


IN THE HIGH COURT OF SOUTH AFRICA

(NORTH GAUTENG HIGH COURT - PRETORIA)	
DELETE WHICHEVER IS NOT APPLICABLE	
(1) REPORTABLE :	YES/NO
(2) OF INTEREST TO OTHER JUDGES :	YES/NO
(3) REVISED	
DATE <u>11-5-11</u>	
In the matter between:	SIGNATURE

Date: 2011-05-13
Case Number: 14421/11

TELE ATLAS AFRICA (PTY) LTD

First Applicant

MAPSTUDIO, A DIVISION OF NEW HOLLAND

PUBLISHING (SOUTH AFRICA) (PTY) LTD

Second Applicant

and

AFRIGIS (PTY) LTD

Respondent

JUDGMENT

SOUTHWOOD J

[1] In their notice of motion the applicants apply for final, alternatively, interim interdicts against the respondent in the following terms:

- (1) An order interdicting the respondent from infringing the applicants' copyright in and to the Maps and the Digital Maps referred to in paragraph 12 of the founding affidavit by –

- (i) reproducing or otherwise copying the Maps and/or Digital Maps or any portion thereof in any manner or form;
 - (ii) making any adaptations of the Maps and/or Digital Maps or any portion thereof;
 - (iii) reproducing any adaptations of the Maps and/or Digital Maps or any portion thereof;
 - (iv) selling, letting by way of trade, offering or exposing for sale or hire or distributing reproductions, copies and/or adaptations of the aforesaid Maps and/or Digital Maps;
- (2) An order that the respondent cease the use and distribution of all maps which are copies, reproductions, adaptations, and/or derivations of the Maps and/or Digital Maps in whatever manner or form and to remove and/or destroy all such maps from its database, alternatively to deliver such maps to the applicants.

[2] The first applicant is a South African company which is a leading provider of digital mapping, navigation and map data solutions. The second applicant is New Holland Publishing (South Africa) (Pty) Ltd a South African company which carries on business under the name of Mapstudio as a cartographer, publisher and distributor of printed street guides, road maps, atlases, tourist maps, wall maps and educational

products. The second applicant has been wrongly cited as Mapstudio but the respondent has not taken issue with this. The respondent is a South African company which is one of the leading providers of geographical information system solutions and location-based services in Southern Africa.

- [3] The applicants contend that the respondent is infringing their copyright in respect of certain maps and digital maps. The respondent denies that the applicants are the owners of the copyright in respect of the maps and digital maps and that it copied the maps and digital maps and asks that the application be dismissed with costs. The respondent summarises its case as follows:

'16 I am advised that, because it is trite law that copyright is a technical subject, it is necessary for an applicant to show that the works in respect of which protection is sought are eligible for copyright and that copyright had vested in the works. This requirement, I am also advised, includes proof that the works relied upon are indeed "works" as defined in the Copyright Act, 1978; that they are original and not copied from any pre-existing work; that they have been reduced to material form; that they were created by a qualified person; that the applicant is the owner of the works; and that there has been an infringement of the works. In respect of the latter, I am further advised, it is necessary for the applicant to show a (qualitatively) substantial similarity between the alleged copyrighted work and the alleged infringing work, and

causality, i.e., actual access to the alleged copyrighted works by the alleged infringer and a copying.

17 A perusal of the founding and supporting affidavits relied upon by the applicants show that the applicants have in no manner discharged that onus.'

[4] At the hearing the applicants' counsel conceded, correctly in my view, that the applicants' case for interim relief is 'thin' and did not argue that such relief should be granted. It is clear that the applicants have not sought to make out a case for interim relief as set out in cases such as ***Reckitt & Colman South Africa (Pty) Ltd v SC Johnson & Son (Pty) Ltd 1995 (1) SA 725 (T)*** at 729I-730G.

[5] The applicants therefore seek final relief on notice of motion. In motion proceedings the general rule is that a court can grant final relief only if the facts alleged by the applicant and admitted by the respondent together with the facts alleged by the respondent justify the grant of such relief. However, the court may resolve disputes of fact on essential issues if the denials of fact or allegations by the respondent are so clearly untenable that the court can reject them on the papers – see ***Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 625 (A)*** at 634E-635C: ***National Director of Public Prosecutions v Zuma 2009 (2) SA 277 (SCA)*** para 26. The applicants do not contend that any of the respondent's denials or allegations of fact should be rejected and the case must therefore be decided in accordance with the general rule.

[6] In order to grant a final interdict against the respondent the court must be able to find on the evidence presented that –

- (1) the applicants have established a clear copyright in respect of the works relied upon;
- (2) the respondent has infringed that right; and
- (3) the absence of similar protection by any other remedy – see ***Setlogelo v Setlogelo* 1914 AD 221** at 227.

[7] It is trite that an applicant must make out his case in the founding affidavit and it is not permissible to make out new grounds for the application in the replying affidavit – see ***Director of Hospital Services v Mistry* 1979 (1) SA 626 (A)** at 635F-636B; ***Titty's Bar and Bottle Store (Pty) Ltd v ABC Garage & Others* 1974 (4) SA 362 (T)** at 369A-B; ***Herbstein & Van Winsen* *The Civil Practice of the High Courts of South Africa* 5 ed Vol 1 440-442**. The applicants have disregarded that rule and included in their replying affidavit new evidence and invited the respondent to file a further answering affidavit. Without agreeing to the new evidence being filed the respondent filed a further answering affidavit to be taken into account in the event the court was prepared to take the new evidence into account. In the absence of a satisfactory explanation for failing to include the evidence

in the founding affidavit I am not prepared to have regard to the new evidence. The applicants' counsel did not advance any argument as to why the court should do so.

[8] The applicants allege that the maps are derived from (original) maps created by employees of Map Studio Productions (Pty) Ltd ('MSP') in 1971-1972 and updated and improved by the various companies to whom copyright in the original maps was assigned. According to the applicants the maps in respect of which they own copyright are 'essentially updated and improved versions of the original maps'.

[9] The first applicant claims to be the owner of copyright in 'a digital map database for the sub-Saharan region' but alleges that it used the second applicant's maps as source material to create 'digital maps' which are digital versions of the maps and the data recorded therein. The applicants do not attach to their founding affidavit either the digital map database or the digital maps or explain in the founding affidavit what they consist of. The second applicant claims to be the owner of the copyright in the following printed maps ('the Maps'):

- (a) Editions 6-9 of the Pretoria Street Guide;
- (b) Editions 9-12 of the Witwatersrand Street Guide;
- (c) Editions 11-12 of the Cape Town Street Guide.

Once again the applicants do not attach to their founding affidavit the street guides referred to or explain in the founding affidavit what the street guides consist of.

- [10] The applicants seek relief in terms of the Copyright Act 98 of 1978 ('the Act') which governs the existence, content and enforcement of copyright in South Africa. The Act comprehensively provides for all aspects of copyright: what works are eligible for copyright (section 2 read with section 1); who the 'author' in respect of each such work is (section 1); how copyright is conferred on the author of each work (section 3) – in the case of an individual, that at the time of making the work the author was a South African citizen or was domiciled or resident in South Africa and in the case of a juristic person, it is incorporated under the laws of the Republic of South Africa alternatively how copyright is conferred by virtue of being first published or emitted (in the case of a program-carrying signal) in the Republic of South Africa (section 4(1)); that (except for a broadcast or program-carrying signal) a work is not eligible for copyright unless it has been written down, recorded, represented in digital data or signals or otherwise reduced to material form (section 3(2)); that in order to be eligible for copyright a work must be 'original' (section 2(1)); the nature of the copyright in respect of each type of work (sections 6, 7, 8, 9, 10, 11, 11A and 11B); the exceptions from protection in respect of the various kinds of work (sections 12, 13, 14, 15, 16, 17, 18, 19, 19A and

19B); who qualifies as the owner of copyright in respect of the eligible works (section 21); how copyright is assigned and licences are granted (section 22); how copyright is infringed (section 23); that infringements are actionable at the suit of the owner, the exclusive licensee and the exclusive sub-licensee of the copyright and what remedies are available to the owner, licensee and sub-licensee of the copyright (sections 24 and 25); a number of procedural matters regarding infringement proceedings (section 26) and various ancillary matters not presently relevant. In view of all these requirements it has been said that copyright cases are technical and that in enforcing any copyright claim it is necessary to establish a copyright claim in the name of a particular claimant and to determine whether or not copyright infringement has taken place – see ***King v South African Weather Service 2009 (3) SA 13 (SCA)*** paras 5-10.

[11] In the present case, the second applicant alleges that it owns the copyright in the various editions of the street guides (i.e. 'maps') while the first applicant alleges that it owns the copyright in the digital maps which apparently are digital versions of the maps and the data recorded therein. The applicants contend that the maps and map data are literary works – because they are a compilation 'of an enormous amount of information' and artistic works.

[12] In order to establish a clear right the applicants first had to identify the maps or digital maps which are alleged to be the subject of their

copyright (this is of the utmost importance – see *King v South African Weather Service* 2009 (3) SA 13 (SCA) para 6) and having done so the applicants had to establish in respect of each map and digital map that –

- (1) copyright subsists in the map or digital map: i.e.
 - (i) each author reduced it to material form (section 2(2));
 - (ii) it is original (section 2(1)) in that it was not copied from other sources and was the product of the author's or maker's own labours – see *Topka v Ehrenberg Engineering (Pty) Ltd* Judgments on Copyright (JOC) 74; *Waylite Diaries CC v First National Bank Ltd* 1993 (2) SA 128 (W) at 132G-I; *Waylite Diaries CC v First National Bank Ltd* 1995 (1) SA 645 (SCA) at 649F-650D; *Klep Valves (Pty) Ltd v Saunders Valve Co Ltd* 1987 (2) SA 1 (A) at 22G-23B – or if it was copied, it was not slavishly copied and, as a result of the author's own skill and labour, it achieved originality – *Klep Valves supra* 22J-23A;
 - (iii) each author was a qualified person because, when the map was made, the author was a South African citizen or was domiciled or resident in South Africa (section 3(1)(a))

or the company in whose service the author was was a company incorporated under the laws of the Republic of South Africa (section 3(1)(b)) alternatively, the map was first published in South Africa (section 4(1));

(iv) each author of the map made the map in the course and scope of his employment by the employer (section 21(1)(d));

(v) the author's employer assigned the copyright in the map to a person who assigned it to the applicant (section 22);

[13] Having established that they are the owners of copyright in the maps and digital maps the applicants had to prove that the respondent infringed the applicants' copyright in the map or digital map by reproducing the map or digital map (section 6(a)) (i.e. made a copy of a substantial part of the map or digital map (section 1(2A)) or by making an adaptation of the work (i.e. an adaptation of a substantial part of the map (section 1(2A))).

[14] With regard to copyright infringement by reproduction the court in ***Jacana Education (Pty) Ltd v Frandsen Publishers (Pty) Ltd 1998 (2) SA 965 (SCA)*** summarised the relevant principles at 972A-J:

'As Corbett JA pointed out in ***Gallago Publishers (Pty) Ltd and Another v Erasmus 1989 (1) SA 276 (A)*** at 280B-D, in order to

prove copyright infringement by reproduction the plaintiff must establish two distinct things, namely

- “... (i) that there is a sufficient objective similarity between the alleged infringing work and the original work, or a substantial part thereof, for the former to be properly described, not necessarily as identical with, but as a reproduction or copy of the latter; and
- (ii) that the original work was the source from which the alleged infringing work was derived, i.e. that there is a causal connection between the original work and the alleged infringing work, the question to be asked being: has the defendant copied the plaintiff’s work, or is it an independent work of his own?”

It is upon the first element that I would focus. The existence of prior subject-matter may render proof of objective similarity more difficult for a plaintiff. Burger J said in ***Bosal Afrika (Pty) Ltd v Grapnel (Pty) Ltd and Another* 1985 (4) SA 882 (C)** at 889C-D:

“Mr. Puckrin, on behalf of defendants, is correct when he argues that “the objective similarity” must be judged in the light of the state of the art as at the date of the making of the alleged original work. Thus, although the alleged infringement and the original work may bear a close resemblance, this resemblance may be explained by the fact that they both incorporate common prior art.”

See also the remarks of Nicholas J in ***Laubscher v Vos and Others* 3 JOC (W)** at 6, where the learned Judge observed that in the case of truly original artistic works a mere comparison usually provides a ready answer, whereas the answer may not be so readily reached if the copyright and the alleged infringing works may have a common source.

The importance of the plaintiff's identifying *those parts of his work* which he alleges have been copied is made clear by Millett J in a case where a "Dog-N-Boots" design was alleged to be a reproduction of a "Puss-N-Boots" design. The case was ***Spectravest Inc v Aperknit Ltd* [1988] FSR 161**. The relevant passage appears at 170:

"Accordingly, where the reproduction of a substantial part of the plaintiffs' work is alleged, a sensible approach is first to identify the part of the plaintiff's work which is alleged to have been reproduced and to decide whether it constitutes a substantial part of the plaintiff's work. The test is qualitative and not , or not merely, quantitative. If it does not, that is the end of the case. If it does, the next question is whether that part has been reproduced by the defendant. Reproduction does not mean exact replication. A man may use another's work as an inspiration to make a new work of his own, treating the same theme in his own manner; but he is not entitled to steal its essential features and substance and retain them with minor and inconsequential alterations. The question is whether there is such a degree of similarity between the salient features of the two works that the one can be said to be a reproduction of the other. In considering whether a substantial part of the plaintiff's work has been reproduced by the defendant, attention must primarily be directed to the part which is said to have been reproduced, and not to those parts which have not."

- [15] With regard to copyright infringement by adaptation the Act contains extended definitions of the word 'adaptation' in relation to the various categories of copyright. The only definition which could be relevant in the present case is that in relation to an artistic work: i.e. adaptation includes a transformation of the work in such a manner that the original or substantial features thereof remain recognisable.

[16] The applicants' difficulties start with the identification of the subject of the copyright. The second applicant's main deponent, Mr. Grobben, alleges that it is the owner of the copyright 'in a number of printed maps and map data relating to sub-Saharan Africa' which 'qualify as literary works (consisting, at the very least, of a compilation of an enormous amount of information) and artistic works' in terms of the Act. Without explaining further what these printed maps and map data consist of the second applicant alleges that it is the owner of the copyright in editions 6-9 of the Pretoria Street Guide, editions 9-12 of the Witwatersrand Street Guide and editions 11-12 of the Cape Town Street Guide (collectively 'the Maps'). In her supporting affidavit, Ms. Lois O'Brien states that the second applicant is the owner of the copyright in the maps 'being the artistic layout, as artistic works and the map data, as literary works'. She does not explain what the concepts 'artistic layout' and 'map data' mean. The first applicant alleges that it is the owner of the copyright in a 'digital map database for the sub-Saharan Africa region' and that it used the (second applicant's) Maps as source material for the creation of the Digital Maps which are 'essentially digital versions of the Maps and the data recorded therein'. Nowhere in their affidavits do the applicants explain what a street guide is or what it consists of and identify which part of each street guide is an artistic work and which part is a literary work. The second applicant has not attached to its affidavits any of the street guides referred to and it is therefore not possible to form any idea as to the precise nature and extent of the street guides. All that the applicants attach to their

affidavits is six pages each containing a map of a small defined area (annexures 7.1, 8.1, 9.1, 10.1, 11.1 and 12.1). Four of these appear to relate to Pretoria, one to Kempton Park and one to Cape Town. The applicants do not say from which edition of the street guides the annexures have been taken. The relevance of these six pages, according to the applicants, is that they contain false information which the applicants contend is to be found in the respondent's allegedly offending maps. (In the respondent's case the word 'map' is used loosely or in an extended sense as the respondent's 'maps' appear to be aerial photographs with the names of roads inserted. For present purposes it will be accepted that the respondent's allegedly offending works are maps.) The first applicant does not explain what a 'digital map database' or a 'digital map' is. The applicants have not annexed a copy of a 'digital map' to the founding affidavit.

- [17] Having identified the maps which are allegedly the subject of their copyright the applicants proceed to explain how the maps were created. None of the maps is a first creation. According to the applicants the maps are 'derived from maps and map data which were originally created between 1971 and 1972 by employees of Map Studio Productions (Pty) Ltd ('MSP') during the course and scope of their employment'. The applicants refer to these maps as the 'Original Maps'. The applicants do not say what these 'Original Maps' consisted of and do not attach copies of these maps to the papers. According to the applicants, in 1977 MSP assigned the copyright in the original

maps to Buckley Map Productions (Pty) Ltd which 'updated and improved' the original maps. The applicants do not annex copies of the 'updated and improved' maps and they do not explain what the updates and improvements consisted of. According to the applicants, in April 1986, Buckley Map Productions assigned the copyright in the original maps in their updated and improved form to a company then called Struik Holdings (Pty) Ltd (now New Holland Publishing (South Africa) (Pty) Ltd). Thereafter, according to the applicants, employees of the second applicant further updated and improved the original maps resulting in the creation of the maps. It will be remembered that the applicants have not annexed to their founding affidavit the 'maps'. The updates and improvements effected by Struik Holdings (i.e. the second applicant) included the insertion of small insignificant errors into the maps which the applicants refer to as 'copy traps'. The purpose of copy traps is to enable the copyright owner to identify more easily any unlawful reproductions by third parties. Finally, according to the applicants, the company now known as New Holland Publishing (South Africa) (Pty) Ltd purported to assign copyright in the maps to its division Mapstudio.

- [18] Mr. Grobben, the applicants' main deponent who outlines this history has no personal knowledge of the facts. On the assumption that the facts are correct, in the absence of the original maps it is clear that the court cannot conclude that the maps are literary or artistic works. In the absence of the updated and improved original maps it is also clear

that the court cannot conclude that they differ to such an extent from the original maps that they are eligible for copyright.

[19] In order to support his narrative, Mr. Grobben refers to the supporting affidavit by Ms. O'Brien who describes herself as the managing director of the second applicant (i.e. a division of the company called New Holland Publishing (South Africa) (Pty) Ltd). Ms. O'Brien states unambiguously that she has never previously created maps and then purports to confirm that the maps were created between 2000 and 2003 and are derived from the original maps (maps and map data) originally created by MSP between 1971 and 1972. Ms. O'Brien does not have personal knowledge of how the original maps were created and she therefore attaches to her affidavit another affidavit deposed to by Mr. Ray Wilkinson on 3 August 2000 on behalf of Mapstudio (Pty) Ltd and Struik New Holland Publishing (Pty) Ltd in copyright infringement proceedings against i-Maps (Pty) Ltd. The admissibility of the evidence in Mr. Wilkinson's affidavit is contentious but no acceptable reason for excluding it was suggested by the respondent.

[20] Mr. Wilkinson describes in detail how, in 1972, MSP produced and published a street guide of Cape Town and its surrounding areas. It first produced and published large maps of the urban area of Cape Town and its surrounding areas which were published in fold-out format. (It did the same for Johannesburg and Durban). MPS first produced two large maps depicting different areas of Cape Town. In

about 1975 MSP produced its first Cape Town and Environs Street Guide in book form. In order to produce the first maps MSP had regard to the prior art in existence at the time: maps supplied by the municipalities, trigonometrical survey maps and maps printed by the Cape Divisional Council. MPS eliminated features such as contours, servitudes and unused roads, reduced the scale and used colouring to differentiate main roads, streets, parks, the sea and nature areas. MPS also introduced information of interest: e.g. medical services, provincial and private hospitals, places of interest, historical monuments and museums, theatres, churches and cinemas. MPS combined the various maps to provide a comprehensive overview of the covered area. MPS used this unified map to produce the street guide which is contained in a book, each page depicting a portion of the unified map. It was important to use the right scale to get the right amount of information onto each page as this would determine the number of pages in the guide and the overall printing cost. Mr. Wilkinson describes in detail the effort and skill involved in creating the large maps and obtaining the information to be inserted and then reducing the information to book form.

- [21] Mr. Wilkinson deals only with the production and publishing of the Cape Town map. He refers in passing to the maps of Durban, Witwatersrand and Vaal Triangle but does not provide all the relevant detail. He does not even refer to Pretoria. The supporting affidavit of John Hall, the MPS cartographer involved in the production of the Cape

Town map does not take the matter further. He merely confirms what Mr. Wilkinson said in 2000. Ms. O'Brien is aware of this deficiency but contends that 'the probabilities are overwhelming that MPS produced the original maps for other geographical areas in South Africa in much the same if not identical manner'. This is clearly not evidence but supposition. In the absence of evidence I do not consider that such a finding is justifiable – see *Director of Hospital Services v Mistry supra* at 635F-H. It is significant that Mr. Hall could have confirmed this to be the case but did not do so.

[22] The supporting affidavits therefore do not support Mr. Grobbens' allegation that MSP created original maps of Pretoria and the Witwatersrand and that the second applicant is the owner of the copyright in respect of such maps. They also do not explain how the second applicant could have become the owner of copyright in editions 6-9 of the Pretoria Street Guide and editions 9-12 of the Witwatersrand Street Guide. The evidence does not show why the street guides are eligible for copyright as artistic and literary works. Accordingly, I find that the applicants have not shown that they own the copyright in respect of the street guides and the digital maps.

[23] Even if it is accepted that the second applicant is the owner of the copyright in respect of each street guide there are a number of obstacles in the way of finding an infringement of that copyright.


[24] The first is the respondent's denial that it copied the applicants' works and reproduced or adapted them. The respondent has described in detail how it creates its works. The evidence is consistent with the fact that there is clearly no visual similarity between the applicants' maps and the allegedly infringing maps. They are not co-extensive and they represent the areas concerned in completely different ways. The applicants' maps are clearly drawings whereas the respondent's maps are clearly aerial photographs with the street names superimposed. The applicants' copy traps which are heavily relied upon by the applicants are disputed and it appears as if most of the copy traps appear in other works. The respondent's evidence cannot be rejected and that is the end of the applicants' case.

[25] The second is that the applicants have not established which guides are the subject of the alleged infringement. The applicants allege that they have found at least 80 instances where the applicants' copy traps have been reproduced in the respondent's digital maps but they have not revealed them because the nature and positioning of the copy traps is highly confidential. Accordingly, to prove copying/reproduction of their maps the applicants attach only six pages of their works and those of the respondent but they have not identified which of the guides are involved. Without the relevant guide being identified the court cannot find that the copyright in respect of any one guide has been infringed and issue an appropriate interdict.

- [26] The third is that the substantial part of the relevant guide allegedly reproduced has not been identified. If the relevant annexures are pages from a book (as they appear to be) it is not possible to conclude that they constitute a substantial part of the work. If each page is the completed work then it has clearly not been reproduced or adapted in the respondent's work. There is no objective similarity between the works and the respondent's works do not contain any recognisable features of the applicants' works.
- [27] As far as infringement of the literary work is concerned the applicants have not identified the compilation alleged to be present in each of its maps and the respondent's maps do not contain anything more than street names which is common place data simply inserted along the line indicating the street.
- [28] The applicants have placed great reliance on the reasoning of the court in ***Fax Directories (Pty) Ltd v Fax Listings CC 1990 (2) SA 164 (D)*** at 178F-J but it is clear that the reasoning was based on the facts of the case. The facts of the present case are very different.
- [29] After conceding that the applicants had not made out a case for interim relief applicants' counsel, in argument, requested the court to consider referring the matter to the trial or evidence on specified issues. This was not supported by any argument and I am not persuaded that there is any reason for the court to exercise its discretion in this way.

[30] The following order is made:

The application is dismissed with costs including the costs reserved on
12 April 2011.


B.R. SOUTHWOOD
JUDGE OF THE HIGH COURT

CASE NO: 14421/11

HEARD ON: 9 May 2011

FOR THE APPLICANTS: ADV. R. MICHAU SC
ADV. I. JOUBERT

INSTRUCTED BY: Ms. D. van Wyk of Weavind of Weavind

FOR THE RESPONDENT: ADV. A.J. BESTER SC

INSTRUCTED BY: Mr. H. Blignaut of Spoor & Fisher

DATE OF JUDGMENT: 13 May 2011