

JAMAICA

IN THE COURT OF APPEAL

SUPREME COURT CIVIL APPEAL NO.8/90

BEFORE: THE HON. MR. JUSTICE FORTE, J.A  
THE HON. MR. JUSTICE DOWNER, J.A  
THE HON. MR. JUSTICE BINGHAM, J.A (AG)

BETWEEN HARBOUR VIEW CINEMA CO. LTD. DEFENDANT/  
APPELLANT  
A N D PERFORMING RIGHTS SOCIETY LTD. PLAINTIFF/  
RESPONDENT

Mr. Allan Wood instructed by  
Mr. Donovan Jackson of Myers, Fletcher  
and Gordon for Appellant

Mr. Norman Wright and Mr. Christopher Dunkley  
for Respondent

15th, 16th and 17th April and 1st July, 1991

FORTE, J.A.

The Appellant, a Company incorporated under the Laws of Jamaica, and carrying on the business of a Cinema operator under the name of the 'Harbour View Drive-in Cinema' was sued by the respondents for infringement of copyright. The infringement alleged in the Statement of Claim concerned the performance in public of a number of musical works in the Society's repertoire without its consent and in particular the words and music incorporated in the sound-tracks of the cinematographic films entitled:-

- (1) "The Killing Fields"
- (2) "Wild Geese II"
- (3) "A Passage to India".

The specific dates on which it is alleged that the infringements took place were on the 19th March, 1985, 3rd December, 1985 and 3rd March, 1986. The evidence of the public performance of these works, on those dates came from Mr. Donald Scott, who at that time had been the Agent for the plaintiff company in Jamaica for twenty-two years. He testified to attending the respondent's drive-in cinema on those dates, and actually sitting through the showing of the three films as follows:-

- (1) 19th March, 1985 - "The Killing Fields"
- (2) 3rd December, 1985 - "Wild Geese II"
- (3) 3rd March, 1986 - "Passage to India".

On each occasion he paid a fee to enter, and was among many other members of the public who viewed the films. He observed and took special note on each occasion of the music incorporated in the film all of which formed a part of the Society's repertoire.

Important to the issues raised in this appeal are two denials made by the appellant in its Defence filed in answer to the Statement of Claim:-

(i) Paragraph 3:-

"The Defendant says that if, which is denied, the Plaintiff at all material times owned and/or controlled the right of public performance of the said musical works, it is not entitled to claim copyright in respect of them under the Laws of Jamaica; and

(ii) Paragraph 6:-

As to paragraphs 5 and 6 of the Statement of Claim the Defendant does not admit that the musical works contained in the soundtracks of the cinematographic films listed in paragraph 2 of the Statement of Claim were per-

formed on the dates alleged or that they formed part of the Society's repertoire, or alternatively, the Defendant denies that the plaintiff is entitled to claim copyright in respect of them under the laws of Jamaica."

It was established by the evidence, that the appellant first applied in 1964 to the respondent for a licence to use the Society's repertoire, and was then granted same. The relationship continued for twenty years when on the 25th May, 1984, the appellant, by letter per its attorney, terminated the agreement effective on the 5th July, 1984. By letter dated 28th June, 1984 the respondent expressly denied the appellant any right or entitlement to the use of any works being a part of its repertoire after the appointed day of 5th July, 1984. It is clear then, that up until the termination of the agreement, the appellant had recognized the respondent's ownership and/or control of all the musical works in its repertoire.

As to the respondent's acquisition of the ownership and/or control of the copyright, the unchallenged evidence for the respondent was that the society is a non-profit company which exists to administer that part of copyright known as the performing rights on behalf of composers and publishers of (inter alia) musical works. It administers these rights as owner of the performing Rights assigned to it by its members.

It also administers the rights of members of other national societies by means of a network of reciprocal representation agreements. A national society exists in virtually every country. As a result of these assignments, the whole of the world's repertoire of copyright music is controlled by the Society. The composer, in joining the Society assigns that part of his copyright known as performing rights to the Society.

A proposed user of any of these musical works would then have to come to the Society's office in London, or to one of its

Agents in the territory (in this case Jamaica), and on application, would be given a blanket licence in the form of a licenced contract which would be subject to annual payments of royalties, and which would enable the user to perform any copyright work whether by way of live performance, recordings or film sound-tracks.

In respect of the rights claimed in this case the respondent produced and tendered several Deeds of Assignment by the various composers whose works are purported to be included on the sound-tracks of the films the subject of its claim.

Of significant relevance are some extracts from these Assignments.

"In this Deed:-

- (a) the expression musical work shall mean any musical work whether non existing or hereafter composed ..... and shall include (without prejudice to the generality of the expression musical work) the vocal and instrumental music in any cinematographic films the words and/or music of any monologue having a musical introduction and/or accompaniment of any non-musical play, and any part of any such work, words, music or accompaniment as aforesaid;
  
- (e) the word "performance" shall include, unless otherwise stated, any mode of acoustic presentation, including any such presentation by means of ..... or by exhibition of a cinematographic film or by the use of a record, or by any other means, and references to "perform" and "performing" shall be construed accordingly."

And paragraph 2:-

"The Assignor hereby assigns to the Society All performing rights which now belong to or shall hereafter be acquired by or be or become vested in the Assignor during the continuance of the

- (ii) By permitting the premises known as Harbour View Drive-in, Saint Thomas Road, in the Parish of Saint Andrew, or any other place of entertainment to be used for the performance in public of the said or any other musical works in the Society's Repertoire without the consent of the Plaintiff during the subsistence of the respective periods of the Plaintiff's ownership and/or control of the performing right therein.
3. That a stay of execution be granted for six (6) weeks; and
4. That there be costs to the Plaintiff to be taxed, or agreed.

Before us Counsel for the appellant having abandoned some of the grounds, argued the following grounds of appeal:-

Grounds 1(i) and (ii) and 2 (together):-

- "1. That the learned trial judge erred in law in finding that the Plaintiff was the owner of copyright in all musical works in the sound-tracks of the three cinematographic films claimed for in the Statement of Claim as:-
  - (i) No evidence was adduced by the plaintiff/respondent to establish that the works were first published in a country to which the Copyright Act 1911 applied;
  - (ii) No evidence was adduced by the plaintiff/respondent to establish that if the works were first published in a country to which the Copyright Act (1911) did not apply it was simultaneously published in a country to which the Copyright Act (1911) did apply.
2. That the learned trial judge erred in law in not holding that the defendant/appellant had put in issue the existence of the copyrights claimed for by the plaintiff/respondent and that the plaintiff/respondent had on a balance of probabilities failed to establish

Assignor's membership of the Society, and all such parts or shares (whether limited as to time, place, mode of enjoyment or otherwise) of, and all such interests in, any performing right as so belong to or shall so be acquired by or be or become vested in the Assignor (all which premises hereby assigned or expressed or intended to be assigned are hereinafter collectively referred to as "the rights assigned"), TO HOLD the same unto the Society for its exclusive benefit during the residue of the term for which the rights assigned shall respectively subsist, or during such time as (in accordance with the provisions of the Articles of Association of the Society for the time being in force) the rights remain vested in or controlled by the Society."

At the end of the case for the plaintiff/respondent the appellant called no evidence and rested its case on submissions made to the learned trial judge who subsequently made the following orders:-

- "1. That there be Judgment for the Plaintiff for damages in the sum. of \$156,358.80 with interest at the rate of 10%; being \$120,276.00 for the period 1984 to 1987 and \$36,082.00 for the period 1989 to 1990.
2. That the Defendant be restrained from infringing the Plaintiff's copyright by doing all or any of the following acts or things itself or by its servants or agents, that is to say:-
  - (i) By performing or permitting or authorising without the Plaintiff's consent the performance in public of the said or any other musical works in the Society's Repertoire during the subsistence of the respective period of the Plaintiff's ownership and/or control of the performing Right in any of the musical works therein;

it was entitled to copyright in the works claimed for."

Ground 1 (v)

"The learned judge failed to appreciate that the owner of copyright, if any, in the sound-tracks of the films in question, namely, the Killing Fields, Wild Geese II, and a Passage to India, was not necessarily or automatically the same as the owner of the Copyright, if any, in the original musical works used in those sound-tracks. The Learned Judge ought properly to have determined whether separate copyright existed in the sound-tracks and in the original musical works, and if so, whether the use by the Defendant of the sound-tracks in the course of displaying the films constituted an infringement of any such right."

Ground 4

"The Learned Judge erred as a matter of Law in awarding damages to the Plaintiff/Respondent in the sum of \$156,358.80 with interest thereon at the rate of 10% per annum. The said award was arrived at on the basis of an annual fee payable to the Plaintiff for the period of 1984 to 1990 which assumed a general repetitive infringement of the Plaintiff's right during that period. The Learned Judge failed to appreciate that the Plaintiff's cause of action related to three specific acts of infringement by the Defendant on the 19th day of March, 1985 the 3rd day of December, 1985 and the 3rd day of March, 1986 and the award of damages to the Plaintiff/Respondent ought properly to have been limited to compensation for loss sustained from those acts of infringement. Further, by the award of damages to compensate the Plaintiff for a period commencing in 1984, the learned Judge wholly ignored the fact that the Plaintiff's cause of action, if any, arose in the year 1985."

Grounds 1 (i) and (ii) and 2

That the Copyright Act 1911 has application to Jamaica was settled in the judgment of this Court in the case of

Claude Rose Trading As Central Theatre vs. The Performing Rights Society SCCA 65/80 delivered on 9th July, 1982

(unreported). In the words of Wright, J.A.:-

"The Copyright Act 1911 was an imperial Act passed for the purpose of amending and consolidating the Law relating to Copyright in the British dominions.

Section 25(1) states:

"This Act, except such of the provisions thereof as are expressly restricted to the United Kingdom, shall extend throughout His Majesty's dominions: Provided that it shall not extend to a self-governing dominion, unless declared by the Legislature of that dominion to be in force therein either without any modifications or additions, or with such modifications and additions relating exclusively to procedure and remedies or necessary to adapt this Act to the circumstances of the dominion, as may be enacted by such Legislature."

Section 37(2) of the Act, so far as is relevant reads:

- '(2) This Act shall come into operation -
- (a) .....
- (b) .....
- (c) .....
- (d) in any other British possession to which this Act extends, on the proclamation thereof within the possession by the Governor.'

The appropriate proclamation extending the Act to Jamaica with effect from the 1st day of July, 1912 was made on the 30th day of May, 1912 and published in the Jamaica Gazette dated the 6th of June, 1912. Accordingly, the Act with the relevant amendments became a part of the Laws of Jamaica and was so preserved by Section 4(1) of the Jamaica (Constitution) Order in Council 1962 which provides, inter alia:

- '(1) All laws which are in force in Jamaica immediately before the appointed day shall (sub-



ject to amendment or repeal by the authority having power to amend or repeal any such law) continue in force on and after that day ....' (that day being the 6th day of August, 1962)."

It is to that Act, therefore, that the respondent resorted in proof of its claim. In order to succeed, however, a plaintiff who alleges infringement of his copyright must prove two things. In the words of Romer L.J in Hogg v. Toye and Company, Limited (1935) 1 Ch. 497 at page 515:-

".... first, that copyright exists in the work in question; and secondly, that he is the owner of the copyright, which he can prove either by showing that he himself is the author or that the work was executed in one of the ways mentioned in the provisos to section 5, or that he is the assignee of the author or other true owner of the copyright."

In this case the respondent attempted to prove:-

- " (i) that copyright existed, and
- (ii) that it is the assignee of the copyright, and
- (iii) infringement of copyright, that is, the performance in public of musical works of the Society's repertoire."

What then is copyright? This is defined by section 1(2) of the Act as follows:-

"For the purposes of this Act "Copyright" means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatsoever, to perform, or in the case of a lecture to deliver, the work or any substantial part thereof in public, if the work is unpublished, to publish the works or any substantial part thereof; and shall include the sole right -

- (a) .....
- (b) .....
- (c) .....
- (d) in the case of a literary, dramatic, or musical work, to make any record, perforated roll, cinematograph film, or other contrivance by means of which the work may be mechanically performed or delivered, ..."

Copyright therefore includes the sole right to perform a musical work in public. Section 1(1) of the Act speaks to the subsistence of copyright. It states:-

"Subject to the provisions of this Act, copyright shall subsist throughout the parts of His Majesty's dominions to which this Act extends for the term hereinafter mentioned in every original literary dramatic musical and artistic work, if -

- (a) in the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid; and
- (b) in the case of an unpublished work, the author was at the date of the making of the work a British subject or resident within such parts of His Majesty's dominions as aforesaid;

but in other works, except so far as the protection conferred by this Act is extended by Orders in Council thereunder relating to self-governing dominions to which this Act does not extend and to foreign countries.

In section 1 (3) however, 'publication' is defined as follows:-

"For the purposes of this Act, publication, in relation to any work, means the issue of copies of the work to the public, and does not include the performance in public of a dramatic or musical work, the delivery in public of a lecture, the exhibition in public of an artistic work, or the construction of an architectural work of art, but, for the purposes of this provision, the

issue of photographs and engravings of works of sculpture and architectural works of art shall not be deemed to be publication of such works.

The contention of the appellant, that the respondent had to prove by virtue of section 1(1) that the musical works in the films, were either first published within one of the Her Majesty's dominions or simultaneously elsewhere (section 35), is clearly fallacious. The instant case, not being concerned with the publication of the musical works cannot be caught by the provision of section 1(1) (a); on the contrary, it is concerned with the performance in public of musical works, which is specifically excluded in the Act, as 'publication'. In this regard then one must look to section 1 (1)(b) to determine whether copyright subsists in relation to the musical works, the subject of this action.

However, before doing so, it should be determined whether section 6 (3) is applicable to the circumstances of this case - a point which forms the content of Ground 2 of the appellants grounds, and which was strongly contended before us.

Section 6(3) reads:-

"In any action for infringement of copyright in any work, the work shall be presumed to be a work in which copyright subsists and the plaintiff shall be presumed to be the owner of the copyright, unless the defendant puts in issue the existence of the copyright, or, as the case may be, the title of the plaintiff, and where any such question is in issue, then -

- (a) if a name purporting to be that of the author of the work is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the author of the work;

- (b) if no name is so printed or indicated, or if the name so printed or indicated is not the author's true name or the name by which he is commonly known, and a name purporting to be that of the publisher or proprietor of the work is printed or otherwise indicated thereon in the usual manner the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the owner of the copyright in the work for the purposes of proceedings in respect of the infringement of copyright therein."

In this regard, the appellant concedes that "the evidence tendered on behalf of the respondent was sufficient to establish the respondent's title as assignee of the performing rights to the works in question if the copyright is presumed to exist". This concession is therefore a complete answer to the second limb of proof required for the establishment of the infringement of copyright, that is, proof that the plaintiff is either himself the author, or that he is the assignee of the author or true owner of the copyright.

The sole question remaining therefore is whether the respondent has, either by the application of the presumption in section 6(3) or by evidence proven that copyright in the musical works in question subsists.

Presumption of subsistence of copyright

The appellant contends that by the pleadings, that is, the Defence filed in answer to the Statement of Claim, the appellant put the question of the subsistence of the copyright into issue, and consequently section 6(3) cannot avail the respondent. This being so, the respondent must prove through the evidence that copyright subsists, and basing his submissions on the failure to prove the requirement of section 1(1)(a), he

contends that the respondent failed to do so.

In respect of the putting into issue of the subsistence of the copyright he relies on paragraph 3 of the Defence which reads as follows:-

"The Defendant says that if, which is denied, the Plaintiff at all material times owned and/or controlled the right of public performance of the said musical works it is not entitled to claim copyright in respect of them under the laws of Jamaica."

Counsel for the appellant contends that by this paragraph of the Defence the appellant did place the subsistence of copyright in issue. He argued "that the paragraph was sufficiently clear in order to alert the respondent to the fact that the presumption of copyright was not to be applied and that the evidential burden was therefore on the respondent to adduce evidence to prove the existence of copyright."

Counsel for the respondent maintained that the content of paragraph 3, does not challenge the subsistence of copyright but instead was putting into question the applicability of the Copyright Act 1911 to the Laws of Jamaica. He argued that that is how the respondent had always interpreted paragraph 3, which is evident in the Reply which reads as follows:-

"2. In answer to paragraphs 3 and 6 of the said defence, the Plaintiff says it is entitled to claim Copyright in the musical works, the subject of this Action by virtue of the Copyright Act 1911, which was proclaimed in Jamaica on the 30th day of May, 1912, and gazetted on the 6th day of June, of the same year, to come into force as of the 1st day of July, 1912."

The Defence therefore rather than challenging the subsistence of the copyright sought to contend that by the Laws

of Jamaica the appellant had no right to claim copyright in Jamaica.

An examination of paragraph 3 of the Defence lends merit to the contention of the respondent. The defendant denies the ownership and/or control of the plaintiff to the right of public performance but does not deny that the 'right' subsists. If copyright is at all denied, it is not its subsistence but the entitlement to claim its subsistence under the Laws of Jamaica.

Mr. Wright supported this contention by an examination of the background to this action which is disclosed in the Statement of Claim and admissions made in the Defence. The allegation made in paragraph 8 of the Statement of Claim, and admitted in paragraph 8 of the Defence, speaks to the fact that for twenty years the appellant had accepted:-

- (i) Ownership of the musical works by the society,
- (ii) The subsistence of copyright therein,
- (iii) Its liability to pay for the use of those works,
- (iv) The fact that for those twenty years it did as a matter of general practice make use of those works, and,
- (v) That Harbour View Drive-in Cinema was a public place used for profit.

He submitted that in light of this, the appellant could not in good faith have put either the respondent's ownership of the copyright or the subsistence of copyright in issue.

In my view, it is a reasonable inference that during those twenty years before the termination of the agreement, the appellant did recognize and accept the subsistence of copyright in all the musical works which formed a part of the repertoire of the respondent during that period. This, however, cannot estop the appellant from putting the question in issue, and consequently

requiring the respondent to prove that fact. Nevertheless, its acceptance in the past does give credence to the interpretation of paragraph 3 of the Defence, and the conclusion (supra) that the appellant was contending therefore that no claim on copyright could be made under the Laws of Jamaica rather than that copyright subsisted. (As to the claim under Laws of Jamaica, see Claude Rose v. The Performing Rights Society (supra)).

In any event, in deference to the submission made by counsel, an examination of the evidence to determine whether subsistence of the copyright was proven may be of some relevance.

This case deals with copyright in the public performance of the musical works, and not with publication, and consequently the respondent is required to prove by virtue of section 1(1)(b), the following:-

"(b) in the case of unpublished work, the author was at the date of the making of the work, a British subject or resident within such parts of His Majesty's dominions as aforesaid."

In proof of this, the respondent led evidence that the producers who gave assignments were at all material times, members of the Society and that persons qualify for membership if and only if they are resident in Her Majesty's territories.

By inference then, this evidence which remained unchallenged, established that the persons who signed the Deeds of Assignments in respect of the musical works on the sound-tracks of the relevant films were all resident in Her Majesty's territories, thus satisfying the requirement of section 1(1)(b) for proof of the subsistence of copyright in those works.

In conclusion, I would hold for these reasons that the learned trial judge was correct in finding that the respondent was entitled to the protection of the Act, it having been proven that (i) the copyright in the musical works was assigned to the Society, and (ii) that the copyright was in subsistence firstly by virtue of the presumption (section 6(3)) - that factor not having been put in issue or in any event on the evidence.

Ground 1(v)

The contention of the appellant is that even if copyright is assumed or proven to exist in the musical works, the learned trial judge failed to determine whether the infringement related to the original musical works, or to the sound-tracks of the films in question. This is important, as by virtue of section 19 of the Act copyright in the original musical works may be differently owned than copyright in the sound-tracks of the films. He maintains that the Deeds of Assignments, assigned copyright in the original works, and not in the sound-tracks, and consequently if the copyright which subsisted relates to the sound-tracks the respondent would not have title to same.

In its Statement of Claim the appellant alleged in paragraph 2:-

"At all material times the said Plaintiff owned and/or controlled the sole right of public performance in a large number of musical works (herinafter called "The Society's Repertoire") including words and music incorporated in the sound-tracks of the cinematographic films entitled as follows:-

- (1) "The Killing Fields"
- (2) "Wild Geese II"
- (3) "A Passage to India"



"Judgment for the Plaintiff in the sum of \$156,358.80 being \$120,376.00 for the period 1984 to 1989, and \$36,082.80 for the period 1989 to 1990 with interest at the rate of 10% per annum."

The learned trial judge therefore awarded damages for each year after the termination of the agreement and up to 1990.

Mr. Wood for the appellant submitted that this is contrary to the evidence, as infringements have only been proved in the years 1985 and 1986 per the respondent's witness who attended on three occasions to view the films in which the sound-tracks containing the musical works were used.

On the basis of the evidence of the respondent's witness that he had reason to believe that the appellant had continued to show films which were controlled by the respondent, the learned trial judge awarded the licence fee for each year of the six years from 1984 to 1990.

This Court in the case of Claude Rose v. The Performing Rights Society (supra) after an examination of the authorities set out the test to be applied in the award of damages in cases such as this. Wright, J.A. in delivering the judgment of the Court stated thus:-

"A party who wilfully makes use of another's copyright material for profit ought not to be in a better position than his competitor who respects the rights of the copyright holder and pays the appropriate licence fee. The depreciation in value of the copyright might very well be the economic loss to the owner whose works are being infringed and who is unable to obtain any financial benefit therefrom whether in the form of a licence fee or otherwise.

On this basis we accepted the licence fee which the appellant would in reality have been obliged to pay the respondent as the appropriate basis for assessing the damages ..."

The measure of damages, applying this principle would therefore be the licence fee which the respondent would have charged if the appellant did as he ought to have done, that is, acquire a licence for the performance of the musical works in public. Apart from the evidence of the impressions of the respondent's witness that the appellant had continued to infringe the copyright during the period 1984 to 1990, the only positive evidence of infringements is that of the witness who witnessed the infringements twice in 1985 and once in 1986. Mr. Wright's contention that there is a strong presumption that the appellant continued to do so and that the visits by the witness were only 'random samples' does not in my view, answer the obvious difficulty in respect of the lack of evidence of infringement at any other time. Consequently, I would hold that the learned trial judge erred when he awarded damages for the period 1984 to 1990, and would consequently reduce the damages awarded to \$48,110.40 being the equivalent of the licence fees for the years 1985 and 1986 at \$24,055.20 per year, being the annual fee claimed in the Statement of Claim.

The appeal should therefore be allowed in part, with a variation of the order in respect of damages, to an award as stated above together with 10% interest thereon. In the circumstances, the respondent should pay half the cost of this appeal. Such costs to be taxed, if not agreed.

DOWNER J.A.

For upwards of twenty years the Harbour View Cinema Company Limited through its principal, Palace Amusement Company Limited, honoured its obligations to pay licence fees to the Performing Rights Society Limited. Then on 25th May, 1984 the Cinema gave notice to terminate their agreement from 5th July, 1984. The substantial royalties paid to the Society ceased, so it instituted proceedings against the Cinema. They went before Reckord J, and that learned judge found for the Society. He found that the aspect of copyright known as performing rights had been breached by the Cinema as they had shown three films with the words and music from the Society's repertoire without a licence from the Society. The Society was awarded substantial damages and an injunction. From that judgment the Cinema has appealed.

Did the appellant Society prove an infringement of their copyright?

This dispute concerns the unauthorised performance of musical works. The basis of the Society's ownership was that authors assigned their property rights to the Society, who to protect and enhance the rights assigned, made arrangements for the determination and collections of licence fees when performances were permitted. It is by this means that the

authors earned their income for their creative works. So extensive is the Society's reach that it covers nearly the whole world through agencies in other countries. The performing rights of the films in issue 'Wild Geese', 'A Passage to India' and the 'Killing Fields' were all assigned to the Society as indicated in Exhibits 1, 2 and 3. The 'cue sheets' provided by the film production companies show the use of and duration of music used in films as well as the name of the composer and Bernard Louston-Lalanne the international representative of the Society gave evidence as to the assignments and the authors of the words and music on the films in issue. The Exhibits disclose that all the authors at the time of the assignment resided in the United Kingdom. t

As for the breach, that evidence was given by Donald Scott the Secretary of the agency for the Society in Jamaica. He gave evidence that he attended the Cinema on three occasions as a patron and heard the music incorporated in the films, and as the Society received no fees for the performance of the music on the three occasions, the Cinema was sued. The dates of his visits were 19th March, 1985, 3rd December, 1985 and 3rd March, 1986. Based on these sample visits damages were claimed for six years.

The Law applicable

The uncontradicted evidence was that the Society was a company incorporated in England and would benefit as the assignee from the protection of the Imperial Copyright Act (1911) U.K. The relevant section reads -

"(1) Subject to the provisions of this Act, copyright shall subsist throughout the parts of His Majesty's dominions to which this Act extends for the term hereinafter mentioned in every original literary dramatic musical and artistic work, if -

- (a) in the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid; and
- (b) in the case of an unpublished work, the author was at the date of the making of the work a British subject or resident within such parts of His Majesty's dominions as aforesaid:

(Emphasis supplied)

The legislature has recognised the application of this Act to Jamaica see Copyright Act (Ja.) and so have the courts see Claude Rose T/A Central Theatre v The Performing Rights Society Ltd. S.C.C.A. 65/80. It was not challenged that there were performances of the films in issue within the meaning of the Act without the consent of the Society. 'Performance' being thus defined in Section 35(1) as -

"Performance means any acoustic representation of a work and any visual representation of any dramatic action in a work, including such a representation made by means of any mechanical instrument."

As for the protection afforded British subjects and British residents Section 35(4) reads -

"(4) Where, in the case of an unpublished work, the making of a work has extended over a considerable period, the conditions of this Act conferring copyright shall be deemed to have been complied with, if the author was, during any substantial part of that period, a British subject or a resident within the parts of His Majesty's dominions to which this Act extends."

Further Section 35(5) deems an author as residing in Jamaica once he is domiciled in Her Majesty's dominions. Even on the pleadings no serious resistance seems to have been offered on the issue of liability. Here is the averment of the Society in their statement of claim -

"6. By performing and/or authorising the performance in public of the said musical works without the consent of the Plaintiff, the Defendant has thereby infringed the Plaintiff's copyright."

"7. Further and in the alternative the premises known as Harbour View Drive-In Cinema is a place of public entertainment and the Defendant has knowingly infringed the Plaintiff's right as aforesaid by authorising and/or permitting for its private profit the said premises to be used for the performance in public of the said musical works without the consent of the Plaintiff."

The defence was a bare denial and it runs thus -

"(6) As to paragraphs 5 and 6 of the Statement of Claim the Defendant does not admit that the musical works contained in the sound-tracks of the cinematograph films listed in paragraph 2 of the Statement of Claim were performed on the dates alleged or that they formed part of the Society's repertoire, or alternatively the Defendant denies that the Plaintiff is entitled to claim copyright in respect of them under the laws of Jamaica.

(7) As to paragraph 7 of the Statement of Claim the Defendant repeats paragraph 5."

The appellant led no evidence at the trial, so the substance of their defence was that the respondent was to be put to proof. However under the Copyright Act there were presumptions in favour of the respondent. The relevant section reads as follows:-

"6(3) In any action for infringement of copyright in any work, the work shall be presumed to be a work in which copyright subsists and the plaintiff shall be presumed to be the owner of the copyright, unless the defendant puts in issue the existence of the copyright, or, as the case may be, the title of the plaintiff, and where any such question is in issue, then -

(a) if a name purporting to be that of the author of the work is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the author of the work;"

Since a defence was pleaded, the issue of the existence of the copyright was put in issue but it was merely put in issue without rebutting the presumption. There was no evidence marshalled by the appellant to alter the incidence of their liability, so the presumption and the absence of contrary evidence favoured the Society. Further since the name of the authors who assigned their work to the Society appeared on the credit of the films and there was no contrary evidence by the appellant then by virtue of Section 6(3)(a) the presumption that those credited were the authors was not displaced by the appellants. See Hogg v Taye & Co. Ltd. (1935) Ch. 497 per Romer L.J. at Page 515. From the authors it is then necessary to go to the assignee and for an example, it is pertinent to cite the relevant part of the Deed of Assignment in the case of Paul Junior McCartney. It is as follows:-

"In this Deed:-

(a) the expression "musical work" shall mean any musical work whether now existing or hereafter composed and such words (if any) as are associated therewith and shall include (without prejudice to the generality of the expression "musical work") the vocal and instrumental music in any cinematograph films, the words and/or music of any monologue having a musical introduction and/or accompaniment, of any non-musical play, and any part of any such work, words, music or accompaniment as aforesaid;

(b).....

(c).....

Then there is definition of 'performing right'. It is as follows:-

(d) the expression "performing right" shall mean and include, subject to the exceptions set out below, the right of performing in public broadcasting and causing to be transmitted to subscribers to a diffusion service, in all parts of the world, by any means and in any manner whatsoever, all musical works, and the right of authorising any of the said acts; but, unless the following or any of them are expressly authorised pursuant to Article 4(d) of the Society's

"Articles of Association, shall not include the right of performing in public, broadcasting, or causing to be transmitted to subscribers to a diffusion service or of authorising any of the said acts, and of the following classes or works unless such acts are done by means of cinematograph films."

Further there is an explanation of 'performance'. It reads thus -

"(e) the word "performance" shall include unless otherwise stated, any mode of acoustic presentation, including any such presentation by means of broadcasting or the causing of a work to be transmitted to subscribers to a diffusion service, or by the exhibition of a cinematograph film, or by the use of a record, or by any other means, and references to "perform" and "performing" shall be construed accordingly."

Paragraph 2 of the Deed shows the legal powers of the Society as assignee. It reads -

"The Assignor hereby assigns to the Society ALL performing rights which now belong to or shall hereafter be acquired by or be or become vested in the Assignor during the continuance of the Assignor's membership of the Society, and all such parts or shares (whether limited as to time, place mode of enjoyment or otherwise) of, and all such interests in, any performing right as so belong to or shall so be acquired by or be or become vested in the Assignor (all which premises hereby assigned or expressed or intended to be assigned are hereinafter collectively referred to as "the rights assigned"), TO HOLD the same unto the Society for its exclusive benefit during the residue of the term for which the rights assigned shall respectively subsist, or during such time as (in accordance with the provisions of the Articles of Association of the Society for the time being in force) the rights remain vested in or controlled by the Society."

It is against this background of the proof of copyright in the Society, and the proven performances without consent of the Society that I agree with Reckord J that the appellant's liability for breach of copyright has been firmly established.



DAMAGES

Reckord J granted the injunction as prayed and damages of \$156,358.80 with interest at the rate of 10%. That part of the award granting the injunction must stand as it restrained the appellant from performance of musical works in the Society's repertoire or permitting their cinema to be used for such performances without the Society's consent. As for the damages awarded the learned judge seems to have proceeded on the wrong principle. The evidence of infringement came from Mr. Scott and it was based on three visits. They were 19th March, 1985, 3rd December, 1985 and 3rd March, 1986. The visits were not sufficient nor were they so close that the presumption of continuity could be applied from 1984 - 1990. Yet the learned trial judge said:-

"Damages is therefore assessed as claimed in the statement (sic) claim as amended in the sum of \$156,358.80 being \$120,276.00 for the period 1984 to 1989, and \$36,082.80 for the period 1989 to 1990 with interest at the rate of 10% per annum.

In coming to that conclusion he relied on section 6(1) of the Copyright Act. Section 6(1) reads -

"Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise provided by this Act, be entitled to all such remedies by way of injunction or interdict, damages, accounts, and otherwise, as are or may be conferred by law for the infringement of a right."

The amendment to the statement of claim for special damages reads as follows:-

"PARTICULARS OF SPECIAL DAMAGE

- |   |                      |
|---|----------------------|
| 1. Licensing fees payable in respect of the years of Assessment 1984/1985 to 1988/1989 i.e. 5 years at \$24,055 per year; and | \$120,276.00         |
| 2. Licensing fees payable in respect of year of Assessment 1989/1990  | 36,082.80            |
|   | <u>\$ 156,358.80</u> |

This was the basis of the award below. The correct approach to the assessment of damages in this case was stated by Wright J.A. in Claude Rose T/A Central Theatre v The Performing Rights Society Ltd., in Supreme Court Civil Appeal No. 65/82 and reiterated by Reckord J at page 22 of the record. It reads thus -

"A party who wilfully makes use of another's copyright material for profit ought not to be in a better position than his competitor who respects the rights of the copyright holder and pays the appropriate licence fee. The depreciation in value of the copyright might very well be the economic loss to the owner whose works are being infringed and who is unable to obtain any financial benefit therefrom whether in the form of a licence fee or otherwise.

On this basis we accepted the licence fee which the appellant would in reality have been obliged to pay the respondent as the appropriate basis for assessing the damages."

A specific statement approved by the courts was adopted in Performing Right Society v Berman & Another (1975) Fleet Street Patent Law Reports p. 400 at 401-402. It reads thus -

"In regard to damages, these are assessed by Mr. Hudson at £31.4s.0d. on the basis of the fee which would have been payable for the right to perform any of the plaintiff's musical works at club dances for the period of one year, taking into consideration the average numbers of people attending the dances and the entrance charge levied upon such people by the club. That this is a proper basis of assessment shown by the case of Performing Right Society v Bradford Corporation (1921) MacGillivray Copyright Cases, 1917-1923 volume p. 309, referred to in Halsbury's Laws of England, 3rd ed., vol. 8, p. 447, para. 812, note (k). I am also satisfied that the sum claimed is reasonable.

The precise method of calculation was given by Mr. Scott and was based on 3% of a full house per week at \$10.00 per set. That sum would be \$48,110.40 based on the claim for 1985 and 1986 in the amendment to the statement of claim. There was no proof for the

other years claimed. The result is that the appeal is allowed in part, the order made below must be varied and reflect the amount now payable for special damages together with 10% interest. The appellant must also have one-half of the costs of Appeal.

BINGHAM J.A. (AG.)

I have taken the opportunity to read in draft the judgments prepared by learned brethren, Forte and Downer JJ.A. and I wish to express my agreement with their reasoning and the conclusions arrived at that the appeal be allowed in part in the manner as proposed in the judgments.

The action below sought to challenge the right of the respondent company to its ownership and/or control of the copyright in the musical works in question.

The issue of liability having assumed thereby some degree of importance, the Copyright Act 1911 (U.K.) in so far as it falls to be interpreted in determining this question has prompted me to make a small contribution to the matter,

The relevant sections of this Imperial Act which was extended to Jamaica with effect from 1st July, 1912, have been referred to by both Forte and Downer JJ.A. These sections do not, therefore, except in so far as I find such references unavoidable need to be re-stated by me.

The Statement of Claim at paragraphs 2 and 5 sought in so far as is material to allege:-

1. The ownership and/or control by the respondent of the published works relating to the subject matter of the claim.
2. The specific breaches committed by the defendant company through its servants or agents. These infringements related to breaches at appellant's premises on 19th March, 1985, 3rd December, 1985 and 3rd May, 1986.

The damages claimed in relation to the alleged breaches of the copyright in the musical works in question which was in the nature of special damages was \$156,358.00 covering a period extending from 1984 to 1990. This sum was calculated based upon Licence Fees of \$24,055.20 per annum from 1984 - 1989 and \$36,082.00

for the year 1990. Having determined the issue of liability in the respondent's favour he then proceeded to award damages on the evidence presented by the respondent for the entire period from 1984-1990 as set out in the Particulars of Claim in the Amended Claim for damages. I shall return to this area of the claim in dealing with the award for damages made by the learned trial judge.

The Issue of Liability

Section 6(3) of the Act presumes that the musical works claimed in paragraph 2 of the Statement of Claim to be works in which copyright subsists. The appellants in their defence by their traverse at paragraphs 2 and 6 sought thereby to rebut the presumption of title to copyright in the respondent and to put them to proof of ownership and/or control of the said musical works. The evidence adduced in the testimony of Bernard Louston-Lallane along with that contained in the documents Exhibits 1, 2 and 3 relating to the assignment of the said musical works to the respondent Society established beyond per adventure of a doubt that which was alleged in paragraph 2 of the Statement of Claim.

Paragraph 5 of the Defence sought to traverse the allegations of specific breaches of copyright alluded to in the evidence of Donald Scott. The appellants' Attorney-at-Law having chosen to rest his case, no evidence was brought to counter Mr. Scott's testimony. Merely to make a bald assertion in the Defence of a lack of knowledge or authority for the performances in question was in my opinion not sufficient to relieve the appellant company from liability for the breaches in question.

The evidence adduced by the respondent which was left unanswered therefore made the determination of liability by the learned trial judge in the respondent's favour inevitable.

The learned judge also granted a final injunction. Such relief was clearly warranted on the evidence. This was not challenged on appeal and therefore must stand.

The Issues of Damages

The learned judge awarded the plaintiff the entire amounts due for the assessed licence fee from 1984-1990 at the sums set out at the commencement of this judgment. The measure of damages in cases of this nature fell for the consideration of this Court in S.C.C.A. 65/80 Claude Rose t/a Central Theatre and the Performing Rights Society Limited (unreported delivered on 9th July, 1982). There it was held by the Court per dictum of Wright J.A. that the appropriate measure of damages in cases of this nature was:-

"The licence fee which the defendant would have been obliged to pay the respondents as the appropriate basis for assessing damages." (Page 16)

Using this yardstick and applying it to the evidence in the Court below, the claim being for special damages, it had of necessity to be specially alleged and strictly proven. See paragraph 23 16th Edition of Mayne and McGregor on Damages, also Straus Bucks Aktie Bolag v Hutchinson (1905) A.C. 515 per dictum of Lord McNaughten.

"Special damages are such as the law will not infer from the nature of the act. They do not follow in the ordinary course. They are exceptional in character and therefore they must be claimed specially and strictly proven."

Although the evidence before the learned judge related to 'random samples' concerning three visits to the appellants' premises by Donald Scott in the years 1985 and 1986, there was no other evidence adduced by the respondent to establish any infringements in the other five years alleged in the amended Statement of Claim. The mere ipse dixit by Scott that he had reason to believe that the appellant will continue to show films

which are controlled by the respondent did not measure up to the standard of proof required. This certainly did not fall within the category of strict proof by evidence which was clear and unequivocal. In this regard, therefore, the learned judge in so far as he sought to rely upon evidence which was clearly lacking as to its cogency, fell into error.

It was for these reasons why I too joined in agreeing to the proposed order as set out at the commencement of this judgment.

and in paragraph 5:-

"The Defendant has on a number of occasions infringed the Plaintiff's copyright by performing and/or authorising the performance in public of a number of musical works in the Society's Repertoire without the consent of the Plaintiff and in particular on the 19th day of March, 1985, the 3rd day of December, 1985 and on the 3rd day of March, 1986, the Defendant without the consent of the Plaintiff performed and/or authorised the performance in public of the words and music incorporated in the sound-tracks of the three (3) films abovementioned."

In all the Deeds of Assignment - "musical works" is defined in the terms already referred to, but for emphasis I repeat here that it "shall include ..... the vocal and instrumental music in any cinematographic films ...." The contention of the appellant that the assignments were of the original musical works appear then to be without merit.

It is clear that the appellant claimed that it was the assignee of the copyright in the musical works including the works incorporated in the sound-tracks.

Proof of this claim came from the witness for the respondent, and as this evidence together with the Deeds of Assignment showing the Assignment to the respondent, remained unchallenged at the end of the plaintiff's case, the respondent's claim to the copyright in the musical works in the sound-tracks was established.

I would therefore hold that there is no merit in this ground of appeal.

Ground 4 - Damages

Having found for the plaintiff/respondent the learned trial judge awarded damages as follows:-