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by the author as a commercial transaction. Suppose a member for a Parliamentary borough organizes dramatic entertainments to which the inhabitants are admitted without payment. Suppose an amateur company act some dramas for a charitable object, with admission upon payment of money or by tickets issued generally. In each of these cases an infringement of the Statute has been committed. Fry, L.J., while agreeing that the place need not be habitually used for dramatic entertainments and that the representation need not be for reward or hire, differed as to the necessity for publicity, holding that "there may be internal and domestic representations which are well within the purview of the statute, as when a nobleman gives a dramatic performance in his mansion to guests staying in his house, and to invited residents in the neighbourhood—what would be the chance of the next company which came to the adjoining town to perform the same piece, getting together as good an audience as they could get had the piece not been performed in the nobleman's mansion?" Though we would answer that in the case put by Lord Justice Fry we should conceive the chance to be very great indeed that the performance were all the better attended by reason of the approval in high society it had previously received, this is not the point. The point which might have been elucidated with a little less doubtful illustration is that the real test as to what is a place of dramatic entertainment is whether the representation diminishes the pecuniary gains of the proprietor of the copyright or not.

In an action for penalties brought under the 3 & 4 Will. 4, c. 15, the declaration stated that the plaintiff was the author of a certain dramatic piece or musical composition, &c., and that the defendant caused the said piece to be represented at a certain place of dramatic entertainment, &c., whereby, &c. It was determined, first, that the introduction of a pantomime was a dramatic entertainment, within the meaning of the statute; secondly, that it was not necessary to allege in the declaration, or

to prove at the trial, that the defendant knew that the plaintiff was the author; thirdly, that the allegation in the declaration, that the same was represented at a certain place of dramatic entertainment, was sufficient (a).

Though it was here decided that a person ignorant of the piratical nature of a representation may be an offender within the meaning of the Act, yet one cannot be considered a transgressor of the provisions of the statute, so as to subject himself to an action of the above nature, unless he himself, or his agent, actually takes part in the representation which is a violation of copyright. Were it to be otherwise held, all those who supply any of the means of representation to him who actually represents, would have to be considered as thereby constituting him their agent, and thus *causing* the representation, within the meaning of the Act; such a doctrine would embrace a class of persons not at all intended by the legislature (a).

Punishment for infringement not to be visited on one not actually taking part in the performance.

By 45 & 46 Vict. c. 40, Copyright (Musical Compositions) Act, 1882, s. 1, on and after the passing of the Act (10th August, 1882), it is provided that if the proprietor of the copyright in any *musical composition* first published after the passing of the Act, or his assignee, shall be desirous of retaining in his own hands exclusively the right of public representation or performance of the same, he must notify the same in print on the title-page of every published copy of such musical composition.

Copyright (Musical Compositions) Act, 1882.

By sect. 2 it is provided that if before publication the right of public representation or performance be, and the copyright be, vested in different owners, and the former desire to retain the right of public representation or performance, he must, before publication, give to the owner of the copyright notice in writing requiring him to print upon every copy of such musical composition a notice to the effect that the right of public representation or performance is reserved; and further, that if after publication, subsequent to the Act, the right of public representa-

(a) *Russell v. Briant*, 19 L. J. (C. P.) 33; 14 Jurist, 201; 8 C. B. 836.

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tion or performance and the copyright, shall become separated and vested in different owners, and such notice shall have been duly printed on all copies published after the passing of the Act previously to such vesting, then if the owner of the right of public representation or performance desire to retain the same, he must before the publication of any further copies of such musical composition, give notice in writing to the person in whom the copyright is vested, requiring him to print such notice as aforesaid on every copy of such musical composition to be thereafter published.

By the 3rd section, if the owner of the copyright, after due notice being given to him or his predecessor in title at the time, and generally in accordance with the last preceding section, neglect or fail to print legibly and conspicuously upon every copy of such composition published by him or by his authority, or by any person lawfully entitled to publish the same, and claiming through or under him, a note or memorandum stating that the right of public representation or performance is reserved, then the owner of the copyright at the time of the happening of such neglect or default is to forfeit and pay to the owner of the right of public representation or performance of such composition the sum of £20.

Liability of person letting for hire a place of dramatic entertainment.

A person who lets for hire by the evening a place of dramatic entertainment for the public performance of songs and music, and provides the hirer, who performs songs and music which he has not liberty to perform, with lights, benches, &c., is not liable to pay damages to the author for causing or permitting to be represented or performed a musical composition without the author's written consent (a).

This doctrine was followed in *Lyon v. Knowles* (b). The defendant, the proprietor of a theatre, allowed one Dillon to have the use of it for the purpose of dramatic entertainments. The defendant provided the band, the scene-shifters, the supernumeraries, the money-takers, and

(a) *Russell v. Briant*, 19 L. J. (C.P.) 33; 14 Jur. 201; 8 C. B. 836.

(b) 11 W. R. 266; 32 L. J. (Q.B.) 71; 10 L. T. (N.S.) 876.

paid for printing and advertising. Dillon employed his own company of actors and actresses, and selected the pieces which were to be represented, free from control on the part of the defendant. It was arranged that the money taken at the doors should be divided equally between the defendant and Dillon. During the period of such occupation of the theatre by Dillon, certain pieces were performed which the plaintiff had the sole liberty of representing or causing to be represented; and it was held, in an action to recover the penalties imposed by the above sections, that the plaintiff could not recover, inasmuch as, under the circumstances, the defendant was not shewn to have represented, directly or indirectly, the said dramatic pieces. If the representation of the pieces could have been considered a joint act of the defendant and Dillon, the defendant would have been liable. The defendant had no right to interfere in the choice of the pieces to be represented; and in short, though the proprietor, he was not the manager. Neither was he a partner; for the receipt of the moneys at the door was a receipt of gross proceeds, not net profits, and was merely a mode of receiving and securing the rent. There was an agreement between them to divide the gross receipts in lieu of payment of a specific sum as rent. But this did not make them partners. The defendant, then, having no control over the performances, could not be said to have caused them to be represented, and was consequently not liable. The defendant, to have been made liable, must have been shewn to have been either the partner or principal of Dillon, the person who actually directed the representation (a).

In the case last referred to Mr. Justice Blackburn said: "I do not think that, by furnishing servants to another, a man can be said to do all that is done by those servants while under the command of that other. A familiar example may be found in the case of a man letting a

(a) *Lyon v. Knowles*, 11 W. R. 266; 3 B. & S. 556; affirmed on appeal 5 B. & S. 751; 12 W. R. 1083; 10 L. T. (N.S.) 876.

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ready-furnished house, leaving an old servant in it. Suppose the tenant gave a dinner, which was cooked by that servant, who also attended on him at it, and for which the plates and furniture of the landlord were used, no one would say that, in any sense of the words, the landlord gave that dinner."

In another case (a) the defendant was the owner and manager of the Grecian Theatre, and for £30 he had let for one night to his son, who was the stage manager, the use of the theatre, company, and all persons employed. The son selected and brought out a play, for which representation the Court held the defendant liable. The judgment was based on the fact that the defendant had the control and management of the theatre and the company during that performance. "I think," said Erle, C.J., "the defendant is responsible for that representation. He was the proprietor of the theatre, and had entire control over the establishment and all belonging to it; and what was done by his son was done by his permission. The case of *Lyon v. Knowles* seems to me to recognise that distinction. There the defendant merely let his theatre with the scenery, scene-shifters, bands, lights, &c., to Dillon, who brought his own company to represent pieces of his own selection, the plaintiff having no control whatever over any person employed in the representation. Here, however, the piece is performed by the defendant's own *corps dramatique*, his son being one of them; and the performance takes place for the defendant's profit to the extent of £30. I think, therefore, it is impossible to say that the defendant did not cause the piece to be represented."

So in another case (b) the defendant was the proprietor of a music-hall, and had engaged a singer who on numerous occasions sang a song called 'We are going to reform some day,' the copyright of which was in the plaintiff as assignee. The defendant at the trial denied that he had

(a) *Marsh v. Conquest*, 17 C. B. (N.S.) 418. See *Parsons v. Chapman*, 5 C. & P. 33.

(b) *Monaghan v. Taylor*, 2 T. L. R. 685.

directed the song to be sung; he was in the hall when it was being sung, but had never heard the whole of it. The Court held, that inasmuch as the singer was hired by the defendant to sing what songs he liked and no supervision or control was exercised as to copyright, there was evidence of agency and authority to sing the song complained of.

It was argued that an authority to do an unlawful act could not be presumed, and that the presumption should be, that under a general or implied permission to sing what the artiste choose, only songs which could be lawfully sung would be selected; but it was considered that there having been a general permission by the defendant to sing, the true inference was that he took the chance of the songs sung being such as could be lawfully or unlawfully sung.

These cases are now met by the recent statute, 51 & 52 Vict. c. 17, the Copyright (Musical Compositions) Act, 1888, the 3rd section of which provides that the proprietor, tenant or occupier of any place of dramatic entertainment or other place at which any unauthorized representation or performance of any musical composition, whether published before or after the passing of the Act, shall take place, shall not by reason of such representation or performance be liable to any penalty or damages in respect thereof, unless he shall wilfully cause or permit such unauthorized representation or performance knowing it to be unauthorized. But the provisions of the Act are not to apply to any action or proceedings in respect of a representation or performance of any opera or stage play in any theatre or other place of public entertainment duly licensed in that respect.

Representing, within the meaning of the Act of William IV., is defined to be the bringing forward on a stage or place of public representation; and the question whether in any particular case the act done amounts to a representation, is a proper question for a jury.

If the words of one song only be taken from a musical or dramatic piece protected by the Act, or be sung on a

Copyright
(Musical Com-
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stage or in any place of theatrical entertainment, without the permission of the proprietor, the representation will be actionable (a).

In *Planché v. Braham*, the defendant sang two or three songs of the plaintiff's libretto to an opera, and one in particular commencing with the words

"Ocean ! thou mighty monster !"

And it was held that this was an infringement of the plaintiff's sole right of representation.

So too, the playing in public the music, though other words than the original be used, would be an infringement.

What is a
dramatic
composition.

The Act of William IV. gives to the authors of "any tragedy, comedy, play, opera, farce, or other dramatic piece or entertainment," the sole liberty of representing it. This right is affirmed by the statute of Victoria, which further declares that "the words 'dramatic piece' shall be construed to mean and include every tragedy, comedy, play, opera, farce, or other scenic, musical, or dramatic entertainment."

The above terms are not very distinct, and questions have arisen as to what is, or is not included in the "or other scenic, musical, or dramatic entertainment."

A work not intended for the stage may be in substance a drama, and may be easily adapted for representation. Is it excluded from the operation of the statute, because is it not in form and name a drama? Again, if fitness for public performance is the test of a dramatic composition, are songs within the purview of the statute? Though hardly dramatic compositions in the ordinary acceptation of the term, they seem to come within the words "musical entertainment." Whether a production is called a poem, or a tragedy, or novel, or a comedy, a history, or a drama, or whether its author did or did not intend it for public

(a) *Planché v. Braham*, 1 Jur. 823; 8 C. & P. 68; 4 Bing. (N.C.) 17. Two pounds may be exacted for each song, and if there is a performance in which 1000 people take part, as in a chorus, each would be liable for a separate penalty.

representation, is immaterial in ascertaining whether it is a dramatic composition. This question is determined by the character of the work, and not by what it is called, or the purpose for which the author has intended it. So also it is immaterial whether the words of a drama are spoken or sung; whether they are or are not accompanied with instrumental music. An opera, not less than a play without music, is a drama. The judicial construction given to "dramatic piece," as used and defined in the statute, is broad enough to embrace every composition which is dramatic in character and is suitable to be performed, recited, read, or sung for the entertainment of an audience. Thus it has been decided that a song which related the burning of a ship at sea, and the escape of those on board, describing their feelings in vehement language, and sometimes expressing them in the supposed words of the suffering parties, is dramatic, and consequently within the meaning of the statute, even though it be sung by one person only, sitting at a piano, giving effect to the verses by the delivery, but not assisted by scenery or appropriate dress (a).

That the whole is expressed in music makes no difference. The early Greek drama was musical throughout; so in the modern Italian opera. Nor can any distinction arise from the want of scenery or appropriate dress: an oratorio has neither, yet it is often dramatic. Nor, again, is it material that no second person performs. No one would suggest that Mr. Mathews' representations, or the readings of Shakespeare by Mrs. Siddons or Mr. Charles Kemble, were not dramatic. The character of Elijah is essentially a dramatic one, requiring, however, not dramatic action, but dramatic sentiment, in order to delineate it. Sometimes the wrath and gloom of such a character must be displayed, at other times the most pathetic tenderness. If the character of drama were denied to this species of entertainment, nothing short of requiring all the ingredients

(a) *Russell v. Smith*, 12 Q. B. 217.

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of a play would be admitted as a dramatic representation. If the interpretation clause of statute 5 & 6 Vict. c. 45, be referred to, it will be remarked that the 2nd section declares that "dramatic pieces" within that Act include "tragedy, comedy, play, opera, farce," or "other scenic, musical, or dramatic entertainment." These words comprehend any piece which can be called dramatic in its widest sense; any piece which, on being presented by any performer to an audience, will produce the emotions which are the purpose of the regular drama, and which constitute the entertainment of the audience (a).

In *Clark v. Bishop*, the court held the song, 'Come to Peckham Rye,' which has little, if any, of the dramatic character, to be a dramatic piece (b). And though there is no express decision to the effect that all songs are entitled to protection, yet there can be little doubt that this is practically the effect of the judicial decisions.

The statute under consideration does not, however, protect a literary production which is not a musical or dramatic composition, and the author has no remedy against any person who publicly reads or recites such production. Of course this applies only to published works, for the unauthorized public reading of any unpublished production, whether a dramatic composition or not, would be a violation of the owner's common law rights in the manuscript.

A spectacular piece is within the protection afforded by the statute. Thus in a case to be hereafter more fully considered, where it appeared that the defendant had taken from the plaintiff's play two scenes or situations, consisting more of scenic effects than of dialogue, Mr. Justice Brett said: "Now, it was first said that the subject matter of the action was not the subject matter of copyright; that the Act gives a property in words, and not in situations and scenic effects; but I think that

(a) Lord Denman, C.J., in *Russell v. Smith*, 12 Q. B. 217; 17 L. J. (Q. B.) 225.

(b) *Clark v. Bishop*, 25 L. T. (N.S.) 908.

these latter are more peculiarly the subject of copyright than the words themselves (a).

Copyright may be secured in the adaptation of a play which is itself common property. Thus in *Hatton v. Kean*, where it appeared that the defendant had designed a dramatic representation, consisting of one of Shakespeare's plays, with certain alterations in the text, original music, scenic effects, and other accessories, the Court did not doubt that the production, as a whole, was a proper subject of copyright, although the play itself was, in its original form, common property (b).

Adaptation
of old play.

A translation of a foreign play not entitled to protection in this country will receive the same protection as an original drama. Any number of persons may dramatize or translate a work which is common property, or, with the consent of the owner of the copyright, a work wherein copyright exists, and whatever may be the similarity between two dramatizations, adaptations, or translations, each dramatist will have copyright in his own version.

Translation
of foreign
drama.

Though the words in the Act 3 & 4 Will. 4 imposed the penalties there specified upon any who may pirate any protected "production or any part thereof," yet it was not necessarily intended to prevent the copying and reproduction of every and any part without regard to its importance. At the same time it does not follow that either the very language of the original drama, or a very considerable portion of it, must be appropriated in order to bring the case within the statute.

Principal
decisions on
questions of
piracy under
the Act of
Will. IV.

In considering and judging of what amount of copying or imitation would constitute piracy, similar rules to those already laid down with reference to copyright in books may be applied to the authors and owners of dramatic productions, for it would seem to be a proper rule to apply the same principle of construction to statutes which aim at objects substantially the same. The question of materiality must depend upon a consideration of the quantity

(a) *Chatterton v. Cave*, 33 L. T. (N.S.) 256.

(b) 7 C. B. (N.S.) 268.

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and value of the portion taken or use made, and must vary indefinitely in various circumstances. As Lord Chancellor Cottenham said in *Bramwell v. Halcomb* (a): "It is useless to refer to any particular cases as to quantity." The quantity taken may be great or small, but if it comprise a material portion of the book, it is taken illegally. The question is as to the substance of the thing, and if there be no abstraction of that which may be substantially appreciated, no penalty is incurred. In all cases, the matter is dealt with as one of degree. In all, quantity and value are both the subjects of consideration, and in none of them has an infringement been established without satisfactory evidence of an appropriation, possibly involving a substantial loss to one person, and a substantial gain to another.

The question in every case must be a question of fact, and therefore one for a jury.

The two principal cases under the 3 & 4 Will. 4, c. 15, are the cases of *Planché v. Braham* (b), and *Chatterton v. Cave* (c). In the first of these cases the defendant used the words of two or three songs of the plaintiff as the vehicle of some airs in an English version of Weber's opera of 'Oberon,' and the action was brought under the above Act. The rest of the version had been written by another person. There was no question as to appropriation of the music; and Lord Chief Justice Tindal left it to the jury to say whether there had been a representation of a part of the plaintiff's dramatic production. The jury found that there had been; and gave a verdict accordingly for the statutory penalty. Serjeant Wilde moved to set aside the verdict on the ground that as there had been no representation of a part of the plaintiff's piece,—the words of the songs adapted to the music being immaterial to the development of the drama,—the defendant was entitled to a judgment. But the Court affirmed the verdict, holding that the question before it must in all

(a) 3 My. & Cr. 738.

(b) 4 Bing. N. C. 17.

(c) L. R. 10 C. P. 572; 2 C. P. D. 42; 3 App. Cas. 488.

cases be determined by a jury. "It is difficult," said the Chief Justice, "to say what is or is not a representation of a part of a dramatic production, . . . and it must be left to a jury to determine the fact."

The second case was an action against the defendant in respect of his having committed an infringement of the copyright of the plaintiffs in a drama founded on the novel by Eugène Sue called 'The Wandering Jew.' There had been a drama in French founded on the same novel, and the version claimed by the plaintiffs, prepared by Mr. Lewis and assigned by him to them, was an adaptation from the French. The defendant had since brought out another adaptation, which it was alleged was, in part, an imitation of the former, and had thereby committed an infringement of the plaintiffs' copyright. When the case came on for trial, it was agreed to discharge the jury, Lord Coleridge undertaking to read the plays, to receive such evidence as he might deem material, and to find whether there had been any copying so as to bring the case within the statute. He found there had been two "scenes or points" of the plaintiffs' drama taken by the defendant without recourse either to the French novel or to the drama constructed from it, and he directed the verdict to be entered for the defendant. The finding was as follows:—"I find in this case that two scenes or points of the drama of the defendant have been taken direct from the drama of which Mr. Lewis was the author and the plaintiffs the assignees, without recourse to either the French novel or the French drama, originals common to the dramas of both the plaintiffs and defendant. I find this, first, in respect of the final scene of the defendant's drama; and secondly, of the appearance of the Wandering Jew, and the stage business connected with that appearance, which are to be found in the second scene of the second act of the defendant's drama, and in the fourth scene of the first act of the plaintiffs' drama. I find that the drama of the defendant is not, except in these respects, a copy from or

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a colourable imitation of the drama of the plaintiffs. I direct the verdict to be entered for the defendant. I assess the damages at 40s. if upon argument, as provided by the terms agreed to at the trial, the Court should be of opinion that the verdict ought to be entered for the plaintiffs." The case was argued upon a rule obtained to enter the verdict for the plaintiffs. This rule was discharged (a), and on appeal this decision was affirmed (b). The plaintiffs appealed to the House of Lords, and it was argued that the scenes, or points, as they were called, were material, valuable, and striking points, and affected considerably the attractiveness of the drama, and no one doubted that they had been copied from the plaintiffs' production, but the House affirmed the decisions of the courts below, Lord Hatherley saying: "There is indeed one obvious difference between the copyright in books and that in dramatic performances. Books are published with an expectation, if not a desire, that they will be criticised in reviews, and if deemed valuable, that part of them will be used as affording illustrations by way of quotation or the like, and if the quantity taken be neither substantial nor material, if, as it had been expressed by some Judges, 'a fair use' only be made of the publication, no wrong is done and no action can be brought. It is not, perhaps, exactly the same with dramatic performances. They are not intended to be repeated by others, or to be used in such a way as a book may be used, but still the principle *de minimis non curat lex* applies to a supposed wrong in taking a part of dramatic works, as well as in reproducing a part of a book. The minimum of damages, to be awarded when the fact of damage and the right to damages have been once established, was no doubt fixed because of the difficulty of proving with definiteness what amount of actual damage had been sustained, by perhaps a single performance at a provincial theatre of a work belonging to a plaintiff, whilst at the same time his work might be seriously

(a) L. R. 10 C. P. 572.

(b) 2 C. P. D. 42.

depreciated if he did not establish his right as against all those who infringed upon it. . . . I think, my lords, regard being had to the whole of the case, to the finding of the Lord Chief Justice that the parts which were so taken were neither substantial nor material parts, and the impossibility of damage being held to have accrued to the plaintiff from such taking, and the concurrence of the other Judges before whom the case was brought, that this appeal should be dismissed, and dismissed with costs" (a).

It is worthy of note here that when the question was raised in the Common Pleas, Lord Coleridge set out fully the reasons which had dictated his direction, and it then appeared that though the finding had no explicit allegation as to the character of the "scenes" or "points" which it finds to have been taken, their immateriality was meant to be conveyed. "These points so copied," said he, "were not parts of the dialogue or composition of the plaintiffs' drama, but were in the nature of dramatic situations or scenic effects. It appeared to me that, looking to the general character of the two dramas respectively, the extent to which the one was taken from the other was so slight, and the effect upon the total composition was so small, that there was no substantial and material taking of any one portion of the defendant's drama from any portion of the plaintiffs'. Therefore, though I felt bound to find that there was a taking of these two small points, I decided to enter the verdict for the defendant."

The Court will not protect any person in the exclusive right of representing an immoral play (b). Immoral play.

The proprietor of a drama whether published or unpublished, may license one or more persons to perform it anywhere, without giving to any one the exclusive right of representation. But in such case the owner of the copyright only could maintain an action in respect of Licences.

(a) 3 App. Cas. 483, 492, 493.

(b) The Lord Chamberlain on one occasion ('The Happy Land' at the Court Theatre) interposed to prevent certain high personages being represented in ludicrous positions upon the stage; see the powers of the Lord Chamberlain, 6 & 7 Vict. c. 68, Appendix.

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unlicensed performances. The owner may grant the exclusive right of representation for any named part of the country, or any town, city, or county, and within such limits, no one without the consent of the licensee has the right to perform the play.

Assignment
of the right
of representa-
tion.

By the 22nd section of the 5 & 6 Vict. c. 45, it is enacted that no assignment of the copyright of any book consisting of or containing a dramatic piece or musical composition, shall be holden to convey to the assignee the right of representing or performing such dramatic piece or musical composition, unless an entry in the registry book, to which reference has already been made (a), shall be made of such assignment, wherein shall be expressed the intention of the parties that such right should pass by such assignment. Under an assignment of "all present and future vested and contingent copyright in a musical composition," together with "all property" therein, the exclusive right of performance passes (b).

It is competent for an assignee of the sole right of representing a dramatic piece to sue for penalties under 3 & 4 Will. 4, c. 15, notwithstanding the assignment is not made by deed, or registered under 5 & 6 Vict. c. 45 (c), and so too it is competent for the author or his assign to sue for unauthorized performances if the performing rights have not been transferred (d).

The administrator of an author of a dramatic piece first acted in 1843, by deed dated the 14th of April, 1859, in consideration of £100, assigned to the plaintiff the copyright and right of representation in all dramatic pieces written by the author; no entry of the assignment to the plaintiff had been made in the registry book in pursuance of the section under consideration; but it was held that the plaintiff might maintain an action for penalties under

(a) *Ante*, chapter on registration.

(b) *Ex parte Hutchins and Romer*, 4 Q. B. D. 90, 483; 27 W. R. 261 857; 48 L. J., Q. B. 29, 505.

(c) *Marsh v. Conquest*, 17 C. B. (N.S.) 418; 10 L. T. (N.S.) 717.

(d) But as to the recovery of penalties see 45 & 46 Vict. c. 40; 51 & 52 Vict. c. 17.

statute 3 & 4 Will. 4, c. 15, against the defendant, for representing the piece without his licence within twenty-eight years of its publication, the period for which the sole liberty of representation is given by that statute, although the deed was not registered under statute 5 & 6 Vict. c. 45, s. 22.

That section in terms applies only to the effect of an assignment of the copyright, limiting its operation as such, and was intended to correct what had probably been an omission in previous legislation; for upon the construction of statute 3 & 4 Will. 4, c. 15, s. 1, the Court of Queen's Bench in *Cumberland v. Planché* (a) had held that the assignment of the copyright of a dramatic piece, carried with it, incidentally, the exclusive right of representation. Section 22 of statute 5 & 6 Vict. c. 45, was intended to meet that decision by enacting that no assignment of the copyright of a dramatic piece or musical composition should be holden to convey the right of representing or performing it, unless an entry was made in the registry book that it was the intention of the parties that such right should pass by the assignment (b). That enactment does not apply to a case in which there is an express assignment of the *right of representing or performing*. In the case of *Lacy v. Rhys*, there was an assignment of the right of acting, as well as of the copyright; and it was held, that it did not follow that, because section 24 required registration of an assignment of the copyright, and there was such an assignment there, therefore the assignment of the *right to represent* was in any way affected: *Utile per inutile non vitiatur*. When a person professes to convey two things, one of which he has a right to convey and the other he has not, the instrument operates to pass the property in that which he has a right to convey, and the rest is surplusage (c).

It is clear, therefore, that an assignment merely of the

Assignment
of the right

(a) 1 Ad. & E. 580. (b) *Chappell v. Boosey*, 21 Ch. D. 240.

(c) *Per* Cockburn, C.J., in *Lacy v. Rhys*, 4 B. & S. 873, 883; 12 W.R. 309; 33 L. J. (Q.B.) 157; 10 Jur. (N.S.) 612. See *Marsh v. Conquest*, 10 L. T. (N.S.) 717; 17 C. B. (N.S.) 418.

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of representation need not be registered.

right of representation needs not to be registered under the 22nd section; but the consent must be in writing. The provision of this section applies only to cases where the copyright in a dramatic or musical composition is assigned without any mention of the right of representation, and where consequently it may be doubtful whether the latter right was intended to be passed (a). Any doubt as to whether the consent within the Act must be in writing is removed by the decision in *Eaton v. Lake* (b), that oral permission to perform is not sufficient to constitute a binding assignment or consent to representation of a composition.

The legal assignment must be in writing.

The legal assignment either of the right to represent a dramatic piece, or perform a musical composition must be in writing (c), but need not be attested (d) or sealed (e). This was decided in *Shepherd v. Conquest* (f), where it appeared that the plaintiffs, being proprietors of the Surrey Theatre, verbally agreed with one Courtney that the latter should go to Paris for the purpose of adapting a piece there in vogue for representation on the English stage; that the plaintiffs should pay all Courtney's expenses, and should have the sole right of representing the piece in London, Courtney retaining the right of representation in the provinces. Courtney accordingly proceeded to Paris, produced a piece called 'Old Joe and Young Joe,' and was paid by the plaintiffs as agreed. The piece was brought out at the Surrey Theatre by the plaintiffs, and afterwards at the Grecian Saloon by the defendant, who had obtained an assignment from Courtney. The representations by the defendant at the

(a) See *Wood v. Boosey*, 7 B. & S. 869.

(b) 20 Q. B. D. 378.

(c) See *ante*, p. 184, as to what is an assignment, see *Leader v. Purday*, 7 C. B. 4; *Lacy v. Toole*, 15 L. T. (N.S.) 512.

(d) *Cumberland v. Copeland*, 1 Hurl. & C. 194.

(e) *Marsh v. Conquest*, 17 C. B. (N.S.) 418; 10 L. T. (N.S.) 717.

(f) 17 C. B. 427; 25 L. J. (C.P.) 127; *Eaton v. Lake*, 20 Q. B. D. 378; 57 L. J. (Q.B.) 227; 59 L. T. 100; 36 W. R. 277 (C.A.). When A. agrees with B. to "let B. have" a particular drama in discharge of £10 due from A. to B., this is a complete assignment of A.'s whole property in the drama: *Lacy v. Toole*, *supra*.

Grecian Saloon were the infringements of the plaintiffs' right complained of. The defendant objected that, as there was no assignment in writing from Courtney to the plaintiffs, the action was not maintainable. The plaintiffs contended that no assignment was necessary, for that, by virtue of Courtney's employment by them, they were the proprietors of the piece in question from the first moment of its composition, or that at least they were entitled to the sole right of representation in London. The Court of Common Pleas were of opinion that though Courtney made the adaptation at the suggestion of the plaintiffs, he acquired for himself, as the author of the adaptation, and as far as that adaptation gave any new character to the work, the statutory right of representing it; and that, inasmuch as the plaintiffs had no assignment in writing of that right, they could not sue for an infringement of it.

In the course of the delivery of the judgment, Jervis, C.J., doubted whether, under any circumstances, the copyright in a literary work, or the right of representation of a dramatic one, could become invested *ab initio* in an employer other than the person who had actually composed or adapted the work. But he was clearly of opinion that no such effect could be produced when the employers merely suggested the subject, and had no share in the design or execution of the work, the whole of which, so far as any character of originality belonged to it, flowed from the mind of the person employed. It appeared to him to be an abuse of terms to say that, in such a case, the employers were the authors of a work to which their minds had not contributed an idea; and it was upon the author, in the first instance, that the right was conferred by the statute which created it. Literary property stood upon a different and higher ground from that occupied by mechanical invention. The intention of the legislature in the enactments relating to copyright was to elevate and protect literary men; such an intention could only be effectuated by holding that the actual composer of the work was the author and proprietor of the copyright, and

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that no relation existing between him and an employer, who himself took no intellectual part in the production of the work, could, without an assignment in writing, vest the proprietorship of it in the latter (a).

This case was followed in *Eaton v. Lake* (b). The plaintiff was employed by the defendant, the proprietor of a music-hall, as the conductor of the orchestra at a weekly salary, and had been in the habit of composing the music for ballets performed there, receiving payments of varying amounts from the defendant in respect of such compositions. The plaintiff composed the music for a Christmas ballet, to be performed at the defendant's music-hall, but while the piece was running he threw up his engagement as conductor and took away the musical score and band parts necessary for the performance of the music. It was subsequently arranged orally between the plaintiff and the defendant that the plaintiff should give up the score and band parts to the defendant in consideration of a payment of £20. The defendant afterwards continued to perform the piece with the plaintiff's music, and the plaintiff brought an action to recover penalties in respect of such subsequent performances. The jury found that the music composed for the ballet by the plaintiff was a substantial, independent musical composition, and that the plaintiff had not sold his rights therein to the defendant. The Court of Queen's Bench (reversing the judgment of the Divisional Court) held that in the absence of any assignment or consent to the representation of the composition in writing given by the plaintiff, the performances were contrary to the right of the author and the action was maintainable.

No assignment necessary where work executed for another.

These cases must be distinguished from those in which one person forms the original and general design of a piece, and another merely carries out that design, as in *Hatton v. Kean* already referred to (c), where the

(a) *Ante*, pp. 134—136.

(b) 20 Q. B. D. 378; 57 L. J. (Q.B.) 227; 59 L. T. 100; 36 W. R. 277 (C.A.); 4 T. L. R. 96, 230.

(c) 29 L. J. (C.P.) 20.

defendant verbally employed the plaintiff to compose music as part of the representation of one of Shakespeare's plays, adapted to the stage by the defendant, with the aid of scenery, dresses, music, and other accompaniments, the general design of which was formed by the defendant. There it was held that, as between the parties, the defendant had the sole liberty of performance without assignment or consent in writing from the plaintiff. Nor is there any conflict with the principle laid down by Sir John Leach in *Barfield v. Nicholson* (a): "That the person who forms the plans and who embarks in the speculation of a work, and who employs various persons to compose different parts of it, adapted to their own peculiar acquirements, that he, the person who so forms the plan and scheme of the work, and pays different artists of his own selection, who, upon certain conditions, contribute to it, is the author and proprietor of the work, if not within the literal expression, at least within the equitable meaning of the statute of Anne, which, being a remedial law, is to be construed liberally."

The enactments upon which literary property and patents for inventions are respectively founded differ widely in their origin and in their details. In order to shew that the position and rights of an author within the former Acts are not to be measured by those of an inventor within the latter, it is only necessary to bear in mind that, whilst on the one hand a person who imports from abroad the invention of another, previously unknown here, without further originality or merit in himself, is an inventor entitled to a patent; on the other hand, a person who merely reprints for the first time in this country a valuable foreign work, without bestowing on it any intellectual labour of his own, as by translation (which, to some extent, must impress a new character), cannot thereby acquire the title of an author within the statutes relating to copyright (b). In *Morris v. Kelly* (c)

(a) 2 Sim. & Stu. 1.

(b) Jervis, C.J., in *Shepherd v. Conquest*, 25 L. J. (N.S.) Ch. 127.

(c) 1 Jac. & W. 481.

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an injunction was granted to restrain the performance of a comedy, the copyright of which had been sold by the author and had been afterwards assigned by writing to the plaintiffs, although it did not appear whether the original assignment was in writing, that fact being presumed till the contrary was shewn.

What constitutes joint authorship.

The making mere alterations, additions, or improvements, whether with or without the consent of the author, does not constitute a joint authorship. In the case of *Levy v. Rutley* (a), the plaintiff, Mr. L. Levy, proprietor of the Victoria Theatre, employed a Mr. Wilks to write for him a piece called 'The King's Wager, or the Camp, the Cottage, and the Court,' and himself suggested the subject. Mr. Wilks having completed the play, the plaintiff and some members of his company introduced various alterations in the incidents and in the dialogue, to make it the more attractive, and one of them wrote an additional scene. Under these circumstances it was held that there was no joint authorship. It was admitted that it was not necessary that each should contribute the same amount of labour, yet to constitute joint authorship there must be a joint labouring in furtherance of a common design. "All that the plaintiff has done," said Mr. Justice Keating in giving judgment, "is this: Wilks having written a dramatic piece complete, the plaintiff thinks it might be made more attractive, and accordingly he, without any co-operation with Wilks, introduces a new scene, and makes various alterations and additions to the dialogue. Could the additions so made constitute him a joint author with Wilks of the whole piece? There may, no doubt, be a plurality of authors: the statute, in s. 1, dealing with the duration of copyright, speaks of 'the author or authors, or the survivor of the authors.' But I fail to discover any evidence that there was any co-operation of the two in the design of this piece, or in its execution, or in any improvements either in the plot or the general structure. All the plaintiff claims to have

(a) Law Rep. 6 C. P. 523; *Shelley v. Ross*, L. R. 6 C. P. 531, note (1).

done is to vary some of the dialogue, so as to make it more suitable for his company or for his audience. If the plaintiff and the author had agreed together to re-arrange the plot, and so to produce a more attractive piece out of the original materials, possibly that might have made them joint authors of the whole. So, if two persons undertake jointly to write a play, agreeing in the general outline and design, and sharing the labour of working it out, each would be contributing to the whole production, and they might be said to be joint authors of it. But to constitute joint authorship, there must be a joint common design. Nothing of the sort appears here. The plaintiff made mere additions to a complete piece, which did not in themselves amount to a dramatic piece, but were intended only to make the play more attractive to the audience."

The composer's interest is not affected by shewing that the song was composed to be sung by a particular performer at the Opera, and that by the regulations of that establishment such compositions become the property of the house (a).

It will be observed that copyright is secured in manuscript dramatic compositions, and the right of exclusive representation is under certain conditions vested in the author, while at the same time copyright is conferred in dramatic works printed and published, and the right of exclusive representation is likewise conferred on the author.

The right of representation in MS plays.

It is obvious that here many questions of difficulty may arise.

Some of the general principles seem clear, but there are very nice distinctions on which little light is obtainable from the reported cases. When the right of representation has once been secured, it will be unaffected by any subsequent representation of the piece. Therefore, if first published in Great Britain and the copyright

(a) *Storace v. Longman*, 2 Camp. 27.

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in the piece duly secured, the first representation of the play afterwards in a foreign country would not affect the copyright.

But a previous publication of the play in print in a foreign country would defeat the claim to copyright in this, and the right of representation could not be secured in this country, even though the first representation of the play were to take place here.

It is said that the duration of the copyright is governed not by the representation, but by the publication, and that as the copyright dates from publication, it cannot be defeated or affected by any public performance of the play, no matter when or where made.

But this must be accepted with caution, for it would make the right of representation begin with and depend upon the first publication in print. And if such were the case a dramatist might have enjoyed the exclusive right of representing a manuscript play under the 20th section of the Copyright Act for nearly forty-two years, and then publish it in print and secure the copyright in the publication for another period of forty-two years. For the copyright in the piece itself would commence to run from the date of publication in print, but in such case it is doubtful whether the author would have the exclusive right of representation during this second period also. For it must be remembered that the 20th section expressly provides that the sole right of representation is to be secured to the author of a dramatic piece in manuscript by entering on the register, amongst other things, "the time and place of the first representation or performance;" and that "the first public representation or performance of any dramatic piece shall be deemed equivalent in the construction of the Act to the first publication of any book."

It therefore seems more likely that, should the question arise, it would be held that the right of exclusive representation would run from the date of the first representation of the play in manuscript, and not

from the date of the publication of the same play in print. No limit is fixed for the duration of the exclusive right of representation of the play while yet in manuscript; and therefore if not perpetual, the right would seem to last for 42 years or for the life of the author, and seven years after his death, whichever may be the longer period.

Where the right to the exclusive representation of a piece in manuscript has been lost by first representing the same in a foreign country, it cannot be recovered afterwards by printing and publishing the piece; for though the copyright in the printed piece might be thus secured, the right of representation having become common property, could not thus be regained.

It has been thought that the right of representation, secured by registration in accordance with the Act, of a piece in manuscript may be lost by such a publication in print as will amount to an abandonment of the copyright. It is argued that the right of representing a manuscript play rests on the condition that the composition is not published in print,—after it has been so published it passes from the class of manuscript to that of printed plays, and becomes subject to the conditions on which the right of exclusive representation will vest in published plays:—that this right then becomes subordinate to the copyright, and the validity of the former is dependent on that of the latter right; that an abandonment of the copyright, which is the greater right, involves an abandonment of the lesser right of representation; and that when the title to copyright is forfeited, the work becomes public property as far as printing copies is concerned; and this would make it public property as far as representing it is concerned (a).

In this view, however, we are unable entirely to concur.

As to dramatic pieces and musical compositions, the

Suggestions of
the Copyright

(a) Drone's 'Law of Copyright and Playright,' (Amer.) 607. The point was raised, but not decided, in the case of *Boosey v. Fairlie*, 7 Ch. Div. 316

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Commis-
sioners as to
musical and
dramatic
copyright.

Royal Commissioners in their report in 1878 said: "While in books there is only one copyright, in musical and dramatic works there are two, namely the right of printed publication and the right of public performance.

"These rights are essentially different and distinct, and we find that many plays and musical pieces are publicly performed without being published in the form of books, and thus the acting or dramatic copyright is in force, while as to literary copyright, such plays and pieces retain the character of unpublished manuscripts. Music printed and published becomes a book for the purpose of the literary copyright, and so, we presume, does a play; but it is a question what becomes of the performing copyright on the publication of the work as a book; and there is a further question, whether the performing copyright can be gained at all, if the piece is printed and published as a book before being publicly performed.

"With regard to the duration of copyright in dramatic pieces and musical compositions, we recommend that both the performing right and the literary right should be the same as for books.

"We further propose, in order to avoid the disunion between the literary and the performing rights in musical compositions and dramatic pieces, that the printed publication of such works should give dramatic or performing rights, and that public performance should give literary copyright. For a similar reason it would be desirable that the author of the words of songs, as distinguished from the music, should have no copyright in representation or publication with the music, except by special agreement" (a).

Private
performance.

In order that the performance be an infringement of the rights of the proprietors, it is necessary that it takes place in public, a strictly private performance not being within the prohibition of the statute.

But a representation may be regarded as a public one,

(a) Par. 72—75.

though the privilege of admission be denied to the general public and be extended only to certain persons. And though the fact that no charge is made for admission is no doubt one ingredient in determining whether the performance be public or private, yet it cannot in all cases be taken as conclusive. For as the object of the law is to protect the proprietor of the copyright from injury, a performance nominally private, but in reality public, whether a charge be made for admission or not, would be restrained, on the ground that it might be as injurious to the proprietor as if the representation had been public. "Private theatricals" are sometimes given by amateur performers in a place of public amusement to which a charge is made for admission. This undoubtedly would be regarded as a representation in public, although only invited persons or members of a certain society were privileged to buy tickets of admission. In a recent case the defendants and others joined in representing a dramatic piece known as "Our Boys" in a room at Guy's Hospital, without the consent of the proprietors of the copyright in the drama. The performance was merely for the entertainment of the nurses, attendants and others connected with the hospital, who were admitted free of charge, the governors of the hospital paying for seats, costumes, &c., and the performers having tickets for their friends. A reporter of a theatrical newspaper attended by invitation. It was held by Brett, M.R., and Bowen, L.J. (Fry L.J., dissenting), affirming the judgment of the Queen's Bench, that the performers were not liable to pay penalties to the owners of the copyright, the place of performance not being a place of dramatic entertainment within the Acts (a).

But if amateurs forming a society or a club subscribe among themselves to get up a dramatic entertainment, they are liable to pay the fees for the authorship as if they received money at the doors. The taking of money,

(a) *Duck v. Bates*, 12 Q. B. D. 79; 13 Q. B. D. 843; 49 L. T. 507; 32 W. R. 169.

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though it is not a necessary, is an important element in determining whether the place of representation is a public place or not.

What is piracy of a dramatic piece.

In considering what amounts to an infringement of the right of exclusive representation, the same general principles that govern infringement of copyright generally are applicable. An unauthorized performance of parts—such parts being material parts of a dramatic composition—will amount to piracy; and it is a question of fact and common sense whether the parts taken are of such a substance and value, or used in such a way, as to amount to an infringement (*a*). In a case where the defendant had dramatized a story of the plaintiff and had extracted almost verbatim from the tale very considerable passages for introduction into his play. Thus Act I. consisted of 674 lines: 47 of these were stage directions; of the remaining 627, 125 were taken verbatim from the novel. Some of the passages extracted were prominent and striking parts of the dialogue contained in the novel. It was held that an infringement had been committed, and that all passages from the plaintiff's book must be cancelled (*b*). Unless a material part has been taken there is no infringement, but substantial identity is sufficient to constitute piracy (*c*).

What amounts to substantial identity.

As to what amounts to substantial identity is well illustrated by a recent American case (*d*). The matter alleged to have been pirated was the "railroad scene" in Daly's play 'Under the Gaslight.' In this scene is represented a surface railroad and a signal station-shed, in which a woman, at her own request, is locked by the signalman, who then disappears. Next are seen two men, one of whom binds the other with a rope, fastens

(*a*) See *Planché v. Braham*, 8 C. & P. 68; on app. 4 Bing. N. C. 17; *Reade v. Conquest*, 11 C. B. (N.S.) 479; *Boosey v. Fairlie*, 7 Ch. D. 301; on app. 4 App. Cas. 711; *Chatterton v. Cave*, L. R. 10 C. P. 572; on app. 2 C. P. D. 42; 3 App. Cas. 483; *Beere and others v. Ellis*, 5 T. L. R. 330.

(*b*) *Warne v. Seebohm*, 39 Ch. D. 73.

(*c*) *Reade v. Conquest*, *supra*; *Boosey v. Fairlie*, *supra*.

(*d*) *Daly v. Palmer*, 6 Blatch. (Amer.) 256; see *Boucicault v. Wood*, 2 Biss. (Amer.) 34; *Martinetti v. Maguire*, 1 Deady (Amer.) 216.

him to the railroad track, and leaves him to be killed by an expected train. From a window in the shed the woman sees what is done, hears the noise of the approaching train, breaks open the door with an axe, and frees the intended victim an instant before the train rushes by.

This scene was reproduced, but with variations, by Mr. Boucicault in his drama entitled 'After Dark.' In that play he makes one of the characters, from a wine vault where he had been thrown, see, through a door into an adjoining vault, two persons pass through a hole in the wall the body of a man who had been made unconscious by drugs. With an iron bar he enlarges an orifice in the wall of the vault, which opens on an underground railway, and sees lying insensible on the track the person whose body has just been put there by the two men in the adjoining vault. Hearing the noise of a coming locomotive, he quickly makes his way through the opening in the wall and moves the body from the track, just in time to prevent it from being run over by the passing train.

In Daly's drama this incident occupies the third scene of the fourth act, and during its progress, there is considerable conversation between the several characters on the stage. In Boucicault's drama, it is represented in three scenes of the third act, chiefly by action, but partly by monologue spoken by one of the characters after he has seen the body on the track. In laying down the law applicable to these facts, Mr. Justice Blatchford said:—

"The series of events so represented, and communicated by movement and gesture alone to the intelligence of the spectator, according to the directions contained in parentheses, in the two plays in question here, embraces the confinement of A. in a receptacle from which there seems to be no feasible means of egress: a railroad track, with the body of B. placed across it in such a manner as to involve the apparent certain destruction of his life by a passing train; the appearance of A. at an opening in the

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receptacle, from which A. can see the body of B., audible indications that the train is approaching, successful efforts by A. from within the receptacle, by means of an implement found within it, to obtain egress from it upon the track ; and the moving of the body of B. by A., from the impending danger, a moment before the train rushes by. In both of the plays the idea is conveyed that B. is placed intentionally on the track, with the purpose of having him killed. Such idea is, in the plaintiff's play, conveyed by the joint medium of language uttered, and of movements which are the result of prescribed directions, while in Boucicault's play it is conveyed solely by language uttered. The action, the narrative, the dramatic effect and impression, and the series of events in the two scenes, are identical. Both are dramatic compositions, designed or suited for public representation. It is true that in one A. is a woman, and in the other A. is a man ; that in one A. is confined in a surface railroad stationshed, and in the other A. is confined in a cellar abutting on the track ; that in one A. uses an axe, and in the other A. uses an iron bar ; that in one A. breaks down a door, and in the other A. enlarges a circular hole ; that in one B. is conscious, and is fastened to the rails by a rope, and in the other B. is insensible, and is not fastened ; and that in one there is a good deal of dialogue during the scene, and in the other only a soliloquy by A. and no dialogue. But the two scenes are identical in substance, as written dramatic compositions, in the particulars in which the plaintiff alleges that what he has invented, and set in order, in the scene, has been appropriated by Boucicault.

“All that is substantial and material in the plaintiff's railroad scene has been used by Boucicault, in the same order and sequence of events, and in a manner to convey the same sensations and impressions to those who see it represented, as in the plaintiff's play. Boucicault has, indeed, adapted the plaintiff's series of events to the story of his play, and, in doing so, has evinced skill and art ;

but the same use is made in both plays of the same series of events, to excite, by representation, the same emotions, in the same sequence. There is no new use, in the sense of the law, in Boucicault's play, of what is found in the plaintiff's railroad scene. The railroad scene in Boucicault's play contains everything which makes the railroad scene in the plaintiff's play attractive as a representation on the stage. As, in the case of the musical composition, the air is the invention of the author, and a piracy is committed if that in which the whole meritorious part of the invention consists is incorporated in another work, without any material alteration in sequence of bars; so in the case of the dramatic composition, designed or suited for representation, the series of events directed in writing by the author, in any particular scene, is his invention, and a piracy is committed if that in which the whole merit of the scene consists is incorporated in another work, without any material alteration in the constituent parts of the series of events, or in the sequence of the events in the series.

"The adaptation of such series of events to different characters who use different language from the characters and language in the first play is like the adaptation of the musical air to a different instrument, or the addition to it of variations or of an accompaniment. The original subject of invention, that which required genius to construct it and set it in order, remains the same in the adaptation. A mere mechanic in dramatic composition can make such adaptation, and it is a piracy, if the appropriated series of events, when represented on the stage, although performed by new and different characters using different language, is recognised by the spectator, through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in the mind, in the same sequence or order. Tested by these principles, the railroad scene in Boucicault's play is, undoubtedly, when acted, performed, or represented on a stage or public

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Infringement
of the copy-
right in a
musical com-
position.

place, an invasion and infringement of the copyright of the plaintiff in the railroad scene in his play.”

As to what amounts to an infringement of the copyright in a musical composition (a), it has been decided that to publish, in the form of quadrilles and waltzes, the airs of an opera in which there exists an exclusive copyright, amounts to such. In *D'Almaine v. Boosey* (b), the plaintiff published, first the overture, and then a number of airs and all the melodies. It was admitted that the defendant had published portions of the opera containing the melodious parts of it; that he had also published entire airs; and, that, in one of his waltzes, he had introduced seventeen bars in succession containing the whole of the original air, although he added fifteen other bars which were not to be found in it. This, it was contended, was not a piracy: first, because the whole of each air had not been taken; and secondly, because what the plaintiff had purchased of the original author was the entire opera, and the opera consisted, not merely of certain airs and melodies, but of the whole score. Lord Lyndhurst, Chief Baron, however, held, as to the first argument, that piracy might be of part of an air as well as of the whole; and with reference to the second, that, admitting that the opera consisted of the whole score, yet if the plaintiff was entitled to the work, *à fortiori* he was entitled to publish the melodies which formed a part. The Lord Chief Baron regarded the subject of music on a different principle to that which he regarded other literary works; for he would not admit that the adapting for dancing, or otherwise, from the original composition, in which some degree of art is needed, could be deemed such a modification of an original work as should absorb the merit of the original in the new composition. It is the air or melody which is the invention of the author, and which may, in such case, be the subject of piracy;

(a) Assumption of the name and description of a song, see *Chappell v. Sheard*, 2 K. & J. 117.

(b) 1 Y. & C. 288. See *Chappell v. Sheard*, 1 Jur. (N.S.) 996.

and a piracy is committed if, by taking, not a single bar, but several, that in which the whole meritorious part of the invention consists is incorporated in the new work.

“If,” said Lord Lyndhurst, “you take from the composition of an author all those bars consecutively which form the entire air or melody, without any material alteration, it is a piracy; though, on the other hand, you might take them, in a different order, or broken by the intersection of others, like words, in such a manner as should not be a piracy. It must depend on whether the air taken is substantially the same with the original. Now, the most unlettered in music can distinguish one song from another, and the mere adaptation of the air, either by changing it to a dance or by transferring it from one instrument to another, does not, even to common apprehensions, alter the original subject. The ear tells you that it is the same. The original air requires the aid of genius for its construction, but a mere mechanic in music can make the adaptation or accompaniment. Substantially, the piracy is, when the appropriated music, though adapted to a different purpose from that of the original, may still be recognised by the ear. The adding variations makes no difference in the principle.”

The author of a dramatic work which has been first represented in a foreign country (such country not being a country within the International Copyright Acts) is not entitled to any exclusive right of representation in this country, the representation of a dramatic work being a publication of it within the meaning of the statute 7 Vict. c. 12, s. 19. This section provides that no author or composer of any dramatic piece or musical composition which shall, after the passing of the Act, be first published out of Her Majesty's dominions, shall have any copyright therein, or any exclusive right to the public representation or performance thereof, otherwise than such (if any) as he may become entitled to under that Act.

Representation first in a foreign country precludes exclusive right of representation being obtained here.

The only question which seems to have arisen upon this section has been as to the meaning to be attached to the

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word "published." In 1863 the point came before Vice-Chancellor Wood with reference to the piece known as 'The Colleen Bawn.' Mr. Boucicault filed his bill against Mr. Delafield, the proprietor of a theatre in the provinces, to restrain his performing this play. It appeared that 'The Colleen Bawn' had been performed in New York, and the Vice-Chancellor decided that the public performance in New York was a publication, and that having published it in that way, Mr. Boucicault was, under the 19th section of the 7 Vict. c. 12, absolutely deprived of the exclusive right in this country (a). After referring to the 19th section the Vice-Chancellor says; "If Mr. Boucicault had first represented his piece in the country, he would have been entitled to the copyright given by the earlier statutes. So, also, if he had given his first representation in any country with which a convention had been made under the International Copyright Act, he would have been entitled under that Act to all the same privileges. But in no case is a person to enjoy any rights conferred by the old Acts concurrently with those created by the International Copyright Act. This is the effect of the 19th section. . . . The plain purpose of the statute is to secure for this country the benefit of the first publication of new works, and certain conditions are made without which works first published abroad are not to be entitled to copyright. These conditions have not been complied with. The plaintiff, therefore, fails in his demand, and the bill must be dismissed."

The point was again raised by the same plaintiff in a subsequent case (b).

Mr. Boucicault applied for an injunction to restrain Mr. Chatterton, who was the lessee of the Adelphi Theatre, from representing the drama called 'The Shaughraun,' the copyright in, and the sole right of representing or performing which, he claimed. 'The Shaughraun' was written by the plaintiff in 1874, and was first performed

(a) *Boucicault v. Delafield*, 1 H. & M. 597.

(b) *Boucicault v. Chatterton*, 5 Ch. Div. 267.

in New York in November of that year. It was registered at Stationers' Hall in 1874, as a book under the Copyright Act, 1842, but there being an inaccuracy in the form of the registration, the drama was again registered in November, 1876, in the name of Mr. Boucicault as the proprietor of the copyright. In September, 1875, the play was produced at Drury Lane under an arrangement between the plaintiff and defendant, and it was there performed till the month of December, after which it was transferred to the Adelphi, and played till January, 1876. Mr. Boucicault then went to America, where he had been naturalized. After this a correspondence took place between the plaintiff and the defendant, in which the defendant expressed his desire to reproduce the drama at the Adelphi Theatre, but the plaintiff declined the defendant's proposals and refused to permit the performance. The defendant thereupon advertised the performance, and the plaintiff commenced an action. He claimed under the Act 3 & 4 Will. 4, c. 15, and contended that his rights under this Act were unaffected by the 7 Vict. c. 12. It was argued that the play had not been published abroad, as representation did not amount to publication; that the statute 7 Vict. c. 12, only took away the right conferred by the 3 & 4 Will. 4, c. 15, and preserved by the 5 & 6 Vict. c. 45, as far as regards plays *published abroad* by printing. Vice-Chancellor Malins considered himself bound by the decision in *Boucicault v. Delafield* and held that the acting of the play in New York was a publication within the meaning of 7 Vict. c. 12, s. 19, and that by that publication Mr. Boucicault had lost his exclusive right of performance.

On appeal this view was confirmed, Lord Justice James saying: "The 19th section of the International Copyright Act has a limited purpose only, expressed in terms shewing the meaning of the word 'published,' which must express something that can be predicated of a book, of a dramatic piece, of a musical composition, of a print or article of sculpture, or any other work of art; that is to

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say, its being made public by those means which are appropriated to the particular thing. A book is published by being printed and issued to the public, a dramatic piece or a musical composition is published by being publicly performed, a piece of sculpture or other work of art by being multiplied by casts or other copies. That, as it appears to me, is the natural meaning of the word 'published' in that section, and that is the meaning attributed to it by the Vice-Chancellor." And Brett, J.A., saying: "A dramatic composition differs from many compositions in this, that it can be made use of in two different ways. It may be made use of by printing it, and distributing it as a written composition or a book. It may also be used by having it acted on the stage of a theatre. If the author be an Englishman, no doubt he has certain rights given to him by the statute 3 & 4 Will. 4, c. 15, but a foreign author has no rights at all under that statute. If, therefore, a foreign author's play was first acted abroad, he could not afterwards claim any protection in England. He would by acting it abroad have made it *publici juris* in England, and, therefore, anybody in England might act it here. It is said, that an English author, although he allows his compositions to be acted abroad, does not come under the same difficulty, because he is protected by the statute of 3 & 4 Will. 4, c. 15. That may be, and although I have some doubts whether the limitation of the meaning of the word 'published' which has been contended for applies even to that statute, I will assume that it does, and that an Englishman, although his piece was first acted abroad, could claim the protection given by the statute of 3 & 4 Will. 4, c. 15. A foreigner, however, certainly could not claim that protection. Then, if that be the state of things before the statute 7 Vict. c. 12, we have two sets of people to deal with as regards dramatic compositions, that is, foreign authors who had no protection in England, and English authors who might first of all have their pieces acted abroad, and yet have protection under 3 & 4 Will. 4, c. 15. The statute of

Victoria begins by giving the Queen power to give protection to foreign authors and dramatic composers, and that is done under section 5, which has regard to their protection against performances. Their protection against publication by printing is given to them under other sections. The 5th section provides that where the authors of dramatic pieces have first publicly represented or performed them in any foreign country, the Queen shall have the power of giving them sole liberty of representing or performing the same in any part of Her Majesty's dominions. The statute is dealing with several kinds of things to be protected, which may be published in different ways, and with different persons, with foreigners, and, as we shall presently see, with Englishmen. Then the 19th section provides in perfectly general words, 'That the author of no dramatic piece or musical composition which shall after the passing of this Act be first published out of Her Majesty's dominions shall have any copyright therein respectively, or any exclusive right to the representation or performance thereof, otherwise than such (if any) as he may become entitled to under this Act.' Now, it is said that the word 'published' ought to be restricted to the meaning which is said to have been affixed to it in the statute 3 & 4 Will. 4, c. 15. If so, the word 'published,' when applied to English authors, must have one meaning, and another when applied to foreign authors under precisely similar circumstances. That seems to me to be contrary to the common canon of the construction of statutes, for it requires us to introduce into the statute the proviso that in the case of English authors representation out of Her Majesty's dominions shall not be considered a publication. That would be to introduce words which we have no right to introduce, unless there be something in the nature of the case which makes it obvious that such must have been the object of the legislature. It is endeavoured to make out this to have been the object by saying that it is unjust to take away the right of an English author. I see nothing contrary to reason or

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justice in saying that if an English author chooses to go abroad and there represent, or allow to be represented, his composition for the first time, he shall be in the same position as a foreigner who has done the same thing. If that be so, the word 'published' must have its natural construction, whether it is applied to the compositions of Englishmen or foreigners. That ordinary meaning is 'made public,' and a dramatic composition is made public the moment it is represented or acted. If Englishmen have their plays first represented abroad, they are by this statute placed on the same footing as foreigners; if they have them first represented in England they do not come under this statute at all; but their rights will be governed by 3 & 4 Will, 4, c. 15, and 5 & 6 Vict. c. 45."

A novel may be dramatised without infringement.

Though no person may, without the author's written consent, represent the incidents of his published dramatic piece, however indirectly taken, yet no action will lie, at the suit of the author of a novel, against a person who dramatizes it and causes it to be acted on the stage (a).

This was decided in *Reade v. Conquest* (b). The second count of the declaration alleged that the plaintiff was the duly registered proprietor of the copyright in a certain registered book, namely, a tale or novel or story entitled 'It is Never too Late to Mend,' and complained that the defendant, without the plaintiff's consent, dramatized the said novel, and caused it to be publicly represented and performed as a drama at the Grecian Theatre for profit, and thereby the sale of the book was injured, &c. To this count there was a demurrer; and it was insisted, on the part of the defendant, that representing the incidents of a published novel in a dramatic form upon the stage, although done publicly and for profit, is not an infringement of the plaintiff's copyright therein; and the Court of Common Pleas was of opinion that the defendant was right (c).

(a) *Reade v. Conquest*, 9 C. B. (N.S.) 755; S. C. 30 L. J. (N.S.) (C.P.) 209; 9 W. R. 434; 7 Jur. (N.S.) 265.

(b) *Ibid.*

(c) In a French case cited in Le Blanc on 'Piracy,' p. 233, under the

Neither the 3 & 4 Will. 4, c. 15, nor the 5 & 6 Vict. c. 45, contemplated the conversion of a book into a dramatic piece, and the definition of copyright in the second section of the latter Act, "the sole and exclusive liberty of printing or otherwise multiplying copies of any subject to which the said word is herein applied," evidently did not include the claim of the plaintiff in the above case.

All that was here decided was, that the defendant had a right to act, that is to say, to speak and *represent the drama* which was constructed out of the plaintiff's novel; it was not held that the defendant had a right to *print it*.

But the drama may not be printed.

In a subsequent case, in 1862 (a), Lush, as counsel for the defendant, submitted that he had a right to print and publish such a drama, with the exception of any passages which were mere copies of the novel; but the circumstances of the case did not render it necessary that the point should be decided. "If that question should arise," said Erle, C.J., "it would then be time to decide whether the defendant could find any defence; but it is clear he could not in that case defend himself on the ground that he was the author of the parts which he copied."

The question, however, has since arisen in the case of *Tinsley v. Lucy* (b). A bill was filed by the publishers and owners of the copyright in two novels, called 'Aurora Floyd' and 'Lady Audley's Secret,' written by Miss Bradon. The novels had been dramatized by a Mr. Suter, and performed at the Queen's Theatre. The defendant, Mr. Lucy, had *published* the two plays as they were performed. It was proved that a large portion of the dramas,

name of *Lefranc v. Paul de Brussel*, a different principle was followed. The defendant there had dramatized a tale written by the plaintiff, and represented it upon the stage for profit; the plaintiff claimed to be entitled, as *collaborateur*, to a portion of the profits, and the court decided that, although he could not claim it in that capacity, inasmuch as the adaptation of the tale to the stage was without his knowledge or consent, still he had a good claim for damages against the defendant for the piracy, and it mulcted the defendant in damages and costs.

(a) *Reule v. Conquest*, 31 L. J. (C.P.) 153; 8 Jur. (N.S.) 764; 11 C. B. (N.S.) 479.

(b) 32 L. J. (Ch.) 535; 11 W. R. 876; 1 Hem. & Mill. 747.

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including the most striking incidents and much of the actual language of the novels, had been taken bodily from the novels. Vice-Chancellor Wood, in passing judgment, admitted that the defendant was entitled to dramatize the novels for the purpose of a mere acting drama; but held that he was not so entitled for the purpose of printing or selling his compilation. "He has taken," said the Vice-Chancellor, "to use the language of Lord Cottenham in *Bramwell v. Halcomb*, the vital portion of the novels, the leading incidents of the plot, and in many instances the very language of the novel itself. He reprints in his books (and I confine myself to what appears in the books, and say nothing as to the represented drama), the very words of the most stirring passages of the novels. It is no answer to say that similar infringements have often been committed. Although Sir Walter Scott and other authors did not choose to assert any claim of this kind, this does not affect the rights of the plaintiff; and it is to be observed, moreover, that there has been a considerable alteration of the law since the time referred to by the extension of copyright to dramatic performances. . . . The question of the extent of appropriation which is necessary to establish an infringement of copyright, is often one of extreme difficulty; but, in cases of this description, the quality of the piracy is more important than the proportion which the borrowed passages may bear to the whole work. Here it is enough to say, that the defendant admits that one-fourth of the dramas is composed of matter taken from the novels. In *Campbell v. Scott* (a), which has a strong bearing on this point, the defendants had published a work containing biographies and selections from the works of a large number of modern poets, and among others, six short poems, and extracts from larger poems written by the plaintiff. The defence was, that the poems were *bonâ fide* selections, forming a very small proportion of the writings of the plaintiff; that such com-

(a) 11 Sim. 31; 11 L. J. (N.S.) Ch. 166; 6 Jur. 186.

pilations were cautiously made by the most respectable publishers; that the price of the compilation was £1 1s., while the plaintiff's entire works were published at 2s. 6d.; and that the plaintiff would be rather benefited than injured by the defendants' work, which contained 10,000 lines, of which only a few hundreds were taken from the plaintiff's poems." The Vice-Chancellor, after observing that in the case of the '*Encyclopædia Londinensis*' the jury found for the plaintiff, though the matter taken formed but a very small proportion of the work into which it was introduced, adds, "that it is not necessary to consider whether the selections were the cream and essence of all that Mr. Campbell ever wrote. There is no doubt that in this case, as in that of Campbell's poems, the passages taken were the striking passages, and these have been taken by the author of the defendant's publications for the express purpose of using Miss Braddon's property for his own benefit. So long as he confined himself to dramatic representations he could not be interfered with; but when he printed his plays he brought himself within the letter of the law."

This was followed in the case of 'Little Lord Fauntleroy.' There the defendant dramatized the novel of this name and caused his play to be performed on the stage. The infringement of copyright complained of was that for the purpose of producing the play the defendant made four copies of it, one for the Lord Chamberlain and three for the use of the performers, either in MS. or by the aid of a type-writer. Very considerable passages in the play were extracted almost verbatim from the novel. Thus in the first act there were 674 lines, of which forty-seven consisted of stage directions. Deducting them, there were 627, of which 125 (or about one-fourth) were taken from the novel. Some of the passages so extracted were prominent and striking parts of the dialogue contained in the novel. The defendant claimed the right to make more copies, if it should be necessary, to enable him to give further representations of the play in London and else-

Neither may
the drama be
otherwise
multiplied.

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where, but the Court denied this right, and held that what had been done by the defendant constituted an infringement of the plaintiffs' copyright, and that they were entitled to an injunction to restrain the defendant from printing or otherwise multiplying copies of his play containing any passages from the plaintiffs' book; also that all passages from the plaintiffs' book in the four copies must be cancelled (a).

It will be observed that in this case the plaintiff did not rely upon section 15 of the Copyright Amendment Act, which provides a remedy for infringement where the infringement is limited to "printed" books, and books "exposed for sale or hire;" for had he done so he must have failed, as the defendant had not "printed" the copies, nor had he "exposed them for sale or hire." He relied simply upon his general rights in virtue of the interpretation claim of the Act, and the decision in *Jefferys v. Boosey*, that copyright is the sole liberty to print or otherwise multiply copies. The question, therefore, was not whether the defendant had violated any performing rights of the plaintiff, for he had no such exclusive rights; nor whether he was or was not entitled to dramatize the plaintiffs' tale, for this right was admitted; but whether the "book" of the play was an infringement of the copyright in the "book" "*Little Lord Fauntleroy*."

Author may protect his novel by dramatizing before publication.

The author of a play who makes use of its plot and dialogue in the composition of a novel, does not thereby forfeit his right to restrain infringement of his copyright in the play, although such infringement takes place through the medium of the novel, by a person who was ignorant of the existence of the original play. The indirect appropriation, then, of any portion of the novel taken from the play, is an infringement of the copyright in the play. The plaintiff in *Reade v. Lucy* (b), wrote a play called 'Gold,' which he afterwards adapted as a

(a) *Warne & Co. v. Seeborn*, 39 C. D. 73; 57 L. J. (Ch.) 689; 58 L. T. 928; 36 W. R. 686.

(b) 1 J. & H. 524.

novel, embodied a portion of the dialogue, and called it, 'Never too Late to Mend.' The novel was dramatized by another person; and, in doing so, portions of the original play were copied word for word, and in that form published by the defendant. It was held that ignorance would not justify the infringement of a right in one case more than in another, and that the publication of the play was an infringement of the copyright in 'Gold,' although the existence of that play was not known to the author, who took his materials from the novel (a).

So in a recent case where an action was brought by the executors of an author to restrain the defendant from representing a certain drama in infringement of the author's stage copyright, and it appeared that the author had first published a drama and afterwards a novel founded upon it, and the defendant's drama was dramatized directly from the novel and without the aid of the author's drama, still it was held that the author having published the drama before the novel, no person had a right to infringe the stage copyright in the drama, even though the passages complained of were taken from the novel and not from the drama of the author (b).

But, according to the authority of *Toole v. Young* (c), an author cannot protect his novel from dramatization by dramatizing it after its publication, it must be effected before publication of the novel. In the case referred to John Hollingshead had published in 1863, in the magazine called 'Good Words,' a story entitled 'Not Above his Business,' which he had written in dramatic form, that it might, with slight alterations, be performed on the stage. Soon after, the author adapted the piece for representation

Author cannot protect his novel by dramatizing it after publication.

(a) So in *Lee v. Simpson*, 3 C. B. 871 ; 4 D. & L. 666, where the defendant had purchased the piece which he represented and believed he had a right to, but on proof by the plaintiff that he, the plaintiff, had the right, the judgment was against the defendant. If the plaintiff had been bound to show the defendant's knowledge, the protection conceded by the statute would be illusory.

(b) *Schlesinger v. Turner*, 63 L. T. 764 ; W. N. (1890) 224.

(c) L. R. 9 Q. B. 523. *Schlesinger v. Belford*, 63 L. T. 762 ; W. N. (1890) 224.

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and called the play 'Shop,' which was substantially the same as the published story. In 1865, the play was bought from the author by the comedian Toole; and, when the action was brought, it had not been published or acted. In 1870, Grattan dramatized the story, which had appeared in 'Good Words,' and afterwards sold the play to the defendant, by whom it was repeatedly performed on the stage under the name of 'Glory.' It was admitted that the plays were substantially the same, and that the defendant's had been obtained from the story, and not from the plaintiff's 'Shop.' The judgment of the court was that no rights, either in the work dramatized or in the plaintiff's play, had been invaded by the defendant's dramatization; but, by first publishing his composition as a book, an author forfeits the exclusive right to dramatize and to represent it on the stage; and though he should afterwards dramatize his own published composition, he cannot thereby bar others from exercising the same privilege.

It seems doubtful how far the distinction drawn by the court between the publication of the novelist's drama preceding the novel and succeeding the same is sound, but the distinction was admitted in the recent case of *Schlesinger v. Bedford* (a).

The only way therefore, according to the authorities, in which it appears possible for an author to prevent other persons from reciting or representing as a dramatic performance the whole or any portion of a work of his composition, is himself to publish his work in the form of a drama, before publishing the novel and thus bring himself within the scope of the dramatic copyright clauses (b).

(a) 63 L. T. 762, W. N. (1890) 224.

(b) As to the dramatization of novels, the Royal Commissioners on Copyright in their report in 1878 said: "With reference to the drama, our attention has been directed to a practice, now very common, of taking a novel and turning its contents into a play for stage purposes, without the consent of the author or owner of the copyright. The same thing may be done with works of other kinds if adapted for the purpose, but inasmuch as novels are more suitable for this practice than other works, the practice has acquired the designation of dramatization of novels. The

Not only an original composition, but any substantially new arrangement or adaptation of an old piece of music is a proper subject of copyright (*a*).

The pianoforte score of an already existing opera, whether arranged by the composer himself or by another person, is the subject of copyright; and as such is entitled

The pianoforte score of an opera.

extent to which novels may be used for this purpose varies. Stories have been written in a form adapted to stage representation almost without change. Sometimes certain parts and passages of novels are put bodily into the play, while the bulk of the play is original matter; and at other times the plot of the novel is taken as the basis of a play, the dialogue being altogether original.

“Whatever may be the precise form of the dramatization, the practice has given rise to much complaint, and considerable loss, both in money and reputation, is alleged to have been inflicted upon novelists. The author’s pecuniary injury consists in his failing to obtain the profit he might receive if dramatization could not take place without his consent. He may be injured in reputation if an erroneous impression is given of his book.

“In addition to these complaints, it has been pressed upon us that it is only just that an author should be entitled to the full amount of profit which he can derive from his own creation; that the product of a man’s brain ought to be his own for all purposes; and that it is unjust, when he has expended his invention and labour in the composition of a story, that another man should be able to reap part of the harvest.

“On the other hand, it has been argued that the principle of copyright does not prevent the free use of the ideas contained in the original work, though it protects the special form in which those ideas are embodied; that a change in the existing law would lead to endless litigation; and that it would work to the disadvantage both of the author and the public. Upon these grounds, or some of them, a bill introduced by Lord Lyttleton in 1866 and supported by Lord Stanhope was defeated.

“We have fully considered all these points, and have come to the conclusion that the right of dramatizing a novel or other work should be reserved to the author. This change would assimilate our law to that of France and the United States, where the author’s right in this respect is fully protected.

“Were this recommendation adopted, a further question would arise as to the time during which this right should be vested in the author, and, in the event of his not choosing to dramatize his novel, whether other persons should be debarred from making use of the story he has given to the world. We are disposed to think that the right of dramatization should be co-extensive with the copyright. It has been suggested in the interest of the public, that a term, say of three or five years, or even more, should be allowed to the author, within which he should have the sole right to dramatize his novel, and that it should be then open to any one to dramatize it. The benefit, however, to the public in having a story represented on the stage does not appear to us to be sufficient to outweigh the convenience of making the right of dramatizing uniform in its incidents with other copyright.” Par. 76-81.

(*a*) So also the arrangement for the piano of quadrilles, waltzes, etc., selected from an opera, is entitled to protection: *Atwill v. Ferrett*, 2 Blatch. (Amer.) 39. So copyright has been held to vest in a song consisting of new words and a new accompaniment written to an old air: *Lander v. Purday*, 7 C. B. 4.

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to protection, provided the arranger had a right so to use the original. The arrangement of the opera score for the pianoforte involves labour as well as intelligence and skill, which constitutes it a new work (a). In Renouard's '*Traité des Droits d'Auteurs*,' tome ii. p. 190, pt. iv. ch. 2, p. 78, it is said: "*Des arrangements, variations, valse, contredanses, etc., composés sur un thème, un air, un motif même, appartenant au domaine public; des pots-pourris, sorte de compilation musicale, disposés dans un certain ordre et avec certaines liaisons ou transitions, sont-ils des objets de privilège? Je n'hésite pas à croire que la solution affirmative résulte des principes généraux sur la matière, exposés au commencement de ce chapitre. Il résulte des mêmes principes que ces compositions ne conféreront un privilège qu'autant qu'elles supposeront de l'art, du travail, un effort d'intelligence; qu'elles seront, en un mot, une production de l'esprit.*"

And in deciding the point in the last cited case Sir A. Cockburn, C.J., said: "It seems impossible to believe that any musician, however great his talent, whether as a composer or an executant, from the mere circumstance of having the opera in its entirety before him, that is to say, with all the score for all the instruments, which neither eye nor mind could take in at the same time, could be able to play the accompaniment while singing the music of the opera at the piano. It requires time, reflection, skill, and mind so to condense the opera score as to compose the pianoforte accompaniment. . . . I cannot, therefore, bring myself to think that the pianoforte arrangement of the music of an opera, which originally consisted of vocal music and instrumentation to be executed by some half-hundred instruments, can be said to be anything else than a specific, separate, and distinct work from the opera itself. And it seems to me to hold otherwise would lead to very

(a) *Wood v. Boosey*, L. R. 2 Q. B. 340; 7 B. & S. 869; 36 L. J. (Q. B.) 103; 15 W. R. 309; 15 L. T. (N. S.) 530; affirmed 9 B. & S. 175; L. R. 3 Q. B. 223; 37 L. J. (Q. B.) 64; 16 W. R. 485; 18 L. T. (N. S.) 105; *Boosey v. Fairlie*, 7 Ch. Div. 301; 14 App. C. 714.

serious consequences. Operas are very frequently arranged sometimes by the composer of the opera himself, sometimes by other persons, with the consent or without the consent of the original composer. It may be, if the arrangement be made without the consent of the composer of the opera, such an adaptation would be an infringement of his copyright, which would subject the adapter to an action. It is not necessary to decide that. But it may be that, after the copyright has expired, an arrangement for the pianoforte may be made in the first instance, or some musical composer, thinking that an arrangement that already existed of some well-known and popular opera is not as good as it can be made, might apply his hand to the work and make a new arrangement. Can it be said that such an arrangement, useful as regards the musical world, shall not be the subject of protection under the Copyright Acts?"

And on appeal Sir Fitzroy Kelly, C.B. (*a*), in affirming the decision of the Queen's Bench, clearly pointed out the difference between the pianoforte score and the original score, and the fact that each might be the subject of copyright. "The opera" said he, "is composed and is published in score, and contains in each line of what is called the entire score, the music for some one particular instrument, these instruments being some twenty in number. Now let us come to what the arrangement is for the pianoforte. Undoubtedly there are portions of it which are identical, as in the case before the Exchequer, and might subject, as I have already observed, the author of the adaptation to an action if it had been published without the authority of the author of the opera. But what is the pianoforte arrangement? It is an arrangement of the whole of the music of this opera for the pianoforte, a part of which is the ordinary pianoforte accompaniment, the bass and the treble, played with both hands, and which is independent of the melody. There

Difference
between
pianoforte
score and
original score.

(*a*) L. R. 3 Q. B. 223, 229; 15 L. T. (N.S.) 530.

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may be, as it appears, the line of music for one voice, or two or three voices, as the case may be; and there are separate and distinct lines for the accompaniment for the pianoforte; and no doubt, here and there throughout this accompaniment, and by going line by line through the score of the original opera, there may be found the same notes; but there are other parts of the accompaniment which are merely the pianoforte accompaniment, the notes forming which are nowhere to be found in the score at all. The accompaniment for the pianoforte is a work of greater or less skill. In some cases, perhaps in many cases—it may be in this for aught I know—the operation of adaptation is little more than mechanical, and what any one acquainted with the science of music, any composer of experience, might have been able to do without difficulty; but it may be, and often is, as in the case of the six operas of Mozart, by Mazzinghi, a work—I would hardly use the term of great genius, but a work—of great merit and skill of that eminent composer and pianist, Mazzinghi. If such a work be published as the adaptation to the pianoforte by a composer, other than the composer of the original opera, no doubt it is a piracy of the opera, and the composer may maintain an action against the adapter or the publisher of the adaptation: but, whenever the copyright in the original opera has expired, if after that, and for the first time, another composer composes another adaptation of that opera to the pianoforte, it is a new substantive work, in respect of which he is just as much entitled to the benefit of the copyright in this country, as the original composer of the opera; and if any one had by an adaptation pirated that arrangement, he would be liable to an action for that piracy. I consider that an infallible test to shew the difference between the one work and the other—between the original opera and the arrangement of it for the pianoforte. It is perfectly clear, therefore, that in point of fact—for it is rather a matter of fact than anything else—the adaptation to the pianoforte, or the arrangement for the pianoforte, of an opera already

published, is itself a new and separate work, and is not one and the same with the original opera" (a).

So also with reference to a piece of music called 'Pestal,' which had been played by the military bands in the style of a Russian Polonaise. The plaintiff, in an action for infringement, had got possession of the score, it did not transpire how—set it to words, concocted a thrilling introductory anecdote, and sold the copyright to a music-seller who published it with success. Other publishers arranged new versions of song and verses, for which the proprietor recovered damages. The coincidence between the harmonies and accompaniments in such a case, must be relied on as forming the part alone in which copyright exists. The original composition, if not claimed by any one, becomes public property; and one person has as much right to publish it as another (b).

In *Leader v. Cocks*, it was held that one who adapts words to an old air, and procures a friend to compose an accompaniment thereto, acquires a copyright in both words and accompaniment, and his assignee in declaring for an infringement, may describe himself proprietor of the copyright in the whole composition. So in *Chappell v. Sheard* (c), where new words had been adapted to an old American melody known as 'Lillie Dale,' in which there was no copyright, to which was added a symphony and accompaniments, and a cadence at the close, and entitled, 'Minnie,' with a portrait of Madame Anna Thillon; and the defendant published a song to the same air, and called it 'Minnie Dale,' with a similar portrait, but different words, and represented it as having been sung by the same

The adaptation of words and accompaniment to an old air.

(a) In this same case Bramwell, B., said: "It has been said that there is nothing inventive on the part of the person who makes the arrangement. In one sense, there is not—that is to say, he neither invents the tune nor the harmony; but there is invention in another sense, or rather there is composition in the adaptation to the particular instrument. Of that, the adapter is the author, and it is perfectly certain that the man who wanted to arrange this opera for a pianoforte would find it a great deal easier to copy what Brissler had done than to take the score and do it over again."

(b) *Leader v. Purday*, 7 C. B. 4.

(c) 2 K. & J. 117.

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lady, whereas in truth this song had never been sung by her, it was held that the plaintiff had obtained a right of property in the name and description of his song, which a Court of Equity, as in the case of dramatic representations and literature, would restrain any person from infringing; and that the publication of the defendant's song was a palpable attempt to induce the public to believe that the song so published was the same as that of the first publisher. In another suit (*a*), where the facts were nearly similar, and the title 'Minnie, dear Minnie,' it was held to be an obvious attempt to pass off the defendant's publication for that of the plaintiff which had obtained the public favour. Neither could the defendant escape his liability by cautioning his shopmen to explain to purchasers that his song was not the same as the plaintiff's; because he could not secure that retail dealers purchasing from him would give the same information to their customers (*b*). But the court refused to extend the injunction to restrain the piracy of two bars of music which had been added by the plaintiff to the original air, until the fact had been established by a trial at law. The principle here expressed appears to be that where a great resemblance exists between a spurious article and the genuine, although the articles may not be exactly alike, yet if there be that which conveys the idea that the article is genuine, whereby the public is deceived, it is a colourable representation of the original, and a piracy of the author's copyright.

As each of two or more independent dramas from a common original is entitled to protection, one is not piracy of another, unless there has been unlawful copying.

The 3 & 4 Will. 4, c. 15, secures no other right and prohibits no other act than that of representation. The right secured by this statute is re-affirmed, its duration enlarged, and its application extended to musical compositions by the 20th section of the Act of 1842; but the

Remedy in cases of infringement.

(*a*) 2 K. & J. 123.

(*b*) See *Sykes v. Sykes*, 3 B. & C. 441.

remedies prescribed by the latter statute for the unlawful publication of a book do not apply, and are not extended to the unlicensed representation of a play. For the latter wrong, the penalties given by the statute of William are re-enacted by the 21st section of the 5 & 6 Vict. c. 45. This section gives to the proprietors of the right of dramatic or musical representation or performance, during the term of their interest, all the remedies provided by the 3 & 4 Will. 4, c. 15. By the second section of this latter Act it is enacted, that if any person, during the continuance of the exclusive right of representing a dramatic piece, cause to be represented, without the author's or the proprietor's previous written consent, such production at any place of dramatic entertainment within the British dominions, every such offender shall, for each representation, be liable to the payment of not less than 40s., or of the full amount of the advantage arising from the representation, or of the loss sustained by the plaintiff, whichever shall be the greater damages. These penalties are recoverable together with double cost of suit (a) by the author or proprietor in any court having jurisdiction in such cases in that part of the British dominions where the offence is committed (b).

The 40s., though styled a penalty in the margin of the Act, is not one strictly speaking. It was held in *Adams v. Batley* and *Cole v. Francis* (c) that the section does not impose a penalty upon the offender so as to preclude the plaintiff in an action to recover the specified amount, from administering interrogatories to the defendant. "The word 'offender,'" said Mr. Justice Day, "is only used as a convenient expression, and is in no way meant to designate a criminal. I am of opinion that this sum of 40s. is not a penalty." The decision was affirmed on

(a) See *Reeve v. Gibson*, 7 T. L. R. 285 ; [1891] 1 Q. B. 652.

(b) See *Beere v. Ellis*, 5 T. L. R. 330.

(c) 18 Q. B. D. 625, and compare the case of *Saunders v. Wicl* [1892], 2 Q. B. 18 (a design case), an action brought for penalties under sec. 58 of the Patents, &c., Act, 1883, in which *Adams v. Batley* was approved and distinguished.

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appeal, when Lord Esher, M.R., said, "I see no characteristic of a penalty in this payment. I am of opinion that this case is not brought within any rule of law which prevents interrogatories from being administered to the defendant."

Where material part taken actual damage need not be proved.

When the part taken is material, the plaintiff is not bound to prove actual damage (a). "The positive enactment," said Tindal, C.J., in the last cited case, "that every offender shall be liable to an amount not less than 40s., or to the full amount of the benefit derived or loss sustained, shews that damage to the plaintiff is not the test of the defendant's liability, but that 40s. is to be paid, even if there be no actual damage." In a later case (b), however, Lord Hatherley seems to have thought it necessary to prove damage in order to subject the defendant to the statutory penalty. "The minimum of damages," said he, "to be awarded when the fact of damage and the right to damages have been once established, was no doubt fixed because of the difficulty of proving with definiteness what amount of actual damage had been sustained, by perhaps a single performance at a provincial theatre of a work belonging to a plaintiff, whilst at the same time his work might be seriously depreciated if he did not establish his right as against all those who infringed upon it." Double costs of suit is given as the sum recoverable is so small that unless there were special provisions the costs of suing for the sum of 40s. would be greater than the sum recovered. And by a later statute (c) provision is made that the plaintiff shall recover a full and reasonable indemnity, which would give such costs as fully to indemnify the plaintiff for any expense incurred in suing, much more than on taxation of costs as "between party and party," and more even than on taxation as "between solicitor and client"—at all events as much. Later County Court

Costs.

(a) *Planché v. Braham*, 4 Bing. N. C. 19; and see *Chatterton v. Cave*, 3 App. Cas. 498.

(b) *Chatterton v. Cave*, 3 App. Cas. 492.

(c) 5 & 6 Vict. c. 97, s. 2. See *Avery v. Wood* [1891], 3 Ch. 115.

statutes have taken away the right to costs in actions which might be brought in those courts in actions founded on tort where not more than £10 is recovered as in actions founded on contract under £20. The question recently arose whether these later Acts have taken away the right to the full and sufficient indemnity under the earlier Acts where less than £10 is recovered. It arose under these circumstances. The plaintiff claimed penalties from the defendant of six separate penalties of 40s. each under the Act for his having represented on six separate occasions a dramatic piece entitled 'The Arca Belle,' without the previous consent in writing of the plaintiff as the sole owner of the play; and the plaintiff claimed £12 as the amount of these penalties. The defendant admitted only four performances, and paid into court the sum of £8 as the amount of four penalties, which the plaintiff accepted and took out of court in full satisfaction, and so the action came to an end. Then, however, arose the question of costs, which turned out to be, in the opinion of the judges, a question of considerable difficulty. The plaintiff claimed such costs as would be a "full and reasonable" indemnity to him for all the expense of suing. It was argued for the defendant that under the Rules of the Supreme Court, especially Order LXV., and the County Court Act, 1888, the costs claimed were not recoverable as the action might have been brought in the County Court, and it was "an action founded on tort," in which less than £10 had been recovered. The Court, however, came to the conclusion that neither the County Court Acts nor the rules as to costs applied to deprive the plaintiff of his right under the earlier Acts to a "full and reasonable indemnity" in such an action as the one then before them. The ground Mr. Justice Wills took was that the costs given by the Act were of a special statutory character, whereas the rules and orders applied only to ordinary costs. The position taken by the other judge, Mr. Justice Williams, was somewhat different. He considered that the costs given by the statute were costs in

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the ordinary sense, and that the only effect of the statute was to give the Master power to allow costs on a more liberal scale than ordinary. Therefore he did not think that on that ground the rules and the County Court Acts had no application (a). The Court of Appeal affirmed this judgment, holding that the case was directly governed by *Husker v. Wood* (b), which decided that the Rules of the Supreme Court did not overrule the provisions of special statutes giving special costs in particular cases. The Act 5 & 6 Vict. c. 97, s. 2, does not apply where an action for alleged infringement of copyright is dismissed with "full costs," according to 5 & 6 Vict. c. 45, s. 26, and in such case the costs are to be taxed in the ordinary way between party and party (c).

The Copy-
right Com-
missioners'
suggestions.

The Royal Commissioners in their report in 1878 on Copyright say (d) :—“This provision for the 40s. penalty has lately been much abused. Copyright in favourite songs from operas and in other works has been bought, and powers of attorney have been obtained to act apparently for the owners of the copyright in such works, and to claim immediate payment of £2 for the performance of each song. These songs are frequently selected by ladies and others for singing at penny readings and village or charitable entertainments, and they sing them, not for their own gain, but for benevolent objects. In such cases there is manifestly no intention to infringe the rights of any person; the performers are unconscious that they are infringing such rights, and no injury whatever can be inflicted on the proprietors of the copyrights. In many cases of this kind, and under a threat of legal proceedings, in default of payment, the penalty has been demanded, and we have reason to believe that the money so demanded has been generally paid. Many instances of this proceeding have been brought to our notice from various parts of the country. . . . The amendment in the law

(a) *Reeve v. Gibson*, 7 T. L. R. 285; [1891] 1 Q. B. 652.

(b) 47 L. J. (Q. B.) 419.

(c) *Acery v. Wood* [1891], 3 Ch. 115.

(d) Pars. 169, 171, 172.

which we propose as most likely to preserve control for the composers, and at the same time to check the existing abuse, is that every musical composition should bear on its title-page a note stating whether the right of public performance is reserved, and the name and address of the person to whom application for permission to perform is to be made. The owner of such composition should only be entitled to recover damages for public performance when such a statement has been made; and instead of the minimum penalty of not less than 40s. at present recoverable for any infringement of musical copyright by representation, the court should have power to award compensation according to the damage sustained."

It did not seem to them that the abuse above referred to had arisen in the case of dramatic copyright, nor did it seem to them likely to arise so long as the present law of licensing places of dramatic performance exists, and therefore they did not suggest any alteration in the law so far as it applies to that copyright.

The alteration suggested by the copyright commissioners has since been carried into effect by the 45 & 46 Vict. c. 40, the Copyright (Musical Compositions) Act, 1882, the 4th section of which gave a discretion to the court, as to costs where the plaintiff did not recover more than forty shillings as penalty or damages. This Act had the effect of giving a check to the vexatious proceedings referred to by the Commissioners, and a final stop was put to them by the 51 & 52 Vict. c. 17, which repeals the 4th section of the Copyright (Musical Compositions) Act, 1882, and provides that notwithstanding the provisions of the Dramatic Copyright Act (a) or any other Act in which those provisions are incorporated, the penalty or damages to be awarded in respect of each and every unauthorized representation or performance of any musical composition, whether published before or after the passing of the Act, shall be such a sum as

The Copyright
(Musical
Compositions)
Act, 1882.

(a) 3 & 4 Will. IV. c. 15.

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shall in the discretion of the court or judge, before whom such action or proceedings shall be tried, be reasonable, and the court or judge may award a less sum than 40s., in respect of each and every such unauthorized representation or performance, or a nominal penalty or nominal damages as the justice of the case may require (a). By the 2nd section, the costs of all such actions or proceedings as aforesaid, are to be in the absolute discretion of the judge before whom such actions or proceedings may be tried.

It must be remembered, however, that musical compositions only are provided for, and that there is no discretion in the court as to the damages and costs (b) for the unauthorized performances of dramatic compositions which are still governed by the Act of William IV.

Actions to be brought within twelve months.

The third section of the 3 & 4 Will. 4, c. 15, provides that all proceedings for any offence or injury under that Act shall be brought within twelve months from committing of the offence, or else the same shall be void and of no effect. This limitation seems to apply only to proceedings for penalties under the Act and not to actions for damages or in equity.

Not necessary to show defendant knowingly invaded plaintiff's right.

It is sufficient in an action upon this statute to describe the offence in the words of the Act; and it is not necessary, in order to constitute the offence, to shew that the defendant knowingly invaded the plaintiff's right (c). The object of the legislature was to protect authors against the piratical invasion of their rights, and in construing the law the Judges have given it the fullest interpretation. Therefore in an action of debt to recover penalties under the 3 & 4 Will. 4, c. 15, s. 2, for representing a pantomime, of which the plaintiff was the author, without his license, at a place of dramatic enter-

(a) S. 1.

(b) *Roberts v. Bignell, Asher and Robertson*, 3 T. L. R. 552, where the case is reported as an action for penalties under "5 & 6 Vict. c. 45, s. 11," which must be a mistake for 3 & 4 Will. 4, c. 15, s. 2.

(c) *Lee v. Simpson*, 4 D. & L. 666; 3 C. B. 871; *Reade v. Lacy*, 1 J. & H. 524.

tainment, upon *nil debet* by statute pleaded, it was held that the plaintiff's undertaking to give material evidence in Middlesex was fulfilled by proof of an offer to sell the pantomime in Middlesex by the plaintiff's agent, acting under his direction (a).

Where the plaintiff, as the author of a dramatic work, assigned the "London right" of it to A., the judge at the trial having found that "London right" meant the whole right of representation in London, and that the assignment was to A. and his assigns, it was held that the plaintiff could not bring an action for penalties under the 3 & 4 Will. 4, c. 15, in respect of representations in London, except as trustee for A. and his assigns (b).

(a) *Lee v. Simpson*, 4 D. & L. 666 ; 3 C. B. 871.

(b) *Taylor v. Neville*, 47 L. J. Q. B. 254 ; 26 W. R. 299 ; 38 L. T. 50.

CHAPTER XII.

COPYRIGHT IN ENGRAVINGS, PRINTS, AND LITHOGRAPHS.

Nature and
origin of the
right.

STRANGE yet true it is, that an art of so much importance—one which has exercised such an influence on the refinement of the people, and tended so apparently, yet indirectly, to the formation of the polished character of civilized Europe—should have remained for years without any protection whatever from the legislature.

In England, protection was not afforded to the artist until that great engraver and designer, Hogarth, arose like a giant from the most elevated of his associates in the art, and with the aid of his keen and penetrating intellect discovered, that, toil and labour how much soever he might, the product of his intellectual genius was by no means regarded as solely his, nor he deemed to have acquired a more permanent property in it, than the purchaser or imitator of one of his numerous works of art.

Engravings resemble literary works as regards the incorporeal right in them accruing to the author by the exertion of his mental powers in their production; but differ, as they also require a considerable amount of his manual skill and labour; they are, therefore, his property upon the same general principles as any other manufacture.

In handling the present state of the law on this branch of the fine arts we may properly investigate, under one view, the various Acts of Parliament which are particularly appurtenant to the collective arts of designing, engraving, and etching, inasmuch as they, unlike those

respecting literary copyright, have not yet been consolidated.

Engravings are works having a commercial value, and as such have a double claim upon the protection of the legislature. On the one hand, the artist claims that the productions of his genius may be protected, and injury to his fame and reputation, by the circulation of inferior imitations, prevented or guarded against; and on the other hand, security in the possession of the money value of the creation of his own mind.

During the reign of the Stuarts the fine arts received more or less patronage, and engraving and other productive arts began to flourish accordingly. George I. knighted the engraver of the cartoons. Line engraving, however, had been most cultivated, and the amount of skill required to imitate a plate must have nearly equalled that of its first production; every stroke of the graver would have to be repeated, so that the pirate could hardly undersell the original; and from the costliness of this style and its refinement few could afford to purchase, and perhaps, fewer could appreciate. As so much talent had to be spent by the engraver in transferring the forms to a new medium, from the canvas to the copper-plate, the value of the right of engraving to the owner of the picture was small; and the picture itself, whether a portrait or work of imagination, was executed solely as an individual work of art. Gradually, however, it became the practice to publish small prints, not for the profit on them, but to assist in spreading the reputation of the painter, and this was done in the case of portraits of public men. Of course the name of the artist was not omitted; it was attached to the corner, to secure, not, as now, the property in the print, but the fame of the picture. The diffusion of some new mechanic or chemic arts of engraving or etching facilitated this (a).

Fine arts
encouraged by
the Stuarts.

The first Act recognising engraving as an art, and The first

(a) Turner on 'Copyright in Designs,' p. 13.

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Copyright
Engraving
Act.

extending towards its professors the protection they so unquestionably deserved, was that of the 8 Geo. 2, c. 13, entitled "An Act for the Encouragement of the Arts of designing, engraving, and etching historical and other Prints, by vesting the Properties thereof in the Inventors and Engravers during the time therein mentioned" (a). After reciting that "divers persons had, by their genius, industry, pains, and expense, invented and engraved, or worked, in mezzotinto or chiaro-oscuro, sets of historical and other prints, in hopes to have reaped the sole benefit of their labours, and that printsellers and other persons had of late, without the consent of the inventors, designers, or proprietors of such prints, frequently taken the liberty of copying, engraving, and publishing, or causing to be copied, engraved, and published, base (b) copies of such works, designs, and prints, to the very great prejudice and detriment of the inventors, designers, and proprietors thereof," it enacted, that from and after the 24th of June, 1735, every person who should invent and design, engrave, etch, or work in mezzotinto or chiaro-oscuro any historical or other print or prints, should have the sole right and liberty of printing and representing the same for the term of fourteen years, to commence from the day of the first publishing thereof, which should be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints. And the Act inflicted on other persons pirating the same "without the consent of the proprietor thereof first had and obtained in writing," the penalty of forfeiting the plate, the sheets on which the prints were copied, together with 5s. for every print so pirated, the one moiety to the king, and the other to any person who should sue for the same. And it further provided, that it should be lawful for any person who should thereafter purchase any plate for printing from the original proprietor,

(a) This Act by the International Copyright Act, 1886, may be cited as "The Engraving Copyright Act, 1734."

(b) See *Graves v. Ashford*, L. R. 2 C. P. 419.

to print and reprint from the said plates without incurring any penalty.

Under this Act Lord Hardwicke refused relief to a person complaining of the piracy of a drawing or design which he had only procured to be made; "for," said he, "the case was not within the statute, which was made for the encouragement of genius and art; if it was, any person who employs a printer or engraver would be so too. The statute is, in this respect, like the statute of new inventions, from which it is taken" (a).

In *Blackwell v. Harper* (b) it was held that this Act was not confined to works of invention only, but included the designing or engraving anything already in nature, and that a print published of any building, house or garden fell within its scope.

No provision, it will be seen, is in this Act made for the protection of any work of which the engraver is not also the designer; and this has been accounted for by the fact that Hogarth, by whose influence the Act was introduced, was invariably the designer as well as the engraver of his celebrated works.

The 7 Geo. 3, c. 38, was made to remedy this oversight, and protection consequently extended to any person making an engraving from the original work of another. Its title is, "An Act to amend and render more effectual an Act made in the 8 Geo. 2, for Encouragement of the Arts of designing, engraving, and etching historical and other Prints, and for vesting in and securing to Jane Hogarth, widow, the Property in certain Prints" (c). The first section recites that the former Act had been found ineffectual for the purposes thereby intended, and enacts that all and every person and persons who shall invent or design, engrave, etch, or work in mezzotinto or chiaro-oscuro, any historical print or prints, or any other print or prints of

The second Act.

(a) *Jefferys v. Baldwin*, Ambl. 164; see *Pierpont v. Fowle*, 2 Wood. & Min. (Amer.) 46; *Binns v. Woodruff*, 4 Wash. (Amer.) 53.

(b) 2 Atk. 93.

(c) This Act may by the International Copyright Act, 1886, be cited as "The Engraving Copyright Act, 1766."

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any portrait, conversation, landscape, or architecture, map, chart, or plan, or any other print or prints whatsoever, shall have the benefit and protection of the said Act and this Act, under the restrictions and limitation thereafter mentioned. The second section enacts that all and every person and persons who shall engrave, etch, or work in mezzotinto or chiaro-oscuro, or cause to be engraved, etched, or worked, any print taken from any picture, drawing, model, or sculpture, either ancient or modern, shall have the benefit and protection of the said Act and this Act for the term thereafter mentioned (twenty-eight years), in like manner as if such print had been graven or drawn from the original design of such graver, etcher, or draftsman; and, if any person shall engrave, print, and publish, or import for sale, any copy of any such print, contrary to the true intent and meaning of this Act and the said former Act, every such person shall be liable to the penalties contained in the said Act, to be recovered as in the said Acts mentioned (a).

The third
Act.

By the next statute of 17 Geo. 3, c. 57 (b), it was enacted, that if any person should within the times limited by the aforesaid Acts or either of them, engrave, etch, or work, or cause, or procure to be engraved, etched, or worked in mezzotinto, or chiaro-oscuro or otherwise, or in any other manner copy in the whole or in part, by varying, adding to, or diminishing from the main design, any copy or copies of any historical print or prints, or any print or prints of any portrait, conversation, landscape, or architecture, map, chart, or plan, or any other print or prints whatsoever, which had been or should be engraved, etched, drawn, or designed in any part of Great Britain, without the express consent of the proprietor or proprietors thereof, the proprietor should, by a special action on the case, recover damages against the person so offending.

(a) For the defective working of this Act, see Mr. Corrie's remarks in *Reg. v. Powell*, the 'Times,' November 10, 1862.

(b) This Act may by the International Copyright Act, 1886, be cited as "The Prints Copyright Act, 1777."

The inventor of the subject of an artistic design, although himself unable to draw, may nevertheless have a copyright in the design in question, if he has employed another person to make the drawings for him, and communicated his ideas to that person (a). But the design must be the production of the party claiming the copyright, and difficulties may occasionally arise as to what constitutes a design within the meaning of the statute. "If," says Mr. Curtis (b), "the party personally engraves the subject of his conceptions, then he is both the inventor and designer; since he has not only conceived the subject of the picture, but has represented it in a visible form. But if the engraving is made by another under his direction, it must be made from his 'design'; and the question is, whether this term means only the intellectual conception, or work of the imagination, before it is reduced to some visible form, or whether it implies a drawing, or other visible representation of the invention, by the hand of its author. Under the American Act of 29 April, 1802, ch. 36, which contained a similar provision, it was held by Mr. Justice Washington, that the party must not only have invented but he must have designed or represented the subject in some visible form, from which the engraver who executes it must have taken the picture (c). The term 'design,' therefore, means the visible form given to the conception of the mind, and must be done by the inventor himself."

In the case of *Stannard v. Harrison* (a) an engraver was examined. He proved that the plaintiff had brought to him his rough sketch or draft, a drawing of the same size as the stone upon which it was to be engraved, pointing out a rough sketch of the forts and towns to give the en-

(a) *Stannard v. Harrison*, 19 W. R. 811; 24 L. T. (N.S.) 570; see *Kenrick v. Lawrence & Co.*, 25 Q. B. D. 99; 38 W. R. 779.

(b) Copy. 145.

(c) *Binns v. Woodruff*, 4 Washington Rep. (Amer.) 48. The Act of 1802 was in these words: "Any person being a citizen of the United States, or a resident within the same, who shall invent and design, engrave, etch, or work, or from his own works and inventions shall cause to be designed and engraved, etched, or worked, any historical or other print, shall have the sole right," &c. *Ib.*

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graver an idea; he furnished him also with a large French map, and some maps published in the 'Times' and 'Daily Telegraph;' he also gave him notice daily of the earthworks that were made, and produced besides a picture published in the 'Illustrated London News.' The plaintiff could not draw himself—and the Vice-Chancellor said: "That the plaintiff cannot draw himself is a matter wholly unimportant if he has caused other persons to draw for him. He invents the subject of the design beyond all question. He prescribes the proportions and the contents of the design; he furnishes a part of the materials from which the drawing has to be made in the first instance, and afterwards collects daily from the proper sources, and even, if it be necessary to say so, from official sources, the decrees, the reports, the bulletins, and accounts contained in the newspapers of the different phases of the war, and especially of the places in which earthworks are thrown up. These he communicates to the man whom he has employed to make a drawing for him. . . . Can there be anything more plainly within the words of the Act of Parliament than that Mr. Stannard did himself invent, that he did procure another person to design and draw for him, and do that which he himself could not do?"

Provisions
of Acts to
be strictly
complied
with.

In order to vest the copyright of an engraving in the designer or engraver of the same, no registration, such as is necessary in the case of literary copyright, is required; the Acts above enumerated have merely to be strictly complied with. In the first place, it is therefore important that engravings should contain the date of publication and name of the proprietor, in order to entitle the party to the penalties imposed by the statute Geo. 2. The reason assigned by the Court in *Sayer v. Dickey* (a) being, "that any person may know when the proprietor's exclusive right ceases, and when, and against whom, he may be guilty of offending contrary to the statute." Lord Hardwicke, in

(a) 3 Wils. 60.

an early case, doubted whether the clause on this subject in the Act ought to be construed as directory or descriptive, but he was of opinion that the property was vested absolutely in the engraver, although the *day* of publication was not mentioned, and compared it to the clause under the statute of Anne, which requires entry at Stationers' Hall, upon the construction of which it has been determined that the property vests although the direction has not been complied with (a). However, it has subsequently been taken for granted by the Court of King's Bench that both the name and date should appear; the *date*, Lord Kenyon observed, is of importance, that the public may know the period of the monopoly; the *name* should appear, in order that those who wish to copy it may know to whom to apply for consent (b).

So in *Harrison v. Hogg* (c) Lord Alvaney differed from Lord Hardwicke, considering the insertion of the name and date essential to the plaintiff's right; that the correct date is a *sine quâ non* was expressly decided in *Bonner v. Field* (d). It was an action for pirating a print of the seal of the Countess of Talbot. The plaintiff had been employed by Lady Talbot to engrave this plate for her, which he executed on the 1st of June, 1778, when he took off some impressions for her use. On the *following day* she gave the plate to the plaintiff, who engraved on the bottom of it, "Drawn and engraved by J. Bonner; published on the 1st June, 1778, as the Act directs." The declaration having stated that the plaintiff was the pro-

As to the date.

(a) *Blackwell v. Harper*, 2 Atk. 95; Barn. Ch. Rep. 210. See *Jefferys v. Baldwin*, Amb. 164; *Roworth v. Wilkes*, 1 Camp. 94; *Harrison v. Hogg*, 2 Ves. Jun. 323; *Thompson v. Symonds*, 5 T. R. 41.

(b) *Thompson v. Symonds*, *supra*; *Mackmurdo v. Smith*, 7 T. R. 518; *Harrison v. Hogg*, *supra*.

(c) 2 Ves. Jun. 323; *Newton v. Cowie*, 4 Bing. 234; *Brooks v. Cock*, 3 Ad. & E. 138; 4 N. & M. 652; *Colnaghi v. Ward*, 12 L. J. (N.S.) (Q.B.) 1; 6 Jur. 969; *Boque v. Houlston*, 5 De G. & Sm. 267; *Graves v. Ashford*, 15 W. R. 495; L. R. 2 C. P. 410; Kerr on Injunc. 465; *Rock v. Lazarus*, L. R. 15 Eq. 104; 27 L. T. (N.S.) 744. So the proprietor of a foreign print must print his name and the date of publication on the plate as required by 8 Geo. 2, c. 13, in order to claim copyright under the International Copyright Acts: *Avonzo v. Mudie*, 10 Exch. 203.

(d) Cited 5 T. R. 44.

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prietor on the 1st of June, Lord Mansfield nonsuited the plaintiff on the ground that he had no title on the day when he claimed it.

The cases were fully reviewed and commented on in the leading case on the subject of *Newton v. Cowie* (a), and it was held that the proprietor's name and the date of publication must appear on the original print, but that it was not necessary that the designation "proprietor" should be added to the name; and that the words on the print "*Newton del., 1st May, 1826, Gladwin sculp.,*" was a sufficient compliance with the provisions of the 8 Geo. 2, c. 13. Best, C.J., on the occasion saying: "Looking at the subject-matter of the law, at the language employed by the legislature, and the practice which has uniformly been followed by engravers, we cannot hesitate to determine that the proprietors of these prints are entitled to the protection which is afforded by the statutes; a decision we have come to with satisfaction, seeing that they exercise a branch of art eminently useful and which in no slight degree *emollit mores nec sinit esse feros*. They contribute also by the same means to the circulation of a knowledge of mechanics so necessary to our manufactures, and so useful to the best interests of the country."

Engravings
or etchings
when pub-
lished with
letter-press.

These essentials, in order to secure to the artist the copyright in engravings or etchings when published separately, are not requisite where the engravings form part of a book in which there is copyright; for the Copyright Act, 1842, gives a copyright in "every volume, part or division of a volume, pamphlet, sheet of letter-press, sheet of music, manuscript, map, plan, or chart, separately published," and this definition, though it would not, of course, extend to prints or designs separately published, yet is sufficiently comprehensive to include prints and designs forming part of a book. The book is not less a book because it contains prints or designs, or other illustrations

(a) 4 Bing. 234.

of the letter-press. A book must include every part of the book ; it must include every print, design, or engraving which forms part of the book, as well as the letter-press therein, which is another part of it. A plaintiff published a book containing letter-press, illustrated by wood engravings, printed on the same paper at the same time. The defendants published a similar book with different letter-press, but containing pirated copies of the wood engravings. The plaintiff, upon motion for an injunction, proved that he had complied with the requisitions of the Copyright Act, 1842, but had not complied with the Act for the protection of engravings (8 Geo. 2, c. 13), by printing the date of publication and the name of the proprietor on each copy. Vice-Chancellor Parker considered the plaintiff entitled to an injunction, for upon the construction of the 5 & 6 Vict. c. 45, where there are designs forming part of a book in which a person has copyright, such copyright extends to the illustrations and designs of the book, equally as to the letter-press (a).

In regard to copyright in maps, there are two concurrent Acts relating to the same thing, the Literary Copyright Act, 1842 (5 & 6 Vict. c. 45), and the series of Acts, viz.: 8 Geo. 2, c. 13 ; 7 Geo. 3, c. 38 ; and 17 Geo. 3, c. 57. Maps.

Maps published together or in connection with letter-press, obviously come within the head "book," and as such are included in the former Act.

Maps, charts, or plans, separately published, are within the above Engraving Acts, as also within the 3rd section of the Literary Copyright Act. Viewed in the light of literary efforts they are entitled to copyright under the latter Act during the life of the author, and for seven years after his death, or for the term of forty-two years, as the case may be. Regarded as artistic works under the former statutes they are entitled to protection for an absolute term of twenty-eight years. Yet no action or suit in respect

(a) *Bogue v. Houlston*, 5 De G. & Sm. 267 ; *Woods v. Highley*, 1866, before Vice-Chancellor Wood.

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of an infringement of such copyright can be maintained under the 5 & 6 Vict. c. 45, until the author shall have previously registered in the manner prescribed by section 13 of the Act (*a*); nor under the Acts of Geo. 2 and Geo. 3, unless the proprietor shall have printed his name and the day of publication on every copy (*b*).

This appears to be the law on the subject, notwithstanding the impression receivable from the unguarded decision in *Stannard v. Lee*; and the inference from that case to be drawn would seem to be that if the proprietor wishes to sue in respect of an infringement without having registered, he must allege that it is an engraving, or otherwise bring it within the Acts of Geo. 2 and Geo. 3, which do not require registration, for in the event of his alleging he has printed and published "a map," the plea that the map has not been registered will meet the case; and this under the rule that every allegation is to be taken most strongly against the pleader, and therefore the defendant is entitled to say that the thing which the plaintiff alleged to be a map, was a map within 5 & 6 Vict. c. 45, and consequently required to be registered (*c*).

In *Stannard v. Lee* (*d*), where the plaintiffs printed and published on the 21st of July, 1870, a map described as 'No. 1, Stannard & Son's Panoramic Bird's-eye View of France and Prussia, and the surrounding countries likely to be involved in the war, with the railways and strategic positions of each army, and the great fortresses of the Rhine provinces,' and filed affidavits alleging in substance that they had formed a design of publishing maps illustrating the seat of war, and had "designed a map," and on the date above mentioned had "in accordance with the Acts of Parliament in that behalf," printed and published the said map by the above description, and that they were proprietors of the map; it was held, that notwithstanding

(*a*) *Stannard v. Lee*, 19 W. R. 615; L. R. 6 Ch. 346.

(*b*) *Bogue v. Houlston*, 5 De Gex & Sm. 267.

(*c*) See *Stannard v. Harrison*, 19 W. R. 811.

(*d*) 23 L. T. (N.S.) 306.

that on the map itself it appeared that Messrs. Packer and Griffin were the delineators and lithographers of the map, there was a sufficient proof under the requirements of the Acts of the plaintiffs' proprietorship, and a motion to dismiss an *ex parte* injunction obtained against the defendant to restrain the infringement of the copyright claimed by the plaintiffs, on the ground, first, that the plaintiffs were not registered as proprietors under the Act of 5 & 6 Vict. c. 45; and, secondly, that it had not appeared on the map that they were the proprietors of the copyright, was refused. "The Acts of Geo. 2 and Geo. 3," said Vice-Chancellor Bacon, "are not mentioned in the Act of 5 & 6 Vict. c. 45, and I do not construe that Act as interfering in any way with the previous Acts, and 15 Vict. c. 12, and the rights conferred thereby." The Lords Justices, however (a), were of opinion that the earlier Acts are virtually repealed by the 5 & 6 Vict. c. 45, and that registration is, therefore, a necessary preliminary to a suit for an infringement of copyright in the case of a map separately published. Lord Justice James said: "In this case, if the argument of Mr. Cotton were to prevail, it would lead at once to one of these two results; either there would be two kinds of maps,—maps published separately and maps forming part of a book, with respect to which there would be two distinct laws of copyright,—or else as to all maps there would be two distinct laws of copyright, one giving a conditional right of property with an unconditional right of action or suit, the other giving an unconditional right of property with a conditional right of action or suit. Either of these states of the law would be strangely inconvenient.

"Thus 5 & 6 Vict. c. 45, s. 2, says that a book shall mean and include every map, chart, or plan separately published; and in the 24th section it proceeds to say that no proprietor of copyright in any book, that is of a map, chart, or plan separately published, according to the defini-

(a) *Stannard v. Lee*, 19 W. R. 615; L. R. 6 Ch. 346.

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tion given of a book, shall maintain an action or suit in respect of any infringement of such copyright unless he shall have previously registered such map, chart, or plan, in the way prescribed by the Act—no very heavy *onus* on the proprietor—no very difficult step to take before he commences his suit. The words are plain and simple, and there is no reason for saying that the intention of the legislature was different from that which is expressed by the words. The object of the enactment is very clear. Formerly maps have been considered artistic works: now they were to be brought into their proper place as literary works. And rightly so, in my opinion, for maps are intended to give information in the same way as a book does. A chart, for instance, gives similar information to sailing rules; maps give instruction as to statistics and history of the country portrayed; they point out the amount of population, the places where battles were fought, the dates when provinces were annexed, as in maps of India, and give other geographical and historical details. It was quite reasonable, therefore, to take them out of the law of artistic works, and to give them greater protection by bringing them under the law of copyright of literary works. There is no inconvenience in giving the natural meaning to the words of the statute, and there would be great inconvenience in the contrary construction. I think, therefore, the plea was well pleaded, and the plaintiffs are not entitled to maintain their suit until they have registered their maps.”

Vice-Chancellor Bacon, however, evidently adhered to his original decision, or rather to the exposition of the law there given, and in the case of *Stannard v. Harrison* (a), which was decided after the Lords Justices had reversed his decision in *Stannard v. Lee*, he explained that they held the map in question not to be protected “because the plaintiff had alleged in his bill that he had invented a design,” and published a “map,” and the defendants

(a) 19 W. R. 811 ; 24 L. T. (N.S.) 570.

there pleaded, relying on the large interpretation of the word "book" in the last Act, that the statute prohibited the institution of any suit before registration had been performed. But in the case then before him the facts were different. The plaintiffs carried on the business of lithographers and publishers, and had acquired a reputation as publishers of maps and lithographic views in the nature of maps during the American War, giving bird's-eye views in apparent relief of the seat of war. During the war between France and Germany the plaintiffs published a series of bird's-eye views or plans illustrating the seat of war, of which they sold a great number of copies. On the 1st of September, 1870, the plaintiffs published a bird's-eye view of Paris and its fortifications under the following description: "No. 8, Stannard & Son's Perspective View of Paris and its Environs, shewing all the fortifications and redoubts, together with the lines of defence recently thrown up, and the roads, rivers, and railways communicating with the interior, compiled from the latest official sources by Alfred Concanen." The plaintiffs alleged that this view was duly designed, or caused to be designed and lithographed, and was duly printed and published by them in accordance with the provisions of the several Acts of Parliament made in that behalf, and that the lithographed copies of this view were prints within the meaning of these Acts. The defendants were the proprietors of a weekly periodical called the 'Gentleman's Journal and Youth's Miscellany,' and with the number of that journal of the 1st of November, 1870, they published a bird's-eye view of Paris and its fortifications, which the plaintiffs alleged was an imitation of their view and an infringement of their copyright. The plaintiffs accordingly filed their bill, and on the 19th of November, 1870, a decree was made by consent, by which a perpetual injunction was granted restraining the defendants from printing, publishing, or selling these views, directing an inquiry as to damages, and ordering the defendants to pay the plaintiffs' costs.

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The defendants petitioned for a rehearing of the suit, or for leave to file a bill of review on the grounds, amongst others, that the plaintiffs had not registered their alleged proprietorship of copyright in the bird's-eye view in question at Stationers' Hall, pursuant to the 5 & 6 Vict. c. 45, s. 13; that the facts in the case were substantially the same as those in *Stannard v. Lee*; that on the authority of that decision, as the plaintiffs had not before the commencement of the suit registered their alleged proprietorship of the copyright, they were debarred by the 5 & 6 Vict. c. 45, from maintaining the suit, and that that statute precluded the Vice-Chancellor from making the decree, even with consent.

Bacon, V.C., dismissed the petition, refusing to re-open the question, and in the course of his judgment said:—
 “The case was formerly argued before me upon these different statutes (the statutes of Geo. 2 and Geo. 3), and Mr. Fooks in his argument insisted that the 5 & 6 Vict. c. 45, containing that prohibition against commencing any action or suit until registration had taken place, and there being no evidence that that registration had been made, he was entitled to use that as an objection to the continuation of the injunction which had been granted. I considered the point at the time. I have considered it since, and more especially have I considered the judgment of the Lords Justices, and I am of opinion that that statute has nothing in the world to do with it. That there is no prohibition in the first two statutes I have mentioned is unquestionable; and although in the case of *Stannard v. Lee* before the Lords Justices it was held that the design there was not protected for want of registration, that was because the plaintiff had alleged in his bill that he had invented a design and published a map, and the defendant there pleads, relying on the large interpretation of the word ‘book’ in the last Act, that the statute prohibited the institution of any suit before registration had been performed. Both the Lords Justices were of that opinion, but the Lords Justices have

said nothing in any part of their judgment about the other two statutes except this : The plaintiff's counsel, desiring to save himself by reference to the earlier statutes, they said ' You cannot do that now you are here ; the plea has been filed to your bill, and the plea meets everything that you allege in your bill ; the plea must either be allowed or overruled.' The statutes were the thing relied upon. Every word of the Lords Justices' judgment proceeds upon that ground, and they never considered anything but that. The judgment of Mellish, L.J., puts that in the plainest light. He, as it were, congratulates them on having, by a mere trick, or accident, the good fortune of placing a technical difficulty in the plaintiff's way so as to get the plea allowed ; but there is not a word about any meritorious elements in the case on the part of the defendant ; there is not any doubt expressed that the plaintiff's claim in morals and in truth was a perfectly good and just claim. That this was so is seen in another part of the judgment, where the Lord Justice, answering Mr. Cotton, who desired to amend his bill so as to raise that question as to its being an historical engraving, says : ' You ought to file a new bill ; you have yourself put it in the category of maps.' Nothing could be further from my wish and desire, as nothing could be more opposed to the proper discharge of my duty, than to call in question, or to express any doubt, of the correctness of the judgment of the Lords Justices, or to decline to follow it. I am bound by whatever judgment they pronounce.

“ Upon the question of the prohibition contained in the statute, I can see no application to this case, because there is no prohibition in the two statutes upon which alone the plaintiffs can reply. An argument was addressed to me upon the Shipping Acts ; it is not necessary to pause long upon that in order to see that there is no kind of resemblance between the two things. It is for the public benefit, for the actual defence of the realm among other things, that certain restrictions should be placed upon dealings in ships, and therefore the legislature has thought

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fit to lay down certain conditions with respect to which there can be no doubt, and without which having been fulfilled there is no validity in any contract entered into. The court is bound to take notice of all those things there stated which are applicable to the matter. But there are many other statutes; there are statutes, for example, which require notice to be given before an action shall be brought against a magistrate. There has been a very notorious statute in force for a long time, I mean the Statute of Frauds, but unless the objection is raised, the court never pays any attention to it. The court does not attend to the Statute of Frauds unless it is pleaded in some way or other. That is a prohibition of the same kind and degree as that which is contained in the Act of the 5 & 6 Vict. c. 45, and that is done in order that every man who is dealing with this kind of property, who is the owner of it, should have a place to resort to, to satisfy any inquiries that he may choose to make. There is nothing to induce us to call it a prohibition beyond what the necessities of the case require. The new matter which has been discovered consists of the judgment of the Lords Justices, and of facts which have been extracted from Mr. Concanen in his examination, which I do not think maintain the defendant's contention in the slightest degree. All those things now before the court, in my opinion, furnish no reason for a rehearing of this case" (a).

Christmas
cards.

As to Christmas cards, the mode in which the copyright should be secured depends to a certain extent on their nature and general character. Some are of such a nature as that protection may be found under the Engravings Acts of Geo. 2 and Geo. 3; or the 25 & 26 Vict. c. 68, if in the nature of a painting, drawing, or photograph; others again may be registered under the Patents, Designs and Trade Marks Act, 1883 (b).

(a) *Stannard v. Harrison*, 24 L. T. (N.S.) 570.

(b) In *Hildesheimer v. Dunn*, 64 L. T. 452, a Christmas card was held rightly registered under both the Act of 5 & 6 Vict. c. 45, as a "sheet of letter press," and the Act 25 & 26 Vict. c. 68, as a painting.

It matters not whether the person selling the pirated engravings is aware of their being spurious or genuine; for though the 8 Geo. 2, c. 13, imposed, first, a penalty upon any person who should engrave, copy, or sell, or cause to be copied or sold, in the whole or in part, by varying, adding to, or diminishing from the main design; and, secondly, upon persons selling the same, "*knowing the same to be so printed or reprinted*;" yet in the 17 Geo. 3, c. 57, the words "knowing the same to be printed or reprinted" are omitted; and it may, therefore, fairly be inferred that the legislature intended to comprehend even those who were not aware that they were selling base copies (a).

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Ignorance
no excuse.

The former part of the 17 Geo. 3, c. 57, s. 1, applies to persons who actually make the copy, and who therefore must know it to be a piracy. But the latter branch applies to all persons who import for sale, or sell, any copy of a piratical print.

What is an infringement is, in many cases, a difficult matter to solve. There can be no reason why a person should not be liable where he sells a copy with a mere collusive variation, for a copy is defined to be that which comes so near to the original as to give to every person seeing it the idea created by the original (b).

As to what is
an infringe-
ment.

Great solicitude is requisite to guard against two extremes equally prejudicial: the one, that men of ability, who have employed their energies for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the community may not be deprived of improvements, nor the progress of the arts retarded. The Act which secures copyright to authors, guards against the piracy of the words and sentiments, but it does not prohibit writing on the same subject. As in the case of histories and diction-

(a) *West v. Francis*, 5 Barn. & Ald. 737; 1 D. & R. 400; *Gambart v. Sumner*, 1 L. T. (N.S.) 13; 5 Hurl. & Nor. 5; *Clement v. Maddick*, 1 Giff. 98; 5 Jur. (N.S.) 592.

(b) *West v. Francis*, 5 Barn. & Ald. 737. See *Roworth v. Wilkes*, 1 Camp. 94; *Moore v. Clark*, 9 M. & W. 692.

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aries: in the first, a man may give a relation of the same facts, and in the same order of time; in the latter, an interpretation is given of the identical words. In all these cases the question of fact to come before a jury is, whether the alteration be colourable or not? There must be such a similitude as to make it probable and reasonable to suppose that one is a transcript of the other, and nothing more than a mere transcript. So in the case of prints, no doubt different men may take engravings from the same picture. There is no monopoly of the subject here any more than in the other instances, but upon any question of this nature, the jury will have to decide whether it be a servile imitation or not (a).

The first engraver does not claim the monopoly of the use of the picture from which the engraving is made; he says: Take the trouble of going to the picture yourself, but do not avail yourself of my labour, who have been to the picture and have executed an engraving (b).

An engraver has no monopoly in the subject.

Where an engraving is made of an object in nature, as of a particular flower or plant, the artist cannot restrain any one from executing a similar print of the same flower or plant; but no one is allowed to copy from the work of another person, each must draw from nature. When it was contended before Lord Hardwicke (c) that some engravings of plants could not be protected, because every herbal-book had prints of those plants in them, he observed: "The defendant, to make out the case he aims at, must shew me that these prints of medicinal plants are in any book or herbal whatsoever, in the *same manner and form* as they are represented here; for they are represented in all their several gradations, the flower, the flower-cup, the seed-vessel and the seed."

So on the same principle if two persons should *bond fide* make engravings from a perusal of the same text, although there might, and probably would be, a similarity

(a) *Sayre v. Moore*, 1 East, 361, n.

(b) *De Berenger v. Wheble*, 2 Stark. N. P. C. 548.

(c) *Blackwell v. Harper*, 2 Atk. 94; S. C. Barn. 210.

between them, yet each would acquire a copyright in the engraving which he has made.

An engraver is invariably a copyist, and if engravings from drawings were not to be deemed within the intention of the legislature these Acts would afford no protection to that most useful body of men, the engravers. The engraver, although a copyist, produces the resemblance he is desirous of obtaining by means very different from those employed by the painter or draughtsman from whom he copies: means which require great labour and talent. The engraver produces his effects by the management of light and shade, or, as the term of his art expresses it, the *chiaro-oscuro*. The due degrees of light and shade are produced by different lines and dots; he who is the engraver must decide on the choice of the different lines or dots for himself, and on his choice depends the success of his print. If he were to copy from another engraving, he might see how the person who engraved that had produced the desired effect, and so without skill or attention become a successful rival (*a*).

The engraving Acts were extended to Ireland in 1837. By the 6 & 7 Will. 4, c. 59 (*b*), it was enacted that, from and after the passing of that Act, if any engraver, etcher, printseller, or other person should, within the period limited for the protection of copyright in engravings, engrave, etch, or publish, or cause to be engraved, etched, or published, any engraving in print of any description whatsoever, either in whole or in part, which might have been or which should thereafter be published in any part of Great Britain or Ireland, without the express consent of the proprietor or proprietors thereof first had and obtained in writing signed by him, her, or them respectively with his, her, or their own hand or hands in the presence of

Engraving
Acts extended
to Ireland.

(*a*) *Newton v. Cowie*, per Best, C.J., 4 Bing. 246; *Martin v. Wright*, 6 Sim. 297.

(*b*) This Act may, by the International Copyright Act, 1886, be cited as "The Prints and Engravings Copyright Act, 1836." By the Short Titles Act, 1892, this act may be cited as "The Prints and Engravings Copyright (Ireland) Act, 1837," and by the same act the whole group of Copyright Acts may be cited by the collective title of "The Copyright Acts."

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and attested by two or more credible witnesses, then every such proprietor might, by and in a separate action upon the case, to be brought against the person so offending in any court of law in Great Britain or Ireland, recover such damages as a jury on the trial of such action, or on the execution of a writ of inquiry thereon, should give or assess.

Engravings
Acts to
include
lithographs.

The 15 & 16 Vict. c. 12, s. 14 (a), declares that the provisions of this Act and the Engraving Acts collectively are intended to include prints taken by lithography or any other mechanical process by which prints or impressions of drawings or designs are capable of being multiplied indefinitely, and the said Acts shall be construed accordingly.

The right in
engravings
may be
infringed by
photography.

It is therefore an infringement of the copyright given by the Engraving Acts to copy by photography, or sell a photographic copy of a print in which a copyright has been acquired under these Acts (b). The question arose some years ago.

It was in an action for the infringement by the defendant of the plaintiff's copyright in two engravings, the one from Rosa Bonheur's 'Horse Fair,' the other from Holman Hunt's 'Light of the World.' It was proved that the plaintiff was the proprietor of these two engravings, and that the defendant had copied them on a very reduced scale by means of photography, and sold a great number of copies. The point was argued before the Court of Common Pleas, and it was unanimously decided that all processes for the indefinite multiplication of copies, whether mechanical or otherwise, were within the Acts for the protection of artists and engravers; and that when they declare mechanical processes of multiplying copies to be within them, no doubt they would have also thus declared the multiplication by means of photography, if the art of photography had then been known. If the object of the Acts of Parliament on the subject were, not

(a) The International Copyright Act, 1852.

(b) *Gumbart v. Ball*, 14 C. B. (N.S.) 306; 9 Jur. (N.S.) 1059; 11 W. R. 699; 32 L. J. (C.P.) 166; *Gruves v. Ashford*, 15 W. R. 495; L. R. 2 C. P. 410; 16 L. T. (N.S.) 98; 36 L. J. (C.P.) 139.

simply to protect the reputation of the artist or the engraver, but to protect him against the invasion of his substantial commercial property in the work of his genius or of his industry, it is plain that he sustains an injury by another offering a photographic copy which is capable of exciting in the mind of the beholder the same or somewhat similar pleasurable emotions as would be communicated by a copy of the engraving itself. The value of the artist's property would be sensibly diminished were the multiplication of copies by means of photography held to be lawful. In the case above referred to, Chief Justice Erle, in passing judgment, said: "In the representation of 'The Horse Fair,' we feel the same degree of pleasure in looking at the forms and attitudes of the beautiful animals there portrayed, whether we see them in the size in which they are drawn in the original picture, or in the reduced size of the engraving, or in the still more diminished form in which they appear in the photograph. . . . The object of the statute to my mind, was, not merely to prevent the reputation of the artist from being lessened in the eyes of the world, but to secure to him the commercial value of his property, to encourage the arts, by securing to the artist a monopoly in the sale of an object of attraction. . . . It seems to me that the making of copies in that way and selling them is within the words as well as the meaning of the Act" (a).

Though the language of the statute includes, as we have seen, copies made by mechanical or chemical process, and capable of being multiplied indefinitely, yet it has been doubted whether it would include copies made by hand or designs transferred to an article of manufacture.

At the date of the first edition of this work it had not been decided whether the words of the statute would include designs transferred to an article of manufacture (b).

(a) This judgment was confirmed on appeal by the Court of Exchequer Chamber.

(b) See remarks of Byles, J., in *Gumbart v. Bull*, 32 L. J. (N.S.) (C.P.) 166, 168.

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The point, however, subsequently arose in the case of *Dicks v. Brooks* (a). Plaintiffs were the publishers and proprietors of a weekly periodical called 'Bow Bells.' Defendants were the proprietors by assignment of the copyright of a print called 'The Huguenot,' engraved from Millais' picture, and of a photograph taken from the print. The plaintiffs had published for their Christmas number of 1877 a chromo-printed pattern for wool-work, called 'The Huguenot,' taken, as they stated, from a Berlin wool pattern which had been imported by a German warehouse. The leading incident of Millais' picture, the farewell of two lovers of different creeds on the eve of the massacre of St. Bartholomew, was to be found in the Berlin wool pattern, but a different background had been introduced, and the colours were not the same as those of the picture. In December, 1877, the defendants issued a circular containing a warning against the sale of any copy of the subject, 'The Huguenot,' without the stamp or imprint of their firm, in whom the sole subsisting copyright existed, and that all such unstamped copies were imitations and unlawfully made. The plaintiffs, alleging that the publication of this circular was a false and malicious libel on their print and pattern, which was not an imitation of any picture to the copyright of which the defendants were entitled, and that their sale of the publication had been greatly damaged by such circular, brought an action to restrain, and obtain damages for, this alleged libel and slander of title. The defendants by their statement of defence and counterclaim asserted their title to the engraving, averring that the plaintiffs had unlawfully copied it in whole or in part, and greatly damaged the defendants' property therein; and they claimed an injunction and the penalty of 5s. under the Act 8 Geo. 2, c. 13, for every copy sold by the plaintiffs, and damages.

Vice-Chancellor Bacon held that the defendants had the

(a) 15 Ch. Div. 22.

exclusive right of publishing the subject delineated in the print taken from Millais' picture. He considered that the plaintiffs' pattern was to all intents and purposes a direct copy of that print. Were they then entitled, said he, to despoil the defendants of their property, and foist upon the public a very coarse imitation of a very celebrated picture. Being mere pirates, they complained that their title was being slandered, and that they were injured by the circular issued by the defendants for the protection of their property. It was the old story of the wolf and the lamb. There was no pretence for the first action, which he accordingly dismissed with costs; and as the defendants had established the right set up by their counterclaim to restrain this piratical publication by the plaintiffs, he decided that they were entitled to the statutory penalty of 5s. for every copy sold by the plaintiffs. The court, however, on appeal held that a pattern for Berlin wool-work could not be regarded as a copy of an engraving within the meaning of the statutes, inasmuch as though there was a reproduction of the design, there was no reproduction of anything which constituted the work of the engraver. And they accordingly reversed the judgment of the Vice-Chancellor.

In delivering the judgment of the Court of Appeal, Lord Justice James said: "The question before us resolves itself into this, whether this pattern for working in Berlin wool is a piratical copy of the print of which the defendants are the proprietors. It appears to me that the Vice-Chancellor fell into (if I may venture so to call it) the error of supposing that the case was within the Act, 8 Geo. 2, c. 13, which gave a protection, not to a mere engraver, but to a man of genius who by his industry, pains, and expense, invented a design, 'or engraved, etched, or worked, or from his own work and invention caused to be designed and engraved, etched, or worked,' and so on, 'any historical print.'

"Those words were intended to give protection for the genius exhibited in the invention of the design, and the

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protection was commensurate with the invention and design. That Act was afterwards extended to embrace the case of persons engraving from something which was not the design of the engraver. Now it appears to me that the protection given by the subsequent Acts to the mere engraver was intended to be, and was commensurate with that which the engraver did, that the engraver did not acquire against anybody in the world any right to that which was the work of the original painter, did not acquire any right to the design, did not acquire any right to the grouping or composition, because that was not his work but the work of the original painter. What, as it seems to me, the Act gave him, and intended to give him, was protection for that which was his own meritorious work. The art of the engraver is often of the very highest character, as in the print before me. It is difficult to conceive any skill or art much higher than that which has by a wonderful combination of lines and touches reproduced the very texture and softness of the hair, the very texture and softness of the dress, and the expression of love and admiration in the eyes of the lady looking up at her lover. That art or skill was the thing which, as I believe, was intended to be protected by the Acts of Parliament, and what we have to consider is, whether the wool pattern before us (the maker of which must have been aided in the production of it by having before him the defendant's print, or some kind of copy of it, because the wool pattern follows the print in some particulars in which the engraving differs from the picture) is a copy of the engraver's work? It appears to me that without going into any etymological definitions of the word 'copy,' and using the word in the ordinary sense of mankind as applied to the subject-matter, the question is, Is this a copy, is it a piracy, is it a piratical imitation of the engraving—of that which was the engraver's meritorious work in the print? I am of opinion, as a matter of fact, that the wool pattern is not a copy, is not a piratical imitation, with colourable variations of the defendant's

engraving. The alleged copy is not a thing intended as a print in the ordinary sense of the word. It was intended to be printed, and was printed, as a pattern for Berlin wool, not put forward in any way fraudulently or as a sham, but really in truth intended solely for that purpose. Now, I am of opinion that whatever may be the similarities between the one and the other, the attempt not to reproduce the print, but to produce something which has some distant resemblance to the print, not by anything in the nature of the engraver's work, but by what I may call a mosaic of coloured parallelograms, is not in any sense of the word a piratical imitation of the print. Nobody would ever take it to be the print, nobody would ever buy it instead of the print, nobody would ever suppose that it was, to use the language of the first Act, a base copy of the print. It is a work of a different class, intended for a different purpose, and, in my opinion, no more calculated to injure the print *quâ* print, or the reputation of the engraver, or the commercial value of the engraving in the hands of the proprietor, than if the same group were reproduced from the same engraving by wax-work at Madame Tussaud's, or in a plaster of Paris cast, or in a painting on porcelain. I cannot conceive that such a reproduction of the subject in tapestry, or Berlin wool, or upon china, or in earthenware, is within the meaning of the Act of Parliament. Whether dealing with it as a matter of law, or dealing with it, as we must do, as a matter of fact, I am satisfied that the appellant's pattern is not a copy or piracy of any part of that which constituted the real merit and labour of the engraver of the defendant's print" (a).

And where the print or engraving differs materially from the original in character, and is dealt with in a different manner, the former cannot be considered a piracy of the latter within these Acts. Thus in 1821, plaintiff, a celebrated artist, composed and painted from sketches he

What not an infringement.

(a) 15 Ch. Div. 22.

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had designed a picture called 'Belshazzar's Feast,' which he shortly afterwards sold. In 1826 he engraved and published from the sketches a print of the same name, having previously done all necessary acts for securing to himself the copyright of the print. The defendant having purchased one of the prints, had it copied on canvas in colours on a very large scale, with dioramic effect; and he publicly exhibited such dioramic copy at the Queen's Bazaar in Oxford Street for money, describing it, in his handbills and advertisements, as "Mr. Martin's grand picture of 'Belshazzar's Feast,' painted with dioramic effect. The plaintiff applied for an injunction, but the Vice-Chancellor refused to grant one on the ground that exhibiting for profit was in no way analogous to selling a copy of the plaintiff's print, but was dealing with it in a very different manner. The Engravings Acts were not intended to apply to a case where there was no intention to print, sell, or publish, but to exhibit in a certain manner. "If, however," added the Vice-Chancellor, "Martin had exhibited his picture as a diorama, then he might have been entitled to an injunction" (a).

The statutes do not apply to the sale of prints taken from the original plate with the consent of the proprietor. In *Murray v. Heath* (b) where the defendant, an engraver, took a number of impressions from a plate engraved by himself, but for the use of the plaintiff, he being permitted to retain certain copies, but not to sell them; afterwards defendant became bankrupt, and his assignees advertised the copies retained for sale. In an action for damages in which the assignees were co-defendants, the defence was set up that the copies had not been unlawfully printed or imported, and therefore their sale was not piracy. The court held that the sale complained of, though a breach of contract, was not a violation of copyright, and consequently that no action was maintainable under the 17 Geo. 3, c. 57.

(a) *Martin v. Wright*, 6 Sim. 297; *Page v. Townsend*, 5 Sim. 395.

(b) 1 Barn. & Adol. 804.

So, upon a similar principle, it was held in *Mayall v. Higbey* (a) that a person who lends photographs to another for a particular purpose, may prevent him from taking and selling copies, except in pursuance of the purpose for which they were lent, and this, although the photographs have been published, and irrespective of the question of copyright. The above was a case in which the plaintiff had lent photographs of eminent persons to Tallis, the proprietor of the 'Illustrated News of the World,' for the purpose of engraving them for that newspaper. Tallis became bankrupt, and his assignees sold the photographs to the defendant; and it was held that the plaintiff was not only entitled to the photographs but to the unsold copies, and to an injunction to restrain the further sale. The court said that there was no question of copyright, and compared it to the case of a valuable statue, which a friend to whom it is lent had no right to get copied.

No copyright can exist in any obscene, immoral, or libellous engraving (b); and were one to destroy such a print or engraving, he would merely be liable at law to pay the value of the paper and print (c).

In what class of engravings no copyright.

An assignee may maintain an action for the piracy of an engraving, although the statute does not expressly give him that right (d). Also it has been held in Scotland necessary to allege where the piracy has been committed (e).

The penalty incurred by a pirate under the Engravings Acts is the forfeiture of the plates on which the prints are copied, and every sheet on which the engraving has been printed, to the proprietor of the original print, who must forthwith destroy or damage them; and he must also

Penalty for piracy.

(a) 1 H. & C. 148.

(b) See 5 Geo. 4, c. 83, s. 4; 1 & 2 Vict. c. 38, s. 2; 20 & 21 Vict. c. 83; *Fores v. Johnes*, 4 Esp. 97.

(c) *Du Bost v. Beresford*, 2 Camp. 511. In *The Emperor of Austria v. Day and Kossuth*, 7 Jur. (N.S.) 641, Ch.; on appeal, 4 L. T. (N.S.) 494, the Lord Chancellor stated that the cases of *Burnett v. Chetwood* (2 Mer. 441, note) and *Du Bost v. Beresford*, *supra*, were wrongly decided. Compare the fact of the liability of the destroyer for the amount of the paper, with the maxim in Moor. 813: "*Inveniens libellum famosum et non corrumpens punitur*," and, if possible, reconcile the two.

(d) *Thompson v. Symonds*, 5 T. R. 41.

(e) *Graves v. Logan*, 7 Sc. Sess. Cas. 3rd Ser. 204.

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forfeit the sum of five shillings for every print found in his custody. The same penalties attach to one who has published, exposed to sale, or disposed of, any pirated engravings: one moiety passing to the Sovereign, and the other being given to the informer.

Special action on the case.

By the 17 Geo. 3, c. 57, it is enacted that a special action on the case may be brought against the person offending, to recover such damages as a jury on the trial of such action, or on the execution of a writ of inquiry, may give; and though all actions under the 8 Geo. 2, c. 13, must have been brought within three months, and under the 7 Geo. 3, c. 38, within six calendar months after the offence, no limitation is mentioned in the 17 Geo. 3, c. 57, as to the time in which this special action on the case is to be brought (a).

Limitation of time as to actions.

Summary proceedings for the recovery of penalties.

In concluding, we will offer a few remarks on the remedy afforded by a later Act of Parliament for the recovery of the penalties for infringement under the Engravings Acts. The mode of recovery was much simplified by the 8th section of the 25 & 26 Vict. c. 68, commonly known as the Copyright (Works of Art) Act (b). By this clause all pecuniary penalties which shall be incurred, and all such unlawful copies, imitations, and all other effects and things as shall have been forfeited by offenders pursuant to any Act for the protection of copyright engravings, may be recovered by the person empowered to recover the same, and thereafter called the complainant or the complainer, as follows:

In England and Ireland.

In *England* and *Ireland*, either by action against the party offending, or by summary proceedings before any two justices having jurisdiction where the party offending resides (c);

(a) See *Graves v. Mercer*, 16 W. R. 790.

(b) By the Short Titles Act, 1892, citable as "The Fine Arts Copyright Act, 1862."

(c) A magistrate sitting at a police court within the metropolitan police district, and every stipendiary magistrate appointed or to be appointed for any other city, town, liberty, borough, or place, or the lord mayor, or an alderman of London, sitting at the Mansion House, or Guildhall Justice Rooms, has power, when sitting alone, to exercise the jurisdiction given

In *Scotland*, by action before the Court of Session in ordinary form, or by summary action before the sheriff of the county where the offence may be committed or the offender resides, who, upon proof of the offence or offences, either by confession of the party offending or by the oath or affirmation of one or more credible witnesses, shall convict the offender, and find him liable to the penalty or penalties aforesaid, as also in expenses; and it shall be lawful for the sheriff, in pronouncing such judgment for the penalty or penalties and costs, to insert in such judgment a warrant, in the event of such penalty or penalties and costs not being paid, to levy and recover the amount of the same by pounding; provided always that it shall be lawful to the sheriff, in the event of his dismissing the action and assoilzieing the defender, to find the complainer liable in expenses; and any judgment so to be pronounced by the sheriff in such summary application shall be final and conclusive, and not subject to review by advocacy, suspension, reduction, or otherwise.

It will be observed here that though the procedure of the 25 & 26 Vict. c. 68, is extended to the Engravings Acts, yet the penalties recoverable are only those given by the Engravings Acts.

Further, it is declared lawful for the superior courts of record in which any action may be pending, or if the courts be not then sitting, then for a judge of one of such courts, on the application of either the plaintiff or defendant, to make an order for an injunction, inspection, or account, as to such court or judge may seem fit.

Orders for
inspection or
account.

As pirated copies are made very much to resemble the original in particular parts, and to be totally distinct in other parts, care must be taken to draw the statement so as to charge the defendant with *copying part*, as well as with copying the whole (a).

by this Act to two justices. 2 & 3 Vict. c. 71, s. 14; 11 & 12 Vict. c. 43, ss. 29, 33, 34; see also 21 & 22 Vict. c. 73; 42 & 43 Vict. c. 49, and 47 & 48 Vict. c. 43.

(a) 5 Barn. & Ald. 737; and 1 Dowl. & Ry. 400, cited Godson on Patents, &c. 301.

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Evidence on
behalf of
plaintiff.

The evidence to be adduced at the trial on behalf of the plaintiff is simply that he is the proprietor of the print or engraving pirated; and it is sufficient that he produce one of the prints taken from the original plate. The production of the plate itself is not requisite.

It seems the best way to continue the name of the first proprietor on the print: for it is doubtful whether a plate with name of the assignee (although the date be correct) is good evidence (a).

(a) In *Bonner v. Field*, cited 5 T. R. 44, Lord Mansfield nonsuited a plaintiff under similar circumstances, cited Godson on Patents, &c. 301.

CHAPTER XIII.

COPYRIGHT IN SCULPTURE AND BUSTS.

THE art of sculpture has never been particularly favoured by the English nation. It is an art which ought certainly to be patronized more extensively, for it refines and improves the public mind and taste. The art of sculpture.

The erection of national monuments to the memory of individuals who by their works or their virtues have conferred lasting benefit or honour on mankind in general or their own country in particular, or in order to commemorate important public events, is a means by which the art produces the most influential moral effects.

These mementoes or memorials, though in the present age the unphilosophical and sciolistic spirit of some have led them to regard with contempt this method of honouring the illustrious great, excite a laudable admiration for the service or benefit to which they testify, and are living realities to perpetuate at once the respect entertained by the nation, both for the individual himself and the performance that has entitled him to their gratitude. When efficiently executed, they not only perpetuate the memory of the individual himself and record his good deeds, but appeal continuously to the national mind, and encourage and stimulate all posterity to follow in his footsteps. The person represented seems to be ever present. The deeds commemorated appear still in vivid force, and although we have not the actual presence of the departed,

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we retain his remembrance and preserve much of his influence.

“Public monuments, moreover,” says Mr. Harris (a), “give a character to a nation and record the existence of what are in reality its noblest treasure,—the great men who have adorned it. They much influence the genius of a people, and in their turn exhibit the national feeling and genius. Indeed, the moral effect of these erections, both in ancient and modern times, has been made obvious. The essential advantage in regard to civilization arising from the national veneration paid to heroes and great men, results from the stimulus which it excites to emulate their virtues, and to shun all those vices which are opposed to the latter, and by which lustre like theirs would be tarnished. The use of monuments in this respect is two-fold: first, to preserve the memory of those great men to whom they are erected, and of their virtues also; secondly, to testify the regard of the nation for those great men and for the virtues which they displayed. In both these respects, they are extensively and directly conducive to civilization, and are calculated to carry it to its highest point.”

On these social grounds, therefore, it is incumbent upon the legislature to cherish and encourage an art yielding fruit such as this is capable of bearing.

Busts of private individuals are not likely to have much value as copyright, but busts of great men have a general interest and value. The demand for copies is so small that seldom is it that piracy takes place. The only case in which we remember the Sculpture Act being applied, is that of a bust of Fox.

The means of reproduction by a cast is very simple and merely mechanical (at least, after a single copy has been obtained), and this fact accounts for the limited application of the Act. Most of the ornamental casts in

(a) ‘Civilization considered as a Science.’

request are taken from foreign works of art, or from such as have been dedicated to the public by exposure or become public property; seldom is the licence of the original designer required. There is little skill in the preparation of the type-mould, which corresponds to the plate of the engraver, unless, perhaps, where the scale is reduced (a).

The copyright in busts and sculptures depends upon the 54 Geo. 3, c. 56 (b). This Act amended and extended the provisions of the 38 Geo. 3, c. 71 (repealed by the Statute Law Revision Act, 1861), which had been found ineffectual for the purposes thereby intended. So ineffectual had it proved that although avowedly passed for the preventing the piracy of busts and other figures made and published by statuaries, it was decided to be no offence to *sell* a pirated cast of the bust if the piracy had any addition to or diminution from the original; nor was it an offence to *make* a pirated cast if it were a perfect *fac-simile* of the original (c). Lord Ellenborough thought the statute had been passed with a view to defeat its own object, and taking advantage of the opportunity of making a joke, which the bar, as a matter of duty, had to imagine exceedingly good, advised artists when they applied to Parliament for further protection, not to *model* the new Act themselves as they appeared to have done the one in question.

Extent and
duration of
Acts.

The 54 Geo. 3, c. 56 (18th of May, 1814), enacts that every person or persons who shall make or cause to be made any new and original sculpture, or model, or copy, or cast of the human figure or human figures, or of any bust or busts, or of any part or parts of the human figure, clothed in drapery or otherwise, or of any animal or animals or any part or parts of any animal, combined with the

(a) Turner on 'Copyright in Design.'

(b) By the Short Titles Act, 1892, citable as "The Sculpture Copyright Act, 1814."

(c) *Gahagan v. Cooper*, 3 Camp. 111.

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human figure, or otherwise, or of any subject being matter of invention in sculpture (a), or of any alto- or basso-relievo representing any of the matters or things thereinbefore mentioned, or any cast from nature of the human figure, or of any part or parts of the human figure, or of any cast from nature of any animal, or of any part or parts of any animal, or of any such subject containing or representing any of the matters and things thereinbefore mentioned, whether separate or combined, shall have the sole right and property of all and in every such new and original sculpture, model, copy, and cast of the human figure and human figures, and of all and in every such bust or busts, and of all and in every such part or parts of the human figure, clothed in drapery or otherwise, and of all and in every such new and original sculpture, model, copy, and cast, representing any animal or animals, and of all and in every such work representing any part or parts of any animal combined with the human frame or otherwise, and of all and in every such new and original sculpture, model, copy, and cast of any subject being matter of invention in sculpture, and of all and in every such new and original sculpture, model, copy, and cast in alto- or basso-relievo, representing any of the matters or things thereinbefore mentioned, and of every such cast from nature, for the term of fourteen years from first putting forth or publishing the same ; provided in all and every case the proprietor or proprietors do cause his, her, or their name or names, with the date, to be put on all and every such new and original sculpture, model, copy, or cast, and on every such cast from nature, before the same shall be put forth or published.

After the expiration of this term of fourteen years the copyright shall return to the person who originally had the copyright, if he be then living, for the further term of fourteen years.

(a) *Caproni v. Alberti*, 8 T. L. R. 146 ; 65 L. T. 785.

The copyright is to run from the "first putting forth or publishing the same." The property secured by the Act seems to be comprehensive enough to embrace the right of public exhibition. The opinion has been judicially expressed that, within the meaning of the statute, a work may be published by being publicly exhibited (a). In *Turner v. Robinson*, Lord Chancellor Brady said: "In the statutes bestowing protection upon works of sculpture, the terminus *a quo* from which the protection commences is the publication of the work, that is, from the moment the eye of the public is allowed to rest upon it. Many large works in this branch of art, which decorate public squares and other places, are of course so published, but there are others not designed for such purposes which could never be published in any other way than in exhibitions; therefore I apprehend that these works of sculpture must be considered as published by exhibition at such places as the Royal Academy and Manchester, so as to entitle them to the protection of the statutes from the date of publication" (b).

The question was recently raised (c) whether the casts of flowers and fruit were within the protection afforded by the Act. The plaintiffs, since 1880, had carried on the business of modellers, sculptors, and makers of casts, and supplied casts to schools and art classes entitled to grants in aid from the Department of Science and Art. The defendant copied three of the plaintiffs' designs upon the application for casts made to him by a person connected with one of the art schools in Manchester, and sold the casts so copied for 3s. or 5s. each cast, being considerably under the price charged by the plaintiffs. On one of the casts some of the letters contained in the name of the

What protected by the Act.

(a) *Turner v. Robinson*, 10 Ir. Ch. 516.

(b) The Royal Commissioners proposed that the term of copyright in all works of fine art other than photographs should be the same as for books, music, and the drama, namely, the life of the artist, and thirty years after his death: par. 95.

(c) *Caproni v. Alberti*, 8 T. L. R. 146 5 L. T. 785.

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plaintiffs appeared, that name having been partly scratched out. On the others no name appeared, the name having been scratched out after the cast had been taken. The defendant, while admitting having copied the designs, contended that that was no cause of action, as the 54 Geo. 3, c. 56, did not apply to a cast of flowers or fruit. The plaintiffs had not registered under the Designs Act, 1850, 13 & 14 Vict. c. 104, s. 6, or under the Patents, Designs, and Trade Marks Act, 1883. The court held that the productions in question came within the Act, and were within the words "being matter of invention in sculpture," and granted an injunction.

Conditions to be complied with in order to effectuate a copyright.

The conditions under which the copyright is acquired are almost identical with those required to be performed in order to obtain a copyright under the Engravings Acts. When a sculptor models a design for himself, and afterwards executes from such model a finished bust for another in marble or any other material, it is not sufficient for the sculptor, in order to acquire the copyright therein, to affix his name and the year when the finished copy from the model was executed (as is frequently the case); he must conform strictly to the letter of the Acts (*a*), and therefore engrave on the *model*, as well as on every cast or copy thereof, his name (*b*), and the day of the month and year when the model is first shewn or otherwise published in his studio, or elsewhere; and such *date must never be altered*.

Assignment of the right.

By the 54 Geo. 3, c. 56, it was further provided that no person who should thereafter purchase the right or property of any new and original sculpture, or model, or copy, or cast, or of any cast from nature, of the proprietor, expressed in a deed in writing signed by him in the

(*a*) As under the Designs Act, see *Pierce v. Worth*, 18 L. T. (N.S.) 710.

(*b*) The name need not necessarily be the baptismal and surname of the proprietor, but such as he or his co-proprietors are commonly known by or trade under.

presence of and attested by two or more witnesses, should be subject to any action for copying, or casting, or vending the same; and that all actions brought for pirating under this Act should be commenced within six calendar months next after the discovery of the offence (a).

Sculptures and models had to be registered under the Designs Act (13 & 14 Vict. c. 104, s. 6), which provided that the registrar of designs, upon application by or on behalf of the proprietor of any sculpture, model, copy, or cast within the protection of the Sculpture Copyright Acts, and upon being furnished with such copy, drawing, print, or description in writing or in print, as in the judgment of the said registrar should be sufficient to identify the particular sculpture, model, copy, or cast in respect of which registration was desired, and the name of the person claiming to be proprietor, together with his place of abode or business, or other place of address, or the name, style, or title of the firm under which he might be trading, should register such sculpture, model, copy, or cast, in such manner and form as should from time to time be prescribed or approved by the Board of Trade, for the whole or any part of the term during which copyright in such sculpture, model, copy, or cast should exist under the Sculpture Copyright Acts; and whenever any such registration should be made, the said registrar should certify under his hand and seal of office, in such form as the said board should direct or approve, the fact of such registration and the date of the same, and the name of the registered proprietor, or the style or title of the firm under which such proprietor might be trading, together with his place of abode or business, or other place of address.

The application under this section need not necessarily be made by the author; it is to be made by the proprietor.

The 13 & 14 Vict. c. 104, is one of the Acts repealed

(a) See form of assignment, Crabb's Pree.

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by the Patents, Designs, and Trade Marks Act, 1883. The only section in this last Act at all affecting registration of sculptures seems to be the 114th, by which it is provided that the register of designs kept under any enactment repealed by the Act of 1883 shall respectively be deemed parts of the same book as the register of designs under that Act. The result apparently is that it is not now necessary to register the copyright or proprietorship in sculptures or busts.

The 54 Geo. 3, c. 56, s. 3, gives an action for damages against any person who shall make or import or cause to be made or imported or exposed to sale or otherwise disposed of any pirated copy or pirated cast, whether it be produced by moulding or copying from or imitating in any way the original.

Infringement
of the right,
and penalties
attached
thereto.

The 7th section of the 13 & 14 Vict. c. 104, provided that if any person should, during the continuance of the copyright in any sculpture, model, copy, or cast which should have been so registered as provided by that Act, make, import, or cause to be made, imported, exposed for sale, or otherwise disposed of, any pirated copy or pirated cast of any such sculpture, model, copy or cast, in such manner and under such circumstances as would entitle the proprietor to a special action on the case under the Sculpture Copyright Acts, the person so offending should forfeit for every such offence a sum not less than £5 and not exceeding £30, to the proprietor of the sculpture, model, copy, or cast whereof the copyright should have been infringed; and for the recovery of any such penalty the proprietor should have the same remedies as were provided for the recovery of penalties incurred under the Designs Act, 1842: provided always, that the proprietor of any sculpture, model, copy, or cast which should be registered under the Act should not be entitled to the benefit of the Act unless every copy or cast of such sculpture, model, copy, or cast which should be published by him after such registration, should be marked

with the word "registered" and with the date of registration.

This provision, as we have already seen, has been repealed by the Patents, Designs, and Trade Marks Act, 1883, and there seems to be in existence now no provision for registration nor necessity for marking with the word "registered" or with the date of registration.

In conclusion, we must express a hope that protection will before long be afforded to the sculptor against drawings or engravings of any description, which may now be taken from his work with impunity. If the sculpture be a production of any merit and value, if well designed and engraved, it might be profitable to the author in various ways; while, on the contrary, if it be badly or carelessly executed, it may be alike annoying to him and injurious to his reputation and fame.

On this subject the Royal Commissioners in their report on Copyright, 1878, say:—"Upon the whole we are disposed to think that every form of copy, whether by sculpture, modelling, photography, drawing, engraving, or otherwise, should be included in the protection of copyright. It might be provided that the copying of a scene in which a piece of sculpture happened to form an object should not be deemed an infringement unless the sculpture should be the principal object, or unless the chief purpose of the picture should be to exhibit the sculpture.

"It was also suggested that copyists of antique works ought to be protected by copyright so far as their own copies are concerned. Many persons spend months in copying ancient statues, and the copies become as valuable to the sculptors as if they were original works. It may be doubted whether the case does not already fall within the Sculpture Act, but we recommend that such doubts should be removed, and that sculptors who copy from statues in which no copyright exists should have copyright in their own copies. Such copyright should not, of course,

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Lord Monkswell's recent Bill proposed that the term of copyright in sculpture as well as in paintings should be the life of the person to whom the same is given and 30 years next after his death.

(a) Pars. 99, 100.

CHAPTER XIV.

COPYRIGHT IN PAINTINGS, DRAWINGS, AND PHOTOGRAPHS.

OF all the branches of the fine arts this was the last recognised as worthy of protection by the legislature. On what ground it is difficult to comprehend. Where is the difference in principle between a picture and a poem ?

The arts of painting and drawing.

The claims of the artist to a copyright in his works are quite as valid as those of the literary author in his ; and if the principle were once admitted that a man should be protected in the enjoyment of his intellectual productions, and a certain period of exclusive possession allowed to the author for his benefit, before the public were in full and free enjoyment of the work, on what ground could Parliament so long withhold the same privilege from the artist as it had already granted to the author ?

It is a strange anomaly that while the law gave a property to that which was, in the ordinary way, the work of a man's hands, and allowed a copyright in inventions and designs, it should have afforded no protection to those productions which were more exclusively the creations of the mind. It was thought but an act of justice and right that a copyright should exist in literary productions, but when it was proposed, as late as 1862, to give a similar right in pictures, a cry was raised that it was derogatory on the part of jurisprudence to protect the works of those who contributed by their art to the honour of their country, the elevation of the national taste, and the amusement, instruction, and delight of the community at large.

With respect to the fine arts, two series of Acts had been passed, giving a copyright of a limited and special

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nature in sculptures and engravings: hence this unaccountable opposition to the bestowing a copyright in paintings appears the more extraordinary. For while an engraving enjoyed protection, the picture from which it was taken was without. A man might make any number of copies of the best work of the artist—sell them, and there was no remedy. Not unfrequently these copies were sold as originals, and even the name of the original artist forged upon them, but the injured party was without redress.

The evil was almost peculiar in this country. In most European countries the principle of copyright extended through the whole range of the fine arts, and, unlike our law, especially protected the work of painters.

At the present day, if one purchases the copyright of a picture he holds the picture free from any interference, and with the perfect right of dealing with it as he pleases. If, however, he buys the picture simply as a picture, the copyright being reserved to the artist by some note in writing, he, the purchaser of the picture, will then have the gratification and delight resulting from its contemplation—he cannot make copies or engravings from it, or use it for a different purpose from that for which the artist sold it (*a*). The same rule applies to authors. When a person buys a book he can read it, but cannot multiply copies of it unless he purchases the copyright. This appears but fair, especially if we bear in mind that the greater part of the artist's remuneration probably arises from the reproduction of his work (*b*).

The existence of copyright in painting is a protection also to the purchaser of a picture. It was formerly well known that after a person had purchased a picture the artist might have made a copy and multiplied it to any extent, although the purchaser might have been under

(*a*) Of course the purchaser of the picture is not bound to lend it to the artist or any other person for the purpose of engraving, and this is only here mentioned as there seems to be some such extraordinary idea prevalent among engravers.

(*b*) The painting of 'The Roll Call,' by Miss Thompson, was sold for £100, the right of engraving fetched £1200, see *post*, p. 456.

the impression that he had bought a picture as being the single work of the artist. Of course such an action would not have become an honourable man, but still the right remained to the artist to act in such a manner had he thought proper. It is not a desirable thing to have a great work of art multiplied indefinitely, and hawked about for sale. It is well known that the frequent repetition of a work of art diminishes the worth of the original; indeed, nothing detracts so much from its commercial value.

At length the wished-for day arrived, and the artists succeeded in obtaining for their protection an Act of Parliament.

The Act (25 & 26 Vict. c. 68) is entitled, 'An Act for amending the Law relating to Copyright in Works of the Fine Arts, and for repressing the commission of Fraud in the Production and Sale of such works' (a). It provides that the author (b), being a British subject or resident within the dominions of the Crown, of every original painting, drawing (c), and photograph which shall be or shall have been made, either in the British dominions or elsewhere, and which shall not have been sold or disposed of before the commencement of the Act, and his assigns, shall have the sole and exclusive right of copying, engraving, reproducing, and multiplying such painting or drawing and the design thereof, or such photograph and the negative thereof, by any means and of any size, for the term of the natural life of such author, and seven years after his death; provided that when any painting or drawing or the negative of any photograph shall for the first time after the passing of this Act be sold or disposed of, or shall be made or executed for or on behalf of any person for a good or a valuable consideration, the person so selling or disposing of or making or executing the same shall not retain the copyright thereof unless it be expressly reserved

Creation of
copyright in
works of art.

(a) By the Short Titles Act, 1892, this Act may be cited as "The Fine Arts Copyright Act, 1862."

(b) *Kenrick & Co. v. Lawrence & Co.*, 25 Q. B. D. 99.

(c) An architectural design is protected under this word.

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to him by agreement in writing, signed at or before the time of such sale or disposition by the vendee or assignee of such painting or drawing or of such negative of a photograph, or by the person for or on whose behalf the same shall be so made or executed, but the copyright shall belong to the vendee or assignee of such painting or drawing or of such negative of a photograph, or to the person for or on whose behalf the same shall have been made or executed; nor shall the vendee or assignee thereof be entitled to any such copyright, unless at or before the time of such sale or disposition an agreement in writing, signed by the person so selling or disposing of the same, or by his agent duly authorized, shall have been made to that effect.

A case on this point is *Levi v. Chumpton & Co., Limited* (a). The plaintiff, Mr. Levi, was a chromolithographer, and the defendants the well-known mustard and vinegar manufacturers. The plaintiff was one evening instructing himself by reading 'Midsummer Night's Dream,' when he came across the well known passage, "Good Master Mustard-seed, I know your patience well: that same cowardly giant-like ox-beef, hath devoured many a gentleman of your house; I promise me your kindred hath made my eyes water ere now. I desire your more acquaintance, good Master Mustard-seed" (b). On reading these lines it occurred to him that the words, accompanied by a suitable illustration, would form a good label or trade-mark for a firm of merchants in or manufacturers of mustard. He accordingly had prepared by his artist an oil painting on millboard of a weird moonlight scene, in which a sprite was pictured presenting a tin of something, presumably mustard, to Bottom and to Titania, who were seated on a green bank, with Puck hovering over their heads. In the lower part of the picture was a label containing the above Shakesperian lines and the word 'Mustard.' This picture was in 1879 shewn to a

(a) 3 T. L. R. 286.

(b) Act iii. sc. 1.

person in Messrs. Champion & Co.'s employment by the plaintiff's traveller, and Messrs. Champion & Co. ordered 250,000 reduced coloured copies as labels for their mustard tins, and the name 'Champion' affixed to the picture, which were duly supplied. The picture itself remained for some time in the possession of the defendants. A second issue of the labels was printed by the plaintiff for the defendants in 1883 at a reduced charge. Subsequently the defendants employed other people to print similar labels, and the plaintiff (having registered the copyright in the picture under the Act of 1862 in 1879) brought his action, alleging that by issuing the labels which were not printed by the plaintiff the defendants had infringed his copyright. Mr. Justice Kekewich came to the conclusion, on the evidence, that the agent for Messrs. Champion did mean to buy the picture, and that the plaintiff's traveller did intend to sell it. Then and there, when the order was given, the property in the picture passed to Messrs. Champion, Levi being intrusted with the task of printing a number of copies, without any reservation of a right on his part to print future issues of the label. His lordship held that there was a contract for sale of the picture, and that the property passed to Messrs. Champion: that section 1 of the Act was applicable, and that a person so selling was not entitled to the copyright. Messrs. Champion did not claim the copyright in the picture, but Levi had not got it—that was to say he had not got the sole or exclusive right; and therefore could not prevent Messrs. Champion or other persons from multiplying copies.

It is important, therefore, that the artist, at the sale, or at or before the time of delivery or the completion of the bargain, should obtain the signature of the vendee or assignee, or of the person for whom the work has been executed, to a written reservation of the copyright to himself, if he desires to retain it; or assign in writing the same to the purchaser at or before the completion of the transaction, otherwise the copyright will be irredeemably

By whom
it may be
claimed.

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lost (a). If the vendee obtains not this agreement in writing, he will be unable to protect himself against piracy or repetition by the artist, as section 6 only protects pictures, &c., in which there is subsisting copyright. The copyright cannot, unless reserved in writing, vest in the vendor; it cannot, if not assigned in writing, vest in the vendee or assignee (b). It, however, would pass without a written agreement to the person for or on whose behalf a work is expressly executed, *as in commissions* (c). But a person who employs another to

Who is the author—

(a) Forms of various kinds of agreements under this Act will be found in the Appendix. Agreements under the Act require a sixpenny stamp.

(b) Evidence of what was actually done on a sale seems to have been ignored by Mr. Justice Stirling in the case of *Troitzsch v. Hers* (3 T. L. R. 773; W. N. (1887) 150). This was a motion by the plaintiff for an injunction to restrain the defendant from reproducing, publishing, importing for sale, selling, or otherwise circulating any copies or colourable imitations of a painting known as 'Christ Healing the Sick,' the property of the plaintiff. The painting in question was by a German artist named Gabriel Max, by whom it was sold, together with the copyright, in November, 1884, to a purchaser who subsequently assigned it to the plaintiff, who resided in Berlin. The plaintiff registered his picture at Stationers' Hall in 1887 under the Acts of 1842 and 1862, and he produced a certificate of such registration. Several points were raised by the defendant, and amongst others the point that there was no evidence of any reservation of the copyright in the picture as required by section 1 of the Act, and though notice had been given to the plaintiff to produce the assignment to himself, he had not produced it, and that being so there was no copyright at all. The report is confused, and how there could have been a *reservation* to the purchaser on the sale to him is beyond the writer's comprehension—possibly an agreement in writing signed at or before the sale by the vendor granting the copyright to the vendee is meant by *reservation*. The Court seems to have held that the fact of the plaintiff being registered was presumptive evidence of there having been such an agreement in writing as is last referred to. Mr. Justice Stirling puts it thus: It was said that there was not sufficient evidence of the plaintiff's copyright. A duly certified copy of the entry upon the register at Stationers' Hall was produced and relied upon by the plaintiff. But it was said that that was only *prima facie* evidence of the copyright which might be rebutted by other evidence. The defendant claimed that it was rebutted by reason of the fact that in answer to his notice the plaintiff had failed to produce any assignment of the copyright to him. His lordship was of opinion, however, that that was not sufficient to enable him to say that the plaintiff's title to the copyright was displaced.

(c) The Royal Commissioners in their report on Copyright in 1878, were of opinion that it was clearly undesirable that copyrights, which are in many cases of great value, should be in this way left free to piracy, and that the law therefore should distinctly define to whom, in the absence of an agreement, the copyright should belong.

They also referred to the expediency of making a distinction between pictures painted on commission and others. They experienced a difficulty in defining what a commission was, and looking to the evidence before

execute for him an artistic work, though the employer may be the proprietor of the copyright, is not therefore the author within the meaning of the Act.

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distinction
between
author and
proprietor.

Thus where the plaintiffs were a firm of printers, J., a member of the firm, conceived the idea of printing and publishing cards, bearing a representation of a hand holding a pencil in the act of completing a cross within a square, with a view to such cards being used at parliamentary and other elections for the guidance and instruction of illiterate voters in the marking of their ballot papers. J., being unable to draw, employed an artist in the service of the firm to make under his direction a drawing of the representation above described. The plaintiffs registered the drawing under the Act of 1862, and in the memorandum stated J. to be the author of the drawing. The Court, however, held that J. was not the author of the drawing, and that the registration was consequently void (a).

Mr. Justice Wills in the case last cited said: "I do not see how a gentleman who is incapable of drawing even such a very simple picture as a rough sketch of the human hand, and who did not in fact set pencil to paper in the matter, can be called the author of the drawing. He suggested the subject and made such limited suggestions as to the treatment as the subject admitted of; but it seems to me that in an Act which gives copyright to drawings the author must mean a person who has at least

them upon the point, they arrived at the conclusion that no distinction could practically be made.

The majority of the Commissioners came to the conclusion that in the absence of a written agreement to the contrary, the copyright in a picture should belong to the purchaser, or the person for whom it is painted, and follow the ownership of the picture. They mentioned that the final proviso in the 1st section of the Act of 1862 was apparently added to the Bill without sufficient consideration during its progress through Parliament.

As to whether an artist who has sold a picture should be at liberty without the consent of the owner to make replicas of it, or whether a distinction should be made between replicas made by the artist, and copies made by others than the artist, the Commissioners reported that they were not inclined to recognise any distinction.

(a) *Kenrick & Co. v. Lawrence & Co.*, 25 Q. B. D. 99; 38 W. R. 779.

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some substantial share in putting the touches on to paper" (a).

The copyright given by the first section is qualified by the following section, to the extent that nothing shall prejudice the right of any person to copy or use any work in which there is no such copyright, or to represent any scene or object, notwithstanding that there may be copyright in some representation of such scene or object.

This must refer to and include all works of ancient and deceased masters, and all paintings of living artists sold before the passing of this Act, or since, without the statutory provisions having been complied with for the creation and transfer of copyright.

The question has several times come before the court as to who is the author of a photograph within the meaning of the Act. In *Nottage v. Jackson* (b), the explanation of the Master of the Rolls as to who was the author was this: "The nearest I can come to, is, that it is the person who effectively is as near as he can be the cause of the picture which is produced, that is, the person who has superintended the arrangement, who has actually formed the picture by putting the people into position, and arranging the place in which the people are to be"; and Lord Justice Cotton said:—"In my opinion, 'author' involves originating, making, producing as the inventive or master mind, the thing which is to be protected, whether it be a drawing, or a painting, or a photograph"; and Lord Justice Bowen said: "The true definition of 'author' for the purpose of the Act, keeping in mind that photography is to be treated for the purpose of the Act as if it were an art, is that the author is the man who really represents, or creates, or gives to the ideas, or fancy or imagination the local habitation—the man, in fact, who in the words of the Master of the Rolls, is most nearly the effective cause of the representation" (c).

(a) *Kenrick & Co. v. Laurence & Co.*, 25 Q. B. D. 99, 106.

(b) 11 Q. B. D. 627.

(c) And see *Wooderson v. Raphael Tuck & Sons*, 4 T. L. R. 57.

Where, therefore, a sitting is given to a photographer without payment, the copyright vests in the employer, and the sitter cannot restrain the sale of the photograph. Where, however, a sitter pays value to the photographer, the sitter is the person "for and on whose behalf" the photograph is "executed for valuable consideration," and the copyright, apart from any agreement to the contrary, vests in the sitter, who will be entitled when he has duly registered to restrain the multiplication and sale of copies.

All formalities, such as are required under the Engraving or the Sculpture Copyright Acts, are unnecessary in the assignment and transfer under this Act. Copyright is declared to be personal property, and capable of being assigned by any note or memorandum in writing, signed by the proprietor of the copyright, or by his agent appointed for that purpose in writing.

Where S., the proprietor of a periodical called 'Good Words,' agreed verbally with G. to purchase the right to engrave certain photographs to illustrate 'Good Words,' G. reserving the right to use them in any other publication, and subsequently signed a receipt for "the use of photographs in 'Good Words' reserving all rights to issue the same in any other publication," and afterwards S. commenced publishing in a separate volume these articles, illustrated by engravings from the same photographs, and G. brought an action under the 25 & 26 Vict. c. 68, for damages and for a writ of injunction; and S. filed a bill for a declaration that under the verbal agreement he was entitled to republish the engravings taken from G.'s photographs, for specific performance of an alleged verbal agreement to grant a licence to use the photographs for the purpose of engraving and publishing in 'Good Words,' or in any republication of the articles which they illustrated, and that the action at law might be restrained; Vice-Chancellor Malins held, that the verbal agreement extended to the use of the photographs in 'Good Words' only, that there was no part performance by G. of a

Assignment
and registra-
tion.

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contract or licence by G. to publish in a separate form, and that S. had no equity, inasmuch as by the 25 & 26 Vict. c. 68, s. 3, every leave or licence for the publication of photographs must be in writing, and dismissed the bill with costs (a).

Assignment of the copyright when limited in effect.

And an assignment in terms of the copyright in a picture may be qualified by the obvious intention of the parties to a licence to copy it, or to an assignment for the limited purpose of producing an engraving or photograph.

Thus in a recent case (b), an action was brought to restrain an alleged infringement by the defendant of the plaintiff's copyright in an oil painting called 'Going to Work,' and in an engraving made from it. The picture was painted by the artist for a Mr. Halford, who, on the 9th of November, 1870, wrote the following memorandum addressed to the plaintiff: "I assign to you for the purpose of producing an engraving of one size, the copyright of the picture painted by Mr. Eddis, entitled 'Going to Work,' and being a portrait of my daughter." The picture represented a little girl in a sea-side costume with bare feet walking on the sea-shore, carrying in one hand a spade over her shoulder, and in the other hand a bucket. The plaintiff, on the 12th November, 1870, registered himself under the 25 & 26 Vict. c. 68, as the proprietor of the copyright of the picture, and in July, 1871, he published an engraving of the picture, his name being engraved on the plate as the proprietor.

In 1879 the defendant published a chromo-lithograph which the plaintiff alleged to be an infringement of his copyright. This picture was called 'Holiday Time,' and it also represented a girl on the sea-shore, with bare feet, with a spade in one hand over her shoulder, and a bucket in the other hand. But her dress was different from that

(a) *Strahan v. Graham*, 16 L. T. (N.S.) 87; 17 L. T. (N.S.) 457; 15 W. R. 487.

(b) *Lucas v. Cooke*, 13 Ch. Div. 872; *Tuck v. Canton*, 51 L. J. Q. B. 363.

of the girl in the picture, and she was standing still instead of walking. The evidence shewed that the chromo-lithograph was derived from a photograph published in New York, and that neither the defendant nor the artist whom he employed to produce the chromo-lithograph had, before its production, seen either the picture or the engraving. There was no evidence to shew how the photograph was produced, or whether the photographer had, before he produced it, seen either the picture or the engraving. The photograph was evidently taken from life.

Mr. Justice Fry held that the letter of the 9th November, 1870, amounted only to an assignment of the copyright of the picture or a licence to copy it, for the limited purpose of producing an engraving of one size, and that the right of producing copies in other ways and of other sizes remained in Halford, and could be assigned by him to any one else. And by sect. 11 of the 5 & 6 Vict. c. 45, the registration gave only a *primâ facie* title which could be rebutted, and here the assignment itself rebutted the *primâ facie* title. The result was that the plaintiff was only the proprietor of the engraving. It was very possible that the photograph might have been in substance copied from either the picture or the engraving, but there was no evidence on which the court was entitled to assume that it was copied from either. But, even if it was copied from one or the other, it might have been copied from the picture, in which the plaintiff had no right, just as well as from the engraving, and the court could not assume without evidence that it was copied from the latter. Before the plaintiff could succeed, he must shew that the photograph had been taken from the engraving, and this he had not done.

It has been decided (a) that a licence not amounting to an assignment of the whole copyright need not be

Licence need not be registered.

(a) *Tuck v. Canton*, 51 L. J. Q. B. 363. See *London Printing and Publishing Alliance, Limited v. Cox*, [1891] 3 Ch. 291; 60 L. J. Ch. 707; 65 L. T. 60; 7 T. L. R. 738.

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registered. The document which was said to amount to a licence ran thus: "The sole right to reproduce the picture in chromos or in any other form of colour painting to be vested in you for the term of two years," and on certain other conditions absolutely. It is questionable, however, whether this was not an assignment of part of the copyright.

Register.

By the 4th section it is declared that a book of registry shall be kept at Stationers' Hall, entitled 'The Register of Proprietors of Copyright in Paintings, Drawings, and Photographs,' in which shall be entered a memorandum of every copyright to which any person shall be entitled under this Act (a), and also of every subsequent assignment; and that such memorandum shall contain a statement of the date of the agreement or assignment, and of the name and place of abode of the person in whom such copyright shall be vested, and also of the author of the work, together with a short description of the subject of the work; and, if the person registering shall so desire, a sketch, outline, or photograph of the work.

It has been doubted whether in this memorandum of registration "abode" is sufficiently described by giving the place of business (b).

How to be registered.

It is not a valid objection that the registration does not give such a description of the work as may enable a person from it alone to ascertain whether he is about to sell the copy of a registered work, for that knowledge may be gained from other sources, and the object of the legislature, as pointed out by the statute, is that there shall be such a description of the picture as to enable a person who has it before him to judge whether or not the registration applies to the one he is about to copy. This was decided in 1868. Mr. Henry Graves, being the proprietor of the copyright in two paintings in oil and in a photograph, entered them

(a) See *London Printing and Publishing Alliance, Limited v. Cox*, [1891] 3 Ch. 291; 60 L. J. Ch. 707; 65 L. T. 60; 7 T. L. R. 738.

(b) *Per* Field, J., in *Nottage v. Jackson*, 11 Q. B. D. 627; 52 L. J. Q. B. 769; 32 W. R. 106; 49 L. T. 339. The judgment of Field, J., is given in the *Law Journal and Law Times Reports*.

under this section, thus: "Painting in oil, 'Ordered on Foreign Service;' painting in oil, 'My First Sermon;' photograph, 'My Second Sermon.'" The first picture represented an officer taking leave of a lady; the second, a young child sitting in a pew, apparently listening with her eyes wide open; the photograph represented the same child asleep in a pew; and it was considered that the nature and subject of the works were sufficiently described under this section. "If we consider it as a question of fact," observed Mr. Justice Blackburn, "there can be no reasonable doubt that the description of each of the pictures is sufficient. The picture, 'Ordered on Foreign Service,' represents an officer who is ordered abroad, taking leave of a lady, and no one can doubt that is the picture intended. So again 'My First Sermon' describes with sufficient exactness a child, impressed with the novelty of her situation, sitting in a pew, and listening with her eyes open; while the same child, fast asleep in a pew, forms the subject of 'My Second Sermon.' Who can doubt that in each of these cases the description is sufficient? There may be a few instances in which the mere registration of the name of the picture is not sufficient; for instance, Sir E. Landseer's picture of a Newfoundland dog might possibly be insufficiently registered under the description of 'A distinguished Member of the Humane Society.' Similarly, the well-known picture called 'A Piper and a Pair of Nutcrackers,' representing a bullfinch and a pair of squirrels, might not be accurately pointed out by its name. In either of those cases the names would scarcely be sufficient, and it would be advisable for a person proposing to register them to add a sketch or outline of the work. But when the subject is indicated, as it is here, it seems to be merely a question of fact whether the description affords enough information, and I cannot doubt that it does" (a).

It is further enacted by the 4th section that no pro-

Benefit of Act
cannot be

(a) *Ex parte Beal*, Law Rep. 3 Q. B. 387; 37 L. J. (Q.B.) 161; S. C. 18 L. T. (N.S.) 285.

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 claimed until
 after regis-
 tration.

prietor of any copyright shall be entitled to the benefit of this Act until such registration, and no action shall be sustainable nor any penalty be recoverable in respect of anything done before registration.

In a recent case *Lopes, L.J.*, expressed an opinion that by this section the proprietor of the copyright was with regard to the right to recover damages and penalties placed until registration in the same position as if he had no copyright; and that the making of the copies before registration and the sale of these copies after registration were so connected together that the proprietor of the copyright could not recover either damages or penalties in respect of the sale. Lord Esher, M.R., and Lindley, L.J., however, were of opinion that though by reason of the section the proprietor of the copyright could not recover damages for the making of the unauthorized copies before the registration, they were entitled to damages for the sale of these copies after the registration, but that the proprietor of the copyright could not recover *penalties* in respect of the sale of such copies after registration (a).

In the case referred to the plaintiffs were art publishers, and were assignees of the copyright in a water-colour drawing entitled 'Sounding the Charge.' In Jan., 1884, the plaintiffs employed the defendant, who was a printer carrying on business in Berlin, to produce 2,000 copies of the drawing. The defendant executed the order, but also produced a number of copies on his own account without the knowledge of the plaintiffs, and some of the copies so produced were imported into England afterwards. On Jan. 21st, 1886, the plaintiffs registered their copyright in the drawing. After such registration the defendant sold copies in England, and the plaintiffs then commenced an action claiming penalties under sect. 6 and damages under sect. 11 of the Copyright Act, 1862. It

(a) *Tuck & Sons v. Priester*, 19 Q. B. D. 48, 629; 57 L. T. 110; 19 Q. B. D. 629; 56 L. J. Q. B. 553; 36 W. R. 93 (C.A.); S. C. *Tuck & Sons v. The Continental Printing Co.*, 3 T. L. R. 150, 661, 826; *Troitze v. Rees*, W. N. (1887) 150; 3 T. L. R. 773.

was held that the statute gave no remedy for infringement of common law right, and by sect. 4 the plaintiffs were not entitled to recover in respect of anything done before registration, and that the sale after registration of copies made and imported before registration was not unlawful so as to give a right of action. In the court of first instance, Mr. Justice Day held that the case did not come within the words "knowing that any such repetition, copy, or other imitation has been unlawfully made" in sect. 6, and from this there was an appeal to the Queen's Bench Division.

On this appeal the view of Mr. Justice Day was confirmed by Mr. Justice Grove and Mr. Justice Denman, the former saying, with reference to sect. 4, "The clause shews that nothing can be claimed for any act done before registration: otherwise the section would give a penalty *ex post facto* for doing that which was lawful when it was done, that is, before registration. If a proprietor of copyright can delay registration, and allow the public to have the free use of his drawing, and allow tradesmen to reproduce it, and exhibit it for sale, and invest their money in it, and can then register it, and say that such reproduction has now become unlawful, and can bring an action for damages under sect. 11, and enforce delivery of all copies, and can also sue for penalties under sect. 6, and claim that all copies be forfeited, the effect would be to encourage what might be a gross fraud, and what certainly would amount to gross negligence on the part of such proprietor. My only doubt has been whether a person who has made copies lawfully before registration could afterwards sell them, when the copyright has been registered in the meanwhile; but I think the word 'sell' in sect. 11 goes with the other words, and that the sale which is prohibited must be a sale of something that was unlawfully made. These copies were not unlawfully made, for no consent was required at the time when they were made, because there had been then no registration, and therefore the defendant did not sell copies made without the consent of the pro-

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prietor within the meaning of the Act, because when the copies were made such consent was not required, and therefore it was not unlawful to sell such copies. I confess I have no sympathy with the defendant, but we must construe the Act of Parliament according to what we consider to be its true meaning ; and, for the reasons I have given, I am of opinion that what the defendant has done was not legally wrong, and therefore he is entitled to judgment.

“The action was brought to recover penalties and damages within the meaning of the Act. The statement of claim does not claim in respect of common law right, or a right under any other Act, but under this Act (a). There was no necessity to register before the passing of this Act, and here nothing was proved to have been done after registration except the sale. The plaintiffs' claim is founded entirely on the statute, and if they fail to shew that the case comes within the statute, they cannot recover either penalties or damages. The sale here was a sale of copies which, so far as the Act goes, were lawfully made, having been made before registration, and therefore the case does not come within the Act, and the defendant is entitled to judgment”

The Court of Appeal reversed the decision of the Divisional Court, and the Master of the Rolls in delivering judgment said : “The question was whether a person might sell after registration copies made before registration. The proprietor of the copyright could not sue in respect of the making of copies before registration. But he could sue for the sale of the copies so made, as copyright existed at the time when the copies were made (*sic*). The word ‘unlawful’ meant without the consent of the proprietor. Therefore every proprietor of a work which was pirated before registration could bring an action for a sale or other wrong committed after registration. Accordingly both under the general law and under the statute the plaintiffs were entitled to an injunction and

(a) 25 & 26 Vict. c. 68.

the damages. As to whether the plaintiffs were entitled to penalties different considerations arose."

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The 4th section, though it prevents an assignee from suing for penalties, before the assignment to him has been registered (a), does not render it necessary that all or any previous assignment should also be registered, or that the copyright of the original author should be registered (b). Registration of the proprietorship of the copyright is only *prima facie* evidence of title, and may be rebutted by the terms of the assignment of the copyright to the person who has made the registration (c).

The enactments of the 5 & 6 Vict. c. 45, in relation to the registry thereby prescribed, are applicable to the registry under the 25 & 26 Vict. c. 68, except that the forms of entry prescribed by the earlier Act may be varied under the latter to meet the circumstances of any case (d). Consequently, the making of false and fraudulent entries of proprietorship of copyright for any purpose, either to acquire property in such copyright or to improperly restrain the publication or copying of works in which no copyright lawfully exists, is a misdemeanour. And the person aggrieved may apply to the court or a judge to obtain an order for the cancellation or substitution of names so inserted (e).

(a) *Dupuy v. Dilkes*, W. N. (1879) 145; 48 L. J. Ch. 682. 'The Young Cricketer.'

(b) *Re Walker & Graves*, 20 L. T. (N.S.) Q. B. 877; L. R. 4 Q. B. 715; *Troitzsch v. Rees*, W. N. (1887) 150; 3 T. L. R. 773.

(c) *Lucas v. Cooke*, 13 Ch. Div. 872. 'Going to Work.'

(d) The Royal Commissioners in their report on Copyright, in 1878, recommended that registration of paintings and drawings should not be insisted on as long as the property in the picture and the copyright were vested in the same person, but that if the copyright were separated by agreement from the property in the picture, there should be compulsory registration, and that the register should shew—

(a) The date of the agreement.

(b) The names of the parties thereto.

(c) The names and places of abode of the artist, and of the person in whom the copyright is vested.

(d) A short description of the nature and subject of the work, and, if the person registering so desires, a sketch, outline, or photograph of the work in addition thereto.

As to engravings, prints, and photographs, however, they thought registration should be compulsory.

(e) *Chappell v. Purday*, 12 M. & W. 303.

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Aggrieved
person.

A person who has been convicted of infringing the copyright in certain paintings and photographs of the registered proprietor, but who sets up no title in himself or adduces any evidence to rebut the *prima facie* evidence of proprietorship afforded by the book of registry, is not a person "aggrieved" within the meaning of this or the 14th section of the 5 & 6 Vict. c. 45.

"A person," said Hannen, J. (a), "to be 'aggrieved' within the meaning of the statute must shew that the entry is inconsistent with some right that he sets up in himself or in some other person, or that the entry would really interfere with some intended action on the part of the person making the application."

"It seems," said Blackburn, J., in the same case, "that to make a person aggrieved within the meaning of the statute, the applicant must have some substantial objection, and one going to the merits of the registered proprietor's title; then the court may direct an issue, or have the question otherwise disposed of, or, if they think this the proper course, may set aside or expunge the entry. But I do not think it is enough to entitle a person to say that he is aggrieved, and that the entry ought to be expunged, that, although the registered proprietor has a complete title in equity and in good sense, yet there is some slip either in the signing of the memorandum or in the spelling of a name; this would be my view if it were necessary to decide this question."

Expunging
entry in
register.

An application under the 14th section was made to the High Court of Justice, Queen's Bench Division, in February, 1876, for an order to expunge from the register the entry of the copyright of the well-known picture called 'The Roll Call,' painted by Miss Elizabeth Thompson, who, by an agreement dated the 11th of May, 1874, had sold the copyright to Messrs. Dickinson & Co. for the sum of £1200. It appeared that the copyright was not, in fact, vested in Miss Thompson, and she had no right to assign it. She

(a) *Graves's case*, L. R. 4 Q. B. 724 ; 20 L. T. (N.S.) 877.

had painted the picture on commission for a gentleman named Galloway, who had paid her £100 in advance. There was no contest as to the ownership of the copyright; it was conceded that Mr. Galloway held it. He had parted with the picture to the Queen for the same price he himself had paid for it, but as this did not carry the copyright, it still remained in Mr. Galloway. Mr. Galloway did not oppose the application, and an order to expunge the entries so as not to affect the rights to the copyright was made.

There is no appeal to a Divisional Court from an order expunging an entry made by a Vacation Judge sitting as a Divisional Court (a), and probably no appeal at all.

Invasion of the property is guarded against by the 6th section, which provides that if the author, after having sold or disposed of the copyright, or if any other person not being the proprietor for the time being of the copyright, shall repeat, copy, colourably imitate, or otherwise multiply for sale, hire, exhibition, or distribution, or cause or procure to be repeated, copied, imitated, or otherwise multiplied for sale, hire, exhibition, or distribution, any such work or the design thereof, or knowing that any such repetition (b), copy or other imitation has been unlawfully made, shall import into the United Kingdom, or sell, publish, let to hire, exhibit or distribute, or offer for sale, hire, exhibition, or distribution, or cause or procure to be imported, sold, published, let to hire, distributed or offered for sale, hire, exhibition, or distribution any repetition, copy, or imitation of the said work, or of the design thereof, such person, for every such offence, shall forfeit to the proprietor of the copyright for the time being a sum not exceeding £10: and all such repetitions, copies, and imitations, and all negatives of photographs made for the

Infringement
of the right,
and penalties
attached
thereto.

(a) *In the matter of the registration of a picture, 'The Young Duchess,' under the Art Copyright Act, 1862, 8 T. L. R. 41.*

(b) *Actus non facit reum, nisi mens sit rea (Reg. v. Sleep, 8 Cox, C. C. 472; Reg. v. Cohen, ibid. 41; Hearn v. Garton, 28 L. J. (M.C.) 216); as to the licence required to copy photographs, see Strahan v. Graham, 16 L. T. (N.S.) 87; 17 L. T. (N.S.) 457.*

purpose of obtaining such copies, shall be forfeited to the proprietor of the copyright.

Under this clause, where the subject of a picture is copied, it is of no consequence whether that is done directly from the picture itself or through intervening copies; if, in result, that which is produced be an imitation of the picture, then it is immaterial whether that be arrived at directly or by intermediate steps. A copy, therefore, from an intervening copy is a copy from the original work, and within the prohibitory clauses of the statute. Nor does the copying refer merely to the imitation of a painting by a painting, or drawing by a drawing, or a photograph by a photograph, so that a photograph of a drawing, or a drawing of a painting, protected by the Act, would be a piracy. For, on inspecting the 1st section, which is the key to the whole Act, it gives to the author of every original painting, drawing, or photograph the sole and exclusive right of copying, engraving, reproducing, and multiplying such painting or drawing and the design thereof, or such photograph and the negative thereof, by any means and of any size; and the terms used are so extensive that it is plain that a photograph of a painting, of a drawing, or of another photograph made without the consent of the owner, though of a different size, provided it be a reproduction of the design, is an infringement such as would subject the maker to the penalty.

Thus where a man had a drawing of his wife made, having attached to her arm and dress a dress-holder, a patented invention of his own, and substituted for his wife's head that of the Princess of Wales, taken from a photograph, the copyright in which belonged to the plaintiff, and from the combination so obtained made and printed cabinet-size photographs for the purpose of advertising his invention, that was held to be an infringement (a). The body in the defendant's photograph was stouter than that of the Princess in the plaintiff's photo-

(a) *The London Stereoscopic and Photographic Co., Limited v. Kelly and others*, 5 T. L. R. 169.

graph, and the pose and dress were different, and, in fact, the only points of similarity between the two photographs were the head, bonnet, and necktie of the Princess, and the position of the right arm, the whole of the remainder of the defendant's photograph being taken from his wife.

Before the existence of statutory copyright in paintings, it was held by the Irish Chancery Court, that the owner's common law rights in a painting were not prejudiced by his public exhibition of it. The case referred to is *Turner v. Robinson (a)*. The defendant was charged with piracy in having made for sale copies of a painting representing the death of Chatterton. He denied direct copying, but admitted that he had seen the original while on exhibition, and said that he had made his photograph from an arrangement of figures, objects, and scenery which he had prepared in his own gallery. He further admitted that he had made the arrangement from his recollection of the painting, and with a view of presenting a stereoscopic photograph of the same representation as that given by the painting. The Court declared this to be an unlawful use of the plaintiff's property.

“If there was no statute protecting copyright in literary works,” said the Master of the Rolls, “and Sir Walter Scott had read out ‘Waverley’ to a large party of friends, it is idle to say that such would have amounted to a publication, so as to have deprived him of his common law right; and the painter or the owner of a painting who exhibits it at such exhibitions as those of London, Dublin, and Manchester, and, having regard to the object of such exhibitions, should be considered as allowing it to be viewed by the public on the tacit understanding that an improper advantage would not be taken of the privilege thus granted; and I am disposed to think, without reference to the letters I have read, that such an exhibition would not be a publication so as to deprive a painter or the owner of a painting of his common law right.” And

(a) 10 Ir. Ch. 121, 510.

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upon the other point, upon appeal, the Lord Justice of Appeal said: "The stereoscopic slides are not photographs taken directly from the picture, in the ordinary mode of copying: but they are photographic pictures of a model itself copied from, and accurately imitating in its design and outline, the petitioner's painting. It is through this medium that the photograph has been made a perfect representation of the painting. Thus the object contrived and achieved, and the consequent injury, are the very same as if the ~~copy~~ copy had, in breach of confidence, been made on the view, and by the eye; and no court of justice can admit that an act illegal in itself can be justified by a novel or circuitous mode of effecting it. If it is illegal, so must the contrivance be by means of which it was effected."

In one case (a) it was contended that a photograph of an engraving was not an original production within the meaning of the Act. In overruling this objection, Mr. Justice Blackburn said: "The distinction between an original painting and its copy is well understood, but it is difficult to say what is meant by an original photograph. All photographs are copies of some object, such as a painting or a statue, and it seems to me that a photograph taken from a picture is an original photograph, in so far that to copy it is an infringement of this statute. As I have already pointed out, by section 2, although it is unlawful to copy a photograph or the negative, it is permitted to copy the subject-matter of the photograph by taking another photograph."

Absence of
artistic merit.

The question of artistic merit is sometimes taken into consideration where at least there is not an exact reproduction. Thus where a plaintiff conceived the idea of printing and publishing cards bearing a representation of a hand holding a pencil in the act of completing a cross within a square, with a view to such cards being used at elections by illiterate voters, and

(a) *Graves's case*, L. R. 4 Q. B. 723.

procured an artist to make, under his directions, a drawing of the representation above described, and subsequently to the registration (which on other grounds was held to be bad) the defendants published similar cards with a hand, holding a pencil, in the act of completing a cross in a particular square of a voting paper, but the hand in the defendant's cards was in a slightly different position, though the idea was clearly taken from the plaintiff's cards; and it appeared that neither the plaintiff's nor the defendants' drawings were of any artistic merit, it was held that an action for infringement of copyright could not be maintained, on the ground that the plaintiff's drawing was so far not the subject of copyright that it was not entitled to protection against an imitation which was not an exact reproduction (a). It is clear that, in the opinion of Lord Justice Bowen, in *Nottage v. Jackson* (b), the statute relates only to works of art of some sort or other. He considered, to put his opinion in the language of Mr. Justice Wills, in the subsequent case of *Kenrick & Co. v. Laurence & Co.* (c), that it was the product of the artistic faculty that was intended to be primarily, at all events, the subject of copyright—the thing to be protected by the Act.

This point, which is of considerable importance, was fully treated by Mr. Justice Wills. He says (d): "The mere choice of subject can rarely, if ever, confer upon the author of the drawing an exclusive right to represent the subject; and certainly, where the subject chosen is merely the representation to the eye of a simple operation which must be performed by every person who records a vote, there cannot possibly be an exclusive right to represent in a picture that operation. It may well be that something special in the way of artistic treatment even of this simple operation, if it existed, might be the subject of

(a) *Kenrick & Co. v. Laurence & Co.*, 25 Q. B. D. 99; 38 W. R. 779.

(b) 11 Q. B. D. 627.

(c) 25 Q. B. D. 99, 104.

(d) 25 Q. B. D. 99, 102.

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copyright; but nothing of the kind has been suggested or exists in the present case, and if it does exist without being discovered it has not been imitated, for there is nothing which by any flight of imagination can be called artistic about either the plaintiffs' or the defendants' representation of a hand making the mark of a cross. It may be also that even the coarsest, or the most commonplace, or the most mechanical representation of the commonest object is so far protected in registration that an exact reproduction of it, such as photography for instance would produce, would be an infringement of copyright. But in such a case it must surely be nothing short of an exact literal reproduction of the drawing registered that can constitute the infringement, for there seems to be in such a case nothing else that is not the common property of all the world. It is possible that in this case the proprietors of the drawing may have a right to be protected from a reproduction of their picture of a hand drawing a cross, in which every line, dot, measurement, and blank space shall be rendered exactly as in the original, or in which the variations from such minute agreement shall be microscopic. But I cannot possibly see how they can make a higher claim, or say that because they have registered a drawing of a hand pencilling a cross within a square, that no other person in the United Kingdom is at liberty to draw a hand pencilling a cross within a square for perhaps the next half century. The plaintiff, Mr. Jefferson, put his case as high as that proposition, for he said he might wish to claim applications of the picture to subjects other than voting cards. It is obvious that, unless there be a copyright in the *subject*, any other person who wishes to draw a hand pencilling a cross within a square, cannot help producing something so like the plaintiffs' design as to look very like a colourable imitation of it. Now, it may or may not be very shabby conduct on the part of the defendant to wish to represent a hand pencilling a cross within a square, notwithstanding that the plaintiffs were first in the field, and notwith-

standing that but for the picture used by the plaintiffs they might never have thought of making theirs; but I cannot see why they should be precluded, for the next fifty years perhaps, from representing in a picture the act which every voter performs when he records his vote, simply because one of the plaintiffs first thought of doing so, any more than if a new article of commerce were introduced of extensive distribution, and very simple and definite shape and proportions, and a drawing of it were made for one firm, all other persons should be precluded from making a drawing which, if it truthfully represented the same thing, must be exceedingly like the first drawing; nor, even though the draughtsman of the second drawing might never have seen the original article, or might have derived his knowledge of its existence and aspect solely from the first drawing. If a new and very simple tea-caddy were represented first by A. in a drawing which he registered, I cannot conceive that he could during his whole life prevent B. from drawing the same tea-caddy, and even from drawing it from his recollection of A.'s picture, nor that A. could claim copyright except in the extremely limited and useless sense in which I have suggested that a copyright might exist for a registered drawing of even such a subject. In the present instance, what the plaintiffs claim is really a right to prevent anyone else from drawing the same subject as that of his drawing. If he has a copyright in the *subject* there is a colourable imitation, because the subject is not altered by changing the position of the hand and adding the indications of a shirt-sleeve. But it is clear that there is no copyright in the subject. As for the manner of treating the subject, there can be no copyright in that, for if the thing to be represented be represented at all it is impossible to treat it in any other way. It seems to me, therefore, that although every drawing of whatever kind may be entitled to registration, the degree and kind of protection given must vary greatly with the character of the drawing, and that with such a drawing as we are

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dealing with, the copyright must be confined to that which is special to the individual drawing over and above the idea—in other words, the copyright is of the extremely limited character which I have endeavoured to describe. A square *can* only be drawn as a square, a cross *can* only be drawn as a cross, and for such purposes as the plaintiffs' drawing was intended to fulfil there are scarcely more ways than one of drawing a pencil or the hand that holds it. If the particular arrangement of square, cross, hand, or pencil be relied upon, it is nothing more than a claim of copyright for the *subject*, which, in my opinion, cannot possibly be supported."

The penalties
cumulative.

The offending individual is liable to the penalty for every copy sold. Thus, where twenty-six copies were disposed of in two parcels of thirteen copies each, it was held that the penalty was properly imposed on every copy sold. "In the case of *Brooke v. Milliken (a)*," says Mr. Justice Blackburn, in *Beal's Case (b)*, to which we have already referred, "the penalty was imposed by 12 Geo. 3, c. 36, for importing for sale any book first published in this kingdom and reprinted in any other place, and it enacted that the offender should forfeit £5, and double the value of every book sold. In that case there could be no doubt that the meaning of the statute was, the penalty should be cumulative, viz., double the value of each book. In the present case the words are, 'such person for every such offence shall forfeit to the proprietor of the copyright for the time being a sum not exceeding £10.' It is quite clear that this imposes a penalty for every copy sold; a different construction would result in an absurdity, and defeat the intention of the legislature. The penalty is imposed also for importation, and it would be monstrous, that if a man had consigned from abroad a cargo of imitations, the utmost penalty that could be imposed on him would be the sum of £10. It would be well worth his while to run the risk of paying

(a) 3 T. R. 509.

(b) Law Rep. 3 Q. B. 395.

that small sum, and to import and distribute for sale elsewhere a quantity worth many thousands. The legislature were dealing with an offence which was likely to be committed wholesale, and they have used words meaning that the sale of every copy shall be an offence, and if ten copies be sold at one time, ten offences are committed, and the offender may be punished for each separately."

The provision as to forfeiture of piratical copies is almost nugatory, as the Act gives no power to enter a house and search for copies. One case was brought before the Royal Commissioners appointed to report on the subject of Copyright in 1878, where a conviction for selling piratical copies having been obtained, the magistrate had made an order that the copies should be delivered up, but it was found that the order could not be enforced.

The Commissioners further suggested that these provisions should be extended to sculpture and other works of fine art.

In an action for infringement of copyright in a picture the production of the original is not essential to the proof of the plaintiff's case (*a*); were this necessary many cases of infringement would go unpunished, as often the proprietorship of the copyright is in one, and the possession of the picture is vested in another, who could not be compelled to produce the same, and indeed in some cases the picture might be abroad or even have been destroyed.

The point came before the court in the case of the painting called 'The Peacemaker.' The plaintiff was the registered proprietor of the copyright in this painting, which had been executed by Marcus Stone, R.A., and he claimed damages by reason of the defendants having sold, published, exhibited, and distributed, or offered for sale, publication, exhibition and distribution copies of the painting made without the plaintiff's consent, and an injunction to restrain the defendants from further infring-

Provisions as to forfeiture of piratical copies.

The production of the original picture not necessary in action for infringement.

(a) *Lucas v. Williams and others*, 8 T. L. R. 575 ; [1892] 2 Q. B. 113.

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ing his copyright. At the trial the following evidence in support of the plaintiff's case was given: It was proved that a photograph of the picture called 'The Peacemaker' was sold by the defendants, who were furniture dealers. At the time the photograph was sold, a card was attached with the words "Painted by Marcus Stone, R.A." upon it. The plaintiff did not produce the original painting, but he produced an engraving of it belonging to himself which he said was made by a well-known engraver, under Mr. Marcus Stone's immediate supervision, and was an exact copy of the original painting. He also produced the photograph sold by the defendants, and said, that it was a bad photograph taken directly from the engraving. He also said, that he knew the original painting, which was formerly in his possession, and had never been out of it until it went to Australia. The defendant submitted that the original painting not having been produced, there was no evidence for the jury that the photograph sold by the defendants was a copy of it. The case was left to the jury, who found for the plaintiff, and the defendant appealed. The Court of Appeal affirmed the decision of the court below, Lord Esher, M.R., saying: "In this case there is only one point of any importance. It was urged by the defendant's counsel that there was no evidence for the jury of an infringement of the plaintiff's copyright, because the original picture was not produced. The question is, whether in an action for infringement of copyright, where the issue is whether or not that which the defendant has sold is a copy of the picture in respect of which the artist who copied it has copyright, it is necessary to produce the original. Here the picture which the defendants sold was produced, and the issue was, Is it an imitation of the picture which Mr. Marcus Stone painted? It is said that you cannot prove that the picture which the defendants sold was such an imitation without producing the original picture. That you may produce the original picture, and put it and the alleged copy before the jury, and ask them to use their own eyes and come to a conclusion

whether the picture sold is a copy of the original picture or not, is undoubted. In actions for the piracy of trade-marks, it is the constant practice to produce the plaintiff's trade-mark and the mark which is said to be an imitation of it, and ask the judge or jury to compare the two, and see whether the one is not an imitation of the other. To produce the original picture and the alleged copy, so that the jury may compare the two, may be the most satisfactory evidence of imitation, but it does not follow that it is the only evidence of it which can be given, nor does it follow that the evidence which was given in this case is only secondary evidence. 'Primary' and 'secondary' evidence mean this: primary evidence is evidence which the law requires to be given first; secondary evidence is evidence in the absence of the better evidence which the law requires to be given first, when a proper explanation is given of the absence of that better evidence. Take the case of proof of a man's handwriting: a witness is called who says, 'I have seen A. B. write, and I know his handwriting. The document produced I declare is in his handwriting, because the writing in it is exactly like his.' That kind of evidence is given every day. What difference is there in principle between a man's handwriting and a picture which he paints? The witness says, 'Looking at the picture which the defendants sold, I say it is exactly like Mr. Marcus Stone's picture.' When he is asked, 'How do you know that?' he answers, 'Because I have seen Mr. Marcus Stone's picture.' That is not secondary evidence, but original evidence. Different kinds of evidence may be used to prove the same fact, and this is another way of proving the fact that the picture which the defendants sold is a copy of the original picture in respect of which there is copyright. If the jury were not satisfied, it would be open to them to say, 'You could have produced better evidence; you have not produced the original picture; we will not act upon this evidence, though it is legal evidence. There is another question which may arise some day.

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Suppose neither the alleged copy nor the original picture were produced. It is not necessary to decide the point, and I do not decide it; but I am not prepared to say that the infringement could not be proved by calling a witness to say that he knew the original picture, and had seen the picture which was alleged to be a copy of it, and they were both exactly alike. In the same way, when it is necessary to prove that a man was at a particular place on a given day, you call a witness to say that he knows A. B., and that the man he saw at such a place on such a day was A. B. That evidence is enough without producing A. B. There was more proof in the present case, because on one of the pictures sold by the defendants were the words 'Painted by Marcus Stone, R.A.,' which is some evidence of an admission by the defendants, that the picture which they sold was a copy of the picture painted by that artist. In either view, therefore, I am clearly of opinion that there was evidence for the jury that the picture which the defendants sold was a copy of the original picture in respect of which the plaintiff had copyright" (a).

Provisions for repressing the commission of fraud in the production and sale of works of art.

The 7th section imposes penalties on every person doing or causing to be done any of the following acts:

1st. If he shall fraudulently sign or otherwise affix, or cause to be signed or otherwise affixed, to any painting, drawing, or photograph, or the negative thereof, any name, initials, or monogram.

This clause was rendered necessary by the decision in the case of *The Queen v. Close* (b). A picture had been painted by Mr. Linnell, who signed and sold it for £180. The prisoner was a picture dealer, and was indicted for fraudulently selling a copy of Linnell's picture as and for the genuine picture which he had painted. Mr. Linnell's name was likewise painted on such copy, which the prisoner sold for £130. The indictment contained three counts: the first charged the prisoner with obtaining money under false pretences, but upon this count he was acquitted; the

(a) *Lucas v. Williams & Sons* [1892], 2 Q. B. 113.

(b) 27 L. J. (M.C.) 54; 7 Cox, C. C. 494; 6 W. R. 109.

second count charged him with a *cheat* at common law (a), by means of writing Linnell's name upon the copy; and the third count charged the prisoner with a *cheat* by means of a forgery of Linnell's name upon the copy. Upon these last two counts the prisoner was convicted; but his counsel objecting, that they disclosed no indictable offence at common law, the judgment was respited in order that the opinion of the Criminal Court of Appeal might be taken upon the objection so raised. The case was afterwards argued before five judges, who formed such court of appeal, and they unanimously held that the conviction was *wrong*; that there was no forgery; that "forgery must be of some document or writing," and Linnell's name in this case must be looked at merely as in the nature of an arbitrary mark made by the master to identify his own work, and was no more than if the painter had put any other arbitrary mark made by him, as a recognition of the picture being his. As to the second count of the indictment, the court held that the conviction could not be sustained, because it did not sufficiently shew that the prisoner sold the copy by *means* of Linnell's signature being forged upon it.

2nd. If he shall fraudulently sell, publish, exhibit, or dispose of, or offer for sale, exhibition or distribution, any painting, &c., having thereon the name, initials, or monogram of a person who did not execute such work.

3rd. If he shall fraudulently utter or dispose of any copy or colourable imitation of any painting, drawing, or photograph, or negative of a photograph, whether there shall be subsisting copyright therein or not, as having been executed by the author of the original work from which such copy or imitation shall have been made.

4th. If, where the author of any painting, drawing, or photograph, or negative of a photograph, shall have sold such work, any person shall afterwards make any alteration by addition or otherwise during the life of the author,

(a) *Albin's Case*, Tremaine, P. C. 109; *Worrall's Case*, *ibid.* 106; 2 East, P. C. 18, cited 2 Russell on Crimes, 282.

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without his consent, or shall knowingly sell (a) or publish such work, or any copies thereof so altered, or of any part thereof, as or for the unaltered work of such author.

This clause is intended to prevent the alterations so frequently made in the works of great artists for fraudulent purposes. Mr. Charles Landseer stated a most glaring case in his evidence before a committee appointed by the Society of Arts. It appears that he painted a picture called the 'Eve of the Battle of Edgehill,' in which he introduced two dogs, which had been touched up by his brother Sir Edwin, and, as he himself admitted, greatly improved. The picture was sold to a dealer, who cut out the figures of the dogs and sold them as the work of Sir Edwin Landseer, and he then filled up the hole in the original picture with two dogs painted by an inferior artist, and sold the whole picture as the work of Mr. Charles Landseer.

Every offender under this section shall forfeit to the person aggrieved a sum not exceeding £10, or not exceeding double the full price at which all such copies or altered works shall have been sold or offered for sale; and they shall be forfeited to the person, or the assigns, or legal representatives of the person whose name, initials, or monogram shall have been fraudulently used; provided such person shall have been living at or within twenty years next before the time when the offence may have been committed.

It would seem that if the double price of the copies be less than £10, yet that amount may still be recovered, and that if the double value exceed £10, then any sum up to such double price may be recovered by the person aggrieved, as an inducement to him to proceed, he having to give up the spurious work to the true artist or his representatives, and receive from the person who has defrauded him the price he has paid and as much more.

(a) Unless the person selling were cognizant of the fact of alteration the Act would be an entirely innocent one. See *Reg. v. Sleep*, 8 Cox, C. C. 472; *Reg. v. Cohen*, *ibid.* 41; *Hearne v. Garton*, 28 L. J. (M.C.) 216.

Under these penal sections it has been determined that a person sentenced to pay a penalty cannot, by executing a deed of arrangement with his creditors, escape from the imprisonment consequent on a failure to pay (a). Mr. Graves, the well-known publisher of engravings, became the proprietor of the copyright in Frith's 'Railway Station' and other paintings, and the designs thereof, and also in the copyright in the engravings of such pictures. Photographic copies of these engravings were then fraudulently made, and sold for about one-twentieth of the price at which the copies of Mr. Graves's prints were sold. Such photographic copies were exact reproductions of the engravings and of a large size. Upon the 16th of May, 1868, a man named William Banks Prince was convicted by a magistrate at Lambeth of having sold no less than nineteen of the fraudulent photographic copies in question. He was adjudged to pay a penalty of £5 in respect of each of the copies sold; and in default of payment the magistrate, under powers given him by the Small Penalties Act, 1865, sentenced Prince to fourteen days' imprisonment in respect of each of the nineteen offences he had committed by selling the photographic copies. While the magistrate was giving his judgment Prince executed a deed of composition with his creditors, which contained a release from them. That deed was assented to by certain creditors of Prince, and then registered in due form. Not having paid the penalties in which he was convicted he was taken into custody upon a magistrate's warrant, and imprisoned pursuant to his sentences. Thereupon he applied to the Bankruptcy Court for his discharge from custody, upon the ground that the penalties in which he had been convicted were *debts*, from the payment of which

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The penalties imposed as a punishment for a criminal offence.

(a) *Graves, Ex parte, In re Prince*, 19 L. T. (N.S.) 241; Law Rep. 3 Ch. 642; 16 W. R. 993; *Bancroft v. Mitchell*, Law Rep. 2 Q. B. 549. See, however, *Johnson, Ex parte, In re Johnson*, 15 W. R. 160; 15 L. T. (N.S.) 163; *Rex v. Stokes*, Cowp. 136; *Rex v. Wakefield*, 13 East. 190; *Rex v. Myers*, 1 T. R. 265. As to limitation of time of three months for action under the 8 Geo. 2, c. 13, not applying to an action on the case brought under 17 Geo. 3, c. 57, see *Graves v. Mercer*, 16 W. R. 790.

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he had been released by the deed of composition executed between him and his creditors. The registrar held that Prince was entitled to his discharge.

From this decision Mr. Graves appealed to the Lords Justices, upon the ground that penalties recovered under the Fine Arts Copyright Act, 1862, were in the nature of a punishment, and consequently were not released by the composition deed which had been executed between Prince and his creditors. On the contrary, it was argued for the respondent that, inasmuch as under the Fine Arts Copyright Act the penalties were payable to Mr. Graves, they amounted in the aggregate to nothing more than a debt, which would have been provable under bankruptcy, and was therefore released by the deed. But Lord Justice Page Wood held that what Prince had done in selling the photographic copies was throughout the Copyright Act treated as an offence, as a *fraudulent* act, for which a punishment was to be inflicted. The penalty provided by the Act was not meant to be the measure of damage sustained by the proprietor of the copyright work which had been pirated, because he was expressly permitted to recover damages by action (in addition to the penalties) under the 11th section of the Act. The object of the Small Penalties Act was merely to provide a simple method of enforcing the payment of penalties not exceeding £5. The penalty given by the Copyright Act was, in his Lordship's opinion, a punishment for what was in the nature of a criminal offence, and the debtor was therefore not entitled to his discharge from custody unless the penalties were paid. The Lord Justice Selwyn was also of opinion that whether the words or the spirit of the Copyright Act, under which the penalties had been incurred, were looked at, the order in bankruptcy was wrong, and must therefore be dismissed with costs.

By section 10 of the Act (a), the importing of piratical copies is expressly prohibited, and by the 11th section,

(a) *Tuck v. Priester*, 19 Q. B. D. 629, 645.

besides the penalties and forfeitures to which we have already referred, a remedy by action for damages is given to the injured owner of the copyright; no limitation as to time within which actions are to be brought is prescribed by the Act (*a*).

The provisions of the International Copyright Act, 1844, 7 & 8 Vict. c. 12, are extended to paintings, drawings and photographs, by section 12 of the Fine Arts Copyright Act, 1862 (*b*).

The Royal Commissioners in their Copyright report, 1878, felt some difficulty on the subject of photographs. They doubted whether the copyright should be assimilated to that in paintings and pass to a purchaser, or whether it should remain with the photographer. "When photographs," said they, "are taken with a view to copies being sold in large numbers, it is practically impossible that the copyright in the negative should pass to each purchaser of a copy, and it must remain with the photographer, or cease to exist. On the other hand, the same reasons exist for vesting the copyright of portraits in the purchaser or person for whom they are taken, as in the case of a painting.

"Indeed, considering the facility of multiplying copies, and the tendency among photographers to exhibit the portraits of distinguished persons in shop windows, it may be thought that there is even greater reason for giving the persons whose portraits are taken the control over the multiplication of copies than there is in the case of a painting. It therefore becomes a question whether it is not necessary to make that distinction between photographs that are portraits and those that are not, and between photographs taken on commission and those taken otherwise, which we have deprecated in the case of paintings. We suggest that the copyright in a photograph should belong to the proprietor of the negative, but in the case of photographs taken on commission, we

(*a*) 19 Q. B. D. 629.

(*b*) See Chap. on International Copyright, *post*.

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recommend that no copies be sold or exhibited without the sanction of the person who ordered them."

The Commissioners further thought that the same questions arose in respect of engravings, lithographs, prints, and similar works, and were of opinion that, so far as regards the transfer and vesting of the copyright, these arts should be placed upon the same basis as photographs.

Artists'
studies and
sketches.

In concluding their general report upon the fine arts they referred to a matter as to which artists say the law is disadvantageous to them. Before the artist paints a picture, he frequently finds it necessary to make a number of sketches or studies, which, grouped together, make up the picture in its finished state. These works may be studies expressly made for the picture about to be painted, or they may be sketches which have been made at various times, and kept as materials for future pictures. If after a picture is so composed, the copyright is sold, the artists are afraid that they are prevented from again using or selling the same studies and sketches, as they have been advised that such user or sale would be an infringement of the copyright they have sold (*a*).

The Commissioners doubted whether this fear was well-founded, but as the use of such studies and sketches as they had described could not, in their opinion, result in any real injury to the copyright owner, who has copies of them in his picture in a more or less altered shape, and combined with other independent work, they thought the doubt should be removed, and that the author of any work of fine art, even though he may have parted with the copyright therein, should be allowed to sell or use again his *bond fide* sketches and studies for such works and compositions, provided that he does not repeat or colourably imitate the design of the original work (*b*).

Replicas.

Where an artist has painted a picture on commission,

(*a*) The doubt exists by reason of the terms of the 6th section of the 25 & 26 Vict. c. 68.

(*b*) Par. 118—124.

as the copyright is in the commissioner, he may not paint a *replica*, but where this is not the case, and there is no agreement as to the copyright within the 25 & 26 Vict. c. 68, the artist is at liberty so to do.

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As to photographs, the copyright in non-commissioned works belongs to the photographer, if reserved in writing, and in commissioned works the negative and the glass on which it is, is usually considered to belong to the photographer, while the copyright belongs to the person who gives the commission.

Copyright in photographs and property in negatives.

The "author" of a photograph is the photographic artist who takes the negative, and not the person who employs him to do so and furnishes the apparatus. If such employer has entered himself on the register as author, the registration is void, because the copyright in that case endures during the life of a person other than the author (a).

Who is the "Author" of a Photograph.

Thus where A. and B. carried on business in copartnership as photographers, under the firm of the L. Company, and they did not take photographs themselves, but employed managers and a large staff of photographic artists and assistants, one of their managers, thinking that the photograph of the Australian cricketers would sell well, arranged for the photographs to be taken without any payment being made for taking them, and sent one of the artists in the employ of the firm to take the negative. From this negative the photograph was in the usual way produced, and sold by the firm in the ordinary course of business; and A. and B. registered themselves under the Fine Arts Copyright Act, 1862, in their individual names as the proprietors and authors of the photograph. In an action by the firm to restrain the pirating of their copyright in the photograph, it was held that A. and B. were not the authors of the photograph. According to the opinion expressed by the court the person who took

(a) *Nottage v. Jackson*, 11 Q. B. D. 627 ; 52 L. J. 760 ; 32 W. R. 106 ; 49 L. T. 339 ; *Burrow Giles Lithographic Co. v. Sarony*, 4 Davis's Rept. (Amer.) 53.

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the negative was the author. Two or more persons may be registered under the Act as the "authors" of a painting, or a drawing, or a photograph; but in such a case it has been doubted whether the copyright would subsist for the joint lives of the authors, and seven years afterwards, or for the lives and life of the survivors and survivor, and seven years afterwards.

Use photo-
grapher may
make of the
negative.

A photographer who has taken a negative likeness of a person to supply her with copies for money, will be restrained from selling or exhibiting copies, both on the ground that there was an implied contract not to use the negative for such purposes, and also on the ground that such sale or exhibition would be a breach of confidence (a).

In deciding the case last referred to Mr. Justice North said: "The question is whether a photographer who has been employed by a customer to take his or her portrait is justified in striking off copies of such photograph for his own use, and selling and disposing of them or publicly exhibiting them by way of advertisement or otherwise, without the authority of such customer, either express or implied. I say 'express or implied,' because a photographer is frequently allowed, on his own request, to take a photograph of a person under circumstances in which a subsequent sale by him must have been in the contemplation of both parties, though not actually mentioned. To the question thus put, my answer is in the negative, that a photographer is not justified in so doing. Where a person obtains information in the course of a confidential employment, the law does not permit him to make any improper use of the information so obtained; and an injunction is granted, if necessary, to restrain such use; as, for instance, to restrain a clerk from disclosing his master's accounts, or an attorney from making known his client's affairs, learned in the course of such employment. Again, the law is clear that a breach of contract,

(a) *Pollard v. Photographic Company*, 40 Ch. D. 345; 58 L. J. Ch. 251; 60 L. T. 418; 37 W. R. 266; 5 T. L. R. 157.

whether express or implied, can be restrained by injunction, and, in my opinion, the case of the photographer comes within the principles upon which both these classes of cases depend. The object for which he is employed and paid is to supply his customer with the required number of printed photographs of a given subject. For this purpose the negative is taken by the photographer on glass; and from this negative copies can be printed in much larger numbers than are generally required by the customer. The customer who sits for a negative thus puts the power of reproducing the object in the hands of the photographer; and, in my opinion, the photographer who uses the negative to produce other copies for his own use, without authority, is abusing the power confidentially placed in his hands merely for the purpose of supplying the customer; and further, I hold that the bargain between the customer and the photographer includes, by implication, an agreement that the prints taken from the negative are to be appropriated to the use of the customer only.

“The principles upon which I rest my judgment are well known, and of familiar application; and, though I am not aware that any case has been decided as to the negative of a photograph, there are many analogous cases in the books. In *Murray v. Heath* (a) the owner of some drawings employed the defendant to engrave plates from them, and the defendant, having done so, struck off some impressions from the plates before handing them over, which impressions his assignees sold after his bankruptcy. An action was brought by the owner of the drawings, founded on the Copyright Acts, and also in trover for the prints so struck. The action failed on both these heads, but Lord Tenterden said, in the course of his judgment, ‘The engraver having contracted to engrave the plate, and to appropriate the prints taken from it to the use of another, an action at common law would lie against him for the breach of that contract.’ And,

(a) 1 B. & Ad. 804.

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again, a little further on, 'As to the count in trover, that cannot be maintained unless the prints therein mentioned were the property of the plaintiff. But they were the property of Heath, who caused them to be taken from his own engraving, though he may be liable to an action for his breach of contract in not delivering all the prints so taken.' Such contract was not express, but was implied from the nature of the employment. Again, the recent case of *Tuck v. Priester* (a) is very much in point. The plaintiffs were the unregistered owners of the copyright in a picture, and employed the defendant to make a certain number of copies for them. He did so, and also made a number of other copies for himself, and offered them for sale in England at a lower price. The plaintiffs subsequently registered their copyright, and then brought an action against the defendant for an injunction, and for penalties and damages. The Lords Justices differed as to the application of the Copyright Acts to the case, but held unanimously that, independently of those Acts, the plaintiffs were entitled to an injunction, and damages for breach of contract. Lord Esher said (b), 'The plaintiffs entered into a written contract with the defendant by which the defendant undertook to make a specified number of copies of a picture which belonged to the plaintiffs, in order that the plaintiffs might be able to sell those copies for their own profit. The contract being a written one, it must be construed by the writing alone, and the plain honest meaning of it was this, "You are to make those copies for us, and then you are to return the picture to us, and you are not to make any other copies for your own benefit." That term was implied as plainly as anything could be. Instead of doing this, the defendant, after he had made the specified number of copies for the plaintiffs, made other copies of the picture for himself, with the intention of selling them for his own profit, and he sent a number of those copies to England

(a) 19 Q. B. D. 629.

(b) 19 Q. B. D. 635, 638.

with the intention of selling them there, and, what was worse, of selling them at a lower price than that at which the plaintiffs were selling theirs. That was a plain breach of contract, and under such circumstances I cannot doubt that, quite irrespective of the Act of 1862, a Court of Equity would grant an injunction and damages against the defendant.' The Master of the Rolls then stated his reasons for coming to the conclusion that an action would lie under the statute, and, after doing so, said: 'The plaintiffs, therefore, are entitled under the general law, by reason of the defendant's breach of contract, and of the trust reposed in him, to an injunction and damages, and they are entitled to the same injunction and damages under the statute.' Then Lord Justice Lindley says (a): 'I will deal first with the injunction, which stands, or may stand, on a totally different footing from either the penalties or the damages. It appears to me that the relation between the plaintiffs and the defendant was such that, whether the plaintiff had any copyright or not, the defendant has done that which renders him liable to an injunction. He was employed by the plaintiffs to make a certain number of copies of the picture, and that employment carried with it the necessary implication that the defendant was not to make more copies for himself, or to sell the additional copies in this country in competition with his employer. Such conduct on his part was a gross breach of contract and a gross breach of faith, and, in my judgment clearly entitles the plaintiffs to an injunction, whether they have a copyright in the picture or not.' That case is the more noticeable as the contract was in writing; and yet it was held to be an implied condition that the defendant should not make any copies for himself. The phrase 'a gross breach of faith,' used by Lord Justice Lindley in that case applies with equal force to the present, when a lady's feelings are shocked by finding that the photographer she has employed

(a) 19 Q. B. D. 638.

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to take her likeness for her own use is publicly exhibiting and selling copies thereof.

“It may be said that in the present case the property in the glass negative is in the defendant, and that he is only using his own property for a lawful purpose; but it is not a lawful purpose to employ it either in breach of faith, or in breach of contract. Again, in *Murray v. Heath* (a), the plates were the property of the defendant, for they had not been delivered to or accepted by the plaintiff. So, in the case of *Duke of Queensberry v. Shebbeare* (b), the defendant was restrained from publishing a work of the Earl of Clarendon, although a person had been expressly allowed by the owner to make and retain as his own a copy of the manuscript, which copy he had sold to the defendant. There, too, an agreement or condition was implied that the manuscript should not be published. Again, it is well known that a student may not publish a lecture to which he has been admitted, even though by his own skill he has taken a copy of it in shorthand; and the receiver of a letter may not publish it without the writer’s consent, though the property in the paper and the writing is in him; and many similar instances might be given.

“It may be said, also, that the cases to which I have referred are all cases in which there was some right of property infringed, based upon the recognition by the law of protection being due for the products of a man’s own skill or mental labour; whereas, in the present case the person photographed has done nothing to merit such protection, which is meant to prevent legal wrongs, and not mere sentimental grievances. But a person whose photograph is taken by a photographer is not thus deserted by the law; for the Act of 25 & 26 Vict. c. 68, s. 1, provides that when the negative of any photograph is made or executed for or on behalf of another person for a good or valuable consideration, the person making or

(a) 1 B. & Ad. 804.

(b) 2 Eden, 329.

executing the same shall not retain the copyright thereof, unless it is expressly reserved to him by agreement in writing, signed by the person for or on whose behalf the same is so made or executed; but the copyright shall belong to the person for or on whose behalf the same shall have been made or executed.

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CHAPTER XV.

COPYRIGHT IN DESIGNS.

Copyright in
designs.

CALICO-PRINTING, the art of dyeing woven fabrics of cotton with variegated figures and colours more or less permanent, has been practised from time immemorial in India. The art was known to the ancient Hindus and Egyptians. Pliny describes it with sufficient precision. "Robes and white veils are painted in Egypt," says he, "in a wonderful way; being first imbued, not with dyes, but with dye-absorbing drugs, by which they appear to be unaltered, but when plunged for a little in a cauldron of the boiling dye-stuff they are found to be painted. Since there is only one colour in the cauldron, it is marvellous to see many colours imparted to the robe in consequence of the modifying agency of the excipient drug. Nor can the dye be washed out. Thus the cauldron, which would of itself undoubtedly confuse the colours of cloths previously dyed, is made to impart several dyes from a single one, painting while it boils" (a).

Anderson, in his 'History of Commerce,' places the origin of English calico-printing as far back as the year 1676; but Mr. Thomson, a better authority, assigns the year 1696 as the date of the commencement of the practice of this art in England, when a small print-ground was established on the banks of the Thames, at Richmond, by a Frenchman.

Linen was long ago, and silks and woollen fabrics also have recently been, made the subject of topical dyeing, upon principles analogous to those of calico-printing, but with certain peculiarities arising from the nature of their textile materials.

(a) Pliny, 'Natural History,' lib. xxxv. c. 2.

The first Act granting protection to the inventor of designs was passed in 1787 (the 27 Geo. 3, c. 38). This Act was followed by the 29 Geo. 3, c. 19, and the 34 Geo. 3, c. 23. But these Acts did not extend to Ireland, nor to fabrics other than linen and cotton, and did not afford any protection to designs on fabrics composed of animal products, as wool, silk, or hair, or mixtures of those materials with flax and cotton. The printing on fabrics of animal and vegetable substances, and on mixed fabrics, having subsequently grown up into an important branch of manufacture, an Act of Parliament was introduced in 1839 (2 Vict. c. 13), by which the same protection was given to designs printed on fabrics of animal substances, or a mixture of animal and vegetable substances, as was afforded to designs printed on fabrics of vegetable substances; and the provisions of the existing Acts were extended to Ireland. In the same year, by the Act 2 Vict. c. 17, protection was given to proprietors of designs for articles of manufacture.

We followed the French in establishing any design rights at all; and it would be well if we adopted their simple, sensible arrangement for securing them.

In the early part of the last century the French entertained more correct notions of the rights of property in design than the British, and so convinced were they that great benefits would flow from rejecting the claim of the copyist to reap the original designer's profits, that, in 1737 and 1744, laws established a property in designs for the manufacturers of Lyons, and in 1787 the benefits of legal protection were fully established. The basis of the pre-eminence of the French, and the means by which they have attained their unrivalled position in *taste*, is *efficient protection*, and it is certainly singular that this fundamental element and primary cause of superiority should have been so long overlooked in this country.

Until the Act of 1883 we had in England two distinct rights, founded upon different Acts of Parliament, in the application of designs—copyright in the application of designs for ornamental purposes, and copyright in the

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The first Act for protection of designs.

Division of the right.

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application of designs for the shape and configuration of articles of utility.

The former was regulated by the 5 & 6 Vict. c. 100, amended by 6 & 7 Vict. c. 65, 13 & 14 Vict. c. 104, 21 & 22 Vict. c. 70, 24 & 25 Vict. c. 73, and 38 & 39 Vict. c. 93 (a).

Copyright in designs for ornamental purposes.

The 5 & 6 Vict. c. 100, repealed all the previous Designs Acts, and enacted that the proprietor of every new and original design not previously published (b), whether such design were applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural or partly artificial and partly natural, and whether such design were so applicable for the pattern or for the shape or configuration, or for the ornament, or for any two or more of such purposes, or by whatever means such design might be so applicable, whether by printing or by painting or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, natural, mechanical, or chemical, separate or combined, should have the sole right of applying the same to any article of manufacture or to any such substance as aforesaid during the respective terms thereafter mentioned, *i.e.* terms varying from 9 months to 5 years.

The statute did not mention "any article of manufacture" being a design, but considered the design to be protected as applicable to the ornamenting of any article of manufacture. The design was always considered as different from the "article of manufacture, or the substance to which it was to be applied."

(a) Special protection was given to designs exhibited in the great exhibition in 1851, by 14 Vict. c. 8, and permanent provision for exhibition of designs at Industrial and International Exhibitions was made by 28 & 29 Vict. c. 3, and 33 & 34 Vict. c. 27.

(b) As to what amounts to publication, see *Cornish v. Keene*, Webst. Pat. Ca. 501, 508. See *Anon.* 1 Chitt. 24; *Carpenter v. Smith*, 9 M. & W. 300; S. C. Webst. Pat. Ca. 530, 536; *Jones v. Berger*, *ibid.* 550; *The Houshill Co. v. Neilson*, *ibid.* 718, n.; *Stead v. Williams*, 7 Man. & Gran. 818. See *Prince Albert v. Strange*, 1 H. 8 Tw. 1; *Daiglish v. Jarvie*, 14 Jur. 945; S. C. 2 Mac. & G. 231; 2 H. & Tw. 437. In the last cited case it was queried whether the nine months' copyright given by the Act referred to in any designs for ornamenting articles of manufacture dated from the publication of the manufacture or from the publication of the design. See further cases, p. 503.

By the 13 & 14 Vict. c. 104, s. 9, as amended by the 38 & 39 Vict. c. 93, the Commissioners of Patents were empowered from time to time to order that the copyright of any class of designs or any particular design registered or which might be registered under the Designs Act, 1842, should be extended for such term, not exceeding the additional term of three years, as the said Commissioners might think fit; and the said Commissioners had power to revoke or alter any order from time to time.

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The Commissioners of Patents empowered to extend time.

Original designs for any article of manufacture having reference to some purpose of utility so far as the design were for the shape or configuration of such article, and whether for the whole of such shape or configuration or only for a part thereof, were governed by the 6 & 7 Vict. c. 65 (a), which provided that the proprietor of such design not previously published in the United Kingdom of Great Britain and Ireland or elsewhere, should have the sole right to apply such design to any article, or make or sell any article according to such design for the term of three years, to be computed from the time of such design being registered according to that Act. But the enactment did not extend to such designs as were within the 5 & 6 Vict. c. 100, 38 Geo. III. c. 71, or the 54 Geo. III. c. 56.

Useful designs.

Now the distinction between ornamental and useful designs is abolished, and the law relating to designs is consolidated and governed by the Patents, Designs and Trade Marks Act, 1883 (which has repealed all previous legislation relating to designs except of sculpture), and the amending Acts 48 & 49 Vict. c. 63, 49 & 50 Vict. c. 37, 51 & 52 Vict. c. 50 (b). The principal Act gives to the proprietor of a design registered under that Act copyright therein for five years dating from the day on which the application for registration is received (c).

Existing legislation.

A design is defined by the Act to mean any design applicable to any article of manufacture, or to any sub-

Definition.

(a) Amended by 13 & 14 Vict. c. 104, 21 & 22 Vict. c. 70, and 38 & 39 Vict. c. 93.

(b) These Acts may be cited collectively as the Patents, Designs and Trade Mark Acts, 1883 to 1888.

(c) 46 & 47 Vict. c. 57, s. 50 (1); Designs Rules, 1883, r. 21.

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stance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

The design
merely pro-
tected.

The Act protects merely the design to be applied to an article of manufacture, or substance for pattern, shape, or ornament, and does not afford or profess to afford protection to any mechanical principle or contrivance directly. The shape or configuration merely is protected. But though this is the case the result of such protection may be to secure important advantages such as attend a mechanical contrivance, if these advantages should be the result directly or indirectly of the shape or configuration adopted and protected.

A design may be the subject of copyright though it depict an article incomplete in itself, but which is intended to be used in combination with and as part of another article of manufacture, *e.g.*, a door of a kitchen-range (*a*).

Shape and
configuration.

Where the design was of a new ventilator, consisting of an oblong pane of glass fixed in a frame, which was inserted into an ordinary window-frame, and was hinged at the top, so as to open and admit the air, by means of a screw acted upon by cords passing over its head, and having a half-pane of glass fixed in the lower portion of the frame in which the ventilating frame ended, so as to prevent a downward draught, the claim of the inventor was said to be for the general configuration and combination of the parts, some of which were not original. This was held not to be a design for the shape and configuration of an article of manufacture within the 6 & 7 Vict. c. 65,

(*a*) *Walker, Hunter & Co. v. Falkirk Iron Co.*, 14 C. of S. Cas. 1072 (Sc.), 24 Scot. L. R. 751 ; 4 Rep. Pat. Cas. 390.

and therefore not the subject of registration ; and a conviction for the infringement of such a registered design was quashed for want of jurisdiction (a). Erle, J., in giving his opinion that the invention was not within the meaning of the statute, said : " It is a combination of means for the purpose of easily admitting air and avoiding a downward draught, and there is a skilful combination of means to produce this result. But the particular shape or configuration is accidental and wholly unimportant, and unconnected with the purpose to be attained. An oblique pane is of no particular use ; a square or circular pane, and a straight or curved screen, would produce the same result. If the prosecutor relies on the shape or configuration as producing a useful result, he fails in making out that the defendant has infringed his right, because there is no doubt that the shape of the defendant's invention varies materially from that registered by the prosecutor : in the one the pane being nearly square and in the other oblong, and the screw being straight in the one, and crooked in the other. The prosecutor intended to protect a combination of means producing a useful result, and that is within the law relating to patents, and not within statute 6 & 7 Vict. c. 65 " (b).

Again, the design of a " protector label," which consisted in making in the label an eyelet-hole, and lining it with a ring of metallic substance, through which a string attaching the label to packages passed, was held not to be within the protection of the old statutes (c). But the design of a newly-invented brick, the utility of which consisted in its being so shaped that when several bricks were laid together in building a series of apertures were left in the wall

(a) *Reg. v. Bessell*, 15 Jur. 773 ; 20 L. J. (M.C.) 177 ; 16 Q. B. 810.

(b) The contrary was held in *Heywood v. Potter*, 1 E. & B. 439 ; 17 Jur. 528 ; 22 L. J. (Q.B.) 133 ; but subsequently the 21 & 22 Vict. c. 70, s. 4, enacted that nothing in the 4th section of the 5 & 6 Vict. c. 100 should extend, or be construed to extend, to deprive the proprietor of any new and original design applied to ornamenting any article of manufacture contained in the said 10th class of the benefits of the Copyright of Designs Acts or of this Act ; provided there shall have been printed on such articles at each end of the original piece thereof the name and address of such proprietor, and the word " Registered," together with the year for which such design was registered.

(c) *Margelton v. Wright*, 2 De G. & Sm. 420.

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Subject of registration must be not an article of manufacture but a design.

through which the air might circulate, and a saving in the number of bricks effected, was held to form the proper subject of registration under the last-mentioned statutes (a).

The subject of registration must not be an article of manufacture, but a design; that is, a combination of lines producing pattern, shape, or configuration, by whatever means such design may be applicable to the manufacture. The "design" is always considered different from the "article of manufacture, or the substance to which it is to be applied."

Thus where M. registered as a design a picture of a basket, stating his claim was for the pattern of a basket consisting in the osiers being worked in singly, and all the butt ends being outside, and he commenced an action in the County Court for infringement of this design, and the defendant alleged that the design was not novel and was not a proper subject for registration, the jury found a verdict for the plaintiff on the question of novelty, but on the application of the defendant for a new trial the judge, doubting whether the design was a proper subject for registration, gave leave to appeal. On the case coming before the Divisional Court it was held that what the plaintiff had registered was in reality a process or mode of manufacture, and was not a design within the meaning of the Patents, Designs, and Trade Marks Act, 1883, and that a design must be something appealing to the eye, and to the eye separable from the object to which it is applied (b).

Mr. Carpmael, of the Repertory of Patent Inventions, Lincoln's Inn, has thus endeavoured to make the distinction clear: "In registering any new design for a table lamp, all which could be secured under such registration, would be some peculiarity of form of an ornamental character in the stem or oil vessel, or in the glass shade,

(a) *Rogers v. Driver*, 20 L. J. (Q.B.) 31; 16 Q. B. 102. See *Millingen v. Picken*, 1 Com. Ben. Rep. 799; 14 L. J. (N.S.) (C.P.) 254; 9 Jur. 714.

(b) *Nooly v. Tree*, 9 Rep. Pat. Cas. 233. Vaughan Williams, J., said, "The Plaintiff seems discreetly to have chosen the best description he could under the circumstances and he calls it a pattern. The fact of his calling it a pattern, does not make it a pattern. What he calls a pattern is the mode of manufacture which consists in the osiers being worked in singly, and with the butt ends outside."

or some ornament applied thereto, if under the first mentioned statute, or some novelty in the shape or configuration, without reference to ornament, if under the second statute;—no new mode of supplying oil to the wick, nor any new mode of raising the wick, nor any new apparatus for supplying air to support combustion, could become the subject-matter of a registration. The simple configuration, or contour, or ornament of the lamp, or some particular part of the lamp, would be the only subject for registration; and any person might, without infringing the registration, make the same description of lamp, all parts acting mechanically in the same manner to produce the same end, so long as the outer configurations were not imitated. A patent, on the contrary, can scarcely ever be said to depend on shape; supposing a patent be taken for any improved construction of lamp—such, for instance, as an improved means of raising the oil from the stem or pillar of a table lamp,—the patent would be equally infringed whether the external figure or design be retained or not so long as the means of raising the oil were preserved.”

An instructive case is the recent case before the Lords of the *Hecla Foundry Co. v. Walker, Hunter & Co. (a)*. The respondents, Walker & Co., registered under the Act of 1883 a drawing or design of a kitchen-range fire-door. They described it as “a range fire-door with moulding on top; moulding forming front of range; SHAPE to be registered.” The fire-door was intended to fit into the range, and the moulding on the top corresponded to and ran flush with the moulding on the front of the hob of the range when the door was closed. The appellant’s fire-door projected over the face of their range, and had a moulding on the top with fitted ends, which projected about three-eighths of an inch in front of the moulding on the range hob. It also had a handle, which the respondents’ door had not. The feature of both doors was that the moulding on each accomplished the useful purpose of closing the space between the hob-plate and the

*Hecla
Foundry Co.
v. Walker,
Hunter & Co.*

(a) 14 App. Cas. 550; 5 Rep. Pat. Cas. 71; 6 Rep. Pat. Cas. 554.

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top of the fire-box, and thus excluded the cold air. It was held by the House of Lords, first, that the Court of Session (a) in considering whether there had been an infringement of the copyright in the design for the shape of the fire-door were wrong in taking into account the question whether the defenders' design accomplished the same useful object (*i.e.* that of excluding cold air) as the design of the pursuers; but secondly, affirming the decision of the Court of Session, that there had been in fact an obvious imitation of the registered design, and therefore an infringement of the copyright. Lord Herschell in his judgment well points out what is protected by the Act and what not. He says: "Under the Designs part of the Act of 1883, I do not think the object which the designer has in view in adopting the particular shape or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected. The scheme of this part of the Act is entirely different from that relating to patents for inventions, where the object attained by the invention for which the patent is granted is, of course, very material to the inquiry what is its subject-matter, and whether there has been an infringement. I cannot agree, therefore, that the registration was claimed or could be claimed 'not for the particular moulding,' but for the form given by placing 'any suitable moulding' upon a fire-door in the described position, or that a privilege was granted 'for putting a moulding upon a fire-door in such a manner as to accomplish' a particular object. I think the protection was granted for the shape and for that alone, and that in such a case, when an infringement is alleged, the only question is, whether the shape of that which is impeached is the same, or whether the one is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end. I quite agree with what was said by Lord Shand in *Walker v. Falkirk Iron Co.* (b), that 'the Act in this branch gives protection only

(a) 15 Court Sess. Cas., 4th Series, 660.

(b) 14 Court Sess. Cas. 4th Ser. at p. 1081; 4 Rep. Pat. Cas. 390.

to the shape or configuration or to the design for the shape or configuration in such a case as the present. The result of such protection may be, however, to secure important advantages such as attend a mechanical contrivance, if those advantages should be the result directly or indirectly of the shape or configuration adopted.' But this is a mere incident. If such advantages are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end. The test of infringement must always be whether the shape is or is not the same. If it be, then the exclusive privilege has been infringed even though the same object be not accomplished; if it be not, then, though the object be accomplished, there has been no infringement. In the present case, for example, by a very slight deviation from the design, which would scarcely be apparent, the air might be admitted to the fire. I do not think that a person making such a fire-door could successfully answer the complaint that he has infringed the right of the proprietor of the design by shewing that, when applied to a range, it would not exclude the air." In the former edition of this work it was stated that it was the received opinion that under the old Act, 6 & 7 Vict. c. 65, designs might be registered the subjects of which could in many cases have obtained a patent (a). This passage was cited with approval in *Walker, Hunter & Co. v. Falkirk Iron Co.* (b), by Lord Shand, who expressed his opinion that this was still the case under the present Act.

Copyright is by the Act defined to mean the exclusive right to apply a design to any article of manufacture, or to any such substance as aforesaid in the class or classes in which the design is registered. Definition.

The classification of articles of manufacture and substances as given in the Rules, 1883, is as follows:— Classification.

Classes

1. Articles composed wholly or partly of metal, not included in class 2.

(a) *Roger v. Driver*, 16 Q. B. 108; see *Millingen v. Picken*, 1 C. B. 799, 812.
 (b) 14 Court Sess. Cas. 4th Ser. at p. 1081; 4 Rep. Pat. Cas. 390.

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2. Jewellery.
3. Articles composed wholly or partly of wood, bone, ivory, papier-mâché or other solid substances not included in other classes.
4. Articles composed wholly or partly of glass, earthenware or porcelain, bricks, tiles or cement.
5. Articles composed wholly or partly of paper (except hangings).
6. Articles composed wholly or partly of leather, including bookbinding of all materials.
7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods (*a*).
14. Printed or woven designs on handkerchiefs and shawls (*a*).

To entitle a design to be registered it must be—

- (1.) New or original (*b*), and
- (2.) Not previously published in the United Kingdom.

(1.) *New or original.*

An original combination a proper subject of registration.

A new treatment of old patterns may be a new and original design, and as such would be a proper subject of registration.

This was determined in the Exchequer Chamber, on appeal from the Court of Exchequer, in the case of *Harrison v. Taylor* (*c*). The plaintiff registered, under the 5 & 6 Vict. c. 100, a design for ornamenting woven

(*a*) *Hottersall v. Moore*, 9 Rep. Pat. Cas. 27.

(*b*) *Harden Star Hand Grenade Fire Extinguisher Co. Trade Mark and Designs*, 3 Rep. Pat. Cas. 132.

(*c*) 3 H. & N. 301, reversed (Ex. Ch.) 4 H. & N. 815; 29 L. J. (Exch.) 3; 5 Jur. (N.S.) 1219; *Sherwood v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 207.

fabrics. The design was applied to a fabric woven in cells, called "The Honeycomb Pattern," and it consisted of a combination of the large and small honeycomb, so as to form a large honeycomb stripe on a small honeycomb ground. Neither the large honeycomb nor the small honeycomb was new, but they had never been used in combination before the plaintiff registered his design. Other fabrics had been woven with a similar combination of a large and small pattern. In an action against the defendant for infringing the plaintiff's copyright it was held that the plaintiff's design was a "new and original design" within the meaning of the 5 & 6 Vict. c. 100.

But where four old designs were respectively applied to three ribbons and to a button, and the three ribbons were then united by the button so as to form a badge, it was held that such union did not amount to a new design within the above statute (a).

A. registered as "a design" within class 12, sect. 3, of the 5 & 6 Vict. c. 100, a pattern of a woven fabric. He gave no written description of his claim. The design consisted of six pointed stars on an Albert chain arranged in a particular manner, and shaded, and he claimed "the particular collocation of the shaded and borrowed stars upon the ornamental chain surface, as shewn in the registered pattern, thus forming together the ornamentation of the woven fabric." B. slightly altered the combination, but not so as to affect the general appearance of the pattern, and it was adjudged that this was an infringement of the pattern registered (b).

In *Reg. v. Firman* (c) it was decided that the result of simultaneously applying two old and known designs to the ornamenting of a button might be a new and original

But the combination must be one design and not a multiplicity.

(a) *Mulloney v. Stevens*, 10 L. T. (N.S.) 190. A claim to a monopoly in a design registered under the 6 & 7 Vict. c. 65, for the shape or configuration of the body of a four-wheel dog-cart was rejected, because the design consisted only of an arch in the fore part of the carriage, made a little higher than that in ordinary use, to permit the convenience of larger fore-wheels: *Windover v. Smith*, 11 W. R. 323; 32 Beav. 200; 32 L. J. (Ch.) 561; 9 Jur. (N.S.) 397; 7 L. T. (N.S.) 776.

(b) *McCrea v. Holdsworth*, 23 L. T. (N.S.) 444; L. R. 6 Ch. 419; 2 H. L. 380.

(c) Cited in *Harrison v. Taylor*, 3 H. & N. 304.

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combination to be protected as a design ; but the result of the combination to be protected as a "design" must be one design and not a multiplicity of designs (a).

Therefore where a claim was made in respect of a design of a shawl, and it was contended that there were five points in respect of which the shawl was new and entitled to protection—first a reversible cloth, with the two sides of different texture and colours ; secondly, a scallop pattern in parts of the shawl ; thirdly, a particular border round the shawl ; fourthly, a particular configuration of the corners of the shawl ; fifthly, a newly invented fringe to surround the shawl ; and the evidence clearly shewed that all these five points, or "designs," had been in public use and had been applied to shawls before the registration of the plaintiff's shawl, but that the combination of them in the plaintiff's shawl was new ; the court held that such a combination was not a "design" within the meaning of the Act of Parliament. "The five points relied upon," said Lord Campbell, C.J., "being all old, no distinction is to be made between them and any other in the texture, configuration, or ornaments of the shawl. Therefore the combination supposed to constitute the design which the plaintiff now seeks to protect comprehends all that is to be discovered on both sides of the shawl, colour as well as shape. . . . The design is always to be considered different from the 'article of manufacture or the substance to which it is to be applied.' This is particularly to be observed in sect. 3, in which the articles of manufacture are enumerated to which the design is to be applied. Among these (classes 7 & 8) are 'shawls,' the 'shawl' is not the 'design,' but 'the article of manufacture to which the design is to be applied.' An ornament for a lady's gown may well be a 'design,' to be protected, although the ornament be the result of a new combination of lace and ribands ; but the gown itself could hardly be such a 'design,' although it be granted that the component parts and ornaments, before well known separately, are arranged according to a fashion entirely new. Such an extension

(a) *Norton v. Nicholls*, 5 Jur. (N.S.) 1202, 1205.

of the statute is quite unnecessary for the object which the legislature seems to have had in view, and we need not point out the great public inconvenience which would arise if we were to put such a construction upon it" (a).

In a recent case the plaintiff alleged that his design as a "combination" was new and original, and not previously published in the United Kingdom; that is, he alleged that the use of a red-coloured border on a body of yellow chamois-leather cloth was entirely new, and constituted a design within the Act, and the mode in which he arrived at the design was not by drawing a pictorial production, but in this way. He took a piece of an old pattern (No. 20) long used for dusters, and directed Mr. F., who was the manufacturer of goods ordered by him, to work out the *border* of this duster (No. 20) in red; and that he then took a duster (No. 19) and took from that a pattern of the so-called chamois-leather cloth, and directed Mr. F. to work that out as the body of a duster with the borders like No. 20, only worked out in red. The border in No. 20 was a very old and common border, and that the chamois-leather cloth was known at the time as a material was clear from the fact that the plaintiff alleged that he took the pattern for the body of No. 2a (the design in question) from No. 19, and when the body of No. 2a was applied to a square forming part of the border of No. 19 this was apparent to the eye: the two things were, in fact, identical. Upon these facts Vice-Chancellor Bristowe said: "He (the plaintiff) takes an old border from a well-known duster, and he applies that well-known border to a previously existing fabric. The border had been used over and over again; the fabric was not new. There is nothing in the slightest degree novel or original in this border; it is a mere stripe of colour, and the material is already in existence, though of recent manufacture. What was there then 'new or original' in this to constitute a design? I admit the difficulty of stating with precision what is a design within

Hothersall v. Moore.

(a) *Norton v. Nicholls*, 5 Jur. (N.S.) 1203; 1 El. & E. 761; 7 W. R. 420.

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the Act; and many judges have previously found that difficulty, but, independently of authority on the subject, I cannot bring myself to the conclusion that there was in the application of the border of the exhibit No. 20 (which was a common border) to a material forming part of No. 19, enough to constitute a design by way of combination within the meaning of the Act" (a).

And it is not material that the plaintiff has independently invented the design if, in fact, it has been previously published. Thus where S. in 1887 registered a design for fire-screens, constructed of three palm-leaf fans to hold a flower-pot, and in 1889 brought an action for infringement. The defendants alleged that the design was not new or original, and called evidence to shew that a similar design had been previously published. And it was held that, even admitting that the design was good subject matter, which was doubted, and although the judge was satisfied that the plaintiff had independently invented the design, on the evidence it had been used before the plaintiff's registration, and the action was dismissed with costs. The design was ordered to be expunged from the register (b).

Copy of
photograph
of well-known
public
character not
a new design.

The mere copy of a photograph of a well-known public character, which is common to all the world, is not "a new and original design" within the meaning of the Act. Thus, where, in the case of *Adams v. Clementson* (c), the plaintiff, who was a manufacturer of earthenware, claimed an injunction to restrain the defendant, who was in the same line of business, from infringing his copyright in a design which he had registered under the 5 & 6 Vict. c. 100, and it appeared that the design consisted of a portrait of General Martinez de Campos, Captain General of Cuba, copied from a photograph which had been sent to the plaintiff from Cuba, and which had been applied by him to plates and other articles of earthenware which had been sent out to Cuba for sale; and that the

(a) *Hothersall v. Moore*, 9 Rep. Pat. Cas. 27.

(b) *Smout v. Slaymaker & Co.*, 7 Rep. Pat. Cas. 90.

(c) 12 Ch. Div. 714; 27 W. R. 379.

defendant had received an order for a supply of earthenware and been furnished with a similar photograph of the General, an injunction was refused. This case has, however, been criticised in the recent case of *Saunders v. Wiel* (a). The design in this last case was for a handle of a spoon and consisted of a representation of Westminster Abbey, and it was objected by the defendant who had copied this design relying on *Adams v. Clementson*, that being of a public building it was not a proper subject of a design. The court, however, held that the design should be protected and granted an injunction.

So a design for a double card basket formed by the combination of two baskets, admittedly old in design, was held not entitled to protection (b). Card basket formed by combination.

It may be laid down generally that a design is not a proper subject of copyright unless there is a clearly marked difference, involving substantial novelty between it and any design previously in use. Therefore where the plaintiffs registered a collar combining three characteristics which it was admitted had existed independently in other collars, but were said to have been never previously combined, and it appeared that these characteristics had appeared in combination before, though in proportions different to those in which they appeared in the registered design, the registration was ordered to be expunged (c). Rule as to what is a proper subject of registration.

In this case the law was clearly stated by Lord Justice Baggallay thus: "In order to justify the registration of a design, especially with reference to such matters as collars and other articles of dress which are in constant and daily use, there must, according to my view of the case, be some clearly marked and defined difference between that which is to be registered as a new design and that which has gone before. If the difference of half an inch in the placing of a stud, or any other similarly trifling difference from previous designs, were to be taken as

(a) W. N. [1892] 95.

(b) *Lazarus v. Charles*, 16 Eq. 117; 42 L. J. Ch. 507.

(c) *Le May v. Welch*, 28 Ch. D. 24; 54 L. J. Ch. 279; 33 W. R. 33; 51 L. T. (N.S.) 867; *Bach's Case*, 42 Ch. Div. 661; 6 Rep. Pat. Cas. 376; *Hothersull v. Moore*, 9 Rep. Pat. Cas. 27.

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justifying registration of a design for a collar, no one could have a collar made in his own house by his servants without running the risk of infringing some registered design. It would be oppressive in the extreme if any trifling change in the shape of such an article as this would justify the registration of the design so as to preclude all the rest of the world from making an article of the same or like form. Upon this ground it appears to me that the case is not brought within the 47th section of the Act, which only permits registration of a new or original design. In my opinion this is not a new or original design; the registration of it, therefore, was a mistake, and the register ought to be rectified by its removal." The other members of the Court of Appeal concurred, Lord Justice Bowen saying: "In order to enable the respondents to maintain the registration, they must be, or claim to be, the proprietors of a new or original design. In the present case is there any new or original design shewn by this drawing? In considering whether the design is new or original we must remember, in the first place, that we are dealing with a design which purports to found itself on shape, and to deal with outline; and secondly, that we are considering the question with reference to an article of dress of the very simplest and least complicated kind, an article of dress which may well vary in form in every town in England, and in every year in which collars are worn. We must not allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length or breadth or configuration in a simple and most familiar article of dress like this, which constitutes novelty of design. . . . There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article" (a).

Similarly a design for a scarf or tie, there being no substantial difference between it and a previous tie, except the introduction of a pleat, was held not capable of

(a) *Le May v. Welch, In re Le May's Registered Design*, 28 Ch. D. 24, 34.

registration, since to allow it to be registered would be to hold that the difference of a few stitches constituted a proper subject for registration (a).

A design already registered in respect of one class cannot be registered as new or original in respect of other classes (b).

Thus, where the applicant registered a design in Class 5 in Schedule 3 of the Designs Rules, 1883, viz., "Articles composed wholly or partly of paper (except hangings)," for the pattern and shape of a flower candle-shade in imitation of a chrysanthemum, and had since the date of registration been selling candle-shades made according to the design, and the respondents registered in Class 12, of the above schedule, viz., "goods not included in other classes," a design for a candle-shade consisting of an imitation chrysanthemum, and had since been selling candle-shades made according to that design of rag and paper combined, and similar to those made by the applicant, the court being of opinion that the two designs were substantially identical, and that the applicant was a person aggrieved within sect. 90 of the Act, regarded the only question calling for a report to be whether having regard to the prior registration of the applicant's design in Class 5, the respondents could register their design in Class 12, that being for a different class of goods. Mr. Justice Chitty referring to the respondents' argument, said, "That argument comes to this, that where a new and original design is registered in one class, a rival designer is at liberty to take the design and transfer it bodily to another class, and register it in that class, or if it be on the register, may maintain it there. I do not think this argument can be sustained. No doubt the copyright in a design conferred by section 60 of the Act, is limited to the goods in the class or classes in which the design is registered, and this is clearly the case, for under sect. 58, which gives a special remedy by penalty for the infringement

A design already registered in one class cannot be registered in other classes.

^a (a) *Smith v. Hope Bros.*, 6 Rep. Pat. Cas. 200; *Sherwood's Design*, 9 Rep. Pat. Cas. 268.

(b) *Re Read & Gresswell's Design*, 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. 450; 6 Rep. Pat. Cas. 471.

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of a registered design, the registered proprietor cannot proceed against the infringer in respect of goods outside the class in which the design is registered, and for this reason, that the person registering having knowingly confined the registration to one class of goods, has by so doing given notice to all the world that they are at liberty to use the design for goods not included in the class or classes, for a person may register a design in more than one class. It is on this, that the respondents' argument is based. But can the legislature have had this intention?

"I suggested the case of a design registered for jewellery, and another trader finding this to be so, and that articles marked with such design were being put on the market, and people were becoming generally acquainted with the design, taking this design and registering it in some other class of goods, such as glass (Class 4), or lace (Class 9), a thing which in the case of many designs might easily be done. I am satisfied that it was not the intention of the legislature to allow this to be done. The answer to the argument is to be found really in section 47 of the Act, where the words used are: 'Any new or original design not previously published in the United Kingdom.' To be capable of being registered a design must be 'new or original' in fact, and not, as is suggested, 'new or original' as to some particular class of goods. It cannot be said to be new and original if it is already being applied to articles of an analogous character."

A principle which is frequently overlooked is that though a design may be registered in one class for a particular purpose, it may be used or applied to another class for a *different purpose*, whereas it could not be applied to another class for the *same purpose*. Thus in the case in the Scotch Courts of *Walker, Hunter & Co. v. Falkirk Iron Co. (a)*, a design used for cabinet-doors and other doors was held to be well registered as applied to range fire doors. But where it was attempted to establish the principle that the design in one material might be

(a) 4 Rep. Pat. Cas. 390.

applied not to a different thing or to a different purpose, but to the same purpose as the previously registered design, there the court held the registration to be bad. So too in *Re Bach's Design* (a). Bach, a lamp manufacturer, in 1886 registered in Class 4, the design of a shade in the form of a rose made of china or porcelain for what was called a fairy lamp; he in 1888 brought an action in the Queen's Bench Division against the Army and Navy Co-operative Society for damages for infringement, and for an injunction to restrain them from infringing the copyright in his design. The defence was that it was not a new design, and in 1888 the Society moved in the Chancery Division to have the Register of Designs rectified by removing therefrom the said design on the ground that it was neither new nor original. It appeared that other designs for shades in the form of roses made of linen had previously been registered, but the case principally relied upon was that one Reed in 1886 had registered under Class 12, a linen shade in the shape of a rose for caudles, also adapted for lamps, and that these shades had been sold by Reed himself, and by the Army and Navy Co-operative Society directly after the registration. Evidence was also given of lamp-shades of china in the form of a tulip having been sold previously to the date of Bach's registration. Mr. Justice Kekewich held that though the materials were different, there was no novelty in the china design, which must therefore be removed from the register.

He said, "It is necessary in order to support the design that it should be new and original. To my mind it is extremely important, if one can, and as far as one can, to base a decision in a case of this kind on some principle, and I find a principle to my hand in the judgment of Lord Justice Fry, in *Le May v. Welch* (b), in which he makes this remark: 'The meaning of the words "novel or original" is this, that the design must either be substantially novel or substantially original, having regard to

(a) 42 Ch. D. 661; 6 Rep. Pat. Cas. 376; 38 W. R. 174.

(b) 28 Ch. D. 24.

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the nature and character of the subject matter to which it is to be applied.' 'Subject matter,' as there used by the Lord Justice, does not mean the material, but the purpose of the design, and the purpose here is precisely the same in each case; that is to say, the designer in each desired to invent or produce a lamp-shade. So that, as regards the subject matter, they were proceeding on identical lines.

"Now, that being the nature and character of the subject matter, what is there substantially new or substantially original? I will dismiss the second alternative, and take the substantially new. If I appeal to my eye, and look at the specimens before me of the roses of Mr. Bach, there is some distinction seen between them and those of Mr. Reed, perhaps not more than one would expect to result from difference of material, the one being more plastic, the other less so; the one necessarily taking a hard form, and the other lending itself to folds and producing a softer effect. But I think I am entitled to look, and I certainly do look, at the design which was actually registered by Mr. Bach, which I have before me, and taking that, and looking from that to Mr. Reed's production, there seems to be so great a similarity that it is difficult to distinguish one from the other. There, in Mr. Bach's registered design, the hardness of his material is not shewn, and he has multiplied the leaves of the rose, and placed them in such positions that they really are precisely the same as those of Mr. Reed. That being so, why should I not hold that the design is the same? It seems to me as a matter of eyesight, that the design is precisely the same. . . . There are many cases in the books in which the court has upheld registration, as for cotton goods in one class, of a design which had already been applied to goods of a different character altogether in another class, and I do not think it necessary to hold or even to intimate that possibly the design of a rose may not be registered for some other entirely different purpose, that is to say, with reference to some other quality of goods in a different class. But the Act does not say,

and I think, cannot have intended to say, that by selecting a different class, a man may register as applied to the same things, say lamp-shades, what has already been registered with reference to that thing, lamp-shades, merely varying the material in which the lamp-shades have been made."

(2.) *Not previously published in the United Kingdom.*

The disclosure of a design to a partner or any necessary agent confidentially is not a publication. But where the inventor of a design (who was a foreign manufacturer) showed it to his sole agent in the United Kingdom, and he in turn showed it to two customers, who gave orders (whether to be executed before or after registration did not appear), it was held that there had been a publication (a), though the disclosure to the agent would not have been such, since he had an interest in the sale of the design (b).

What is publication.

Persons entitled to register.

Any of the following persons may be considered the proprietor of copyright and may register under the Act.

Who may register.

1. The author of a new design, unless he has executed the work on behalf of another person for a good or valuable consideration.

2. Where the work is executed on behalf of another person for a good or valuable consideration, the person on whose behalf it is executed.

Thus, where a person who is engaged in business has a person in his employ who in the course of his employment makes a design which is new or original, the design will become the property of the master by virtue of the

(a) *Blank v. Footman*, 39 Ch. Div. 678 ; 5 Rep. Pat. Cas. 653 ; 57 L. J. Ch. 909 ; 36 W. R. 921 ; 59 L. T. 567 ; *Hunt v. Stevens*, W. N. 1878, p. 79 ; *Winfield & Son v. Snow Brothers*, 8 Rep. Pat. Cas. 15 ; *Read & Gresswell's Design*, 6 Rep. Pat. Cas. 473, in which the question was raised, but not decided, whether registration alone of a design would be publication. *Sherwood's Design*, 9 Rep. Pat. Cas. 268, and see cases, *ante*, p. 484.

(b) See *Humpherson v. Syer*, 4 Rep. Pat. Cas. 184, 407.

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relation which exists between them, and the master will be entitled to register the design (a). And a company incorporated under the Companies Acts may be the proprietors of the copyright of a design invented by one in their employ.

3. Every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any article or substance either exclusively of any other person or not.

4. Every person on whom the property in such design or such right to the application thereof may devolve; but the persons entitled to copyright under heads 3 and 4 will only be proprietors in respect of and to the extent of the rights so acquired (b).

A person who has a partial assignment of the design or an assignment of the right to apply it for the whole period of protection, or a licensee who has the right to make articles in accordance with the design for the whole or a limited term may register (c); but an agreement assigning an exclusive right to sell, unless it confers a right to manufacture the articles to which the design is applicable, does not entitle the assignee to register.

A body corporate may be registered as proprietor by its corporate name (d).

Where A. who was acting as the sole agent and consignee in the United Kingdom of toys manufactured in the United States by an American company, and consigned to him by them, registered in his own name the designs in accordance with which some of such toys were manufactured; and the company had authorized him to register the designs in his own name, but had not assigned to him the designs or the right to apply them to goods, the only arrangement between them and A. being that A. should sell in the United Kingdom goods manufactured and consigned to him by the company; it was

(a) *Lazarus v. Charles*, 16 Eq. 117—123.

(b) S. 61.

(c) *Jewitt v. Eckhardt*, 8 Ch. Div. 404—409; *Re Gutterman's Registered Design*, 55 L. J. Ch. 309, p. 310.

(d) Rule 27.

held that A. was not the proprietor of the designs within the 61st section of the Act of 1883, and that the registration in his name was therefore wrongful and must be expunged (*a*).

Where a person alleged that a design registered by another was invented by himself and carried out by the other person at his (the complainant's) expense and he moved to rectify the register, it was held that the burden of proof was on the applicant (*b*).

Register of Designs.

The Act of 1883 provides that a book called the Register of Designs shall be kept at the Patent Office, in which shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed, and that this register shall be *prima facie* evidence of any matters by the Act directed or authorized to be entered therein.

The Register of Designs.

Notice of trusts are not to be entered on the register (*c*), but this provision and the Patent Rules only refer to the exclusion from the register of simple notices of trusts and not documents affecting the proprietorship which, by creating trusts or otherwise, and consequently equitable assignments of a design or a share in a design, may be entered on the register as documents affecting the proprietorship (*d*). The Comptroller may refuse to register any design of which the use would in his opinion be contrary to law or morality (*e*).

Notice of trusts need not be entered.

The register is to be at all times open to the inspection of the public, subject to prescribed regulations; and certified copies sealed with the seal of the Patent Office of any entry are to be given to any person requiring the same on payment of the prescribed fee (*f*).

Inspection of register.

(*a*) *In re Gutterman's Registered Designs*, 55 L. J. Ch. 309.

(*b*) *Heinrich's Design*, 9 Rep. Pat. Cas. 73, and as to the burden of proof on a person alleging himself to be author of a design, see *Hothersall v. Moore*, 9 Rep. Pat. Cas. p. 38.

(*c*) S. 85.

(*d*) See *Stewart v. Casey*, 9 Rep. Pat. Cas. 9; [1892] 1 Ch. 104.

(*e*) S. 86.

(*f*) S. 88.

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Printed or written copies or extracts purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, are to be admitted in evidence without further proof or production of the originals (a).

Rectification
of register.

Any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars (b) from the register, or by any entry made without sufficient cause, may apply to the court for an order for the expunging or varying the entry (c); and the costs of the proceedings are in the discretion of the court. On any such application the court may either decide any question as to the rectification of the register, or may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved. It is also provided that any order of the court rectifying the register shall direct that due notice be given of the rectification to the Comptroller. And the Rules under section 101 of the Act of 1883 provide that the person in whose favour an order has been made shall forthwith leave at the Patent Office an office copy of such order upon which the register shall be rectified, or the purport of such order entered in the register, as the case may require.

False entries
in register.

Any person making or causing to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry therein, or producing or tendering or causing to be produced or tendered in evidence any such writing knowing the entry or writing to be false, is declared to be guilty of a misdemeanor (d).

Right of
applicant to be
heard before
adverse deci-
sion.

It is further provided that any discretionary power given to the Comptroller shall not be exercised adversely to an applicant for registration of a design without (if so required within the prescribed time by the applicant) giving

(a) S. 89.

(b) Sect. 90, Patents, Designs, &c., Act. 1883, s. 23, Patents, Designs, &c., Act, 1888.

(c) *Harden Star Hand Grenade Fire Extinguisher Co.'s Design*, 3 Rep. Pat. Cas. 132; *Bach's Design*, 6 Rep. Pat. Cas. 376; *Smith v. Hope Bros.*, 6 Rep. Pat. Cas. 200; *Reed & Grosswell's Design*, 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. 450; 6 Rep. Pat. Cas. 471; *Smout v. Slaymaker*, 7 Rep. Pat. Cas. 90.

(d) Sect. 93, Act 1883.

the applicant an opportunity of being heard personally or by his agent.

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Any application, notice or other document authorized or required to be left, made or given at the Patent Office or to the Comptroller or to any other person under the Act, may be sent by a pre-paid letter through the post, and if so sent is to be deemed to have been left, made or given at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving service or sending, it is sufficient to prove that the letter was properly addressed and put into the post (a).

How applicant's notices, &c., to be made or sent.

Registration.

The application may be by any person claiming to be the proprietor or by any agent duly authorized on his behalf. It must be in the following form :

Registration.

Form of Application to register.

Application for registration of design in classes.

You are hereby requested to register the accompanying design in class _____ in the name of [*Here insert legibly the name, address, and description of the individual or firm*] of _____ who claims to be the proprietor thereof, and to return the same to _____

Form.

Statement of nature of design [*such as whether it is applicable for the pattern or for the shape.*]

(Signed)

[*To be signed by the applicant.*]

Dated the _____ day of _____ 189 .

To the Comptroller, Patent Office, Designs' Branch.

This form with the prescribed fee must be left at the Patent's Office (Designs' Branch), or be sent by prepaid letter addressed to the Comptroller.

Fees on registration.

The fees payable are thus fixed by the Rules :

Rules.	£	s.	.
1. On application to register one design to be applied to single articles in each Class, except Classes 13 & 14.	0	10	0

(a) S. 97, Act 1883.

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	2. On application to register one design to be applied to single articles in Classes 13 & 14.	0	1	0
	3. On application to register one design to be applied to a set of articles for each class of registration	1	0	0

Statement of nature of design.

The form must contain a statement of the nature of the design and the class or classes of goods in which the applicant desires that the design be registered.

The statement of the nature of the design is not required to be like the specification of a patent (*a*), but should be sufficiently full and explicit to make the design intelligible to enable the Comptroller to give the information required to be given by him by section 53, and to fully explain all matters pertinent to the registration which cannot be gathered from looking at the representation or specimen of the design filed with the application.

The same design may be registered in one or more of the classes according as it is intended to be employed in one or more species of manufacture, but a separate fee must be paid on account of each separate class, and all such registrations must be made at the same time.

It might sometimes be worth while to register in more than one class to prevent vulgarization, but as publication in one class is publication in all, this must be done as before mentioned at the same time, or at least before any form of the pattern or design be in circulation.

In case of doubt as to the class in which a design ought to be registered, the Comptroller may determine the question.

In a recent case an action was brought to restrain the infringement of a design registered in Class 13 ("printed or woven designs on textile piece goods"), the certificate of registration identifying it by having attached

(*a*) See *Holdsworth v. McCrae*, L. R. 2 H. L. 385. In America the practice is different, and a specification is required. In the recent case of *Demartial v. Brook* (not yet reported, but intended to be in 9 Rep. Pat. Cas.), the American specification was given in evidence, no party objecting.

thereto a cutting of a material known as "chamois leather cloth." The goods as sold by the plaintiff were woven in pieces consisting of twelve squares marked off, one from the other by threads woven across the piece, each square being intended to be cut from the rest and to be used as a duster; the cutting attached to the certificate was taken from the middle of one of these squares, and shewed a plain yellow centre and a border at each side, consisting of a red stripe about one inch in width, with two narrow yellow lines running down the middle. Subsequently the plaintiff registered in Class 14 ("printed or woven designs in handkerchiefs and shawls"), a design, which was substantially the same as the former, except that the colour of the stripe was woven in the top and bottom of the duster, and grey at the two sides. The identification was in this case also effected by means of a duster, showing the stripe running all round the piece, but crossing at each corner, so as to form a check at the corners. An injunction was sought to restrain the defendant from manufacturing or selling cloth made according to the registered designs or only colourably differing from them. The defendant alleged amongst other things that dusters, though woven in lengths consisting of sets of twelve, were comprised in Class 14 ("printed or woven designs for handkerchiefs or shawls"), and not in Class 13, and it was held the defendant was right, Vice-Chancellor Bristowe saying, "I have come to the conclusion that there is a substantial difference between the Classes, No. 13 & No. 14, in the Rules of 1883, and that 'piece goods' are by the order in question—that is, the order under the Act of 1883—intended to denote goods commonly known as 'piece goods,' measured by the piece and sold by the piece, and should be classed under No. 13, and that goods which though woven in the piece are subdivided in patterns by cross lines or other demarcations showing that they would be sold, not by measurement, but by number, as per dozen, fall within the class of handkerchiefs and shawls sought to be registered under Class 14; but that to avoid any difficulty the person desiring to register, may

CAP. XV.

register under both classes, and so ensure his desired protection. Now the plaintiff has not done this at the time. He has registered under Class 13. In my judgment that might, if the design were capable of registration, protect him for the sale of such goods as the long piece worked out as a piece, but it would be of no avail to protect him for such goods as No. 22 " (a).

Correction of clerical errors.

By the 91st sect. of the Act of 1883, the Comptroller may, on request in writing accompanied by the prescribed fee, correct any clerical error in or in connection with an application for registration of a design, or correct any clerical error in the name, style or address of the registered proprietor, and by the 24th sect. of the Act of 1888, may permit an applicant for registration to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design to be registered (b).

What to accompany application.

The application must be accompanied either—

- (a.) By a sketch or drawing, or
- (b.) By three exactly similar drawings, photographs or tracings of the design, or
- (c.) By three specimens or exact representations of the design ;

and in describing the nature of the design, the applicant must state whether it is applicable for the pattern, or for the shape or configuration of the design, and the means by which it is applicable. When sketches, drawings or tracings are furnished they must be fixed, and they, as well as the application itself, must be written, printed, copied or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left hand part thereof, and the signatures of the applicants or agents must be written in a large and legible hand. The Comptroller has however power in any particular case to vary the requirements of this rule if he thinks fit.

When the articles to which designs are applied are

(a) *Hollersall v. Moore*, 9 Rep. Pat. Cas. 38.
 (b) 51 & 52 Vict. c. 50, s. 24.

not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs must be furnished.

The Comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen, which is not, in his opinion, suitable for the official records.

The Comptroller on receipt of an application for registration is to send to the applicant an acknowledgment, and if he determines to register, he is to send the applicant a certificate of registration sealed with the seal of the Patent Office, in the following form—

Certificate of registration.

Certificate of Registration of Design.

(Rd. No. .)

Patent Office, Designs' Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

This is to certify that the design of which this is a copy was registered this day of 189 , in pursuance of the Patents, Designs, and Trade-Marks Act, 1883, in respect of the application of such design to articles in Class for which a copyright of five years is granted.

In the event of the Comptroller considering that a design should not be registered, and before exercising his discretionary power adversely to any applicant, he is to give the applicant ten days' notice of the time when he may be heard personally or by his agent before the Comptroller, and within five days from the delivery of such notice in the ordinary course of post, the applicant is to notify to the Comptroller whether or not he intends to be heard upon the matter. When the Comptroller refuses to register a design, the applicant may appeal to the Board of Trade, but he must within one month from the date of the decision appealed against, leave at the Patent Office, Designs' Branch, a notice in the following form—

Notice to applicant that he may be heard before Comptroller.

Applicant's right of appeal.

CAP. XV.*Appeal to the Board of Trade on refusal of Comptroller to register a Design.*

(To be accompanied by an unstamped copy).

Sir,

I hereby appeal against your decision upon my application to register and beg to submit my case (a) for the decision of the Board of Trade.

I am, Sir,

Your obedient servant,

The Comptroller, Patent Office, Designs' Branch.

What to accompany appeal.

The notice must be accompanied by a statement of the ground of appeal and of the applicant's case in support thereof, and a copy of the notice must at the same time be sent by the applicant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal has to be given to the Comptroller and the applicant.

Upon the sealing of a certificate of registration, the Comptroller is to cause to be entered in the register of designs, the name, address and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day is to be deemed to be the date of registration (b).

In the case of the loss of the certificate or in any other case in which the Comptroller deems it expedient, he may grant a copy or copies of the certificate (c).

A letter from the Comptroller giving the result of a search under Rule 35 of the Designs Rules is not evidence (d).

Permissible to register by pattern.

The Designs Act of 1842 did not permit registration by pattern; this was an improvement introduced by the

(a) The statement of the case to be written upon foolscap paper (on one side only) with a margin of two inches on the left hand side thereof.

(b) Rule 21.

(c) S. 49.

(d) *Smith v. Hope Bros.*, 6 Rep. Pat. Cas. 201.

21 & 22 Vict. c. 70, which declared that the registration of any *pattern* or *portion* of an article of manufacture to which a design is applied, instead or in lieu of a copy, drawing, print, specification, or description in writing, should be as valid and effectual to all intents and purposes as if such copy, drawing, print, specification, or description in writing had been furnished to the registrar under "The Copyright of Designs Acts." The 48th section of the Act of 1883 allows specimens or exact representations of the design to be furnished instead of copies.

The advisability of registering by specimen, will of course depend upon the nature of the design to be protected. There is a risk either way. There is a risk on the one hand of misdescription of the claim, for though the same nicety is not required in registering patterns or designs, as in describing inventions sought to be protected under the patent laws, yet it is necessary that the party should properly explain the nature of the design he is desirous of protecting, and on the other hand, where the party exercises the option of silence, and merely produces the pattern of his invention, he is exposed to this:— that as by the registration of the sample he has claimed protection in respect of the entirety of what is exhibited on the face of that pattern; if only a part is used in a different combination, he is without the protection which he would otherwise have had (*a*).

When
advisable
to do so.

When a piece of manufacture with a design impressed upon it is registered without any explanation or addition in writing, and that design consists of several parts not necessarily united in configuration, but capable of being severed into independent integral parts, then the design registered is the entire thing, exactly as it is described in the pattern furnished; and such registration is therefore not open to the objection of uncertainty, but is valid according to the foregoing provision. The designer, however, is, as we have already pointed out,

When not
advisable.

(*a*) *Holdsworth v. M'Creca*, Law Rep. 2 H. L. 390.

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under this disadvantage, that when he registers a pattern of material, there is no infringement unless it is exactly copied. If the designer be content with putting a design, which is composed of several parts placed together, but capable of being severed and used in a separate form, upon the register without limitation and without explanation, he claims simply to be the inventor of the entire thing, exactly as it is described in the drawing or pattern which he has exhibited, and all that he can claim to protect against imitation is, that thing in its exact form and relative positions and proportions as they appear upon his pattern. Anything, therefore, which is a *fac simile* of that drawing—any other pattern which is a reproduction of that in its integrity—becomes an infringement. But that which is different in shape and form, or in the relative positions of its several parts, which is not a reproduction of it, as a *replica* or a copy of a picture, would not be an infringement of the thing specified (a).

Thus where a sample of an article had been registered under the 21 & 22 Vict. c. 79, s. 5, Vice-Chancellor Wickens was of opinion that the design so registered would not be infringed by an article produced upon the same principle, if different in style.

It is doubtful whether, in view of the 3rd sub-section of the 47th section of the Act of 1883, registration by specimen alone ever can be made, this sub-section expressly requiring the application for registration to contain a *statement* of the nature of the design, but possibly this might be waived under rule 29 of the Designs Rules by virtue of the dispensing power vested in the Comptroller with the consent of the Board of Trade.

In one case it was argued that the registration of the design, which was for a kitchen range fire-doors, was invalid on the ground that it was not clear for what purpose the design was registered, because, in short, the registration did not carry on its face in some way the

(a) *Per* Lord Westbury in *Holdsworth v. M'Crea*, L. R. 2 H. L. 388.

When sample of article registered, design not infringed by article produced on same principle, if different in style.

announcement that it was for the shape only, and it was urged that third parties were entitled to assume that the registration was for the ornament in connection with the hinge which formed part of the design, and gave no protection to the shape. Lord Shand, in giving the judgment of the Court of Session (a) on this point, said, "I am clearly of opinion that this objection is not well founded. When an infringement of copyright is complained of, all that the alleged infringer is entitled to see is the registered design, either as it may be found in the form of the article itself, as for example, the actual door of a fire range, as in this case, or it may be a design and relative certificate which is in the hands of the owner of the copyright. The statute does not entitle him to demand inspection of the registration itself from the Comptroller until the copyright has ceased, as is clear from the 52nd section of the statute. No specification by the author of the design is required or indeed allowed, as in the case of patents for inventions, and there is no register to which the alleged infringer can go as in the case of an infringement of patent to ascertain whether the act complained of can properly be complained of as an infringement with reference to the particular object for which the design is registered, whether for pattern, shape, or ornament. In this state of matters it seems to me, of necessity, to follow that it must have been intended that the purpose for which the design was registered might be proved by evidence when any question arose on the subject, primarily the evidence of the owner who made the registration, but outside by the evidence of others acquainted with the trade, or manufacture, or business in the article to which the design relates. It will be found that many—probably the large majority of designs—are self-interpreting without such evidence, but there must be others in which a question may be raised which, however, in most instances will be easily settled as soon as evidence

(a) 4 Rep. Pat. Cas. 390, 394.

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is adduced. Thus, for example, in the present case, evidence having been fully led, no one has seriously suggested on the proof—in which persons acquainted with the trade were examined—that the pursuer's design was or could be registered for any of the purposes authorized by the statute except its shape or configuration, attended as that shape is with useful results. A person alleged to be an infringer is quite entitled to demand of the person complaining that he shall state for what purpose or purposes under the statute the design was registered, and if he be dissatisfied with the answer he may, under legal proceedings, have such inquiry as has taken place on that question in this case with reference to the pursuer's design. He may in that enquiry be able to show that the complainer is seeking to use the certificate of registration of a design for a purpose and to an effect which is not warranted by the design, either as self-interpreting or as interpreted by the evidence where there is a question, and in that case he may succeed in his defence. I do not think it possible to read the enactment of the statute, which obviously leaves matters without special provisions on this subject, in any other way, for the only other reading would result in this, that where any design had special or peculiar shape, with some ornament however slight, and was consequently registered on account of that shape, an infringer would be able to defeat the copyright by merely alleging that the design registered for shape was protected only as regards ornament, or that the subject of registration was doubtful, and so the registration was ineffectual, and that evidence could not be admitted on the subject. Such an interpretation of the statute would lead to the result that in the great majority of designs to which the statute obviously is intended to give protection no such protection could be given. This is a view of the statute which does not commend itself to me, and is not, in my opinion, to be adopted. It seems to me that in order to give reasonable effect to the statute, the claim or representation of the

pursuer in such cases, not only may be the subject of evidence such as we have in this case, but may further be solved by an easy and certain test. The statute, section 47, sub-section 3, provides that the application for registration must contain a statement of the nature of the design as well as of the class or classes of goods in which the applicant desires the design may be registered. This infers that the applicant shall settle the purpose or object for which the design is to be registered,—pattern, shape, or ornament—and, accordingly, in the Board of Trade Rules issued in reference to the statute, it is provided by Rule IX. that the applicant in stating the nature of the design shall state whether it is applicable for pattern, shape, or configuration of the design. I see no reason to doubt that when a controversy of this kind arises as to infringement of a design, and it becomes necessary to determine whether protection was given to the design for pattern, shape, or ornament, or for any two or more of these purposes, either party may refer to the application for registration for a definition or description of the purpose of registration, and the Court will, if necessary, order the evidence on this subject to be produced, and such evidence should go far to decide the controversy. In the present case it is proved that the application was for a design for a ‘range-fire door, with moulding on top, moulding forming part of range, shape to be registered.’ That is a piece of evidence by itself, and, regard being had to the other evidence in the case, makes it clear that the pursuer’s design was registered not for any mere matter of ornament in connection with the form or hinges of the door or otherwise, but without reference to ornament, and solely for its shape in connection with the moulding on the top, which has material advantages” (a).

Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such

Registration
mark.

(a) *Walker, Hunter & Co. v. Falkirk Iron Co.*, 4 Rep. Pat. Cas. 390.

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design must, if the article is included in any of the classes 1 to 12, cause each article to be marked with the abbreviation 'Rd.' and the number appearing on the certificate of registration, and must, if the article is included in classes 13 or 14, cause each article to be marked with the abbreviation 'Regd.'

Provisions as to registration mark construed strictly.

These provisions will be construed strictly, and should any copies of a registered design be sold without bearing the registration mark when necessary (*a*), protection will be lost. A case arose under the 6 & 7 Vict. c. 56, on a bill being filed by Mr. Pierce, described as the proprietor of a newly invented chair called "the registered royal step chair," against the defendants, who were furniture manufacturers, to restrain the sale of certain articles of furniture described as improved combined chair and steps, used principally for library purposes. The defendants, by their answer and the evidence, contended that the article was not a new invention, but that similar articles of furniture had been made and sold by them and others in the trade long before the registration of this particular article. In addition, they said that the plaintiff had sold some of the articles without having the word "registered" attached to them with the date of registration. It was given in evidence by a person who had been in the employ of the plaintiff, that he was his foreman at the time of the registration of the design, the 13th Nov., 1867. That, as such foreman, he had forwarded on the 15th Nov., 1867, an order to a die-cutter at Sheffield for a die to be made for stamping oval metal plates which should have on them the words "Alfred E. Pierce, 109, Hatton Garden, London," and also the word "registered" and the date of the registration, the "13 Nov., 1867," and also for the striking off and stamping 2000 of such plates to be delivered to plaintiff in London. That none of the said plates were delivered to the plaintiff until the 31st January, 1868, when a

(*a*) 5 & 6 Vict. c. 100, s. 16. See 13 & 14 Vict. c. 104, ss. 12—14, and 38 & 39 Vict. c. 93. And an action lies for false representation as to the registry of a design: *Barley v. Walford*, 9 Q. B. 197.

packet containing 100 of such oval metal plates was delivered to him. That before the delivery of the said 100 plates there were not on the business premises of plaintiff any similar plates. That between the date of the said plaintiff's registration of his said design and the 31st Jan., 1868, a large number of combined chairs and steps made according to said plaintiff's said registered design, and amounting to upwards of fifty, were sold by plaintiff and delivered to various customers [the names of several of such customers were set out], and that they had not on them the word "registered" or the date of registration, but that all the said combined chairs and steps had on them an oval metal plate having on it the words "Alfred E. Pierce, patentee, 109, Hatton Garden, London," with the royal arms in the centre. The question was whether, under the circumstances, the plaintiff could obtain the relief prayed. For him it was contended that the spirit of the Act had been fully complied with, but the Vice-Chancellor Giffard said he considered the words of the 3rd section of the Act too clear for argument. It was a statute which must be rendered strictly; and therefore from the fact contained in the evidence, which was not denied, that plaintiff had sold many of these articles without the word "registered" or the date of registration attached to them, he must dismiss the plaintiff's bill with costs (a).

Although a bill to prevent an infringement did not allege that the requirements of the Acts had been complied with, yet the Master of the Rolls held, that the bill was not on that ground alone open to demurrer (b). Each piece sold must be marked, and if the proprietor sells in small pieces, whether for pattern or for use, he must mark each small piece or pattern (c); if in large pieces only he need mark only the large pieces (d). And where a narrow

(a) *Pierce v. Worth*, 18 L. T. (N.S.) 710.

(b) *Sarazin v. Hamel*, 32 Beav. 145; 9 Jur. (N.S.) 192; 32 L. J. (Ch.) 378—380.

(c) *Heywood v. Potter*, 1 Ell. & Bl. 439; 22 L. J. Q. B. 133; 17 Jur. 528; *Hothersall v. Moore*, 9 Rep. Pat. Cas., pp. 27, 39.

(d) *Blank v. Footman*, 39 Ch. Div. 678, 685; 5 Rep. Pat. Cas. 653.

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coloured trimming was sold by the maker in pieces of many yards having round them paper bands bearing "Rd." and the registration number, it was held that they were sufficiently marked (*a*). A butter-dish and cover were held to be sufficiently marked by marking the dish, as they together only constituted one article (*b*). And an article does not lose the protection of the statute when part of its registration mark becomes illegible during the process of manufacture (*c*); but a single instance proved of omission to mark has been held fatal (*d*). And under the corresponding provisions of the former Act it has been held that the copyright of a registered design is lost if the proprietor (whether English or foreign) sells the registered article even *abroad* without the letters "Rd." being attached thereto, as required by the 5 & 6 Vict. c. 100, s. 4, and 24 & 25 Vict. c. 73 (*e*); but under the policy of the present Act this decision does not seem to be applicable.

The terms of the 51st section of the Act are "Before

(*a*) *Blank v. Footman, Pretty & Co.*, 39 Ch. D. 678; 57 L. J. Ch. 909; 59 L. T. 507; 36 W. R. 921. In this case Mr. Justice Kekewich thus puts it: "It has been argued that the trimming itself ought to be marked, and it would be impossible, and it is admitted that it would be impossible to say where and how often it should be marked. It is obvious that you could not mark every quarter of an inch, and that even if you could do it, you could not, in lace-work like this, preserve the thing if you were to stamp it with marks. Therefore it is not suggested that this ought to be done, but it is said that every article, however small, ought in some way to shew that it is a registered design. That, to my mind, is entirely a misconstruction of the 51st section. The Act may or may not go far enough, but the Act says that a mark is to be placed before delivery on sale of any articles to which a registered design is to be applied. The marking is to be caused to be done by the proprietor of the design. If the proprietor of the design does not sell those articles of dress to which the trimmings are affixed, the section lays no liability upon him to mark those articles of dress—what is to be marked by him is the article to which a registered design has been applied—that is the trimming. If he sells it in pieces of 144 yards he must mark the piece of 144 yards. If on the other hand he sell small pieces, whether for patterns or for use, he must mark each small pattern in some manner in which those things can be conveniently marked, as for instance by tying on a label, or by printing something on the packet in which it is. But he is not bound to mark anything but that which he sells, and that is the exact consequence of the decision in *Fielding v. Hawley* (48 L. T. (N.S.) 639). There the Court held that whether it was a small piece or a large piece he must mark the piece sold, and so I say,—he must mark the piece sold and need not mark anything else."

(*b*) *Fielding v. Hawley*, 48 L. T. (N.S.) 639; 47 J. P. 582.

(*c*) See *Fielding v. Hawley*, *supra*.

(*d*) *Hunt v. Stevens*, W. N. (1878) 79.

(*e*) *Sarazin v. Hamel*, 32 Beav. 151; 9 Jur. (N.S.) 192; 32 L. J. (Ch.) 380.

delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered: and if he fails to do so the copyright in the design shall cease, unless the proprietor shews that he took all proper steps to ensure the marking of the article." Under this last saving provision comes the case of *Wittman v. Oppenheim* (a). There the proprietor of a registered design instructed the manufacturer, who made for him the articles to which the design was applied, to stamp the proper mark upon them and furnished him with a die for the purpose, but the manufacturer by inadvertence used an old die and marked some of the articles with a mark which belonged to another design registered by the same proprietor (the copyright of which had expired), both marks containing the letters Rd. in a prominent position; it was held that the proprietor had not forfeited his copyright by selling some of the articles so wrongly marked without observing his error, but was protected by the saving clause as having taken "all proper steps to ensure the marking."

It may be mentioned that it is not necessary to mark a book containing copies of registered designs under section 51 (b).

All designs of which the copyright has expired may be inspected at the Patent Office on the payment of the proper fee and on production of the number of the design, and copies may be taken; but *no* design, the copyright of which is existing, is, in general, open to inspection except to the proprietor or a person authorized in writing by him, or a person authorized by the Comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the Comptroller or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection is not to be entitled to take any copy of the

The register
open to
inspection.

(a) 27 Ch. Div. 260.

(b) *Branchardière v. Elvcry*, 4 Ex. 380; 18 L. J. Ex. 381.

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design. The Act of 51 & 52 Vict. c. 50, s. 6, provides, however, that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration is to be entitled to inspect the design so registered. Any person may, by application at the office, require a search to be made by the Comptroller to ascertain whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any design applied to such goods and registered since the commencement of the Act (a).

The Comptroller has power to dispense with evidence, to make amendments and to enlarge the time in every case (b).

*Duration of right.*Duration of
copyright.

Under the old law the period of protection varied, in the case of ornamental designs, from nine months (designs applied by printing to shawls or yarn, thread or warp, classes 8 and 9) to five years (designs applied to articles composed of metal, class 1), while in the case of utility three years was allowed. Under the new Act a uniform period of five years' protection from the date of registration is afforded to all designs without distinction of class or character.

But if a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design is to cease (c).

It is also provided that before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon his copyright in the design is to cease.

(a) Designs Rules, 1889, r. 3.

(b) Rules of 1883, rr. 29, 30 & 31.

(c) S. 54.

Transfer of Copyright in a Design.

The transfer of the copyright of a design must be in writing, as must also any partial assignment or license (a). Transfer.

The Patents, Designs and Trade Marks Acts, 1883 (b), provides that where a person becomes entitled by assignment, transmission, or other operation of law to the copyright in a registered design (c), the Comptroller shall, on request and on proof of the title to his satisfaction, cause the name of such person to be entered as proprietor of the copyright, and the person for the time being entered in the register as proprietor shall, subject to the provisions of the Act, and to (d) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise to deal with the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. And it is further provided, that any equities in respect of such design may be enforced in like manner as in respect of any other personal property.

By the Rules, a request is to be made by any person becoming entitled as above, for the entering of his name in the register as the proprietor, or as having acquired such right as the case may be, addressed to the Comptroller, and left at the Patent Office, Designs Branch.

Request to
make entry on
register.

This request is, in the case of an individual, to be made and signed by the person requiring to be registered as proprietor; and, in the case of a firm or partnership, by some one or more members thereof, or in either case by his or their agent, duly authorized to the satisfaction of the Comptroller; and, in the case of a body corporate, by their agent authorized in like manner (e).

(a) *Jewitt v. Eckhardt*, 8 Ch. Div. 404; 26 W. R. 415. There is no requirement to this effect in the present Act or rules as there was in the Act of 1842, sec. 6, but see opinion expressed by Wright, J., in *Woolley v. Broad* [1892], 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

(b) S. 87.

(c) Copyright in design devolves on the executor, *Jewitt v. Eckhardt*, *supra*.

(d) Added by 51 & 52 Vict. c. 50, s. 21.

(e) Rule 23.

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What request
to contain.

The request is to state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to shew the manner in which the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right, as the case may be.

Statutory
declaration to
accompany
request.

It must also be accompanied by a statutory declaration verifying the several statements, and declaring that the particulars comprise every material fact and document affecting the proprietorship of the design, or the right to apply the same, as the case may be, as claimed by such request. And the claimant is to furnish to the Comptroller such other proof of title as he may require. The following is the form of *Request to enter Name of Subsequent Proprietor of Design with Declaration in support thereof* :—

Form of
request.

I [*or We*] [*here insert name, full address, and description*] hereby request that you will enter my [*or our*] name [*or names*] in the Register of Designs as proprietor of the Design No. , in Class . I am [*or We are*] entitled as to the said design [*Here state whether design transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as, e.g. "by deed dated the day of 18 , made between so-and-so of the one part."*]

(a) And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said design as above-claimed.

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

[*To be signed here by the person making the declaration.*]

(a) This paragraph is not required when the declaration is made out of the United Kingdom.

Declared at
 this day of 18 , before me,
*[Signature and title of the authority before
 whom the declaration is made.]*
 To the Comptroller, Patent Office, Designs Branch.

It seems clear, from the 58th section of the Act, that a license must be in writing. But where the design is registered there seems to be nothing to prevent an assignee bringing an action for infringement without having registered his assignment (a); but North, J., in so deciding expressed the opinion that it was very desirable that assignments should be registered. As to licenses.

No time should be allowed to elapse between a transfer and its registration; for, in case of the bankruptcy of the registered proprietor of a design, after the execution of a transfer and before registration of such transfer, the copyright of the design would probably be considered in the order and disposition of the bankrupt, and would therefore pass to his trustee (b).

Remedy for Infringement.

During the existence of the copyright it is unlawful for any person :— Remedy for infringement.

- (i.) Without the license or written consent of the registered proprietor to apply or cause to be applied such design (c), or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, and
- (ii.) To publish or expose for sale any article of manufacture, or any substance to which such design, or any fraudulent or obvious imitation

(a) *Ihlee v. Henshaw*, 31 Ch. Div. 323.

(b) See *Longman v. Tripp*, 2 Bos. & Pul. New R. 67; *Hesse v. Stevenson*, 3 Bos. & Pul. 565; *Re Dilworth*, 1 Dea. & Chitt. 411.

(c) Added by sect. 7 of the Act of 1888.

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thereof, shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor (a).

Any person who acts in contravention of the above prohibition is liable to forfeit to the registered proprietor a sum not exceeding £50 for every offence, but not exceeding in all the sum of £100 in respect of any one design. Such sum may be recovered as a debt by action in any court of competent jurisdiction. Where the plaintiffs proved a single purchase of one hundred tiles one fine of £50 was imposed (b).

Under old act what necessary to prove.

Under the old Act it was necessary that the proprietor should prove that the offending party exposed the pirated goods for sale knowing that the proprietor had not given his consent: and the proof by the proprietor of this knowledge on the part of the offending party was more than the proprietor could in general adduce. This objectionable feature was omitted in the 7th section of the 5 & 6 Vict. c. 100, and in lieu it was provided that notice was to be given that the proprietor had not given his consent to the application of the design. And a notice was not sufficient unless it expressly stated that the proprietor of the design had not given his consent to the application of the design, and whether or not he intended to sue either for the application of the design to an article of manufacture or for the sale of such article with the design applied. It had also to specify the real claim intended to be made.

Notice by proprietor of copyright.:

What insufficient.

Thus where a notice was addressed to the defendants, both as manufacturers who had applied the design to articles of manufacture, and as retail dealers who had sold articles of manufacture to which the design had been applied by others, and stated that if the defendants either applied the design to an article of manufacture, or sold an article of manufacture with the design applied to it, the plaintiff would sue them; it was held that a sufficient notice had not been given, the court being of opinion that

(a) *Woolley v. Broad*, [1892] 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

(b) *Sherwood v. Decorative Tile Co.*, 4 Rep. Pat. Cas. 207.

it was not tantamount to a notice that the plaintiff had not given his consent to the application of his design to the manufactured article, and that such notice was perfectly consistent with the fact of his having actually given his consent, and could not be considered the performance of a condition introduced to save retail dealers from very serious liability (a).

No such notice in writing is required by the present Act to be given, though it has been said that to render a retail seller liable it should be shewn that before he sold the articles complained of, he had sufficient information of the plaintiff's registered design to enable him to judge what it was the plaintiff claimed (b). The words of the Act, however, hardly justify such a conclusion.

No notice need be given under present act.

The publication and sale of a book containing registered designs, with or without a notice that persons wishing to manufacture them for the purpose of sale must have the inventor's permission, does not amount to a license to purchasers of the book to sell articles to which the design has been applied, though it may amount to a license to copy the designs for private use (c).

As to what is "fraudulent and obvious imitation," some difficulty has arisen. In one case it was laid down that the Act does not prohibit imitation, a design being open to such great varieties; a fair imitation—that is something to which the idea of the original design has been applied, is not prohibited; and that "fraudulent imitation" is imitation with knowledge; conscious imitation, the man who imitates having the design before him, and knowingly and wilfully imitating, and his imitation not being sufficiently original to be protected as a fair imitation (d). And it has been further said that it is permissible to imitate a registered design if the result differs, as a whole, from

Meaning of "fraudulent and obvious imitation."

(a) *Norton v. Nicholls*, 5 Jur. (N.S.) 1203.

(b) *Smith v. Lewis, Roberts & Co.*, 5 Rep. Pat. Cas. 611 (Bristowe, V.C.).

(c) *Branchardière v. Elvery*, 4 Ex. 380; 18 L. J. Ex. 381.

(d) *Barron v. Lomas*, 28 W. R. 973, per Jessel, M.R. See *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 267.

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the registered design—if it is in fact substantially a new design (*a*).

“Obvious” does not mean obvious at a glance to the unskilled eye, but obvious to a judge or jury with the assistance of experts—persons conversant with the particular trade; and the test is not merely to look at the two designs side by side (though that is one element of comparison), but consideration should also be given to what would be the effect supposing they were seen at different times or looked at a little distance off (*b*).

Thus where the plaintiffs registered a design producing on calico a particular effect, familiar in silk and velvet, and the defendants prepared a design which in general arrangement resembled the plaintiffs’ and produced a similar effect, though there were variations in detail (*e.g.* where the plaintiffs’ design had acorns and sprays, the defendants substituted mangosteens and sprays closely resembling the plaintiffs’ in contour), it was held that the resemblance being so close as to make it impossible to distinguish the one from the other by memory alone, and there being coincidences between the two designs which would have been strange, but for the fact that the defendants’ designer had had the plaintiffs’ design before him, the defendants’ design was *prima facie* an “obvious imitation” of the plaintiffs’ and an injunction was granted till the trial. The defendants in this case had in fact put the plaintiffs’ design before their draughtsman and instructed him to produce the effect, but not to copy the plaintiffs’ design. The decision was approved by the Court of Appeal (*c*). Cotton, L.J., saying, “If a man knowing that the pattern is a registered design, goes and imitates it, and does that without any sufficient invention on his own part, that would be a fraudulent imitation, if in fact it is an imitation. There may be an imitation which is unconscious—that is to say, not an imitation in the sense of copying—

(*a*) *Thom v. Syddall*, 26 L. T. (N.S.) 15.

(*b*) *Grafton v. Watson*, 50 L. T. (N.S.) 420.

(*c*) 51 L. T. 141 (C.A.).

producing the same effect without knowing of the registered design ; but when the registered design is known, then if there is imitation the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated."

It is not easy to define in words exactly what is meant by a fraudulent imitation. This expression was no doubt introduced into the Act for the purpose of meeting the case of an imitation not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. The instance given by Mr. J. Manisty (a), is "having before your mind and before your eye the design of another and introducing into your design some differences in order, if possible, to avoid coming within the Act of Parliament."

Where a design was registered, the application being for "a range-door, with moulding on the top, moulding forming front of range; *shape* to be registered," and the drawing shewed a moulding on the front of the door fitting into the moulding on the front of the range and flush with it; and the evidence shewed that the merit of the design lay in attaching the moulding to the door instead of to the fire-cover, as had been done previously in convertible kitchen-ranges, it was held that another design, in which the moulding (which was of a different outline) on the door overlapped the moulding on the front of the range, was an obvious imitation of the registered design (b).

Example of obvious imitation.

An innocent infringer of a registered design must pay the costs of a motion for an injunction to restrain him from continuing the infringement, although the plaintiff has given him no notice of the infringement before serving him with the writ in the action, the plaintiff being under no obligation to give any notice before commencing his action (c).

Infringer not entitled to notice before action.

The case, however, is different with the retailer only of

Retailer only of pirated

(a) *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 207.

(b) *Walker, Hunter & Co. v. Hecla Iron Co.*, 15 C. of S. Cas. 660; 25 Scot. L. R. 491; 5 Rep. Pat. Cas. 71, 365; 6 Rep. Pat. Cas. 554.

(c) *Wittman v. Oppenheim*, 27 Ch. Div. 260; 54 L. J. Ch. 56; 32 W. R. 767; 50 L. T. (N.S.) 713; *Upman v. Forester*, 24 Ch. Div. 231;

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article entitled
to notice.

Penalty for
wrongfully
describing
design as
registered.

Proceedings in
Isle of Man.

the pirated articles; here it is necessary to show that before selling he had notice that the articles complained of were an infringement of the plaintiff's design, otherwise he will not be liable at all (*a*).

Any person who describes any design applied to any article sold by him as registered which is not so, is liable for every offence, on summary conviction (*b*), to a fine not exceeding £5; a person is deemed to represent that a design is registered if he sells the article with the word "registered" (or any word or words expressing or implying that registration has been obtained for the article), stamped, engraved or impressed on, or otherwise applied to the article (*c*). It is an offence to continue the sale of articles with the word "registered" on them after the expiration of the copyright (*d*). It has been decided that the English Courts have jurisdiction to expunge a trade mark from the register where the registered owner is domiciled in Ireland (*e*).

The Act of 1883 extends to the Isle of Man, and nothing in such Act is to affect the jurisdiction of the courts in the Isle in proceedings for infringement or in any action or proceeding respecting a design competent to those courts.

The punishment for a misdemeanour under the Act in the Isle of Man is to be imprisonment for any term not exceeding two years with or without hard labour, and with or without a fine not exceeding £100, at the discretion of the court. And any offence committed in the Isle of

52 L. J. Ch. 946; 32 W. R. 28; 49 L. T. (N.S.) 122; but not where the infringement is very trifling, *America Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 Rep. Pat. Cas. 218.

(*a*) *Halsey v. Brotherhood*, 15 Ch. Div. 514, 517; *Smith v. Lewis, Roberts & Co.*, 5 Rep. Pat. Cas. 611.

(*b*) In the application of the Act to Ireland "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1881, and any Act amending it (sect. 117, Act 1883).

(*c*) S. 105, Act 1883. And see the Merchandise Marks Act, 1887, which imposes penalties for applying any false trade description to goods. See sect. 3.

(*d*) See *Cheavin v. Walker*, 5 Ch. Div. 850, 863.

(*e*) *King & Co.'s Trade Mark*, 9 Rep. Pat. Cas. 350.

Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved in the manner in which offences punishable on summary conviction may for the time being be punished.

It may be worth while to note here that the jurisdiction given by the 26th section of the 51 & 52 Vict. c. 50, to the Court of Chancery of the County Palatine of Lancaster does not extend to designs, but is limited to trade-marks (a).

Jurisdiction of
County Pala-
tine of
Lancaster.

The copyright of designs protected under the Act of 1883, has no extra-territorial effect, and consequently the manufacture and sale by British subjects in a foreign country of goods, the design of which is protected under the statute, is not an infringement of that copyright (b).

Manufacture
and sale in
foreign
country.

Notwithstanding the remedy given by the Act of 1883, for the recovery of the penalties specified, the registered proprietor of any design may (if he elects to do so), bring an action for the recovery of any damages arising from the application of such design, or of any fraudulent or obvious imitation thereof, for the purpose of sale to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design, or any fraudulent or obvious imitation thereof, shall have been so applied, such persons knowing that the proprietor had not given his consent to such application (c).

Action for
damages.

In order to succeed in an action under sections 58 or 59 of the Act of 1883, it is necessary that the plaintiff be a registered proprietor. In a recent case the registered proprietor of a design applicable to lace goods registered under the Act of 1883, verbally agreed with the other plaintiffs to supply them all the goods manufactured by him according to the design, and to give them the exclusive right of selling such goods. The registered proprietor and the exclusive licensees having claimed to

Right to sue
only in regis-
tered pro-
prietors.

(a) By the Chancery of Lancaster Act, 1890, the Palatine Court has within its jurisdiction the same powers and jurisdiction as the High Court in its Chancery Division.

(b) *Potter & Co. v. Braco de Prata Printing Co.*, 18 C. of Sess. Cas. 511; 8 Rep. Pat. Cas. 218 (Sc.).

(c) S. 59.

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recover damages against a third person for applying the design to lace goods and selling goods to which it had been applied without the licence or written consent of the plaintiffs, the defendant raised the point of law that the statement of claim disclosed no cause of action in the licensees, and it was so held because the licensees were not the registered proprietors of the design, and the only right of action in respect of the injuries complained of was that given by section 59 of the Act to the registered proprietor exclusively. It was contended that section 61 shewed that the person who had the right to apply the design should be regarded as the proprietor, because this section provides that "every person acquiring for good and valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent but not otherwise." But the court considered the section did not touch the case, and was meant only to apply to cases like that of a servant who executes a new and original design for his master, and then the person for whom the design is made is to be considered the proprietor (a).

Burden of proof.

Where one person is already on the register and another person calls in question his right to be on the register, the burden of proof is on the party impeaching the title of the registered proprietor (b).

Considerations as to the remedy to select.

In selecting the mode of proceeding the effect of publicity in deterring others, the moral weight of the decision of the court in which the action or suit is brought, and the probability of the judge or magistrate going more or less into the minutiae of the case, should be thoughtfully regarded. In some cases, either from the fact of the defendant being in such a position that the moral effect

(a) *Woolley v. Broad*, [1892] 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

(b) *In the matter of Heinrichs' Registered Design*, 9 Rep. Pat. Cas. p. 73.

of so doing would be more effectual in preventing similar thefts for the future, or from the fact that the defendant may be a man of straw, it may be advisable to place him in the police court, while in others the more costly and efficient remedy provided by the Superior Courts of Judicature may be adopted.

There was no provision in the Designs Acts nor is there in the present Act analogous to that of the 23rd section of the Literary Copyright Act, 1842, as to the delivery up of unsold copies of a pirated book to the proprietor of the copyright without his making any compensation for the cost of production and publication; but in the case of *M'Crea v. Holdsworth* (a), Lord Justice Knight Bruce made an order under the Designs Act for the delivery up to the plaintiff, "for the purpose of being destroyed, the drawing or drawings, point paper, and the several cards used in applying his design, and also of the articles manufactured by the defendants to which the plaintiff's design had been applied."

No provisions for delivery up of pirated designs.

Proceedings may also be taken in the Chancery Division of the High Court of Justice in all cases.

Proceedings in the Chancery Division.

In a statement of claim under the Patents, Designs & Trade Marks Act, 1883, the following allegations should be inserted in their proper places; first, that previously to publication of the design the plaintiff caused a proper entry thereof to be made in the registry; secondly, there should also be special allegations that the design is new or original, and has not been previously published in the United Kingdom or elsewhere (b); thirdly that the defendant has applied the design without the licence or written consent of the registered proprietor, or has exposed articles for sale to which the design has been applied knowing that the same has been so applied without the consent of the registered proprietor.

The articles alleged to be piracies should be produced to the court, in order that they may be compared with

(a) 2 De Gex & Sm. 497; 12 Jur. 820.

(b) On pleading in Design cases, see *Sarazin v. Hamel*, 32 Beav. 145; and *Woolley v. Broad*, [1891] 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

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the original design and the articles to which it has been applied by the proprietor (*a*). But where the alleged piracies were proved to have been stolen out of the possession of the plaintiff, the uncontradicted testimony of a witness as to their nature has been held sufficient (*b*).

The court, or a jury, will then be able to pronounce, on the comparison, whether the registered design has been applied or not. But if what is complained of is a fraudulent imitation, and not an application of the exact design, it will be convenient, if possible, to shew by direct evidence that the defendant's design has been taken from the plaintiff's (*c*). As to costs, see *Grafton v. Watson* (*d*) and *Blank v. Footman, Pretty & Co.* (*e*); *Sherwood and Cotton v. Decorative Art Tile Co.* (*f*), *Winfield v. Snow* (*g*).

Terms on which particulars of objection may be amended.

The rule of practice in patent actions that a defendant will be allowed to amend his particulars of objections on terms that the plaintiff may elect to discontinue his action and the defendant bear the costs subsequent to the delivery of his first particulars, was applied to an action to restrain infringement of copyright in registered designs (*h*), but the judge has complete discretion (*i*).

In action under 58th sect., interrogatories cannot be delivered.

In an action under the 58th section the plaintiffs are not entitled to interrogate the defendant (*k*). The sum recoverable under this section is regarded in the light of a penalty, and consequently interrogatories cannot be administered.

Costs.

Where a defendant succeeds generally he may have the costs of some of his defences in which he has not succeeded; but where he has raised a distinct issue and has failed, he ought not to have the costs of that issue (*l*).

(*a*) *Sheriff v. Coates*, 1 Russ. & My. 159.

(*b*) *Fradella v. Weller*, 2 Russ. & My. 247.

(*c*) *Lowndes v. Browne*, 12 Ir. L. Rep. 293; cited Norman on 'Designs,' p. 51.

(*d*) 51 L. J. 141 (C.A.).

(*e*) 39 Ch. Div. 678, 685.

(*f*) 4 Rep. Pat. Cas. 207, 212.

(*g*) 5 Rep. Pat. Cas. 15.

(*h*) *Morris, Wilson & Co., v. Coventry Machinists' Company*, [1891] 3 Ch. 418; 60 L. J. Ch. 524; 40 W. R. 152; 8 Rep. Pat. Cas. 353.

(*i*) *Woolley v. Broad*, not yet reported on this point.

(*k*) *Saunders and another v. Wiel*, W. N. [1892] 95.

(*l*) *Blank v. Footman, Pretty & Co.*, 39 Ch. Div. 678.

In a case where the plaintiffs put in evidence which the court considered unnecessary and improper, though judgment was given in their favour, the court awarded them two-thirds only of the taxed costs (*a*).

Where the plaintiff rested on a single purchase of 100 tiles and there was no evidence that the defendants had been making a profit, the court considered that it ought to treat that as one offence, and consequently imposed a penalty of £50 (*b*).

Provisional registration was permitted by the 13 & 14 Vict. c. 104, the 1st section of which provided that any design registered in accordance with that Act should be deemed "Provisionally registered," and the registration should continue in force for the term of one year (which might be further extended for six months by the Commissioners of Patents) from the time of such registration, during which period the proprietor should have the sole right and property in such design, and be protected in the enjoyment of this right by the penalties and provisions enumerated in the Designs Act, 1842. During the term for which protection was afforded by this provisional registration, the proprietor of any design might sell or transfer the right to apply the same to an article of manufacture, but had he sold, exposed, or offered for sale, any article to which the design had been applied until after complete registration, the provisional registration would have been deemed null and void (*c*).

And neither the exhibition nor the exposure of any design provisionally registered, or of any article to which such design might have been applied, in any place, whether public or private, in which articles were not sold, or exposed, or exhibited for sale, and to which the public were not admitted gratuitously, or in any place which had

Damages.

Provisional registration of designs.

Exhibition of design provisionally registered not to prevent future registration.

(*a*) *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 207, 212.

(*b*) *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 207, 212. The total sum forfeitable now in respect of any one design shall not exceed £100, Patents, Designs & Trade Marks Act, 1883, s. 7.

(*c*) 13 & 14 Vict. c. 104, s. 4.