

# Intellectual property

## The return of the lion

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The Lion sleeps tonight in Africa, where it belongs. It has found and, has returned to, its roots in South Africa. At the same time, Mickey Mouse, Donald Duck and their friends have been released from custody in South Africa where they have been held hostage.

In the late 1930s Solomon Linda, a Zulu tribesman, composed the song MBUBE. He relocated to Johannesburg where he was employed as a sweeper in the storeroom of Gallo Record Company. Gallo recorded and released his song which became a good seller in South Africa.

In the early 1950s the recording of MBUBE found its way to America and came to the attention of Pete Seeger, the folksinger. He liked what he heard and transcribed the music from the record to make his own song which he called WIMOWEH. It was successful in the United States in the 1950s and then was later reworked into another version in the 1960s by the song writers George Weiss, Hugo Peretti and Luigi Creatore as THE LION SLEEPS TONIGHT. In this form the song became a major hit and has remained popular for more than 40 years. It is, indeed, reported to be one of the most successful songs ever written.

In the mid 1990s it was incorporated into the Disney musical THE LION KING, in both the movie and stage versions. The origins of the song in MBUBE and the role played by Solomon Linda did not receive acknowledgment and the song was presented as being of American origin.

At the time when MBUBE relocated to America, Solomon Linda executed an assignment of his worldwide copyright in that song to Gallo Records. That marked the beginning of his journey into oblivion as far as the song was concerned. He died in 1962 as a pauper, leaving a wife and four children.

Under the prevailing South African law of intestate succession his wife, Regina, was his sole heir. In 1983 the American music publishing company, Folkways, which had gained control of WIMOWEH, exacted an assignment of Regina's rights to the renewal term of WIMOWEH under United States

copyright law and threw in at the same time her worldwide rights to the song, such as they may have been.

MBUBE from the four Linda daughters. No stone had been left unturned to ensure that the Linda family had no claim to the copyright in the song MBUBE.

In the late 1990s, author and freelance journalist, Rian Malan, wrote an article exposing all the machinations that had taken place. He made the point that, though the derivatives of that song, and in particular THE LION SLEEPS TONIGHT, made millions of US Dollars, the Linda daughters, one of whom had recently died from AIDS, were living in abject poverty in South Africa and were deriving no material benefit from the fruits of their father's creative work.

The article, published in Rolling Stone, caused sufficient outcry in South Africa to foster the resolve to take legal steps to stake a claim on the part of the family to proceeds from the song, and especially THE



In 1990, Regina died leaving a will nominating her four children as her heirs. In 1992, when litigation was raging in the United States regarding WIMOWEH and THE LION SLEEPS TONIGHT, Folkways exacted a further assignment of worldwide rights to

LION SLEEPS TONIGHT version, and to gain due acknowledgment of the role played by Solomon Linda in creating the song, as well as for its South African origin.

In order to establish a cause of action on the part of the Linda heirs, reliance was placed on

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s5(2) of the Imperial Copyright Act of 1911, a British statute which was made law throughout the British Empire as it existed in 1911, including South Africa. In terms of this provision, where an author assigned his copyright during his lifetime, 25 years after his death, the copyright reverted to the Executor of his estate, as an asset in that estate, notwithstanding any other assignments of copyright which might have taken place in the meantime.

This provision was tailor-made for the facts of the MBUBE case, save that both Regina and the daughters had already assigned their claim to copyright in MBUBE to Folkways. However, it was reasoned that the reversionary copyright vested in the Executor and did not become the property of either Regina or her daughters unless and until such time as it was transferred to them by the Executor, which never happened. Accordingly, the assignments in favour of Folkways had no force or effect.

The estate of the late Solomon Linda was reopened and an Executor, Stephanus Griesel, was appointed in 2004. Litigation commenced in the name of the Executor in his representative capacity. Since the Executor could only claim rights to MBUBE in countries which were formally members of the British Empire, it was decided to bring the litigation before the South African court.

There was no way in which jurisdiction on the part of the South African court could be claimed against Abilene Music, the alter ego of Weiss, Peretti and Creatore, and it was decided to sue the most prominent and high profile licensee of the song, Walt Disney Enterprises Inc, against which it was possible to secure jurisdiction before a South African court. This could be done by attaching in

excess of 200 registered trade marks owned by Walt Disney Enterprises in South Africa.

An application was brought before the Transvaal High Court to attach Disney's registered trade marks, as well as the copyright in the movie THE LION KING, and this application was granted.

An action was then instituted against Disney, as well as against certain other licensees or sub-licensees of Abilene. In the action it was claimed that the defendants had infringed the Executor's copyright in MBUBE by, without his authority, reproducing and publically performing a substantial part of it in the guise of THE LION SLEEPS TONIGHT. An interdict restraining unauthorised use of THE LION SLEEPS TONIGHT in South Africa, damages, as well as various other forms of ancillary relief, were claimed.

Walt Disney Enterprises reacted aggressively to the attachment of its trade marks. It brought an urgent application before the South African court to set aside the attachment on the grounds that the Executor had no case against it. All the legal issues, including some technical procedural issues, were ventilated in this application and the court refused the application. In effect this endorsed the Executor's cause of action and confirmed the attachment of Disney's trade marks.

The action proceeded along its way, and was set down for trial on February 21 this year. Shortly before the trial date, negotiations commenced and culminated in a settlement between the parties to the litigation, as well as with Abilene Music, which had granted an indemnity to Disney when it had licensed the use of THE LION SLEEPS TONIGHT to it. Abilene was in truth the true defendant in the litigation, though it was not before the court

for reasons of lack of jurisdiction.

The settlement encompasses the following:

- It operates worldwide and is in settlement of all claims.
- The Linda heirs will receive a payment for past uses of THE LION SLEEPS TONIGHT and an entitlement to future royalties flowing from the worldwide use of the song.
- It is acknowledged that THE LION SLEEPS TONIGHT was derived from MBUBE.
- Solomon Linda is acknowledged as a co-composer of THE LION SLEEPS TONIGHT and will be designated as such in the future.
- A trust is to be formed to administer the heir's copyright in MBUBE and to receive on their behalf, and distributed to them, the payments due out of the use of THE LION SLEEPS TONIGHT.

It is implicit in the settlement that THE LION SLEEPS TONIGHT is acknowledged as being of South African origin and is thus rooted in South African culture. It is likely that Solomon Linda will assume the proportions of a South African cultural icon. This and the remuneration which the heirs will receive through the trust ought to ensure that the Linda daughters will be able to sustain themselves economically into the future.

From a South African perspective the whole saga has a happy ending and there is some pride in having felled an entertainment industry Goliath with a single slingshot. The record will, however, read: Griesel NO v Walt Disney Enterprises and others: case withdrawn.🔒

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# Could become too ghastly to contemplate

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Contrary to popular belief (hope?), the Minister of Finance did not take the bold step of abolishing exchange control in the budget. This means that the current uncertainty about the application of exchange control regulations to cross-border transfers of intellectual property will continue.

As things stand, SA residents may not export IP without exchange control (Excon) approval. Generally, Excon

(an arm of the SA Reserve Bank) argues that the export of IP may constitute an export of capital which is a contravention of reg.10(1)(c). It

relies strongly on the decision court in *Couve and Another v Reddot International (Pty) Ltd and others* 2004 (6) SA 425