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by means not equivalent to drawing or painting or photographing, or any such means, but by totally different means, by the exhibition of living figures. Is that what is aimed at? It appears to me obviously and plainly it is not. When we look at the language used, where an idea of that kind was present to the mind of the Legislature, we find a totally different class of words selected. The word 'represent' is the word used in the Dramatic Copyright Act (3 & 4 Will. IV. c. 15), but there is not a word about representing in the Act with which we are dealing. It does not say that the author of a picture shall be entitled to prevent anybody from representing his picture. It is intended to protect the author of the picture from anybody's producing a painting, drawing, or photograph of his picture so as to compete with him in the market. The language appears to me to be incapable of being stretched so as to touch such a representation as is sought to be restrained by this case. Light is thrown upon the true construction of section 1 by section 6, which provides for the forfeiture, and section 10 which prohibits the importation of copies unlawfully made. Those sections are not applicable to this Act if it is construed as the plaintiff asks us to construe it. But I do not rely so much upon those sections as upon the clear, and what I consider the unquestionable, meaning and intention of Parliament in passing this series of Acts. If we are to go out of the language and look further, I think a good deal of light is thrown upon this question by the case of *Dicks v. Brooks* (a), because, although it is very true, as was pressed upon us by Mr. Scrutton, that the word 'design' is not used in the Engraving Acts, still, the object of the Acts in protecting engravings is exactly the same as the object which the Legislature had in view in protecting paintings, drawings, and photographs in this Act. It was not intended to give them the right to restrain Madame Tussaud from exhibiting a representation of a painting in waxwork; but to restrain people from producing something which would compete in the market with the originals or with authorised copies of them."

So Lord Justice Kay: "A reproduction of a painting must, one would think, be by another painting or something which is equivalent to another painting. The argument has been rather put on the ground that this is a reproduction of 'the design thereof' within the meaning of the Act. What does 'reproduction' really mean? Reproduction is producing again. Is this a producing again the design of this painting within

(a) (1880), 15 Ch. D. 22, *ante* p. 348.

the meaning of the Copyright Act? I cannot think that it is. It seems to me that in order to reproduce the painting you must have something which itself is and would be properly described as a picture." According to these views a sculpture apparently could not be an infringement of the copyright in a picture.

This case subsequently went to trial, when the court adhered to its former opinion as to the groups, but held that the backgrounds were infringements of the plaintiff's copyright (*a*).

At the same time that the plaintiff in the case above referred to commenced his proceedings against the Empire Palace he also took proceedings against two daily newspapers—the 'Daily Graphic' and the 'Westminster Budget'—for having published in their papers sketches, made by artists who had visited the Empire, of the tableaux vivants that had been represented on the stage of the theatre, alleging that these sketches were infringements of the copyright of his pictures, though the sketches were not taken directly from the pictures, but indirectly through the tableaux vivants. Mr. Justice Stirling held that, though the tableaux vivants were not themselves infringements of the plaintiff's copyright, nevertheless the sketches published in the newspapers were reproductions of the design of the pictures and he granted an injunction (*b*).

From this decision the 'Westminster Budget' did not appeal, but the 'Daily Graphic' did, and succeeded in obtaining a reversal of Mr. Justice Stirling's decision in the Court of Appeal (*c*), and the decision of the Court of Appeal was finally affirmed by the House of Lords (*d*).

Mr. Justice Stirling considered, on the authority of *ex parte Beal* (*e*), that the fact that the sketches were indirect, and not direct, copies of the pictures made no difference, and that the sketches must be treated as copies of the pictures. The answer to the argument that the illustrations in no way competed with copies of the pictures authorized by the plaintiff appeared to him to be that the illustrations constituted a violation of the exclusive right conferred by the statute of 1862; that, in the language of Kelly, C.B., in *Bradbury v. Hotten* (*f*), the defendants were thereby applying for their own use and for their own profit what otherwise the plaintiff might have turned, and possibly might still turn, to a profitable account.

In the Court of Appeal Lord Justice Lindley was not

(*a*) (1895), 11 Times L. R. 314, 368; (1895), W. N. 76.

(*b*) *Hanfstaengl v. Newnes* (1894), 3 Ch. 109.

(*c*) *Ibid.*

(*d*) *Hanfstaengl v. Baines & Co.* (1895), A. C. 20.

(*e*) (1868), L. R. 3 Q. B. 387.

(*f*) (1872), L. R. 8 Ex. 1, 6.

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prepared to say, as a matter of law, that although the sketches were made from something in which there was no copyright, and although they represented something which was not of itself an infringement of the plaintiff's copyright, the sketches might not infringe the plaintiff's rights, if they could be fairly regarded as reproductions of his pictures, or of the designs thereof. To hold otherwise would be to open the door to indirect piracies, which he was not all disposed to do. A copy of a foreign copy of an English painting would not, he apprehended, be protected by sect. 2 (a), and the judgment of Lord Blackburn in *ex parte Beal* (b) showed that if a painting is, in fact, reproduced, it is immaterial what the intermediate steps might be by which the reproduction was arrived at. His decision was based upon different and wider grounds. "The sketches are not intended to be, and are not, in fact, copies of the pictures at all, neither are they intended to be, nor are they, in fact, reproductions of the designs of the pictures. They do not represent any of the beauties. They are rough sketches, made for a different purpose and answering a very different purpose, that purpose being, not to give an idea of the plaintiff's pictures, but to give a rough idea of what is to be seen at the Empire Theatre. In giving that idea, it is true that they also give a very rough idea of the subject represented in the plaintiff's pictures. It is also true that in *West v. Francis* (c) Mr. Justice Bayley said: 'A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original.' But in applying this to any particular case the degree of resemblance is all important, and the possibility of injury to the plaintiff must be regarded. It is only by a great stretch of language and by the exercise of much imagination that these sketches can be regarded as copies of the plaintiff's pictures or the designs thereof. The case is very unlike *Gambart v. Ball* (d), where engravings were copied by photography. I cannot bring myself to say that the sketches complained of are, in any fair sense of the words, copies of the plaintiff's pictures or reproductions of the designs thereof within the meaning of the statute to which I have referred. The question, if it came before a jury, would be one of fact for the decision of the jury, or a proper exposition by the judge of the meaning of the statute, and I do not believe that any jury, properly directed, would find these sketches to

(a) See *Murray v. Bogue* (1852), 1 Drew. 353.

(b) (1868), L. R. 3 Q. B. 387.

(c) (1822), 5 B. & Ald. 737, 743.

(d) (1863), 14 C. B. (N.S.) 306.

be copies of the plaintiff's pictures or reproductions of his designs. The defendants have not, in fact, directly or indirectly, intentionally or unintentionally, made any use, certainly not any unfair use, of the plaintiff's pictures or of the brains of their authors" (a).

In the House of Lords Lord Herschell, L.C., was equally clear that the defendants had not infringed the plaintiff's copyright. It was obvious, he said, that the plaintiff could not successfully claim to have a monopoly of every treatment of such common subjects as love and courtship, or charity. He was far from saying that a "Living Picture" might not be so arranged to represent an existing painting that a photograph or drawing of the "Living Picture" would be a copy of the design of that painting. All that he could say was that this must depend upon the character of the picture, and what is justly to be regarded as its design. In the present case, the sketch most favourable to the plaintiff's case was admittedly that representing "Courtship." As to that, "there is no doubt a resemblance between the sketch and the photograph from the painting. In each case a young man and a young woman are standing beside one another close to a stile or fence. In each case the woman is shading her head by a parasol, and the dress of the man is somewhat similar in the two. The idea suggested is, of course, the same, each represents 'Courtship,' but the idea of a young man courting a young woman at a country stile is of great antiquity. It has often formed the subject of pictorial representation. This cannot be said to be the design of the plaintiff's painting within the meaning of the Act. Much more must be comprehended than this. There can only be a copy of such a design if the treatment of the subject be the same. Now, comparing the sketch with the photograph from the painting, I do not think this can be said to be the case. The faces are different; the mode in which the woman's hair is arranged is different; the pose is different; the attitudes are different; the background is different; and in the case of the sketch the foreground is wanting. In the artist's design all these things play a part, and, though I do not say that a variation in one or even more of these respects would prevent the sketch being a copy of the design, yet comparing the two, and considering the design of the painting as a whole, I cannot avoid the conclusion that the sketch is not a copy of the painting or of the design thereof, and therefore that there has been no infringement" (b).

(a) (1894), 3 Ch. p. 131.

(b) (1895), A. C. p. 24.

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Effect of decisions in the "Living Picture" cases.

Too much stress must not be placed upon the fact that in these cases some of the judges attached importance to the fact that the alleged piracies could not compete in the market with the plaintiff's pictures. A photograph hardly competes in the market with a painting, yet the owner of the copyright in a painting clearly has a right to prevent sales of a photograph of it, for the artist himself may some day make and sell such a photograph. In *Hanfstaengl v. Holloway*(a), copies of the plaintiff's pictures were put on pill boxes, yet this was held to be an infringement of copyright. Nor again did the decisions in the "Living Pictures" cases turn entirely on the fact that the copies were bad imitations. The effect of the decisions, it is submitted, rather is that the combination of circumstances must be looked at; and that, if it be found that the alleged copies are made for entirely different objects from the original picture, then it is of importance to examine how close a copy the alleged infringement is of the original picture. Another matter that may be taken into consideration is whether the conception of the picture is original or hackneyed.

What is the "design" of a picture?

We may conclude from the "Living Picture" cases that the words, "the design thereof," in section 1 of the Act of 1862, do not mean the "idea" of the picture. Lord Justice Davey thought that these words were probably inserted in order to bring within the protection of the Act a copy through a different medium; for instance, a black and white copy of a picture made by the engraver, the photographer, or the draftsman (b). According to Lord Watson the expression means nothing more than the particular forms and arrangements (whether of lines or colouring) which the copyright author has selected as the vehicle for conveying his idea to those who see his work. He thought there might very well be cases in which the author's design, and the idea to which it gives birth, would be both of them so novel and exceptional that it would be difficult, if not impossible, for another author to create the same idea without trenching upon his design (c). If this latter opinion be correct the design of a picture is only of importance when it is exceptionally original.

Remedies for infringement.

The remedies of a proprietor of copyright in paintings, drawings, and photographs, in respect of infringements, are: (1) Penalties; (2) damages under section 11; and (3) an injunction. Section 10 also prohibits the importation of piratical copies and provides that if the proprietor of the copyright or

(a) (1893), 2 Q. B. 1; cf. *Hildesheimer v. Faulkner* (1901), 2 Ch. 552.

(b) (1894), 3 Ch. at p. 134.

(c) (1895), A. C. at p.

his agent shall declare that any goods imported are repetitions, copies, or imitations of his work, then such goods may be detained by the officers of His Majesty's Customs.

The penalties to which an offender is liable under section 6 are to pay to the proprietor a sum not exceeding £10 "for every such offence" and to forfeit the infringing copies. It was held so long ago as the year 1868, in *Beal's case*, that the offender 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. "It is quite clear," said Mr. Justice Blackburn, that the section "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 worth his while to run the risk of paying 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" (a).

Penalties
recoverable.

Though the statute mentions a maximum penalty, it does not prescribe a minimum penalty. It has been held in several cases (b), that a farthing, being the smallest coin of the realm, is the smallest penalty that can be imposed in respect of each copy sold, but obviously if a large number have been sold, a sum of one farthing in respect of each might amount in the whole to a far larger sum than the justice of the case required, and in a recent case (c) the Court of Appeal, whilst approving and following *Beal's case*, have held that the court may award for all the offences a lump sum, which, if divided by the number of offences, will give for each a fraction less than a farthing. "The only reason," said Collins, L.J., in the case referred to, "why a farthing is generally adopted as the lowest measure of recoverable damages in this country is that a

(a) *Ex parte Beal* (1868), L. R. 3 Q. B. 395; *Hildesheimer v. Faulkner* (1901) 2 Ch. 552.

(b) *Ellis v. Marshall* (1895), 64 L. J. Q. B. 757; *Buschet v. London Illustrated Standard Co.* (1900), 1 Ch. 73; *Green v. Irish Independent Co.* (1899), 1 Ir. Rep. 386.

(c) *Hildesheimer v. Faulkner* (1901), 2 Ch. 552, since followed in *Nicholls v. Parker* (1902), 18 T. L. R. 459, which, it is believed, is under appeal to the House of Lords.

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farthing is the lowest sum for which execution can issue, it being; I believe, at the present time, the smallest sum which is actually coined. But when there is no need to issue execution for that particular sum, where is the necessity that the sum assessed as the proper penalty should be represented by a coin? It seems to me that when, as here, execution is not contemplated for the particular penalty, there is no reason in principle or common sense why the penalty should not be measured as it ought to be, namely, by relation to the offence and not by reference to the possibility of levying execution, which is the only justification for giving a larger sum than justice would require."

Ignorance,
when an
excuse.

It will be noticed that under section 6 the person making the infringements, or causing them to be made, is liable to penalties, even though he acts ignorantly, but a seller or importer is only liable when he acts with knowledge that the copies have been unlawfully made.

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 (a)*. 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 second count charged him with being a *cheat* at common law (*b*), by reason 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

(a) (1858), 27 L. J. (M.C.) 54; 7 Cox, C. C. 494; 6 W. R. 109.

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

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 show 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, without his consent, or shall knowing 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.

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

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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.

The penalties imposed as a punishment for a criminal offence.

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

(a) *Graves, Ex parte, In re Prince* (1868), 19 L. T. 241; Law Rep. 3 Ch. 642; 16 W. R. 993; *Bancroft v. Mitchell* (1867), Law Rep. 2 Q. B. 549. See, however, *Johnson, Ex parte, In re Johnson* (1867), 15 W. R. 160; 15 L. T. 163; *Re v. Stokes* (1775), Cowp. 136; *Re v. Wakefield* (1812), 13 East, 190; *Re v. Myers*, 1 T. R. 265. As to limitation of time of three months for action under the 8 Geo. II. c. 13, not applying to an action on the case brought under 17 Geo. III. c. 57, see *Graves v. Mercer* (1868), 16 W. R. 790.

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 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 in 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.

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 Copyright

Provisions as to forfeiture of piratical copies.

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Commissioners of 1878, where a conviction for selling piratical copies having been obtained, the magistrates had made an order that the copies should be delivered up, but it was found that the order could not be enforced.

Action for damages.

The right to damages conferred by section 11 is expressly stated to be in addition to the plaintiff's right to recover penalties. Under this section the plaintiff need not prove guilty knowledge on the part of the offender, and he can in the same action recover damages not only for the infringement, but also for the retention or conversion of all unlawful repetitions, copies, and imitations and negatives of photographs.

Production of original picture not necessary in action for infringement.

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; 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. In one case (*a*) the plaintiff, the proprietor of the copyright in a painting called 'The Peacemaker,' by Marcus Stone, R.A., did not produce the picture, but gave evidence that he had seen it, and that a photograph sold by the defendants, which he produced, was directly taken from an engraving which was an exact copy of the original picture, and he produced the engraving. It was held that this evidence was admissible to prove the infringement, and was evidence for the jury that the photograph sold by the defendants was a copy or the original picture.

Indecent works.

There can be no copyright in any obscene, immoral, or libellous picture, and where an action in respect of infringement fails on the ground of the indecency of the work, and the indecency has been repeated in the infringements, the action will be dismissed without costs (*b*).

There is no limitation as to the time within which actions are to be brought under the Act of 1862.

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 (*c*).

The Royal Commissioners in their Copyright report, 1878, felt some difficulty on the subject of photographs. They

(*a*) *Lucas v. Williams & Sons* (1892), 2 Q. B. 113; 61 L. J. Q. B. 595.

(*b*) *Baschet v. London Illustrated Standard Co.* (1900), 1 Ch. 73.

(*c*) See Chap. on International Copyright, *post.*; but the Act of 1862 does not extend to the Colonies; *Graves v. Gorrie* (1903), A. C. 496.

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 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.

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).

Artists' studies and sketches.

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

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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 *bonâ fide* sketches and studies for such works and compositions, provided that he does not repeat or colourably imitate the design of the original work (a).

Replicas.

Where an artist has painted a picture on commission, 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.

(a) Par. 118-124.

PART IV.
COPYRIGHT IN DESIGNS.

CHAPTER I.

SUBJECT-MATTER OF COPYRIGHT.

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.

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The first act
for protection
of designs.

The first Act granting protection to the inventor of designs was passed in 1787 (the 27 Geo. III. c. 38). This Act was followed by the 29 Geo. III. c. 19, and the 34 Geo. III. 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.

Division of
the right.

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 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).

(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.

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 (*a*), 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 nine months to five years.

Copyright in designs for ornamental purposes.

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."

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.

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 designs 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 (*b*), which provided that the proprietor of such design not previously

Useful designs.

(*a*) As to what amounts to publication, see *Cornish v. Keene* (1835), Webst. Pat. Ca. 501, 508. See *Anon.* 1 Chitt. 24; *Carpenter v. Smith* (1841), 9 M. & W. 300; S. C. Webst. Pat. Ca. 530, 536; *Jones v. Berger* (1843), *ibid.* 550; *The Household Co. v. Neilson* (1843), *ibid.* 718, n.; *Stead v. Williams* (1845), 7 Man. & Gran. 818. See *Prince Albert v. Strange* (1819), 1 H. 8 Tw. 1; *Dalglish v. Jarrie* (1850), 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.

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

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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.

Existing
legislation.

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 (a). 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 (b).

Definition.

A design is "for the purposes of this Act" to mean any design applicable to any article of manufacture, or to any substance 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 (c), 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

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

(b) 46 & 47 Vict. c. 57, s. 50 (1); Designs Rules, 1890, r. 21.

(c) Colour cannot be the subject-matter of a design; *Grafton v. Watson* (1884), 50 L. T. at p. 423; *Nevill v. Bennett* (1898), 15 R. P. C. at p. 417.

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*).

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, and therefore not the subject of registration; and a conviction for the infringement of such a registered design was quashed for want of jurisdiction (*b*). 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" (*c*).

Shape and
configuration.

Again, the design of a "protector label," which consisted in

(*a*) *Walker, Hunter, & Co. v. Falkirk Iron Co.* (1887), 14 C. of S. Cas. 1072 (Sc.), 21 Scot. L. R. 751; 4 Rep. Pat. Cas. 390.

(*b*) *Reg. v. Bessell* (1851), 15 Jur. 773; 20 L. J. (M.C.) 177; 16 Q. B. 810.

(*c*) The contrary was held in *Heywood v. Potter* (1853), 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.

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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 (*a*). 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 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 (*b*).

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

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 that his claim was for the pattern of a basket consisting in the osiers being worked in singly, and all the butt ends being outside, 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 (*c*).

In another case the plaintiff's design for the shape and configuration of that part of the corset in which the busks are inserted was expunged from the register as not being proper subject of a design. In previous corsets the busks were either sewn into the front of the corset or were laced in so as to be easily removable, but with the lacing at the outer margin of the busks. In the plaintiff's corsets the busks were laced in and thus were easily removable, but the lacing was diagonal

(*a*) *Margetson v. Wright* (1848), 2 De G. & Sm. 420.

(*b*) *Rogers v. Driver* (1850), 20 L. J. (Q.B.) 31; 16 Q. B. 102. See *Millingen v. Picken* (1845), 1 Com. Ben. Rep. 799; 14 L. J. (N.S.) (C.P.) 254; 9 Jur. 714. These cases were decided under the utility statutes. Whether a design is useful or not is now wholly immaterial. "What you have to see is whether, tested by the eye, the design is novel or original within the meaning of the Act. That it may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original." *Per* Farwell, J., *re Morton's Design* (1900), 17 R. P. C. 117.

(*c*) *Moody v. Tree* (1892), 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."

and at the inner margin of the busks, so that when fastened by studs and clasps this diagonal lacing gave the appearance of the corset having been really laced together. The court considered that, as there was no new appearance given by the plaintiff's design, there was not, so far as design was concerned, any novelty or originality that could be tested by the eye (a).

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, 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 a case before the Lords of the *Hecla Foundry Co. v. Walker, Hunter & Co.* (b). 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

(a) *Cooper v. Symington* (1893), 10 L. R. (Ct.) 261.

(b) (1889), 14 App. Cas. 554; 5 Rep. Pat. Cas. 71; 6 Rep. Pat. Cas. 554; *Harper & Co. v. Wright* (1899), 1 C. 12.

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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 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 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

(*a*) (1888), 15 Court Sess. Cas., 4th Series, 660.

(*b*) (1887), 14 Court Sess. Cas. 4th Ser. at p. 1081; 4 Rep. Pat. Cas. 390.

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 showing that, when applied to a range, it would not exclude the air."

In a former edition of this work it was stated that it was the received opinion that under the old Act, 6 & 7 Viet. 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; and Mr. Justice Byrne has recently decided that a design may at one and the same time be the subject of a patent and a design (*c*).

Design may be registered even if patentable.

The classification of articles of manufacture and substances as given in the Rules, 1890, is as follows: Classification.

Classes.

1. Articles composed wholly or chiefly of metal, not included in class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier-mâché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including bookbinding of all materials.

(*a*) *Roger v. Driver* (1850), 16 Q. B. 108; see *Millingen v. Picken* (1845), 1 C. B. 799, 812.

(*b*) (1887), 14 Court Sess. Cas. 4th Ser. at p. 1081; 4 Rep. Pat. Cas. 390.

(*c*) *Werner Motor Co. v. Gamage* (1904), 1 Ch. 264.

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7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths and oil-cloths.
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*).

According to the terms of section 47 of the Act of 1883 to entitle a design to be registered it must be—

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

(1) *New or original.*

Rule as to what is a proper subject of registration.

A design must be either new or original and there may be a distinction between “new” and “original.” Every design which is original is new, but every design which is new is not necessarily original (*c*).

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 (*d*).

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

(*a*) *Hottersall v. Moore* (1892), 9 Rep. Pat. Cas. 27.

(*b*) *Harden Star Hand Grenade Fire Extinguisher Co. Trade Mark and Designs* (1886), 3 Rep. Pat. Cas. 132.

(*c*) *Per Chitty, L.J., re Rollason's Design* (1898), 1 Ch. 237, 248.

(*d*) *Le May v. Welch* (1884), 28 Ch. D. 24; 54 L. J. Ch. 279; 33 W. R. 33; 51 L. T. (N.S.) 867; *Bach's Case* (1889), 42 Ch. Div. 661; 6 Rep. Pat. Cas. 376; *Hottersall v. Moore* (1892), 9 Rep. Pat. Cas. 27; *Heath v. Rollason* (1898), A. C. 499. In *Tyler v. Sharpe* (1893), 11 R. P. C. 35, Mr. Justice Romer seems to have considered that the commercial success of a design was evidence of its novelty, but it would seem rather to be evidence of its utility, which is immaterial, *ante* p. 410, note (*b*).

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 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." 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 shown 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 of 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 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 (b).

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

(a) *Le May v. Welch* (1884), 28 Ch. D. 24, 34; *Cooper v. Symington* (1893), 10 R. P. C. 264.

(b) *Smith v. Hope Bros.* (1889), 6 Rep. Pat. Cas. 200; *Sherwood's Design* (1892), 9 Rep. Pat. Cas. 268; *re Morton's Design* (1900), 17 R. P. C. 117, the shank of a sleeve link.

An original combination 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* (a). The plaintiff registered, under the 5 & 6 Vict. c. 100, a design for ornamenting woven 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 (b). 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 (c), but the combination of a bassinette and mailcart was held to be well registered (d).

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 shown 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 (e).

(a) (1859), 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.* (1887), 4 Rep. Pat. Cas. 207.

(b) *Mulloney v. Stercus* (1861), 10 L. T. 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: *Windsor v. Smith* (1863), 11 W. R. 323; 32 Beav. 200; 32 L. J. (Ch.) 561; 9 Jur. (N.S.) 397; 7 L. T. (N.S.) 776.

(c) *Lazarus v. Charles* (1873), 16 Eq. 117; 42 L. J. Ch. 507.

(d) *Rivett v. Grimshaw* (1894), 11 R. P. C. 351.

(e) *McCrea v. Holdsworth* (1870), 23 L. T. 444; L. R. 6 Ch. 419; 2 H. L. 380.

In *Reg. v. Firman* (a) 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 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 (b). CAP. I.
But the combination must be one design and not a multiplicity.

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 showed 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 (c).

In another 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 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 *Hothersall v. Moore.*

(a) Cited in *Harrison v. Taylor* (1859), 3 H. & N. 304.

(b) *Norton v. Nicholls* (1859), 5 Jur. (N.S.) 1202, 1205.

(c) *Ib.*

CAP. I. 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 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 show 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, the evidence showed that 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).

Novel
application.

But it is not necessary that a design should be novel in its subject-matter if its application to some article of manufacture be novel. In *Adams v. Clementson* (c) 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. An injunction was refused to restrain the defendant from supplying earthenware with a portrait of the general copied from a similar photograph furnished to him.

Saunders v. Wiel.

The case last cited was, however, doubted by the Court of Appeal in the important case of *Saunders v. Wiel* (d). There

(a) *Hothersall v. Moore* (1892), 9 Rep. Pat. Cas. 27.

(b) *Smout v. Slaymaker & Co.* (1890), 7 Rep. Pat. Cas. 90.

(c) (1879), 12 Ch. D. 714; 27 W. R. 379.

(d) (1893), 1 Q. B. 470.

the plaintiffs registered as a design in Class I. (namely, articles comprised wholly or partly of metal) a representation of Westminster Abbey intended to be applied to the handles of spoons and forks. The original design was made by an artist employed by the plaintiffs, from a photograph of the Abbey. The defendant made and sold metal spoons bearing on their handles a similar representation of the Abbey, and the court gave judgment for the plaintiffs in an action for infringement. "What we have to consider," said Lindley, L.J., "is whether this registered design—for a design of some sort, of course, it is—is a design applicable for the pattern and for the shape to things in Class I., and in particular to forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Why is it not? Has such a design applicable to metals ever been seen before? If you ask that, you are told this: 'Yes, if you mean a view of public buildings, or if you mean a view of cathedrals and churches, they are common enough; therefore, there is no novelty in the 'idea.' But if you ask a little closer, whether anybody has previously taken this particular aspect of Westminster Abbey, and used it as a design applicable to things in Class I., or to any things like it, the answer is, 'No, that is new, and never has been published before.' That answer seems to me to bring the plaintiff's case within the Act of Parliament; and I think the answer to the argument addressed by the defendant is this: he says the Abbey is not a design within the meaning of this Act of Parliament. In one sense, of course, it is a very valuable design. If an architect was thinking about building an abbey, having Westminster Abbey before him, it would be a very valuable design, but it is not a design within section 60 until you come to apply it, as a design, to some article of manufacture, and, therefore, you cannot say that, abstractly and as a general proposition, Westminster Abbey is a design. Then it is said the photograph is a design. The answer is, the photograph, whatever it may be in other Acts, is not a design within this Act until you apply it to something. The plaintiffs are not infringing the copyright of the photographer, or, if they are, we need not discuss that. What they are doing is this: they are making precisely the same use of the photograph which they might have made of the Abbey itself, and they are doing nothing more than taking that which anybody can see, if he chooses to go down to Westminster Abbey, and applying what is there to be seen for a particular purpose. They bring themselves within both s. 60 and s. 47." The Lord Justice

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then goes on to point out that *Adams v. Clementson* was decided under the earlier Act of 5 & 6 Vict. c. 100, s. 3, and remarks: "I cannot help thinking that the Vice-Chancellor there, even under the old Act, slipped into an erroneous view, and took 'design' rather as an abstract design instead of a design applicable to particular modes of manufacture."

So a design for an upright hexagonal metal stove, the sides of which had the representation in metal-work of a church window, of a particular style of architecture, with tracery above and below, was held to be properly registered under the Act (a). On the other hand, when C. registered a design for a "Lamp for electric lighting applicable for its shape," which was, in fact, a design for a lamp-shade, consisting of a reflecting screen which had been erroneously used for gas lights, and a ventilating top not materially differing from those which had been used before for gas, except that a chimney, which was required for gas lights, but not for electric lights, was omitted, it was held that there was no such originality or novelty in the design as to make it a proper subject of registration (b).

A design already registered in respect of one class cannot be registered as new or original in respect of other classes if the designs are to be used for similar purposes (c).

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, 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 applicant was a person aggrieved within section 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 design already registered in one class cannot be registered in other classes.

(a) *Harper & Co. v. Wright* (1896), 1 Ch. 142.

(b) *Re Clarke's Design* (1896) 2 Ch. 38.

(c) *Re Read & Gresswell's Design* (1889), 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. 450; 6 Rep. Pat. Cas. 471.

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 section 58, which gives a special remedy by penalty for the infringement 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 applied

Unless to be used for different purpose.

(a) (1887), 4 Rep. Pat. Cas. 390.

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not to a different thing or to a different purpose, but 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 candles, 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 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?"

(a) (1887), 42 Ch. D. 661; 6 Rep. Pat. Cas. 376; 38 W. R. 174; *re Clarke's Design* (1896), 2 Ch. 38.

(b) 28 Ch. D. 24.

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 shown, 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."

But comparatively slight alterations from an old design may sometimes entitle a new design to registration. Thus, R. registered a design for coffin plates. The drawing showed a set of irregular four-sided coffin plates, with leaf-shaped projections at the corners, each of which contained a shell-pattern ornamentation with double lines or rims running round the inner edges of the plate and enclosing the centre of it, and also double lines enclosing the shells, and in the view taken by the court the drawing indicated that the plate had a sunken centre. S. had previously registered a design of a somewhat similar character, with shells at the corners, but without the inner double lines or rims enclosing the centre and the shells; and in the view taken by the court, his

Alterations in
old design.

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drawing indicated a flat centre. It was held that R.'s design was new and original (a). But the substitution of a flange to a lamp, in lieu of slip-fittings, was held not to make the design a new one (b).

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

What is
publication?

The disclosure of a design to a partner or any necessary agent confidentially is not a publication. Thus, where the inventor of a design for a writing-table, previously to registering it and while perfecting it, consulted a person with whom he had business relations as to the design, and sent him a sample for his inspection and opinion, it was held that there had been no previous publication (c). 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 (d), though the disclosure to the agent would not have been such, since he had an interest in the sale of the design (e). The question was raised, but not decided, in *re Gresswell's Design* (f), whether registration alone of a design would be publication; but, *semble*, it would not.

Exhibiting at
exhibitions.

By section 57 of the Act of 1883, it was provided that the exhibition of a design at an industrial or international exhibition shall not prevent or invalidate the registration of the design, provided the exhibitor gives to the Comptroller seven days (g) notice in writing of his intention to exhibit the design and that he applies for registration within six months from the date of the opening of the exhibition.

(a) *Re Rollason's Design* (1898), 1 Ch. 237; S. C. on appeal *sub nom*; *Heath & Sons v. Rollason* (1898), A. C. 499.

(b) *Re Sherwood's Design* (1892), 9 R. P. C. 268.

(c) *Heinrich v. Bastendorff* (1893), 10 R. P. C. 160; *Westley Richards & Co. v. Perkes*, *ib.* 181.

(d) *Blank v. Footman* (1889), 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* (1891), 8 Rep. Pat. Cas. 15.

(e) See *Humpherson v. Syer* (1887), 4 Rep. Pat. Cas. 184, 407.

(f) (1889), 6 R. P. C. 473.

(g) See R. 36 of Designs Rules, 1890.

CHAPTER II.

REGISTRATION 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.

Notices of trusts are not to be entered on the register (*a*), 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 (*b*). The Comptroller may refuse to register any design of which the use would in his opinion be contrary to law or morality (*c*). 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 (*d*). Inspection of register.

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 (*e*).

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 Inspection of registered designs.

(*a*) S. 85.
(*c*) S. 86.

(*b*) See *Stewart v. Casey*, 9 Rep. Pat. Cas. 9; [1892] 1 Ch. 104.
(*d*) S. 88. Rules 33 and 34 of 1890.

(*e*) S. 89.

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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 design (*a*). 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.

The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the office, and inform any person requesting him so to do 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 registered design applied to such goods of which the copyright is still subsisting (*b*).

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 (*c*).

Who may
register.

An application to register must be in the prescribed form (*d*), and may be made by any person claiming to be the proprietor of the design or by any agent duly authorized on his behalf (*e*).

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

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

(*a*) S. 52.

(*b*) Designs Rules, 1890, r. 35. A letter giving the result of this search is not evidence; *Smith v. Hope Bros.* (1889), 6 R. P. C. 204.

(*c*) Sect. 93, Act of 1883.

(*d*) See the forms in Schedules to the Rules of 1890 and for lace designs, Rules of 1893. App. F. *post*.

(*e*) But the Comptroller is not bound to recognise an agent whose name has been erased from the Register of Patent Agents. See Rules of 1898.

become the property of the master by virtue of the 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; 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 (c).

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 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 (e).

Any application, notice or other document authorised or required to be left, made or given at the Patent Office or to

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

(a) *Lazarus v. Charles* (1873), 16 Eq. 117-123.

(b) S. 61.

(c) *Jewitt v. Eckhardt* (1878), 8 Ch. Div. 404-409; *Re Guiterman's Registered Design* (1886), 55 L. J. Ch. 309, p. 310; *Woolley v. Broad* (1892), 1 Q. B. 806.

(d) Rule 26. Foreigners may register, *re Carez* (1889), 6 R. P. C. 552.

(e) *In re Guiterman's Registered Designs* (1886), 55 L. J. Ch. 309.

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the Comptroller or to any other person under the Act, may be sent by a prepaid 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).

Statement of
nature of
design.

The form of application must contain the name, address, and description of the individual or firm making the application, and must be signed by the applicant or his duly authorized agent (b). It must also 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 (c).

The statement of the nature of the design is not required to be like the specification of a patent (d), 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 (e), or in a case of difficulty apply to either of the law officers of the Crown for directions (f).

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 thereto a cutting of a material known as

(a) S. 97, Act 1883.

(b) See Instructions to persons who wish to register Designs. Appendix F, *post*.

(c) Sect. 47 (3).

(d) See *Holdsworth v. McCrae* (1867), L. R. 2 H. L. 385. In America the practice is different, and a specification is required. In *Demartial v. Booth* (1892), 9 R. P. C. 499, the American specification was given in evidence, no party objecting.

(e) Sect. 47 (5).

(f) Sect. 95.

“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 showed 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. 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 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).

By the 91st section 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 section 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).

The application must be accompanied either—

(a) *Hothersall v. Moore* (1892), 9 Rep. Pat. Cas. 38.

(b) 51 & 52 Vict. c. 50, s. 24.

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What to
accompany
application.

- (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 (a).

"Pattern,"
"shape," or
"configuration."

In a case where a design for coffin plates was stated to be "applicable for the pattern," and one of the grounds for asserting novelty was that the centre of the coffin plate was depressed instead of flat, it was argued that this depression was a matter of "shape" and "configuration," and not "pattern." Lord Herschell, in dealing with this argument, said: "My Lords, these words 'applicable for the pattern or for the shape or configuration or for the ornament thereof,' are to be found in the Act only in the interpretation clause. All that section 47 and the following sections deal with is the question of 'design': that is the word used and the only word; but the word 'design' is interpreted by the interpretation clause, section 60. In my opinion, the object of that interpretation clause was to make the word 'design' as extensive as it reasonably ought to be. It was not intended to draw the distinction suggested as a sharp, hard and fast distinction between the design being 'applicable for the pattern' or 'for the shape or configuration' or 'for the ornament.' I do not think you can say that 'pattern,' as it is used in that section, necessarily and always excluded the shape or configuration, and that nothing could be included in 'shape' or 'configuration' which might not fall to be considered under 'pattern'; or again, that the 'ornament thereof' might not be a part of the pattern, and included in certain cases within the word 'pattern.'" He then went on to point out that all section 47 required of the applicant was to state "the nature of the design," and that Rule 9 does not purport to insert as a condition that the person registering the design is to be limited to some part of his design or to some effect in his design. To his mind the word "pattern," as used by the applicant in relation to the subject-matter, "would include everything which would go to make up the 'design'" (b).

(a) Rule 9 of 1890.

(b) *Heath v. Rollason* (1898), A. C. 499 ; cf. *per Rigby, L.J., Harper & Co. v. Wright* (1896), 1 Ch. 142, 157 ; *per Sha L.J., Walker v. Falkirk Iron Co.* (1887), 4 R. P. C. 390, 394.

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 (*a*).

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs must be furnished (*b*).

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 (*c*).

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 (*d*).

No discretionary power given to the Comptroller may be exercised adversely to an applicant for registration of a design without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

By the rules the Comptroller 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 (*e*). When the Comptroller refuses to register a design, the applicant may appeal to the Board of Trade (*f*), 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 prescribed form (*g*).

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,

(*a*) Rule 8 of 1890.

(*b*) Rule 9.

(*c*) Sect. 48 (2).

(*d*) Rule 10. See form of certificate, Schedule II. to Rules of 1890. App. F, *post*.

(*e*) Sect. 94 and Rules 12 and 13.

(*f*) Sect. 47 (6).

(*g*) See Form in Schedule to Rules of 1890. App. F., *post*.

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of the time and place appointed for the hearing of the appeal has to be given to the Comptroller and applicant (a).

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).

Permissible
to register by
pattern.

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

When
advisable
to do so.

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 (d).

When not
advisable.

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

(a) Rules 15-19. There is no appeal from the decision of the Board of Trade. See *re Trade Mark "Normal"* (1887), 35 Ch. D. 231, 234. (b) Rule 20.

(c) S. 49.

(d) *Holdsworth v. McCruie* (1867), L. R. 2 H. L. 390.

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, 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 (b).

When sample of article registered, design not infringed by article produced on 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.

Any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from the register, or by any entry made without sufficient cause, may apply to the court for an order for expunging or varying the entry; 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

Rectification of register.

(a) *Per* Lord Westbury in *Holdsworth v. M'Crea* (1867), L. R. 2 H. L. 388.

(b) *Thom v. Syddall* (1872), 26 L. T. 15.

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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 (a).

Does not apply to an omitted registration.

It will be noticed that the power of the court under this section is to either expunge or vary an entry; it would seem to confer no power to put on the register an entry that has been omitted. As we have already seen, if the Comptroller refuses to enter a design, the remedy of the proprietor is an appeal to the Board of Trade and not to the court.

"Person aggrieved."

The question has been discussed as to who is a "person aggrieved," and, consequently, entitled to apply to have an entry expunged. A person engaged in the same trade, and likely to deal in the same articles as those to which the design is intended to be applied, is *prima facie* a "person aggrieved." "I should be very unwilling," said Herschell, L.C., in a trade-mark case, "to unduly limit the construction to be placed upon these words, because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the register a mark which ought not to be there, and by which many persons may be affected who nevertheless would not be willing to enter upon the risks and expense of litigation. Wherever it can be shown, as here, that the applicant is in the same trade as the person who had registered the trade mark, and whereon the trade mark, if remaining on the register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the register he could not lawfully do that which but for appearance of the mark upon the register he could lawfully do, it appears to me that he has a *locus standi* to be heard as a 'person aggrieved'" (b).

The applicant must, however, show that in some possible way he may be damaged or injured if the design is allowed to stand, and by "possible" must be meant possible in a practical sense, and not merely in a fantastic view (c).

Substitution of name of proprietor.

The court has power to substitute the name of the true owner of a design for the name of a wrongful claimant. Thus where the agent for the proprietor of a design by mistake registered in his own name instead of in the name of his

(a) Sect. 90 Act of 1883 and sect. 23 Act of 1888.

(b) *Powell v. Birmingham Vinegar Co.* (1894), A. C. 8, 10; *re Powell's Trade Mark* (1893), 2 Ch. 388; *Apollinaris' Case* (1891), 2 Ch. 186.

(c) *Re Wright, Crossley & Co.'s Trade Mark* (1897), 15 R. P. C. 131, 377.

principal, the court ordered the latter's name to be substituted (*a*). If, however, the name of the proprietor has been changed, *e.g.*, by alteration in the name of a company, no application to the court is necessary, but the Comptroller can make the necessary alteration in the register under section 87 (*b*).

Any order of the court rectifying the register must direct Practice. that due notice be given to the Comptroller, and the person in whose favour an order has been made must 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 (*c*).

In *Bayer v. Connell* (*d*) the Irish court held that it had no jurisdiction to rectify the register, but that the application must be to the High Court in England, but in a Scotch case it seems to have been assumed that the Scotch courts had such jurisdiction (*e*). At any rate, the application can always be made to the High Court of Justice in England, even if the applicant be domiciled in Scotland or Ireland (*f*).

An application to rectify the register is generally made by motion in the Chancery Division, but it may be by summons. A separate application is necessary; the order cannot be made on a counterclaim (*g*). Four clear days notice of the application must be given to the Comptroller (*h*).

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 (*i*); and generally the burden of proof rests on the person alleging himself to be the author of a design (*k*).

(*a*) *Re Grocott's Design* (1899), 17 R. P. C. 139.

(*b*) *Re Ormonde Cycle Co.'s Mark* (1896), 13 R. P. C. 475.

(*c*) Sects. 90 (3) & 111 (2). Rule 28.

(*d*) (1897), 14 R. P. C. 275; *cf. Kinahan v. Kinahan* (1891), 8 R. P. C. 18.

(*e*) *Cowie v. Herbert* (1897), 14 R. P. C. 436, 443.

(*f*) *Re King & Co.'s Trade Mark* (1892), 9 R. P. C. 350.

(*g*) *Pinto v. Badman* (1891), 8 R. P. C. 181, 187, 190.

(*h*) Rule 27.

(*i*) *Re Heinrich's Design* (1892), 9 R. P. C. 73.

(*k*) *Hothersall v. Moore, ib.* 38.

CHAPTER III.

MARKING.

Registration
mark.

BEFORE the delivery on sale of any article to which a registered design has been applied, the proprietor of such design must, if the article is included in Class 13 or Class 14, cause each article to be marked with the abbreviation "Regd.," and 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 also, in the case of articles other than lace, with the number appearing on the certificate of registration (*a*).

Provisions as
to registra-
tion 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 (*b*), protection will be lost. Thus, in a case under the 6 & 7 Vict. c. 56, where the plaintiff had designed an improved combined chair and steps for library purposes, and had given an order to a die cutter for plates to be delivered to him with the word "registered" stamped on them for fixing on the chairs, but, before the delivery of these plates, he had sold a large number of the chairs having on them an oval metal plate stamped with the words "Alfred E. Pierce, patentee, 109 Hatton Garden, London," with the royal arms in the centre, but without the word "registered," 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 (*c*), but in a case where the word "Regd." was placed on

(*a*) Rule 5 of 1893.

(*b*) 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* (1850), 9 Q. B. 197.

(*c*) *Pierce v. Worth* (1865), 18 L. T. 710.

the article instead of "Rd.," this error was held not to invalidate the registration (*a*); and in another case the registration was upheld where a wrong number was placed on the article in addition to the right number (*b*). In *Heath v. Rollason* (*c*) the figure 5 was stamped instead of 3 in the number of the design 232908, but this was accidental, and the copyright was saved by the proviso to section 51 of the Act (*d*).

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 (*e*). 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 (*f*); if in large pieces only he need mark only the large pieces (*g*). And where a narrow 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 (*h*). A butter-dish and cover were held, under the old Act, to be sufficiently marked by marking

Where mark
to be placed.

(*a*) *Heinrichs v. Bastendorff* (1893), 10 R. P. C. 160.

(*b*) *Harper v. Wright* (1895), 2 Ch. 593; (1896), 1 Ch. 142; 12 R. P. C. 433, 483.

(*c*) (1898), A. C. 499; 15 R. P. C. 441.

(*d*) See *post* p. 438.

(*e*) *Sarazin v. Hamel* (1863), 32 Beav. 145; 9 Jur. (N.S.) 192; 32 L. J. (Ch.) 378-380.

(*f*) *Heywood v. Potter* (1853), 1 Ell. & Bl. 439; 22 L. J. Q. B. 133; 17 Jur. 528; *Hothersall v. Moore*, 9 Rep. Pat. Cas., pp. 27, 39.

(*g*) *Blank v. Footman* (1888), 39 Ch. Div. 678, 685; 5 Rep. Pat. Cas. 653.

(*h*) *Blank v. Footman, Pretty & Co.* (1888), 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 show 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* (1883), 48 L. T. 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." But where twelve squares were marked off, one from the other, by threads woven across the piece, each square being intended to be cut from the rest and used as a duster, *Bristowe, V.-C.*, thought that each square ought to have been marked; *Hothersall v. Moore* (1892), 9 R. P. C. 27.

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the dish, as they together only constituted one article (*a*), but where the design was applicable to the shank of a cuff link and the mark was placed on the plate of the link, the design was ordered to be removed from the register (*b*).

Single instance fatal.

A single instance proved of omission to mark has been held fatal (*c*). And under the corresponding provisions of the former Act it was held that the copyright of a registered design was lost if the proprietor (whether English or foreign) sold 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 (*d*); but under the policy of the present Act this decision does not seem to be applicable.

Accidental mistakes.

The terms of the 51st section of the Act are "Before 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 shows 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* (*e*). 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."

"The section [51] by its concluding words," said Lord Herschell in one case (*f*), "leaves an opening to prevent the operation of the section in full stringency, because it provides that the right shall not cease if all proper steps have been taken by the proprietor to insure the marking of the article.

(*a*) *Fielding v. Hawley* (1883), 48 L. T. 639; 47 J. P. 582.

(*b*) *Re Morton's Design* (1900), 17 R. P. C. 117.

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

(*d*) *Sarazin v. Hamel* (1863), 32 Beav. 151; 9 Jur. (N.S.) 192; 32 L. J. (Ch.) 380.

(*e*) (1884), 27 Ch. Div. 260.

(*f*) *Heath v. Rollason* (1898), A. C. 499, 504.

In interpreting these concluding words, I think it is necessary to bear in mind the object of the section, and to take into account, too, what the nature of the omission was. The object of the section as stated in plain terms is to 'denote that the design is registered'—that is to say, to give warning to the public that they are not entitled to copy it by reason of registration. Of course, if there is nothing to give that notice to the public, the proprietor would need to make out a very strong case to excuse himself under the concluding words of the section, because he has failed to do that which was essential to the very purpose of the provision contained in the section, namely, to indicate to the public that the design was a registered one. Even in that case he might escape the loss of his design by making out a case which would show that it was not due to any fault of his; but it seems to me that the case to be made out would then need to be much stronger than if there were merely some error in complying with the exact requirements of the section as to the figures or words to be put upon the article if there were such compliance as plainly to indicate that the design was a registered one."

In the case from which the above remarks are taken, the plaintiff had employed a competent person to make the dies and stamp coffin plates, and the dies were correctly made and stamped upon the plates in every instance, except one, and in that case the figure 5 was stamped instead of 3 in the number of the design 232908, and a certain number of plates thus stamped were sold. Upon the mistake being pointed out, the plaintiff immediately had it corrected. The plaintiff was held to have taken all proper steps. Again, an article will not lose the protection of the statute when part of its registration mark becomes illegible during the process of manufacture (*a*); but it is the duty of the manufacturer to take proper precautions to see that his orders are carried out, and that the moulds from which his designs are marked do not become so worn as to prevent a distinct impression of the mark from being conveyed to the article, and if he neglects to do so, and the article is not marked, his protection will be lost (*b*).

Difficult questions may arise if the failure to mark the articles is due to the default of a licensee of the proprietor of the design.

It may be mentioned that it is not necessary to mark a

(*a*) *Fielding v. Hawley* (1883), 48, L. T. 639.

(*b*) *Johnson v. Bailey* (1893), 11 R. P. C. 21; cf. *Wedekind v. General Electric Co.* (1897), 14 R. C. P. 190.

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book containing copies of registered designs under section 51 (a).

Delivery on sale.

The mark must be placed on the article before there is any "delivery on sale." The meaning of this expression was considered in the case of *Woolley v. Broad* (No. 2) (b). There the plaintiff, John Woolley, the inventor of certain lace designs, had entered into a contract with A. H. Woolley and Co., by the terms of which A. H. Woolley and Co. were to give orders to John Woolley and to nobody else, and John Woolley was to manufacture for A. H. Woolley and nobody else; but John Woolley was to hand over the goods to A. H. Woolley and Co. in the "brown" or unfinished state, to be turned by the latter into white lace and prepared for the market. It was held that the delivery by John Woolley to A. H. Woolley, who paid for the goods, was a delivery on sale, and that though the goods were only delivered in the rough state they ought to have been marked.

This case is apt to deceive. It will be noticed that there was an actual sale by John Woolley to A. H. Woolley and Co., and the articles had not been simply sent to the latter in order to be finished and then returned to John Woolley. Further, so far as the application of the design was concerned, the lace was finished and the process to which it was submitted by A. H. Woolley and Co. did not affect the design. If goods are sent to another manufacturer only to undergo a finishing process, this will not, ordinarily, be a delivery on sale.

It is provided by section 105 of the Act of 1883, that any person who describes any design applied to any article sold by him as registered, which is not so, shall be liable for every offence, on summary conviction, to a fine not exceeding £5, and a person is to be deemed, for the purpose of this enactment, 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.

(a) *Branchardière v. Elvery* (1851), 4 Ex. 380; 18 L. J. Ex. 381.

(b) (1892), 9, R. P. C. 429.

Penalty for false mark.

CHAPTER IV.

DURATION AND TRANSFER OF COPYRIGHT IN A DESIGN.

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 useful designs 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.

Duration of copyright.

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 (a).

Forfeiture.

It is also provided that before delivery on sale (b) 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 (c). Copyright is also liable to forfeiture, as we have seen, if articles to which a registered design has been applied are sold without being properly marked. Copyright extends to the United Kingdom and the Isle of Man (d).

The transfer of a copyright of a design must be in writing, as must also any partial assignment or licence (e).

The Patents, Designs and Trade Marks Acts, 1883 (f),

(a) S. 54.

(b) As to the meaning of this expression, see p. 440, *ante*.

(c) Sect. 50 (2); see also S. 94 and Rules 12-14.

(d) Sec. 112.

(e) *Jewitt v. Eckhardt* (1878), 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.

(f) S. 87.

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provides that where a person becomes entitled by assignment, transmission, or other operation of law to the copyright in a registered design (a), 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 (b) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise to deal with the same, and to give effectual receipts for any consideration for such assignment, licence, 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.

Request to make entry on register.

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 (c).

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 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 (d).

What request to contain.

This 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 show 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 (e).

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 (f). And the claimant is to furnish to the Comptroller such other proof of title as he may require (g).

(a) Copyright in design devolves on the executor, *Jewitt v. Eckhardt, supra.*

(b) Added by 51 & 52 Vict. c. 50, s. 21.

(c) Rule 21.

(d) Rule 22.

(e) Rule 23.

(f) Rule 24.

(g) Rule 25. For form of request for a lace design, Form K¹. Rules

Schedule II., K. Rules of 1890, or, in case of

It seems clear, from the 58th section of the Act, that a licence must be in writing, and a licensee cannot sue for infringement, unless, at any rate, he has the right to *apply* the design to articles of manufacture (a). CAP. IV.
As to licences.

The right to sue is vested in the "registered" proprietor of the design, and it would therefore seem that an assignee must register before he can recover in his action, though it is not necessary that he should be registered when he issues his writ (b). Assignee
should
register.

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 (c).

(a) *Woolley v. Broad* (1892), 1 Q. B. 306; *Jewitt v. Eckhardt* (1878), 8 Ch. D. 404.

(b) *Ihlce v. Henshaw* (1886), 31 Ch. Div. 323; *Magnolia Metal Co. v. Atlas* (1897), 14 R. P. C. 389.

(c) See *Longman v. Tripp* (1805), 2 Bos. & Pul. New R. 67; *Hesse v. Sterenson* (1806), 3 Bos. & Pul. 565; *Re Dilworth* (1833), 1 Dea. & Chitt. 411.

CHAPTER V.

INFRINGEMENT AND THE REMEDIES THEREFOR.

What is infringement.

By section 60 of the Act of 1883 copyright is defined to mean the exclusive right to apply a design to any article of manufacture or to any substance, artificial or natural, or partly artificial and partly natural, in the class or classes in which the design is registered. And by section 58, during the existence of the copyright it is unlawful for any person:

- (i.) Without the licence or written consent of the registered proprietor to apply or cause to be applied (*a*) such design, 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 thereof, shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor (*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

Notice by proprietor of copyright.

(*a*) Added by sect. 7 of the Act of 1888.

(*b*) *Woolley v. Broad* (1892), 1 Q. B. 806; 9 Rep. Pat. Cas. 208; cf. *Mallett v. Howitt*, W. N. (1879) 107.

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. CAP. V.

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 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). What insufficient.

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 shown 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, though the retailer must, before he can be made liable, have knowledge that the design has been applied without the consent of the registered proprietor, and a notice is useful to prove such knowledge. 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 licence to purchasers of the book to sell articles to which the design has been applied, though it may amount to a licence to copy the designs for private use (c).

To expose a person to an action for infringement of a design he must have applied the design to an article of manufacture for the purposes of sale, and he would not be liable if he applied it for his amusement or even for his own use if he had no intention of selling the article to which the design has been applied. What is an infringement.

The copyright of designs protected under the Act of 1883 Manufacture and sale in

(a) *Norton v. Nicholls* (1857), 5 Jur. 1203; 28 L. J. Q. B. 225.

(b) *Smith v. Lewis, Roberts & Co.* (1888), 5 Rep. Pat. Cas. 611 (Bristowe, V.-C.).

(c) *Branchardière v. Elvery* (1851), 4 Ex. 380; 18 L. J. Ex. 381.

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foreign
country.

Meaning of
"fraudulent
and obvious
imitation."

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 (*a*).

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 (*b*). And it has been further said that it is permissible to imitate a registered design if the result differs, as a whole, from the registered design—if it is in fact substantially a new design (*c*).

Again, it has been said that "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 that the test is not merely to look at the two designs side by side (though that is one element of comparison), but that 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 (*d*).

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'

(*a*) *Potter & Co. v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

(*b*) *Barron v. Lomas* (1880), 28 W. R. 973, *per* Jessel, M.R. See *Sherwood & Cotton v. Decorative Art Tile Co.* (1887), 4 Rep. Pat. Cas. 207.

(*c*) *Thom v. Syddall* (1872), 26 L. T. 15.

(*d*) *Grafton v. Watson* (1884), 50 L. T. 420.

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 (a), 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—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" (b).

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 (c), 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 showed 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 showed 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 (d).

The tendency of modern cases is to determine the question of infringement solely by an appeal to the eye. "It seems to me," said Lord Herschell, in *Hecla Foundry Co. v. Walker, Hunter and Co.* (e), "that the eye must be the judge in such a

(a) 51 L. T. 141 (C.A.).

(b) Cf. *Harper & Co. v. Wright* (1896), 1 Ch. 142.

(c) *Sherwood & Cotton v. Decorative Art Tile Co.* (1887), 4 Rep. Pat. Cas. 207.

(d) *Walker, Hunter & Co. v. Hecla Iron Co.* (1887), 15 C. of S. Cas. 660; 25 Scot. L. R. 491; 5 Rep. Pat. Cas. 71, 365; 6 Rep. Pat. Cas. 554.

(e) (1889), 14 A. C. 550, 555.

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case as this, and that the question must be determined by placing the designs side by side and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought perhaps to qualify this by saying that as a design to be registered must, by sect. 47, be a 'new or original design, not previously published in the United Kingdom,' one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial."

The fact, therefore, that there are differences in detail between two designs will not necessarily prevent the one from being an imitation of the other. In one case the plaintiff had registered an upright hexagonal metal stove, the sides of which had the representation in metal work of a church window, of a particular style of architecture, with tracery above and below. Mr. Justice Kekewich held that a similar stove produced by the defendants was not an infringement of the plaintiffs' design, because, though the general appearance might be the same, on examining them closely he found that the windows in the two stoves were different, since they belonged to entirely different periods of architecture and the tracery above and below the windows was different (*a*). This decision was, however, reversed by the Court of Appeal, who held that the defendants' stove was an obvious imitation of the plaintiffs' (*b*). "I think," said Lord Herschell, "that the learned judge in the court below erred in considering too much the details as essentials of the design; the designs may be the same although the details largely differ. . . . The truth is, that the defendants took all the essential elements of the plaintiffs' design."

Remedies for infringement.

Any person who pirates a registered design 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 (*c*). An alternative remedy is given by sect. 59 of the Act of 1883, which provides that 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

(*a*) *Harper & Co. v. Wright* (1895), 2 Ch. 593; 12 R. P. C. 433.

(*b*) (1896), 1 Ch. 142. See also *Oliver & Co. v. Thornley & Co.* (1896), 13 R. P. C. 490; *Varley v. Keighley Ironworks* (1896), 14 R. P. C. 169; *Nevill v. Bennett & Sons* (1898), 15 R. P. C. 412.

(*c*) Sect. 58, Act of 1883; sect. 7 (2), Act of 1888.

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. The plaintiff cannot recover both penalties and damages, but must elect under which section he will proceed. Where there is a difficulty in proving damages proceedings for penalties will be advisable. Where the plaintiffs proved a single purchase of one hundred tiles one fine of £50 was imposed (a). A plaintiff can also obtain an injunction in a proper case.

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 (b). Trivial actions are, however, liable to be dismissed with costs (c).

Infringer not entitled to notice before action.

But in dealing with the retailer 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 (d).

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 (e), 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 (f). It is an offence to

Penalty for wrongfully describing design as registered.

(a) *Sherwood v. Decorative Tile Co.* (1887), 4 R. P. C. 207.

(b) *Wittman v. Oppenheim* (1884), 27 Ch. D. 260; 54 L. J. Ch. 56; 50 L. T. 713; 32 W. R. 767; *Upman v. Forester* (1883), 24 Ch. D. 231; 52 L. J. Ch. 946.

(c) *Jan v. Grossman* (1895), 12 R. P. C. 537; *American Tobacco Co. v. Guest* (1892), 1 Ch. 630; 9 R. P. C. 218.

(d) *Halsey v. Brotherhood* (1880), 15 Ch. Div. 514, 517; *Smith v. Lewis, Roberts & Co.* (1885), 5 Rep. Pat. Cas. 811. But an injunction will be granted with costs if he unsuccessfully contests the plaintiff's title; *Werner Motors v. Gamage* (1904), 1 Ch. 264.

(e) 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).

(f) Sect. 105, Act 1883. And see the Merchandize Marks Act, 1887, which imposes penalties for applying any false trade description to goods. See sect 3.

CAP. V.

Proceedings
in Isle of
Man.

continue the sale of articles with the word "registered" on them after the expiration of the copyright (a).

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 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.

In what
courts pro-
ceedings may
be taken.

In England proceedings may be instituted in the High Court of Justice or in the Chancery of the County Palatine of Lancaster, which latter Court has, under the Chancery of Lancaster Act, 1890, the same powers and jurisdiction over persons and property within the Palatine County as the High Court in its Chancery Division. It has been held (b) that a county court has no jurisdiction to try a patent case, where the validity of the patent is in question, but it is doubtful whether the reasoning applies to a case of infringement of a design, and such cases have been tried in county courts without any objection being taken to the jurisdiction (c). The Act of 1883 does not provide any summary remedy for recovering penalties for infringement as was the case under the Act of 1842.

Right to sue
only in regis-
tered pro-
prieters.

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 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

(a) See *Cheavin v. Walker* (1877), 5 Ch. Div. 850, 863.

(b) *R. v. Halifax County Court Judge* (1891), 2 Q. B. 263 ; 8 R. P. C. 338.

(c) See *Moody v. Tree* (1892), 9 R. P. C. 333.

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 showed 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*).

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 person impeaching the title of the registered proprietor (*b*). Burden of proof.

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 *McCrae v. Holdsworth* (*c*), 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.

An order for delivery of pirated designs now usually accompanies an injunction (*d*), but, of course, such an order cannot be made against a person who is not a party to the action (*e*).

(*a*) *Woolley v. Broad*, [1892] 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

(*b*) *In the matter of Heinrichs' Registered Design* (1892), 9 Rep. Pat. Cas. p. 73.

(*c*) (1848), 2 De Gex & Sm. 497; 12 Jur. 820.

(*d*) *Gordon & Co. v. Patrick* (1895), 12 R. P. C. 22; *Knowles & Co. v. Bennett* *ib.* 137.

(*e*) *Knowles & Co. v. Bennett*, *ubi sup.*

CAP. V.

Pleading.

In a statement of claim under the Patents, Designs, and 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 (*a*); 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 statement of claim should also make it clear whether the plaintiff is proceeding for damages or penalties.

Evidence.

The articles alleged to be piracies should be produced to the court, in order that they may be compared with the original design and the articles to which it has been applied by the proprietor (*b*). 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 (*c*).

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 show by direct evidence that the defendant's design has been taken from the plaintiff's (*d*).

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 (*e*), but the judge has complete discretion (*f*).

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 (*g*). The sum recoverable under this section is regarded in the light of a penalty, and consequently interrogatories cannot be administered.

(*a*) On pleading in Design cases, see *Sarazin v. Hamel* (1863), 32 Beav. 145; and *Woolley v. Broad*, [1891] 1 Q. B. 806; 9 Rep. Pat. Cas. 208.

(*b*) *Sheriff v. Coates* (1830), 1 Russ. & My. 159.

(*c*) *Fradella v. Weller* (1831), 2 Russ. & My. 247.

(*d*) *Lowndes v. Browne* (1848), 12 Ir. L. Rep. 293; cited Norman on 'Designs,' p. 51.

(*e*) *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.

(*f*) *Woolley v. Broad* (1892), 9 R. P. C. 429.

(*g*) *Saunders and another v. Wiel*, [1892] 2 Q. B. 18, 321.

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 (a). CAP. V.
Costs.

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 (b).

Provisional protection, which was allowed by the 13 & 14 Vict. c. 104, is now at an end, there being no provision made in the recent Acts for such, but the protection afforded to those exhibiting in industrial or international exhibitions made permanent by the 28 & 29 Vict. c. 3 and 33 & 34 Vict. c. 27, is continued by the 57th section of the Act of 1883, which is as follows:— Provisional protection at an end.

The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered or invalidate the registration thereof, provided that both the following conditions are complied with, namely:— Exceptions.

- (a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and
- (b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

By the rules of 1890, the notice to be given to the comptroller of the intention to exhibit or to publish a description of the design is to be a seven days' notice in writing (c). And, for the purpose of identifying the design in the event of an application to register the same being subsequently made, the applicant is to furnish to the comptroller a brief description of the nature of the design, accompanied by a sketch or drawing thereof, and such other information as he may in each case require.

(a) *Blank v. Footman, Pretty & Co.*, 39 Ch. Div. 678.

(b) *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 Rep. Pat. Cas. 207, 212. See further as to costs, *Grafton v. Watson* (1884), 51 L. J. Ch. 141; *Winfield v. Snow* (1891), 5 R. P. C. 15. Trivial actions will be dismissed with costs, *Jan v. Grossman* (1895), 12 R. P. C. 537.

(c) Rule 36.

CAP. V.

Foreign
designs.

As to foreign designs, section 103 of the Act of 1883 enables Orders in Council to be issued declaring the provisions of that section applicable to foreign states specified in such order.

Any person who has applied for protection for any design in any such state is entitled to registration of his design, under the Act, in priority to other applicants, and such registration is to have the same date as the date of the application in such foreign state (*a*). The application in this country, however, must be made within four months from the application for protection in the foreign state (*b*).

If the application be not made in time (even though no order was in force within the time limited), and the design has been published in the United Kingdom, the right of registration will be gone. The proprietor of the design is precluded from recovering damages for infringements happening prior to the date of the *actual registration* of his design in this country.

The exhibition or use of the design in the United Kingdom or Isle of Man during the four months, or the publication therein during this period, of a description or representation of the design, will not invalidate the registration.

All applications for registration pursuant to the section under consideration, must be made in the same manner as an ordinary application under the Act.

The provisions of the section only apply to those foreign states with respect to which the Crown by Order in Council declares them to be applicable, and so long only, in the case of each state, as the Order in Council continues in force with respect to that state. Orders are now in force as to the following states which are parties to the Industrial Property Convention, 1883, as amended in 1900: America, Belgium, Denmark with the Faroe Islands, Dominican Republic, France and her colonies, Germany, Italy, Japan, Norway, Portugal with the Azores and Madeiras, Servia, Spain, Sweden, Switzerland, and Tunis. Orders are also in force with regard to the following states which are not parties to the Convention:—Paraguay and Uruguay (O. in C., 24th September, 1886), Mexico (O. in C., 28th May, 1889), Roumania (O. in C., 5th August, 1892), Ecuador (O. in C., 16th May, 1893), Greece (O. in C., 15th October, 1894), and the Republic of Honduras.

Colonial
designs.

Under section 104, Orders in Council may be issued applying the provision of the Act of 1883, with such variations or

(*a*) Sect. 103, Act 1883, as amended by 48 & 49 Vict. c. 63.

(*b*) See *Re Application by Californian Fig Syrup Co.*, W. N. (1888), p. 248; 6 Rep. Pat. Cas. 126.

additions, if any, as may be thought proper to British Possessions. CAP. V.

It must be first shown to the Crown that the legislature of the British Possession in whose favour the Act is to have application, has made satisfactory provision for the protection of designs registered in this country; and any Order in Council will take effect from the date mentioned in it as if its provisions had been contained in the Act (*a*).

The only Orders at present in force under this section are in favour of Queensland, which was made the 17th September, 1885; New Zealand, made the 8th February, 1890; Tasmania, made the 30th April, 1894; Western Australia, made the 11th May, 1895.

(*a*) Sect. 104.

PART V.
INTERNATIONAL AND COLONIAL
COPYRIGHT.

CHAPTER I.

INTERNATIONAL COPYRIGHT.

Non erit alia lex Romæ, alia Athenis; alia nunc alia posthac, sed et apud omnes gentes et omnia tempora una eademque lex obtinebit.—CICERO.

International
copyright the
offspring of
modern
civilization.

INTERNATIONAL law is entirely the offspring of modern civilization, and is the latest important discovery in political science.

The origin and progress of international law is itself a remarkable step in the march of civilization. Nations now begin to acknowledge their subjection to laws in conformity with natural justice and reason, as in the very origin of society individuals acknowledged themselves so bound. And the development of international law will proceed amongst the civilized nations of the earth, until citizens can enjoy in foreign countries all the rights which they enjoy in their own. Commerce, the influence of which unites the human family by one of its strongest ties, the desire of supplying mutual wants, demands an international code for the civilized nations of the earth. Art demands that the property in its inventions should be secured by an international law of patents. Literature, that the property in its works should be secured by international copyright.

“The actual law of nations,” observes Mr. Curtis (a), “knows no exclusive right of an author to the proceeds of his work, except that which is enforced by the municipal law of his own country, which can operate nowhere but in its own jurisdiction. As soon as a copy of a book is landed in any foreign country, all complaint of its republication is, in the absence of a treaty, fruitless, because no means of redress exist, except under the

(a) ‘Copyright,’ p. 22.

law of the author's own country. It becomes public property, not because the justice of the case is changed by the passage across the sea or a boundary, but because there are no means of enforcing the private right."

Formerly, if a book were written by a foreigner and published abroad, a person who purchased the right to publish here could not enjoy the right exclusively (a).

Until the passing of the International Copyright Act, 1886 (b) International Copyright in England, that is copyright in works first published out of the British dominions was regulated by the 7 & 8 Vict. c. 12, explained by the 15 & 16 Vict. c. 12, the 25 and 26 Vict. c. 68, and 38 & 39 Vict. c. 12.

International Copyright first regulated by 7 & 8 Vict. c. 12, and 15 & 16 Vict. c. 12.

The 7 & 8 Vict. c. 12 repealed an earlier Act, the 1 & 2 Vict. c. 59, which had been found insufficient, and, in particular, did not empower the Crown to confer any exclusive right of representing or performing dramatic pieces or musical compositions first published in foreign countries upon the authors thereof, or to extend the privilege of copyright to prints and sculpture first published abroad; it merely had reference to books.

The Act of 1837 had reference solely to books.

By the Act of 1844 (c) the Crown was empowered by any Order in Council to direct that as respects all or any particular class of the following works (namely), books, prints, articles of sculpture, and other works of art to be defined in such order, which should, after a future time to be specified in such order, be first published in any foreign country to be named in such order, the authors, inventors, designers, engravers, and makers thereof respectively, should have the privilege of copyright therein during such period as should be defined in such order, not exceeding, however, as to any of the above-mentioned works, the term of copyright which authors, inventors, designers, engravers and makers of the like works respectively first published in the United Kingdom might be entitled to.

Enlargement of the power conferred on the Crown of concluding international copyright conventions.

If the order applied to books, the copyright law as to books first published in this country should apply to the books to which the order related, except so far as might be excepted in any order, and except as to the delivery of copies of books at the British Museum and the other libraries (d).

And if the order applied to prints, articles of sculpture, or to any such other work of art as aforesaid, the copyright law as to

(a) *Guichard v. Mori* (1831), 9 L. J. Ch. (O.S.) 227.

(b) The Acts 7 & 8 Vict. c. 12, 15 & 16 Vict. c. 12, 25 & 26 Vict. c. 68; 38 & 39 Vict. c. 12, and 49 & 50 Vict. c. 33, may under the Short Titles Act, 1892, be cited collectively as the International Copyright Acts. The Acts may also be separately cited as the International Copyright Act, 1844, the International Copyright Act, 1852, the Fine Arts Copyright Act, 1862, the International Copyright Act, 1875, and the International Copyright Act, 1886. (c) 7 & 8 Vict. c. 12. (d) Sect. 3.

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prints, sculptures, and such other works of art first published in this country should apply to the prints, sculptures, and other works of art to which such order related, except as might be provided in any order (a).

The 5th section of the Act enacted that it should be lawful for the Crown, by order of the Crown in Council, to direct that the authors of dramatic pieces and musical compositions, which should after a future time, to be specified in such order, be first publicly represented or performed in any foreign country, to be named in such order, should have the sole liberty of representing or performing in any part of the British dominions such dramatic pieces or musical compositions during such period as should be defined in such order, not exceeding the period during which authors of dramatic pieces and musical compositions first publicly represented or performed in the United Kingdom might for the time be entitled by law to the sole liberty of representing and performing the same: and from and after the time so specified in any such last-mentioned order the enactments of the said Dramatic Literary Property Act and of the said Copyright Amendment Act, and of any other Act for the time being in force with relation to the liberty of publicly representing and performing dramatic pieces or musical compositions, should, subject to such limitations as to the duration of the right conferred by any such order as should be therein contained, apply to and be in force in respect of the dramatic pieces and musical compositions to which such order should extend and which should have been registered as thereafter provided in such manner as if such dramatic pieces and musical compositions had been first publicly represented and performed in the British dominions, except such of the said enactments or such parts thereof as should be excepted in such order.

Registration.

The provisions in regard to registration under the International Copyright Act, 1844, were contained in the 6th section, which required that every author, to entitle himself to the protection thereby afforded, should, within a time to be prescribed in each Order in Council made in pursuance of the Act, register the same at Stationers' Hall. It was necessary to register the title to the copy thereof, the name and place of abode of the author or composer thereof, the name and place of abode of the proprietor of the copyright, the time and place of the first publication, representation, or performance, as the case might be, in the foreign country. One printed copy of the whole of any book, and of any dramatic piece or musical

(a) Sect. 4.

composition, in the event of the same having been printed, and of every volume, had to be delivered to the officer of the Company of Stationers.

Special provisions were made as to registration of dramatic pieces or musical compositions in manuscript, also as to engravings and prints and articles of sculpture, and as to registration of anonymous works. Section 8 rendered the provisions of the Copyright Act, 1842, as to inspection, searches, false entries, &c., applicable to the International Register, and by section 9 every entry made in pursuance of the Act of a first publication was to be *prima facie* proof of a rightful first publication; and the same section made provision as to the expunging or varying an entry grounded in wrongful first publication.

The task of making and also of construing the statutable entries was rendered somewhat difficult owing to the circumstances, first, that the statute did not require, or the book of registry in form provide for, any description of the thing to be registered apart from its title; and, secondly, that the register in its actual form was framed with headings applicable only to the registration of a book or other printed matter. In *Wood v. Boosey (a)*, the registration of the pianoforte arrangement of an opera was held to be invalid, because the name of the composer of the opera had been entered in the registry, instead of the name of the person who had made the arrangement. In the opinion of the court, the latter, and not the former was the author of what was registered. ^{Mode of entry.}

In *Boosey v. Fairlie (b)*, the plaintiffs claimed the exclusive right of representing a comic opera known as 'Vert-vert,' composed by Offenbach, of which a pianoforte arrangement made by Soumis, but not the orchestral parts, had been published in print. There had been entered in the registry the title of the opera, the name and place of abode of Offenbach as composer and owner, and the time and place of the first representation of the opera, and the time and place of the first publication of the pianoforte arrangement. A copy of the pianoforte arrangement, but not of the opera itself, had been delivered to the officer of the Stationers' Company. The Court of Appeal, reversing Bacon, V.-C., held that all the facts required for the registration of the opera itself had been duly entered, and that the additional entry of the time and place of the first publication of the pianoforte arrangement, and the

(a) (1868), L. R. 2 Q. B. 340; 3 Q. B. 223.

(b) (1877), 7 Ch. Div. 307; 4 App. C. 714.

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delivery of a copy of it, were superfluous acts, which did not affect the registration of the original opera. There was, therefore, a good registration of the unpublished opera, but not of the pianoforte arrangement (*a*).

Order may specify different periods for different foreign countries and for different classes of works.

By the 13th section it is provided that the respective terms to be specified in any Order of Council for the continuance of the privilege to be granted in respect of works to be first published in foreign countries may be different for works first published in different foreign countries and for different classes of works: and that the times to be prescribed for the entries to be made in the register book of the Stationers' Company, and for the deliveries of the books and other articles to the said officer of the Stationers' Company as thereinbefore mentioned, may be different for different foreign countries, and for different classes of books or other articles.

Orders to be published in Gazette.

Provision was made that every order made under the powers conferred by the Act should be published in the 'London Gazette' as soon as might be after the making thereof, and from the time of such publication should have the same effect as if every part thereof were included in the Act.

Remedies for infringement.

As we have seen above, by section 3 a foreign author is given, in respect of books, the benefit of the provisions of the Literary Copyright Act, 1842, and of any other Act for the time being in force with relation to the copyright in books first published in this country, and by section 4 foreign artists are given the benefit of the Engraving Copyright Acts and Sculpture Copyright Acts or of any other Act for the time being in force with relation to the copyright in prints or articles of sculpture first published in this country. Likewise section 5 applies the Dramatic Literary Property Act and the Copyright Amendment Act to foreign musical and dramatic works.

It is provided by the 10th section that no copies of books wherein there shall be any subsisting copyright under or by virtue of that Act, or of any Order in Council made in pursuance thereof, printed or reprinted in any foreign country, except that in which such books were first published, shall be imported into any part of the British dominions, except by or with the consent of the registered proprietor of the copyright or his agent authorized in writing, and if imported contrary to such prohibition, the same and the importers thereof are made

(*a*) Now, by sect. 4 of the International Copyright Act, 1886, the provisions of the Act of 1844 with respect to the registry and delivery of copies of works are not to apply to works produced in a country in respect of which an Order in Council under the International Copyright Acts have been made except so far as provided by the order.

subject to the enactments in force relating to goods prohibited to be imported by any Act relating to the customs (*a*); and as respects any such copies so prohibited to be imported, and also as respects any copies unlawfully printed in any place whatsoever of any books wherein there shall be any subsisting copyright as aforesaid, any person who shall in any part of the British dominions import such prohibited or unlawfully printed copies, or, who knowing such copies to be so unlawfully imported or unlawfully printed, shall sell, publish, or expose to sale or hire, or shall cause to be sold, published, or exposed to sale or hire, or have in his possession for sale or hire, any such copies so unlawfully imported or unlawfully printed, such offender shall be liable to a special action on the case at the suit of the proprietor of such copyright, to be brought and prosecuted in the same courts and in the same manner, and with the like restrictions upon the proceedings of the defendant, as were respectively prescribed in the Copyright Act, 1842, with relation to actions thereby authorized to be brought by proprietors of copyright against persons importing or selling books unlawfully printed in the British dominions.

It will be observed that this section, absolutely prohibiting the importation of piracies, expressly excepts from its operation the importation of copies made in the country in which the copyright book was first published. Consequently in a case where the plaintiff was the owner of the British international copyright of a book first published in Germany, and the defendant imported and sold in Great Britain copies printed in Germany by the owner of the German copyright, it was contended that the plaintiff had no remedy. The Court of Appeal, however, decided, reversing Kekewich, J., that section 10 of the International Copyright Act was not intended to be a code containing a complete enumeration of the remedies available for an infringement of copyright in foreign works, but that section 3 made sections 15 and 17 of the Literary Copyright Act, 1842 (*b*), applicable to the book in question, and that as under those sections the owner of the copyright could, if the book had been published in Great Britain, have restrained the importation of these copies, the owner of the British international copyright could do so, though the alleged infringements were "lawfully" printed in Germany (*c*).

(*a*) See 39 & 40 Vict. c. 39, s. 42, The Customs Consolidation Act, 1876.

(*b*) See *ante* p. 194.

(*c*) *Pitts v. George & Co.* (1896), 2 Ch. 866. By section 9 of the 15 & 16 Vict. c. 12, the provisions against unlawful importations were extended to translations.

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This decision, though no doubt correct in principle, may be found to work harshly in practice. For instance, A. may have been in the habit of ordering, say, German copyright books from B., the proprietor of the copyright in Germany, in order to supply the British market. That is a perfectly lawful proceeding on his part, so long as B. has retained the entire copyright; but one day B., without any notice to A., assigns the British copyright to C. and thereupon A. will become liable, at the suit of C., for unlawfully importing into Great Britain.

Translations
under Act of
1844.

The 18th section of the Act of 1844, provided that nothing in that Act should be construed to prevent the printing, publication, or sale or any translation of any book the author whereof and his assigns might be entitled to the benefit of the Act.

But this section was repealed by the 1st section of the 15 Vict. c. 12, so far as it was inconsistent with the provisions of that Act. And the 2nd section of that Act provided that the Crown might by Order in Council direct that the authors of books which were, after a future time to be specified in such order, published in any foreign country to be named in such order, their executors, administrators, and assigns, should, subject to the provisions thereafter contained or referred to, be empowered to prevent the publication in the British dominions of any translations of such books not authorized by them, for such time as might be specified in such order, not extending beyond the expiration of five years from the time at which the authorized translations of such books thereafter mentioned were respectively first published, and, in the case of books published in parts, not extending as to each part beyond the expiration of five years from the time at which the authorized translation of such part was first published (*a*).

The 15 & 16 Vict. c. 12, further provided in section 3, now repealed by the International Copyright Act, 1886, that, subject to any provisions or qualifications contained in such order, and to the provisions of the Act contained or referred to, the laws and enactments for the time being in force for the purpose of preventing the infringement of copyright in books published in the British dominions should be applied for the purpose of preventing the publication of translations of the books to which such order extended which were not sanctioned by the authors of such books, except only such parts of the said

(*a*) And as to representation of translations of dramatic works, see 15 & 16 Vict. c. 12, sect. 4.

enactments as related to the delivery of copies of books for the use of the British Museum, and for the use of the other libraries (a).

The 7th section of the 15 & 16 Vict. c. 12 provided that articles of political discussion which had been published in newspapers or periodicals in foreign countries might be made free use of, provided the sources from which they were taken were acknowledged.

The 19th clause of the 7 & 8 Vict. c. 12, which enacted that no author of any book or dramatic piece, which should be first published out of Her Majesty's dominions, should have copyright therein, otherwise than under the provisions of that Act, has been held to apply to British subjects first publishing in a country with which no international convention was subsisting. Authors publishing abroad only entitled to copyright under International Acts.

And it was held that this section applied to works first published in any foreign country, whether the provisions of the International Copyright Acts had or had not been extended to that country; and accordingly that no author whether a British subject or an alien, was entitled to any other protection for a work first published abroad than that which he might claim under the International Copyright Acts. Therefore where a British subject first produced for representation a dramatic piece of which he was the author, at New York, and he subsequently produced it in London, Vice-Chancellor Sir W. P. Wood held that as he had not complied with the provisions of the 7 & 8 Vict. c. 12 (there being no such international treaty or arrangement as was alluded to by the above section), he had not obtained the copyright to such piece, in England nor the exclusive right to the representation of his drama; and that this was the case though he could not, by any possibility, have complied with the provisions of the said Act, no regulation having been made according to the course pointed out by the Act as to international copyright between the two countries (b).

It was contended by the plaintiff that this Act could not annihilate the privileges enjoyed by British subjects under the former Acts. That the word "author" must mean an author in a country affected by the Act, and that the simple performance of a piece in manuscript abroad was not contemplated by the term "publication."

However, the contention failed, the Vice-Chancellor saying:

(a) Sect. 3.

(b) *Boucicault v. Delafield* (1863) 9 Jur. 1282; 33 L. J. (Ch.) 38; 12 W. R. 101; 1 H. & M. 597.

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“ The 19th clause says, in effect that this Act having been made, if any person, whether a British subject or not, chooses to deprive this country of the advantage of the first representation of his work, then he may get the right, if he thinks fit, under the arrangements which may have been come to with that country he so favours with his representation, pursuant to the 7 & 8 Vict. c. 12. If, however, he does not get it, if he chooses to publish his performance in a country which has not entered into any treaty or made any arrangement for that purpose, he may do so, but this country has nothing more to say to him, and he must be taken to have elected under which of the statutes, which have been made respecting similar subjects, he wishes to come, and by performing his work in one country instead of the other, he is thereby excluded from all advantage of publishing in the other. I cannot see anything to justify me in restraining the provision, or to say that it applies to foreigners, and does not apply to British subjects, because if I did so, I should be bound, by parity of reasoning, to say, that any foreigner publishing first in this country, and acquiring a right under the existing law, would have to be deprived of that right by this Act, whilst a British subject would not be deprived of the benefit. The object of the legislature seems to have been in these cases to secure, in this country, the benefit of the first publication, and to extend to any other country the same benefit, only on certain conditions, namely, that reciprocity shall be afforded, and that the representation shall take place for the first time in England, which may be published afterwards in another country.”

In a later case the same plaintiff met with no better fate. The piece in question was ‘ The Shaughraun,’ which had been composed by the plaintiff and first performed in New York, but had never been printed. The court held that the case was covered by the decision in *Boucicault v. Delafield*, for representation was publication within the meaning of section 19 (a).

Fair imitations or adaptations.

The 15 & 16 Vict. c. 12 also contained a short but most important provision that nothing in the Act should be so construed as to prevent fair imitations or adaptations to the English stage of any dramatic piece or musical composition published in any foreign country (b).

Orders in Council and Conventions.

Pursuant to the Act of 1844 a large number of Orders in

(a) *Boucicault v. Chatterton* (1876), 5 Ch. Div. 267.

(b) Sect. 6. But see now 38 & 39 Vict. c. 12, *post*. The Order in Council was made under the last Act on the 5th Aug., 1875, revoking the application of 15 & 16 Vict. c. 12, as to dramatic pieces first published in France. This Order was revoked by the Order of the 28th Nov., 1887.

Council were promulgated, and the various European countries had also numerous copyright treaties *inter se*. The general purport was to give the authors of works first published in one of the federated states the same privileges in the other states as would be enjoyed if the work had been published there.

The following conventions were entered into by Great Britain :

Prussia	May 13, 1846.	Hamburg (b)	Aug. 16, 1853.
Saxony	Aug. 24, 1846.	Belgium	Aug. 12, 1854.
Brunswick	March 30, 1847.	Prussia, Saxony, &c.	
Thuringian Union	July 1, 1847.	(additional)	June 14, 1855.
Hanover	Aug. 4, 1847.	Spain (c)	July 7, 1857.
Oldenburg	Dec. 28, 1847.	Sardinia	Nov. 30, 1860.
French Republic (a)	Nov. 3, 1851.	Hesse Darmstadt	Nov. 19, 1861.
Anhalt	Feb. 8, 1853.	Italy	Sept. 12, 1865.
	Germany (d)		June 2, 1886.

A complicated state of circumstances arose, for the rights of an author in foreign countries varied according to the particular treaty or Order in Council, and in 1885 an attempt was made by several of the great powers to secure uniformity throughout their dominions, and a Conference was held at Berne with the result that a draft Convention was finally agreed to by the various powers. The Conference then adjourned and re-assembled in 1887, when the Convention, known as the "Berne Convention," was signed. In the meantime the International Copyright Act of 1886 was passed, the object being to enable the Crown to issue Orders in Council embodying the chief features of the new Convention. The Berne Convention.

The Act referred to, after reciting that by the International Copyright Acts the Crown was authorized by Order in Council to direct that as regards literary and artistic works first published in a foreign country the author should have copyright therein during the period specified in the order, not exceeding the period during which authors of the like works first published in the United Kingdom had copyright, provides that the Act of 1886 and the previous International Copyright Acts shall be construed together. Power is given to the Crown to make Orders in Council for the purposes of the earlier International Copyright Acts as well as the Act of 1886, for revoking or altering any Order in Council previously made (e). But any order so to be made is not to affect any rights acquired or The International Copyright Act, 1886.

(a) Amended by Order in Council, 5th Aug., 1875.

(b) Amended by Order in Council, 8th Feb., 1855.

(c) The treaty with Spain expired and was renewed 11th Aug., 1880.

(d) The Orders in Council under the Copyright Conventions have now all been revoked by the Order in Council of 28th Nov., 1887.

(e) Sect. 10, sub-sect. 1.

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accrued at the date of such order coming into operation, and shall provide for the protection of such rights (a).

The Berne Convention was signed on the 5th September 1887, by Great Britain, and on the 28th November of the same year an Order in Council was issued giving full effect to the Convention throughout the British dominions, and the Convention, translated into English, is placed in a schedule to the order. This order is to be construed as if it formed part of the International Copyright Act, 1886, and all the previous Orders in Council were repealed.

The "Additional Act of Paris."

In the year 1896 another Conference of the Powers was held in Paris to consider certain proposed modifications of the original Convention, and this resulted in what is known as the "Additional Act of Paris, 1896," modifying the Berne Convention of 1886 in certain particulars, the most important being with regard to translations.

By Order in Council, dated 7th March, 1898, Great Britain adopted the "Additional Act of Paris," but she was unable to accept an "Interpretative Clause" that was agreed to by the other Powers (b).

The countries at the present day bound by the Berne Convention, and forming what is known as the Copyright Union, are: Great Britain with her colonies and possessions, Belgium, Denmark, France with Algeria and her colonies, Germany, Hayti, Italy, Japan, Luxemburg, Monaco, Norway (c), Spain with her colonies, Switzerland, and Tunis.

Fundamental principle.

The fundamental principle of the Berne Convention is to be found in Article II., which, as modified by the Act of Paris, provides that authors of any of the countries of the Union or their lawful representatives, shall enjoy in the other countries for their works, either not published or published for the first time in one of those countries, the rights which the respective laws do now or may hereafter grant to natives, except that the term of protection is not to exceed that in the country of origin. Thus the rights of foreigners are to be assimilated to the rights of natives, except in the matter of length of copyright term.

Works protected under

The works which are protected under the Berne Convention

(a) Sub-sect. 2.

(b) The reasons for Great Britain's non-adherence to the "Interpretative Clause" were chiefly because her domestic law permits dramatization of novels and makes public performance of dramas equivalent to publication. See text of the Interpretative Clause, Appendix.

(c) Norway is not a party to the "Additional Act of Paris," but has signed the Interpretative Clause. For dates of adherence of various countries, see Appendix B.

are books, pamphlets, and all other writings; dramatic or dramatico-musical works, musical compositions with or without words; works of design, painting, sculpture, and engineering; lithographs, illustrations, geographical charts; plans, sketches, and plastic works relative to geography, topography, architecture or science in general; in fact, every production whatsoever in the literary or artistic domain which can be published by any mode of impression or reproduction (*a*) (Article IV.). By Article IX. the provisions of the Convention are extended to public representation of dramatic works and the lyric drama, whether the works in question have or have not been published, and they are also made to apply to musical pieces, but subject to an obligation on the author to state that he forbids public performance.

By a clause added to Article II. by the "Additional Act of Paris" posthumous works are included amongst protected works.

It is an essential condition to protection within the Union that a work shall be published within one of the countries of the Union, but it is not necessary that the author shall be a subject of the country in which he publishes, or indeed of any country belonging to the Union (Article III.). This Article, as originally framed, gave copyright, in the case of an author publishing in a foreign country, to his publisher, but this has been altered by the "Additional Act," and the copyright is now vested in the author himself.

In order that an author may enjoy protection in the other countries of the Union he must be actually protected in his own country (*b*). The author is relieved from all formalities prescribed by the laws of the other countries, but he must comply with the conditions and formalities prescribed by law in the country of origin (*c*). If a work has the name of the author indicated on it in the accustomed manner, he is *prima facie* entitled to the copyright, but the tribunals may, if necessary, require the production of a certificate from the competent authority to the effect that those formalities have been accomplished in the country of origin (*d*).

The "country of origin" is defined to be that in which the work is first published, or if such publication takes place simultaneously in several countries of the Union, that one of them in which the shortest term of protection is granted (*e*).

(*a*) As to photographs, see Art. I. of "Final Protocol," and Art. II. of "Additional Act"; as to choregraphic works, see Art. II. of "Final Protocol."

(*b*) This seems reasonably clear from the second paragraph of Art. II., though it is nowhere expressly so stated.

(*c*) Art. II.

(*d*) Art. XI.

(*e*) Art. II. *Quaere*, if one of the countries does not grant any protection?

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This clause may give rise to difficulties, for it is not always easy to determine the exact date of publication. The country of origin for unpublished works is the country to which the author belongs.

Period of protection.

The Convention does not prescribe any uniform or minimum term of protection for countries of the Union, but leaves this matter to be determined by the local legislation of the various countries. An author cannot, however, claim the benefit of a greater length of protection accorded by the legislation of the country in which he seeks protection, if it exceed that conferred by the legislature in the country where he publishes (*a*).

Translations.

The "Additional Act of Paris" has made an important alteration in the original Convention with regard to translations. Article V. of the original Convention fixed a period of ten years from the first publication of the work during which the author should enjoy the exclusive right of translation. This was a minimum period, but any State was at liberty to accord a longer period of protection, and—though the contrary has sometimes been contended—the effect of section 5 of the International Copyright Act, 1886, and the Order in Council thereunder, probably was to give, in Great Britain, more extensive protection than was required by the Convention as originally drafted in 1886.

Article V. of the Convention has, however, now been altered by the "Additional Act," and brought into accordance with what is believed to have been the law in Great Britain before the "Additional Act" was ratified. As that Article now stands it confers upon authors of any of the countries of the Union, or their representatives, the exclusive right of making or authorizing, in the other countries of the Union, translations of their works during the whole duration of the right in the original work, but the exclusive right of translation is to cease to exist when the author has not within a period of ten years from the first publication of the original work published in one of the countries of the Union, a translation in the language for which protection is claimed. Authorized translations are protected as original works, but if the translating right has fallen into the public domain, the translator cannot oppose the translation of the same work by other writers (*b*).

Newspapers.

Newspapers are dealt with by Article VII., which has been remodelled by the "Additional Act," and now provides that serial novels ('Romans-feuilletons'), including novels published

(*a*) Art. II.

(*b*) Art. VI. It was this Article that prevented Norway from adhering to the "Additional Act."

in newspapers or periodicals of one of the countries of the Union, cannot be reproduced, in original or translation, in the other countries without the authorization of their authors or their representatives. This prohibition applies equally to other articles whenever reproduction is expressly forbidden, and for periodicals it is sufficient if the prohibition is made in a general way, at the beginning of each number. In the absence of prohibition, reproduction is permitted on condition of indicating the source, and the prohibition cannot, in any case, apply to articles of political discussion, to news of the day, or current topics.

As to infringement, this is a matter which the Berne Con- Infringement.
vention leaves generally to the domestic law of each country, subject to the condition that foreign authors are to have the rights granted to natives (*a*). Article XI., however, provides that amongst piracies shall be included indirect appropriations of literary or artistic works, such as adaptations, arrangements of music, &c., when they are only the reproduction of a particular work in the same form, or in another form with non-essential alterations, additions, or abridgments, so made as not to confer the character of a new original work. Article VIII. also provides that as regards the liberty of extracting portions from literary or artistic works for use in publications destined for educational or scientific purposes or for chrestomathies (*b*), the matter is to be decided by the legislation of the different countries of the Union, or by special arrangements existing or to be concluded between them.

It is, further, to be understood that the manufacture and sale of instruments for the mechanical reproduction of musical airs which are copyright, are not to be considered as constituting an infringement of musical copyright (*c*).

Pirated works may be seized by the competent authorities Remedies.
of the countries of the Union where the original work has a right to legal protection, but the seizure is to take place conformably to the domestic legislation of each country (*d*).

The Convention came into force three months after the From what
date Con-
vention takes
effect.
exchange of ratifications (*e*), and is to remain in force for an

(*a*) Art. I.

(*b*) *i.e.*, "a collection of choice passages from an author or authors, especially one compiled to assist in the acquirement of a language." Dict.

(*c*) Final Protocol, Clause 3. It is sometimes contended that perforated rolls for æolian organs are not "instruments" for mechanically reproducing musical airs. And it has been so held in Germany, see *post*.

(*d*) Art. XII. as modified by the "Additional Act." The original article only provided for seizure on importation, but the modified clause provides for seizure in the interior also.

(*e*) Ratifications were exchanged on the 5th Sept., 1887.

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indefinite period, until the termination of a year from the day on which it may have been denounced (*a*).

It is provided by Article XIV. that the Convention is to apply to all works which at the moment of its coming into force have not yet fallen into the public domain in the country of origin, but only subject to the stipulations on this head which may be contained in special Conventions. In the absence of such stipulations any country may by its domestic legislation regulate the manner in which this principle is to be applied (*b*).

Berne Convention only provides a minimum protection.

Although the Berne Convention provides a minimum protection which every State belonging to the Union must accord to authors belonging to the other countries of the Union, there is, of course, no reason why any State should not grant more extensive protection, and Article XV. of the Convention expressly permits the various countries of the Union to enter into separate and particular arrangements with each other, provided that such arrangements confer upon authors more extended rights than those granted by the Union, or embody other stipulations not contrary to the Convention. The local laws of some countries belonging to the Union do confer upon authors advantages superior to those provided in the Convention, particularly in the matter of the right of translation. Where this occurs, such State ought, except where otherwise provided in the Convention, to accord to authors resident in other countries of the Union the benefit of these more favourable provisions, by virtue of the fundamental principle above alluded to, and to be found in Article II. of the Convention, which assimilates the rights of foreigners to those of natives.

Rights of British authors in foreign countries.

It follows from what has been said that when an author of one country of the Union desires to ascertain his rights in respect of his literary or artistic work in another country of the Union he must consult the four following sources (*c*):

1. The law of the country of origin, to ascertain the term of protection and the existence or non-existence of formalities necessary to be complied with.

2. The Berne Convention, which stipulates a minimum protection.

3. The law of the country of importation, that is to say, the country where protection is sought, for everything which

(*a*) Art. XX. Art. XVIII. provides for new accessions to the Union.

(*b*) Art. XIV. and Clause 4 of the "Final Protocol." See Sect. 6 of International Copyright Act, 1886.

(*c*) See an article in 'Le Droit d'Auteur' (the official magazine of the Berne Convention), 1895, p. 162.

relates to the nature of the protection to which he is entitled, and, in particular, to see whether it is in any points more favourable than the Convention.

4. The particular treaties between two or more States being parties to the Union, provided they accord more extensive protection than the Convention (*a*).

The English courts have no jurisdiction to restrain a threatened infringement of copyright in a foreign country, even though that country be a member of the Copyright Union, but proceedings must be taken in the courts and according to the law of the foreign country (*b*).

Foreign rights not protected in English courts.

Turning now to the rights of foreign authors in Great Britain and her colonies, a somewhat peculiar state of affairs is produced by the fact that, for constitutional reasons, an Act of Parliament was necessary before Great Britain could become a party to the Berne Convention. The Act referred to is the International Copyright Act, 1886 (*c*), to which we have already alluded and which incorporates the earlier International Copyright Act of 1844 (*d*). Under the powers conferred by these Acts the Order in Council of 28th November, 1887, was passed decreeing that the Berne Convention set forth in the schedule to the order should, as from the commencement of that order "have full effect throughout Her Majesty's dominions"; and the Order in Council of 7th March, 1898, similarly directs that the "Additional Act of Paris" is to have "full effect" throughout the dominions.

Rights of foreign authors in Great Britain and her colonies.

In order, therefore, to ascertain the rights of foreign authors in Great Britain it is necessary to have regard not only to the Berne Convention itself, but also to the International Copyright Act, 1886, and the two Orders in Council above referred to, and it is most unfortunate that these differ in their terms upon matters as to which there should have been absolute identity. It seems clear, however, that if these differences cannot be reconciled, the statute must prevail over the Orders in Council and the Berne Convention.

The International Copyright Acts.

The earlier International Copyright Act, 1844, as we have seen, conferred upon the Crown the power to direct by Orders in Council that authors of works published in foreign countries should have copyright therein within the dominions of the Crown for such period as might be named in such order, not

(*a*) Inasmuch as Great Britain only possesses one copyright treaty, and that with Austria, which is not a member of the Union, British authors are not concerned as to this last source.

(*b*) '*Morocco Bound' Syndicate v. Harris* (1895), 1 Ch. 534.

(*c*) 49 & 50 Vict. c. 33.

(*d*) 7 & 8 Vict. c. 12.

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exceeding the term of copyright to which British authors are entitled (*a*), and that in such cases the various copyright Acts should, subject to any limitation that might be contained in the orders, apply to the foreign works (*b*). It is conceived, therefore, that no additional power was necessary to enable the Crown to give effect to the fundamental principle of the Berne Convention, assimilating the rights of foreigners to the rights of natives; but sect. 2 and sub-sect. (3) of the Act of 1886 has enacted that "the International Copyright Acts and an order made thereunder shall not confer on any person *any greater right or longer term* of copyright in any work than that enjoyed in the foreign country in which such work was first produced," and similar words are to be found in the Order in Council of 28th November, 1887.

What is the meaning of "greater right."

The provision as to the longer term of copyright is clearly in accordance with the Berne Convention, but it is not easy to find anything in the Berne Convention to justify the limitation of the foreign author's rights to no "greater right" than he enjoys in his own country. The only other limitation to the foreign author's rights, contained in Article II. of the Convention, is that they are to be "subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work." If the words of the Act were intended to refer to this limitation, they have been most unfortunately chosen.

Hanfstaengl v. Empire Palace.

The question as to the meaning of these words was raised in the case of *Hanfstaengl v. Empire Palace* (*c*). The plaintiff was the owner of the copyright in certain pictures first produced in Germany. These pictures had been represented on the stage of an English theatre in the form of tableaux vivants, and the defendants, who were the proprietors of an illustrated newspaper, published in their paper sketches of the tableaux vivants, with explanatory letter-press. Evidence was adduced to the effect that, according to German law, the insertion of copies of works of art in literary works was not prohibited, provided the literary matter was the chief object, and the illustrations were only subsidiary to and for the purpose of explaining the text. It was contended, therefore, by the defendants that even if the insertion of these sketches in their newspaper were a piracy according to English law, it was not a piracy according to German law, and that inasmuch as by section 2 of the Act of 1886 the defendant could not have a

(*a*) Sect. 2.

(*c*) (1894), 3 Ch. 109.

(*b*) Sects. 3, 4, and 5, *ante*, p. 547.

“greater right” in England than in Germany, the plaintiff could not succeed in his action.

In the event it did not become necessary for a decision of the case to determine the meaning of the words, for Mr. Justice Stirling, before whom the case first came, held that the defendants’ sketches were infringements of the plaintiff’s copyright, both according to the law of England and to the law of Germany; whilst the Court of Appeal held, reversing Stirling, J., that the defendants’ sketches were not infringements, even according to English law (*a*). Stirling, J., however, seems to have been of opinion that if the German law had been less favourable to the plaintiff than the English law he could not have claimed the benefit of the more extensive protection, and in the Court of Appeal Lord Justice Lindley remarked (*b*), “If the German law of copyright confers upon the plaintiff a less extensive right in his pictures than the right conferred on British authors by the Act to which I have already alluded, the extent of the plaintiff’s rights must be measured by the German standard, and not by the English standard, and must be restricted accordingly.” Lopes, L.J., expressed his agreement with this view of the law.

If this view of the law should be ultimately held to be correct it will lead to numberless difficulties, for in every case where the international right is in question, the English courts will have to inquire into and decide questions of foreign copyright law. Foreign law is in English courts a matter of evidence, but if foreign copyright law is anything like as intricate as English copyright law, it will be a comparatively easy matter to produce contradictory evidence upon which English courts will not find it easy to base a decision (*c*). But an even more important objection to such a construction is that it would involve a distinct breach of Great Britain’s treaty obligations and would imperil her position as a member of the Copyright Union. The fundamental principle of the Berne Convention is, as we have already pointed out, assimilation of the rights of foreigners to the rights of natives, except as to length of term of copyright and “subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of work.” The principle of the Convention of Montevideo of 11th July, 1889, on the other

(*a*) See this case more fully dealt with on this point, *ante* p. 391.

(*b*) (1894), 3 Ch. at p. 125.

(*c*) In the case referred to above Lindley, L.J., remarked, “I confess that I do not feel sufficiently sure of the German law to be able to base my decision upon it.”

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hand, is that the law of the country of origin follows the work into the countries of the other members of the Union. This latter principle was, it is believed, deliberately rejected by the delegates of the various countries which took part in the deliberations leading up to the Berne Convention of 1887, yet this very principle would be established in England by a decision in accordance with the views expressed by Lord Justice Lindley. If such a decision were then to be given, it would be incumbent upon Parliament to alter her legislation so as to give proper effect to the true principle of the Berne Convention (*a*).

It is, we think, tolerably clear that the Legislature never intended, by the expression referred to, to restrict rights of foreigners in the manner suggested, but the words of the Act must prevail over the intention, unless another meaning can be found for the words. Having regard, however, to the inconveniences above alluded to the courts will, it is thought, strive to find such other meaning and even strain the language, if necessary, in the endeavour. It has been suggested that the words "greater right" mean no more than "longer term," but that would be to render them mere surplusage. A more plausible suggestion is that they refer to the other point mentioned in the Berne Convention, upon which it is permissible to have regard to the law of the country of origin, viz., to see what "formalities and conditions" are thereby prescribed, and whether the author has any right at all, so that if the foreigner has no copyright in his own country, he is not to have any "greater right" in Great Britain (*b*). It is to be hoped when the point again comes before the courts that some solution will be found that will obviate the undoubted difficulties that the expression gives rise to and give that "full effect" to the Berne Convention which the Order in Council directs.

In other respects the International Copyright Acts and the Orders in Council published thereunder seem to have fairly carried out the Berne Convention, but there are still some other unfortunate differences in language.

Some difficulty seems to have been experienced with regard

Rights of
foreigners

(*a*) See the article, already referred to, in 'Le Droit d'Auteur,' 1895, p. 162.

(*b*) Great Britain has a separate copyright treaty with Austria, and in the Order in Council giving effect to this treaty is to be found identically the same expression as to "greater right" and "longer term," whilst by the treaty itself it is provided "that these advantages shall only be reciprocally guaranteed to authors and their legal representatives when the work in question is also protected by the laws of the State where the work was first published, and the duration of protection in the other country shall not exceed that which is granted to authors and their legal representatives in the country where the work was first published."

to Article III. of the original Convention, which provided that the publisher, and not the author, should be entitled to the copyright when the author did not belong to any country of the Union. The difficulty, which was met by section 2 (2) of the Act of 1886 and clause 4 of the Order in Council, no longer exists, since the "Additional Act of Paris" has provided that in such cases the copyright is now to vest in the author.

not belonging
to the
Union.

With regard to works published simultaneously in two or more countries of the Union the work is, according to clause 5 of the Order in Council, deemed to be produced in that one of those countries in which the term of copyright in the work is shortest. This is practically in accordance with Article II. of the Convention, but neither the Convention nor the Order in Council is specific as to what is to happen if one of the countries grants no term of protection at all to the particular production. However, an author is not likely to publish simultaneously in a country which grants no protection, and a more serious difficulty is raised by section 3 (2) of the Act which says that where in the case of simultaneous publication a work is deemed to be published in a foreign country, and not in the United Kingdom, then "the copyright in the United Kingdom shall be such only as exists by virtue of production in the said foreign country, and shall not be such as would have been acquired if the work had been first produced in the United Kingdom." The object of the provision in the Berne Convention was simply to determine the period of protection, but this section of the Act is not so limited, and would appear to raise similar difficulties to those created by the expression "greater right" in section 2.

Simultaneous
publication.

Throughout the International Copyright Act the expression used with regard to works is "produced," and this is interpreted by section 11 to mean, as the case requires, "published, or made, or performed, or represented." In a case, in which infringement of the copyright in a picture was alleged, it appeared that the original picture had been painted in Italy, but, as the plaintiff contended, first published in Germany. Registration is necessary in Italy, but not in Germany, and the plaintiff had not registered. The defendant urged that this omission was fatal, arguing that the words in the interpretation section of the Act must be construed *reddendo singula singulis*, that the appropriate word for a picture was "made," and not "published," and that the picture in this case having been *made* in Italy the conditions prescribed by the law of that country must be complied with, even if it were true that the

Country of
origin.

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work had been first *published* in Germany. The Court of Appeal, however, refused to follow this argument, holding that, in this instance, the English statute had not departed from the provisions of the Berne Convention, and that in order to determine the country of origin of a work the place of publication must be settled (*a*).

Registration
and other
formalities.

According to the Berne Convention, authors belonging to a country of the Union are to be entitled to copyright in the other countries of the Union, "subject to the accomplishment of the 'conditions' and formalities prescribed by law in the country of origin of the work" (*b*), and it is further provided (*c*) that, in order to entitle authors to institute proceedings against pirates before the courts of the various countries of the Union, "it will be sufficient that their name be indicated on the work in the accustomed manner," but the tribunals may, if necessary, require the production of a certificate from the competent authority to the effect that the formalities prescribed by law *in the country of origin* have been accomplished. The section which refers to registration in the International Copyright Act, 1886, is section 4, which provides that "where an order respecting any foreign country is made under the International Copyright Acts, the provisions of those Acts with respect to the registry and delivery of copies of works shall not apply to copies of works produced in such country, except so far as provided by the order." We have already seen that the 7 & 8 Vict., which dealt not merely with the copyright in books, but also with the copyright in prints, engravings, sculptures, and other works of art, did require that foreigners should register their works in a special international register, though in 1844, when the Act was passed, there was no existing provision as to registration of copyright in engravings or in sculptures first published in England.

Formalities
necessary
under the Act
of 1844.

Under the Act of 1844 authors of works in France claiming copyright in this country were held not exempt from conditions affecting authors of works in this country (*d*), and so the proprietors of a foreign print had to comply with the provisions of the Engravings Acts, and the proprietor's name had to be printed thereon (*e*).

This clearly was the view taken by Lord Hatherley in *Cassell v. Stiff*, which he thus expressed: "He," that is the author, "is to have the same protection which the author of

(*a*) *Hanfstaengl v. American Tobacco Co.* (1895), 1 Q. B. 317.

(*b*) Art. II.

(*c*) Art. XI.

(*d*) *Cassell v. Stiff* (1856), 2 K. & J. 279.

(*e*) *Aranzo v. Mudie* (1856), 10 Ex. 203.

any other book would obtain under an Order in Council. He would obtain in that manner protection subject to all the other provisions of the statute, otherwise authors of foreign works would be placed in a better position than those in this country, which certainly was not intended. There is a careful and jealous provision that no author of a foreign work shall be in a better position in this country than authors of works here are. It was not intended to give them anything more. The 3rd section of the statute provides that under an Order in Council the foreign author is to be subject to the provisions of the general Copyright Acts, unless it should be otherwise specified in the order."

The Order in Council of 28th November, 1887, not having provided for either registration or delivery of copies of works, it is clear from section 4 of the Act of 1886 no such registration or delivery is necessary in the case of foreign books, musical or dramatic compositions or of prints, engravings, or sculptures. Nor, it is submitted, are any other formalities prescribed by English law necessary in the case of foreigners, except that, as provided by Article IX. of the Berne Convention, the owner of the copyright in musical works must expressly declare on the title-page or commencement of the work that he reserves the right of public performance, if he desires to do so (*a*).

It has been contended that paintings, drawings, and photographs stand in a different category from the other works referred to, and that, in their case, registration is necessary even under the Act of 1886. It must be remembered that at the passing of the Act of 1844 there was no copyright in paintings, drawings, and photographs, and the Fine Arts Copyright, 1862 (*b*), in conferring such copyright, provided that a special register should be kept at Stationers' Hall, in which the proprietors of the copyright in such works were to register. This register was distinct from the register created by the 5 & 6 Vict. c. 45 for literary works. And the 12th section of the Act of 1862 (*c*) provided that such Act should be considered as including the provisions of the International Copyright Act, 1844 (*d*), in the same manner as if such provisions were part of the Act of 1862. Consequently section 4 of the Act of 1844, and also section 6 which provided for

Under Act of 1886.

As to paintings, drawings, and photographs.

(*a*) In a case of *Moul v. Crown Theatre* ('Times' newspaper, 11th Dec., 1901, 4th Feb., 1903), it seems to have been suggested that this reservation must be in the English language.

(*b*) 25 & 26 Vict. c. 68.

(*c*) Partly repealed by the International Copyright Act, 1886.

(*d*) 7 & 8 Vict. c. 12.

registration, not in the register directed to be kept by the Act of 1862, but in the book kept by the Stationers' Company under the authority of the Copyright Act, 1842, were introduced into the Act of 1862 in the same manner as if they had been there repeated.

Section 4 of the Act of 1886 provides, as we have seen, that where an order is made under the "International Copyright Acts," the provisions of "those Acts" as to registry and delivery of copies of works are not to apply, except so far as provided by the Order in Council. The term "The International Copyright Acts" by section 1 means the Acts specified in the second part of the first schedule to the Act, together with the enactment specified in the second part of the schedule, and these consist of the Acts of 1844, 1852, 1875, and section 12 of the Act of 1862 (a). Consequently section 4 is open to the construction that any provisions with respect to the registry and delivery of copies which are introduced by the International Copyright Acts are not to apply to works produced in a foreign country, except so far as provided by the order, that is to say, unless there is found in the Order in Council something intimating that these provisions as to registration are to apply, but that the provisions of the Copyright Acts, as distinct from the International Copyright Acts, apply unless there is something in the order excepting from the obligation imposed by the first mentioned Acts. In other words, it is open to the construction that the 4th section of the Act of 1886 does not deal with registration under the general Copyright Acts, but under the International Copyright Acts only, and that though there is nothing in the Order in Council of the 28th Nov., 1887, requiring registration under the International Copyright Acts, yet as there is nothing in that order which excepts the enactments with respect to registration contained in the general Copyright Acts, these latter apply. The points above mentioned were fully dealt with in the case of *Fishburn v. Hollingshead* (b), where the question arose in respect of a painting exhibited by the defendants, which was held to be a colourable imitation of the picture of 'Jerusalem and the Crucifixion of Christ,' belonging to the plaintiffs. The plaintiffs had, in fact, purported to register under the Act of 1862, and though the defendants contended the contrary, Mr. Justice Stirling held that the registration was valid. The point, therefore, was

*Fishburn v.
Hollingshead.*

(a) See the Short Titles Act, 1892, which includes, under the term International Copyright Acts, the Acts of 1844, 1852, 1862, 1875, and 1886.

(b) (1891), 2 Ch. 371; 7 T. L. R. 263.

not necessary to the decision of the case, but as it had been argued at great length, the learned judge dealt with it in his judgment. The view he took was that the Legislature provided jealously that no author of a foreign work should be in a better position in this country than a British author, and that though the necessity for registration under the "International Copyright Acts" was removed by section 4 of the Act of 1886 that section did not remove the necessity for registration under the "Copyright Acts." The reasoning of the learned judge undoubtedly involved that before the passing of the Act of 1886 a foreigner had to make a double registration in the case of paintings, drawings, and photographs—under the International Act of 1844 and the Fine Arts Act of 1862, and that whilst the Act of 1886 did away with the necessity for registration under the former Act, it did not under the latter. Such double registration was, however, never effected in practice, it always having been considered that, by virtue of section 12 of the Act of 1862, registration in the international register was sufficient.

In the last edition of this work it was contended that the decision in *Fishburn v. Hollingshead* was wrong, and this contention has been affirmed by subsequent cases.

The case was first doubted by Smith and Grantham, J.J., in the argument in *Moul v. Groenings (a)* (though the doubt is not reported), and in a County Court case it was not followed (*b*). The point then came before Charles, J., in the case of *Hanfstaengl Art Publishing Co. v. Holloway (c)*. The plaintiffs were the proprietors of the copyright, both in Germany and the United Kingdom, of a painting called the 'Guardian Angel,' which had been first published in Germany. The defendants, who were the proprietors of Holloway's pills, had caused photographs of the picture to be copied on to cards which they issued for advertisements. It was not denied that the copies were infringements of the plaintiffs' copyright, but it was contended that the plaintiffs could not recover as they had not registered their copyright under the Fine Arts Copyright Act. This contention the learned judge rejected, holding that a foreigner had never been under any obligation to register save in the international register, and that the necessity for that had been abolished by the Act of 1886. The object of that Act seemed to him to be clear. It was not designed to impose disabilities, but rather, if they existed, to remove them, and to leave the

Fishburn v. Hollingshead overruled.

(a) (1891), 2 Q. B. 443.

(b) *Moul v. Devonshire Park Co.*, 'Law Times,' Sept. 19, 1891.

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foreign and native author as nearly as might be on an equality. The foreigner who complied with the requirements of the law of his own country was to be protected in England; the Englishman who complied with the requirements of English law was to be protected in the foreign countries of the Copyright Union.

The decision of Charles, J., in *Hanfstaengl Art Co. v. Holloway* has since been approved by the Court of Appeal in *Hanfstaengl v. American Tobacco Co. (a)*, and *Fishburn v. Hollingshead* may, it is thought, be taken as overruled on this point.

Translations.

The 5th section of the International Copyright Act, 1886, provides that where a work being a book or dramatic piece is first produced in a foreign country to which an Order in Council applies, the author or publisher, as the case may be, shall, unless otherwise directed by the order (and the order does not direct otherwise) have the same right of preventing the production in and importation into the United Kingdom of any translation not authorized by him of the said work as he has of preventing the production and importation of the original work. But it is provided that if after the expiration of ten years, or any other term prescribed by the order next after the end of the year in which the work, or in the case of a book published in numbers, each number of the book (the last number, according to the Convention, section 5), was first produced (b), an authorized translation in the English language of such work or number has not been produced, the said right to prevent the production in and importation into the United Kingdom of an unauthorized translation of such work shall cease. And it is also provided that the law relating to copyright, including the Act of 1886, shall apply to a lawfully produced translation of a work in like manner as if it were an original work, and that such of the provisions of the International Copyright Act, 1852, relating to translations as are unrepealed by the Act of 1886 (*i.e.*, ss. 6 & 7 of 15 Vict. c. 12, but as to s. 6, see Order in Council, s. 6), shall apply in like manner as if they were re-enacted in the Act of 1886.

The provisions of section 6 of the Act of 1886 were more generous than Article V. of the Berne Convention as originally agreed to in 1886, but seem to be in accord with that Article as modified by the "Additional Act of Paris," which, by Order in Council of 7th March, 1898, was directed to have "full effect"

(a) (1895), 1 Q. B. 347.

(b) By the Act 15 & 16 Vict. c. 12, s. 8, the period was one year. See, too, *Osborne v. Vizeletly* (1885), 1 T. L. R. 17.

throughout the British dominions. The result seems to be that a foreigner has the right to prevent others from making or importing into the United Kingdom translations in the English language throughout the whole period during which the original work is protected, provided an authorized translation in the English language of such work has been produced within ten years, but if no authorized translation appears within that period, then the right of translation falls into the public domain. It is submitted also, that if an authorized translation in another language than English is published in any of the countries of the Union, within the same period, unauthorized translations in that language are forbidden in the United Kingdom during the period for which the original work is entitled to protection.

Under the earlier International Copyright Acts the authors of foreign plays (*i.e.*, plays first published abroad) might prevent the representation in the British dominions of any unauthorized translation, for a period not exceeding four years from the first publication or representation of an authorized translation, but nothing in these Acts was to prevent "fair imitations or adaptations to the English stage" of a foreign play or musical composition (*a*).

Dramatic translations under the earlier Acts.

In the case of *Wood v. Chart* (*b*), 'Frou-frou,' a French comedy, was registered in England, and an English version was made, published, and registered. Mr. Wood, the plaintiff, became assignee of all English rights, both of the authors and translators. An unauthorized version was made and publicly acted by the defendants. Thereupon the plaintiff filed a bill for an injunction and an account. The authorized English version of the plaintiff was entitled 'Like to Like,' the scene transferred to England, the names of the characters changed to English names, and certain alterations and omissions made in the dialogue, but the plot and the main incidents continued the same. Vice-Chancellor James dismissed the bill, holding that the requisitions to entitle the plaintiff to the benefit of the Acts had not been complied with, for 'Like to Like' was not a "translation" within the meaning of the Act, but rather "an imitation or adaptation to the English stage" (*c*).

The scope of the 6th section of the International Copyright Act, 1852, as to fair imitations or adaptations to the English stage of any dramatic piece or musical composition published

Adaptations now restricted.

(*a*) 15 & 16 Vict. c. 12, s. 6.

(*b*) (1870), L. R. 10 Eq. 193; 18 W. R. 822; 22 L. T. 432; 39 L. J. Ch. 641.

(*c*) Cf. *Lauri v. Renard* (1892), 3 Ch. 402, 414.

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in any foreign country was restricted by the 38 & 39 Vict. c. 12, by which the Crown was empowered by Order in Council to direct that the 6th section of the Act of 1852 as to fair adaptations should not apply to dramatic pieces first represented in any foreign country.

By the Order in Council of the 28th November, 1887, section 6, the last-mentioned section was acted upon, and the Berne Convention declares (*a*), as we have seen, that indirect appropriations such as adaptations, arrangements, of music, &c., are especially included among the unlawful reproductions to which the treaty is to apply where they are only the reproduction of a work in the same form or in another form with some non-essential alterations, additions, or abridgments so made as not to confer the character of a new original work. Henceforth, adaptations such as that in *Wood v. Chart*, will be subject to be restrained. This is in accordance with the view of Vice-Chancellor James in that case, when he stated that though the version of 'Frou-frou' was not a translation within the meaning of the Act of 1844, it would have been an infringement of the author's copyright.

What is a translation?

As to what is a translation some difficulty has arisen. Dryden reduces translations to three heads: first, that of metaphrase, or turning an author word by word, and line by line, from one language into another. Thus, or near this manner, was 'Horace, his Art of Poetry,' translated by Ben Jonson. The second way is that of paraphrase, or translation with latitude, where the author is kept in view by the translator so as never to be lost, but his words are not so strictly followed as his sense; and that, too, is admitted to be amplified, but not altered. Such is Mr. Waller's translation of 'Virgil's fourth *Æneid*.' The third way is that of imitation, where the translator (if now he has not lost that name) assumes the liberty, not only to vary from the words and sense, but to forsake them both as he sees occasion; and taking only some general hints from the original, to run divisions on the groundwork, as he pleases. Such is Mr. Cowley's practice in turning two odes of Pindar, and one of Horace, into English (*b*).

Transitory provisions.

Transitory provisions are, by the Berne Convention, expressly left to the legislatures of the various countries of the Union. Article XIV. states that "under the reserves and conditions to be determined by common agreement," the Convention is to apply to all works which at the moment of its coming into force have not yet fallen into the public domain in the country

(*a*) Art. X.

(*b*) Dryden's Works (Scott's Ed.), xii. 11.

of origin. By clause 4 of the Final Protocol the "common agreement" referred to by Article XIV. of the Convention means that the Convention is to apply to works not fallen into the public domain according to stipulations contained in special Conventions, and that in the absence of such stipulations between any countries of the Union the respective countries shall regulate, each for itself, by its domestic legislation, the manner in which the principle contained in Article XIV. is to apply.

Accordingly by section 6 of the International Copyright Act, 1886, it is provided that where an Order in Council is made under the International Copyright Acts with respect to any foreign country, the author and publisher of any literary or artistic work first produced before the date at which such order comes into operation (*i.e.*, 6th December, 1887) (*a*) are to be entitled to the same rights and remedies as if the said Acts and that Act and the said order had applied to the said foreign country at the date of the said production: Provided that where any person has before the date of the publication of an Order in Council (*i.e.*, 28th November, 1887) (*a*) lawfully produced any work in the United Kingdom, nothing in section 6 is to diminish or prejudice any rights or interests arising from or in connection with such production which were subsisting and variable at the said date.

Clause 7 of the Order in Council of 28th November, 1887, in revoking all previous copyright treaties between Great Britain and foreign countries, provides that neither this revocation, nor anything else in the order, shall prejudicially affect any right acquired or accrued before the commencement of that order, by virtue of any order thereby revoked, and any person entitled to such right shall continue entitled thereto, and to the remedies for the same in like manner as if that order had not been made. Similarly the Order in Council of 7th March, 1898, putting the additional "Act of Paris" into force in British dominions, provides (clause 5) that nothing in that order is to prejudicially affect any right acquired or accrued before the commencement of that order by virtue of the Order in Council of 28th November, 1887, or otherwise, and any person entitled to such right is to continue entitled thereto and to the remedies for the same as if that order had not been made; and (clause 6) the author of any literature or

(*a*) This date is, of course, only applicable to the countries of the original signatories to the Convention—Belgium, France, Germany, Hayti, Italy, Spain, Switzerland, and Tunis. Various other dates are applicable to the countries that have since joined the Union, according to the dates of the respective Orders in Council made on their adhesion. The dates will be found in Appendix B.

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artistic work first produced before the commencement of that order is to have the rights and remedies to which he is entitled under section 6 of the International Copyright Act, 1886.

Effect of
sect. 6.

If it were not for the decision in *Lauri v. Renad* (a), it would seem fairly clear that the intention of section 6 of the Act, combined with Article XIV. of the Convention, is that authors whose rights have not fallen into the public domain *in the country in which their works were first published* at the date of the Convention coming into operation in the British dominions are to be protected in England, with a saving in respect of rights and interests which were "valuable and subsisting" at the said date. The decision referred to seems, however, to militate against this view.

*Lauri v.
Renad.*

The facts in *Lauri v. Renad* were as follows: The plaintiff claimed to have acquired by assignment and registration the right of representation both of the English and French versions of a play or pantomime known as 'The Voyage in Switzerland'; or, 'The Swiss Express,' which was originally written in French in 1879 and called 'Le Voyage en Suisse' and translated into English later in the same year. The action was for an injunction to restrain the defendants, a Parisian troupe of pantomimists, from performing a version of the same play, translated from the original in 1891, at a theatre in Nottingham. Section 4 of the International Copyright Act, 1852, having provided that a foreign author should enjoy the exclusive right of translation for five years only from the publication of an authorized translation, it was contended on behalf of the defendants that this exclusive right expired in 1884; that, consequently, at the date when the Berne Convention came into operation, the right of translation had fallen into the public domain in England; and that the Act did not revive a lapsed right. Mr. Justice Kekewich refused on this ground to grant the interlocutory injunction sought by the plaintiff, and, upon appeal, his appeal was rejected.

Lord Justice Lindley said that the only enactment which could avail the plaintiff was section 6 of the Act of 1886; but there was a fundamental rule of English law that no statute shall be given a retrospective operation unless its language is such as plainly to require such a construction, and that no statute shall have a greater retrospective operation than its language renders necessary; and it would be a violation of these rules if that section were to be construed so as to

(b) (1892), 3 Ch. 402.

revive or recreate a right which had expired before the Act was passed, or to confer a new right on the owners of an expired right without any fresh act done by him. Mr. Justice Kay was of opinion that section 6 must certainly have some retrospective meaning and operation, but he could not think that its true construction was to take away from the public the right which they had as to this drama published in 1879 under the legislation which existed prior to 1886.

It is submitted with great deference that this decision was wrong. It must be remembered that the defendants' translation had not been made before 1886; if it had, then, no doubt they would have had a "valuable and subsisting" interest in their translation, in the enjoyment of which they would have been protected by the final proviso to section 6. The fundamental rule of English law stated by Lord Justice Lindley cannot be denied, but the question is whether the language of the statute does not require a retrospective operation to be given to it. Article XIV. of the Berne Convention must, it is submitted, be treated as though it were part of the statute, for the Order in Council of 1887 was made by virtue of the authority conferred by that statute, and that order states that the Convention is to have "full effect." Article XIV. provides that the Convention is to apply to all works which at the moment of its coming into force have not yet fallen into the public domain *in the country of origin*, and there was no evidence in this case that either the right of translation or of representation had fallen into the public domain *in France* in 1886. No doubt, if section 6 plainly requires the restrictive meaning that the Court of Appeal placed upon it, this meaning must prevail over the Convention, but it is submitted there is no necessity for such a construction. Did the plaintiff fail in his action, it may be asked, because he had the misfortune, by reason of the copyright treaty with France, to have had at one time in England the right to prevent such a translation as he complained of, or would his action have been equally dismissed if he never had had any such right before 1886? For instance, as England had not a copyright treaty with Switzerland before the Berne Convention, any one might, until 1886, have pirated in England a Swiss book whether protected or not in Switzerland; yet it surely cannot be contended that any one may still pirate a Swiss book published before 1886, even though it has not fallen into the public domain in that country? But, if so, then the Act of 1886 has operated to take away from the public a right they possessed before 1886, and Lord Justice Kay's

Examination
of decision
in *Lauri v.*
Renard.

CAP. I.

objection falls to the ground. On the whole, therefore, we cannot but regard *Lauri v. Renad* as wrongly decided, and consider that, according to the true construction of section 6, the determining factor is not whether a work has fallen into the public domain in *England* at the date when the Convention comes into operation, but whether it is still entitled to protection in the country of origin. If it be still entitled to protection in the country of origin then the effect of the section, it is thought, is that the foreign author may prevent piracies in the United Kingdom made after the coming into operation of the Convention, but without prejudice to any rights or interests which are subsisting and valuable at that date.

Section 6 is retrospective.

This view is strengthened by the decision of Mr. Justice Charles in *Hanfstaengl Art Co. v. Holloway* (a)—a case already referred to on another point (b). There the learned judge held that section 6 was retrospective and afforded protection to the proprietor of the copyright in a picture made in Germany in 1884. He regarded that section as co-extensive with Article XIV. of the Berne Convention, and thought it might properly be applied in accordance with the introductory words of the Convention, for the effectual protection of authors generally, as well of foreign authors whose works were published or made when the Act was passed, as of foreign authors who thereafter should publish or make works abroad (c).

Saving as to existing rights.

The proviso to section 6, which enacts that where works have, before the publication of an Order in Council, been "lawfully produced in the United Kingdom" (d), nothing in that section is to diminish or prejudice "any rights or interests arising from or in connection with such production which are subsisting and valuable at the said date," is important, and was fully considered in the case of *Moul v. Groenings* (e).

The plaintiff, a French subject, had composed and first produced in France a musical composition called the 'Caprice Polka' before the order of the 28th November, 1887, had come into operation, but had not acquired the copyright or sole right of performance in England, pursuant to 7 & 8 Vict. c. 12, and the Order in Council made under that Act, 16th January, 1852. Before the date of the publication of the order of 1887, an English publisher had printed and published the plaintiff's work in

(a) (1893), 2 Q. B. 1.

(b) *Ibid.*, p. 479.

(c) See also per Grantham, J., in *Moul v. Groenings* (1891), 2 Q. B. 443, at p. 451.

(d) The proviso, therefore, does not protect works lawfully produced in a foreign country before the Convention came into force.

(e) (1891) 2 Q. B. 443; 7 Times L. R. 623; 64 L. T. 329; 65 L. T. 327.

England, and the defendant, a bandmaster, had purchased a copy for 5s. for the use of his band, and had played it by his band both before and after such date. In an action for damages for the infringement of copyright and for an injunction, it was held by the Court of Appeal, affirming the judgments of A. L. Smith and Grantham, J.J., that there was evidence to warrant the finding that the defendant had an interest arising from or in connection with the lawful production of the work in the United Kingdom which was subsisting and valuable when the Order in Council was published, and that he was, therefore, protected by the proviso to sect. 6.

In his judgment in the Divisional Court below, Mr. Justice Smith says: "It appears to me that the legislature contemplates a distinction between the word 'rights' and the word 'interests' used in the disjunctive as they are, and to understand what is meant thereby, it becomes important to remember the positions of many authors and publishers in this country when the International Copyright Act was passed in 1886. By the International Copyright Act, 1844 (a), to entitle a foreign author to the copyright of a foreign work in this country, it must have been registered within a time to be prescribed by each Order in Council. In 1886, there existed many foreign works copyright in their own country, which had no protection here, and in connection with such works, English authors and publishers were in the habit of bringing out reproductions with such additions and alterations as to give them a protection under the English Copyright Acts. In these cases the English translator or adapter beside his right (in the popular sense) to produce in common with all mankind, a work not copyright in England, had a right in the strict legal sense of the term under the English Copyright Acts, having obtained for his translation or adaptation protection thereunder. It is true he could not prevent other persons going to the foreign original for a similar purpose, but he could prevent them from saving themselves the trouble of translating or adapting by copying his work without going to the original. It is to this class of case, in my judgment, that the term 'rights arising from or in connection with publication' applies, but it is not suggested that Lafleur (the publisher of the English version) had any such rights.

"There also existed another class of case in which English publishers had bestowed no original labour on the foreign

(a) 7 & 8 Vict. c. 12, s. 6.

CAP. I.

works they produced here, but had simply reproduced them as Lafleur had produced the polka in the present instance. In this class of case, in my judgment, the English publishers would not have acquired rights within the meaning of the proviso. It is true that they would have, popularly speaking, a right to reproduce the works as had every one else, for no one could stop them ; but though they had this right to produce, they could not in my judgment in the terms of the proviso, have any 'rights arising from or in connection with their production.' They had no further right on the day after they had produced the works than they had the day before, and I arrive at the conclusion that in this case neither Lafleur nor the defendant had any rights arising from or in connection with their publication, or performance of the polka within the true reading of the proviso.

"But had not Lafleur *an interest* arising from or in connection therewith? If the publisher of a work had invested capital in its production, and depended for the return of that capital upon the sale of copies in stock, or it may be upon the proceeds of a second edition, and was in such a position upon December 2, 1887, why, I ask, has he not an 'interest arising from or in connection with the production of the work subsisting and valuable' upon December 2, 1887? In my judgment he has, and that it was to meet cases such as these, that the word 'interests' was inserted in the proviso in contradistinction to the word 'rights.' He has a direct subsisting pecuniary interest in the continuation of the production or, in other words, in connection with the production; and s. 6 enacts that this interest is not to be diminished or prejudiced, which a foreigner could distinctly do if he could in such a case, by means of the Act of 1886, stop the further production of the work. This instance of a publisher by no means exhausts the examples which might be given as to whom the proviso would apply, but it suffices to accentuate the points now in hand. I hold, therefore, that Lafleur would have an interest within the true reading of the proviso assuming that he was in the position suggested on December 2, 1887. Now comes the question as to the defendant. Why had not he, on December 2, 1887, an 'interest arising from or in connection with the performance' of the polka then subsisting and of value? For the reasons above given he had no 'rights' within the proviso; but why not an '*interest*'? The learned county court judge held that there was evidence that he had an interest subsisting and of value. In my judgment there was

evidence that he had an interest then subsisting, viz., an interest to recoup and to obtain a return for the outlay he had been put to in purchasing the piece, in training his band in its performance, and possibly in adapting it to different parts for his men, and that this interest was of value. Whether there be such an interest of value must in each case depend upon the facts of each case.

“ There is also another point, which is this: if all the bandmen in the kingdom and all others are to be prevented from playing this polka, it might well be that Lafleur’s interest in his unsold copies, if such there be, would be seriously affected, and it seems to me that this would also prevent this action from succeeding, if it were proved that Lafleur was in such a position on December 2, 1887.” In the same case Mr. Justice Grantham gave some apt illustrations which clearly show the view the courts are likely to take on the subject. He says: “ Just let us assume that it is a book which is the subject of dispute; an English printer has published a French book here, and has a number of copies still unsold. Are those copies to be wasted or not? In my judgment, not, and he would have the right of selling, and others would have the right of buying them certainly until that edition was sold out. As far as his position is concerned, he occupies very much the same position *pro tanto* at least that he would occupy if he had printed and published a book written by an English author, before that author had taken steps to secure his copyright. His interests, to say nothing of his rights in connection with or arising from the publication, would be subsisting and valuable. Next let us take the case of a manager of a theatre. He translates and produces on the stage a French comedy before the passing of the Act. Can it be said that he ought or was likely to be prejudiced by *ex post facto* legislation, and that, though perhaps only one or two performances had been given and none of the initial expenses of reproduction recouped to him, yet he had no interests arising out of that production which were subsisting and valuable at the date of the coming into operation of the Order in Council giving the foreigner this new right? Next take the case of a composer or publisher of music who incurs considerable expense in printing some musical compositions for a band, and has only sold a few copies, and is dependent on the performance of the music by those who have already bought it to popularise the music, and so sell the remainder of his edition. He was completely within his legal rights in the publication here of the music. Has he no interests

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in that publication which would be legal as against an English composer who had delayed the claim of and thus lost his copy right? And if he has as against him this right, he should have the same right as against the foreigner who for the first time was being treated in the same position as the home producer. If the publisher has this right, why then has not the performer of the music the same right apparently reserved to him in the same spirit by this proviso? He might have spent days in teaching his band this music. He might have spent pounds where in this case shillings were spent in the purchase of the music, and he intended probably, as in this case, to continue the performance to recoup himself for his outlay, and to enjoy the valuable interests he had in this music from its great popularity. Would it not be right to preserve his vested interests as well as those of the publisher of the book first mentioned, or the theatrical manager who prepared a French play for the English stage? For these reasons my judgment must be for the defendant, the respondent."

Foreign pictures as trade marks and advertisements.

This case was followed by Mr. Justice Chitty in *Schauer v. Field (a)*. The plaintiff, a German, claimed to have the photographic copyright in an oil painting called 'Lisette,' produced in Germany before December 1885, and also the copyright in a photograph of 'Lisette' as a distinct work of art. In January 1887, some months before the Order in Council extending the benefit of the International Copyright Act, 1886, to Germany came into operation, the defendants registered as their trade mark for candles, a photograph of 'Lisette' on a small scale, with their name and the words "trade mark" across the picture. This trade mark was extensively used by the defendants on their goods; it was also reproduced by them in various sizes and colours by chromolithography on show cards and trade lists for the purposes of advertisements. It was held that the defendants, as the proprietors of the trade mark had an interest in advertising it, as they had done, by means of the show cards and trade lists; that this was an interest arising from or in connection with the trade mark itself, which was subsisting and valuable at the date of the publication of the Order in Council, and that the defendants were consequently protected by section 6 of the Act, and that it was not material to consider the date at which these show cards were produced; neither was it material that there was a trifling difference between the show cards and the trade mark.

(a) (1893), 1 Ch. 35.

so long as the substance of the trade mark had been honestly advertised.

This case must be distinguished from *Hanfstaengl Art Co. v. Holloway* (a), where a German picture had been used for the purpose of advertising the defendant's well-known pills, but not as a trade mark. It would appear—though it is not distinctly stated in the report—that all copies printed before the Order in Council came into operation had been exhausted and that the plaintiff's complaint was in respect of those subsequently printed. Mr. Justice Charles held that the defendant had not such a "direct subsisting pecuniary interest" in the continuation of the advertisement as to bring his case within the proviso to section 6, and he granted an injunction and damages to the plaintiffs.

It would seem to follow from these cases that if a person has lawfully produced in the United Kingdom before December 1887, say, a French work, he will be entitled to sell after that date all copies made before that date, but he will not have a right to bring out a fresh edition or to create fresh copies after that date.

As to the words "lawfully produced," these, apparently, mean produced without any one having had a right in the United Kingdom to prevent the production as being an infringement of copyright (b).

The 7th section of the Act of 1886 provides that where it is necessary to prove the existence or proprietorship of the copyright in any work first produced in a foreign country to which an Order in Council applies, an extract from a register or a certificate or other document stating the existence of the copyright, or the person who is the proprietor or is for the purpose of any legal proceedings in the United Kingdom deemed to be entitled to such copyright, if authenticated by the official seal or the signature of a Minister of State of the said foreign country, or by the official seal or the signature of a British diplomatic or consular officer acting in such country, shall be admissible as evidence of the facts named therein, and all courts shall take judicial notice of every such official seal and signature, and shall admit in evidence without proof the documents authenticated by it.

Evidence
of foreign
copyright.

The 11th Article of the Berne Convention is as follows: In order that the authors of works protected by the present Convention shall in the absence of proof to the contrary be

(a) (1893), 2 Q. B. 1.

(b) Cf. *Pitt Pitts v. George* (1896), 2 Ch. 866.

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considered as such, and be consequently admitted to institute proceedings against pirates before the courts of the various countries of the Union, it will be sufficient that their name be indicated on the work in the accustomed manner. For anonymous or pseudonymous works the publisher whose name is indicated on the work is entitled to protect the rights belonging to the author. He is, without other proof, reputed the lawful representative of the anonymous or pseudonymous author. It is, nevertheless, agreed that the tribunals may, if necessary, require the production of a certificate from the competent authority to the effect that the formalities prescribed by law in the country of origin have been accomplished, as contemplated in Article II.

Treaty with
Austria.

Great Britain has a special copyright treaty with Austria, which differs in some respects from the Berne Convention. This treaty came into force on 11th May, 1894 (Order in Council, 30th April, 1894), and applies to all the colonies and foreign possessions of the Crown except Canada, the Cape, and New South Wales (*a*). Under this treaty authors of literary or artistic works, which have been first published in the dominions of one of the contracting parties, are to have in the dominions of the other contracting party the same legal remedy against all infringements of their rights as if the work had been first published in the country where the infringement may have taken place, but these advantages are only to be reciprocally guaranteed to authors when the work in question is also protected by the laws of the state where the work was first published, and the duration of protection in the other country is not to exceed that which is guaranteed to authors in the country where the work was first published (*b*).

This treaty must be construed along with the International Copyright Acts and the Order in Council of 30th April, 1894, made thereunder.

Convention
of Montevideo and
Pan-
American
Convention.

Besides the Berne Convention there are two other Conventions at the present day for the protection of international copyright, viz., the Convention of Montevideo (11th January, 1889) and Pan-American Convention (27th January, 1902). To neither of these is Great Britain a party (*c*). The former Convention

(*a*) Newfoundland, Natal, Victoria, Queensland, South Australia, Western Australia, and New Zealand became entitled to the benefit of this treaty on 2nd Feb. 1895, and India on 11th May, 1895.

(*b*) See full text of this treaty and the subsequent Order in Council of 30th April, 1894, in Appendix.

(*c*) The parties to the Convention of Montevideo are the Argentine Republic (19th Dec. 1894), Paraguay (3rd Sept. 1889), Peru (25th Oct. 1889), Uruguay (1st Oct. 1892), and Bolivia (5th Nov. 1903). Brazil and Chili have signed, but not

adopts a wholly different principle to that of the Berne Convention, conferring upon an author belonging to one country of the Union in the other countries of the Union the rights which he enjoys in the country where he first publishes, not the rights which authors enjoy in the country where the infringement takes place, so that under this Convention the law of the country of origin follows the work into the other countries of the Union (*a*). The Pan-American Convention adopts the Berne principle, but in order to obtain the recognition of the copyright of a work it is indispensable that the author shall address a petition to the official department to be designated by each government, claiming the recognition of such right, which petition must be accompanied by two copies of the work, which are to remain in the proper department. If the author desire that his copyright shall be recognized in any other of the signatory countries, he must attach to his petition a number of copies of his work, equal to that of the countries he designates in his petition, to be forwarded to those countries by the department (*b*).

There is no treaty between Great Britain and the United States on the subject of copyright, and until recently British authors could not prevent their works being pirated in America. Some measure of protection is, however, now accorded to British authors by virtue of the Act known as the Chace Act, 1891. The benefits of this Act are extended to a citizen of a foreign state when such foreign state permits to Americans the "benefit of copyright on substantially the same basis as its own citizens," or when such foreign state is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States may at its pleasure become a party thereto. The existence of either of these conditions is to be determined by the President by proclamation.

International
copyright
with the
United
States.

The rights of foreign authors in the United States under the Chace Act will be fully treated in the part of this work dealing

ratified the Convention. France adhered to the Convention on 3rd July, 1897, Spain on 29th Dec. 1899, Italy 18th April, 1900, and Belgium in 1903. The adhesion of these European countries has been accepted only by the Argentine Republic and Uruguay. The Pan-American Convention was signed by the representatives of seventeen American States, viz., Argentine Republic, Bolivia, Chili, Colombia, Costa Rica, Dominican Republic, Ecuador, Guatemala, Hayti, Honduras, Mexico, Nicaragua, Paraguay, Peru, Salvador, United States, and Uruguay. It has, so far, been ratified only by Guatemala, Salvador, Costa Rica, and Paraguay.

(*a*) As only two of the five countries that have ratified this Convention, viz., Peru and Bolivia, have a precise law on the subject of copyright, the application of the principle seems a little difficult.

(*b*) The provisions of these Conventions are more fully set out in the part relating to Copyright in Foreign Countries.

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with Copyright in Foreign Countries, but it must be remembered that the rights of American authors in Great Britain and her possessions do not rest upon any treaty, but simply upon the ordinary copyright law in Great Britain. In the year 1891 an official assurance was given by the British Government, acting on the opinion of the law officers of the Crown, to the President of the United States, to the effect that under the existing English legislature a foreigner can obtain copyright upon first publication of his work in any part of the British possessions, and that simultaneous publication in a foreign country does not prevent the author from acquiring British copyright. Residence, it was stated, in some part of the British possessions is not a necessary condition to obtaining the protection of the English laws concerning copyright.

We have in an earlier part of this work considered how far this opinion truly represents the English law as to literary copyright (*a*). As to copyright in paintings, drawings, and photographs it seems undoubtedly erroneous, for section 1 of the Fine Arts Copyright Act, 1862 (*b*), expressly confines copyright in those productions to an author who is "a British subject or resident within the dominions of the Crown." Yet upon the faith of the above official assurance, the President of the United States proclaimed Great Britain as entitled to the benefits of the Chace Act (*c*).

But, in any case, an American author will only be entitled to copyright in Great Britain upon complying with the same conditions as a British subject. He must, therefore, publish simultaneously in Great Britain or her possessions on the one hand and in the United States on the other hand, and he must register at Stationers' Hall and deposit the necessary copies of his work where this would be required from a British author.

(*a*) *Ante* p. 91 *et seq.*

(*c*) And see under "Canada," *post*.

(*b*) 25 & 26 Vict. c. 68.

CHAPTER II.

COLONIAL COPYRIGHT.

THE rights enjoyed in the United Kingdom by authors of works first published in the colonies and those enjoyed in the colonies by authors of works first published in the United Kingdom differ materially, the former being governed by Imperial legislation, the latter partly by Imperial legislation and partly by colonial.

As to Literary Copyright the Act of 5 & 6 Vict. c. 45, expressly extends copyright to every part of the British dominions (*a*), but none of the Acts relating to artistic or dramatic copyright contain any similar provision. On the other hand, the Literary Copyright Act did not confer copyright in the United Kingdom on works first published in the colonies (*b*). The Fine Arts Copyright Act, 1862, does refer to the British dominions, giving copyright in all works made in the British dominions or elsewhere (*c*), but it has been held that there is nothing to extend the copyright throughout the British dominions, the provisions of sections 8 and 10, providing for the recovery of the penalties in England, Scotland, and Ireland, and forbidding the importation into the United Kingdom of copies made in any part of the British dominions indicating a contrary intention (*d*).

Whilst, therefore, a British author publishing a literary work in the United Kingdom obtains under the Literary Copyright Act, 1842, an imperial copyright, extending throughout the British dominions (*e*) and is thus enabled to prevent piracies in any colony, a British artist first publishing in the United Kingdom obtains no imperial copyright, but, if he desires to prevent infringements in a colony, must

(*a*) Sect. 29.

(*b*) This is now remedied by the International Copyright Act, 1886, see *post*.

(*c*) Sect. 1.

(*d*) *Graves & Co. v. Garrie* (1903), A. C. 496.

(*e*) The "British dominions" means "all parts of the United Kingdom of Great Britain and Ireland, the islands of Jersey and Guernsey, all parts of the East and West Indies, and all the colonies, settlements, and possessions of the Crown which now are or hereafter may be acquired."

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acquire local copyright according to the laws of the particular colony.

Foreign
reprints
forbidden
to be
imported into
Colonies.

By section 17 of the Literary Copyright Act all persons other than the proprietor of the copyright or persons authorised by him are forbidden to import into any part of the British dominions, for sale or hire, any printed book first composed or written or printed and published within the United Kingdom, wherein there shall be copyright, and reprinted in any country or place out of the British dominions, under penalty of £10, and double the value of the books (*a*). Complaints arose, especially from Canada, with regard to this prohibition. It was contended that in the sparsely populated colonies, where the circulating library system did not prevail, the price of English books was practically prohibitive, whilst English publishers feared to issue special cheap colonial editions, because they would not be able to prevent their re-importation into Great Britain. With a view to remedy these grievances, in 1847 there was passed an Act, which is still in force, commonly known as the Foreign Reprints Act (*b*), enabling the Crown by Order in Council to suspend the prohibition against importation into the colonies of English copyright works, under certain conditions.

The Act provides that in case the legislative authorities in any British possession shall be disposed to make provision for securing or protecting the rights of British authors in such possession, and shall pass an Act or make an Ordinance for that purpose, and shall transmit the same in the proper manner to the Secretary of State, in order that it may be submitted to the Crown, and in case the Crown should be of opinion that such Act or Ordinance is sufficient for the purpose of securing to British authors reasonable protection within such possession, it shall be lawful for the Crown, if it think fit so to do, to express its royal approval of such Act or Ordinance, and thereupon to issue an Order in Council declaring that so long as the provisions of such Act or Ordinance continue in force within such colony, the prohibitions contained in the aforesaid Acts (*i.e.*, the Copyright Act, 1842, and 8 & 9 Vict. c. 93) (*c*), and therein before recited, and any prohibitions contained in the said Acts, or in any other Acts, against the

(*a*) And see Customs Consolidation Act, 1876 (39 & 40 Vict. c. 36), sects. 151 and 152, as to any colony not making entire provision for the management and regulation of their own customs. *Black v. Imperial Book Co.* (1903), 5 Ontario L. R. 184, *ante*, p. 197.

(*b*) 10 & 11 Vict. c. 95. This Act may, by the Short Titles Act, 1892, be cited as the Colonial Copyright Act, 1847.

(*c*) Since repealed, and now replaced by the 39 & 40 Vict. c. 36.

importing, selling, letting out to hire, exposing for sale or hire, or possessing foreign reprints of books first composed, written, printed, or published in the United Kingdom, and entitled to copyright therein, shall be suspended so far as regards such colony; and thereupon such Act or Ordinance shall come into operation, except so far as may be otherwise directed by such Order in Council. Every such Order in Council to be published in the 'London Gazette,' and Orders in Council and the colonial Acts or Ordinances to be laid before Parliament within a certain specified time. Accordingly, the following colonies have placed themselves within the provisions of this Act, viz., Antigua, 25th June, 1850 (*a*); Bahamas, 5th June, 1849; Barbadoes, 29th December, 1848; Bermuda, 2nd March, 1849; British Guiana, 4th November, 1851; Canada, 24th December, 1850, and 8th July, 1868 (*b*); the Cape, 16th March, 1855; Grenada, 13th January, 1854; Jamaica, 13th January, 1854; Mauritius, 15th April, 1853; Natal, 22nd May, 1857; New Brunswick, 8th September, 1848; Newfoundland, 7th August, 1849; Nova Scotia, 8th September, 1848; Prince Edward's Island, 3rd November, 1848; St. Christopher, 20th November, 1849; St. Lucia, 19th November, 1850; St. Vincent, 27th August, 1852; and Trinidad, 1875. In fact, all the important colonies with the exception of Australia. The understood arrangement is, that English publishers shall furnish catalogues of their copyrights to the custom-house authorities in the different colonies, as a guide for exacting what is termed the protective duties. These measures are next to inoperative, and the whole thing is little better than a delusion; so little is collected, that British authors and publishers reap either nothing or some paltry and insignificant amount, and they have now (*c*) generally ceased to give themselves any concern in the matter. In Canada the evil was experienced to a greater extent than in other colonies. Its proximity to the United States need only be recalled to mind to suggest the quarter from which the unauthorized reproductions of British works chiefly proceeded. In short, unauthorized cheap reprints of British copyright

(*a*) The dates are the dates of the 'London Gazette,' containing the respective orders. The orders themselves are dated a few days earlier.

(*b*) These Orders in Council seem no longer to be in force as to Canada. See *post*.

(*c*) A ludicrous but significant illustration of the value of colonial copyright to English authors is furnished in a document sent in 1875 to Archbishop Trench from Her Majesty's Treasury. It announced that the sum of elevenpence was in the hands of the Paymaster-General, and would be paid to Dr. Trench on presentation of a signed receipt. It appears that the elevenpence represented the whole amount the colonial authorities in Canada had levied on the Archbishop's behalf during nearly as many years, that is, at the rate of a penny a year. Yet it is well known that Dr. Trench's books had there a large and constant sale.

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works may be said to have been freely imported into and sold in Canada and the adjacent provinces.

These statements are confirmed by a letter dated the 11th of June, 1868, from Mr. John Lovell (a Montreal publisher) to Mr. Rose, which appears in the correspondence carried on between the Canadian Government and the Imperial authorities upon the subject of "Copyright Law in Canada," and published some years ago. Mr. Lovell says: "At present only a few hundred copies pay duty, but many thousands pass into the country without registration, and pay nothing at all; thus having the effect of seriously injuring the publishers of Great Britain, to the consequent advantage of the United States. I may add that, on looking over the custom-house entries to-day, I have found that not a single entry of an American reprint of an English copyright (except the reviews and one or two magazines) has been made since the 3rd day of April last, though it is notorious that an edition of 1000 of a popular work coming under this description has been received and sold within the last few days by one bookseller in this city."

The Copy-
right Com-
missioners on
the Colonial
Copyright
Act, 1847.

The Royal Copyright Commissioners in their report in June, 1878, referring to the operation of the Colonial Copyright Act, 1847, say, "so far as British authors and owners of copyright are concerned, the Act has proved a complete failure. Foreign reprints of copyright works have been largely introduced into the colonies, and notably American reprints into the Dominion of Canada; but no returns, or returns of an absurdly small amount, have been made to the authors and owners. It appears from official reports that during the ten years ending in 1876, the amount received from the whole of the nineteen colonies, which have taken advantage of the Act, was only £1155 13s. 2½*d.*, of which £1084 13s. 3½*d.* was received from Canada; and that, of these colonies, seven paid nothing whatever to the authors, while six now and then paid small sums amounting to a few shillings" (*a*).

Customs
Consolidation
Act.

Section 152 of the Customs Consolidation Act (*b*) prohibits the importation into the British possessions abroad of British copyright books printed or reprinted in any other country, provided the proper notices be given to the customs authorities; but this section is limited by section 151 of the same Act, which, whilst declaring that the Customs Acts are to extend and be of full force and effect in the several British possessions abroad, excepts

(*a*) See 39 & 40 Vict. c. 36, s. 42, and 52 & 53 Vict. c. 42; from 1877 to 1895 the sum of £5278 was collected in Canada.

(*b*) 39 & 40 Vict. c. 36.

any possession which "shall by local Act or ordinance have provided, or may hereafter with the sanction and approbation of Her Majesty and her successors, make entire provision for the management and regulation of the customs of any such possession, or make in like manner express provisions in lieu or variation of any of the clauses of the said Act for the purposes of such provision." Canada, for instance, does make such provision, and the Act, therefore, does not apply in that colony (*a*).

The suggestions of the Royal Copyright Commissioners on the subject of colonial copyright were numerous. They recommended that the difficulty of securing a supply of English literature at cheap prices for colonial readers should be met in two ways: first, by the introduction of a licensing system in the colonies; and, secondly, by continuing, though with alterations, the provisions of the Colonial Copyright Act, 1847.

Suggestions
of Copyright
Commis-
sioners as to
colonial
copyright.

In proposing the introduction of a licensing system, they did not intend to interfere with the power now possessed by the colonial legislatures of dealing with the subject of copyright, so far as their own colonies are concerned. They recommended that in case the owner of a copyright work should not avail himself of the provisions of the copyright law (if any) in a colony, and in case no adequate provision be made by republication in the colony or otherwise, within a reasonable time after publication elsewhere, for a supply of the work sufficient for general sale and circulation in the colony, a licence might, upon an application, be granted to republish the work in the colony, subject to a royalty in favour of the copyright owner, of not less than a specified sum per cent on the retail price, as might be settled by any local law. Effective provision for the due collection and transmission to the copyright owner of such royalty should be made by such law (*b*).

The Commissioners could not recommend the simple repeal of the Colonial Copyright Act, 1847. They believed that although the system of republication under a licence might be well adapted to some of the larger colonies which have printing and publishing firms of their own, and which could reprint and republish for themselves with every prospect of fair remuneration, it would be practically inapplicable in the case of many of the smaller colonies. These latter at present depend almost wholly on foreign reprints for a supply of literature; and to sweep away the Colonial Copyright Act, 1847, without estab-

Not recom-
mend repeal
of the
Colonial
Copyright
Act, 1847.

(*a*) *Black v. Imperial Book Co.* (1903), 5 Ontario L. R. 184.

(*b*) Par. 207.

CAP II.

lishing some other system of supply would be to deprive them in a great measure of English books (*a*). The Commissioners considered that it had been proved that the existing law in the different colonies had failed to secure remuneration to proprietors of copyright, and therefore they suggested that power should be given to the Crown to repeal the existing Orders in Council, and that no future Order in Council should be made under the Act until sufficient provision had been made by local law for better securing the payment of the duty upon reprints to the owners of copyright works (*b*).

It appeared to the Commissioners that possibly some arrangement might be effected by which all foreign reprints should be sent to certain specified places in the colony, and should be there stamped with the date of admission upon payment of the duty, which could then be transmitted here to the Treasury or Board of Trade for the author. All copies of foreign reprints not so stamped, they thought should be liable to seizure, and possibly some penalty might be also affixed to the dealing with unstamped copies.

And having regard to the power which they had contemplated, for authors to obtain colonial copyright by republication in the colonies, and to the licensing system which they had suggested, they recommended that when an Order in Council for the admission of foreign reprints has been made, such reprints should not, unless with the consent of the owner of the copyright, be imported into a colony—

1. Where the owner has availed himself of the local copyright law, if any.
2. Where an adequate provision, as pointed out above, has been made; or,
3. After there has been a republication under the licensing system (*c*).

And, lastly, the Commissioners were of opinion that colonial reprints of copyright works first published in the United Kingdom should not be admitted into the United Kingdom without the consent of the copyright owner; and conversely, that reprints in the United Kingdom of copyright works first published in any colony, should not be admitted into such colony without the consent of the copyright owners (*d*).

In the case of *Routledge v. Low* (*e*), Lords Cairns, Cranworth, Chelmsford, Westbury, and Colonsay unanimously held that to

(*a*) Par. 211.

(*c*) Pars. 215, 216.

(*e*) (1868), L. R. 3 H. L. 100.

(*b*) Par. 213.

(*d*) Pars. 225, 226.

Colonies now have copyright in the United Kingdom.

acquire a copyright under 5 & 6 Vict. c. 45, the work must be first published in the United Kingdom. The law, therefore, was that if a literary or musical work were first published in the United Kingdom, it would be protected from infringement in any part of the British dominions; but if, on the other hand, any such work were first published in India, Canada, Jamaica, or any other British possession not included in the United Kingdom, no copyright could be acquired in that work, excepting only such (if any) as the local laws of the colony, &c., where it is first published might afford.

This opinion caused great and general dissatisfaction in the colonies and India; it either destroyed all copyright property in the numerous works since 1842, which had been first published there, or rendered such property comparatively worthless; and this hardship was increased by the fact that, since 1842, it had been, and still is, compulsory upon all publishers in the British dominions, gratuitously to send one copy of every book published by them to the British Museum, and on application four to the libraries of Oxford, Cambridge, &c.

This grievance is now removed by the International Copyright Act, 1886, which, by section 8, provides that the Copyright Acts (*a*) shall, subject to the provisions of the Act of 1886, apply to a literary or artistic work first produced in a *British possession* in like manner as they apply to a work first produced in the United Kingdom: provided (*a*) that the enactments respecting the registry of the copyright in such work shall not apply if the law of such possession provides for the registration of such copyright; and (*b*) that where such work is a book the delivery to any persons or body of persons of a copy of any such work shall not be required. If, therefore, in the particular colony there is no provision for registration, then the registration must be effected in this country.

It follows, therefore, that a book produced in the colonies obtains at once the same copyright throughout the British dominions that it would have enjoyed if first produced in the United Kingdom (*b*). But it has been held that the author of

(*a*) *i.e.*, The Engraving Copyright Acts, 1734 and 1766; The Copyright Act, 1775; The Prints Copyright Act, 1777; The Sculpture Copyright Act, 1814; The Dramatic Copyright Act, 1833; The Lectures Copyright Act, 1835; The Prints and Engravings Copyright Act, 1836; The Copyright Act, 1836; The Copyright Act, 1842; The Colonial Copyright Act, 1847; and the Fine Arts Copyright Act, 1862.

(*b*) Section 8 of the International Copyright Act, 1886, provides that nothing in the Copyright Acts, or that Act shall prevent the passing in a British possession of any Act or Ordinance respecting the copyright within the limits of such possession of works first produced in that possession. No local Act can, however, limit the imperial copyright conferred by the Act of 1842. It will be noticed that there is nothing to restrict the term of copyright to the term which the author enjoys according to the local laws of his colony.

CAP. II. a work of art published in the United Kingdom does not, under the 25 & 26 Vict. c. 68, obtain copyright in any part of the British dominions outside the United Kingdom, although it is provided by section 9 of the Act of 1886 "that this Act shall apply to every British possession as if it were part of the United Kingdom" (a). Apparently, therefore, a work of art produced in, say, Canada enjoys copyright in the United Kingdom, and in the countries of the Copyright Union, but not in Australia, India, and other British possessions.

Evidence of
Colonial
copyright.

It is further provided by section 8 of the Act of 1886 that where a register of copyright in books is kept under the authority of a Government of a British possession, an extract from that register purporting to be certified as a true copy by the officer keeping it, and authenticated by the public seal of the British possession, or by the official seal, or the signature of the governor of a British possession, or of a colonial secretary, or of some secretary or minister administering a department of the Government of a British possession, shall be admissible in evidence of the contents of the register.

It would appear from the terms of this provision that it would only apply to the registration of works other than books, if their registration were contained in a register of books.

Where, before the passing of the Act of 1886, an Act or Ordinance has been passed in any British possession respecting copyright in any literary or artistic works, an Order in Council may be made modifying the Copyright Acts and the Act of 1886, so far as they apply to such British possession and to literary and artistic works produced therein (b). It is also provided that fresh colonial legislation may be passed and hold good within the limits of the colony passing it (c).

Law previous
to the
International
Copyright
Act, 1886.

Previous to the International Copyright Act, 1886, and the Berne Convention, a foreign author registering in London a book first published in a federated country, and also delivering in London a copy in the prescribed manner, became entitled to sue in respect of any infringement taking place in the British possessions. It is clear that as all the provisions as to registration and deposit under the former Acts referred to the United Kingdom, no colonial registration or preliminary formalities in reference to the colonies were necessary.

Position of
colonies
under Berne
Convention.

It will be well briefly to consider the position of the colonies under the International Copyright Acts and the Berne Convention.

(a) *Graves & Co. v. Gorrie* (1903), A. C. 496.

(b) Sect. 8.

(c) *Ib.*

There are two sections of the Act of 1886 which deal with the question, the 9th and 10th. CAP. II.

The former provides that where it shall appear to the Crown expedient that an Order in Council under the International Copyright Acts made after the passing of this Act (a), as respects any foreign country shall not apply to any British possession, it shall be lawful for the Crown by the same or any other Order in Council to declare that such Order and the International Copyright Acts and the Act of 1886, shall not, and the same shall not apply to such British possession, except so far as is necessary for preventing any prejudice to any rights acquired previously to the date of such order; and the expressions in the said Acts relating to the dominions of the Crown shall be construed accordingly; but save as provided by such declaration the said Acts and the Act of 1886 shall apply to every British possession *as if it were part of the United Kingdom*.

The expression "British possession" is defined to mean and "include any part of Her Majesty's dominions exclusive of the United Kingdom"; and where parts of such dominions are under both a central and a local legislature, all parts under one central legislature are for the purposes of the definition to be deemed to be one British possession (b). "British possessions."

The 19th Article of the Berne Convention provides that the federated countries shall have the right to introduce into the Convention their colonies or foreign possessions. They may do this either by a general declaration comprehending all their colonies or possessions within the accession, or by specially naming those comprised therein, or by simply indicating those which are excluded. By the *procès verbal de signature*, France declared the accession of all the French colonies, and Great Britain, under this article declared that her accession to the Convention for the protection of literary and artistic works, was for the United Kingdom of Great Britain and Ireland and all the colonies and foreign possessions of Her Britannic Majesty (c). At the same time this country reserved the power of announcing at any time the separate denunciation of the Convention (d), by one or several of the foreign colonies or

(a) The Act of 1886.

(b) Sect. 11.

(c) Great Britain also ratified the Additional Act of Paris "on behalf of the United Kingdom, as well as of all the British colonies and possessions."

(d) If any colony were to require the mother country to denounce the Convention so far as that colony were concerned, the Crown would seem to have power under section 9 of the International Copyright Act, 1886, to deprive that colony of the benefits of section 8 of the same Act, under which colonial works acquire copyright in Great Britain; so far, however, the only colony that has shown any disposition to retire from the Union has been Canada.

CAP. II.

possessions in the manner provided by Article 20 of the Convention, namely:—India, the Dominion of Canada, Newfoundland, the Cape, Natal, New South Wales, Victoria, Queensland, Tasmania, South Australia, Western Australia, and New Zealand.

Rights of
foreigners in
British
colonies.

The rights of foreigners in the British colonies depend upon the International Copyright Acts, the Orders in Council made thereunder, and the Berne Convention with the Additional Act of Paris. The Order in Council of 28th November, 1887, provides that the author of a literary or artistic work produced in one of the foreign countries of the Copyright Union shall have as respects that work "throughout Her Majesty's dominions the same right of copyright . . . as if the work had been first produced in the United Kingdom, and shall have such right during the same period" (a). According to this provision a foreigner belonging to one of the countries of the Copyright Union obtains in the British colonies not the protection accorded by the local laws of the particular colony but the protection which an author would obtain in the colonies who published in the United Kingdom. He therefore obtains copyright under the Act of 1842 for books throughout the British possessions, but it is more doubtful whether he obtains copyright in a work of art. As we have seen, it has been held that a picture published in Great Britain does not obtain colonial copyright (b), but it is conceived that a foreign artist may perhaps be placed in a more favourable position than the British, by reason of the closing words of section 9 of the Act of 1886, which enact that "the said Acts and this Act shall apply to every British possession as if it were part of the United Kingdom." As an artist publishing in the United Kingdom would clearly have copyright in his picture there, it might possibly be contended that these words operate to extend the foreigner's rights, though, according to the decision above referred to, they do not so operate with regard to a British artist's rights.

Rights of
colonials in
countries of
Copyright
Union.

The rights of colonial subjects in the foreign countries of the Copyright Union do not depend upon the International Copyright Acts and the Orders in Council thereunder, so the peculiar wording of those provisions need not be considered. These rights depend simply upon the Berne Convention and the legislation conferring copyright in the particular foreign

(a) Clause 3. Clause 3 of the Order in Council of 30th April, 1894, putting the treaty with Austria into effect is similarly worded.

(b) *Graves & Co. v. Gorrie* (1903), A. C. 496.

country. A suggestion has been made (a) that the language of Article 19 implies the introduction of the colonies or foreign possessions as part of the mother country and not as distinct countries. It is, however, submitted that the preferable construction is that the various colonies for the purpose of obtaining copyright in foreign countries are to be treated as distinct countries, except that their adherence or denunciation is to be conveyed through the mother country.

The point, no doubt, is of importance, because, for the purpose of Article 2 of the Convention, it has to be determined what is the "country of origin" of a work—is it the mother country or is it the colony? The question is, when that article provides that the formalities necessary to obtain protection are those prescribed by the legislation of the "country of origin of the work," does it mean, in the case of a colony, the formalities required by the legislation of the colony or the mother country of which such colony is a dependency? For instance, if a work be first published in New Zealand, must it be registered at Stationers' Hall in order to obtain copyright under the Berne Convention. It is submitted that the colonial copyright that is protected in these foreign countries is the copyright conferred by section 8 of the Act of 1886, and, consequently, that if the colony provides for registration that will be sufficient; if not, then registration in England is necessary. Therefore, an author who publishes in a colony which has no copyright legislation will, it is conceived, on registering in England, acquire copyright both in Great Britain and in all the countries belonging to the Copyright Union.

(a) Cutler, Smith, and Weatherley on Musical and Dramatic Copyright.

CHAPTER III.

LOCAL COPYRIGHT LAWS OF BRITISH COLONIES AND POSSESSIONS.

AUSTRALASIA.

THE Australian Colonies have all legislation of their own respecting copyright: this legislation is, for the most part, a copy of the English law, but it is inclined to lag behind, and only follows the changes of the English law at a respectful distance of time. All appear to have established registries for copyright, except Tasmania.

NEW SOUTH WALES.

Act of 1879. The Copyright Act, 1879 (42 Vict. No. 20), was passed in 1879 to secure to proprietors of works of literature and fine art, and to proprietors of designs for articles and works of manufacture and art, the copyright of such works and designs for a limited period (*a*). The Act came into force on the 1st of July, 1879.

Definitions. "Book" is defined as in the (Imperial) Copyright Act, 1842, and "dramatic or musical production" as "dramatic piece" in the said Act.

"Engraving" includes every work made upon a plate, block, or slab of any material by engraving, lithography, or any other process, whereby impressions may be taken from such plate, block, or slab.

"Drawing and painting" include every drawing and painting made in any manner and material and by any process.

"Photograph" includes any photograph or other similar work which shall be produced by the action of light or any chemical process.

(*a*) It has been held in New South Wales that the proprietor in Great Britain of the sole right of representing a dramatic work can, under the 3 Will. IV. c. 15 and 5 & 6 Vict. c. 45, assign to another that right in the Australian Colonies, and the assignee can sue in his own name in those colonies to restrain the infringement of his right. *Holt v. Woods* (1896), 17 N. S. W. R. 36.

“ Work of sculpture ” includes any piece of sculpture whether in the round, in relief, or intaglio, made in any material, and by any process.

CAP. III.
NEW SOUTH
WALES.

Copyright means the sole and exclusive right and liberty of making, printing, writing, drawing, painting, photographing, or otherwise howsoever multiplying copies of any matter, thing, or subject to which the said word is herein applied, or to which any original design has been applied.

Proprietor includes the author of books, &c., unless executed on behalf of others for value in which case the latter are to be considered proprietors and entitled to be registered; and also includes assignees or partial assignees of copyright, and persons to whom copyright is bequeathed or on whom it devolves.

Part I. of the Act relates to literary, dramatic, and musical works, and is substantially identical with the Imperial Copyright Acts relating to the same subject-matter, *i.e.*, the Copyright Act, 1842, the Dramatic Copyright Act, 1833, and the Lectures Copyright Act, 1835. Ss. 3 to 17 correspond to ss. 3, 5, 6, 7, 10, 11, 13, 15, 16, 17, 18, 19, 22, 23, and 24 of the Copyright Act, 1842, with the following modifications:

Literary,
dramatic, and
musical copy-
right.

The Governor instead of the Privy Council is to license the republication of books on the complaint of the Attorney-General.

Copies of books are to be delivered to the Free Public Library and the University of Sydney; delivery to be made within two months after first sale, publication, or offering for sale in the colony. The penalty for default is a sum not exceeding £10.

A Book of Registry is to be kept at the Registry appointed by the Act.

Piracy in the colony only is restrained: in addition to a right of action against him, the offender is also to be liable to a penalty not exceeding £10 for each offence, to be recovered in a summary manner with full costs.

Importation into the colony is alone restrained.

Registration is a condition precedent of the right to sue in the case of dramatic pieces as well as books, but an exception is made in the case of lectures.

Sects. 18 and 19 are equivalent to ss. 20 and 21 of the Copyright Act, 1842, and ss. 1 and 2 of the Dramatic Copyright Act, 1833.

Sects. 20, 21, 22, 23, and 24 correspond to ss. 1, 2, 3, 4 and 5 of the Lectures Copyright Act, 1835.

The required notice is to be given twice in a newspaper circulating in the locality where a lecture is given.

CAP. III.
NEW SOUTH
WALES.
Fine arts
copyright.

Part II. relates to the Fine Arts, and with the important exception that a more limited term of duration is given; and that the Act also provides, as to sculptures and engravings throughout, is substantially identical with the Fine Arts Copyright Act, 1862.

Sects. 25 to 33 correspond to ss. 1, 2, 4 to 8, 10, and 11 of the last-named Act, with the following modifications:

Authors must be British subjects, or resident in the colony: fourteen years' protection only is given, which, in the case of photographs, is reduced to three.

Omission to register, it is expressly provided, shall only affect the right to sue. A register of the works to which this part of the Act applies is to be kept at the registry. Recovery of penalties follows the English procedure: jurisdiction is also given where the offender has his place of business.

Importation into the colony only is restrained.

Designs.

Part III. relates to designs, and incorporates 5 & 6 Vict. c. 100, 6 & 7 Vict. c. 67, and 21 & 22 Vict. c. 70.

Sect. 34 is a combination of s. 3 of the 5 & 6 Vict. c. 100, s. 3, and 6 & 7 Vict. c. 67, s. 2.

The designs protected are any new and original designs of any artistic or work of manufacture or art, and whether such article or work be for purposes of utility, ornament, or otherwise, and whether such design be applicable to the ornamentation only of any article or work of manufacture or art, or to the pattern, shape, configuration, or ornamentation of any substance, artificial or natural, or partly artificial and partly natural, and whether such design be applicable to two or more of such purposes, . . . following onwards s. 3 of 5 & 6 Vict. c. 100.

Protection is given in the first five classes for three years, in the remaining nine for two years; the classes agree with those in the English Act, except that class 2 includes articles of stone, cement or plaster; ivory, bone, and papier mâché, and other solid substances not in the previous classes (see 13 & 14 Vict. c. 104, s. 8), are put in a separate class, No. 5.

Class 7 corresponding to class 6 of the English Acts includes tapestry, floor-cloth, and oil-cloth (see 6 & 7 Vict. c. 65, s. 5).

Sect. 35 corresponds to s. 4 of the 5 & 6 Vict. c. 100 and 21 & 22 Vict. c. 70, s. 4.

Sect. 36 corresponds to s. 15 of the 5 & 6 Vict. c. 100 and 21 & 22 Vict. c. 70, s. 5, providing that there must be furnished on registration a model or pattern as well as two copies, &c.

of the design. The model or pattern may be dispensed with by the Attorney-General. CAP. III.

NEW SOUTH
WALES.

Sects. 37 to 44 correspond with ss. 16, 6, 17, 7, 8, 9, 10, and 11 of the 5 & 6 Vict. c. 100.

The penalty for piracy is not to exceed £50, and if sued for summarily not more than £20. Jurisdiction is also given where the offender has his place of business.

Part IV. of the Act contains miscellaneous provisions:

Sect. 45 corresponds to 5 & 6 Vict. c. 100, s. 19.

Sect. 46 corresponds to 5 & 6 Vict. c. 45, s. 12.

Sect. 47 corresponds to 25 & 26 Vict. c. 68, s. 3.

Sect. 48 corresponds to the last part of 5 & 6 Vict. c. 45, s. 26, relating to the limitation of actions.

Sect. 49 corresponds to 25 & 26 Vict. c. 68, s. 9. It provides that actions for infringement must be brought in the Supreme Court and that injunctions may be granted.

Sect. 50 provides that the registrar may amend entries at the request of the proprietor, and contains a provision similar to that contained in 5 & 6 Vict. c. 45, s. 14.

Sect. 51 corresponds to s. 9 of the 6 & 7 Vict. c. 68.

Sects. 52, 53, and 54 relate to the appointment of registrars, &c., the seal of the registry office, and fees respectively.

Sect. 55 provides that nothing in the Act contained shall be deemed to affect the law of copyright as applicable to the colony by any imperial statute then in force, and also that persons in the colony may copy paintings, &c., in public museums.

In 1899 the Book Purchasers' Protection Act, 1899 (69 Vict. No. 25), was passed repealing an earlier of 1890. It provides that every contract for the purchase of books, engravings, lithographs, pictures, or other like matter shall be void, where the books or any volumes or numbers thereof are not to be delivered to the purchaser at the date of the contract in a completed form, unless the purchaser has signed an agreement in a special form containing words limiting the liability of the purchaser. Book Act of
1897.

The vendor is at the time of signing the agreement to give a duplicate thereof to the purchaser, and cannot recover unless he produces an acknowledgment by the purchaser of receiving such duplicate.

The court may determine the value of any printed matter in actions on contracts, proof to be on the vendor.

New South Wales is not a party to the British Copyright Treaty with Austria.

CAP. III.

NEW
ZEALAND.

NEW ZEALAND.

Copyright in
books.

An Act passed in 1842 (5 Vict. No. 18) regulates copyright in books. It provides that the author of any printed and published book shall have the sole right of printing and reprinting it for twenty-eight years from first publication, and if the author is living at the end of that period for the residue of his life (*a*).

Penalty.

Persons printing or importing protected books or knowingly selling the same or having them in their possession, shall be liable to an action in which double costs shall be allowed, and if verdict is given against him, the offender shall forfeit £50 to the Government (*b*).

In 1877, the "Fine Arts Copyright Act, 1877" (41 Vict. No. 17), was passed.

The Act provides for copyright in any original painting, drawing, engraving, useful or ornamental design, sculpture, photograph, and the negative in any photograph: and is with the exception of the introduction of designs, substantially identical with the Fine Arts Copyright Act, 1862.

A register is to be kept at Wellington: in the case of a photograph, a positive photograph upon paper is to be furnished to the registrar.

Any officer omitting or falsely making an entry is to be guilty of misdemeanor.

The penalties for signing or affixing a name, initials, or monogram shall only be incurred if the person whose name, &c., was signed or affixed was living at or within seven years next of the time of offence.

Pecuniary penalties, &c., may be recovered by summary proceeding before a resident magistrate or two justices of the peace, having jurisdiction where the offence was committed or the complainant resides.

Photographs.

The Photographic Copyright Act, 1896 (No. 16), provides that photographs other than portraits or photographs of any subject for taking which valuable consideration has been given, are to be protected in favour of the person or firm taking and producing the same for a period of five years, if the word "protected" with the name of the taker and date of taking are made part of the original plate and clearly appear in each reproduction thereof.

Industrial designs are protected by the "Patents, Designs,

(*a*) See 54 Geo. III. c. 156.

(*b*) Barton's Practical Statutes of New Zealand, vol. ii. p. 1218.

and Trade Marks Act, 1889" (No. 12), as amended by the Amendment Act of 1897 (No. 8), which is substantially identical with the Imperial Patents, Designs, and Trade Marks Act, 1883, as amended.

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NEW
ZEALAND.

QUEENSLAND.

The Colonial Act affecting copyright in books and dramatic pieces is "The Copyright Registration Act (Queensland), 1887" (51 Vict. No. 2), the effect of which is shortly given.

Copyright
Registration
Act, 1887.

After a preamble referring to the International Copyright Act, 1886 (49 & 50 Vict. c. 33), and stating that it was advisable to make provision for the registration of copyright in literary and artistic works in Queensland, and for keeping a register of copyright, it enacts (s. 2) that the Imperial Copyright Acts may be cited as citable in the Short Titles Act, 1892.

The terms "book" and "dramatic piece" are respectively defined as in the Copyright Act, 1842.

Sect. 3 provides that there is to be kept at Brisbane a register of copyright in books and dramatic pieces published in Queensland, in which shall be recorded the title of the work, the name of the publisher and the place of publication, the name and place of abode of the proprietor of the copyright, and the date of the first publication or first performance in Queensland.

Register.

By section 4, the proprietor of copyright in any such work published in Queensland may cause the same to be registered.

He is to deliver a statement giving the particulars previously required, and pay the sum of 5s.

In the case of MS. dramatic or musical compositions it is sufficient to register the title, the name and place of abode of the author or composer, the name and place of abode of the proprietor, and the time and place of first performance.

Under section 5 any registered proprietor may assign his interest by delivering to the registrar a memorandum of such assignment, and of the name and place of abode of the assignee, attested by a justice. Fee 5s.

Assignment
of copyright.

Such assignment shall be registered, and shall then be effectual in law to all intents and purposes whatsoever without being subject to stamp duty.

By section 6 persons aggrieved by an entry in the register may apply to the Supreme Court, who may order the entry to be varied or expunged.

Sect. 7 enacts that copies of books and of all subsequent

Deposit of

CAP. III. editions are to be delivered within six months of the day of first sale, publication, or offering for sale, and before the copyright is registered, by the publisher at the Museum and the Parliamentary Library in Brisbane.

copies of books.

Sect. 8 provides as to the mode of delivery.

Penalty for non-delivery.

Sect. 9 enacts that if delivery is not made, the person who would have been entitled to copyright shall not be entitled to any benefit of copyright.

The register is to be open for inspection on payment of 1s. for every entry inspected: certified extracts are to be given when required on payment of 5s., and shall be received in evidence and shall be *prima facie* evidence of the proprietorship assignment right of representation or performance.

Making a false entry in the register is a misdemeanor punishable with imprisonment up to three years with or without hard labour.

Fine Arts Registration Act.

The Copyright (Fine Arts) Registration Act, 1892 (56 Vict. No. 6), provides for the registration of paintings, drawings, and photographs, and for the assignment of the copyright in such works, and for the registration of such assignment.

By section 6 persons aggrieved by an entry may apply to the Supreme Court, who may order the entry to be varied or expunged.

Making a false entry is punishable with imprisonment up to three years with or without hard labour.

Under the Copyright Registration Act, 1898 (62 Vict. No. 13), the duties of the Registrar-General under the Copyrights Acts were transferred to the Registrar of Patents, Designs, and Trade Marks.

Designs.

Designs are protected by the "Patents, Designs, and Trade Marks, 1884" (48 Vict. No. 13). This Act is in substance identified with the Imperial Patents, Designs, and Trade Marks Act, 1883.

This Act, so far as it relates to designs, has been amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1890, which incorporates the amendments made by the Imperial Act of 1888 (51 & 52 Vict. c. 50), and also provides for protection of designs exhibited at exhibitions outside the colony of Queensland.

SOUTH AUSTRALIA.

Copyright Act, 1878.

The Copyright Act, 1878 (41 & 42 Vict. No. 95), was passed in 1878 to protect copyright in designs and works of manufac-

ture and art, in works of literature and fine arts for a limited period. It was assented to on the 22nd October, 1878.

The Act is not to affect the law of copyright as applicable to the colony by any imperial statute then in force.

The Act is substantially identical with the Copyright Act of New South Wales with some slight variations and omissions.

The part relating to designs omits the lists of classes and the clause as to cancellation and amendment of registration.

Copies of books are to be sent to the South Australian Institute: the penalty is a sum not exceeding £5.

Proceedings before justices are to be conducted under Ordinance No. 6 of 1850.

In case of non-payment of penalties, &c., the person making default may be committed to prison for three months by any justice of the peace.

An appeal lies from any order of justices of the peace to the Local Court of Adelaide of full jurisdiction only: the proceedings are regulated by Ordinance No. 6 of 1850. The Local Court may on the hearing of an appeal state a case for the opinion of the Supreme Court.

Newspaper telegrams are protected under the Telegram Copyright Act, 1872.

TASMANIA.

The only Colonial Act passed in Tasmania on the subject of copyright seems to be "The Newspaper Copyright Act, 1891," which defines newspapers, and provides that persons republishing in a newspaper any portion of a message received by electric telegraph from any place within forty-eight hours of the first publication thereof in the newspaper in which it first appeared without consent, and not having previous copyright in such matters shall for every offence upon conviction on the information to be laid before two justices of the proprietor of the newspaper in which the matter first appeared, forfeit a sum from £20 to £100. Half the penalty goes to the informant.

Designs are protected under the Patents, Designs, and Trade Marks Act, 1893 (57 Vict. No. 6), which is substantially in accordance with the Imperial Acts.

VICTORIA.

Previously to 1890 copyright in Victoria was governed by the Copyright Act, 1869, and the Exhibitors' Protection Act, 1872; this legislation was repealed and substantially

CAP. III.
VICTORIA.
Copyright Act, 1890.

re-enacted by the Copyright Act, 1890, which came into operation on the 1st of August, 1890. It is divided into four parts, and protects designs, literary, dramatic and musical productions, lectures and fine arts.

The Act is substantially identical with the Copyright Act of New South Wales *mutatis mutandis*. Copies of books are to be delivered to the Melbourne Library.

Sect. 56 provides that county courts are to have jurisdiction in cases relating to copyright and the provisions of the County Court Act, 1890, are to apply.

Sect. 58 provides that proprietors of articles protected as designs and fine arts which may be publicly exhibited at any exhibition authorized by the Governor under the Exhibitions Act, 1890, shall during the exhibition be entitled to the benefits of this Act as if such proprietor had complied with the provisions of the Act, and such exhibition shall not be deemed a publication.

WEST AUSTRALIA.

Designs.

Copyright in designs is protected by the "Designs and Trade Marks Act, 1884" (48 Vict. No. 7) (as amended in 1894, 58 Vict. No. 4), which came into operation on the 1st January, 1885.

The Act is, so far as it relates to designs, substantially identical with the Patents, Designs, and Trade Marks Act, 1883 and 1888 (Imperial). The Colonial Secretary is substituted for the Comptroller, and the appeal from him is to the Governor.

The register is to be kept at the Colonial Secretary's office.

By the Act 50 Vict. No. 4, being an Act to alter the law relating to the procedure under the Act of 1884, and an Act regulating patents, it was enacted that a Patent Office should be provided under the control of a registrar, and the powers, duties, &c., of the Colonial Secretary were transferred to the Registrar and the Patent Office was substituted for the Colonial Secretary's office.

Copyright Register Act, 1887.

By the Copyright Register Act, 1887 (51 Vict. No. 3), a copyright register was established, wherein are to be registered the proprietorship in the copyright of books and assignments thereof, and in dramatic and musical pieces whether in MS. or otherwise, and licences affecting such copyright.

The register is to be kept by the Registrar-General at his office, is to be open for inspection on payment of a fee of 1s., the Registrar is to give certified copies of entries on payment

of 5s.: such copies are to be received in evidence, and shall be *prima facie* proof of proprietorship, subject to rebuttal, and in case of dramatic or musical pieces, *prima facie* proof of the right of representation or performance.

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WEST
AUSTRALIA.

Making a false entry or tendering in evidence a false copy is a misdemeanor.

There are also provisions corresponding to ss. 13 and 14 of the (Imperial) Copyright Act, 1842. Forms are given in the schedule.

Copyright in literary and artistic works is regulated by the Copyright Act, 1895 (59 Vict. No. 24). It is very similar, *mutatis mutandis*, to the Copyright Act of New South Wales. Copies of books are to be sent to the Victoria Public Library; the penalty in default is a sum not exceeding £5.

Copyright in newspaper telegrams is protected under the Telegraph Copyright Act, 1872.

BRITISH AMERICA.

CANADA.

Unusual interest attaches to the question of copyright in Canada. Canada, and this interest seems likely to increase rather than diminish. Her proximity to the United States and the extent of her frontier have peculiarly exposed her to the importation of unauthorised reprints, and the enterprise of United States publishing firms has threatened to strangle the native book-producing industry. For over half a century the copyright laws have been a constant source of friction between Canada and the Mother Country, and the trouble does not appear even yet to have been finally removed.

In 1875, the Dominion Parliament passed an Act (*a*) giving copyright for twenty-eight years from the time of recording the copyright as therein directed to any person domiciled in Canada, or in any part of the British dominions, or being the citizen of any country having an international copyright treaty with the United Kingdom (*b*), who is the author of any book, map, chart, or musical composition, or of any original

The Canadian
Acts of 1875
and 1886.

(*a*) Now replaced and substantially re-enacted by the revised Statutes of Canada, 1886, c. 62, to be cited as "The Copyright Act."

(*b*) These words cover the case of any country which is a party to the Berne Convention. They also cover Austria, which has a copyright treaty with Great Britain, though Canada is not included in that treaty, but Canada contends that the words do not cover the United States, see *infra*. The Act of 1889 proposed to limit the words by adding "in which Canada is included."

CAP. III.
CANADA.

painting, drawing, statue, sculpture, or photograph, or who invents, designs, etches, engraves or causes to be engraved, etched, or made from his own design any print or engraving, and the legal representatives of such person the sole right and liberty of printing, reprinting, publishing, reproducing and vending such literary, scientific, or artistic works or compositions, in whole or in part, and of allowing translations to be printed or reprinted and sold of such literary works from one language into other languages (*a*).

Term of copy-
right and in
whom vested.

If at the expiration of the term of twenty-eight years, the author or any of the authors (when the work has been originally composed and made by more than one person) be still living, or being dead have left a widow or a child or children living, the same exclusive right is continued to such author, or if dead, then to such widow and child or children, as the case may be, for the further term of fourteen years, provided that within one year after the expiration of the first term the title of the work be again recorded, and all other regulations required to be observed in regard to original copyrights are complied with in respect to such renewed copyright (*b*).

Conditions
on which
copyright
depends.

In order to entitle an author to the benefit of copyright under this Act, the following conditions must be complied with :

1. Such literary, scientific, or artistic works must be printed and published or reprinted or republished in Canada, or in the case of works of art, must be produced or reproduced in Canada, whether so published or produced for the first time or contemporaneously with or subsequently to the publication or production elsewhere (*c*).

2. In the case of a book, map, chart, musical composition, photograph, print, cut, or engraving, two copies must be deposited at the office of the Minister of Agriculture ; and so in the case of paintings, drawings, statuary and sculpture, unless a written description of such works is furnished to the Minister of Agriculture (*d*).

3. Information must be given of the copyright being secured, by causing to be inserted in the several copies of every edition on the title-page, or on the page immediately following, if it is a book, or if it is a map, chart, musical composition, print, cut, engraving, or photograph, by causing to be impressed on the face thereof, or if a volume of maps, charts, music, engravings

(*a*) Sect. 4, Act of 1875 ; sect. 4, Act of 1886.

(*b*) Sect. 5, Act of 1875 ; sect. 17, Act of 1886.

(*c*) Sect. 4 (2), Act of 1875 ; sect. 5 (1), Act of 1886. The section places no limit on the time within which republication must be effected.

(*d*) Sect. 7, Act of 1875 ; sect. 9, Act of 1886.

or photographs upon the title-page or frontispiece thereof, the following words, "Entered according to Act of Parliament of Canada in the year _____, by A. B., at the Department of Agriculture" (*a*). As regards paintings, drawings, statuary, and sculptures, the signature of the artist is deemed sufficient notice of the proprietorship (*b*).

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4. Whenever the author of a literary, scientific, or artistic work or composition which may be the subject of copyright has executed the same for another person, or has sold the same to another person for due consideration, such author will not be entitled to obtain or retain the proprietorship of such copyright, which is by the said transaction virtually transferred to the purchaser, who may avail himself of such privilege unless a reserve of the said privilege be specially made by the author or artist in a deed duly executed (*c*).

Pending the publication or republication in Canada of a literary, scientific, or artistic work, the author may secure interim copyright (*i.e.*, for one month from the date of the original publication elsewhere) by depositing a copy of the title or a designation of the work intended for publication or republication in Canada. The author must publish the registration of this interim copyright in the 'Canada Gazette' (*d*). When interim copyright is secured the work must be published in Canada within one month of its original publication elsewhere under a maximum penalty of 100 dollars (*e*).

Interim
copyright.

Offenders forfeit the plate and every sheet copied, and are liable to a penalty varying from ten cents to a dollar for every sheet—half to the proprietor and half to the Crown.

Piracy.

The right is assignable either as to the whole or in part by an instrument in writing made in duplicate and recorded in the Office of the Minister of Agriculture (*f*).

Assignment.

Section 15 (*g*) of the Act provides that "works of which the copyright has been granted and is subsisting in the United Kingdom, and copyright of which is not secured or subsisting in Canada under any Canadian or Provincial Act, shall upon being printed and published, or reprinted and republished in Canada, be entitled to copyright under this Act; but nothing in this Act shall be held to prohibit the importation from the

Importation.

(*a*) It is sufficient if the statutory form is substantially followed. *Garland v. Gemmill* (1887), 14 Canadian R. 321.

(*b*) Sect. 9, Act of 1875; sect. 12, Act. of 1886.

(*c*) Sect. 16, in both Acts.

(*d*) Sect. 10, Act of 1875; sect. 13, Act of 1886.

(*e*) Sect. 17, Act of 1875; sect. 33, Act of 1886.

(*f*) Sect. 18, Act of 1875; sect. 15, Act of 1886.

(*g*) Sect. 6, Act of 1886.

CAP. III. United Kingdom of copies of such works legally printed
CANADA. there."

If, on the other hand, a work be copyrighted in Canada, then such importation into Canada is forbidden (*a*); and by section 4 of the Imperial Act (38 & 39 Vict. c. 53), which authorized the Crown to assent to the Canadian Act of 1875, it was provided that when any book in which there is imperial copyright becomes entitled to copyright in Canada "it shall be unlawful for any person, not being the owner in the United Kingdom, of the copyright in such book, or some person authorized by him, to import into the United Kingdom any copies of such book reprinted or republished in Canada."

It must be remembered that the Imperial Copyright Act of 1842 confers upon any person first publishing in the United Kingdom, copyright not only in the United Kingdom, but in the colonies and the dominions of the Crown. It seems to have been considered in Canada that the Act of 1875 virtually repealed the Act of 1842 so far as it concerned that colony, and that, consequently, Canadian publishers were free to republish English copyright books in Canada without any consideration whatever, but this idea was dissipated by the decision in *Smiles v. Belford* (*b*). This Imperial Act is, therefore, in force in Canada, and by section 17 of that Act it is forbidden to import into Canada or any other part of the British dominions a work copyrighted in the United Kingdom (*c*). Canada, however, having taken advantage of the Foreign Reprints Act, this prohibition was suspended, and importation of foreign reprints was permissible, subject to an *ad valorem* duty of 12½ per cent. (*d*).

The position of a British author under the Act of 1875 with respect to his copyright books, therefore, was that if he copyrighted his books in Canada he was protected against piracy and importation into Canada, but he could not import himself. If he did not take out a copyright in Canada, he could, under imperial law, prevent the reprinting of his books in Canada, but he could not prevent importation from another country by reason of the suspension of the prohibition contained in section 17 of the Imperial Act of 1842 by the Order in Council of 1868 under the Foreign Reprints Act, 1847.

(*a*) See Copyright Act, 1875, sects. 11 and 13; Copyright Act, 1886, sects. 30 and 32; Customs Act, 1886 (Canada, 49 Vict. c. 4), Schedule D.

(*b*) (1877), 1 Ont. A. R. 436; *Morung & Co. v. Publishers' Syndicate* (1900), 32 O. R. 393.

(*c*) It has been held that the Customs Consolidation Act of 1876 is not in force in Canada; *Black v. Imperial Book Co.* (1903), 5 Ontario L. R. 184.

(*d*) See *ante*, p. 496.

On the other hand, the Fine Arts Copyright Act, 1862, confers no imperial copyright, and a British artist can only obtain copyright in his pictures under the Canadian Acts (a). CAP. III.
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The state of the law as to copyright gave great dissatisfaction to Canadian printers and publishers. They complained that they were damaged, on the one hand, by authors belonging to the United States publishing in Great Britain and thus securing copyright in Canada, and, on the other hand, by British authors making arrangements with United States publishers whereby the latter secured the Canadian, as well as the United States, market, the consequence being Canada was flooded with cheap American reprints which Canada had no power to exclude, to the great detriment of their trade. The Berne Convention only added to these grievances; as it enlarged the class of persons who could obtain copyright in Canada without republishing there. Complaints of
Canadian
publishers.

In 1889 the Dominion Parliament, in order to remedy these grievances, passed an Act to amend the Copyright Act, 1875. This amending Act provided that any person domiciled in Canada, or in any part of the British possessions, or any citizen of any country having an international copyright treaty with the United Kingdom, *in which Canada was included*, should be entitled to copyright in Canada, but only on condition that the work were printed and published or produced in Canada or reprinted and republished or reproduced in Canada *within one month after publication or production elsewhere*. If the author failed to take advantage of these provisions, any person domiciled in Canada might obtain a licence from the Minister of Agriculture to print, publish, or produce the author's work, paying to the latter a royalty of 10 per cent. on the retail price. If such a licence were granted importation from foreign countries of the licensed work was to be prohibited. At the same time as this Act was passed Canada expressed her desire to retire from the Copyright Union. Canadian Act
of 1889.

The passing of this Act—conceived in the interests rather of Canadian printers and publishers than of either authors or the reading public—led to a long and bitter controversy between Canada and the Mother Country, which was not terminated till the year 1900. It does not fall within the province of this work to enter into the merits of this controversy (b), but the

(a) *Graves v. Gorrie* (1903), A.C. 496.

(b) The arguments on either side will be found fully stated in a Blue Book presented to the House of Commons on 27th June, 1895. It may seem surprising that a Copyright Act should have aroused so much feeling in Canada, considering the British public takes so little interest in copyright matters. The explanation is that there

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CANADA.

home government resolutely refused to give its necessary assent to the Act, and the Act never became effective law. When in the year 1891, after the passing of the United States Act, known as the Chace Act, British authors were enabled to obtain copyright in the United States on condition that they printed and published there, the discontent of the Canadian publishers was greatly increased. Canada has always refused to recognise the arrangement between Great Britain and the United States as an "international copyright treaty" (a), and does not permit United States authors to obtain Canadian copyright under her Copyright Act of 1886 (b). Finally, in the year 1885, directions were issued by the Customs authorities in Canada to cease to collect the duties required by the Foreign Reprints Act, 1847 (c).

The Act of
1900.

At length, in the year 1900, a compromise was effected and the assent of the Crown was given to a Dominion Act amending the Copyright Act, 1886 (d). By section 1 of this amending Act it is provided that if a book "as to which there is subsisting copyright under the Copyright Act" has been first lawfully published in any part of the British dominions other than Canada, and if it is proved to the satisfaction of the Minister of Agriculture that the owner of the copyright so subsisting and of the copyright acquired by such publication has lawfully granted a licence to reproduce in Canada, from movable or other types, or from stereotype plates, or from electroplates or from lithograph stones, or by any process for fac-simile reproduction, an edition or editions of such book designed for sale only in Canada, the Minister may, notwithstanding anything in the Copyright Act, by order under his hand, prohibit the importation, except with the written consent of the licensee, into Canada of any copies of such books printed elsewhere. Two copies may, however, be specially imported for the *boni fide* use of any public free library or any university or college library, or for the library of any duly incorporated institution or

was involved in the controversy the constitutional question of the right of Canada to legislate for her own affairs. The Canadian public were more interested in the constitutional principle than in the fate of this particular Bill.

(a) See section 4 of Canadian Copyright Act, 1886.

(b) Technically this contention would seem to be correct. Of course United States citizens can obtain imperial copyright by publishing simultaneously in Great Britain and the United States, but no doubt it would be more convenient for American publishers to arrange for this in Canada.

(c) This step was not necessarily illegal, but the effect was that the Foreign Reprints Act ceased to have any force in Canada, and foreign reprints became prohibited from importation by section 17 of the Imperial Copyright Act of 1842. See *Morang & Co. v. Publishers' Syndicate* (1900), 32 O. R. 393; *Black v. Imperial Book Co.* (1903), 5 Ontario L. R. 184.

(d) 63 & 64 Vict. c. 25 (Canadian). The Act is set out in full in the Appendix.

society for the use of such institution or society for the use of the members of such institution or society.

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CANADA.

By section 2, the prohibition against importation may be revoked if (a) the licence to reproduce in Canada has terminated or expired; or (b) the reasonable demand for the book in Canada is not sufficiently met without importation; or (c) the book is not, having regard to the demand therefore in Canada, being suitably printed or published; or (d) any other state of things exists on account of which it is not in the public interest to further prohibit importation.

This Act applies to books only, and further, only to books that are copyright in Canada, for the "Copyright Act" mentioned in section 1 means the Canadian Copyright Act of 1886. The objectionable feature of the 1889 Act, whereby an author practically would have lost his copyright in Canada, unless he acquired local copyright also, is removed. The Act does not touch imperial copyright, and whether a British author takes advantage of the Act or not rests entirely with himself. If he desire to do so, he must make arrangement with a local publisher, and a special Canadian edition must be printed in Canada, though the type need not be set there. Thereupon the Canadian publisher will acquire local copyright for the Canadian edition and the author or anybody else will be prohibited from importing copies of the work into Canada, but otherwise the author's imperial copyright will not be affected. If, on the other hand, the author does not desire to take advantage of the Act of 1900, that Act has no effect upon his rights whatsoever.

Effect of the Act of 1900.

The Act has, it is believed, worked satisfactorily in practice, but unfortunately a section of the Canadian printing and publishing houses do not appear to be yet satisfied, and there are indications of another agitation in favour of the more stringent provisions of the Act of 1889.

Canada is not a party to the British Copyright Treaty with Austria.

NEWFOUNDLAND.

In the year 1888, the Newfoundland Parliament passed a Copyright Act which was disallowed by the Imperial Government, and the Act which now governs copyright in that colony is the Copyright Act, 1890 (a).

This Act is practically a textual reproduction of the Canadian Act of 1886 (b), with the important modification that it is

(a) Consolidated Statutes of 1892, chapter 110.

(b) See *ante* p. 515. The Canadian Act will be found in full in the Appendix.

CAP. III. purely local in character and does not confer any copyright
 NEWFOUND- except upon persons domiciled in Newfoundland (a). The
 LAND. register is kept by the Colonial Secretary and literary produc-
 tions must be marked with the words "Entered according to
 the Act of Legislature of Newfoundland, in the year , by
 , at the Colonial Secretary's office."

A 20 per cent. *ad valorem* duty is payable on importation
 of foreign reprints of British copyright books (b).

SOUTH AFRICA.

CAPE COLONY.

Copyright
 Act, 1873.

The Copyright Act of 1873 (1873, No. 2) confers copy-
 right in books published in the author's lifetime for his life
 and five years after his death, with a minimum period of
 thirty years (section 1). Posthumous works are protected for
 thirty years from publication (section 2).

A book is defined by section 9 as meaning "every volume,
 part or division of a volume, pamphlet, sheet of letter-press,
 sheet of music, map, chart, or plan separately published," and
 copyright means "the exclusive liberty of printing or otherwise
 multiplying copies of any book" (c).

Registration.

Under the Act of 1883, a book of registry is to be kept
 in which proprietors of copyright may register their copyright
 and assign the same by making entries in the registry book.
 Fee 5s. in each case (sections 3 and 4). Objections to entries
 are to be decided by the Supreme Court (section 5).

Registry Act,
 1888.

By the Books Registry Act, 1888 (1888, No. 4), four copies
 of every edition published in the colony must be delivered free
 of charge to an officer appointed by the Governor within one
 month after delivery from the press (section 2); one of such
 copies to be given to the South African Public Library, another
 to the Grahamstown Public Library, and the other two to be
 disposed of as the Governor directs (section 4). On receiving
 the copies the officer is to send a memorandum to the Register
 of Deeds, who enters the same in the registry book as required
 by the Act of 1873, and thereupon the provisions of that Act
 apply (section 5). Registered entries are published quarterly
 in the Gazette (section 6). Books printed outside the colony

(a) The modification is all the more important having regard to the decision in
Graves v. Gorrie (1903), A. C. 496.

(b) Consolidated Statutes of 1892, chap. 111.

(c) These definitions are the same as those in the Imperial Copyright Act, 1842.

but published in the colony are deemed to be printed within the colony.

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CAPE
COLONY.

Printers and publishers contravening the Act are liable to penalties not exceeding £5. In the Act of 1888 "book" has the same meaning as in the Act of 1873, but does not include publications such as price lists, circulars, advertisements, pamphlets, music, maps, or plans not for sale, but intended for private circulation and of which not more than fifty copies are printed, and the Governor has power to make rules (to be published in the Gazette) to exclude any books or class of books from the operation of the Act (sections 11 and 12).

The proprietor of the copyright may, under the Act of 1873, have an action for damages for infringement (section 6), and under the Copyright Protection Act, 1895, the importation of reprints of books registered under the Act of 1873 is prohibited, provided notice be given to the Collector of Customs. Offenders are liable to a penalty and double the value of the pirated copy. The provisions of the Act of 1895 are to be without prejudice to the proprietor's right to damages.

Remedies for
infringement.

There seems to be no law in this colony protecting dramatic or artistic works, but designs are protected under the Registration of Designs Act, 1894, under which the proprietor has copyright in his design for five years from registration. If a registered design be used in manufacture elsewhere than in the colony, and be not used in the colony within six months of registration, the copyright ceases. Offences against the Act involve penalties not exceeding £100 in respect of any one design, or, as an alternative, the proprietor may bring an action for damages.

Designs.

Telegraphic messages are protected for 120 hours from the time of publication, or 130 hours from receipt, whichever shall be the shorter period, under the Telegraphic Messages Copyright Act, 1880.

Telegraphic
messages.

Cape Colony is not a party to the British Copyright Treaty with Austria.

TRANSVAAL AND ORANGE RIVER COLONY.

These countries having become incorporated in the British Empire, they have thereby become members of the Copyright Union, by reason of the declaration made by Great Britain on signifying her adhesion to the Berne Convention that "the adhesion of Great Britain to the said Convention includes the

CAP. III. United Kingdom of Great Britain and Ireland and all the
 TRANSVAAL. colonies and foreign possessions of Her Britannic Majesty" (a).

There is no copyright law in the Orange River Colony, but a law was on the 23rd May, 1887, promulgated in the Transvaal—then the South African Republic—dealing with this subject. Its provisions were as follows (b):

I.—*In what Copyright consists.*

Definition.

Art. 1. The author and his representatives have exclusively the right of publishing in print, writings, drawings, charts, musical or theatrical works, and oral addresses, as well as the right of publicly performing or representing dramatic-musical and dramatic works.

All performances or representations to which admission is obtained, for one or several occasions, by payment in money or *la prestation d'une valeur*, even when a person cannot be present without election, are equivalent to public performances or representations.

Art. 2. The following have the same rights as authors:

(a) Publishers, in works mentioned in Art. 1, when they are composed of works contributed by various collaborators.

(b) Charitable foundations and other legal bodies, associations and societies, in works published under their directions.

(c) Translators in their translation.

Moreover when a work is composed of parts contributed by different collaborators, each one of them, in the absence of agreement to the contrary, has copyright in his own work.

Anonymous works.

Art. 3. In the case of anonymous or pseudonymous works published in print, the publisher is treated as the author, or if the publisher's name does not appear on the title-page, or if none, on the cover, the printer, until some third person makes himself known as the person entitled in the manner prescribed in Arts. 10 and 11, except the time fixed for the deposit in Art. 10.

Laws.

Art. 4. Except in cases determined by the government on the advice of the executive council, there is no copyright in laws, ordinances, decrees, and other documents, which the

(a) See letter of 6th May, 1903, from the British Government to the International Bureau at Berne.

(b) Translation taken from the French translation of M. Ernest Chavegrin given in *Lois françaises et étrangères*, par M. Lyon-Caen. Reference should be made to the Dutch Law of the 28th June, 1881, from which this is taken almost word for word,

public authorities publish to the world in writing or in print. CAP. III.

Art 5. The author has the exclusive right of publishing printed translations: TRANSVAAL.
Translations.

(a) Of his works not published in print, including oral addresses.

(b) Of his works published in print, on condition that on the title-page, or if none, on the cover of the copies of his first edition, he expressly reserves the right in question for one or more specified languages, and also that he publishes his printed translation within three years from his first edition.

In the case of works appearing in separate volumes or parts, the period is calculated separately for each part or volume.

Art. 6. When the same work is published simultaneously in several languages, one of the editions is considered the original, and the others as translations. Simultaneous
publication.

The author is entitled to designate on the title-page or cover, the edition which he intends to treat as the original.

In the absence of indication, the edition published in the mother-tongue of the author is considered the original.

Art. 7. Copyright in works published in print does not prevent other persons making extracts from them and inserting them in other works, with the object of criticising or discussing them. Extracts.

It is permissible to reproduce, with a mention of the source, reports or articles published in daily, weekly, or monthly papers, unless copyright has been expressly reserved at the head of the articles or reports in question, and the formalities prescribed by Art. 10 have been observed.

Art. 8. Copyright in oral addresses does not prevent reports of debates taking place in any public assembly. Oral
addresses.

Art. 9. Copyright is considered personal property, can be assigned in whole or in part, and is transmissible to heirs. It cannot be taken in execution. Assignment.

II.—The conditions to which the recognition of Copyright in works published in print is subject.

Art. 10. The author or his representatives, the publisher or printer of every work published in print, must, under penalty of forfeiture, in the two months following publication, and besides, in the case of translations, in the period fixed by Art. 5, deposit at the office of the *Registrar* three copies, each having Registration.

CAP. III.
 TRANSVAAL. on the title-page or cover the signature of the depositor written by himself, with his address and date of publication.

The deposit must be accompanied by a sworn declaration of the printer, attesting that the work has been printed in his establishment situate within the domains of the Republic.

Art. 11. The registrar shall give the depositor a dated receipt. A duplicate of this receipt is entered on a register kept in his office, which any one may consult gratuitously, and from which any one may obtain extracts or copies at his own expense. The government shall settle the form of receipt and regulate the keeping of the register.

The 'Staats Courant' shall contain every month a notice of the works and translations deposited.

Art. 12. The author loses the exclusive right of representation in dramatic-musical or dramatic works published in print, unless this is expressly reserved on the title-page or cover of the first edition.

III.—Duration of Copyright.

Duration.

Art. 13. Copyright in works published in print lasts fifty years from the first publication, dating from the receipt mentioned in Art. 11.

If the author survives this period without having alienated his right, he preserves it during his life. This provision does not apply to the persons entitled to copyright enumerated in Art. 2 (a) and (b).

Art. 14. Copyright in works not published in print, including oral addresses, lasts for the life of the author and thirty years afterwards.

Art. 15. The exclusive right of performance or representation of dramatic and dramatic-musical works lasts,—

- (1) For those not published in print, during the life of the author and thirty years after.
- (2) For those published in print with a reservation of the exclusive right, ten years from the date of the delivery of the receipt mentioned in Art. 11.

Art. 16. The exclusive right of translation lasts,—

- (1) In the case of unpublished works, including oral addresses, as long as copyright.
- (2) In the case of published works, five years from the delivery of the receipt mentioned in Art. 11.

Art. 17. In respect to works composed of volumes or separate parts, the duration of copyright is calculated separately for each part or volume.

IV.—Protection of Copyright.

Art. 18. Any person who infringes copyright, or sells, imports, or circulates, puts on the market, or has in his possession for sale a work infringing copyright, is liable to a civil action for damages on the part of the author or his representatives. Protection of copyright.

Art. 19. An author or his representatives may seize copies published in print in defiance of their right, and may demand the confiscation of such copies for their own benefit, or for destruction.

These measures do not apply to isolated copies found in the possession of individuals who do not sell them and have only acquired them for their personal use.

V.—Transitory Provisions.

Art. 20. Copyright cannot be had in a work published before the coming into force of this law, unless in the six months before this date the author or his representatives, the publisher or printer, deposits at the office of the registrar three copies, each bearing on the title-page or cover the signature of the depositor written by himself, his address, and the date of the first edition. Works published before this law.

This date, subject to proof to the contrary, is the commencement of the duration of the right.

A declaration in accordance with Art. 10 (2) must be delivered also in this case.

Art. 21. The registrar shall deliver to the depositors a dated receipt, a duplicate of which shall be entered on the register kept in his office; any one may consult the register without payment, and obtain copies and extracts at his own expense.

The 'Staats Courant' shall contain a notice every month of the works and declarations received by the registrar, with information of the dates assigned by the depositors to the first edition of their works.

VI.—Final Provisions.

Art. 22. Of the three copies deposited according to Arts. 10 and 20, one shall remain in the office of the registrar, a second shall be placed in the state library, the third shall be placed as the government shall determine.

CAP. III. *Art. 23.* This law comes into force three months after its
 TRANSVAAL. publication in the 'Staats Courant.'

By a resolution of the first Volksraad of 25th June, 1895, the president of the late South African Republic was authorized to assure, by proclamation, the advantages of the above law to proprietors of copyright in works published and printed in any country or colony, under condition of reciprocity being assured to works published and printed in the Transvaal. The power to make such a proclamation is, apparently, now vested in the Governor.

Maps of
 South Africa.

By proclamation, dated 19th April, 1902, issued by Lord Milner, it is provided that the copyright in all maps of the South African possessions of the Crown, made or drawn by the Field Intelligence Department of the troops in South Africa and published in the Transvaal, shall vest in the General Officer commanding the said troops. Three copies of any map of any part of these South African possessions, signed by a person duly authorised by the said General Officer, must be deposited at Pretoria within two months of publication in the Transvaal, otherwise the provisions of Article 10 of the Law of 1887 are not to apply.

INDIA.

Copyright in literary works is regulated in India by Act No. 20 of 1847, passed on the 18th of December, 1847. The preamble of the Act recites that it was passed by reason of doubts existing whether the right called copyright could be enforced by the common law of England in the parts of the territories governed by the East India Company where English common law had been introduced. And whether the right could be enforced by virtue of the principles of equity and good conscience in the other parts of the territories governed by the East India Company. And because it was desirable that the existence of the said right should be placed beyond doubt and be made capable of easy enforcement. And it was doubtful whether the English Act of 5 & 6 Vict. c. 45, contained sufficient provisions for the enforcement of the said right by the proprietors thereof in every part of such territories.

Literary
 works.

The Act, which does not however contain an interpretation clause (*a*), follows the English Act as to the period of duration and other essential features.

(a) See the Press Act No. 25 of 1867, *post*, p. 814.

It does not contain the provisions of sections 6 to 10 of the English Act relating to delivery of copies (a). CAP. III.
INDIA.

A register is to be kept in the office of the Secretary to the Government of India for the Home Department (b).

The fee for inspection of an entry is two annas: for a copy of an entry two rupees. Such copies do not require to be impressed with a stamp: for an entry of copyright two rupees.

Applications to expunge entries are to be made to the Supreme Court of Calcutta, or if the court be not then sitting to any judge of such court sitting in chambers.

Under section 7 (c) as amended by Act No. 13 of 1876, if any person shall print or cause to be printed either for sale or exportation any book in which there shall be subsisting copyright, without the consent in writing of the proprietor thereof, or shall have in his possession for sale or hire any such book so unlawfully printed without such consent as aforesaid, such offenders shall be liable to a suit in the highest local court exercising original civil jurisdiction (d). Court in which proceedings are to be taken.

It will be observed that knowledge of unlawful printing is not necessary.

Sect. 17 of the English Act relating to importation is omitted from the Indian Act (e).

Also the sections 20 to 22 and all provisions relating to musical and dramatic works.

The Act contained no provision for limitation of civil actions (f).

The ordinary form of procedure of the Zillah and other local courts may be used instead of actions in detinue and trover for recovery of pirated copies and damages.

Under the law of 1867 (No. 25) for regulating printing presses and newspapers: Press Act of 1867.

Sect. 1. Book in this Act includes every volume, part or division of a volume, and pamphlet in any language, and every sheet of music, map, chart or plan separately printed or lithographed.

Sect. 3. Every book or paper printed within British India shall have printed legibly on it the name of the printer and the place of printing, and (if the book or paper be published) of the publisher and his place of residence.

(a) See the Press Act, No. 25, of 1867.

(b) See Press Act, s. 18.

(c) Sect. 15 of 5 & 6 Vict. c. 45.

(d) Petition of Hameedoollah. L. R. Calc. 6, p. 499.

(e) See the Sea Customs Act of 1878.

(f) See the Indian Limitation Act of 1877.

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INDIA.

Sect. 5. No printed periodical work containing public news or comments on public news shall be published in British India except in conformity with the rules hereafter laid down.

Deposit.

Sect. 9. Three printed or lithographed copies of the whole of every book printed or lithographed in British India after this Act shall come into force, together with all maps, prints, or other engravings belonging thereto, finished and coloured in the same manner as the best copies of the same shall be produced, and also of any second or subsequent edition which shall be so produced with any additions or alterations, whether the same be in letter-press or in the maps, prints, or other engravings belonging thereto, and whether the first edition of such book shall have been produced before or after this Act shall have come into force, shall within one calendar month after the day in which any such book shall first be delivered out of the press, and notwithstanding any agreement (if the book be published) between the printer and publisher thereof, be delivered by the printer, bound, sewed, or stitched together, and upon the best paper on which the same shall be printed or lithographed at such place and to such officer as the Local Government shall, by notification in the official 'Gazette,' from time to time direct.

The publisher or other person employing the printer shall, at a reasonable time before the expiration of the said month, supply him with all maps, prints, and engravings, finished and coloured as aforesaid, which may be necessary to enable him to comply with the requirements aforesaid.

Nothing in the former part of this section shall apply to any periodical work published in conformity with the rules laid down in section 5.

Sect. 10. Such officer shall thereupon give a receipt in writing for the copies so received, and if the book is for sale to the public, shall, on the publication thereof, pay the publisher for the same copies at the rate at which the book shall be *bond fide* sold for cash to the public.

Sect. 11. One copy is to be transmitted to the Secretary of State for India, another to be disposed of as the Governor-General in Council shall direct, and the remaining copy, after a memorandum containing the particulars hereinafter mentioned respecting the book shall have been registered as hereinafter provided, shall be deposited in such public library or otherwise disposed of as the local government shall direct.

Persons offending against section 3 may be punished with fine not exceeding 5000 rupees, or imprisonment up to two years, or both.

Printers who do not supply copies of books shall forfeit, besides the value of the copies, a sum not exceeding 50 rupees.

Publishers, &c., not supplying the printer with maps, &c., shall forfeit the value of the maps, &c., which they ought to have supplied, and in addition a sum not exceeding such value.

Sect. 18. An office and an officer are to be appointed by the local government, and a book is to be kept called a Catalogue of Books printed in British India, wherein is to be registered a memorandum of every book delivered, under section 9. Such memorandum (so far as practicable) is to contain the following particulars: Registration.

- (1) Title of the book, the contents of the title-page, with a translation into English of such title and contents if not in the English language.
- (2) The language in which the book is written.
- (3) Name of author, translator, or editor of the book or any part thereof.
- (4) The subject.
- (5) Place of printing and publication.
- (6) Name or firm of printer or publisher.
- (7) Date of issue from press or of publication.
- (8) Number of sheets, leaves, or pages.
- (9) Size.
- (10) First, second, or other number of the edition.
- (11) The number of copies of which edition consists.
- (12) Whether the book is printed or lithographed.
- (13) The price to the public.
- (14) Name and residence of the proprietor of the copyright or any portion of the copyright.

The memorandum is to be made as soon as possible.

Every registration under this section shall, upon payment of two rupees to the officer keeping the catalogue (*a*), be deemed to be an entry in the book of registry kept under the Act of 1847.

Sect. 19. The memoranda registered are to be published quarterly in the local 'Gazette,' and copies are to be sent to the Secretary of State and the Secretary to the Government of India for the Home Department.

(*a*) All books becoming the property of the Government for educational purposes are exempted from this payment.

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INDIA.

4. The Governor-General of India in Council may, by notification in the 'Gazette of India,' exclude any class of books from the operation of the Act.

Under this provision the following have been exempted:—

- (1) Acts of legislative councils without notes or commentaries.
- (2) Price lists and tradesmen's circulars.
- (3) Catalogues of books and other articles, auctioneers' notices and advertisements.
- (4) Playbills comprising advertisements of theatrical and musical entertainments.
- (5) Decisions of courts of law without notes or commentaries.
- (6) Petitions and appeals addressed to constituted authority under the provisions of law.
- (7) Testimonials of private individuals or public officers.
- (8) Annual reports of schools, banks, societies, and firms.
- (9) Almanacs and calendars.
- (10) Labels affixed to articles of commerce.

Limitation
of actions.

Under the Indian Limitation Act of 1877 (which repealed the Act of 1871) (No. 15 of 1877), section 4, and the second Schedule (No. 40), actions for compensation for infringement of copyright must be brought within three years of the date of infringement.

Injunctions.

Under the Specific Relief Act, 1877 (No. 1 of 1877), section 54, illustration (v.), perpetual injunctions may be granted to restrain infringement of copyright, unless the work of which copyright is claimed is libellous or obscene; and under section 55 (a), the court may order the copies produced by piracy to be given up or destroyed.

Importation.

Under the Sea Customs Act of 1878 (No. 8 of 1878), section 18 (a), no book printed in infringement of any law in force in British India on the subject of copyright shall be brought, whether by land or sea, into British India when the proprietor of such copyright, or his agent, has given to the chief customs authority a notice in writing that such copyright subsists, and a statement of the date on which it will expire. The penalty for unlawful importation is confiscation of the books and a fine equal to not more than three times their value, and in any case not to exceed 1000 rupees.

Stamps.

Assignments of copyright by entry on the register are still free from the stamp duty: see the Stamp Act, 1879, Schedule II., No. 5.

(a) *Baker v. Sutherland*, 8 Beng. L. R. 298

Under the Civil Procedure Code of 1882 (Law No. 14 of 1882), which came into force on the 1st June, 1882, temporary injunctions may be granted to restrain infringement (section 492, and see Form No. 166 of Schedule IV.), where it is proved by affidavit or otherwise that any property in dispute in the suit is in danger of being damaged by any party to the suit. And the said Schedule IV. contains forms of concise statements of claim and of injunctions in actions for infringement of copyright, Nos. 114 and 166.

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Procedure.

The Presidency Small Cause Courts Act of 1882 (Act 15 of 1882), section 19, provides that the Small Courts shall have no jurisdiction in suits for compensation for the infringement of copyright.

There are no provisions relating to musical and dramatic works in India.

Musical and
dramatic
works.
Designs.

The Inventions and Designs Act of 1888 (which received the assent of the Governor-General on 16th March, 1888) (No. 5 of 1888), Part II., sections 50–62, contains the following provisions as to designs: Part II., section 50 (1). In this part, unless there is something repugnant in the subject or context :

Definition.

(1) Design means some peculiar shape, configuration or form given to an article, or arrangement of lines or the like used on or with an article, but not the article itself.

(2) Copyright means the exclusive right to apply a design to an article.

(3) The author of any new and original design shall be considered the "proprietor" thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case that person shall be considered the proprietor; and every person acquiring for good or valuable consideration a new and original design, or the right to apply the same to any article, either exclusively of any other person or otherwise, and also every person on whom the property in the design or the 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.

51 (1) Any person, whether a British subject or not, claiming to be the proprietor of any new and original design not previously published in British India, may apply to the Governor-General in Council for an order for the registration of the design.

Application
for order for
registration
of design.

(2) The application must be in writing in the form or to

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the effect of the 5th Schedule, and must contain a statement of the nature of the design and be accompanied by as many copies of drawings, photographs, or tracings thereof, not being fewer than four, as may be required by the rules for the time being in force under this part.

(3) It must be left with, or sent by post to, the secretary (a), and the date of delivery or receipt thereof in the office of the secretary shall be endorsed thereon and recorded in that office.

Registration
in register of
designs.

52 (1) Upon the application the Governor-General in Council may, after such inquiry as he thinks fit, make an order authorizing the registration of the design.

(2) When an order has been made under sub-s. (1), the secretary shall cause the design to be registered in a book to be kept by him for the purpose, and to be called the register of designs.

(3) The date of registration shall be recorded in the register.

Duration of
copyright.

53. When a design is registered, the proprietor thereof shall, subject to the other provisions of this part, have copyright in the design during five years from the date of registration.

Marking
registered
designs.

54 (1) Before delivery or sale of any article to which a registered design has been applied, the proprietor of the design shall cause the article to be marked with the word "registered" either in full or in an abbreviated form.

(2) If he fails to cause the article to be so marked, the copyright in the design shall cease unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Effect of
exhibiting
unregistered
designs at
exhibitions.

55. If the proprietor of a design exhibited at an industrial or international exhibition, certified as such by the Governor-General in Council, causes an application for an order for the registration of the design to be delivered to or received by the secretary within six months from the date of the admission of the design into that exhibition, the design shall not be deemed to be a new and original design not previously published in British India within the meaning of section 51 by reason only of the design having been exhibited at the exhibition.

Mutation of
names in
register of
designs.

56. Any person in whom the copyright in a design has become vested may apply to the secretary for the entry of his

(a) Secretary to the Government of India appointed to discharge functions of the Secretary under this Act. Sect. 4 of Act, sub-s. (8).

name in the register of designs as proprietor of the copyright, and the secretary may, if he thinks fit, cause the entry to be made.

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57 (1) The registered proprietor of a design may institute a suit in the District Court (a) for the recovery of any damages arising from the application by any person to any article of the design or of any fraudulent or obvious imitations thereof for the purpose of sale, or from the publication, sale or exposure for sale by any person of any articles to which the design, or any fraudulent or obvious imitation thereof, has been applied, that person knowing or having reason to believe that the proprietor had not given his consent to such application.

Suit for infringement of copyright.

(2) When the Court makes a decree in a suit under this section, it shall send a copy of the decree to the secretary, who shall cause an entry thereof to be made in the register of designs.

58. When from the expiration of the term of copyright or from any other cause, the copyright in a design has ceased, the secretary shall cause an entry with respect to the cessation of the right to be made in the register of designs.

Registration of cessation of copyright.

59 (1) A High Court (b) may, on the application of any person aggrieved by an entry in the register of designs, or by the omission of an entry therefrom, make such order for the rectification of the register as it thinks fit.

Rectification of register of designs.

(2) An order under sub-section (1) may declare copyright in a design not to have been acquired.

(3) A copy of the order shall be forwarded by the court to the secretary, who shall cause an entry thereof to be made in the register of designs.

(4) When the secretary is a party to an application under this section, the costs of another party thereto shall not be adjudged to be payable by the secretary.

60. A High Court to which an application has been made under the last foregoing section may stay proceedings on, or dismiss the application if, in its opinion, the application would be disposed of more justly or conveniently by another High Court.

Power to High Court to stay proceedings on, or dismiss application for rectification of the register.

Under section 61 four copies at least of drawings, photographs, or tracings accompanying an application of an order for the registration of a design in respect of which such an

(a) District Court has the meaning given to that term by Code of Civil Procedure, Law XIV. of 1882.

(b) High Court = High Court of Code of Criminal Procedure, 1882 (No. X. of 1882), in reference to proceedings against European British subjects.