

A. Vivian Mansell - - - - - *Appellant*

*v.*

The Star Printing and Publishing Company of Toronto,  
Limited - - - - - *Respondents*

FROM

THE COURT OF APPEAL FOR ONTARIO

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JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF  
THE PRIVY COUNCIL, DELIVERED THE 28TH JULY, 1937.

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*Present at the Hearing :*

LORD ATKIN.  
LORD MACMILLAN.  
LORD WRIGHT.  
LORD ALNESS.  
LORD MAUGHAM.

[*Delivered by* LORD MACMILLAN.]

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The plaintiff in these proceedings (now the appellant) is a publisher of fine art colour prints who resides in England and does business throughout the world. He complains that between the months of March and July, 1932, the respondents in infringement of his rights published in Toronto, in the illustrated section of a newspaper owned by them and known as the "Star Weekly", a number of pictures of which he claims to be entitled to the copyright. The action related originally to thirty-eight pictures. In the course of the proceedings the appellant abandoned his claim to four of the pictures and as regards three of them, which were painted after the Canadian Copyright Act, 1921, came into operation on 1st January, 1924, the trial Judge (Rose, C.J.) held that the appellant was entitled to copyright and awarded him \$600 damages for infringement. As regards the remaining thirty-one pictures, all of which were painted before 1st January, 1924, the trial Judge held that the appellant had no copyright in them in Canada and was consequently not entitled to any remedy against the respondents. This judgment was affirmed by the Court of Appeal for Ontario. The appellant says in his printed case that the appeal was dismissed "without reasons" and the respondents say that the Court of Appeal "gave no written reasons" It appears, however, from a newspaper report of the case which was supplied to their Lordships that the learned Judges of the Court of Appeal in disposing of the case gave expression to their views on the questions raised and their Lordships regret that no official record of these opinions has been made available to them, notwithstanding

the requirement of Rule 16 of the Judicial Committee Rules, 1925.

The only question between the parties at their Lordships' bar was whether the appellant was entitled to copyright in Canada in the thirty-one pictures painted or "made" before 1st January, 1924. The appellant maintained that he was so entitled in virtue either of (1) the Canadian Copyright Act, or (2) the Imperial Copyright Act of 1911.

1. The Canadian Copyright Act, 1921, was substantially reproduced in chapter 32 of the Revised Statutes of Canada, 1927, and it is to the latter statute that their Lordships will refer. It being admitted that the pictures in question were "made" before 1st January, 1924, the logical starting point from which to approach the appellant's claim is to be found in subsection 5 of section 42 of the Canadian Copyright Act which enacts as follows:—

"Subject to the provisions of this Act, copyright shall not subsist in any work made before the first day of January one thousand nine hundred and twenty-four otherwise than under and in accordance with the provisions of this section."

The appellant must therefore establish his case under and in accordance with the preceding provisions of section 42. The first subsection reads as follows:—

"Where any person is immediately before the first day of January one thousand nine hundred and twenty-four entitled to any such right in any work as is specified in the first column of the First Schedule to this Act or to any interest in such a right he shall, as from that date be entitled to the substituted right set forth in the second column of that Schedule or to the same interest in such a substituted right, and to no other right or interest, and such substituted right shall subsist for the term for which it would have subsisted if this Act had been in force at the date when the work was made, and the work had been one entitled to copyright thereunder."

The First Schedule, so far as material, is in the following form:—

"Existing Rights

Existing Right.	Substituted Right.
“(a) In the case of Works other than Dramatic and Musical Works.	
Copyright.	Copyright as defined by this Act.
*   *   *   *	

"For the purposes of this Schedule the following expressions where used in the first column thereof have the following meanings:—

“‘Copyright’ in the case of a work which according to the law in force immediately before the commencement of this Act has not been published before that date and statutory copyright wherein depends on publication, includes the right at common law (if any) to restrain publication or other dealing with the work

\*   \*   \*   \*   ”

The definition does not apply to the pictures in question for if "published" means, as their Lordships hold that it does mean, "published anywhere", and not merely "published in Canada", it was admitted that the pictures were published before 1st January, 1924.

Their Lordships observe in the first place that section 42 of the Act is obviously a transitional enactment designed to prevent the loss of rights existing before 1st January, 1924. It achieves this by conferring on those who enjoyed pre-existing rights the substituted rights defined by the new Act. In the next place, it is clear that the pre-existing copyright enjoyed must have been copyright in Canada, for the statute in substituting "copyright as defined by this Act" for the pre-existing copyright is plainly conferring a new Canadian copyright in place of a previous Canadian copyright.

It was strenuously argued that section 42 in dealing with the case of any person "entitled to any such right in any work as is specified in the first column of the First Schedule to this Act or to any interest in such a right" covered the case of a person who was entitled anywhere to copyright or an interest in copyright and in particular the case of the appellant who asserted that he enjoyed in England before 1st January, 1924, copyright or an interest in copyright in the pictures in question. Their Lordships cannot accept this reading. As they have just said, the copyright specified in the first column of the First Schedule must be existing copyright in Canada for it is a new copyright in Canada that is to be substituted for it. Like is to be substituted for like. The matter is put beyond doubt by subsection (2) of section 42 which deals with the case where the author of any work in which "any such right as is specified in the first column of the First Schedule to this Act subsists" on 1st January, 1924, has before that date assigned the right or granted any interest therein for the whole term of the right; in such a case "at the date when but for the passing of this Act the right would have expired", the substituted right conferred by the section is, in the absence of express agreement, to pass to the author of the work and any interest therein created before 1st January, 1924, and then subsisting is to determine, subject to certain qualifying provisions. The "right specified in the first column of the First Schedule" is thus a right having a term which but for the passing of the Act would have expired at a certain date and this term, which the Act prolongs, must plainly be a term prescribed by law in Canada. The date at which but for the passing of the Act of 1921 the right would have expired can be ascertained only from the previous Canadian Act of 1906, R.S.C. c. 70, under which copyright is conferred from the time of recording the copyright.

The result of the foregoing analysis of the relevant provisions of the Canadian Copyright Act is to narrow the critical issue in the present case to the simple question—Was

the appellant immediately before 1st January, 1924, entitled to copyright in Canada in the thirty-one pictures? If so, he must have acquired it under the previous Canadian Copyright Act of 1906. But the appellant never acquired copyright in Canada in the thirty-one pictures under the Act of 1906, for he never complied with the requirements of that Act. The condition for obtaining copyright in Canada under that Act in the case of works of art was prescribed by section 6, viz., "that they shall be produced or reproduced in Canada", and the thirty-one pictures were never produced or reproduced there before 1st January, 1924; nor did the appellant ever record the copyright thereof as required by the Act. As Lord Lindley said in giving the judgment of the Board in *Graves & Co., Ltd., v. Gorrie* [1903] A.C. 496 at p. 500: "Those who want copyright in Canada for paintings drawings and photographs must obtain such copyright by complying with the laws of that country." There was a substantial interval of time between the passing of the Canadian Copyright Act of 1921 and its coming into operation on 1st January, 1924, during which the appellant by compliance with Canadian law could have protected himself but he did not do so. The result is that the appellant's case so far as founded on the present Canadian Copyright Act therefore fails.

2. Turning to the appellant's alternative submission under the Imperial Copyright Act of 1911, their Lordships are of opinion that the appellant can derive no aid from this quarter. The argument assumes that there can be simultaneously subsisting in Canada two independent copyrights, namely, copyright under the Canadian Act and copyright under the Imperial Act. Their Lordships would not readily reach so unlikely and so embarrassing a conclusion. Fortunately it is not necessary to do so. The Imperial Act by section 25 (1) provides that it shall not extend to a self-governing Dominion unless declared by the legislature of that Dominion to be in force therein. The legislature of Canada has never declared that the Imperial Act of 1911 shall be in force therein. On the contrary the Canadian Act of 1921 by section 45 declared that no person should be entitled to copyright otherwise than under and in accordance with the provisions of that Act or of any other statutory enactment for the time being in force; and section 47 enacted that "all the enactments relating to copyright passed by the Parliament of the United Kingdom are so far as they are operative in Canada hereby repealed".

The appellant, however, sought to rely on the second subsection of section 25 of the Imperial Act. Under that subsection the Secretary of State may certify that any self-governing Dominion has passed legislation under which works the authors whereof were at the date of the making of the works British subjects resident elsewhere than in the Dominion or (not being British subjects) were resident in the parts of His Majesty's Dominions to which the Imperial

Act extended, enjoy within the Dominion rights substantially identical with those conferred by the Imperial Act. On the Secretary of State so certifying, as he did in the case of Canada on 6th December, 1923, "then whilst such legislation continues in force the Dominion shall, for the purposes of the rights conferred by this Act, be treated as if it were a Dominion to which this Act extends". The certificate of the Secretary of State did not and could not extend the Imperial Act to Canada. His certificate had merely the effect of bringing into operation the provision that Canada should for the purposes of the rights conferred by the Imperial Act (but for those purposes only) be treated as if it were a Dominion to which the Act extended. The Imperial Act conferred no rights in Canada and it was only for the purposes of the rights conferred by it that Canada was to be treated as if the Act extended to it. This can only mean that although under section 1 a Canadian author writing in Canada would not, when the Imperial Act was passed, have any copyright under the Imperial Act, the effect of the certificate would be that such an author would become a person entitled to "the rights conferred" by the Imperial Act. That is to say, Canadian authors are to have the same rights under the Imperial Act, within the area to which that Act extends, as they would have if the Act extended to Canada, but they have no rights in Canada under the Imperial Act.

As the Imperial Act confers no rights in Canada on the appellant his second contention must share the fate of the first.

Their Lordships will accordingly humbly advise His Majesty that the appeal be dismissed and the judgment of the Court of Appeal of Ontario of 27th January, 1937, be affirmed. The appellant will pay the respondents' costs of the present appeal.



In the Privy Council

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A. VIVIAN MANSELL

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THE STAR PRINTING AND PUBLISHING  
COMPANY OF TORONTO, LIMITED

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DELIVERED BY LORD MACMILLAN

Printed by His Majesty's Stationery Office Press,  
Poocock Street, S.E.1.

1937