

THE EASTERN CARIBBEAN SUPREME COURT
IN THE HIGH COURT OF JUSTICE

MONTSERRAT

CLAIM NO. MNIHCV 2019/0001

BETWEEN:

[1] KEVIN WEST

Claimant

and

[1] EDGE ENTERPRISES LTD. Trading as PEOPLE'S TELEVISION (PTV)

Defendant

Appearances:

Mr. Kevin West Litigant in Person
Dr. David Dorsett for the Defendant

2024: MARCH 21

2024: APRIL 30

JUDGMENT

FITZPATRICK [AG.]:

THE COURT CONSIDERED THE FOLLOWING:

- [1] The Claimant is an individual resident of Montserrat with an enviable array of abilities. He is a carpenter, an artist and a professional photographer who has been published internationally in such acclaimed publications as the New York Times and National Geographic Magazine.

- [2] The Defendant is a limited company incorporated under the *Montserrat Companies Act* that operated a television broadcast station and related production facility located on Montserrat featuring news and assorted entertainment.
- [3] The Claimant, at obvious and considerable personal risk, approached the Soufriere Hills volcano during the early morning hours of January, 1997. The volcano was then literally a radiant red lava dome. Mr. West took a photograph of this truly remarkable sight, which he titled "Glowing Lava Dome" (the "Image").
- [4] The Claimant claimed copyright for the Image. He marketed the Image for sale to the public in various forms, including picture postcards, posters and photobooks all with his copyright noted.
- [5] In or about 2012, the Defendant promoted a DVD video called "Montserrat Volcano Series: Volcanic Relations" exploring the eruption of the Soufriere Hills volcano and the impact on the community. The Defendant offered this video for sale to the public. The cover of this DVD and promotional materials featured the Image (see: Exhibit B and C of the Claimant's Witness Statement filed May 21, 2021). The Image was not part of the video contents itself.
- [6] The Defendant used the Image without seeking or, at any time, obtaining the Claimant's permission. In addition, the DVD cover and promotional materials featuring the Image included a statement below it, namely "Copyright © 2013, People's Television". The Claimant suggests that by doing so the Defendant claimed copyright for the Image.
- [7] The Claimant became aware of the unauthorized use of the Image by the Defendant and the purported copyright claim. In response, the Claimant commenced this action by Claim Form filed January 23, 2019 seeking damages for the copyright infringement.
- [8] The Defendant conceded liability when this case was before Mr. Justice Morley on March 28, 2022. As such, Justice Morley entered Judgment on March 28th for the Claimant as to liability leaving only the determination of quantum.
- [9] The trial respecting quantum was held before this Court on March 21, 2024.

The Trial Evidence

[10] The trial was completed in less than one day. Each party testified. Each party adopted his witness statement as evidence in chief and was subject to cross-examination. I below review the material evidence from each side.

The Evidence for the Claimant

[11] The Claimant was shown and adopted as his evidence in chief the contents of his Witness Statement filed May 21, 2021, his affidavit sworn January 20, 2023 and his Witness Statement filed February 12, 2024.

[12] The Claimant's evidence was that he first became aware of the Defendant's unauthorized use of the Image in 2013. He says that this infringement left him unable to use the Image to generate revenue or otherwise. The Claimant's evidence was that he believed any use of the Image by him risked reprisal from the Defendant given its copyright claim. The Claimant believed that this dispute needed to be determined before he could resume his marketing and sale of the Image.

[13] The Claimant's evidence was that the Image would otherwise have been the highlight of materials he marketed for public sale.

[14] The Claimant testified that he had work as a carpenter available to him that he had to refuse to remain in Montserrat to address this litigation.

[15] The Claimant itemized his losses as follows:

- a) Loss of earnings from postcards of \$15,000.00 EC (3,000 cards at \$5);
- b) Loss of earnings from photobooks of \$92,500.00 EC (500 books at \$185);
- c) Loss of earnings from posters of \$60,000.00 EC (3,000 posters at \$20);
- d) Loss of earnings as a carpenter of \$137,491.20 EC (\$20,160 pounds sterling for each of 2021 and 2022 converted at 3.41 to 1 EC).

The Claimant provided no documents or other details supporting these claimed losses.

[16] The Claimant was unable to recall what his licensing fee was in or around 2013. The Claimant's evidence was that any license fee would be negotiated and would depend on the use intended. He suggested a general license fee range of \$3,000.00 EC and up.

[17] The total of the losses identified above is \$304,991.20 EC. The Claimant seeks the reduced, all inclusive figure of \$35,000.00 EC for his losses in this matter. In addition, the Claimant seeks \$13,500.00 EC representing the legal fees he paid to counsel to represent him earlier in this litigation.

The Evidence for the Defendant

[18] The Defendant called one witness to testify, namely its director and principal, Denzil Edgecombe. Mr. Edgecombe was shown and adopted as his evidence in chief the contents of his Witness Statement filed December 1, 2023.

[19] Mr. Edgecombe stated that he was the managing director of the Defendant. His evidence was that the Defendant was incorporated in 1991 but ceased all operations and business of whatsoever kind in 2012 when Mr. Edgecombe suffered a very serious stroke leaving him unable to work thereafter. Mr. Edgecombe advised that he experienced significant memory issues following his stroke in 2012.

[20] The Defendant has conceded liability.

[21] Mr. Edgecombe acknowledged that his son attended at the Claimant's business purchasing a postcard of the Image. Mr. Edgecombe could not recall whether that postcard of the Image was the same photo used for the subject DVD cover and related marketing materials.

[22] Mr. Edgecombe's evidence was that the DVD was originally produced around 2005 to 2008. He stated that the DVD was packaged by an unnamed third party located in England but he could not recall when. Mr. Edgecombe suggested that this

unnamed third party had selected the Image used on the DVD cover. There was no evidence that any external party prepared the market materials for the DVD, which this Court infers to mean that the marketing materials were produced by the Defendant.

- [23] Mr. Edgecombe's evidence was that the Defendant had "not in any way profited from the use of the Claimant's photo". That said, Mr. Edgecombe could not recall how many DVD's were made. No business or other records of the Defendant were produced to provide any information about the DVD production, marketing, sales or any other related information.

Analysis

- [24] The issue for this Court is to determine what damages are owed to the Claimant flowing from the Defendant's admitted unauthorized use of the Image.

- [25] As detailed above, the Claimant seeks \$35,000.00 EC in global damages plus \$13,500.00 EC for legal fees incurred.

- [26] The Defendant concedes damages are owed.

- [27] The Defendant submits that a licensing fee of \$1,023 EC (\$300 pounds sterling converted at 3.41 to 1 EC) is appropriate relying on the direction from the court in *Absolute Lofts South West London Ltd. V. Artisan Home Improvements Ltd. and another* [2015] EWHC 2608 (IPEC) which stated as follows:

"Sanctions for copyright infringement shall be effective, proportionate and dissuasive. The starting point in an assessment of what the parties would have agreed as willing licensor and willing licensee immediately before the acts of infringement is an accurate characterisation [sic] of the circumstances which are relevant to that assessment (see: paragraphs 10 and 12)."

- [28] The court in *Absolute Lofts* awarded a license fee of \$300 pounds sterling to the claimant in that case on the basis of the "user" principle. The user principle is an

attempt to go back in time to the point immediately prior to the infringing act to have the parties engaged in a license fee negotiation. The point of this exercise is to determine an appropriate fee to award the owner of the copyright as damages for the infringement.

[29] This license fee awarded in the *Absolute Lofts* is clearly distinguishable from this case.

[30] Absolute Lofts was a corporation engaged in the construction business. It was the corporation's principal who would take photographs of his completed works for promotional use, including the photos that were used by the defendant on its website to promote its own construction business. The photographs, therefore, were fairly generic and not done by a professional photographer. In addition, the two corporations were not located or operating in the same area.

[31] In this case, the Image is unique, the Claimant is a professional photographer and the parties are located and operate in Montserrat. I address each of these points in greater detail below.

[32] The decision of the court in *Absolute Lofts* is of assistance for the principles to apply in determining the damages payable in a copyright infringement case. That court presented three heads of damages, namely payment of a license fee applying the user principle, additional damages where the infringer acts with knowledge (i.e. knew or had reasonable grounds to know he was engaging in infringing activity) and damages directed to deterrence if not already achieved through the sums awarded under the other heads of damages.

[33] The court in *Absolute Lofts* awarded additional damages of \$6,000 pounds sterling (\$20,460.00 EC converted at 3.41 to 1) to the claimant for unfair profits arising from the knowing, unauthorized use of the photos in that case.

[34] The Claimant here is entitled to be compensated for the infringement by the Defendant. Generally, he is to be placed in the position he would have been but for the infringing acts.

- [35] The infringement here has two elements, namely the admitted unauthorized use of the Image and the alleged unlawful copyright claim.
- [36] The Court can and does draw the inference on a balance of probabilities that the Defendant obtained the Image from the postcard that was purchased from the Claimant by Mr. Edgecombe's son or thereby became aware of the Image and subsequently sourced it. This is the only logical conclusion flowing from Mr. Edgecombe's testimony that he was aware that his son purchased a postcard of the Image from the Claimant and that the Image subsequently adorned the subject DVD cover along with related marketing materials created by the Defendant. Why else would his son's purchase of a postcard be so distinctly memorable to Mr. Edgecombe all these years later especially given his admitted memory issues following his stroke?
- [37] Given the above, this Court rejects any suggestion by Mr. Edgecombe that the unnamed third party in England that he says packaged the DVD had selected and used the Image on the cover. It is simply not believable that the Image used by the Defendant in its marketing for the DVD was also independently sourced and used by this third party for the DVD packaging.
- [38] The Court also does not accept Mr. Edgecombe's evidence that the Defendant ceased all operations and business of whatsoever kind in 2012. The Defendant's marketing materials for the subject DVD featuring the Image included a statement "Copyright © 2013, People's Television". Clearly, the Defendant was operating in 2013 at minimum.
- [39] The Court makes the above findings simply to address Mr. Edgecombe's evidence. These findings are not otherwise necessary given that the Defendant conceded liability for the unauthorized use of the Image and Judgment for liability was made against the Defendant on that basis. In other words, this Court has already determined that the Defendant made unauthorized use of the Image with the only outstanding issue being the quantum of damages owed to the Claimant flowing from that misconduct.
- [40] The court in *Absolute Lofts* directed that the starting point for compensation in a copyright infringement case is determining the fee that the Claimant and the

Defendant would have negotiated immediately prior to the infringing acts in the context of the specific case circumstances.

- [41] The Claimant is a professional photographer with placements in prestigious, international publications. The Image is without doubt unique in terms of the event captured (i.e. an erupting volcano) and the quality of the photograph (i.e. a fairly close up view of the volcano exterior fully radiating).
- [42] There was no evidence before me of any limitation intended by the Defendant when the Image was initially usurped with regards to intended market or duration of use. There was no evidence this was a campaign limited in any way. In other words, the DVD, including the Image, was being marketed to an international market for an unlimited duration.
- [43] The Claimant is entitled to damages that reflect his pedigree, the uniqueness of the Image and the intended use. As noted above, the Claimant could not recall his licensing fee at the time of the infringing act but suggested a range starting at \$3,000.00 EC.
- [44] Using \$3,000.00 as a starting point, this Court believes that the Claimant and the Defendant would have negotiated a fee of no less than \$5,000.00 EC for the unlimited use of this professional and unique photograph for the DVD cover and in the Defendant's international marketing of the DVD. The fee would not have been at the bottom of the range given the uniqueness and quality of the Image. This \$5,000.00 fee of course would have been agreed to on the basis that the Defendant would acknowledge the Claimant's copyright of the Image in all uses.
- [45] As stated above, the second component of the infringement was the Defendant's alleged false attribution of the copyright of the Image. If established, this is an act separate from the unauthorized use. The Claimant has a right to be recognized and acknowledged as the owner/creator of the Image.
- [46] Mr. Edgecombe in his evidence attempted to deflect fault saying that copyright was only being claimed for the DVD and not the Image adorning the cover. I reject this for one simple reason. The Defendant failed to make that distinction by specifically acknowledging the Claimant's copyright of the Image on the DVD or the related

marketing materials. In so failing, the Defendant claimed copyright to the Image and denied the Claimant's ownership of the Image.

- [47] What is the appropriate measure of compensation where copyright is claimed by someone other than the lawful owner of that right? The loss is one to reputation and goodwill. The lawful ownership and provenance is being challenged. This resonates particularly in this case where the Claimant and the Defendant are both active in the same, small location. The Claimant's reputation and goodwill were clearly undermined where the Defendant was claiming the Image as its own in the same location where the Claimant said he was the owner.
- [48] Admitting to no clear formula for the calculation of damages to reputation and, therefore, accepting there is some judicial arbitrariness to this, I do not think it unreasonable to suggest an amount equal to the license fee, namely \$5,000.00 EC as reasonable compensation.
- [49] The false attribution of copyright by the Defendant also infringed the Claimant's economic rights, namely his ability to earn income from the Image. The Claimant's unchallenged evidence was that he could not use the Image in the way he had prior for fear of challenge from the Defendant given its claim to copyright ownership.
- [50] This Court accepts that the Claimant was inhibited from using the Image for financial gain given the Defendant's copyright claim with both parties being located on Montserrat. Said another way, this Court accepts that it would be reasonably foreseeable that the legal owner of the Image would, at least for some initial period, be inhibited from using it for his own financial gain where another is marketing the photo with a copyright claim in the same location.
- [51] What would be the Claimant's reasonably foreseeable economic losses from the Defendant claiming copyright to the Image?
- [52] The Court accepts the Claimant's evidence that he was in the business of offering the Image for sale to the public in various forms, including postcards and posters, at the time of the infringement. The Claimant has itemized the values for these losses, which is a useful guide to the quantum of these economic damages.

- [53] More complicated is determining the reasonable duration for these economic losses. The Claimant's evidence was that he first became aware of the Defendant's infringing acts in 2013. That said, the Claimant did not commence this action until January, 2019. The Court received no explanation for this substantial delay.
- [54] The Claimant had the obligation to seek the timely assistance of the court to address the Defendant's misconduct. He failed to do so. The Claimant should have commenced an action immediately following his discovery of the Defendant's infringement. He could have then sought a restraining order or related relief that would have paved the way for the Claimant's use of the Image for profit.
- [55] Again acknowledging some arbitrariness in this, a reasonable period for the Claimant to retain counsel, approach the court for relief and return to his pre-infringement use of the Image for profit would be two years from the point of discovery of the infringing acts.
- [56] The Claimant's evidence was that he lost sales of approximately \$12,000.00 EC annually from the point he became aware of the Defendant's false claim of copyright to the Image (i.e. postcards of \$15,000.00 EC, posters of \$60,000.00 and photobooks of \$92,500.00 over a period of 14 years from the date of discovery to this hearing). These figures were not supported by any documentation but they were not challenged either. Given the lack of supporting documentation the Court should take a more conservative approach when determining appropriate damages. With that approach in mind, I am prepared to award a sum of \$7,500.00 EC annually for lost sales over two years for a total of \$15,000.00.
- [57] This Court does not accept that the Defendant should be responsible to pay the Claimant for losses arising from missed opportunities for carpentry work in England. Simply said, the claim for lost opportunity for carpentry work abroad in 2021 and 2022 it is not reasonably foreseeable loss flowing from the false claim of copyright, especially one from 2013. Regardless, the evidence supporting this relief was not persuasive. The Claimant's argument was that he could not leave Montserrat while this action was pending. This is not factually or legally correct.

- [58] Following *Absolute Lofts*, additional damages can be given where the infringer acted knowingly.
- [59] The Court has above made the finding that the Defendant obtained the Image from the postcard that was purchased from the Claimant by Mr. Edgecombe's son or thereby became aware of the Image and subsequently sourced it.
- [60] The Claimant filed a postcard with the Image as part of his evidence in this trial. The postcard is clearly marked "© Kevin West, Paradise Photo and Art Studio, Montserrat, W.I." along with the Claimant's telephone number and email. Two points present from this. One, the Defendant had notice of the owner of the photograph and his copyright claim. Two, the Defendant had the information readily available to contact the Claimant to seek permission to use the photo and to then negotiate an appropriate fee.
- [61] This Court finds that the Defendant used the Image knowing the Claimant was the copyright claiming owner of the Image. There is no other credible finding available on the evidence.
- [62] The court in *Absolute Lofts* stated that additional damages for the knowing infringement of another's work could be measured by the actual prejudice suffered by the rights holder such as lost profits or "unfair profits" earned by the infringer. The measurement of such additional damages would, of course, depend on the evidence available in the particular case.
- [63] Here, there was no evidence from the Defendant beyond the bald assertion that no profits were made. However, the Claimant detailed what he alleged were his lost profits in this matter. That said, these losses have already been addressed above with the determination of the Claimant's economic losses flowing from the Defendant's false copyright claim. As such, no so called additional damages are warranted.
- [64] Following *Absolute Lofts*, the last consideration is whether deterrent damages should also be awarded here. There is no doubt that copyright and related intellectual property rights infringement is a significant commercial issue especially with the expansion of potential markets worldwide over the internet.

- [65] Merely compensating the lawful owner for losses reasonably flowing from the infringement is not enough. In most cases, deterrence will need to be addressed in the form of making the offender pay sums additional to the reasonable losses of the victim. Without this, the rights of owners/creators will be significantly diminished and insufficiently protected.
- [66] If a person contemplating use of a copyrighted work can choose between negotiating/paying a fee prior to use or knowing that the worst case scenario is payment of the same fee and some share of made or missed profits **only** if the unauthorized use is discovered and prosecuted is hardly a disincentive. To the contrary, it could be an incentive to engage in the authorized use accepting the catch me if you can risk of a payout of more or less similar fees only if caught.
- [67] The court has an obligation to deter unlawful conduct and that can only occur where offenders are faced with payment of additional sums strictly to dissuade future violations. This is particularly so where, as here, the infringement was done knowingly.
- [68] The Defendant cannot be classified as the worst offender in the most egregious circumstances. That said, this Defendant knowingly and without authorization used the Image and denied the Claimant's ownership. Punitive, deterrent damages are warranted in these circumstances, which are fixed in the sum of \$5,000.00 EC.

Conclusion

- [69] The Defendant has conceded liability for the unauthorized use of the Image. The evidence before this Court establishes that the Defendant falsely attributed copyright ownership of the Image to itself causing additional reputational and economic damages to the Claimant. The Defendant's infringing acts were done knowingly and warrant an additional award as deterrence. The whole of the evidence directs this Court to the finding that the Claimant is due total damages of \$30,000.00 EC.

[70] The Claimant is entitled to his costs of this action pursuant to Rule 65.5 and Appendix B of the Civil Procedure Rules 2023. The total amount awarded here is \$30,000.00 EC. The Claimant is entitled to 20% of that amount, namely \$6,000.00 EC in costs.

[71] Pre-Judgment interest was not sought in the Claimant's Statement of Claim and none is awarded.

[72] The Claimant is entitled to post-judgment interest at the rate of 4% pursuant to section 7. of the *Judgments Act*.

IT IS HEREBY ORDERED THAT:

1. The Defendant shall pay to the Claimant damages of \$30,000.00 EC.
2. The Defendant shall pay to the Claimant his costs of this action in the amount of \$6,000.00 EC.
3. The Defendant shall pay to the Claimant post-judgment interest on the damages of \$30,000.00 EC and costs of \$6,000.00 EC at the rate of 4% per annum measured from the date of this Judgment until the same shall be satisfied in full.

The Hon. Dale Fitzpatrick
(Ag) High Court Judge

By the Court

REGISTRAR