Awaking the Lion

The case of The Lion Sleeps Tonight

OWEN DEAN

Tafelberg

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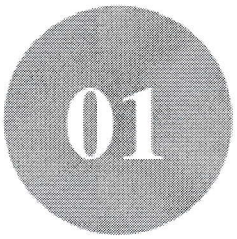


Discovering the lion

There was nothing about 2 September 2002 that outwardly suggested it was going to be anything but a conventional day in my life. It was a normal spring day in Pretoria, bright and sunny, without being too hot. The trees in the city were already heralding the approach of spring and there were signs of their boughs budding with green.

I was an attorney and partner at Spoor & Fisher, one of the leading specialist intellectual property law firms in the country. This field of law comprises patents, trademarks, copyright and designs. I had been specialising in trademark and copyright law for the past 28 years and become known as 'Mr Copyright'.

I was sitting in my office waiting for a client named Geoff Paynter of Gallo Africa, one of the principal music companies in South Africa. It was part of a group of companies that also comprised Nu Metro Films and various other entities in the entertainment industry. Geoff Paynter was the person at Gallo who was primarily involved in copyright matters, especially the commercial exploitation of music, as distinct from recorded music. Gallo was a major client of mine and I had acted for them in several matters, including in connection with music rights, sound recordings and the distribution of movies in the home entertainment market.

I hadn't been told what Geoff wanted to talk to me about, but I had an inkling; I had half been expecting him to see me about it for some time. This went back to a consultation I had had with him some two years earlier, in June 2000, when he had raised a very interesting matter and sought a formal opinion from me on behalf of his company.

It related to the rights in a song called *Mbube*, which had evolved over a period of several years into an international hit called *The Lion Sleeps Tonight* and become one of the most successful pop songs ever written and performed. After several visits to the international hit parade in various guises, it had been taken up into the world famous musical production *The Lion King*,which had enjoyed long and successful runs on Broadway, London's West End and other parts of the world. The stage show, the animated movie version of its story and its music had been produced by Walt Disney of the United States.

Two years before, Geoff had brought me a suitcase full of documents that represented everything Gallo had on file about the song *Mbube*. He had also handed me a copy of an article entitled 'In The Jungle' by Rian Malan, an investigative journalist and writer who had made a name for himself by writing controversial articles, often of a political nature. The article, published in the US magazine *Rolling Stone* of 25 May 2000, related the sad tale of the composer of *Mbube*, Solomon Linda (also known as Ntsele), and his family.

The main thrust of Malan's article was that although Solomon Linda had written *Mbube*, which had gone on to achieve great things and generate bounteous riches, none of these riches had accrued to the composer or his family, who all lived a life of poverty. The article sketched how the song had developed as a commercial property and how it had been the subject of commercial and legal wrangles between various other parties. But all of this had passed Solomon Linda and his family by; he had simply passed into oblivion.

The article said it was grossly unfair that the original composer of the song and his family should have lived such impoverished lives while the song was a passport to riches for others, mainly the moguls of the music industry in the United States. The plight of the composer and his family was attributed at least in part to the Apartheid system and the second-class status suffered by black people in South Africa at the time.

Gallo, the initial usurper of the song from Solomon Linda, had given it a start along its successful road and participated in the benefits. In fact, Gallo was cast somewhat in the role of villain in what had befallen Solomon Linda and his family. And it wasn't enjoying being portrayed in this light, particularly in the 'new' South Africa where it had become part of a corporate group with a strong black empowerment orientation. The purpose of that earlier visit of Geoff's had been to commission me to investigate the legal situation surrounding the rights to the song, and to find out whether anything could be done to reinstate the claim of the Linda family to the song and improve their material lot.

In short, Gallo was politically embarrassed by the position Rian Malan's article had highlighted, and wanted me to find some way for it to redeem itself, particularly in the eyes of the public.

I had undertaken the task of ploughing through myriad documents, mostly contracts entered into over the years in connection with the song. I had pieced together the relevant facts and legal issues in the hope that I would miraculously find that Gallo and/or the Linda family could claim some rights in the song which would lead them to the pot of gold. It had been a daunting task. I had spent many hours sifting through all the documents and at the end of it all I had produced a lengthy written opinion for Gallo. The position I had arrived at was an interesting one – and one that surprised everyone, including me.

The Solomon Linda story

Solomon Linda was an unsophisticated and uneducated Zulu man who hailed from what was then Natal. He came to Johannesburg to seek his fortune and got work as a cleaner in Gallo's warehouse. He was also a talented musician and performing artist. Together with a group called The Songbirds, he performed in the music halls of black society at the height of the Sophiatown era in Johannesburg. In about 1938 he composed the song *Mbube* (which means 'lion' in Zulu) and Gallo made a record of it. The record sold reasonably well and Linda derived a meagre income from royalties. In January 1952 Linda assigned, or transferred, the worldwide copyright of his song *Mbube* to Gallo.

At about this time, Gallo sent Linda's record of *Mbube*, along with several other Gallo recordings, to the United States to see whether there was a market for them there. The song came to the attention of Pete Seeger, a well known American songwriter and singer. There was thought to be no market for Linda's record, but Pete Seeger saw potential in the song and he transcribed it from Linda's record and later made a revised version named *Wimoweh*. ('Wimoweh' was Seeger's transcription of Linda's enunciation of the word 'mbube' on his record.)

Wimoweh was performed and recorded by Pete Seeger and his group, The Weavers. A company Seeger was associated with, Folkways Music Publishers, claimed copyright in *Wimoweh* as an original work. In this guise, the song made it to the hit parade in the United States and became an international hit. Folkways and Gallo entered into several agreements over the years regarding *Wimoweh*, the gist of which was to grant rights to Gallo for its exploitation in various African countries, while Folkways had the exploitation rights for the rest of the world.

Around May 1961 a group called The Tokens released a record embodying an adaptation of *Wimoweh*, but given the name *The Lion Sleeps Tonight*. Authorship of this version of the work was credited to Hugo Peretti, Luigi Creatore and George Weiss. Whereas *Wimoweh* was almost entirely an instrumental piece, *The Lion Sleeps Tonight* was a song with words and it boasted some variations and innovations to the original melody. A company called Token Music Corporation claimed copyright in *The Lion Sleeps Tonight*.

Folkways and Token Music fought various legal battles in the United States as to who actually owned the copyright in *The Lion Sleeps Tonight*. Token Music, or its successor in title, Abilene Music, won the day. *The Lion Sleeps Tonight* achieved enormous fame and success and graced the hit parade for many years (in different versions and interpretations) throughout the world. It became a huge money spinner.

During litigation in the United States about copyright ownership of *Wimoweh/The Lion Sleeps Tonight,* it was acknowledged that *Wimoweh* had been derived from *Mbube* and that *The Lion Sleeps Tonight* was in turn derived from *Wimoweh.* Although the later two versions of the work were eligible for copyright in their own

right, they were nevertheless derivatives of *Mbube* and so the owner of the copyright in *Mbube* could potentially control the use of later versions of the work.

When Solomon Linda wrote *Mbube* in 1938 the song, as an original musical work, enjoyed copyright in South Africa through the South African Patents, Designs, Trade Marks and Copyright Act, 1916, and throughout the civilised world by virtue of an international treaty, The Berne Convention, of which South Africa was a member, as well as various other treaties signed by the country. As the author or composer of the song, Solomon Linda was the initial copyright owner.

At that time, South Africa's law of copyright was in fact regulated by the British Copyright Act of 1911 – known as the Imperial Copyright Act because Britain had it legislated and adopted in all its overseas territories, i.e. throughout the British Empire and Commonwealth. The 1916 South African Act (incorporating the Imperial Copyright Act of 1911) was repealed by the Copyright Act, 1965. It in turn was repealed by the Copyright Act, 1978, which is the still the Act today.

In terms of all of these statutes, the existence, ownership and duration of copyright in a work is determined by the Act in force at the time when the work was made, even if the Act in question had been repealed by a later Act. In other words, these aspects of the copyright in *Mbube* were determined by the 1916 Act (incorporating the Imperial Copyright Act). Since the Imperial Copyright Act was in force throughout the British Empire and Commonwealth, this meant that if Solomon Linda was the initial owner of the copyright in the song in South Africa, he was also the copyright owner throughout the British Empire and Commonwealth.

When the copyright in a work is assigned from one person to another, the person giving up the rights (the assignor) transfers them all to another (the assignee). Once transfer has taken place, the assignor normally has no rights to the work. Copyright also passes from one person to another in terms of the law of succession. When a copyright owner dies, unless there is a specific provision regarding the ownership of copyright held by him, that copyright passes to his heirs as a normal piece of property or an asset in his estate. But Solomon Linda assigned the worldwide copyright in *Mbube* to Gallo in 1952, thereby giving up all rights to that song.

The purchase price for the copyright back in 1952 was 10 shillings. Little did Solomon Linda – and no doubt Gallo – know at the time that the song would become worth billions of US dollars.

Solomon Linda died on 8 October 1962, but he had already divested himself of all rights in *Mbube* so no rights to the song passed to his heirs. Nevertheless, adopting a belt-and-braces approach during the disputes in the United States between Folkways and Token Music over ownership of the copyright in *Wimoweh/The Lion Sleeps Tonight*, Folkways got Regina, Solomon Linda's widow – against the possibility that she might conceivably hold some rights in the song *Mbube* – to transfer her right, ti-

tle and interest in it to them in 1983. But in fact she didn't hold any rights in 1983; for all practical purposes, Folkways probably already held the rights anyway.

When Regina died in February 1990 she left her entire estate to her four children, Elizabeth, Fildah, Delphi and Adelaide, in equal shares. No rights in *Mbube* were included in the assets of her estate at that time. However, no doubt in an excess of caution, in March 1992 Folkways also got Solomon Linda's children to assign the right, title and interest in *Mbube* to them. The children likewise held no such rights at the time.

All this meant that Solomon Linda, his wife Regina and his children had done a good job of assigning away all rights in the song *Mbube*. They no doubt had little or no conception of what they were doing. Although Gallo and Folkways had entered into a multitude of agreements, licensing *Mbube* and *Wimoweh* backwards and forwards, none of these agreements created any rights in favour of Solomon Linda or his family. On my first reading of the documentation, the ability of Solomon Linda's heirs to claim any rights in *Mbube,* and therefore in *The Lion Sleeps Tonight,* didn't look at all promising. Indeed, it seemed to be a lost cause.

A legal outline

Then in the small hours of the morning I had a sudden inspiration. I remembered that while I had been researching and preparing my doctoral thesis some thirteen years earlier, I had come across a very strange provision in the Imperial Copyright Act. This provision altered the normal situation that for the standard term of copyright – which is the lifetime of the author plus 50 years after his death – the copyright in the work belongs to the person who can claim ownership of the work through being the successor in title to the author. Where the author has assigned or transferred the copyright, the most recent assignee retains ownership until the end of the term.

In terms of Section 5(2) of the Imperial Copyright Act, however, where the author of a work was the initial owner of the copyright in it, no assignment of copyright or any licence granted under copyright could confer on the assignee or licensee any rights in the copyright beyond the expiration of 25 years from the death of the author. The term of 50 years beyond the death of the author was effectively divided into two 25-year segments. The ownership of the most recent assignee ended at the end of the first 25 years. Ownership of the second 25-year segment of the copyright was awarded to the author's heirs.

In other words, at that point the author's heirs replaced the most recent assignee as the copyright owner. The right to receive and acquire this final 25-year segment

of the term of copyright was known as 'reversionary interest'. It operated no matter what assignments of copyright might have taken place after the initial transfer of copyright by the author.

Solomon Linda both wrote *Mbube* and died during the time when the 1916 Copyright Act in South Africa was in force, so it applied to the ownership of the copyright. The outcome was that 25 years after his death in 1962 – that is, in 1987 – copyright in *Mbube* reverted to his heirs, who were his wife Regina and his four children. This was despite the fact that he had signed over the rights to Gallo in 1952. This position applied not only in South Africa but throughout the countries of the former British Empire and Commonwealth.

The upshot of all of this was that, contrary to my initial conclusion, Solomon Linda's heirs did indeed have copyright in *Mbube* in South Africa and in many other countries in the world. They had owned the copyright since 1987. All uses of the work in these countries since 1987 required the heirs' authorisation. Without their approval, any uses amounted to infringements of the copyright, giving rise to a claim of damages. Of course, because *Wimoweh* and *The Lion Sleeps Tonight* were derivatives of *Mbube,* the heirs also controlled the right to the use of those songs, including the use of *The Lion Sleeps Tonight* in the musical production *The Lion King.* The heirs were, as it turned out, in a very strong position – at least in theory.

This revelation had formed the cornerstone of my opinion. As I saw it, the heirs could claim damages and royalties for all uses of *Mbube* and its derivatives, especially *The Lion Sleeps Tonight.* I had triumphantly presented the opinion to Gallo, expecting that it would take steps to rectify the past wrongs the Linda family had suffered.

Nothing happened.

I received no feedback from Gallo, apart from an acknowledgement of receipt. My opinion had disappeared into a void. Days, weeks and months, even years, went by without any reaction from Gallo.

In the meantime, I read in the press and learned from television that a Johannesburg attorney named Hanro Friedrich, with the help of Rian Malan, was representing the Linda family and clutching at straws to find some leg to stand on – besides appealing to notions of fair play – to mount some sort of claim for payment of royalties to the Linda family for usage of *The Lion Sleeps Tonight.* It was clear to me that Friedrich was conducting a wild goose chase and I was tempted to pick up the telephone and tell him there was a way for his clients to achieve success.

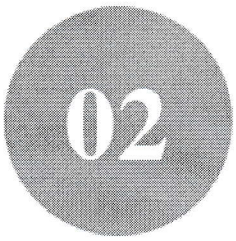
But of course, ethical considerations made it impossible for me to disclose to a third party the contents of an opinion I had written for Gallo. It was for Gallo to decide what if anything should be done with it.

It was frustrating. I began to suspect that Gallo had expected, even wanted, me to fail to come up with a viable course of action; that they would rather I had advised

them there was nothing that could be done – in which case they could declare publicly that they had consulted the leading expert on the area of the law for some way they could help the family but, regrettably, there was nothing to be done. This would clear their public conscience.

Now, more than two years later, Geoff Paynter was coming to see me. Was he going to discuss the *Mbube* matter with me, explain why Gallo took no steps based on my opinion? Or was the purpose of his visit was something completely different. I simply didn't know.

My telephone rang; he was waiting in reception. I picked up a note pad and my file dealing with the *Mbube* opinion on the off-chance that the consultation had something to do with it. As I passed through the door of my office into the corridor, a strange feeling came over me. I had a premonition that something momentous in my career was about to happen. It was as though everything that had happened in the past had been leading up to that moment. I went to meet my client with a feeling of anticipation tinged with trepidation.



Preparing for the lion

Without being a committed believer in the theory of predestination, through my life I've had a feeling that it was being predetermined by extraneous influences, call it fate, divine guidance, or what you may. It was a little like being the driver of a train travelling along a predetermined track with an unknown destination. As the driver of the train, I could determine its speed, when it stopped and went, and to some extent the smoothness of the journey, but the tracks it was following actually determined where it was going. From time to time the tracks passed through junctions and there was a semblance of choice of direction, but the points determining the track to be followed had been set and the choice was just an illusion.

I was born and grew up in Cape Town, where I went to Sea Point Boys High School. I then did a law degree at Stellenbosch University and, because my studies were funded by a state bursary, I was obliged to enter the civil service for six years. I spent those six years in the Department of Foreign Affairs and served at the South African Embassy in The Hague for most of this time. On my return to South Africa, I decided that a legal career was my destiny. I wanted a career as an attorney, but for this I'd have to do two years articles of clerkship.

By this time I was married, and my wife Dana and I had had two children, Ian and Carin, while we were in The Hague. My first choice of a place to practise was my home town, Cape Town, but my position as a returning diplomat meant taking up office in Pretoria. My salary at the time was the princely sum of R350 per month – even then, a meagre income. Articles of clerkship back in 1972 were notoriously badly paid; the going rate was around R100 per month. Dana couldn't work because she was nursing a two-month-old baby, so we'd be entirely reliant on my salary.

I approached attorneys firms in Cape Town, Johannesburg and Pretoria with a view to getting a position as an articled clerk. Each would have been happy to take me on at a salary of R100 per month, but not R350 per month, which is what I considered to be the minimum I needed if we were to make ends meet. I began to despair; a career as an attorney was probably not going to materialise.

I decided to buy a house in the then Verwoerdburg area, giving me the flexibility to work either in Pretoria or Johannesburg if I struck it lucky and secured articles of

clerkship, while in the meantime continuing to work at the Department of Foreign Affairs. In the course of house hunting I met an estate agent named Maurice Witt, who had also gone to Sea Point Boys High. With that as a common bond, while we travelled together to look at houses I shared with him my aspirations and the problems I was experiencing in achieving them. He knew an attorney named Sonny Hart, the senior partner of Friedland Hart & Partners in Pretoria, and arranged an interview for me. But Hart's attitude was no different from that of the other attorneys I had approached; he couldn't pay more than R100.

He did, however, mention his son, Laurie Hart, who was a partner of Spoor & Fisher, specialist intellectual property attorneys, and said perhaps an intellectual property firm might place greater store on my international experience than an ordinary attorneys firm. Some weeks later Laurie Hart invited me to an interview. I had no idea what a specialist intellectual property attorney did or what intellectual property law entailed, but it had become clear that this might be my last opportunity to get a position as an articled clerk. Spoor & Fisher were prepared to take me on at my required salary and the rest, as they say, is history.

That's how I embarked on my chosen career. It has proved very fulfilling and I have no doubt there's no other branch of the law that would have suited or appealed to me more than intellectual property. Fortuity, happenstance, fate, destiny? Whichever it was, it set in motion a sequence of events that played a significant role in the unfolding of this story.

A new direction

When I started with Spoor & Fisher I plunged almost immediately into a copyright infringement case in which I played a very minor role. Our client lost the case by virtue of the opposition taking a totally unexpected, indeed unheard of, point of copyright law. My principal and the eminent senior counsel we had briefed were taken by surprise. This experience aroused my interest and curiosity and I researched the background to this fine point of copyright law, even though it was too late for the case in question.

Through my investigations I realised that so-called 'reverse engineering' of industrial articles such as pumps and spare parts for motor vehicles could be curtailed by relying on a copyright infringement argument. Basically, when an industrial article is cloned, the copyist indirectly reproduces, in three-dimensional form, the design drawings on which the article is based. If this is done without the authority of the copyright owner, it constitutes copyright infringement.

Once I unearthed this principle, I wrote articles and presented papers about it at conferences, and this earned me the reputation of being a copyright attorney. A thriving industry in bringing reverse engineering copyright infringement cases came

about. One thing led to another and I started attracting copyright matters. Finally, I did a doctorate in copyright law and published a legal text book entitled *Handbook of South African Copyright Law*, a loose-leaf publication which to this day is the standard South African work on copyright law.

I was appointed to a statutory advisory committee under the Copyright Act which advised the government on matters pertaining to copyright law, and later to intellectual property law in general. Soon I was being described as the leading copyright practitioner in the country. This precipitated an approach from the film industry to act as its copyright attorney. Even this came about through an unlikely set of circumstances in which fate/destiny played a role. The Motion Picture Association of America (MPPA) – the American industry body representing the major American film companies – placed me on a retainer. Subsequently, the MPAA created a South African company named South African Federation Against Copyright Theft (SAFACT) to carry out its anti-piracy programme for movies and I became its director.

The role I played in the film industry led to my being appointed in a similar capacity by the record industry and the computer software industry. The publishing industry and the South African Broadcasting Corporation also consulted me regularly.

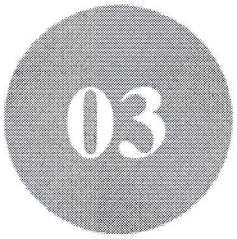
One of my first clients in the movie industry, and indeed the precursor of my relationship with the MPAA, was Gallo. At the start of the home video industry in South Africa, Gallo got a licence to distribute home video versions of films from several major American film companies, who were members of the MPAA. Gallo's role was later taken over by Nu Metro, its sister company, and then I acted for Nu Metro. My involvement with the MPAA also brought me into contact with Walt Disney, one of the major players in the MPAA. I began to act for Walt Disney in the movie field. I had already acted for Walt Disney in the field of character merchandising, in terms of which licences were granted to various manufacturers to use characters like Mickey Mouse and Donald Duck to market their products.

At the height of my involvement with Walt Disney, their character merchandising representative in South Africa, Michael Bennett – who also played a role in Walt Disney's film business in South Africa – passed away. I had enjoyed a good relationship with him. His successor, for reasons I have never been able to fathom, didn't like me or my firm. This eventually led to the parent Walt Disney company deciding to move their legal representation to Adams & Adams, a competitor intellectual property law firm. My efforts to get an explanation for this move came to nought and we parted company on a somewhat strained basis. I nevertheless continued to represent the MPAA and many of its members, so indirectly I retained some connections with Walt Disney.

My relationship with the entertainment industry, and more particularly with the MPAA and the record industry, as well as my reputation as a copyright specialist,

played an important role in Gallo approaching me for an opinion on the *Mbube* matter. That I had acted for Gallo over many years was also significant.

In retrospect, starting with the somewhat bizarre circumstances of my arriving in the specialist practice of intellectual property law and progressing through the development of my copyright career in acting for the film industry, the record industry and Gallo, a chain of events took place that led to Gallo asking me for an opinion on the copyright in the song *Mbube*. It is possible to interpret this sequence of events as preparation for the *Mbube* case, and to this case being an inevitable consequence. The track my train had been running on for some 58 years had brought me to *The Lion Sleeps Tonight*.



The master plan

When I greeted Geoff Paynter at reception at Spoor & Fisher that day in September 2002, I saw that he wasn't alone; he had a whole posse with him. Ivor Haarberger was a senior executive at Gallo; Hanro Friedrich was the attorney who had been representing the Linda family; Rian Malan was the author of the contentious article in *Rolling Stone*; and the final member of the team was Paul Jenkins. I knew Jenkins by reputation. For many years he had been a partner of the prominent attorneys firm, Webber Wentzel, making entertainment and media matters a speciality. I had read that he had retired from legal practice and entered the corporate environment as an executive at Johnnic Entertainment, a member of the Gallo Group. I was surprised to receive such a large delegation.

Jenkins was the spokesman. He said that, after careful consideration of my opinion and consulting all other interested parties, particularly Hanro Friedrich and Rian Malan, it had been decided that all the parties would come together in a joint endeavour to further the interests of the Linda heirs in connection with *Mbube.* And they would be briefing me to take up the legal case.

Jenkins said Gallo would bear all the costs of the legal action and no expense was to be spared. I must take whatever steps necessary to make the Linda family's rights in the song *Mbube* prevail. I was to achieve recognition of these rights with a view to generating income from royalties for them from the use of *Mbube* and its derivatives, particularly *The Lion Sleeps Tonight.* I could count on the support and assistance of all the interested parties.

We felt the best way of demonstrating the existence of the family's rights to the world at large would be to conduct a test case in which a court ruling should say the family owned the copyright in *Mbube* and was thus entitled to control the use of *The Lion Sleeps Tonight.* The purpose of a test case is to use an actual dispute as a means of getting a court ruling that supports your chosen principle.

Our general view was that the interests of the family would be best served by conducting a prominent copyright infringement case against a high profile defendant who was using *The Lion Sleeps Tonight* without the authority of the family in a country where it owned the copyright in *Mbube* – in other words, a country that was

a former member of the British Empire or Commonwealth. The choice narrowed down to Walt Disney, which was then producing in London the musical show *The Lion King*,which incorporates the song *The Lion Sleeps Tonight*. Disney and the way it used *The Lion Sleeps Tonight* made it a very suitable candidate for a test case. I was instructed to prepare to conduct copyright infringement litigation against Walt Disney in the United Kingdom.

As a legal practitioner this was a marvellous opportunity for me. I was given carte blanche to bring a major copyright infringement case on sound grounds, in a legal forum that was literally on the world stage. It had all the makings of being the high point of my legal career and I was excited by the prospect.

Developing a case

My first thought was that Gallo should be the claimant or plaintiff. This would need them to take assignment of the family's rights in the song *Mbube* from them. But Jenkins was adamant that Gallo wanted to remain in the background and not be the protagonist in the case. The family must be the plaintiff. But there was a problem because Regina Linda and the Linda children had signed away their rights in the past.

The nature of copyright, as an asset, is unusual because under copyright law you can enter into a present day assignment of future copyright. This means the author of a prospective work can assign his copyright in that work to, for instance, a publisher, even before pen is put to paper. When the work comes into existence, the copyright is immediately transferred to the assignee, or in our example, the publisher.

The same principle applies where someone enters into a present assignment of copyright that he doesn't currently hold, but may acquire in the future. In this situation, as soon as that person acquires the copyright, his assignment is activated and the copyright automatically passes to his assignee. This is what happened in the case of Regina and the Linda children. The effect of the assignments they executed would be that, once copyright in *Mbube* became vested in them, those assignments would be activated and immediately deprive them of their copyright in favour of the assignees. So in this case it would be fatal to create a situation where the copyright would revert to any member of the Linda family.

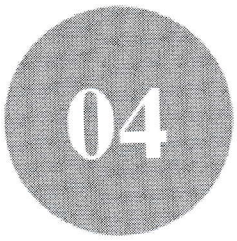
We talked loosely of the 'author's heirs' becoming the recipient of the reversionary interest in the copyright of *Mbube*. But that was a simplification and it wasn't what the relevant section of the Imperial Copyright Act actually said. What it said was that the reverted copyright would pass to the deceased's 'legal personal representative as part of his estate'. This provision had never been interpreted by any court, but I took it to mean that the reverted copyright would pass to the executor in the deceased author's estate. What the law then contemplates is that in due course the executor will transfer the copyright to the heirs or some other party they nominate. Using this in-

terpretation we decided to proceed on the assumption that the executor of Solomon Linda's estate was the holder of the transferred copyright and that the proceedings should be instituted by that executor in his representative capacity.

Of course this meant I would have to get an executor appointed in the estate of Solomon Linda and instruct British solicitors to prepare a copyright infringement case against Walt Disney in the UK High Court. I was comforted that I would be able to call on the support of Hanro Friedrich and Rian Malan who had a close relationship with the Linda heirs and a good knowledge of the factual background. We promised to stay in close contact.

All this was easier said than done because it meant appointing an executor in the estate of a black person who had died in 1962, some 40 years earlier!

Nevertheless, I was excited. This case would effectively make new law both in South Africa and internationally. Although there had been a handful of cases in the United Kingdom dealing with interpretation of the relevant provision of the Imperial Copyright Act, none of those cases had approached the matter from the same angle that we were going to. I was gratified that Gallo was at last taking up the challenge in a responsible manner.



Mastering the plan

The year following that meeting – the one that gave me the go-ahead to prepare a case against Walt Disney in the United Kingdom – was a long and frustrating one fraught with problems in preparing the groundwork for the case.

I lined up Clive Thorne of the British firm, Denton Wilde Sapte, to act on behalf of the executor of the Linda estate in bringing the court case. I knew him as a competent and knowledgeable solicitor, particularly in UK copyright and entertainment law matters. I outlined the course of action to him and he agreed with my view of the law and the approach I had adopted. He was poised to prepare the papers to start proceedings. Retaining his services had been the easy part.

The difficulties came in appointing an executor, and the case couldn't get off the ground until this appointment had been made. Until there was an executor there was no plaintiff to bring the proceedings. I called on the assistance of my colleague, Herman Blignaut, to look after this aspect of the project with me.

Solomon Linda lived and died in Johannesburg. This brought him within the jurisdiction of the Transvaal Provincial Division of the Supreme Court. The Master of this division of the court is responsible for winding up estates in the jurisdiction of the court. We told him we needed to appoint an executor to deal with a previously unknown asset of an estate dating from 1962 and asked his advice on how to proceed. He said at that time the estates of blacks living in Johannesburg were the responsibility of the Magistrate of Johannesburg, so Solomon Linda's estate would have been wound up under his jurisdiction. Before we could do anything else, we needed to trace the file dealing with that estate. The matter was complicated because the legislation that had existed in 1962, being considered Apartheid legislation, had since been repealed and new legislation had been put in place.

Herman paid a visit to the Magistrate in Johannesburg and outlined the circumstances of the case. The matter was foreign to him because jurisdiction for winding up estates had long since been removed from magistrates. Nevertheless, he promised to search the records at his office to see if he could find a file relating to Solomon Linda's estate.

He found no trace of any such file, but suggested it was possible that files dating from 1962 had been transferred to the State Archives. Herman examined the records at the State Archives and, to our surprise, found a file dealing with Solomon Linda's estate. It showed Linda had died intestate and the sum total of his assets at the time of his death was a bank account with R150. This had been passed to his intestate heirs, the estate had been wound up and the file closed.

We took the Linda estate file to the Magistrate of Johannesburg, who begrudgingly accepted that it was his task to appoint an executor to deal with the newly discovered asset and oversee its proper disposal. This process consumed many months but eventually Hugh Melamdowitz, a partner of Spoor & Fisher, was formally appointed as executor and he would serve as the plaintiff in the court proceedings.

In the meantime I met with the three surviving Linda children, Elizabeth, Fildah and Delphi, to explain what was taking place. One of the four children, Adelaide, had recently died of Aids, at least partially brought about by their impoverishment. My meetings with them were arranged by Hanro Friedrich who had a close relationship with them. They listened to what I had to say with some scepticism because many similar promises of gaining an income for them from the use of *Mbube* had been made in the past and all had come to nought. Their expectations had been raised on several occasions, only to be dashed. They had no reason to believe my project would be any different. I promised them that this time we would be successful.

For reassurance that we were on the right track about the law of succession, in particular relating to blacks, I consulted with an expert in the law of succession and an expert in traditional African laws. Nothing I learned from them changed my view.

Bombshell forces a new direction

Now that we were at last in a state of readiness to move forward with launching the case in the name of the executor, I had another consultation with Paul Jenkins. It was 22 April 2004. The aim was to bring him up to date with all that had been achieved during the past several months and get his go ahead to launch the litigation in the United Kingdom.

I was sitting across the table from him when he dropped a bombshell. Gallo had decided to drop the project, withdraw from it completely. They were willing to provide funding to cover all costs to date, but as far as they were concerned, the matter should be shelved and they would have no further part of it.

I was shattered. I had been working on this matter for more than three years and just when we were ready to put our carefully laid plan into action, Gallo aborted it.

Jenkins explained that the group of companies Gallo was part of, particularly Nu Metro, were the South African licensees of Walt Disney. From a business point of view they couldn't be involved in an adversarial situation with their own licensor. He

didn't explain why this hadn't been an issue many months before when he himself had suggested Walt Disney should be the target for the test case.

What should have been a triumphant meeting – because at last we had appointed an executor and opened the way for our plan to be put into action – was now a debacle. My earlier suspicion returned. Had Gallo intended this matter go to litigation or had they banked all along on it not being feasible to reopen the estate and appoint an executor? Whatever the case, the project appeared doomed to be consigned to the scrap heap.

But I wasn't prepared to have it end here. Too much effort, money and emotional capital had been invested for me just to drop it. Mindful of the promise I had made to the Linda daughters, I told Jenkins I was going ahead with the project, with or without Gallo. I would find someone else to fund the costs of the litigation and we would pursue the project to its conclusion.

I took stock. It simply wasn't going to be possible to go ahead with litigation against Walt Disney in the United Kingdom; the cost burden was too heavy. The theatre of action would have to be South Africa where we could better manage costs and where I hoped key role players could be persuaded to act pro bono.

I told Jenkins that I now proposed to bring copyright infringement proceedings against Walt Disney in South Africa, before the Transvaal Provincial Division of the Supreme Court, but that other parties would have to be added as co-defendants. Unlike in the United Kingdom – where Walt Disney was actually undertaking the production of the stage show and thus directly perpetrating infringing conduct – in South Africa it had at best collaborated with other parties in those parties making unauthorised use of *The Lion Sleeps Tonight*. This had been by authorising or licensing others to distribute the film version of *The Lion King* in the home entertainment market and in cinemas. In other words, Walt Disney was a contributory infringer along with those who were responsible for reproducing and distributing copies of the film *The Lion King* in South Africa.

He assured me that the project's continuation enjoyed the tacit and moral support of Gallo, even though it would no longer play an active role. This was important, because one of the co-defendants would have to be Nu Metro, as the distributor of *The Lion King* in South Africa. He understood why Nu Metro had to be added as a formal defendant in the proceedings, whereas Walt Disney would be the true defendant, and promised to explain the situation to Nu Metro. He assured me there would be no problem with this.

Plan B gets off the ground

I had to think carefully how I should proceed in the light of this shattering development. There was no longer anyone to pay the bills. I was on my own, out on a limb,

along with Hanro Friedrich. I didn't really even have a client since the Linda children had played no active role at all and Hanro Friedrich and Rian Malan had been mainly interested bystanders. But I was determined not to dash the hopes of the Linda children yet again if I could possibly help it.

Forced to abandon Plan A but determined to persevere with the project, I now had to implement Plan B.

The departure point was that Walt Disney would be sued for copyright infringement in South Africa, as a contributory infringer. Nu Metro – and possibly others – would be joined in the proceedings as the theoretical principal infringers, though their involvement would be somewhat nominal. Since Walt Disney Enterprises, the American company in question, had no presence in South Africa and wasn't actually trading here, I also had to proceed against South African-based entities who were trading in South Africa and had used the song *The Lion Sleeps Tonight* in the sense that it was part of films, videos and music CDs they had been selling. You can't have a contributory infringer without a principal infringer.

There were two major problems in putting together plan B. In the first place, we needed funding for the litigation; without it, it wasn't feasible to continue. The second problem was that the South African court doesn't have automatic jurisdiction over a foreign-based corporation that has no presence in South Africa and is not itself trading here. Although Walt Disney had acted through licensees and agents in this country, this didn't give the South African court jurisdiction over it.

Another problem was that I no longer had an instructing client. Although the Linda family would be the beneficiaries of successful litigation, they weren't my client; Gallo was. We could tackle this by enhancing the role of Hanro Friedrich, the family's attorney, from that of interested bystander and assistant to the status of 'client'. But this might have been more form than substance. In practice, I would largely be instructing myself.

There was a way around the jurisdictional problem. The law said the South African court could obtain jurisdiction against a foreign corporation in a monetary claim if that corporation had property based in South Africa and that property was 'attached' to provide security for the execution of any monetary and/or costs award made against that corporation. 'Attachment' involves obtaining a sort of 'pledge' over the property in question. You need to apply to the court for an order for that specified property to be attached for the purposes of founding jurisdiction against its owner.

A search in the Register of Trademarks showed that Walt Disney owned around 250 registered trademarks in South Africa, including marks such as Donald Duck, Mickey Mouse and Disney itself. The Trademarks Act made provision for trademarks to be attached as security, so the way forward was to apply to court asking for the attachment of all of Walt Disney's registered trademarks in South Africa. If the order was granted, the jurisdictional problem would be solved.

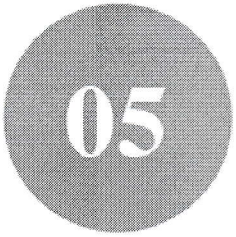
The solution to the funding problem was less obvious. The most likely source of funding would be a major South African corporation that would see the cause as worthwhile and, largely for reasons of altruism, be prepared to put up the money needed. I earmarked certain of Spoor & Fisher's major corporate clients as possible benefactors.

I thought I'd have a better prospect of finding a funder if I could approach possible candidates with something concrete – in other words, a project that was already in existence – rather than with what might appear to be a speculative idea. I decided to launch the proceedings against Walt Disney first and only then, armed with an actual court case in progress, approach possible funders.

This was a bold and risky venture because once litigation began there was a potential liability for payment of the other side's legal costs if the litigation was aborted or unsuccessful. I would, of course, be acting on behalf of the executor of an estate with no assets (other than those to be realised by the outcome of the litigation) and the executor would be acting in a representative capacity and therefore not personally liable for paying the other side's costs. Nevertheless, there was always the risk that a powerful and successful defendant could find some way to get satisfaction for its claim for costs by holding the parties involved, such as the executor or the attorneys, personally liable for the costs. I was therefore taking a gamble.

In the changed circumstances, I considered it inappropriate for a partner of Spoor & Fisher to act as executor and decided to change to an independent outsider. I approached Stephanus (Fanie) Griesel, a chartered accountant who had done auditing work for Spoor & Fisher but was no longer the firm's formal accountant. He accepted the appointment despite the risks and the prospect that he might never receive payment for his services.

Next, I needed to secure the services of advocates to act for the executor. I approached Cedric Puckrin SC, who had handled most of my litigation for many years, and Reinhard Michau, who had been my articled clerk and assistant at Spoor & Fisher before he went to the bar and became an advocate. I explained the case and asked if they would be willing to act for nothing, or at least on a contingency basis (which is permissible in terms of the bar rules). They agreed to a contingency, which meant that they would charge no fees unless and until the matter was successful, in which case they would be paid out of the proceeds of the court case. The measure of the payment in terms of the bar rules would be an amount equal to double their normal charges. It would place a considerable financial burden on the funder and/or the estate, but I had no choice.



The lion and the mouse

To put Plan B into action we applied to the court for an order attaching Walt Disney's registered trademarks. This kind of application required us to disclose all the circumstances of the case and make a *prima facie* or provisional case that the claim would be successful. If the order was granted, we would issue a summons, accompanied by the particulars of the claim, setting out the executor's entire case. We prepared the particulars of our claim for launching the action and attached it to the application, in which we provided further explanations. An application of this nature is brought *ex parte* – in other words, no notice is given to the potential defendant(s). The defendants in the action would be Disney Enterprises Inc, David Gresham Entertainment Group/David Gresham Records (Disney's South African agents relating to the commercial exploitation of their works) and Nu Metro Home Entertainment (the exclusive distributors of their films in South Africa). In our papers we outlined how Griesel came to be the current owner of the copyright in *Mbube*. We also showed that, directly or indirectly, Gresham and Nu Metro had commercially exploited *The Lion Sleeps Tonight* in South Africa without appropriate authority. We claimed that Disney caused, or aided and abetted Gresham and Nu Metro in perpetrating infringements of copyright by licensing them to conduct commercial activities.

The attachment order was granted on 29 July 2004 and we served the documents on Walt Disney in Los Angeles. The die had been cast. At the time I couldn't help thinking of Mark Antony's speech at the funeral of Julius Caesar in Shakespeare's play of that name: 'Now let it work. Mischief, thou art afoot, take thou what course thou wilt.'

Retribution came quickly and viciously. A few days later I attended a routine meeting of the board of SAFACT, the South African representative of the Motion Picture Association (MPA), the name by which the MPAA had now become known. The chairman immediately asked me to leave the meeting because my directorship of SAFACT and all relations with the MPA had been summarily terminated. Disney was a powerful enemy to cross. I also became persona non grata with Nu Metro.

I tried to explain to the MPA that my firm wasn't Disney's attorneys because they had (rudely) discharged us some years earlier, and indeed I had previously acted

against them in certain trademark matters. I had no doubt there was no conflict of interest in my acting against Disney; we had no confidential information about them that was relevant to this case or compromised us. This case had nothing to do with video piracy, which was my area of involvement with the MPA and its members, so there was no ethical reason why I couldn't act against Disney. Anyway, Disney was just one of several members of the MPA and the case didn't involve this organisation. It was to no avail. The guillotine fell.

In the case of Nu Metro, I pointed out that adding it as a defendant had been in consultation with Paul Jenkins, who had promised the group's moral support. I suggested they discuss the matter with him so it might be seen in its proper perspective; it was not in essence an unfriendly act. I don't know if it was ever discussed with Jenkins, or what he said if it was, but my pleas had no effect. I felt betrayed.

Still, I had confidence in our case. I believed it was sound in law and pursued a noble cause. Over the years I have found in conducting intellectual property litigation that it is important to maintain the moral high ground. You must try to get the court to want, subjectively, to find in your client's favour. It then becomes a matter of theorising and rationalising the legal principles that can justify a largely subjective viewpoint on the part of the judge. I had no doubt that we had the moral high ground, particularly before a South African court. This confidence gave me fortitude in dealing with the problems that beset me.

In a claim for damages before a South African court, the court can only award damages suffered in South Africa. Damages suffered in other countries are irrelevant. Although the family, or more correctly the executor, owned the copyright in *Mbube* in some 50 countries – and potentially had a damages claim in all of those countries – our litigation could only deal with the South African damages. These were paltry compared to the total sum of international damages that were claimable in principle. While it was possible to institute similar proceedings in all of the 50 countries, it was clearly unfeasible.

The South African case was the one shot we had to achieve the goal of getting meaningful income for the Linda family from the exploitation of *The Lion Sleeps Tonight*. There had to be a way to use the South African case to negotiate an international settlement. The amount of damages claimable in South Africa alone was never going to be a big enough inducement to bring such a settlement about.

Fighting on two fronts

The moral virtues of our case, which gave us the high ground in the South African litigation, were a powerful weapon. I was convinced the battle against Disney should be fought on two fronts, the legal front and the propaganda front. There was a good prospect of making headway in the battle on the propaganda front, which entailed

creating bad publicity for Disney (with its wholesome family image) because it was gaining a fortune at the expense of a poverty-stricken African family by exploiting a work that was properly owned by the African family. I decided that while the legal case was the foundation, propaganda was the best battle ground.

So I embarked on a concerted publicity campaign, not only in South Africa, but internationally. It turned out to be very successful and the story of the case spread like wildfire in the local and international media. *The Times* of London took up the cause, as did various American newspapers. It was featured on the CNN and BBC World television programmes. In South Africa I conducted numerous press, television and radio interviews. Disney was portrayed in an unfavourable light.

Ironically, the attachment of Disney's registered trademarks was what the media seized on as particularly newsworthy. This was epitomised by a cartoon that appeared in an American newspaper; it showed Mickey Mouse behind bars in the tower of a castle, with a by-line to the effect that Mickey was being held hostage in South Africa. The propaganda assault achieved considerable momentum and success.

Finding a funder

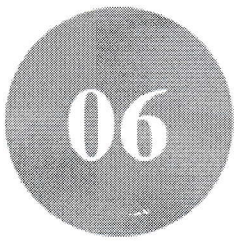
With the case underway, it was essential to resolve the funding issue – and speedily. We were out on a limb and playing a risky game. I put out feelers to some of Spoor & Fisher's major corporate clients. While they expressed interest and appreciation for the cause, there were no signs that funding was likely to be forthcoming.

Then Hanro Friedrich told me he'd had a chance encounter with Minister of Arts and Culture Pallo Jordan at an airport and briefly mentioned the case to him. Minister Jordan had shown some interest, in the context of his portfolio. I decided to take the bull by the horns. Through my contacts in entertainment and cultural circles, I got an appointment with the director-general of Arts and Culture and his senior officials.

Friedrich and I went together and told them about the case, gave them copies of the court papers and suggested there was a case to be made for the Department to fund the litigation. We argued that the outcome would be beneficial to a very needy South African family whose forebear was a South African cultural icon. It would result in the South African roots of *The Lion Sleeps Tonight* being made public knowledge throughout the world, which would be a boost for South African culture. It would show that the law provided redress for disadvantaged South African authors, composers, artists and the like, who had been held back in the dark days of political oppression by their poor bargaining position against powerful companies in the entertainment and cultural spheres. It came as an enormous relief when the department agreed to fund the litigation.

But my euphoria was soon dispelled by a telephone call from a somewhat unsettled Fanie Griesel, who said a court application made by Walt Disney Enterprises had been served on him in his capacity as the executor.

A new chapter in the saga was about to unfold.



The law of the jungle

It was cold and dark when I got out of bed in our chalet at the Madikwe Game Reserve on 7 September 2004. My wife Dana and I were about to go on an early morning game drive.

Around a month had passed since Walt Disney had launched its counter-application against Griesel in court. The matter had been heard in court and we were waiting for judgment. It had been a physically and mentally taxing time and I had withdrawn to the bush to recharge my batteries and regain my equilibrium. There is no better way to do this than to commune with nature.

Walt Disney, through its attorneys Adams & Adams – Spoor & Fisher's main competitor for the leading intellectual property attorneys in the country – had brought a High Court application against the executor, seeking to set aside the attachment of its trademarks. It had also applied to compel Spoor & Fisher to pay the costs of the proceedings, an unconventional and punitive measure intended to censure a firm of attorneys for bringing frivolous or improper litigation.

This wasn't the first time in my career that Adams & Adams had played the man and not the ball. Once, when I brought a copyright infringement action against a prominent academic, alleging that he had plagiarised a text book, Adams & Adams' client had launched a defamation action against me personally. It was on the grounds that as the attorney I had drafted the founding affidavit in the copyright infringement case which had alleged that their client had deliberately copied an earlier work. (I might mention that this is an essential and standard statement in making out a copyright infringement claim). So much for collegiality in the intellectual property legal profession!

Now Walt Disney had gone on the offensive; the lion king had bared its fangs and claws.

There followed a hectic period of exchanging affidavits, preparing for the hearing and eventually having the matter heard in the High Court. A procedure that normally takes three to six months was compressed into a few short weeks.

The goal in having the court set aside the attachment of the trademarks was to remove the basis on which the court could exercise jurisdiction over Disney. This

would have been the end of the matter in the court. To succeed, Disney had to persuade the court that, for reasons outlined in its application, the order granting the attachment of the trademarks was wrongly made.

Disney's application was based on three main points. First, that Griesel, claiming to act as executor of Solomon Linda's estate, had no legal standing to bring the copyright infringement case; second, that the executor had made an incomplete disclosure of all the relevant facts and circumstances in his affidavit supporting the attachment application; and third, that Disney hadn't caused, authorised or aided and abetted the alleged infringement by Gresham and Nu Metro and was therefore not a contributory infringer.

It was interesting that no challenge was made to the claim that the reverted copyright had vested broadly speaking in Linda's heirs or that the conduct of Gresham and Nu Metro was indeed an infringement of copyright. These two issues were the real meat of the case.

Once I got over the initial shock of Disney's counter-application, I realised it was for the best because it meant the legal dispute between the parties would be resolved almost immediately, without having to go through the time-consuming and expensive process of a trial, which would probably only have taken place some two years later.

Going head to head with Disney

I was prepared to meet Disney's challenge head on.

The wording of Section 5(3) of the Imperial Copyright Act stated that the reversionary interest passed to the 'personal representative' of the deceased author. This was, of course, British legislation that had been adopted holus-bolus into our law and it needed to be interpreted in conformity with our law in general. I concluded that the term 'personal representative' of the deceased meant the 'executor' of a South African deceased estate. Disney challenged this interpretation and argued that Griesel ought in any event to have been appointed by the Master of the Supreme Court, not the Magistrate of Johannesburg. We countered that the British legislation must be adapted to suit South African circumstances and that the executor of the estate was the envisaged role player. Griesel's appointment as executor by the Magistrate of Johannesburg was valid because we followed directions from the Master of the Supreme Court, and could be justified on the basis of a proper analysis of the applicable law, which we presented to the court.

Disney's point about incomplete disclosure of all the relevant facts referred to our failure to deal with the assignments of copyright that Regina and the Linda children had entered into in 1990 and 1992. It was true that we made no mention of these assignments – for the simple reason that they were irrelevant. Since the reverted copy-

right would only have belonged to either Regina or the daughters when and if it was transferred to them by the executor – and this could only occur after the executor wound up the estate, which hadn't happened yet – these weren't relevant to the executor's title to the copyright.

We refuted Disney's arguments that it hadn't authorised or aided and abetted Gresham's and Nu Metro's infringing conduct by analysing the licence agreements Disney had entered into with these companies. They contained clauses relating to advertising, quality of product, and so forth, which Disney insisted licensees must observe, as well as clauses laying down performance standards. On the strength of these agreements, we argued, it was clear that Disney had played an active role in aiding and abetting, if not causing, the infringing conduct.

I was optimistic that we would succeed and the order Disney wanted would be refused. But, on the strength of many years of experience with High Court litigation, I knew that impressions count for nothing; the court's attitude could only be learnt from the judgment when it was handed down, and not until then.

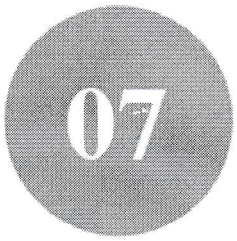
This had been a very stressful time for me. I had put my reputation and career on the line in going ahead with this case, and the court may make a punitive costs award against my firm. That wouldn't go down well with my partners, even apart from the financial outlay they would have had to make to settle the cost claim. I had also been fired by two major clients.

Not surprising, then, that I had headed for the bush.

So there we were on a game drive at Madikwe and we came across a pack of wild dogs hunting an impala. The dogs drove the impala into a thicket and although we could see nothing, the impala's screams and the dogs' howls left us in no doubt about the outcome. I had considerable sympathy for the impala; I knew how it felt.

Then my cell phone buzzed as a text message came in: judgment had been handed down in the Disney case. Disney's application, including the demand that Spoor & Fisher should pay the costs of the application, had been dismissed.

Round one to us, but there were other rounds were to come. I prepared mentally to re-enter the fray and deliver what I hoped would be a knock-out blow.



The law of the jungle

Eighteen months later the battle with Disney was over. We had won and we were holding a press conference on 15 February 2006 to make this announcement and give the media brief details of the settlement that had been reached with Walt Disney.

Appearing at the press conference were Hanro Friedrich, the Linda children, Rian Malan and me. I had asked the Department of Arts and Culture to send a representative to the media conference, but at the eleventh hour they declined and also asked me to withhold all information about the identity of the funder of the litigation.

I found this puzzling. Their initial reaction to my invitation had been that they were only too happy to announce to the world their role in this notable victory. However, by the nature of this very strange case and what had gone before, I had learned not to be surprised about anything and I simply accepted their wishes. It was not for me to reason why.

I was thinking through what and how much I should tell the media. The outcome of Disney's application to set aside the attachment had really been the climax. After that, we and the defendants had gone through the motions of following procedure for the damages action. We had exchanged pleadings, made discovery of all relevant documentation, and attended the pre-trial conference between the parties a few weeks before the trial was due to begin.

One noteworthy point had arisen during the exchange of pleadings: Disney had claimed *Mbube* was not an original work, but a traditional song Solomon Linda had simply adopted. As such it enjoyed no copyright.

This point had merit if the facts showed the song was indeed a traditional Zulu song. It had been described in some of the documentation as traditional, so I consulted with an authoritative Zulu musicologist, who said it was not a traditional song and had indeed been composed by Solomon Linda. What had happened was that the popularity and success of the song had spawned a new genre of music among the Zulu people and many other similar songs were subsequently composed. This genre of music became known as Mbube music. The musicologist had agreed to give expert evidence to this effect at the trial.

This evidence had put paid to Disney's point.

Not unexpectedly, when the lawyers met for the pre-trial conference, the question of a settlement had been broached. Indeed, the case cried out for a settlement. After negotiations lasting a few days, a settlement agreement had been signed.

In the time leading up to the settlement we discovered that Disney had approached and obtained a licence from a company in the United States called Abilene to use the song *The Lion Sleeps Tonight* in *The Lion King* production. Abilene is the alter ego of George Weiss, one of the purported composers of *The Lion Sleeps Tonight*. It owns the copyright in, and controls the use of, *The Lion Sleeps Tonight*. In granting a licence to Disney to use the song, it had declared that it held the rights to the song and had given an indemnity to Disney for any claims that might be made against it by third parties arising out of the use of the song.

This meant that the real defendant in the copyright infringement claim, although not a party before the court, was Abilene. Disney was simply its surrogate. Disney brought pressure to bear on Abilene to be a party to the settlement of agreement and it was Abilene instead of Disney that met many of our settlement requirements.

I had some sympathy for Disney because it had probably acted in good faith in incorporating *The Lion Sleeps Tonight* in *The Lion King*, and had done everything that reasonably could have been expected in getting appropriate authorisation to use it in the production. They were not to know that their licensor didn't in fact hold the rights to license it. My sympathy was, however, tempered by the vindictive manner in which they went about conducting the case.

The settlement

It was of enormous significance that Abilene was brought into the settlement. The basis of the settlement was that the executor would withdraw the action and each party would be responsible for its own costs. Disney and Abilene acknowledged that Solomon Linda was the original composer of what became *The Lion Sleeps Tonight* and he would be acknowledged as a composer in all further notifications about the song. The executor granted a full licence to Abilene and its licensees to use *Mbube/ The Lion Sleeps Tonight,* subject to the payment of a royalty. Abilene had to make a lump-sum payment to the executor to cover past unauthorised uses of the song until the expiry of the copyright in *Mbube.* A trust was established to take up ownership of the copyright in *Mbube* and to receive and distribute all payments to the heirs. (Remember, it was important that Linda's daughters should never own the copyright, otherwise their copyright assignment to Folkways would immediately take effect.)

Most importantly, the settlement and in particular the obligation to pay royalties was to operate worldwide. The significance of this last term can't be overemphasised. The litigation related only to payment of damages in South Africa and at best the ex-

ecutor could only ever claim damages and royalties for uses of *The Lion Sleeps Tonight* in countries that were members of the former British Empire and Commonwealth. The executor had no rights in respect of *Mbube* and *The Lion Sleeps Tonight* in any other countries. But the settlement brought a flow of royalties to the Linda family for the use of *The Lion Sleeps Tonight* even in countries where they had no rights.

This outcome exceeded my wildest dreams.

At the press conference of 15 February 2006, there was considerable interest from the media, both national and international. The media had followed developments closely and given prominence to them all along. This interest was heightened by the successful outcome for the Linda family. I have no doubt that the amount of publicity the case generated worldwide – and the adverse nature of this publicity – had been the single most important consideration leading Disney to settle. Another strong consideration on Disney's part had been its anger that its registered trademarks had been placed under attachment, and its desire to release that attachment. Ironically, the merits of the actual copyright infringement case were relatively unimportant.

The press conference went off well even though the media were disappointed that I couldn't disclose the amount of the settlement paid by Disney/Abilene for past infringements; it was a term of the settlement agreement that the figure should remain confidential. I also had to tell them that the funder of the litigation wanted to remain anonymous. (The Department of Arts and Culture later relented and made the announcement itself in parliament.)

The press conference marked the end of what was really a rags-to-riches fairy tale. The Linda family would be receiving ongoing payments of considerable sums of money. The lion had been aroused from its long hibernation and shown its true South African colours. The advocates received payment that was double their normal fee. Fanie Griesel, Hanro Friedrich and Spoor & Fisher received payment in accordance with their standard fee structures. I was content (and relieved) that I had successfully conducted a landmark piece of litigation. In true fairy tale fashion, the victors ought to live happily ever after.

Synopsis

The story of the copyright saga that made international news headlines. In the Apartheid era, Solomon Linda, an impoverished black composer, was convinced to sign away his rights to what became the world-renowned song *The Lion Sleeps Tonight*. Copyright expert Owen Dean tells the story of his role in the saga to get recognition and reparation from international for the Linda family from the widespread use of this song.

About the Author

Owen H Dean is Professor of Intellectual Property Law at Stellenbosch University. He was previously a senior partner, now a consultant, of leading intellectual property attorneys Spoor & Fisher. His areas of specialisation include trademark and copyright law. He served on the government's Advisory Committee on Intellectual Property Law for twenty years and as Chairman of the Copyright Sub-Committee of that Committee. A past president of the South African Institute of Intellectual Property Law, he has written a number of books and journal articles. He is a frequent speaker on intellectual property matters at seminars and conferences.