

IN THE SUPREME COURT OF THE DEMOCRATIC SOCIALIST
REPUBLIC OF SRI LANKA

S.C. Appeal No: S.C. (CHC) 04/2001

Commercial High Court Case No: 12/96(3)

J.D.FERNANDO

No.31/1, Bodhiraja Mawatha,

Nedimala.

Plaintiff

Vs

Wasath Chandrasiri Gamlath,

No.46, Honnanthara,

Piliyandala.

Defendant

AND NOW BETWEEN

J.D.Fernando

No.31/1, Bodhiraja Mawatha,

Nedimala.

Plaintiff-Appellant

Vs

Wasath Chandrasiri Gamlath,
No.46, Honnanthara,
Piliyandala.

Defendant-Respondent

BEFORE

J.A.N.DE SILVA CJ,
EKANAYAKE J
SURESH CHANDRA J

COUNSEL

Mahinda Ralapanawa with Chandima Gamage for
Plaintiff-Appellant
Sumedha Mahawanniarachchi for Defendant-Respondent

ARGUED ON:

10th February 2011

DECIDEN ON :

06th May 2011

R. K. S. Suresh Chandra J,

This is an appeal from the judgment of The Commercial High Court, Colombo in respect of an appeal filed by the Plaintiff.

The Plaintiff in her Complaint filed in the District Court of Colombo which was later transferred to the Commercial High Court, Colombo averred that her husband was the late Mr. C.T Fernando that the said Mr. C.T. Fernando, had done a musical composition for the song "Pinsuduwanne" and was its singer as well. The Defendant had included the said song in a teledrama titled "Mal Kekulak" without the Plaintiffs permission and had telecast it for a commercial purpose. The Plaintiff

claimed the intellectual property rights to the “tune” of the said song as the widow of late Mr. C.T. Fernando in terms of section 19(1) of the Code of Intellectual Property Act No. 52 of 1979 and averred that the Defendant had breached the Plaintiffs rights under the Code of Intellectual Property. She prayed for a declaration to the effect that the tune of the said song was composed by her late husband Mr. C.T.Fernando, for an order that the Defendant had breached the Plaintiffs’ rights under the said code, and had also distorted the tune of the said song and thereby breached section 11(b) of the Code of Intellectual Property Act, for damages in the sum of Rs. 25,000/= for violating the Plaintiffs rights under the said Code, for an order in the sum of Rs. 25,000/= against the Defendant for unjustly enriching himself by violating the Plaintiffs rights under the said Code. The Defendant filed answer denying the breach of the Plaintiffs rights and stated further that the Plaintiff did not have rights to the said song and that he had taken the song from the textbook published by the Educational Publishing Department in 1993.

After trial the Learned High Court Judge held that the composition of the said song was that of late Mr. C.T. Fernando and that the Plaintiff acquired the rights of the late Mr. C.T. Fernando in terms of the Code of Intellectual Property Act and further that the Defendant included the said song in the teledrama without the Plaintiffs permission. However the Learned High Court Judge went on to hold that the Defendant had not infringed the rights of the Plaintiff and proceeded to reject the other claims of the Plaintiff.

In the Appeal filed before this Court both parties had filed written submissions but when the matter was taken up for argument on 10th February 2011 the Defendant was absent and unrepresented and the Court proceeded to hear the appeal.

R.G. McKerron Q.C., in *The Law of Delict* referring to the position relating to “passing off” under the Roman Dutch Law states that -

“A person may be restrained from selling his goods by the same name as that of the Plaintiff, or any colourable imitation thereof. But a restraint will not be imposed in respect of goods which are not the same kind as those of the Plaintiff. Nor will protection be afforded to a *peregrinus* who is not carrying on business, or whose goods are not sold on the market, within the jurisdiction in which he seeks relief; for to entitle the plaintiff to an interdict he must show that he has ‘a right of property in regard to his name or goods within the jurisdiction of the court’”.

A parallel could be drawn to this instant case which deals with the use of the composition of the song that the Plaintiff has complained of. It certainly would be a case comparable to a case of “passing off”.

The law relating to the trademarks and passing off was governed by the Trademarks Ordinance No. 15 of 1925 which used the above principles based on the law of Delict. The law in relation to trademarks, passing off and copyright is now governed by the Code of Intellectual Property Act No 52 of 1979.

Section 19(1) of the Code of Intellectual Property Act No. 52 of 1979 states that -

“Unless expressly provided otherwise in this Part, the rights referred to in section 10 shall be protected during the life of the author and for fifty years after his death.”

Section 10 of the Code of Intellectual Property Act No. 52 of 1979 states that -

“Subject to the provisions of sections 12 to 16 the author of a protected work shall have the exclusive right to do or authorize any other person to do the following acts in relation to the whole work or a part thereof-

- (a) reproduce the work;
- (b) make a translation, adaptation, arrangement, or other transformation of the work ;
- (c) communicate the work to the public by performance, broadcasting, television or any other means.”

In the English Law copyright protection will only subsist for works which are considered to be ‘original’ works. The test to consider whether a work is original was laid down in the case of *University of London Press v University Tutorial Press* [1916] 2 Ch 601 where Peterson J held that

“The word ‘original’ does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought ... But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.”

He further pointed out the much used principle in English Law which is that ,“what is worth copying is prima facie worth protecting”.

In the case of *Sawkins v Hyperion Records* [2005] EWCA Civ 565 the claimant a musicologist, had prepared performing editions based upon works of Lalande, a French composer at the courts of King Louis XIV and King Louis XV. The existing sources of Lalande’s music were not in a form that could be played by an orchestra, and to make it possible to perform the music the claimant had to transpose the source material into conventional modern notation, make extensive corrections, and complete several missing sections, all of which involved a great level of skill, labour and judgment. However, the claimant did not compose a single new note of music. In the judgment of the Court of Appeal, Mummery LJ held that on the application of the principle laid down in *Walter v Lane* (1900) AC 539, the effort, skill and time which the claimant had spent in making the performing editions were sufficient to satisfy the requirement that they should be “original” works in the copyright sense. Jacob LJ further held that the required question that needed to be asked when considering originality was whether “what the copyist did went beyond mere servile copying?” It was held in the Hyperion Records case that there was more than mere servile copying as the Claimant’s work had the practical value of making the original work playable and that the work of the Claimant had sufficient aural and musical significance to attract copyright protection.

When considering infringement of copyright the courts would need to look at the similarities between the works. In the case of *Designers' Guild v Russell Williams* [2000] UKHL 58 which considered an artistic work Lord Millett held that

“ An action for infringement of artistic copyright, however, is very different. It is not concerned with the appearance of the defendant's work but with its derivation. The copyright owner does not complain that the defendant's work resembles his. His complaint is that the defendant has copied all or a substantial part of the copyright work ... Even where the copying is exact the defendant may incorporate the copied features into a larger work much and perhaps most of which is original or derived from other sources. But while the copied features must be a substantial part of the copyright work, they need not form a substantial part of the defendant's work ... Thus the overall appearance of the defendant's work may be very different from the copyright work. But it does not follow that the defendant's work does not infringe the plaintiff's copyright.”

“The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges have been copied from the copyright work.”

“... the inquiry is directed to the similarities rather than the differences. This is not to say that the differences are unimportant. They may indicate an independent source and so rebut any inference of copying, but differences in the overall appearance of the two works due to the presence of features of the defendant's work about which no complaint is made are not material.”

In the case of *Francis Day & Hunter v Bron* [1963] Ch.587 the Claimant who was the composer of the musical work “In a Little Spanish Town” claimed that the first eight bars of the claimant's musical work had been copied in the first eight bars of the defendant's musical work named “Why”. Willmer LJ held that the composer had used some of “the commonest tricks of composition,” and which were furthermore “exactly the sort to be expected from the composer of a popular song.” Willmer LJ referred to the fact that the opening bar of the claimant's work was a commonplace series found in other previous musical compositions, which had then been developed over the remainder of the first eight bars of the musical work.

When considering the moral rights such as the right to object to the derogatory treatment of a work the main issue would be to consider whether there has been evidence put forward to the court to be able to consider whether a distortion or a mutilation of the work has occurred which has caused the author dishonor or disrepute.

In the case of *Confetti Records v Warner Music* [2003] EWCh 1274 (Ch) the third claimant composed a garage track entitled “Burnin,” which consisted of an insistent instrumental beat accompanied by the vocal repetition of the word “burning” or variants of it. The defendant, a leading UK garage act, released a version of the track “Burnin” with the addition of a rap line. The claimant alleged that the rap was a derogatory treatment of his work because it allegedly included

reference to drugs and violence. It was accepted by the Defendant that the addition of the rap line was a “treatment” of the work, and the issue was whether the treatment was “derogatory.”

The Court held that according to the Copyright Act of United Kingdom, distortion or mutilation is only derogatory if it is prejudicial to the author’s honour or reputation. The judge held that the fundamental weakness in the case was that there was no evidence about the author’s honour or reputation, or of any prejudice to either of them.

In the instant case the Learned Judge of the Commercial High Court having considered the evidence before Court had arrived at the conclusion that the late Mr. C.T Fernando was entitled to rights in respect of the composition in respect of the song “pinsiduwanne” in terms of the provisions of the Code of Intellectual Property Act, he had further held that the Plaintiff who is the widow of the Late Mr. C.T Fernando had inherited such rights but went onto hold that the Defendant had not infringed such rights.

Although the Plaintiff alleged the distortion of the musical composition by the Defendant there was no proof of such distortion which was established by the Plaintiff and the Learned High Court Judge arrived at the conclusion that there was no such distortion. Considering the evidence before the Commercial High Court the Learned Judge has arrived at a correct finding on that matter.

With the advancement in technology it is very easy to copy works of original artists, composers, singers, etc. But there has to be a way of safeguarding the rights of the original artists such as the singer as in the present instance, specially when a singer has achieved a reputation which would be recognized for generations and generations. Once such recognition has been there, and rights acquired which according to law can be inherited, the works of such original reputed artists such as singers can be used by other only by obtaining permission from the original artist or from those who inherit such rights which amounts to a recognition of the fame and reputation of the original singer.

We find that the Defendant had in the case before the Commercial High Court admitted including the said song in his teledrama without permission from the Plaintiff. Furthermore in evidence the Plaintiff stated that the Defendant had asked permission from her to use the said song of her late husband to which she had declined. The book published by the Educational Publishing Department which the Defendant claims to have been the source material used for the song in his teledrama contained only the lyrics to the said song and to which the Plaintiff claimed no such copyright as copyright was owned by a different individual who is not a party to the above action. In such an event as the Plaintiff had the rights for the musical composition under the Act it will be clear that the use of the said composition by the Defendant without permission was an infringement of the rights of the Plaintiff. The Plaintiff had claimed the sum of Rs.25,000/= for the said infringement by the Defendant in view of the position that there has been an infringement of the Plaintiffs rights regarding the composition by the Defendant and the Plaintiff would be entitled to damages as claimed by her plaint. Therefore a sum of Rs. 25,000/= as claimed by the Plaintiff is awarded to her which is to be paid by the Defendant.

In the petition of appeal filed by the Plaintiff she had prayed for :

- (a) setting aside the judgment of the High Court dated 27.11.2000;
- (b) to decide the appeal in her favour ;
- (c) alternatively to send the case back for a fresh hearing.

As stated above the judgment of the High Court is varied in relation to the finding that there has been no infringement of the Plaintiffs rights as there has been such infringement. In the prayers mentioned above there is no specific prayer claiming damages except for seeking a decision in favour of the Appellant which would presuppose seeking a decision as prayed for in the Plaint which includes a prayer claiming damages in the sum of Rs. 25,000/=. This is to be considered only for the purposes of granting relief to the Plaintiff as there is a finding regarding the infringement of the Plaintiffs rights which would naturally result in causing damages to the owner of such rights. However such damages are limited to the amount claimed by the Plaintiff in her plaint which is the sum of Rs. 25,000/=.

In the above circumstances the Plaintiffs appeal is allowed and she is awarded a sum of Rs. 25,000/= as damages with costs fixed at Rs.10,500/=.

JUDGE OF THE SUPREME COURT

J.A.N.DE SILVA CJ

I agree.

CHIEF JUSTICE OF THE SUPREME COURT

CHANDRA EKANAYAKE J

I agree.

JUDGE OF THE SUPREME COURT