantha Suraweera.

It was also submitted that if the Final Draft attracted copyright, all intellectual property rights; namely, the economic rights and moral rights in the Final Draft had been transferred from the Respondent to the Department due to the provisions of the Agreement. Thus, the Respondent no longer owned the moral rights in the Final Draft. Further, if the Respondent had wanted to retain his moral rights, a specific clause should have been included in the Agreement to that effect.

During the course of oral submissions, the learned State Counsel for the Appellant submitted that the Respondent had waived his right to claim moral rights, if any, by acquiescence and he is now estopped from claiming moral rights.

Without prejudice to the other submissions, the learned State Counsel further submitted that the quantum of damages awarded was excessive.

Submissions by the Respondent

In response, the learned President's Counsel for the Respondent submitted that while economic rights in the Final Draft had transferred to the said Department, the Respondent's moral rights were not transferable in terms of section 11 of the 1979 Act. It was also submitted that the Respondent and Shantha Suraweera continued to be co-owners of the moral rights in the Final Draft and are thereby, entitled to have their names indicated as joint authors in connection with the Published Work. Therefore, the failure to indicate that the Respondent's authorship in connection with the Published Work was an infringement of his moral rights.

It was further submitted that the Respondent was entitled in law to ensure that the Final Draft was published in the same manner which was handed over to the Department without any unauthorized, deletions, alterations, changes or editing.

The Respondent further claimed that there were several errors and changes made to the Final Draft upon publication which infringed his moral rights.

Can the Respondent Claim Copyright to the Final Draft?

In order to consider whether the Respondent had copyright to the Final Draft, it is necessary to consider whether the Respondent was an author of the Final Draft in terms of the 1979 Act.

(a) Who are the 'Authors' of the Final Draft?

Section 17(1) of the 1979 Act defines an author as follows:

"The rights protected under this Part shall be owned in the first instance by the author or authors who created the work. The authors of a work of joint authorship shall be the co-owners of the said rights." [Emphasis added]

Further, section 6 of the 1979 Act defines a ‘work of joint authorship’ as follows:

“... a work created by two or more authors in collaboration, in which the individual contributions are indistinguishable from each other.”

Thus, it is necessary to consider who created the Final Draft.

The Appellant submitted that the Respondent and Shantha Suraweera were given access to facilities and ensured cooperation of the staff members of the Department to prepare the said draft.

While giving evidence, the Respondent described the work carried out to create the Final Draft. He stated that Shantha Suraweera and he prepared the programme and split the country into five zones. As stated above, data in the North and East was gathered by representatives deployed by them while the remaining zones were visited by the Respondent and Shantha Suraweera and their team. The representatives worked on formats provided by the Respondent and Shantha Suraweera.

Further, the research carried out involved conducting interviews and detailed studies, taking measurements and photographs, making sketches to scale and compiling key materials.

In his evidence, the Respondent stated that he and Shantha Suraweera performed the work laid out in the Terms of Reference in Appendix A of the Agreement which includes the preparation of a catalogue-cum-field manual as stipulated in Activity 4 of Appendix A.

The Terms of Reference in Appendix A stipulated the following activities:

- Activity 1 – Prepare comprehensive lists of types of craft and gear*
- Activity 2 – Classify craft and gear*
- Activity 3 – Documentation of craft and gear*
- Activity 4 – Prepare a catalogue-cum-field manual*
- Activity 5 – Present and correct draft*

Further, Activity 4 in the aforementioned Appendix A states as follows:

“Prepare a catalogue-cum-field manual

Using the collected data, prepare a draft catalogue-cum-field manual in English. The manual is to be user friendly, pedagogic and easily read by a non-technical readership while also containing enough basic data on the craft and gear to identify types but not design the craft and gear in question.”

Thus, the Respondent and Shantha Suraweera used information gathered during field research and information collected by other representatives deployed by them, and exercised skill and judgment to prepare a draft catalogue-cum-field manual (i.e. the Final Draft) which could be easily read and understood by a layperson.

The Appellant submitted that the draft document was critiqued at a workshop held at the Department using a Critique Sheet provided by the UNDP and it was produced in court during trial.

In response, the Respondent stated that after the workshop, the only changes made involved minor editing of the draft document and the removal of repetitions and minor alterations.

A careful consideration of the said Critique Sheet shows that it was merely a mode of providing feedback to the Respondent and Shantha Suraweera as to what needed to be corrected, rather than being a means of contributing to the work. Therefore, I am of the view that giving access to the facilities of the Department, ensuring the cooperation of the Department staff and feedback does not amount to a contribution to the preparation of the Final Draft which meets the threshold required for authorship.

Having considered the work prepared under the Terms of Reference in Appendix A in the Agreement, particularly Activity 4 of Appendix A, I am of the opinion that the Respondent and Shantha Suraweera are the authors of the Final Draft.

Although the roles were divided, it was the culmination of both their skill and judgment that resulted in the Final Draft and their contributions are indistinguishable from each other. Therefore, I am further of the opinion that the Final Draft was a work of joint authorship within the meaning of section 17(1) of the 1979 Act.

(b) Is the Final Draft an ‘original’ literary work?

In view of the above finding that the Respondent and Shantha Suraweera are the authors of the Final Draft, it is now necessary to consider whether the Final Draft is an original literary work and therefore a protected work in terms of the 1979 Act.

Section 7 of the said Act stipulates a protected works as follows:

“(1) Authors of original literary, artistic and scientific works shall be entitled to the protection of their works under this Part.

(2) Literary, artistic and scientific works shall include in particular –

(a) books, pamphlets and other writings;

(3) Works shall be protected irrespective of their quality and the purpose for which they were created.” [Emphasis added]

The originality of the Final Draft was contested by the Appellant on the basis that the Final Draft was not created by the Respondent and Shantha Suraweera, but that they only compiled the data which was collected by them and other representatives deployed by them.

In order to consider if the Final Draft satisfies the requirement of originality, it is necessary to consider the work performed by Shantha Suraweera and the Respondent.

Having considered the Final Draft, I am further of the opinion that the preparation of the Final Draft involved skill, choice of language and style, composition and intellectual effort by the Respondent. Therefore, the Final Draft can be considered as ‘original’ work for the purpose of the said Act as there is originality in the work.

The test for originality of a work was set out in *University of London Press v University Tutorial Press* [1916] 2 Ch 601 wherein it was held at 608:

“The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.” [Emphasis added]

The fact that the Final Draft contained pre-existing information which was partly gathered by the representatives deployed by the Respondent and Shantha Suraweera does not affect originality of the Final Draft. I am of the view that a novel composition of pre-existing information by exercising skill, knowledge and decisions involving choice of language and style satisfies the requirement of originality. In *Football League Ltd v Littlewood Pools Limited* 1959 Ch 637, it was held as follows at 651:

“...it is clearly settled law that there can be no copyright in information or in an opinion per se. Copyright can only be claimed in the composition or language which is chosen to express the information or the opinion.” [Emphasis added]

(c) Is the Final Draft a ‘literary work’?

Section 7(2) of the 1979 Act states that literary, artistic and scientific works include “*books, pamphlets and other writings*”.

Section 7(3) of the 1979 Act states that a work is protected notwithstanding its quality and the purpose for which it is created.

The minimum standard of a literary work required to attract copyright was set out in *University of London Press Limited v University Tutorial Press Ltd* (*supra*) at 608 wherein the court had to address whether examination papers were subject to copyright. It was held:

“In my view the words “literary work” cover work which is expressed in print or in writing, irrespective of the question whether the quality or style is high. The word “literary” seems to be used in a sense somewhat similar to the use of the word “literature” in political or electioneering literature and refers to written or printed matter.” [Emphasis added]

In order to determine if a work constitutes a literary work under the 1979 Act, it is necessary to consider the work performed, instead of the quality and purpose for which the draft was created. In *Football League Limited v Littlewoods Pools Limited* (*supra*) at 650, it was held:

“Compilations frequently, though not, of course, necessarily, consist of merely quasi-statistical reference matter such as railway time tables, horse breeding material, catalogues, indices, solar and lunar calendar events and reference directories. Such material has no literary merit in the sense of having grammatical composition. ... Copyright for such a compilation can be claimed successfully if it be shown that some labour, skill, judgment or ingenuity has been brought to bear upon the compilation. The amount of labour, skill, judgment or ingenuity required to support successfully a claim for copyright is a question of fact and degree in every case.” [Emphasis added]

The Respondent, Shantha Suraweera and the representatives had collected data and decided on the type of data that should be included; which photographs should be taken and used and, finally, compiled and composed the final draft of an inventory containing a written description supported by sketches, diagrams and photographs which was user friendly, pedagogic and easily read by a non-technical readership while containing basic data on craft and gear for identification.

Hence, I am of the opinion that the Final Draft prepared by the Respondent and Shantha Suraweera constitutes a 'literary work' within the meaning of Section 7(1) of the 1979 Act.

(d) Are the Sketches and Photographs in the Final Draft subject to Copyright?

As required by the Agreement, the Respondent and Shantha Suraweera took measurements and prepared sketches which were included in the Final Draft. The 1979 Act states that protected works include '*works of drawing*' under section 7(2)(g).

In *Vermaat and Powell v Boncrest Ltd* [2001] FSR 5, the court held that the annotated drawings of bedspreads were protected by copyright though they were not exclusively pictorial. Thus, I am of the opinion that the sketches included in the Final Draft are subject to copyright.

Further, they took photographs of the fishing craft and gear and included them in the Final Draft. Under section 7(2)(h), '*photographic works*' are also protected under the 1979 Act. In *Absolute Lofts South West London Ltd v Artisan Home Improvements Ltd* [2015] EWHC 2608 (IPEC), the court awarded damages for infringement of copyright in photographs of loft conversions.

In *Associated Newspapers of Ceylon v Chandragupta Amerasinghe* [2013] 1 SLR 290, the court held that the use of photographs taken of the 1983 communal riots without the approval of the photographer amounted to an infringement of copyright.

The Final Draft contained photographs that were taken and drawn by the Respondent and Shantha Suraweera using their skill and judgment. Thus, I am of the view that the abovementioned photographs satisfy the criteria set out in section 7(2)(h) of the 1979 Act.

(e) Is the Final Draft a Protected Work?

As stated above, the Final Draft (which included the sketches and photographs) authored by the Respondent and Shantha Suraweera is an original literary work within the meaning of section 7 of the 1979 Act and is therefore copyright protected.

Have the Moral Rights Been Transferred by the Agreement?

Moral rights are personal rights which protect the personal rights of an author in respect of the treatment and control of the author's works.

England's Statute of Anne was enacted in 1710 to introduce substantive rights and definitive procedures relating to copyright and its purpose was described as to encourage learned men to compose and write useful books. Cornish and Llewellyn (5th Edition) stated that the concept of moral rights evolved primarily from Continental Europe in recognition of the need to safeguard the artistic integrity of the author. The concept of moral rights was incorporated into the Berne Convention for the Protection of Artistic and Literary Works at the 1928 Rome Conference. As a signatory to the aforementioned convention, moral rights were incorporated into our law by the Legislature.

Moral rights are enshrined in section 11 of the 1979 Act which states:

“(1) *The Author of a protected work shall have the right –*

- (a) to claim authorship of his work, in particular that his authorship be indicated in connexion with any of the acts referred to in Section 10, except when the work is included incidentally or accidentally when reporting current events by means of broadcasting or television;*
- (b) to object to, and to seek relief in connexion with, any distortion, mutilation or other modification of, and any other derogatory action in relation to, his work, where such action would be or is prejudicial to his honour or reputation.*

(2) The rights referred to in subsection (1) shall subsist for the life of the author and fifty years thereafter. After his death, the said rights shall be exercisable by his heirs.

(3) The rights referred to in subsection (1) shall be exercisable even where the author or his heirs do not have the rights referred to in Section 10.

(4) The rights referred to in subsection (1) are not transferable.”
[Emphasis added]

The Appellant’s submission that a specific contractual clause was necessary for the Respondent to retain his moral rights is not sustainable in view of the said section 11(4). Nor can it be argued that Clause 5 of the Standard Conditions of Contract annexed to the Agreement which transfers “*all property*” in the work carried out transferred moral rights in view of the specific prohibition stipulated in section 11(4).

Additionally, the nature of the Respondent’s employment is irrelevant when it comes to the question of moral rights as moral rights attach to the author of a work and are non-transferable in terms of the law.

Hence, I am of the opinion that the moral rights of the Respondent and Shantha Suraweera relating to the Final Draft cannot be transferred under the said Agreement.

Translations

It is necessary to note that section 10 of the 1979 Act, *inter alia*, states that the author of a protected work has the right to reproduce and translate the whole work or a part thereof. As the Department is the current holder of the economic rights to the Final Draft, it has the right to translate the Final Draft as per section 10 of the 1979 Act.

The rights in translations are set out in section 8 of the 1979 Act which states:

“(1) *The following shall also be protected as original works –*

- (a) translations, adaptations, arrangements and other transformations of literary, artistic and scientific works...*

(2) The protection of any work referred to in subsection (1) shall be without prejudice to any protection of a pre-existing work utilised by the making of such work.” [Emphasis added]

As noted earlier, section 11(4) states that moral rights are not transferable and section 11(3) states that they may be exercised even when the economic rights have been transferred.

At this point, it is also worthy to consider Section 15 of the 1979 Act which states:

“Where any work has not been published in Sinhala or Tamil within ten years from its having been published for the first time in its original language, it shall be lawful to translate the said work into Sinhala or Tamil, as the case may be, and to publish such translation, even without the authorisation of, and without any payment to the owner of the copyright of the work, without prejudice to the application of the provisions of section 11.” [Emphasis added]

Thus, I am of the view that the protection afforded to moral rights is of a standard that when an economic right holder lawfully translates a protected work, moral rights can still be asserted by the author who created the original work.

Do the Published Work and the Translation Thereof Infringe the Moral Rights of the Respondent?

(a) The Right to Have Authorship Indicated

Upon comparing the Final Draft and the Published Work, it is evident that the same wording and structure have been copied short of some typographical errors and minor changes to formatting.

Further, the first, second, sixth and ninth paragraphs of the preface submitted by the Respondent were copied verbatim and five new paragraphs were added by the 1st Defendant. Most notably, the paragraph by the Respondent thanking Shantha Suraweera for his work on the project was deleted and 1st Defendant’s name at the bottom of the preface replaced the Respondent’s name.

Therefore, having compared the Final Draft and the Published work, I am of the opinion that the Published Work was merely the Final Draft with an altered cover page and preface.

Thus, the removal of the Respondent and Shantha Suraweera’s names from the cover page and preface amount to an infringement of the Respondent’s moral right to have his joint authorship with Shantha Suraweera recognised.

(b) The Right to Have Authorship Indicated in a Translation

As opined earlier, an author can exercise his moral rights with regard to translations of a work by having his or her name indicated as the author of the original work which was subject to translation.

While the prayer in the plaint filed in the Commercial High Court refers to translations in Sinhala and Tamil, it must be noted that only the Sinhala translation of the Published Work was produced at the trial.

In the circumstances, the Respondent and Shantha Suraweera were entitled to exercise their moral rights with regard to the translation of the Published Work even though the translation was lawful as the economic rights to the Final Draft are held by the Department.

Therefore, I am of the opinion the Respondent and Shantha Suraweera are entitled to have his work acknowledged when the translations were published.

(c) Did the Department Mutilate or Distort the Final Draft?

With regard to the allegation of mutilation or distortion of the Final Draft, I am of the view that although there are minor errors in the publication, they are insufficient to constitute mutilation or distortion within the meaning of Section 11(1)(b).

Did the Respondent Waive his Right to Claim Moral Rights to his Work?

The Appellant submitted that the Respondent participated in the negotiations and the drafting of the said Agreement. Further, the Respondent signed the Agreement on behalf of Messrs. Neil Fernando and Company. Therefore, the Appellant argued that the Respondent should have secured his moral rights by including a clause in the Agreement to protect such rights. Further, the aforementioned process, he acquiesced by conduct and this amounted to waiver of his moral rights, if any. Hence, he is now estopped from claiming moral rights.

With regard to the concept of waiver, section 87 of the UK's Copyright, Designs and Patents Act of 1988 states:

“(1) It is not an infringement of any of the rights conferred by this Chapter to do any act to which the person entitled to the right has consented.

(2) Any of those rights may be waived by instrument in writing signed by the person giving up the right.

(3) A waiver –

(a) may relate to a specific work, to works of a specified description or to works generally, and may relate to existing or future works, and

(b) may be conditional or unconditional and may be expressed to be subject to revocation;

and if made in favour of the owner or prospective owner of the copyright in the work or works to which it relates, it shall be presumed to extend to his licensees and successors in title unless a contrary intention is expressed.

(4) Nothing in this Chapter shall be construed as excluding the operation of the general law of contract or estoppel in relation to an informal waiver or other transaction in relation to any of the rights mentioned in subsection (1)”

Waivers of moral rights has now been included under section 10(3) of the Intellectual Property Act No. 36 of 2003 which is set out below:

“The author may waive any of the moral rights mentioned in subsection (1), provided that such a waiver is in writing and clearly specifies the right or rights waived and the circumstances to which the waiver applies:

Provided that, where a waiver of the rights under paragraph (c) of subsection (1) specifies the nature and the extent of the modification of other action in respect of which the right is waived, subsequent to the death of the author or the physical person or legal entity upon whom or which the moral rights have devolved shall have the right to waive the said rights.”

Since there is no similar provision regarding waiver and acquiescence in the 1979 Act, I am of the opinion that the Respondent has not waived his moral rights to the work he had created under the Agreement. In fact, waiver was not part of the Sri Lankan law in terms of the 1979 Act and only became part of our law when the Intellectual Property Act No. 36 of 2003 was enacted.

Remedies for the Infringement of Moral Rights

The purpose of indicating authorship is to ensure that authors are given due recognition for their work and thereby protect society as a whole. The need to afford such protection to artists, authors and other creators of works was summarised in *Tolnay v Criterion Film Productions Limited* [1936] 2 AER 1625 at 1626 and 1627:

“All persons who have to make a living by attracting the public to their works, be they artistes in the sense of painters, or be they literary men who write books or who perform in other branches of the arts, such as pianists or musicians, must live by getting known to the public.”

The remedies for infringement of copyright are set out in section 21 of the 1979 Act which provides:

“(1) Any person who infringes any of the rights protected under this Part may be prohibited by injunction from continuing such infringement and may also be liable in damages.

(2) The provisions of Chapter XXXII relating to infringements shall apply, mutatis mutandis, to the rights protected under this Part.” [Emphasis Added]

The ‘Part’ referred to in section 21 includes moral rights under section 11; thus, the remedies for copyright infringement include remedies for the infringement of moral rights. As stated earlier, the moral right infringed by the Department in this case is the moral right to claim authorship to the Published Work and, therefore, the remedies available under section 21 need to be considered.

In relation to the infringement of the right to claim authorship, injunctions may be granted under section 21 to prevent the circulation of works that have not been attributed to the author. Further, damages could be awarded in order to compensate for losses suffered in appropriate cases.

The word “*may*” in section 21 of the 1979 Act makes the award of damages discretionary and I am of the view that due consideration must be given to the circumstances and the facts of each case if damages are to be awarded.

Assessing the Quantum of Damages

The issue with a moral rights infringement is that it often deals with intangible or non-monetary losses. One approach of calculating damages is to compare the position of the affected person before and after the infringement and to raise the affected person to the position they would have been prior to the wrong. The other approach is to consider what the affected person's position would have been if his rights had not been infringed and what benefits could have been gained.

In this instance, it would be more appropriate to apply the latter approach as the Respondent is unable to quantify the damages for not being attributed as a joint author of the Published Work.

The benefit that would have been gained if the right had not been breached is generally considered to be publicity. G. Davies and K. Garnett in *Moral Rights* (Sweet and Maxwell, 2010) at 10-056 stated:

“The measure of damages for infringement of the paternity right will usually be related to the loss of recognition of publicity thereby caused.”

Further, the case cited by the Respondent, *Tolnay and Another v Criterion Film Production (supra)* at 1627, addresses the question of financial loss when the defendants failed to give the plaintiffs screen credit. The court held as follows:

“... I doubt not that the loss of publicity is serious to an author. ... One way in which they can expect remuneration and expect employment is by getting their name before the public. Therefore, I think that as they have been deprived here of screen credit, it must be that they have suffered damage, and it must mean that they have suffered damages which is not nominal, and I am bound to give them a separate sum for each.”
[Emphasis added]

While loss of publicity is one aspect, I am of the opinion that it is necessary to consider other relevant factors when awarding damages for the infringement of the moral right to claim authorship. Such factors include whether it is a flagrant or innocent infringement, lost employment opportunities, the competitive or non-competitive nature of the infringement and profits made from the infringing publication. However, the award of damages should not be a windfall.

Further, in instances where the economic rights have been transferred, the price paid for the economic rights ought to be taken into consideration when awarding damages for the infringement of moral rights. However, if the economic rights have been transferred for purposes such as charity and other considerations, the consideration paid will not be a deterrent to award damages for the breach of moral rights.

Was the Award of Damages Excessive?

The Appellant submitted that in any event, the damages awarded by the trial judge were excessive.

In response, the Respondent contended that the quantum of damages awarded by the trial court was justified on the basis of moral rights infringement when considering the failure to indicate joint authorship, altering the preface, replacing the Respondent's name with the 1st Defendant's

name and the loss of employment opportunities due to the non-recognition as he lost future opportunities to get more work in the relevant field.

It was proved at trial that the names of the Respondent and Shantha Suraweera had been removed from the cover page and only carried the name of the Department. Further, all references to Shantha Suraweera and the Respondent had been removed from the preface. When reading the preface in the Published Work, it is apparent that the Published Work was attributed solely to the said Department and, therefore, a reader of the Published Work would not know the Respondent and Shantha Suraweera are the joint authors of the said work.

The Respondent further stated that he persuaded Messrs. Neil Fernando and Company to undertake the work as the work would give him publicity and as such he worked on a lower hourly rate than usual.

The Respondent submitted that the infringement was flagrant as his name and Shantha Suraweera's name had been removed intentionally. It was further submitted that the failure to indicate his joint authorship deprived him of publicity and career opportunities. Further, when applying for consultancy positions, the number of publications attributed to his name was one of the criteria used to assess his suitability for the position. Thus, the failure to indicate his joint authorship deprived him of more opportunities and higher income consultancy positions which resulted in a financial loss.

Although a specific sum was not proved, I am of the view that the trial court was correct in deciding to award damages to the Respondent. In light of the aforesaid conclusion, it is necessary to consider whether the damages awarded by the trial judge are excessive.

It is appropriate to award a fair and reasonable sum as compensation taking into consideration the facts and circumstances of the infringement referred to above.

The Respondent and Shantha Suraweera were identified as key personnel in the Agreement and later the Department organised the workshop to critique the Final Draft; therefore, the Department knew that the joint authors of the Final Draft were Shantha Suraweera and the Respondent. However, the cover page and the preface had been changed to give the impression that the work was carried out by the said Department.

Moreover, a document was produced during trial titled 'Sri Lanka/FAO National Workshop on Development of Community-Based Fishery Management'. An article within the said document cited the Final Draft under consideration in this appeal and attributed the Respondent and Shantha Suraweera as the joint authors. The citation was marked as 'Xd' at trial. Thus, the Department was aware that the Respondent and Shantha Suraweera were the authors of the Final Draft and acknowledged them as such in the aforementioned document.

It is important to note that in the instant case, the Respondent did not have an opportunity to read the final version of the draft before it was printed and published, and therefore, he did not have an opportunity to stop the publication by way of an injunction.

I am of the view that the Respondent was deprived of publicity and future prospects of seeking similar work when the Appellant failed to indicate the Respondent's joint authorship in connection with the Published Work and the translation of the Published Work.

As stated above, after considering the Department's actions with regard to the Published Work, particularly the removal of the Respondent and Shantha Suraweera's name from the cover page of the Published Work, the alteration of the preface including the removal of the line thanking Shantha Suraweera and publishing the book without the knowledge of the Respondent and

Shantha Suraweera amount to flagrancy. Moreover, the work was published in such a manner that the public would believe that the work was created by the Department.

The Respondent also claimed exemplary damages. Exemplary damages are a highly contentious form of civil remedy due to their punitive element. The House of Lords in *Rookes v Bernard* [1964] AC 1129 laid down the governing principles of awarding exemplary damages. Exemplary damages may be awarded where, *inter alia*, the infringer had made a calculated infringement with the knowledge that his profit would be more than the compensation he would be required to pay. However, in *Kuddus v Chief Constable of Leicestershire* [2002] 2 AC 122, it was held that exemplary damages could only be granted in limited circumstances.

Evidence led at trial revealed that the Department was under the misconception that the moral rights were transferred to the Department under the Agreement. Further, there was no mutilation or distortion of the work handed over to the Department. The infringement by the Department was also a non-competing infringement. In these circumstances, I am of the view that though exemplary damages could be awarded in the event of a serious and abusive breach of a moral right, the instant case does not warrant awarding exemplary damages.

Taking into the consideration all the facts and circumstances of this case stated above, particularly with regard to the misconception of ownership of the moral rights by the Department and the non-competing nature of the infringement, I am of the opinion that the sum of Rs. 1.5 million awarded in terms of prayer (i), (iv), (vi) and (viii) of the amended plaint was excessive.

The loss of publicity, future prospects of securing similar work, the flagrancy of the infringement and the fact that the Respondent charged a lesser hourly rate to perform the work under the contract, I am of the opinion that the sum of Rs. 500,000/- with legal interest thereon would meet the ends of justice in this case.

Hence, I modify the award of Rs. 1.5 million with legal interest thereon and award a sum of Rs. 500,000/- as damages with legal interest thereon.

I affirm the judgment of the trial judge subject to the abovementioned modification of the above quantum of damages awarded to the Respondent.

However, The Department is entitled in law to publish and distribute the Published Work and translations thereof subject to the aforementioned intellectual property rights of the Respondent and Shantha Suraweera (i.e. by acknowledging them as joint authors).

I order no costs.

Judge of the Supreme Court

Buwaneka Aluwihare, PC, J

I agree

Judge of the Supreme Court

Nalin Perera, J

I agree

Judge of the Supreme Court