

## STALKING THE SLEEPING LION

By Owen Dean

*'Your mandate is to find a way, and to do everything possible, to enable the children of Solomon Linda, the composer of a song called Mbube, which later evolved into the international hit song The Lion Sleeps Tonight, to derive some financial benefit from the considerable revenues generated by the popularity of The Lion Sleeps Tonight. You should recommend any reasonable course of action which you can conceive and we are willing to finance it even if it means conducting litigation abroad.'*

This instruction came from representatives of Gallo (Africa) Limited, the South African record company. With that they delivered a pile of documents standing the best part of a metre high and left me to peruse them. This appeared to be an interesting and stimulating challenge and perhaps the opportunity of a lifetime. It was the year 2000.

I ploughed through the mountain of paper and steadily a pattern and coherent story emerged. The route map through the bewildering landscape turned out to be an article entitled 'In the Jungle' written by the author and journalist Rian Malan and published in the 25 May 2000 edition of the magazine *Rolling Stone*, the authoritative mouthpiece of the international entertainment industry, and more particularly the American entertainment industry.

In his well-researched and revealing article Rian Malan told a sad story that smacked of the abuse of simple poor black people by music industry moguls in relentless pursuit of riches. The upshot of the story was that, despite the success of derivatives of his song Mbube, Solomon Linda had died a pauper and his descendents had been doomed to live in abject poverty in Soweto.

Meanwhile, the song had bestowed bounteous riches on those who had commandeered it. The interesting and stimulating legal challenge was supplemented, if not overshadowed, by a truly righteous cause. The publication of Malan's article caused a considerable outcry in South Africa and set in motion the chain of events described in this article.

### The history

Solomon Linda was an uneducated Zulu tribesman who was a gifted performer of music. He composed several songs, one of which was called Mbube. The name of the song means 'lion' in Zulu. He migrated to Johannesburg and took up a job as a cleaner in a storeroom at Gallo Records. By night he performed at the local shebeens and gathering places of black people together with a group called 'The Evening Birds'. In the late 1930s his song Mbube, as performed by The Evening Birds, was made into a record by Gallo and was released into the local market place. It sold well.

In the early 1950s Gallo, which had a relationship with Decca Records in the United States of America, forwarded a collection of their records to Decca with the hope that Decca would be interested in releasing some of them internationally. None of the material was, however, attractive to Decca but they passed it on to Pete Seeger, a well-known folk singer of the time.

Pete Seeger listened to the material and found Mbube to his liking. He decided to make his own recording of the song. Having no sheet music to work from, he transcribed the song from Solomon Linda's record. He heard the word Mbube, as it was chanted by The Evening Birds, as 'Wimoweh' and called his song by that name, which was also the core of the vocal rendition of the song. Wimoweh was released in the United States of America in the mid-1950s and it became a hit. It was thereafter recorded by various other people.

In the early 1960s a successful pop group in the United States, 'The Tokens', decided that they wished to record the song but they wanted to update it to conform with the requirements of contemporary pop music. The song was rearranged and the lyricists George Weiss, Hugo Peretti and Luigi Ceatore were brought in to give the song English lyrics. Thus was The Lion Sleeps Tonight born.

It was an immediate number one hit and it then proceeded to have an evergreen life over the next 40 years revisiting the hit parade on several occasions as new versions of it were made. It was also taken up into several movies but perhaps its crowning glory came when, in the mid 1990s, it was incorporated into the Walt Disney animated movie and stage musical The Lion King. The song is said have made many millions of US dollars over the years. If its South African origins were ever recognised, they were long forgotten and the song was regarded as part of American pop culture with the credit going to Weiss, Peretti and Ceatore.

Contemporaneously with the song migrating to the United States, Solomon Linda entered into an assignment of his copyright in Mbube with Gallo Africa. This was in 1952 and the consideration payable to Solomon Linda in the Deed of Assignment was 10 shillings. Gallo then registered the United States copyright in the song in its own name. When Pete Seeger recorded Wimoweh its copyright became the property of an American company called Folkways, a music publisher.

In 1962 Solomon Linda died, leaving his wife Regina as his sole heir in terms of the South African law of intestate succession at that time. The marriage between Solomon and Regina produced four daughters but the daughters did not inherit. In 1982 the copyright registration in respect of Mbube in the United States of America came up for renewal into its second 27-year term. Under United States copyright law, the right to renew the copyright in a work into its second term vested in the author or his heirs. Folkways secured an assignment of whatever rights of copyright she held in Mbube from Regina. It then registered Mbube in its renewal term in its own name.

Regina died in 1990 leaving a will (drafted by Folkways' South African lawyer) in which she left all her assets to her four daughters. Soon thereafter, in 1992, Folkways secured yet a further assignment in its favour from the four daughters of whatever rights they might have held under the copyright in Mbube. One of these daughters was to die of Aids before the events described below took place. No effort was spared in ensuring that Solomon Linda and his descendents divested themselves of any possible vestiges of the copyright in Mbube that they might have held.

It should be mentioned that in the early 1990s Folkways was locked in battle with a company called Abilene Music (which was the vehicle of Weiss, Pereritti and Ceatore for managing the copyright in The Lion Sleeps Tonight). Abilene came out on top in that contest and became, at least as far as the United States was concerned, the unequivocal owner of the copyright in The Lion Sleeps Tonight.

### **Analysis of the history**

The mountain of documents holding the key to a possible claim by the Linda heirs comprised all sorts of items, including a plethora of agreements between Gallo Africa and Folkways relating to Mbube and Wimoweh. These documents were confusing and often contradictory but their general impact was to give rights to Mbube and Wimoweh to Gallo in African countries, and to confer these rights on Folkways throughout the rest of the world. Cross-licences were entered into to ensure that both parties benefited to some extent in the worldwide exploitation of these two songs.

For the major part there were no agreements relating to The Lion Sleeps Tonight which had passed out of the orbit of both Gallo and Folkways. While there had been litigation between Folkways and Abilene in the United States of America in which it was alleged that The Lion Sleeps Tonight was an infringement of the copyright in Wimoweh, the outcome of the litigation in the early 1990s put paid to any further claims of this nature, at least in the United States of America.

An interesting and surprising element of the outcome of this litigation was that for some reason, which was not readily apparent, a ruling was made that 10% of the performing rights in respect of The Lion Sleeps Tonight should be paid by Abilene to the heirs of Solomon Linda. Apart from this, an analysis of all this material did not bring to light any cause that the heirs of Solomon Linda, or Gallo Africa for that matter, could pursue. It seemed a hopeless case and a reason for despair. The situation was, of course aggravated by the assignments of copyright her daughters had executed in favour of Folkways. Hope, however, came from a remote source.

In 1989 I was awarded the degree of Doctor of Laws (LLD) at Stellenbosch University. The title of my doctoral thesis was 'The Application of the Copyright Act, 1978, to Works Made Prior to 1979'. In researching and writing my doctoral thesis I gave consideration to the British Copyright Act of 1911, known as the 'Imperial Copyright Act' because the British government of the day made it law

throughout Britain's possessions and territories in its Empire, which at the time included South Africa, and also countries like Australia, New Zealand, Canada, India, etc.

This Act had a curious provision, in the proviso to s 5(2). It was to the effect that, where during his lifetime, the author of a work of copyright assigned his copyright to another, that copyright reverted to his heirs 25 years after his death, notwithstanding any other assignments of copyright which might have taken place in the intervening years. This so called 'reversionary interest' in the copyright could not be assigned by the author and any purported assignment was invalid. There was only one known reported case in which this provision had been applied, namely the so called '*Redwood case*' [1981] RPC 337 (HL). I had dealt with this provision as interpreted in the *Redwood case* in an academic manner in my doctoral thesis. It seemed to me on reflection as though the reversionary interest principle might be of assistance in the Mbube case.

The 1911 British Copyright Act was incorporated lock, stock and barrel in the South African Patents, Designs, Trade Marks and Copyright Act 9 of 1916. It formed Schedule 3 to that Act and effectively the Act provided that the British Act of 1911 would apply in South Africa subject to certain incidental changes which were detailed in the text of the 1916 Act. The 1916 Act had, however, been repealed – as far as copyright was concerned – by the Copyright Act 63 of 1965, and this Act had in turn been repealed by the Copyright Act 98 of 1978, which came into force on 1 January 1979. The crucial question was whether a provision of a 1911 British Act, which had twice removed been repealed in South Africa, could nonetheless be invoked to give a cause of action to the Linda heirs in the present matter.

### **Resurrecting the reversionary interest**

Section 43 of the 1978 Copyright Act makes that Act retrospective in the sense that it applies to works made before its commencement in the same way as it applies to works made thereafter. There are, however, two exceptions to this provision, the pertinent one being contained in para (a). In terms of this paragraph the Act does not affect the ownership, duration or existence of any copyright which subsists under the 1965 Copyright Act, which Act was repealed by the 1978 Act.

Accordingly, it becomes necessary to ascertain whether copyright which reverted to the estate of a deceased author in terms of the s 5(2) of the British 1911 Act, subsisted under the 1965 Copyright Act. This leads one to s 48(1) of the 1965 Act which states that provisions contained in the Sixth Schedule to the Act have effect on works made prior to the coming into operation of the 1965 Act. Section 41(1) of the Sixth Schedule provided that the 1965 Act applied in relation to things existing at the commencement thereof as they apply in relation to things coming into existence thereafter. Sections 1, 2 and 3 of the Sixth Schedule effectively preserved the subsistence, duration and ownership of copyright in

works made during the currency of the previous Act as though that Act had continued in force.

Section 27(3) of the Sixth Schedule preserved the operation of s 5(2) of the previous Act, namely the provisions pertaining to the reversionary interest. The upshot of all of this is that copyright conferred by the 1911 British Copyright Act continued to exist untrammelled as though the 1911 Act had never been repealed but it was deemed that that copyright was conferred by the 1965 Act. Thus, copyright to which the reversionary interest was applicable, although coming into being prior to 1965, subsisted or continued to subsist by virtue of the provisions of the 1965 Act, thus bringing it within the ambit of s 41 of the 1978 Act which, in turn, meant that it continued to exist under the 1978 Act exactly as it had existed under the 1911 Act. In short, the reversionary interest in Mbube created by the assignment in 1952 continued to exist under the 1978 Act.

This meant that, on his death in 1962, Solomon Linda's estate acquired the reversionary interest in Mbube but the actual reverted copyright would vest in the estate only 25 years later, namely in 1987. In the *Redwood* case the reversionary interest was dealt with as though the reverted copyright vested as aforementioned in the heirs of the author and that was the initial assumption on which I proceeded.

However, on further examination it became apparent that this situation would be fatal to the heirs' ability to lay claim to and enforce the copyright in Mbube at the present time because, firstly, Regina in 1983 and thereafter the daughters in 1992 had divested themselves of their rights under the copyright in Mbube by virtue of the assignments that they had entered into in favour of Folkways. It seemed as though this line of reasoning had led into a cul-de-sac.

A detailed analysis of s 5(2) of the 1911 Act, however, makes it clear that the reversionary interest devolved on the executor as an asset of the author's estate. The executor had the power to deal with the reversionary interest in the same way as he could deal with any asset in an estate. He could pass the reversionary interest to one or more of the heirs if he deemed it appropriate, or he could transfer it to a third party and pass to the heirs the monetary value realised by such transfer. It was necessary, no matter to whom the executor transferred the reversionary interest, that he should enter into a written deed of assignment effecting transfer of the rights. The heirs of the author became the owners of the reversionary interest only if and when such interest was assigned to them in writing by the executor.

This had not happened in the present instance and, accordingly, when Regina in 1983 and the daughters in 1992 entered into assignments of copyright in Mbube, the reversionary interest did not vest in them and they therefore could not transfer the reversionary interest to Folkways. In other words, the assignments were of no force or effect. Moreover, in the case of the 1983 assignment by Regina, the reverted copyright had not even at that stage vested in the executor.

Prior to 1987 all the executor had received on behalf of the estate was the right to receive the copyright in the work in 1987.

The mists of time had been cleared away and it was apparent that the reverted copyright in Mbube vested in the executor of Solomon Linda's Estate in 1987 and still remains in his hands up to the present time. Further research showed that, like South Africa, other countries which were formerly part of the British Empire also preserved the reversionary interest created by s 5(2) of the 1911 Imperial Copyright Act up to the present time with the result that what the executor held was not only the reverted copyright in South Africa but also in all countries which were former British possessions.

The way forward was clear. The executor in the estate of the late Solomon Linda could enforce the copyright in Mbube in South Africa and in any country which was formerly part of the British Empire, including the United Kingdom itself. He would be in a position to make a claim of copyright infringement against anyone performing any acts in relation to *The Lion Sleeps Tonight* falling within the scope of the copyright in Mbube. But first an executor had to be appointed, some 42 years after Solomon Linda's death.

An approach was made to the Master of the High Court in Pretoria and the whole issue was canvassed with him. After dispelling his scepticism regarding this asset of the estate that had suddenly materialised, he agreed to open a file for the administration of the Linda estate but, before doing so, required to be satisfied that no file had previously been opened by a magistrate holding jurisdiction over Solomon Linda in 1962 because, at that time, the estates of Africans, particularly those dying intestate, were administered by the magistrate having jurisdiction, in this case the magistrate of Johannesburg.

The Johannesburg magistrate was duly approached and he could find no record of any such estate. He required, however, that a search be conducted in the state archives. This was duly done and to our surprise a file was indeed located and it showed that all Solomon Linda's assets at the time of his death, being the proceeds of a savings account at a bank in the amount of R145, had been transferred to his wife Regina. This information was conveyed to the Master and he was requested to reopen the file. However, he adopted the stance that, since the previous file had been dealt with by the magistrate of Johannesburg, the fresh file should be administered under his auspices. The Johannesburg magistrate was once again approached and he thereupon appointed Stephanus Griesel, a chartered accountant, as the executor in the estate.

The envisaged claim now had a cause of action and a plaintiff. What was next required was a suitable defendant. Abilene Music, the licensor and claimed copyright owner of *The Lion Sleeps Tonight* was located in the United States of America and, as far as could be ascertained, did not conduct any business outside that country. Since the executor's rights were confined to countries which were formerly members of the British Empire, and did not extend to the United States of America, there appeared to be no basis on which any suitable court

could have jurisdiction against Abilene Music. Another defendant had to be sought. It was considered important that litigation should be embarked on because it was felt that, in the absence of successful litigation, no one would attach any credence to the claim of the executor. The choice of a defendant fell on a licensee that was operating within the jurisdiction of the court of an appropriate country and against which that court could exercise jurisdiction.

After considering various possibilities, the choice fell on Walt Disney. Disney had released the movie *The Lion King* throughout the world and moreover the stage show *The Lion King* was playing in London. Disney appeared to be an ideal candidate because it was a very high-profile user of *The Lion Sleeps Tonight* and by virtue of its pre-eminent position in the entertainment industry it would be in a good position to bring pressure on Abilene to meet the executor's demands. It was surmised that Disney obtained a licence from Abilene to incorporate *The Lion Sleeps Tonight* in the musical *The Lion King* and that Abilene had probably given an indemnity to Disney in terms of that licence. This in effect made Disney a surrogate defendant for Abilene Music.

By virtue of the strong emotional reaction evoked by the plight of the Linda heirs viewed against the background of the success of the song, it was appreciated that a claim brought by the executor would evoke widespread public sympathy and solidarity and that this would place pressure on Disney to resolve the matter expeditiously rather than have to endure long drawn-out litigation. With this in mind the strategy was developed that as much worldwide publicity as possible would be generated for the case. Indeed, the strategy was to conduct a 'propaganda' campaign as much as a legal case against Disney.

The results of the research into the legal position and the conclusions which had been reached in regard to the strategy to be adopted was put to Gallo in accordance with the mandate that I had been given. Gallo was, however, unwilling to support the proposed litigation because its sister company in the Johnnic Group, namely Nu Metro Home Entertainment (Pty) Ltd, was the South African licensee of Disney under the movie *The Lion King*.

### **Launching the litigation**

The project appeared to have reached another dead end with Gallo's decision. However, by now the project had been going for three years already and the worthy cause had gathered such momentum that there was no turning back. This meant that alternative funding for the project would have to be obtained. With the tenuous position regarding the funding of the project, it was decided that it would be foolhardy to launch the litigation in the United Kingdom as had been originally envisaged because the costs would be far too high in comparison with what equivalent litigation in South Africa would cost.

It was therefore decided that the case must be brought in South Africa but then a further problem cropped up, namely that Disney Enterprises Inc, the company which owned the copyright in *The Lion King* and all Disney's intellectual property,

did not have a presence in South Africa and the South African court would therefore have no jurisdiction against it. This obstacle was, however, circumvented when it was realised that Disney owned very valuable property in South Africa, namely in excess of 200 registered trade marks, including such marks as Mickey Mouse, Donald Duck, etc, and moreover it had registered the copyright in the movie The Lion King in South Africa under its registration of copyright in Cinematograph Films Tax Act 56 of 1960. These items of intellectual property constituted property which could be attached in order to found jurisdiction against Disney Enterprises Inc before the South African court.

In June 2004 an *ex parte* application in the name of the executor was brought before the Transvaal Provincial Division of the High Court of South Africa in which the executor's cause of action against Disney Enterprises Inc was outlined and an order attaching the registered trade marks and the copyright in The Lion King in order to found the court's jurisdiction against Disney in an action to be instituted against it was sought. This application was granted and an action was duly instituted.

At the same time, Nu Metro Home Entertainment (Pty) Ltd, David Gresham Entertainment Group (Pty) Ltd and David Gresham Records (Pty) Ltd, all of which were South African companies and were licensees or sub-licensees of Abilene Music, were joined as co-defendants with Disney. The news of the attachment and of the institution of the proceedings spread around the world in an instant and it attracted considerable interest and comment. In particular, the fact that Mickey Mouse, Donald Duck and their friends had been 'taken hostage' in South Africa by means of the attachment caught the public's imagination. Indeed one of the reasons why Disney was attractive as a target was its susceptibility to publicity and its likely aversion to bad publicity which would cause it to put pressure on Abilene to get rid of the litigation.

The main thrust of the executor's case against the defendants was that Nu Metro and David Gresham Entertainment and Records had commercially exploited the song, or the film The Lion King comprising the song, in South Africa without the authority of the executor as the copyright owner of Mbube, from which Lion Sleeps Tonight had been derived, and had therefore infringed the copyright in Mbube. It was claimed that Disney had caused Nu Metro's actions in that respect in South Africa and therefore was a contributory copyright infringer. Interdicts restraining further unauthorised use of The Lion Sleeps Tonight, damages, as well as various other forms of ancillary relief were claimed against the defendants. Damages in the amount of R10 million were claimed against Disney and Nu Metro, and in the amount of R5 million against David Gresham Entertainment and Records. Of course, relief could be claimed only in respect of the defendant's activities in South Africa which was but a small portion of the world market of the song.

Meanwhile concerted efforts were made to find alternative financiers or sponsors for the litigation and these efforts were successful. The sponsor has elected to remain anonymous and these wishes have been respected.

## **The Disney empire strikes back**

Disney responded to the institution of the action both swiftly and severely. Within a matter of weeks it brought an urgent application to the court to set aside the attachment of its intellectual property. In addition, steps were taken to bring pressure to bear against me personally, *inter alia*, by seeking a costs order against my firm, Spoor & Fisher, *ex bonis propriis* along with the granting of the application.

The application was brought on several grounds. It was claimed that the executor had not properly been appointed and therefore had no *locus standi* to institute the litigation against Disney. Disney further claimed that material information pertinent to the executor's claim had not been brought to the attention of the court in the papers seeking the attachment of the marks. More particularly, it was argued that the assignments by Regina and the Linda daughters, respectively, were not disclosed to the court and this was a serious omission on the part of the executor.

On the substantive law it was claimed that, by virtue of the fact that subsidiary companies of Disney's had granted licences to Nu Metro Home Entertainment to exploit the film The Lion King in South Africa, and not itself, it had therefore not contributed to any infringement of the copyright that may have been perpetrated by Nu Metro Home Entertainment. The court dismissed Disney's application (under case no 12003/04), finding that the executor had made out a *prima facie* case against Disney.

The court was satisfied that the executor had been duly appointed as such and was in that capacity the holder of the reversionary interest in Mbube. It accepted the executor's argument that the 1993 and 2002 assignments of copyright were not material to the executor's entitlement to enforce the copyright in Mbube and, furthermore, that, on the strength of the chain of licences linking Disney indirectly with Nu Metro Home Entertainment, Disney had *prima facie* caused Nu Metro to infringe the copyright in Mbube through trading in copies of the film The Lion King. No award of costs was made in the application on the basis that the matter was proceeding to trial in due course and the costs issue could be properly decided at the trial. The court did, however, order that no costs should be payable by Spoor & Fisher.

The court's decision in the application endorsed the executor's case against Disney and dealt with all the significant legal issues, deciding them on a *prima facie* basis in favour of the executor. It is significant that Disney could not challenge the applicability and the operation of s 5(2) of the 1911 British Act as conferring a reverted copyright upon the executor as an asset in the estate of the late Solomon Linda.

The publicity given to the case extended worldwide and offers were received from lawyers in other countries such as the United Kingdom, Canada, Hong Kong and France to bring corresponding cases on a contingency basis in their

countries. It was intimated to Disney that further cases in foreign jurisdictions were in the offing.

### **Finalising the action**

Subsequent to the dismissal of the application to set aside the attachment, the pleadings closed in the action and it was set down for trial on 21 February 2006. The defendants based their defences on essentially the same grounds as had been advanced by Disney in its application to set aside the attachment. Certain further defences, mainly of a technical nature, were also advanced and these included challenging the originality of Mbube as a copyright work and, as far as the David Gresham companies were concerned, contending that these companies were not acting on their own behalf, but rather as the agents of Abilene Music with the result that their conduct must be attributed to their principal and not to themselves.

Shortly before the trial date, settlement negotiations took place between the parties, and these also involved Abilene Music. This company was drawn into the settlement negotiations by virtue of its position as the licensor, directly or indirectly, of all the defendants. This emphasises the point that Abilene Music was in fact the true defendant in the proceedings, although it was not before the court. The negotiations gave rise to a settlement agreement which met all the objectives of the executor in launching the case, namely the following:

- Abilene undertook to pay to the executor an undisclosed amount by way of compensation for past uses of The Lion Sleeps Tonight and, furthermore, undertook to pay royalties to the estate in respect of all future uses of the song, on a worldwide basis.
- It was acknowledged by the defendants that The Lion Sleeps Tonight was derived from Mbube.
- Solomon Linda would henceforth be designated as a co-composer of The Lion Sleeps Tonight.

The settlement further provided that the executor would withdraw the litigation and all claims on behalf of the estate against Abilene or any of its licensees would be waived. A trust would be appointed by the executor to administer the funds which would flow to the heirs arising out of the settlement.

The effect of the settlement was to confirm the *prima facie* findings of the court in its judgment in the application to set aside the attachment, and in this sense the court's decision in the application was made final.

### **Consequences of the settlement**

The settlement acknowledged at least by implication that *The Lion Sleeps Tonight* has a South African origin and is thus an element of South African culture. Furthermore, it demonstrated that the reversionary interest in copyright is available to the heirs of South African authors who created their works during the period 1916 to 1965. Indeed, it showed a similar availability to the heirs of authors who created works in any country in which the 1911 Imperial Copyright Act was in force if the works in question were made during the currency of that legislation. It demonstrated what steps could be taken by the heirs of authors whose works had been appropriated by others and perhaps not been paid proper compensation, so that a commercial wrong could be redressed.

This facility is of particular importance to the heirs of South African authors who suffered legal and commercial disabilities under the apartheid system. A parallel can be drawn between the descendants of authors of copyright works relying on the reversionary interest and land claims perused by persons whose forebearers had suffered injustice through their land being misappropriated.

From the point of view of the executor, the settlement was a satisfactory result. By relying on a right derived under South African copyright law, the executor was able by means of a single court case to bring about a worldwide recognition of the rights of the estate and to achieve a flow of money to the heirs arising from the exploitation of *The Lion Sleeps Tonight* throughout the world; and this from a company which was not a party to the litigation. It had taken six years. After a lengthy period of being stealthily stalked the sleeping lion awoke with a jolt.

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