

Francis Day & Hunter Limited - - - - *Appellants*

*v.*

Twentieth Century Fox Corporation Limited and others - *Respondents*

FROM

THE SUPREME COURT OF ONTARIO (APPELLATE DIVISION)

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JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF  
THE PRIVY COUNCIL, DELIVERED THE 12TH OCTOBER, 1939

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*Present at the Hearing :*

LORD THANKERTON

LORD RUSSELL OF KILLOWEN

LORD WRIGHT

LORD ROMER

SIR LYMAN POORE DUFF (CHIEF JUSTICE  
OF CANADA)

[*Delivered by LORD WRIGHT*]

In 1892 a song entitled "The Man Who Broke the Bank at Monte Carlo" was published in London. It consisted of three verses, with a chorus and was written and composed by Fred Gilbert. Many people remember the original publication. Both words and music were of the most commonplace character, but the music went with a jaunty swing which gave it great vogue and popularity, especially when performed by Charles Coborn. The song consisting of words and music was duly registered at Stationers Hall in London and acquired copyright under the Copyright Act of 1842. But the performing right was not acquired, because of the failure to comply with the conditions imposed by the English Copyright (Musical Compositions) Act, 1882, which required that the proprietor of the copyright if he desired to acquire and retain the right of public representation or performance should print upon the title page of every published copy a notice to the effect that the right of public representation or performance was reserved.

In the song the singer recounts how he went to Monte Carlo to raise his winter's rent, but was so successful at the tables that he had lots of money, went to Paris, and swaggered about as a millionaire. The words of the title are repeated at the end of the chorus.

Gilbert, the writer and composer died intestate in 1903. Under the then existing law in England the copyright would have expired in 1934, but under the Copyright Act, 1911, the period was changed into one of 50 years from the authors

death, that is until 1953. For the residue of this extended period, that is from 1934 to 1953 the copyright vested not in the assignees of the right but in the author or his personal representatives. In the present case these were two daughters. One of these in 1935 transferred one half of her right to the appellant company, whose title so far as it goes is not questioned in these proceedings.

Sometime about 1935 there was exhibited in various theatres in Canada a motion picture entitled "The Man Who Broke the Bank at Monte Carlo." The plot of that picture was based on a comedy in three acts by Ilia Surgutchoff and F. A. Swann entitled "The Gamble," but also at different times called "The Man Who Broke the Bank at Monte Carlo," "Le Jeu" and by other titles. The motion picture represented the plot of the comedy, which consisted of the story of an exiled Russian Prince, working as a taxi driver in Paris, who went to Monte Carlo to try his luck with money subscribed by his compatriots in Paris. He had a wonderful run of luck. Then followed an elaborate story of his love affair with a woman. He went back to Monte Carlo, was unsuccessful and lost all his money. He suspected that the object of his affection was guilty of double dealing. He returned to Paris and to his taxi cab. Eventually he and the girl settled their difficulties and all ended happily.

To an unprejudiced observer no two things could appear more dissimilar than this song and this elaborate motion picture, except for the bare fact that each bears the title "The Man Who Broke the Bank at Monte Carlo." The appellants, however, in 1936 brought an action against the two respondents, the former of whom had distributed and rented the film in Canada, while the latter exhibited it in its cinematograph theatres in Canada. The claim in the action was for damages for infringement of the appellants' copyright in the song by performance in public. But without any formal amendment the scope of the action became extended without objection so as eventually to include also a claim for infringement of the literary copyright and for "passing off."

In the Supreme Court of Ontario, McEvoy J. who tried the action decided against the appellants in respect of the performing right, but decided in their favour and awarded damages for the use of the "title and theme" of the musical work. He said nothing on the issue of "passing off." In the Appellate Division, the Court of Appeal agreed with McEvoy J. in rejecting the claim so far as regards the performing right, but reversed his decision in respect of the literary copyright, and held that there had been no infringement. The Court also rejected the claim for "passing off." It will be necessary in this appeal to discuss the three heads of claim independently.

The claim for infringement of the appellants' performing right in the song fails in their Lordships' opinion on grounds both of law and of fact. As to the law, the appellants' claim was expressly based on the Imperial Act of 1842, which gave to

the owner of copyright under that Act, a right to protection in Canada. But it was contended on behalf of the respondents that apart from difficulties arising from the course of Canadian copyright legislation which need not here be discussed, the appellants whose claim in the action was based solely on the Act of 1842, could not in any event claim the protection of that Act because as has been stated above, they and their predecessors in title had failed to publish on each copy of the song the printed notice required by the Copyright (Musical Compositions) Act, 1882. Now it is true that the Act of 1882 did not in terms extend to Canada, but in their Lordships' judgment it did so by necessary implication and effect. It was in the nature of an amendment to the Act of 1842 and had the effect of regulating the rights under that Act in respect of public performance. It imposed a new condition for the acquisition and retention of the performing right, whether in England or in any other place where the copyright was based upon and derivative from the English right. Thus the Act of 1842 cannot be relied on where performing right is in question according to its original bare terms but only as qualified by the Act of 1882.

On this narrow ground of law, apart from other considerations, the appellants must fail in their Lordships' opinion. This agrees with the decision of McEvoy J. and the Court of Appeal. But in truth the appellants' claim fails on the facts. There cannot be an infringement of performing right in a musical composition (assuming it to exist) unless there has been a public performance of the musical composition by the defendant. But it is idle to suggest here that by anything the respondents have done they have performed the song in any sense. The motion picture it is true, is what is called a talkie film. But not a word of the song is repeated in any form except that the title is thrown on the film at the outset. It will be considered later if that constituted an infringement of the literary copyright in the film. But to say that this bare fact was a public performance of a musical composition is abhorrent to common sense. A musical composition is performed by audible reproduction, by the voice or by musical instruments or by mechanical methods of reproduction. Nothing of the sort can be predicated here.

The claim for infringement of the literary copyright fails equally, but for other reasons. It is not claimed that there has been any copying of the letterpress or musical notation, except the words "The Man who Broke the Bank at Monte Carlo" which constituted the title of the song, and appear as the title of the film. What is relied on as infringement is the use of these words as the title of the film. It is clear that they have been used by the respondents as the title of the film, both in the actual production and in the advertisements issued on behalf of the respondents. The respondents, however, say that the use of these words is too unsubstantial a matter to constitute an infringement of copyright and that there is no copyright in a title. They also rely on the recent decision of this Board in *Mansell v. Star Printing and Publishing Co. of Toronto* [1937] A.C. 872.



That decision was by itself held fatal to the appellants' claim by the Court of Appeal. That Court held that the effect of the decision was that under the Canadian Copyright Act, 1921, which came into force in 1924 all rights of copyright existing in Canada in virtue of Imperial legislation might be converted into rights existing by virtue of Dominion legislation but only by complying with the conditions under the Act of 1906, which was not done either in *Mansell* or in the present case. In the words of Middleton J. A. "It was Canadian rights only that were preserved. All inchoate rights existing by virtue of Imperial legislation came to an end." But Counsel on behalf of the appellants sought to distinguish the decision in *Mansell* and contended that it did not apply in the present case. In *Mansell*, it was contended, what was in question was copyright in pictures, to which no copyright attached under the Act of 1842. It was first granted in England under the Fine Arts Copyright Act of 1862, but that Act did not apply to Canada. There could therefore be no copyright in such works in Canada under that Act. There was no copyright in such works until the passing of the Canadian Copyright Act of 1906, and then only subject to the conditions imposed in that Act which had not been complied with. In the present case, however, as the appellants contended, their only claim to copyright was based on the English Act of 1842, the rights under which did not depend on the performance of conditions under any Canadian Act; that copyright, it was said, subsisted at the date specified as the date of the commencement of the Act of 1921, and by the terms of the Canadian Act of 1921 rights under that Act took the place of the rights under the English Act of 1842, so that at the material dates these latter rights were vested in the appellants in the circumstances stated above. In this way, it was said, the appellants did not rely upon and did not need to rely on any Dominion copyright legislation except in so far as the Act of 1921 gave a substituted copyright for the right existing under the Act of 1842.

Their Lordships do not think it necessary in the present appeal to determine this controversy, which raises questions of difficulty and importance on the law, because the appeal can, in their opinion, be decided on another ground. Assuming, but not deciding, that the appellant company is entitled to the copyright in Canada which it claims, it is, in their Lordships' judgment, not entitled to succeed in its claim that the respondents have infringed that right. The copying which is complained of is the use of the title, and that is too unsubstantial in the facts of this case to constitute an infringement. The appellant's contention was put as high as that copyright in a title is infringed by the application of that title to a work of a different character from that of the work to which it was originally applied. In the present case the title was originally applied to a musical composition, whereas it has been applied by the respondents to a motion picture or a film. The argument of the appellant company would be the same, it

seems, if the application of the title complained of had been to a picture or a statue. On this reasoning it would be said that the title "Adam" applied to a work of statuary would be infringed if that title were used as that of a novel. These and other anomalous consequences justify the broad principle that in general a title is not by itself a proper subject matter of copyright. As a rule a title does not involve literary composition and is not sufficiently substantial to justify a claim to protection. That statement does not mean that in particular cases a title may not be on so extensive a scale and of so important a character as to be a proper subject of protection against being copied. As Jessel M.R. said in *Dicks v. Yates*, 18 Ch. D. 76 (which as Lindley L.J. said in *Licensed Victuallers Newspapers Co. v. Bingham*, 38 Ch. D. 139, virtually overruled on this point *Weldon v. Dicks*, 10 Ch. D. 247) there might be copyright in a title "as for instance a whole page of title, or something of that kind requiring invention". But this could not be said of the facts in the present case. There may have been a certain amount, though not a high degree, of originality in thinking of the theme of the song, and even in choosing the title though it is of the most obvious. To "break the bank" is a hackneyed expression, and Monte Carlo is or was the most obvious place at which that achievement or accident might take place. The theme of the film is different from that of the song and their Lordships see no ground in copyright law to justify the appellants' claim to prevent the use by the respondents of these few obvious words which are too unsubstantial to constitute an infringement, especially when used in so different a connection.

The appellants' counsel, however, have strenuously contended that though this might be the position under English or Canadian law before 1931, it was changed in Canada by an amendment in that year of the Canadian Act of 1921, which added a new definition to those contained in section 2 of the latter Act, namely "(v) work shall include the title thereof when such title is original and distinctive". It was in virtue of this definition that McEvoy J. held that there was infringement and he awarded damages to the appellant company. The Court of Appeal reversed that holding. Middleton J.A. did not think it necessary to decide whether the amendment applied to existing copyrights. "It is admitted" he said "that prior to this Act no such right existed". He did not think that for purposes of this case the Act of 1931 had changed the law.

Their Lordships are prepared to assume for purposes of this appeal that the amendment applied to existing copyrights: they will likewise assume that the title was original in the sense that it had not been copied from another work. They are content for purposes of this appeal to adopt the definition given by Maclean J. in *Kantel v. Grant Nisbit & Auld, Ltd.*, 1933, Ex. Rep. 84, though they wish to reserve the question how far that definition can be accepted as sufficient in other cases. It is, however, difficult to define satisfactorily the word "distinctive", since it cannot mean

merely that the title is used to identify the particular work. In this connection regard must be had to section 3 of the Act of 1921 which defines copyright as the "right to produce or reproduce the work or any substantial part thereof". The definition (v) does not, in their Lordships' judgment, mean that the title of a work is to be deemed to be a separate and independent "work". Work is to include "the title thereof", that is to say, the title is to be treated as part of the work, provided that it is original and distinctive whatever these words may connote. When that definition is read with section 3, the result is that to copy the title constitutes infringement only when what is copied is a substantial part of the work. This view would agree in effect with what was said by Jessel M.R. in *Dick v. Yates (supra)* in the words quoted above and would apply to a case such as a title covering a whole page of original matter, or something of that nature, but would not justify such a wide extension of copyright as the appellant company has contended for, or the holding of McEvoy J. on this point. It is said that so to construe the definition is to treat it as adding nothing to the law. But the definition may have been inserted to settle doubts and to avoid it being said that in no circumstances could a title receive protection. In any event their Lordships do not think that the new definition (v) entitles the appellants to succeed in this case.

There remains a third point which has been argued on behalf of the appellants, namely, that the respondents have been "passing off" the exhibition of their motion picture as a performance of the song. This startling claim was not pleaded and is dealt with only by the Court of Appeal who disposed of it in summary fashion, "Certainly the moving picture was not represented as the copyright song. No one could be misled or defrauded by what was here done". In these words Middleton J.A. dismissed the claim.

Their Lordships do not wish to be taken to say that in no circumstances can there be a "passing off" by the use of the same title for a literary, artistic or musical work though it is difficult to imagine such a case where there are no circumstances calculated to mislead other than the mere title. A title may, however, be used in the case of a book or newspaper under such conditions that persons may be deceived into buying the defendant's book or newspaper under the impression that they are buying that of the plaintiff. Similarity of name may be strengthened by similarity in make up, and in subject matter, and by other circumstances. Nor is such a claim limited to things sold, though it is commoner in that class of case. It is not impossible that there might be "passing off" of such a nature that persons might pay to go to a performance of the defendants' work under the impression that they were going to witness the plaintiff's work. Such cases are perhaps not very likely to occur, but there may conceivably be the same element of likelihood of deception, whether designed or not, as to involve an invasion of the plaintiff's common law



rights and a disturbance of his business interests. But in their Lordships' opinion it is enough to state these elementary principles to see how inapplicable they are to the subject matter of this appeal. The member of the public who is supposed to be likely to be deceived, must, to start with, be assumed to know what he was wanting to see or hear. Thus in the present case he must be presumed to know that what he wanted was to hear the song "The Man who broke the Bank at Monte Carlo". It seems inconceivable that when or if he bought a ticket for the motion picture, he imagined he was going to hear a performance of the familiar song. The two things are completely different, and incapable of comparison in any reasonable sense. The thing said to be passed off must resemble the thing for which it is passed off. A frying pan cannot be passed off as a kettle. In Canada, what was advertised was the film. There was no hint that the song was going to be sung. Indeed it was not sung at any performance. If it had been sung, it would presumably, on the assumptions made by their Lordships, have been an infringement of the performing right, but, if that were possible, it would have made the claim for passing off, even more preposterous, because the assumed victim would have got what he desired, namely, a performance of the song.

On all these grounds their Lordships will humbly advise His Majesty that the appeal should be dismissed. The appellants must pay the costs of the appeal.

In the Privy Council

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FRANCIS DAY & HUNTER LIMITED

v.

TWENTIETH CENTURY FOX CORPORATION LIMITED AND OTHERS

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DELIVERED BY LORD WRIGHT

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