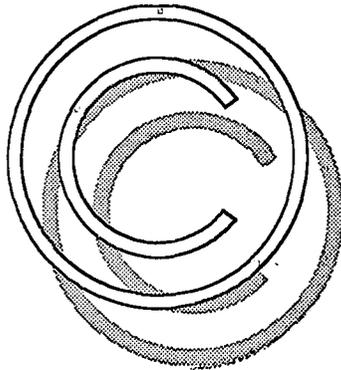

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NOTICES FROM THE COPYRIGHT OFFICE

The new Mexican Copyright Law of 1963 contains several provisions of interest to those wishing to protect their works in Mexico. Since there have been some differences of interpretation of this law within the United States copyright industry, a statement in writing has been obtained from the Mexican Director General of Copyrights answering the basic questions of interpretation. Based on these answers, a summary of the main provisions in the law is given below. Since the law contains a *time limit of December 21, 1964* for taking advantage of one of its provisions, expeditious action is advised to protect copyright interests.

In brief, works published in the United States on or after May 12, 1957 (the effective date of Mexico's adherence to the Universal Copyright Convention) are automatically protected. The law seems ambiguous as to which works published prior to that date must be registered by the above deadline. The Mexican Director General of Copyright states, however, that works which were published prior to January 1, 1948 and which were not registered in Mexico, so that they fell into the public domain there, may obtain protection if registration is completed by December 21, 1964. Furthermore, he states that foreign works published during the period from January 1, 1948 to May 11, 1957, which were not registered in Mexico and thus are in the public domain there, may obtain the protection of the current law by being registered at any time, even subsequent to December 21, 1964. Works published prior to May 12, 1957 which have already been registered in Mexico do not need to be registered.

The registrations mentioned above may be requested by the author or his successors in title. The heirs or other successors in title of deceased authors must establish that death occurred within a period of thirty years immediately preceding December 22, 1963. Prior rights legally acquired by third parties are not affected.

The new law also provides that all assignments of copyright in Mexico, including assignments by United States individuals or companies to Mexican nationals, must be registered in Mexico to assure protection. Such assignments are not valid in Mexico until registered, but there is no time limit for such registrations.

Periodical publishers are notified that the new copyright law also provides protection for titles of newspapers, magazines and other periodicals if registration is effected. This protection may be desirable since it is understood that names are not protectible in Mexico as trademarks.

The Copyright Office does not possess official information concerning fees, application forms, or other registration procedures. Therefore to obtain full details of these, or answers to any further questions of interpretation, interested parties should communicate directly with, or should have their Mexican representatives communicate with:

Director General de Derecho de Autor
Secretaria de Educación Pública
Rio Lerma No. 4-5 piso
Mexico D. F., Mexico*

COPYRIGHT LAW REVISION

Part 3—Preliminary Draft for Revised U. S. Copyright Law and Discussions and Comments on the Draft

This is the third in a series issued by the House Committee on the Judiciary. It contains the complete text of a Preliminary Draft for a new copyright law prepared by the Copyright Office in 1963 as a basis for discussion, a full transcript of the discussions at the first four of eight meetings convened by the Register of Copyrights during 1963 and January 1964, and comments submitted on the sections of the Draft discussed at those four meetings. The transcript of the later meetings and additional comments will appear in Part 4 to be issued at a later date.

Copies are available from the Superintendent of Documents, U. S. Government Printing Office, Washington, D. C. 20402, at \$1.25.

* See also page 82 for a later Notice regarding registration in Mexico.

PART I.

ARTICLES

THE AMERICAN BAR ASSOCIATION COPYRIGHT SYMPOSIUM
(New York City, August 8, 1964)

The Subject: "Current Developments in Copyright Law Other Than Revision." John R. Peterson, Moderator.

The Editors are pleased to publish, as in previous years and with the permission of the authors and the Patent, Trademark and Copyright Section of the American Bar Association, the papers comprising the Copyright Symposium presented at the annual Convention.

1. COPYRIGHT OFFICE DEVELOPMENTS

By ABRAHAM L. KAMINSTEIN*

For me, talking about current developments in the Copyright Office other than the program for general revision of the copyright law is like trying to describe a football game without ever saying what is happening to the ball. There is furious motion; everybody is running around, we make occasional advances, and occasionally we get knocked flat, but it's all meaningless without reference to the focal point of the activity. And during the past year in the Copyright Office most of our basic efforts were directed at general revision.

It was exactly nine years ago this week that Congress, at the request of my predecessor, Arthur Fisher, passed an appropriation bill that got the general revision program underway. Our progress since then has not been exactly steady. We have had our ups and downs, and I am very much aware that we still have a considerable distance to travel. But I think that anyone who has observed this program from its beginnings (and there are a number of you in this room) will have to agree that genuine progress has been made, and that the chances of Congressional action on copyright law reform are a great deal better as a result.

* Register of Copyrights, United States Copyright Office.

People usually don't get bouquets until the final curtain, but I can't resist this opportunity of paying tribute to the tremendous amount of dedicated work that has already gone into this project. We have benefited greatly from the contributions of the members of the Panel of Consultants on the General Revision of the Copyright Law, both at the panel meetings and in correspondence. During the past year, under the tireless chairmanship (not to say whip-hand) of John Schulman, the sub-committees of American Bar Association Committee 304 have produced a body of reports and comments on the principal problems in revision that have helped greatly in crystallizing opinion and working out language. This committee work resulted in some key compromises that have carried the revision program forward, and is something that the Association and its members should take a good deal of pride in.

Finally, to get back to the Copyright Office, I want to express my appreciation to the General Revision Steering Committee which has been meeting for many years but never so continuously as it has in the first half of this year. Included in the Steering Committee have been George Cary, Arpad Bogsch (when he was with this Office), Waldo Moore (and his predecessor, Richard McCarteny). Most specifically, I want to thank Barbara Ringer and Abe Goldman for the incalculable amount of work they both put in as members of the Committee in the continuous drafting and redrafting of each section of the bill submitted to Congress.

It is a little hard for me to realize, but even aside from general revision, the Copyright Office had quite a year in 1963-1964. One of the major problems that reached solution in a good deal of publicity was the registrability of computer programs. This problem involves two fundamental legal questions: (1) whether a program as such is the "writing of an author" and thus copyrightable, and (2) whether a reproduction of the program in a form actually used to operate or be "read" by a machine is a "copy" that can be accepted for copyright registration.

A good deal of research, discussion, and correspondence went into finding answers to these questions. In April, 1964, the Office decided that, although they are both doubtful questions, they should be resolved in favor of registration. We issued an announcement explaining that before a computer program will be registered it must meet certain requirements.

First of all, we pointed out that the elements of assembling, selecting, arranging, editing, and literary expression that went into the compilation of the program must be sufficient to constitute original

authorship. Second, since registration is to be made as a "book" in Class A, the program must have been published with copyright notice. This means that "copies" (by which we mean reproductions of the program in which the content is perceptible or capable of being made perceptible to the human eye) bearing a notice must have been distributed or made available to the public. Finally, the copies deposited for registration must consist of or include reproductions in a language intelligible to human beings. In other words, if the material was published only in a form that cannot be perceived visually or read, a readable form of the program such as a "print-out" will have to be deposited along with the machine-readable copies.

The Copyright Office has undoubtedly made registration in the past for a number of computer programs as part of larger works such as books and periodicals. However, the three registrations we made in May and June of this year were probably the first ever made for computer programs as such, and for this reason they attracted a great deal of attention. As a result we have been receiving a number of calls, letters, and visits on this subject, and the indications are that our decision is being given careful consideration by those concerned with the development of computer technology. However, if experience is any guide, we do not expect any flood of applications covering computer programs for some time to come, and as our announcement said, we will have to await developments before we can work out detailed registration procedures in this area.

As always, plaguey problems continued to arise in connection with Government publications, motion pictures, designs, the manufacturing clause, and renewals. It may be worth noting here, in connection with the continuing problem of what to deposit in connection with electronic music, that in one case we accepted a complete oscillogram made directly from a performance of the tape. We also made some rather sweeping administrative changes in the methods of processing assignments and other documents submitted for recordation; we hope these will not only speed up the process but will result in more accurate and meaningful records.

More than half of the application forms in use by the Copyright Office were revised during the past year. The changes ranged from relatively minor improvements and clarifications in Forms B, K, R, and U to relatively extensive revisions in parts of Forms A, BB, E Foreign, G, I, and L-M. Most of the new forms have already been issued, although two are still at the Government Printing Office; if you should like copies or supplies, I suggest you write to the Service Division of the Copyright Office for the particular forms you use

regularly. I should emphasize also that the new forms do not make the previous applications obsolete, and we have no objection to your continuing to use existing stock.

Possibly the most noticeable change in format is the addition of a box for the examiner's initials. The important and frequently misunderstood "new matter" line was completely revised on Forms E Foreign, G, I, and L-M, and line 6 of Forms A and BB, which is intended to elicit information concerning previous foreign editions and which has been the source of much difficulty, was also entirely rewritten.

The most delicate revisions involved the wording of the affidavit of domestic manufacture (line 11 of Form A). As you may know, the book manufacturers argue that the practice of some publishers of having books produced from imported reproduction proofs is a violation of the manufacturing requirements of section 16 of the law. The book publishers take the opposite view, and the Copyright Office takes the position that there is sufficient doubt on the question to justify registration. More than a year ago representatives of the Book Manufacturers Institute pointed out to us that the wording of the affidavit form in use for the past several years did not conform exactly to the language of section 17 of the statute, and they argued that it encouraged importation of repro-proofs. In an effort to arrive at language which conforms with the statute, is reasonably intelligible, and leaves the repro-proof question open, the Copyright Office entered into correspondence and discussions with the representatives of the book publishers and the book manufacturers. These efforts went on for more than a year, and the strength of feeling on both sides is indicated by the fact that in the end the question had resolved itself into a substantial dispute over one semi-colon.

Joe Dubin will be covering international developments in copyright, and I have already reported, in the BULLETIN of the Copyright Society, upon the conferences I attended last year in Brazzaville, Geneva, and New Delhi. Without anticipating Mr. Dubin or repeating myself on this subject, I would like to stress the importance to us in the United States of the major current international developments: the forthcoming revision of the Berne Union Convention, now scheduled to be held in Stockholm in 1967, the coming into force of the Neighboring Rights Convention this year, and the continuing efforts to develop copyright legislation in the newly independent African nations. All of these developments interact upon one another and, of course, influence national copyright laws throughout the world, including this country. Similarly, our efforts at general revision of the

United States copyright laws will, I believe, eventually have considerable impact abroad. The next few years seem almost certain to be of pivotal significance in the history of world copyright and I urge you to follow the trends as closely as possible.

I also do not want to trespass on Professor Derenberg's subject of copyright litigation, but I might mention the two actions now pending against me. The first is the perennial *Rickover* case, which has not yet come to trial in the District Court for the District of Columbia. The other action was brought against me in the same court by the Armstrong Cork Company, to compel registration as a "work of art" for its "Montina" tile flooring. The pleadings in that case raise the interesting question of whether it is possible to copyright a design consisting of vinyl chips, arranged randomly and non-repetitively by a machine, where no two segments of the flooring product are alike but where the over-all design effect is similar.

In connection with copyright litigation, I should also like to throw out three suggestions for your consideration. The Copyright Office is currently attempting to publish all court decisions in the copyright field, and to maintain collections of briefs and exhibits submitted in copyright cases. These are things which can be of great value to future litigants and scholars, and unless preserved at the time of trial they are likely to be lost forever.

I should therefore like to suggest, first, that if you know of a decision in the copyright field that has not been reported, you notify us of it, or preferably, send us a copy of the opinion. This is especially important in the case of state court decisions, which are virtually impossible for us to obtain through official channels. Second, we should be most grateful if you could send us copies of any briefs you file in copyright cases. And, finally, we are now in the process of attempting to build up a "museum" of copies of works involved in copyright litigation. In most cases we can draw on the deposit copies for this purpose, but this is usually not possible with respect to cases involving common law copyright or with respect to the allegedly infringing copies. If you have any such copies, it would be a service to the bar and to the public if you could send them to us for preservation. In the case of both briefs and copies, I think specially of those senior members of our bar who have participated in many of the landmark copyright cases.

In closing, a few words about workload and statistics. These are dull subjects to many people, but not to administrators fighting daily battles to keep our operations current while maintaining the quality of our work. Last year we made 279,000 registrations, which was an

increase of 5% over the previous year and of 24% over the total in 1957. I am proud to say that our staff has managed to stay on top of this astounding increase, and is now maintaining a currency standard of about three weeks. However, without additional personnel I am not sure how much longer this can continue. Moreover, I am acutely conscious that people now spending most of their time in efforts to maintain currency could better be used to improve the administrative and operational efficiency of the Office and to do some badly-needed long-range planning. I need hardly stress the challenge presented to us by the possibility of complete copyright law revision. I do not ask your indulgence, but I do seek your understanding and support in the months to come.

2. LEGISLATIVE DEVELOPMENTS*

By MORTON DAVID GOLDBERG

In the Annual Report of one of the predecessors of the present Register of Copyrights, the legislative situation of thirty years ago was characterized by the statement that "Although the year has passed without enactment of any new legislation by Congress affecting copyright there has been considerable suggestive agitation of the subject in committee."¹ (Precisely what the Register had in mind by "suggestive agitation" does not appear in his Report.) As I think is apparent, there has been a similar paucity of copyright legislation enacted in the present session of Congress.

Accordingly, I shall mention not only the bills relating to copyright which have been introduced in the present Congress, but also bills relating to copyright which were passed in the previous Congress—the 87th—and a few bills which have been introduced in state legislatures on this subject in the past few years.

I. The 88th Congress

The primary bills affecting copyright now pending in Congress relate to the repeal of the jukebox exemption and the proposal for a new design statute. In addition, bills have been introduced concerning various aspects of the government copyright problem; a proposed increase in Copyright Office fees; bills easing the tax impact on copyright proprietors; miscellaneous bills with respect to other copyright matters; and the trade secrets and unfair commercial activities bills.

A. The Jukebox Bills

Several bills have been introduced in the 88th Congress to repeal the jukebox exemption.² These bills are the latest in a long series of

* © 1964 by Morton David Goldberg. All rights reserved. Member of the New York Bar; Vice Chairman, ABA Committee on Program for Revision of the Copyright Law; Member, Panel of Consultants to the Register of Copyrights.

1. 36 REG. COPR. ANN. REP. 7 (1933).

2. The jukebox exemption is an exception to the exclusive right of the copyright proprietor of a musical composition to perform the work publicly for profit:

"The reproduction or rendition of a musical composition by or upon coin-operated machines shall not be deemed a public performance for

bills introduced over the years to accomplish this end.³ The American Bar Association has been on record since as early as 1953 in favor of the abolition of the jukebox exemption.⁴

One of the jukebox bills which was actively discussed in Congress during the present session, H.R. 1045,⁵ introduced by Mr. Celler on January 9, 1963, was strongly disapproved by resolution of the Copyright Law Revision Committee (301) of this Section in 1963.⁶ The principle of abolishing the exemption was approved, but the statutory procedure to be set up was deemed objectionable. That bill called for an establishment of an Office of Performing Rights Trustees to be appointed by the Attorney General to fix the amount of annual royalties from jukeboxes and to parcel out the proceeds to copyright proprietors or performing rights organizations in accordance with surveys to be made by the Trustees. Any person not an "operator" of the jukebox would have been exempt from liability even if admission were charged to the place where the jukebox was located.

H.R. 1046, introduced by Mr. Celler simultaneously with H.R. 1045, was identical with H.R. 1045 except that H.R. 1046 provided for no governmental procedure for administering the collection and distribution of royalties. Committee 301 refrained from approving H.R. 1046, however, because of its exemption of non-operators from liability.⁷

Subsequent to the introduction of H.R. 1045 and H.R. 1046, Mr. Celler introduced H.R. 5174⁸ on March 28, 1963 to repeal the jukebox exemption and establish a fixed annual license fee of \$5.00 per jukebox. This bill would have established a Performing Rights Administration under the direction of the Register of Copyrights, who would have held the unenviable position of Performing Rights Ad-

profit unless a fee is charged for admission to the place where such reproduction or rendition occurs." 17 U.S.C. §1 (e), Third Paragraph.

3. For a short summary, see H.R. Rep. No. 733, 88th Cong., 1st Sess. (1963), accompanying H.R. 7194.
4. 78 A.B.A. ANN. REP. 179 (1953).
5. This bill had earlier been introduced by Mr. Celler in the previous Congress as H.R. 12450, July 11, 1962 (87th Cong., 2d Sess.).
6. 1963 SUMMARY OF PROCEEDINGS OF SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW, AMERICAN BAR ASSOCIATION 53, cited hereinafter as "1963 SUM. PROC."; 1963 COMMITTEE REPORTS, *id.* 131-132, cited hereinafter as "1963 COM. REP."
7. 1963 COM. REP. 130-131.
8. Also introduced by Mr. Halpern on May 2, 1963 as H.R. 6017 (88th Cong., 1st Sess.).

ministrator. The Administrator would make an annual determination as to the equitable distribution of the license fees received. Hearings were held on this bill,⁹ but the bill was not reported out of the Judiciary Committee.

Instead, on June 24, 1963, Mr. Celler introduced still another bill, H.R. 7194,¹⁰ which would also repeal the jukebox exemption. The sole additional provision in this bill is that no proprietor of a jukebox location would be deemed an infringer unless he either, on the one hand, owned or controlled the jukebox or, on the other, refused after request to disclose the identity of the person who did own or control the jukebox.

This bill was reported out of the Judiciary Committee on September 10, 1963 with a majority report by Congressman Willis strongly supporting the bill and the two minority statements by Congressmen Rogers and Libonati strongly opposing the bill.¹¹ The bill was referred to the House Calendar,¹² where it now remains until brought up by the Rules Committee. That Committee held hearings on the bill on June 10, 1964¹³ and is to hold further hearings, but no date has been scheduled.

B. *The Design Bills*

As with the attempts to repeal the jukebox exemption, over the years there have been many attempts to enact separate legislation for the protection of original ornamental designs of useful articles.¹⁴ The principles of these bills have been approved by the American Bar Association.¹⁵ Four identical design bills have been introduced in the present Congress, H.R. 323,¹⁶ H.R. 769,¹⁷ H.R. 5523¹⁸ and

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9. Hearings on H.R. 5174 Before Subcommittee No. 3 of the House Committee on the Judiciary, 88th Cong., 1st Sess., ser. 2, (May 2 & 3, 1963).
 10. Also introduced by Mr. Halpern on September 17, 1963, as H.R. 8457 (88th Cong., 1st Sess.).
 11. H.R. REP. NO. 733, 88th Cong., 1st Sess. (1963).
 12. 109 CONG. REC. 16728 (1963).
 13. 110 CONG. REC. D457 (daily ed. June 10, 1964).
 14. See BIBLIOGRAPHY ON DESIGN PROTECTION, U.S. Copyright Office (1955, 1959).
 15. 87 A.B.A. ANN. REP. 400 (1962). The bills pending in the present Congress are substantially the same as those introduced in the 87th Congress, 1st Session, whose passage was specifically recommended by the American Bar Association: H.R. 6776, introduced by Mr. Flynt on May 4, 1961; H.R. 6777, introduced the same day; and S. 1884, introduced by Messrs. Hart, Wiley and Talmadge on May 16, 1961.
 16. Introduced by Mr. Flynt on January 9, 1963 (88th Cong., 1st Sess.).
 17. Introduced by Mr. Ford on January 9, 1963 (88th Cong., 1st Sess.).
 18. Introduced by Mr. Libonati on April 8, 1963 (88th Cong., 1st Sess.).

S.776.¹⁹ On December 6, 1963, the Senate bill passed the Senate and on December 12, 1963, the House Judiciary Committee held hearings on the House bills. These proceedings are still open.

The purpose of the design bills is to provide creators of ornamental designs of useful articles a form of protection which is presently unavailable—or available only through a cumbersome procedure—under the existing copyright²⁰ and design patent²¹ statutes. The present copyright statute provides a term of protection too long for most designs and a scope of protection which is too broad. It also has formalities which are not appropriate for design protection. And, perhaps most important, designs are afforded protection under the copyright statute only if they have separate existence as “works of art.”²²

The design patent statute is inadequate because a novelty search is required before a design patent may be obtained, and a design may have a commercial life so short that it has expired by the time a design patent can be obtained.

Under the pending design bills, protection would be available for an original ornamental design of a useful article from the date when the design is first made public. The protection would last for a period of five years, renewable for another five years. Protection would not be available, however, for a design which is not original, is substantially commonplace or is dictated solely by a utilitarian function of the article embodying it. The alternative marking symbol proposed under the design bills, “Ⓞ,” would join the line of related symbols under other United States laws for protection of intellectual and industrial property, including the “©” under the Copyright Act,²³ the “®” under the Lanham Act²⁴ and the “Ⓟ” proposed for sound recordings under Section 25 (b) (1) of the new bill proposing overall revision of the Copyright Act.²⁵

19. Introduced by Mr. Hart (for himself and Mr. Talmadge) on February 11, 1963 (88th Cong., 1st Sess.).

20. 17 U.S.C.

21. 35 U.S.C. 171-173.

22. 17 U.S.C. §5 (g).

23. 17 U.S.C. §19.

24. 60 Stat. 427, §29 (1946), as amended, 15 U.S.C. §1111.

25. Introduced as H.R. 11947 by Mr. Celler and as S. 3008, a companion bill, by Mr. McClellan on July 20, 1964 (88th Cong., 2d Sess.). This bill “has been introduced for purposes of study and comment, and no Committee hearings on it are contemplated at this session.” Transmittal letter from Register of Copyrights to members of the Register’s Panel of Consultants, July 21, 1964.

C. *Government Publications*

Action in Congress on the controversial question of copyright on government publications has been limited primarily to the mere introduction of several bills. In the 88th Congress only one of these has passed—and that one of perhaps only symbolic significance.

On January 9, 1963, Mr. Cramer introduced H. Res. 39 (88th Cong., 1st Sess.) to authorize an investigation into the copyrighting of works prepared by government employees and the publication by private publishers of material originally prepared by or for the government. This bill is substantially identical with H. Res. 794²⁶ and H. Res. 829²⁷ introduced in the 87th Congress. H. Res. 39 was referred to the Committee on Rules, where at last report it still remains.

H.J. Res. 6²⁸ and H.J. Res. 23²⁹ are bills proposing Constitutional amendments which would provide that the government "shall not engage in business, professional, financial, commercial or industrial enterprise except as specified in the Constitution." All government activities (including, presumably, those of the Government Printing Office) which violate such an amendment would be liquidated within three years from the amendment's ratification. Those resolutions were referred to the Committee on the Judiciary, which has taken no action.

Likewise, no action has been taken on two other bills introduced in the 88th Congress which deal, as an ancillary feature, with the question of government publications. H.R. 336³⁰ would establish a National Spelling Commission to reform the spelling of English words and to publish a United States Official Dictionary. This bill, dealing with the government copyright question somewhat gingerly, provides that the Spelling Commission "shall investigate the desirability of obtaining a copyright for the Dictionary when it is completed." The other bill, H.R. 3668,³¹ provides—less gingerly—that the faculty and affiliated personnel of the National Academy of Foreign Affairs, which the bill proposes to establish, would be encouraged to write and speak on subjects within their special competence and that "such writ-

26. Introduced by Mr. Mathias on September 4, 1962 (87th Cong., 2d Sess.).

27. Introduced by Mr. Cramer on October 5, 1962 (87th Cong., 2d Sess.).

28. Introduced by Mr. Alger on January 9, 1963 (88th Cong., 1st Sess.).

29. Introduced by Mr. Utt on January 9, 1963 (88th Cong., 1st Sess.).

30. Introduced by Mr. Hagen on January 9, 1963 (88th Cong., 1st Sess.). Also introduced in the same Session by Mr. Brown as H.R. 6394 on May 16, 1963.

31. Introduced by Mr. Hays (by request) on February 11, 1963 (88th Cong., 1st Sess.). Also introduced in the same Session by Mr. Fascell as H.R. 3937 on February 21, 1963, and by Mr. Vanik as H.R. 5999 on May 1, 1963.

ings and speeches other than those required in the performance of their official duties shall not be considered publications of the United States Government" under the Copyright Act³² or under the Printing Law.³³

And last,—by no means gingerly—Congress has specifically abrogated the Copyright Act to grant copyright to a revised manual of Senate Procedure, prepared by the Senate Parliamentarian and Assistant Parliamentarian. Under the joint resolution enacted as P.L. 88-155,³⁴ Congress has purported to grant copyright to the authors of the manual, "notwithstanding any provision of the copyright laws and regulations with respect to publications in the public domain. . . ."

D. *Copyright Office Fees*

The Patent Bar is not alone in its concern about statutory fees. H.R. 5136, introduced by Mr. Steed on March 25, 1963 (88th Cong., 1st Sess.), would make substantial increases in the present fee provisions of the Copyright Act. The bill was referred to the Judiciary Committee, which has taken no action as yet.

The 1963 Report of this Section's Committee 303 (Copyright Office Affairs) discussed in some detail the budgetary problems of the Copyright Office and specifically the relationship between fees paid by the public and appropriations received by the Office from Congress.³⁵ It was the opinion of the Committee that the optimum formula for determining the relationship between Copyright Office fees and Congressional appropriations to the Office would be: appropriations equals (1) fees plus (2) the value of deposits added to the collections of the Library of Congress. If, however, the Office needs additional personnel at the higher levels, the Committee took the tentative position that the best formula would be: appropriations equals (1) fees received by the Office plus (2) the value of deposits added to the Library plus (3) the cost of services rendered without fee to other governmental agencies and to the general public.

It should be noted that in fiscal 1949 (the first fiscal year following the last statutory increase in Copyright Office fees), the fees received by the Copyright Office were approximately equal to its Congressional appropriations; but by the end of fiscal 1962, the fees

32. 17 U.S.C. §8.

33. Act of January 12, 1895, 44 U.S.C. §58.

34. 77 Stat. 272 (1963). See H.R. Rep. No. 854 and S. Rep. No. 560, accompanying the bill, S.J. Res. 123, 88th Cong., 1st Sess. (1963).

35. 1963 COM. REP. 147-148.

received equaled only about 64% of Congressional appropriations.³⁶ H.R. 8190 (88th Cong., 1st Sess.),³⁷ the Patent Office fee bill which has passed the House,³⁸ aims at 75% as the percentage of Congressional appropriations which the Patent Office should bring in by way of fees.³⁹ It is not clear whether the Steed bill on Copyright Office fees aims at a similar percentage return.

E. *Taxation*

On January 24, 1963, Messrs. Lindsay and Javits introduced companion bills in the House and Senate to ameliorate the tax burden on copyright proprietors: H.R. 2519 and H.R. 2520, identical with, respectively, S. 497 and S. 498 (88th Cong., 1st Sess.). Under H.R. 2519 and S. 497, the essential changes in the Internal Revenue Code of 1954 would consist of modification of Sections 1221 and 1231 (b) (1) and the addition of a new Section 1250. These amendments would permit copyrights and copyrightable works to be treated as capital assets (within certain limitations) for purposes of capital gains treatment. The benefits would be similar to those now accorded patents and patent rights, but somewhat more restricted. H.R. 2520 and S. 498 would provide for the averaging of income derived from copyrights and copyrightable works by the individuals whose efforts created such works.

None of these taxation bills has been acted upon. The amendments enacted by the 1964 Revenue Act of 1964 (P.L. 88-272), however, provide bunched income relief which in part satisfies the need motivating H.R. 2520 and S. 498. See Internal Revenue Code of 1954, as amended, §§ 1301-1305.

F. *Trade Secrets and Unfair Commercial Activities*

On the periphery of the copyright law, but certainly in the focus of the attention of members of this Section, are the trade secrets⁴⁰

36. *Ibid.*

37. Introduced by Mr. Willis on August 21, 1963 (88th Cong., 1st Sess.).

38. 110 CONG. REC. 896 (daily ed., January 22, 1964).

39. See H.R. Rep. No. 949, accompanying the bill, 88th Cong., 2d Sess. (1964), and House discussion of the bill, 110 CONG. REC. 881-896 (daily ed., January 22, 1964). But *cf.* the Congressional policy on fees of administrative agencies declared in 5 U.S.C. §140.

40. Introduced as H.R. 5217 by Mr. McDowell on March 28, 1963 (88th Cong., 1st Sess.). The bill would make it a crime to steal trade secrets or transport stolen trade secrets in interstate or foreign commerce.

and unfair commercial activities⁴¹ bills which have been introduced in the 88th Congress. These will be discussed at the Trademark Symposium tomorrow, so I merely mention them here.

G. *Miscellaneous Bills*

No action has been taken on any of a number of miscellaneous bills introduced in the 88th Congress. This includes H.R. 6234,⁴² which would amend Section 526 of the Tariff Act of 1930⁴³ to prohibit the importation of any merchandise of foreign manufacture which "copies or simulates" any merchandise covered by a valid copyright or design patent.

There has likewise been no action on H.R. 4567,⁴⁴ which would permit the extension of copyrights for an additional fifteen-year period, conditioned upon the proprietor turning over one-half of the annual royalties for the extended period to the Secretary of the Treasury. The bill would establish a series of awards for promising young composers and authors and would promote the performance and publication of their works, the program to be financed one-half by the royalties received by the Treasury and one-half by general Congressional appropriations.

H.R. 4567 was opposed last year by Committee 301 (Copyright Law Revision) of this Section in its annual report.⁴⁵ Excellent critiques of the bill appear in that report. H.R. 4567 is a modification of H.R. 9906 (87th Cong., 2d Sess.), which was disapproved both specifically and in principle by the Section in 1962.⁴⁶ The earlier bill would have given the government copyright rights in the entire body of works

41. Introduced as H.R. 4651 by Mr. Lindsay and as S. 1038, a companion bill, by Mr. Javits on March 7, 1963 (88th Cong., 1st Sess.). These bills would grant rights and remedies with respect to a broad category of unfair commercial activities in or affecting commerce, including: acts likely to cause confusion or dilution; false or misleading statements; deceptive acts or those which violate "reasonable standards of commercial ethics"; and the institution in bad faith of an action under the proposed statute. The bill would not, however, enlarge the existing rights and remedies under the patent and copyright statutes, although it would specifically provide relief in addition to, and not in exclusion of, common law rights and remedies and those under state and other federal statutes.

42. Introduced by Mr. Ashley on May 13, 1963 (88th Cong., 1st Sess.).

43. 19 U.S.C. 1526.

44. Introduced by Mr. McDowell on March 6, 1963 (88th Cong., 1st Sess.).

45. 1963 COM. REP. 132-133, 138-140.

46. 1962 SUM. PROC. 45.

in the public domain. The later bill proposes giving the government an interest only for a limited time, but remains an undesirable bill.

S. 405⁴⁷ proposes that a broadcast of a phonograph record would not constitute a copyright infringement unless the name of the copyright proprietor is printed on each side of the record or the person responsible for the broadcast had reason to believe that it would be an infringement. The bill has many defects, which were set forth in last year's report of Committee 301.⁴⁸ The Section disapproved the bill.⁴⁹

The last of the miscellaneous bills, H.R. 6745,⁵⁰ would provide a more praiseworthy exemption from liability. That bill proposes that the use of books on sound recordings for the use of the blind and quadriplegics would not constitute an infringement. Such recordings and devices for utilizing them would be provided by the Library of Congress.

II. The 87th Congress

In the 87th Congress there were four bills passed having to do with copyrights and related matters. The most significant having to do with copyright itself was of course the interim extension of certain renewal copyright terms, P.L. 87-668, enacted September 19, 1962.⁵¹ This bill was premised on a desire to prevent any works now in their renewal term from falling into the public domain prior to the enactment of an overall revision of the Copyright Act. It provides:

That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution would expire prior to December 31, 1965, such term is hereby continued until December 31, 1965.

Under P.L. 87-846, enacted October 22, 1962,⁵² the Trading With The Enemy Act⁵³ was amended to divest the Alien Property Custodian and the Attorney General of all copyrights of former enemy nationals and to return such copyrights to the proper owners. The divestment was subject to the rights of prior licensees and assignees and the right

47. Introduced by Mr. Ellender on January 22, 1963 (88th Cong., 1st Sess.).

48. 1963 COM. REP. 129-130.

49. 1963 SUM. PROC. 53.

50. Introduced by Mr. Lindsay on June 3, 1963 (88th Cong., 1st Sess.).

51. 76 Stat. 555 (1962).

52. 76 Stat. 1107 (1962).

53. 40 Stat. 411 (1917), as amended, 50 U.S.C. App. §1 et seq.

of the United States to reproduce any divested motion picture film for its own use or exhibit such film.⁵⁴

P.L. 87-646,⁵⁵ enacted on September 7, 1962, made a technical amendment to § 8 of the Copyright Act, a change in language but not in substance, as a part of a codification of certain laws relating to the postal service.

To help deter the counterfeiting of phonograph records and labels, P.L. 87-773 was enacted on October 9, 1962.⁵⁶ This act adds a new § 2318 to Title 18, U.S.C., to provide criminal penalties for knowingly and with fraudulent intent trafficking in phonograph records bearing forged or counterfeit labels.

And lastly, should copyright lawyers have substantial disagreement with the Register on the registrability of a work, it should be noted that P.L. 87-748, enacted October 5, 1962,⁵⁷ permits mandamus actions against government officials to be brought in the United States District Court where the plaintiff resides, thus obviating the necessity of instituting an action in the District of Columbia.

III. State Legislation

In the last few years there has also been "suggestive agitation" of copyright matters in state legislatures. Bills have been introduced in the legislatures of Alabama, Idaho, Mississippi and Rhode Island, apparently aimed at restricting the activities of the performing rights organizations. In Mississippi, for example, a bill was introduced entitled—perhaps somewhat whimsically— "An Act in the Aid of the Federal Copyright Laws and to Assist in Effectuating Their True Intent and Their Enforcement in the State of Mississippi. . . ." ⁵⁸ This bill would have made it unlawful for owners of musical compositions to form any association or other group when the members of the group constitute a "substantial number" of the copyright owners of musical compositions in the United States and when one of the objects of such a group is to fix license fees for public performance of such compositions for profit.

This bill would also have required anyone wishing to license performing rights in a copyrighted musical composition to file a list of

54. See also the related amendment to the Trading with the Enemy Act enacted on October 23, 1962 by P.L. 87-861, 76 Stat. 1139 (1962).

55. 74 Stat. 605 (1962).

56. 76 Stat. 775 (1962).

57. 76 Stat. 744 (1962), adding a new §1361 and §1391 (e) to Title 28, U.S.C.

58. Senate Bill No. 1751, introduced February 23, 1962, identical with House Bill No. 465, introduced February 26, 1962.

such compositions and related data with the Mississippi Secretary of State each year, to be supplemented monthly. Blanket licenses by any group of owners would be declared unlawful and anyone wishing to institute an action against a performing rights organization could do so by service of process on the Mississippi Secretary of State. This bill and similar Mississippi bills⁵⁹ failed to pass the legislature. On May 18, 1962, however, the Mississippi legislature memorialized Congress to amend the Copyright Act to prohibit copyright owners from making unlawful combinations and from requiring blanket licenses not based upon the specific musical compositions actually performed.⁶⁰

The Idaho legislature, in a bill expressing the purpose of "Protecting the Owners of Copyrighted Music or Drama . . .,"⁶¹ also sought to restrict performing rights organizations, but neither this nor a similar Idaho bill⁶² was enacted. Similar bills in Alabama⁶³ and Rhode Island⁶⁴ also failed to become law.

Conclusion

This paper has been devoted primarily to legislative developments in the 87th and 88th Congresses having to do with copyright matters other than the overall revision program. Hopefully, a review of the developments in the 89th Congress can be focussed on the revision program and will report somewhat greater progress toward facilitating "the Progress of Science and useful Arts."

59. House Bill No. 465, *supra*, note 58; Senate Bill No. 1904, introduced April 6, 1964.

60. House Concurrent Resolution No. 102, 1962 MISS. SESS. LAWS.

61. Senate Bill No. 110 (37th Sess. 1963).

62. House Bill No. 383 (37th Sess., 1963).

63. House Bill No. 685, introduced June 27, 1963.

64. Senate Bill No. 305, introduced February 13, 1964.

3. INTERNATIONAL DEVELOPMENTS*

By JOSEPH S. DUBIN**

The last decade has produced extensive developments in the field of copyright. The Universal Copyright Convention has grown to forty-seven members.¹ The Berne Convention, rejuvenated by means of the Brussels Revision, now has an enrollment of sixty-four,² largely due

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1. Geneva, September 6, 1952 (hereinafter cited as U.C.C.). See generally Dubin, "Universal Copyright Convention," 42 Cal. L. Rev. 89 (1954).
 - (a) The following countries have either acceded to or ratified the U.C.C. (the date indicates the coming into force of the Convention): Andorra, Cambodia, Chile, Costa Rica, German Fed. Republic, Haiti, Israel, Laos, Monaco, Pakistan, Spain, United States, Sept. 16, 1955; Argentina, Feb. 13, 1958; Austria, July 2, 1957; Belgium, Aug. 31, 1960; Brazil, Jan. 13, 1960; Canada, Aug. 10, 1962; Cuba, June 18, 1957; Czechoslovakia, Jan. 6, 1960; Denmark, Feb. 9, 1962; Ecuador, June 5, 1957; Eire, Jan. 20, 1959; Finland, April 16, 1963; France, Jan. 14, 1956; Ghana, Aug. 22, 1962; Greece, Aug. 24, 1963; Holy See, Oct. 5, 1955; Iceland, Dec. 18, 1956; India, Jan. 21, 1958; Italy, Jan. 24, 1957; Japan, Apr. 28, 1956; Lebanon, Oct. 17, 1959; Liberia, July 27, 1956; Liechtenstein, Jan. 22, 1959; Luxemburg, Oct. 15, 1955; Mexico, May 12, 1957; Nicaragua, Aug. 16, 1961; Nigeria, Feb. 14, 1962; Norway, Jan. 23, 1963; Panama, Oct. 17, 1962; Paraguay, Mar. 11, 1962; Peru, Oct. 16, 1963; Philippines, Nov. 19, 1955; Portugal, Dec. 25, 1956; Sweden, July 1, 1961; Switzerland, Mar. 30, 1956; United Kingdom, Sept. 27, 1957.
 - (b) By a note from the Philippine Minister in Paris dated Nov. 14, 1955, UNESCO was advised that the President of the Philippines had directed the withdrawal of the instrument of accession prior to Nov. 19, 1955, at which time the U.C.C. would have become effective. As yet, no determination has been made as to the legal effect of the withdrawal.
 - (c) (i) Canada: *Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Copyright 16* (1957), recommended ratification of U.C.C.;
 (ii) New Zealand: *Report of Copyright Committee 18, 144* (1959), recommended ratification of U.C.C.
2. Berne Convention, Additional Article and Final Protocol, Sept. 9, 1886; Paris, Additional Act and Interpretative Declaration, May 4, 1896; Berlin Revision, Nov. 13, 1908; Additional Protocol, Mar. 20, 1914; Rome Revi-

to the continued adherence or accession of the newly independent nations.³ New countries have either withdrawn,⁴ refused to recognize

sion, June 28, 1928; Brussels Revision, June 26, 1948. See, generally, UNESCO, COPYRIGHT LAWS & TREATIES OF THE WORLD (1956-63).

- (a) The following countries have adhered to or ratified the Brussels Revision, which went into effect Aug. 1, 1951; Austria, Belgium, Brazil, Denmark, Eire, Finland, France, Greece, Holy See, India, Israel, Italy, Liechtenstein, Luxemburg, Monaco, Morocco, Norway, Philippines, Portugal, South Africa, Spain, Sweden, Switzerland, Tunisia, Turkey, United Kingdom and Yugoslavia. See: 77 *Droit d'Auteur* (hereinafter referred to as D.A.) 4 (1964).
 - (b) Excluding the countries that have adhered to the Brussels Revision, the following countries have adhered to the Rome Revision: Australia, Bulgaria, Canada, Czechoslovakia, Germany, Hungary, Iceland, Japan, Lebanon, Netherlands, New Zealand, Pakistan, Poland and Rumania. See 77 D.A. 4 (1964).
 - (c) Thailand, which has not acceded to the Rome Act nor to the Brussels Revision, is bound by the Berlin Act with those other countries which have acceded to the Berlin Act. See 77 D.A. 4 (1964).
 - (d) Tangiers acceded to the Berlin Revision without formal ratification. See 11 *Revue Internationale du Droit d'Auteur* (hereinafter referred to as R.I.D.A.) 84, 108 (1956).
3. (a) Rome Revision applied: Burma, 27 D.A. 33 (1914); Ceylon, note dated July 20, 1959, 72 D.A. 205 (1959); Gambia, British Order of Council, June 24, 1912; Germany (East), effective from Aug. 29, 1955, 7 BULL. Cr. Soc. 138 (1960); Malaya, 45 D.A. 39 (1932); Nigeria, 45 D.A. 39 (1932); Rhodesia-Nyassaland, 45 D.A. 39 (1932); Sierra Leone, note of Feb. 20, 1962 advised Sierra Leone would observe existing treaty obligations (U.K. Board of Trade note of Mar. 19, 1962); Somalia, 45 D.A. 39 (1932); Tanganyika, British Order of Council, Apr. 16, 1924; Uganda, British Order of Council, June 24, 1912.
- (b) Brussels Revision applied:
- (i) By France, 65 D.A. 49 (1952): Cameroon, Central African Republic, Chad, Guinea, Madagascar, Mauretania and Togo;
 - (ii) By U.K.: Kenya, 76 D.A. 238 (1963); Zanzibar, 76 D.A. 6 (1963);
 - (iii) Congo (Brazzaville), note of May 8, 1962, 75 D.A. 146 (1962); Congo (Leopoldville), note of Oct. 8, 1963, 76 D.A. 22 (1963); Cyprus, note of Feb. 24, 1964, 77 D.A. 127 (1964); Dahomey, note of Jan. 3, 1961, 74 D.A. 69 (1961); Gabon, note of Dec. 19, 1961, eff. Mar. 20, 1962, 75 D.A. 70 (1962); Ivory Coast, note of July 8, 1961, eff. Jan. 1, 1962, 74 D.A. 257 (1961); Mali, note of Mar. 19, 1962, 75 D.A. 146 (1962); Niger, note of May 2, 1962, 75 D.A. 170 (1962); Senegal, note of June 30, 1962, eff. Aug. 25, 1962, 75 D.A. 170 (1962); Upper Volta, note of Apr. 20, 1963, eff. Aug. 19, 1963, 76 D.A. 156 (1963).
4. Indonesia denounced Rome, by note of Feb. 9, 1959, effective Feb. 9, 1960, 24 R.I.D.A. 155 (1959), Netherlands had previously applied Rome Revi-

the application of the Convention,⁵ have specifically recommended against joining or have passed legislation preventing them from joining Berne.⁶

There have been no new signatories to the Washington Convention⁷ since 1955, but thirteen American Republics, ten of whom are signatories to the Washington Convention, have joined the U.C.C.⁸

The Rome Convention on Neighboring Rights⁹ came into force May 18, 1964.¹⁰ The United States is not a signatory and it is not in

sion, 45 D.A. 41 (1932); Syria denounced Rome by note of Jan. 12, 1961, effective Jan. 12, 1962, 74 D.A. 70 (1961), France had previously applied Rome Revision, 46 D.A. 133 (1933).

5. Cambodia, note of Sept. 28, 1960, 73 D.A. 338 (1960); China, by note of Dec. 6, 1960 advised that Berne, as applied by Japan to Formosa, was not applicable after Oct. 25, 1945, 74 D.A. 27 (1960); Korea, by note of July 15, 1960, advised its adherence by Japan was of no effect after Aug. 15, 1945, 73 D.A. 337 (1960); Vietnam, by a note of June 17, 1960, advised the undertaking by France was not effective, 73 D.A. 337 (1960).
 6. Canada: *Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Copyright* 16 (1957) recommended against accession to Brussels; Ghana: The provisions in the Copyright Act of 1961 prevent Ghana from adhering to Brussels. (See footnotes 59-62, *infra*); New Zealand: *Report of Copyright Committee* 16, 144 (1959), recommended against accession to Brussels.
 7. Inter-American Convention on the Rights of the Author in Literary, Scientific and Artistic Works, Washington, D.C., June 22, 1946. Cuba deposited its instrument of ratification on Sept. 29, 1955.
 8. Argentina, Brazil, Chile, Costa Rica, Cuba, Ecuador, Haiti, Mexico, Nicaragua, Panama, Paraguay, Peru and the United States are members of the U.C.C. Argentina, Bolivia, Brazil, Chile, Costa Rica, Cuba, Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Mexico, Nicaragua and Paraguay are members of the Washington Convention.
 9. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Rome, Oct. 26, 1961.
 10. The treaty, pursuant to Article 25, comes into force three months after the date of deposit of the sixth instrument of ratification, acceptance or accession. The following countries acceded or ratified: Congo (Brazzaville) acc. June 29, 1962; Ecuador rat. Dec. 19, 1963; Mexico rat. Feb. 17, 1964; Niger acc. Apr. 5, 1963; Sweden rat. July 13, 1962; U.K. rat. Oct. 30, 1963. 77 D.A. 28, 44 (1964). Czechoslovakia acc. May 13, 1964 (eff. Aug. 14, 1964). 77 D.A. 162 (1964).
- (a) The following are signatories: Argentina, Austria, Belgium, Brazil, Cambodia, Chile, Denmark, France, Germany, Holy See, Iceland, India, Italy, Mexico, Spain, Sweden, United Kingdom and Yugoslavia, Oct. 26, 1961; Israel, Feb. 7, 1962; Finland, June 21, 1962; Ecuador, Lebanon and Monaco, June 26, 1962; Eire and Paraguay, June 30, 1962. See 77 D.A. 28 (1964).

a position to ratify, accede to or accept the Convention. Domestic legislation would be required, since the Convention is not self-executing.¹¹

Under Article 26 of Brussels, the Convention may be made applicable to territories and possessions, but unless so specified the Convention does not apply. (A similar provision is found in the U.C.C.)¹² Under Article 25 (3) of Brussels, countries outside the Union may accede, with accession effective one month after the date of the notification made by Switzerland to the other countries of the Union, unless a later date is specified.¹³

Upon attaining their independence, the new nations, formerly colonies, territories or possessions to whom the Convention had previously so been made applicable, are Countries of the Union but not Contracting Countries. They may continue to adhere,¹⁴ may terminate and then adhere, or denounce and withdraw.¹⁵ A Union Country may denounce, effective within twelve months.¹⁶

In the case of Gabon, Ivory Coast and Upper Volta,¹⁷ there was a gap of more than one month between notification and the effective date, which could create problems as far as continued protection in those countries is concerned. A legal fiction has been developed, allowing continued adherence in order to avoid any hiatus.¹⁸

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11. (a) Under Article 26, each State undertakes to adopt, in accordance with its Constitution, the measures necessary to insure application of the Convention and, at the time of deposit of its instrument of ratification, acceptance or accession, must be in a position under its domestic law to give effect to the terms of the Convention. It should be noted there is no time limit in Article 26, for some countries would require a period of time in order to revise their domestic law.
 - (b) A similar provision is found in Article 10, U.C.C. It was necessary to enact P.L. 743, 83rd Congress, 2nd Session, approved on Aug. 31, 1954, to enable the United States to deposit its instrument of ratification to the U.C.C.
 12. Article 13.
 13. The Convention is effective three months after deposit of the instrument of ratification, acceptance or accession. U.C.C.9 (2).
 14. See footnote 3 (b), *supra*.
 15. See footnotes 4 and 5, *supra*.
 16. Brussels 29 (2, 3). A State may denounce, effective within twelve months. U.C.C. 14.
 17. See footnote 3 (b) (iii), *supra*.
 18. Masouyé, "Decolonisation, independence et droit d'auteur," XXXVI-XXXVII R.I.D.A. 85 (1962); Masouyé, "The International Union on the Threshold of 1964," 77 D.A. 5 (1964).

Under Article 17, U.C.C., the Convention does not affect the provisions of Berne, nor membership therein. (This is the "safeguarding clause.") The Declaration annexed to Article 17 provides: (1) Works which have as their country of origin a country that has withdrawn from Berne, after January 1, 1951, are not protected by the U.C.C. in Berne countries; (2) The U.C.C. is inapplicable between countries of Berne insofar as it relates to the protection of works whose country of origin is a Berne country.

Ghana, to whom the Rome Revision had been applied by the United Kingdom,¹⁹ has not notified Berne that Rome is applicable to it. It acceded to the U.C.C. on August 22, 1962,²⁰ and its legislation effectively prevents it from applying Berne.²¹ For all practical purposes, Ghana is no longer in the Berne Union and has withdrawn. Is the "safeguarding clause" applicable?²²

It would appear that Ghana felt the "safeguarding clause" could not be applied, for that clause refers to works having as their country of origin a country that had withdrawn from Berne. Since Ghana never belonged to Berne of its own volition, but only as a colony, it did not regard the "safeguarding clause" as applicable to it. The repercussions in the new African Countries might be rather unfortunate if any member of the Berne Union sought to invoke the provisions of Article 17, U.C.C.²³

I. LEGISLATION

Many legislative changes have taken place or been proposed during the last ten years. These have ranged from complete revision to minor amendments—the countries have included the Nordic Bloc,²⁴ Iron Curtain Countries and satellites,²⁵ Latin American Republics,²⁶

19. 45 D.A. 39 (1932).

20. See footnote 1 (a), *supra*.

21. See footnotes 6, *supra*, 59-62, *infra*.

22. See footnote 18, *supra*.

23. Straschnov, "The Ghanaian Copyright Act," 75 D.A. 93 (1962).

24. Denmark: Laws 157 and 158 of May 31, 1961, 75 D.A. 142 (1962); Finland: Laws 404 and 405 of July 8, 1961, 76 D.A. 21 (1963); Norway: Laws of June 17, 1960 and May 12, 1961, 74 D.A. 258 (1961), 76 D.A. 28 (1963). Act of Dec. 14, 1962, amending Act of Dec. 2, 1955, extending term of protection to Dec. 31, 1966, see footnotes 38-46, *infra*; Sweden: Laws 729 and 730 of 1960, 74 D.A. 156, 163 (1961).

25. Albania: Decree 538 of Sept. 24, 1957, *Unesco Copy. L. & T.* (1956-63); Rumania: Laws of June 18, 1956, July 24, 1957, *Unesco Copy. L. & T.*

those steeped in the Anglo-Saxon concept of jurisprudence,²⁷ African Independencies,²⁸ those of the Far East²⁹ and old and established sources for the works of creators.³⁰ Our own country is presently in-

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- (1956-63); U.S.S.R.: Law of Dec. 8, 1961, 75 D.A. 190 (1962); Yugoslavia: Law of July 10, 1957, 71 D.A. 155, 162 (1958).
26. Dominican Republic: Law of Jan. 22, 1958, *Unesco Copy. L. & T.* (1956-63); Ecuador: Law of Oct. 24, 1957-Jan. 22, 1958, 73 D.A. 246 (1960); El Salvador: Decree 376 of Sept. 6, 1963, 77 D.A. 49 (1964); Guatemala: Law 1037 of Feb. 8-11, 1954, *Unesco Copy. L. & T.* (1956-63); Mexico: Law of Dec. 29, 1956, *Unesco Copy. L. & T.* (1956-63); Peru: Law 13714 of Sept. 1, 1961, 75 D.A. 287 (1962); Venezuela: Law of Dec. 12, 1962, 76 D.A. 94 (1963).
27. Eire: Act 10 of 1963, 76 D.A. 157, 183 (1963); India: Law 14 of June 4, 1957, *Unesco Copy. L. & T.* (1956-63); New Zealand: Act 33 of 1962, 38 R.I.D.A. 147 (1963); United Kingdom: Law of Nov. 5, 1956, *Unesco Copy. L. & T.* (1956-63).
- (a) Australia: *Report, Copyright Law Review Committee* (1959).
- (b) Canada: *Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Copyright* (1957).
- (c) Pakistan: Copyright Ordinance of June, 1962 (to replace the Indian Copyright Act of 1914, based on the U.K. Act of 1911). Not yet in force. Whale, "New Legislation on Copyright in Countries of the British Commonwealth," XLI R.I.D.A. 37, 51 (1963).
- (d) South Africa: Copyright Bill, 1963, 1964 (to replace Copyright Act of 1916 to bring the law up to date in accordance with British Act of 1956). See, also, footnote 76, *infra*.
28. Egypt: Law of July 24, 1954, *Unesco Copy. L. & T.* (1956-63); Ethiopia: Civil Code, 1960, 75 D.A. 6 (1962); Ghana: Copyright Act, 1961, 75 D.A. 93, 148 (1962), 76 D.A. 33 (1963).
29. China: No more pirated books or records may be shipped or taken out of Formosa, *N.Y. Times* Oct. 20, 1963; Japan: Term changed from thirty years after death to thirty-three years after death, 76 D.A. 124 (1963); Korea: Law 432 of Jan. 28, 1957, XXIII R.I.D.A. 90 (1959).
30. France: Law 57-296 of Mar. 11, 1957; Italy: Under Law 1337 of Dec. 27, 1961, period of protection extended to Dec. 31, 1962. 75 D.A. 152 (1962); Holy See: Law of Jan. 12, 1960 puts into force present Italian law. *Unesco Copy. L. & T.* (1956-63).
- (a) France: Under bill approved by the cabinet on July 23, 1963, foreign authors will no longer be protected in the absence of reciprocity. The bill will afford protection for a foreign author if his country seeks the French author's consent and pays equitable remuneration. *N.Y. Herald Tribune* (Paris) July 24, 1963; see, also, footnotes 113-115 *infra*.
- (b) Germany: Draft of 1954 superseded by new Draft of 1959. On March 23, 1962, four bills were submitted to the Federal Assembly and a

volved in a proposed general revision, but this does not form part of this paper, except as to certain items that will be discussed *infra*.³¹ Comparatively few countries have no copyright law or legislation³²—the trend is toward protecting the rights of both creator and user.

Time does not permit the discussion of all of the legislative changes that took place during the past decade and, therefore, only the more recent will be mentioned.

committee was appointed to study the bills. 15 *Unesco Copyright Bulletin* 191 (1963). See, also, footnotes 63-67, *infra*.

(i) In 1959, a bill was introduced to protect the right of privacy, but the bill has not yet been enacted into law. 75 D.A. 34 (1962).

31. See footnotes 88-123, *infra*.

32. (a) The following countries have no copyright law or legislation: Afghanistan: Only Press Law of 1950; Iran: Penal provisions available; Iraq: No information available; Kuwait: No information available; Libya: Note to UNESCO Mar. 10, 1954; Mongolia: No information available; Nepal: Letter to UNESCO of Feb. 15, 1960; Saudi Arabia: No information available; Sudan: No information available; Vietnam: Note to UNESCO of Aug. 25, 1954; Yemen: Note to UNESCO of May 27, 1954.

(b) Congo (Leopoldville): Belgium law applicable; Copyright Statute of June 21, 1948.

(c) The following countries still apply the French law (French Decree of Oct. 29, 1887 extended French law to colonies); Algeria, Cameroon, Central African Republic, Congo (Brazzaville), Dahomey, Gabon, Guinea, Ivory Coast, Madagascar, Mali, Mauretania, Morocco, Niger, Senegal and Upper Volta.

(i) French law specifically applied: Cambodia: Letter to UNESCO of Sept. 28, 1955; Chad: Letter to UNESCO of Feb. 17, 1961; Laos: Letter to UNESCO of Sept. 8, 1951; Togo: Letter to UNESCO of Feb. 15, 1961.

(d) Andorra: French and Spanish law applicable.

(e) Indonesia: Letter to UNESCO of Sept. 1, 1954, Netherlands law applicable.

(f) Italian law applicable: Holy See, Law of Jan. 12, 1960; Somalia. Law 1950 of Nov. 7, 1925, Decree of Feb. 8, 1932. See *Unesco Copy. L. & T.* 1956-1963.

(g) British law applicable:

(i) Act of 1911: Burma: Order of Apr. 9, 1951; Ceylon: Ceylon Ind. Act, 1947 (4); Cyprus: In effect from Aug. 16, 1960, Schedule to Cyprus Ind. Act, 1960, Item 13; Tanganyika: Order of Apr. 16, 1924; Gambia, Kenya, Nigeria, Rhodesia-Nyasaland, Sierra Leone and Uganda: Order of June 24, 1912.

(ii) Act of 1956: Zanzibar: Order of Dec. 21, 1961.

The laws enacted by the Nordic Bloc³³ all uniformly protect neighboring rights.³⁴ Sweden extended the term of protection from thirty years to fifty years after death³⁵ and Norway, in order to protect the works of Edvard Greig,³⁶ further extended until 1966 the term of protection of works that would have expired between 1962-1965.³⁷

In 1955, Norway adopted legislation providing for a six-year extension for works whose authors had died before December 31, 1955 and that were not in the public domain on December 2, 1955.³⁸ On the basis of reciprocity, Norway concluded arrangements with Austria,³⁹ France,⁴⁰ Italy,⁴¹ Brazil⁴² and Spain.⁴³ Under the terms of the latest

33. See footnote 24, *supra*.

34. See footnote 24, *supra*. Denmark, Articles 45-48; Finland, Articles 45-50; Norway, Articles 42, 45, 58; Sweden, Articles 45-49.

(a) Sweden, Finland and Denmark are signatories to the Neighboring Rights Convention. See footnote 10 (a), *supra*. Sweden has ratified the same. See footnote 10, *supra*.

35. Article 43.

36. Grieg died in 1907 and his works would have fallen into the public domain in 1957; See Lid, "Classiques au Crepuscule," VIII R.I.D.A. 85 (1955); Dubin, "Extensions of Copyright in Europe" 8 U.C.L.A. L. Rev. 682, 691 (1961).

37. Act of Dec. 14, 1962. 76 D.A. 28 (1963).

38. Law of Dec. 2, 1955.

39. Notes of Dec. 12, 1956. Norwegian works are entitled to the benefit of the Austrian seven-year extension, if the works arose before Jan. 1, 1949 and were not in the public domain on Aug. 5, 1953 (Austrian Law of July 8, 1953). Austrian works are entitled to the benefit of the Norwegian six-year extension under the Law of 1955.

40. Note of Oct. 24, 1956. Norwegian works are entitled to the French World War II extension of eight years and one hundred twenty days, if not in the public domain on Aug. 13, 1941 and if published before Jan. 1, 1948 (*Journal Officiel*, Sept. 25, 1951) with a term of extension not to exceed six years, period of extension in Norway. French works are entitled to the Norwegian extension of six years.

41. Notes of Dec. 16, 1956. Italian works have the benefit in Norway of the Norwegian six-year extension, while Norwegian works, not in the public domain on Aug. 17, 1945, receive the benefit of the Italian six-year extension (Italian Laws of July 20, 1945, Dec. 19, 1956).

42. Note of Dec. 19, 1956. Brazilian works receive the benefit of the Norwegian six-year extension while Norwegian authors obtain a six-year extension in Brazil, which has a term of protection of sixty years after death (Brazil, C.C. Article 649).

43. Note of Dec. 21, 1956. Spanish works benefit in Norway by the six-year extension and Norwegian works receive a similar six-year extension in Spain, which has a term of protection of eighty years after death (Spanish Law of Jan. 10, 1879 (6)—to third persons until twenty-five years after

Norwegian extension. the works of Austrian and French authors would be entitled to the benefit of the additional period in Norway and vice versa, but, in the absence of an exchange of additional notes, the extension would not appear to be applicable to the works of Brazilian, Italian or Spanish authors in Norway, or vice versa.⁴⁴

If one preserves the fiction that the 1955 extension was enacted to compensate for losses suffered because of World War II⁴⁵ and that, therefore, those who were the owners of rights during the war years should benefit from the extension, since such owners have already been compensated for their war losses it would appear that only the author or his heirs, in the absence of specific contract, would benefit from the additional six-year extension under the 1962 Law.⁴⁶

The new Soviet Law of 1961⁴⁷ fixes a term of protection during the lifetime of the author and then to his heirs (not assigns) with the period thereafter to be determined by the laws of the various Federated Republics.⁴⁸ Protection is still not afforded foreign works.⁴⁹

The El Salvador Law of 1963⁵⁰ provides for a compulsory license in favor of the government,⁵¹ protection of neighboring rights,⁵² registration and notice as a condition to judicial proceedings,⁵³ and vests authorship in the director of a photoplay.⁵⁴

The Venezuelan Law of 1962⁵⁵ grants the producer, in the absence of proof to the contrary, the exclusive right of exploitation.⁵⁶ There

death and to heirs for the remaining fifty-five years.) See, generally: Dubin, "Extensions of Copyright in Europe," 8 U.C.L.A. L. Rev. 682 (1961) re footnotes 39 to 43, *supra*.

44. Austria and France: The exchange of notes referred to the Norwegian Law of Dec. 2, 1955. See footnotes 39 and 40, *supra*; Brazil, Italy and Spain: The exchange of notes referred to an extension of six years. See footnotes 41, 42 and 43, *supra*.

45. But see footnote 36, *supra*.

46. Birger-Larsen, "Letter From Norway," 76 D.A. 217 (1963).

47. See footnote 25, *supra*.

48. Article 105. Under the Act of 1928 (15) the term of protection was fifteen years after death.

49. Article 97. The Soviet Union has not entered into any international treaties.

50. See footnote 26, *supra*.

51. Articles 45-47.

52. Articles 56-80.

53. Articles 77-80.

54. Article 35.

55. See footnote 26, *supra*.

56. Articles 12, 15, 16.

is no protection for neighboring rights. The author is entitled to a proportionate share of the receipts realized from the exploitation of the work.⁵⁷

Authors' groups have complained that the Copyright Law of Ghana⁵⁸ ignores essential copyright principles and disregards the rights of authors.⁵⁹ Ghana felt that the Berne Convention was inappropriate since most intellectual works were of foreign origin and there was a reluctance on the part of the government to have large sums of money leave the country. The Law is an original piece of legislation specifically adopted for the requirements of a newly independent country.⁶⁰ The term of protection ranges from twenty years after publication (published films or records), to twenty-five years after death (unpublished works), to the death of the author or twenty-five years after publication, whichever is later (published works). If a work is first published after its copyright as an unpublished work has expired, a new term begins.⁶¹ There is a compulsory license in favor of the government.⁶²

The German Draft Law on copyright and neighboring rights⁶³ contains provisions regarding *domaine public payant*,⁶⁴ lending libraries, *droit de suite*,⁶⁵ neighboring rights, proposed adherence to Brussels and authors' societies.⁶⁶ Under the new proposed law there is a provision that the embodiment of broadcasts of copyrighted works on tape for private use does not require consent but obliges the user to pay royalties. Despite heavy opposition by GEMA, this provision was

57. Article 55. See France, Law of 1957 (35).

58. See footnote 28, *supra*.

59. See Straschnov, footnote 23, *supra*; Malaplate, "Ghana Copyright Act," 76 D.A. 33 (1963).

60. See Straschnov, footnote 23, *supra*.

61. Article 2 (2).

62. Article 12.

63. Footnote 30 (b), *supra*.

64. After expiration of the normal period of protection, a work may not be freely used without payment of royalty, generally to authors' societies which utilize such funds for cultural purposes or to aid needy authors and their families. See Dubin, "Extensions of Copyright in Europe," 8 U.C.L.A. L. Rev. 682, 686 (1961).

65. The author or artist shares in the money which changes hands upon sales of his work, subsequent to the transaction wherein he transferred such work. See Dubin, "Motion Picture Rights—United States and International," 28 So. Cal. L. Rev. 205, 213 (1955).

66. XV *Unesco Copyright Bulletin* 191 (1962).

canceled because it was felt to be an intrusion into privacy and incapable of being controlled.⁶⁷

The British Commonwealth Countries, in enacted and proposed legislation, have included a Performing Right or Copyright Tribunal, with jurisdiction to grant licenses to perform in public or to broadcast literary, dramatic or musical works, to cause sound recordings to be heard in public or to be broadcast and to cause television broadcasts to be heard or seen in public.⁶⁸

The Performing Right Tribunal, while not compatible with the strict letter of the Brussels text, is based on a Declaration by the British Delegation to Brussels in 1948.⁶⁹

With the exception of New Zealand, all Tribunals have jurisdiction over general licenses only and do not assume control over individual licenses, relating to the works of a single owner, although a literal interpretation of the Indian Act might cause it to be applied to an individual license.⁷⁰ In New Zealand, where opposition to authors' rights is powerful,⁷¹ the Tribunal has jurisdiction over all licenses, in-

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67. 76 D.A. 61 (1963). On May 31, 1961, the Federal Court at Karlsruhe held that it was an infringement to tape a copyrighted work for the purpose of entertainment and similar private purposes. Since GEMA cannot control a private sphere, it attempted to solve the problem by making arrangements with tape recording manufacturers by which the manufacturers agreed to pay a license for every machine sold, in which case the private use of such a licensed machine was not an infringement. 75 D.A. 60 (1962).
68. Eire: Act of 1963 (29-42), The Tribunal is the Controller of Industrial and Commercial Property. Canada: Act of 1921 (48-51), Copyright Appeal Board. India: Act of 1957 (33-35). New Zealand: Act of 1962 (30-48). United Kingdom: Act of 1956 (23-30).
- (a) Australia: *Report, Copyright Law Review Committee* (1959) Paragraphs 355-378.
- (b) Pakistan: Copyright Order of June 1962 to replace the Indian Copyright Act of 1914. See footnote 27 (c), *supra*.
- (c) South Africa: Proposed legislation. See footnote 27 (d), *supra*.
69. Brussels Article 11(1) grants an exclusive right to the author to authorize the public performance and presentation of his works, subject to the special provisions of Article 11 *bis* (radio diffusion) and Article 13 (recordings) under which the condition of the exercise of the rights mentioned in the two latter articles is made subject to national legislation. The United Kingdom Delegation specifically reserved the right to enact such legislation as it might consider necessary in the public interest to prevent or deal with any abuse of the monopoly rights conferred upon the copyright owner by the law of the United Kingdom. "Explanatory Notes of United Kingdom Delegates, Brussels Copyright Convention" (H. M. Stat. Off. (1949)) 16.
70. Paragraph 2(r). See also Whale, *op. cit. supra*, footnote 27 (c) at 49.
71. See Whale, *op. cit. supra*, at 57.

cluding the right to make a film for broadcasting purposes and to broadcast a film.⁷² Its jurisdiction extends to any licenses granted by any copyright owner, i.e., individual works.⁷³

All of these countries have done away with the provision which limited the assignment by an author, as the first owner of copyright, to a term not to exceed twenty-five years after death.⁷⁴ This will be discussed at greater length *infra*.⁷⁵

An interesting situation took place in connection with South Africa. In 1963, a draft bill was introduced to bring the South African Law up to date in accordance with the British Act of 1956, with provisions for a Copyright Tribunal. The legislation sought to apply the compulsory license in connection with motion pictures. In an extensive exchange of correspondence, it was pointed out that (a) South Africa had adhered to the Brussels Revision, effective August 1, 1951; (b) Brussels granted cinematographic works the same protection as other works; (c) national legislation could not impose a compulsory license in the field of cinematographic works and any such attempt would be in direct violation of Article 14 of Brussels.⁷⁶ A new 1964 version of

72. Article 36.

73. Article 36. See Whale, *op cit. supra*, at 63.

74. British Act of 1911 (5(2)).

75. See footnotes 88-92, *infra*.

76. Article 11(1) of Brussels provides that authors enjoy the exclusive right of authorizing the presentation and public performance of works and the public distribution by any means of the presentation and performance of their works, but the application of the provisions of Article 11 *bis* (radio diffusion) and Article 13 (recordings) is also reserved. See footnote 69, *supra*, re: *Declaration by the United Kingdom Delegation*. Article 13(1) provides that the authors of musical works have the exclusive right of authorizing the recording of such works and the public performance of such recordings. In addition, Article 13 (2) was amended to provide that any reservations that might be imposed by national legislation upon the exercise of the rights referred to in Paragraph 1, should not prejudice the author's right to receive an equitable remuneration. Article 14(1) gives the author the exclusive right to authorize the cinematographic adaptation and reproduction of his works and the distribution of such works as well as the public presentation and performance (cinematographic works) were thus given the same protection as other works and the former restriction by which the original character of the work was the condition of protection, was removed from the Convention. A new provision (Article 14(4)) was added to provide that the cinematographic adaptation of works was not subject to the reservations and conditions contained in Article 13(2). In the field of cinematographic works, national legislation could not impose a compulsory license, for such works are not subject to the reservations applicable to the regulation of mechanical rights. Dubin, "Copy-

the Copyright Bill has been published and the provisions which made the licensing of motion pictures subject to the jurisdiction of the Copyright Tribunal have been deleted.

II. MEETINGS

An African Study Meeting on Copyright took place in Brazzaville from August 5-8, 1963. Generally, the following items were considered: (a) The term of protection of fifty years after death be reviewed with a view to its reduction; (b) Modification of Article 20 of Berne to enable bilateral agreements promoting exchanges in derogation of the present text;⁷⁷ (c) Special provisions safeguarding African folklore and permitting free use of works for educational and school purposes; (d) The Conventions be reviewed in the light of the special needs of the African Nations.⁷⁸

At Geneva, between November 18-23, 1963, a Committee of Experts convened in connection with the proposals for the revision of Berne, scheduled to be held at Stockholm in 1967. The proposals of the Swedish Working Group, recommending the application of a series of presumptions in favor of the motion picture producer, were voted down. The representatives of the authors' groups took the position that Berne was enacted for the benefit of the authors and that the film producer and films were not entitled to protection under that Convention—that whatever rights they might have must at all times be secondary to the rights of authors.

The Inter-Governmental Copyright Committee, established by the U.C.C., and the Permanent Committee of Berne met in New Delhi from December 2-7, 1963. Resolutions were adopted covering the following: (a) Copyright publications in languages other than English and French; (b) A solution be attained concerning musical scores; (c) Studies be continued regarding photographic reproduction of works by libraries, etc.; (d) Countries ratify or accede to the Neighboring Rights Convention; (e) Countries adopt provisions regarding criminal proceedings in the case of copyright infringement; (f) African States adopt domestic legislation suitable to their needs and adhere to inter-

right Aspects of Sound Recordings," 26 So. Cal. L. Rev. 139, 144 (1953); 1 *Unesco Copyright Bulletin* 24 (1948); 52 D.A. 33 (1949); 66 D.A. 97 (1953). Note, also, that the South African Delegation made no declaration similar to the one made by the United Kingdom Delegation. See footnote 69, *supra*.

77. Special arrangements may be entered into insofar as they confer greater rights than those granted by the Convention, or are not contrary to the Convention. (Brussels (20)).

78. 16 *Unesco Copyright Bulletin* 173, 184 (1963).

national conventions; (g) A study take place covering the possibility of providing for a compulsory license to reproduce and translate works for educational purposes.⁷⁹

III. JUDICIAL

In *Composers, Authors and Publishers Association of Canada, Ltd. v. International Good Music, Inc.*, an application was made, in an infringement action, for an order to serve two American defendants, *ex juris*. The program originated in Washington and was received in Canada. The court first determined that in order to justify an order for such service, the plaintiff need not fully establish the merits of his claim, but only to present a "good arguable cause"—the allegation of copyright infringement in Canada, by means of transmission from the United States, did constitute such good cause. The court stated that one who had held himself out as being able to communicate to some one million persons in British Columbia, if he transmits musical works of which the plaintiff has the Canadian copyright, may thereafter have communicated to viewers in Canada musical works by radio communication within the provisions of the Copyright Act. That point, however, was not determined by the court.⁸⁰

The fair dealing clauses in the British Copyright Act⁸¹ were held not to apply to the private use of reproduction of copyrighted works on tape for entertainment—the clauses refer only to research and private study, criticism and review.⁸² Consistent with this view, where the purchaser of a tape in which musical works were embodied transferred the works to a tape recorder used for demonstration purposes, he was held guilty of infringement since the recording of the work from one tape to another constituted a new act of reproduction, which, even for private use, required consent.⁸³

The Ray Noble popular composition "The Very Thought of You" was the subject of an opinion in November of 1962.⁸⁴ The court held that an assignment of the full copyright in all countries for the period of copyright, together with all rights therein, passed the contingent

79. 77 D.A. 35 (1964).

80. Canada Supreme Court, Jan. 22, 1963; 10 BULL. CR. SOC. 278 (1963).

81. Section 6 (1, 2).

82. 75 D.A. 60 (1962).

83. *Wright Music Co., Ltd. v. Grundy, Ltd.*, 77 D.A. 61 (1964); See footnote 67, *supra*, Decision of German Federal Court at Karlsruhe, May 31, 1961.

84. *Campbell Connelly & Co., Ltd. v. Noble (Q.B. Ch. Div.)*, 10 BULL. CR. SOC. 121 (1962).

right of renewal in the United States copyright. The case involved an English contract and was governed by English rules of construction and the assignment of a further right operated as an agreement to assign when the right came into existence.

Three rulings touching on moral rights are of passing interest. In *Roy Export Co. Estab. v. D.U.K. Films Ltd.*,⁸⁵ five of Charlie Chaplin's films were put together, without permission, and the plaintiff contended the versions were inept. Defendant, claiming to be an innocent infringer, consented to judgment. The English publishers of a French work on antiques included captions and illustrations not authorized by the plaintiff and which he claimed damaged his reputation and standing. Judgment was entered in favor of the plaintiff after the defendant admitted the items could have been damaging, apologized to plaintiff and undertook to publish a new edition.⁸⁶ Corinne Calvet brought an action under Section 43 (1, 2) of the British Act, which created a cause of action for false attribution of authorship, claiming that an article was published purportedly setting forth an interview in which she made certain uncomplimentary remarks regarding Hollywood. She denied having uttered such statements—the jury, unable to reach a verdict, was discharged.⁸⁷

IV. INTERNATIONAL DEVELOPMENTS AND PROPOSED UNITED STATES REVISION

Two recommendations by the Register of Copyrights are of particular import, in view of the developments abroad. The first is the suggestion that the author's right to freely dispose of his work be limited, in order to protect him and his heirs against improvident and disadvantageous transfers since authors are in a relatively poor bargaining position.⁸⁸

It should be pointed out that similar limitations on transfers by the author, inserted in the interest of an author's family, to prevent, if possible, an author from making improvident contracts to the detriment of his dependents, were found to be ineffectual.⁸⁹ All English speaking countries formerly having such a limitation in their copyright

85. T.L.R. June 27, 1962 (Ch. Div., High Court of Justice).

86. *Rheims v. George Weidenfeld and Nicolson, Ltd.*, 76 D.A. 40 (1963)

87. *Calvet v. Tomkies*, T.L.R. July 2, 1963; 77 D.A. 62 (1964).

88. REPORT OF REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 92 (July 1961).

89. COPINGER AND SKONE-JAMES ON COPYRIGHT (9th Ed.) 134 (1958); Fox, CANADIAN LAW OF COPYRIGHT 291 (1944).

laws,⁹⁰ and who have enacted or proposed new legislation, have removed this restriction.⁹¹ The archaic doctrine that an author is incapable of handling his own affairs, and must therefore be treated as a ward under guardianship of the law, would prevent him from realizing on his assets when he may be most in need of funds and would deny him the freedom to dispose of the fruits of his labor as he may see fit.⁹²

The second recommendation of the Register proposes to extend our Copyright Law to all foreign works, but the President could restrict, suspend or withhold the application of the statute in the case of works originating in any particular country.⁹³ The Register has suggested an alternate, namely, that unpublished works should be protected without regard to the citizenship or domicile of the author; published works should be protected if the author is a United States citizen or domiciliary,

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90. An author who is the first owner of the copyright may not assign for a term to exceed twenty-five years after his death: (a) Australia: Act of 1912 (8); (b) Canada: Act of 1921 (12(3)); (c) Eire: Ind. and Comm. Ppty. (Pro.) Act, 1927 (158(2)); (d) India: Copyright Act of 1914 (2); (e) New Zealand: Act of 1913 (8(2)); (f) Pakistan: See India; (g) South Africa: Act of 1916 (143); (h) United Kingdom: Act of 1911 (5(2)).
91. (a) Australia: *Report, Copyright Law Review Committee*, (1959) par. 395, 396, summary of recommendations par. 45. "We do not think that that provision has been of great benefit to authors' families. . . ."
- (b) Canada: *Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Copyright* (1957), see pp. 114, 115.
- (c) Eire: Act of 1963 (the former provision is not found in the new act).
- (d) India: Act of 1957. (The former provision is not found in the new act.)
- (e) New Zealand: Act of 1962. (Although the *Report of the New Zealand Copyright Committee* (1959) on p. 35 recommended its retention, the former provision is not found in the new act.)
- (f) Pakistan: See India and footnote 27(c), *supra*.
- (g) South Africa: Since the proposed new South African bill will replace the Copyright Act of 1916 in order to bring the law up to date in accordance with the British Act of 1956 (see footnote 27(d), *supra*), it may be assumed that the former provision will no longer appear, in view of its absence from the British Act.
- (h) United Kingdom: Act of 1956. (The former provision is not found in the new act.)
92. *Fisher Music Co., Inc. v. Witmark & Sons*, 318 U.S. 643, 87 L.ed. 1055 (1943).
93. REPORT OF REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 119 (July 1961).

or a citizen or domiciliary of a country that is a party to the U.C.C.,⁹⁴ the Buenos Aires Convention,⁹⁵ or the Mexico City Convention,⁹⁶ or if first publication took place in the United States or in a nation adhering to the U.C.C., or if on the date of first publication the author was a citizen or domiciliary of a foreign country to which protection had been extended by Presidential proclamation, provided that the President could restrict, suspend or revoke the application of the statute. It should be noted that in both suggestions of the Register, in the absence of treaties, international conventions or Presidential proclamations, protection is first granted to foreign works without the necessity of reciprocity and without regard to whether or not the foreign work has any protection in its own country. The proposal that the President could restrict, suspend or revoke protection would be an afterthought since protection would first be granted and would require another act to withhold such protection.

With the possible exception of France, to be treated separately,⁹⁷ only Argentina, Belgium, Lebanon, Luxemburg, Paraguay, Portugal, Syria and Uruguay grant protection without regard to reciprocity.⁹⁸ All other countries grant protection only if there is reciprocity or the existence of a treaty or convention.⁹⁹

94. See footnote 1, *supra*.

95. Convention on Literary and Artistic Copyright, Aug. 11, 1910.

96. Convention on Literary and Artistic Copyright, Jan. 27, 1902.

97. See footnotes 102-121, *infra*.

98. (a) Argentina: Law 11723 of Sept. 28, 1933 (13); (b) Belgium: Law of Mar. 22, 1886 (38); (c) Lebanon: Decree 2385 of Jan. 17, 1924 and 526 of Sept. 22, 1926 (148); (d) Luxemburg: Law of May 10, 1898 (39); (e) Paraguay: Law 94 of 1951 (48); (f) Portugal: Decree 13725 of 1927 (136); (g) Syria: See Lebanon; (h) Uruguay: Law 9739 of 1937 (4).

99. Albania: Law 538 of Dec. 24, 1947 (26); Australia: Act of 1912 (8, 29); Austria: Act of Apr. 9, 1936 (96); Bulgaria: Act of Nov. 16, 1951 (10); Canada: Act of 1921 (4); Chile: Law 345 of Mar. 17, 1925 (5); China: Reg. of May 14, 1928 (10); Colombia: Law 86 of Dec. 26, 1946 (44); Costa Rica: Decree 40 of June 27, 1896 (Final Art.); Czechoslovakia: Law of Dec. 22, 1953 (61); Denmark: Law 158 of May 31, 1961 (60); Dominican Republic: Law 1381 of Mar. 17, 1947 (42); Ecuador: Law of Oct. 24, 1957-Jan. 22, 1958 (49, 50); Egypt: Law 354 of June 24, 1954 (49); Eire: Copy. Act. 10 of 1963 (43, 46); El Salvador: Decree 376 of Sept. 6, 1963 (16); Finland: Law 404 of July 8, 1961 (69); Germany: Act of June 19, 1901, as am. 1910, 1934 (22, 55); Ghana: Act of 1961 (2); Greece: Law 2387 of June 29, 1920 (17); Guatemala: Law 1037 of 1954 (20); Hungary: Law LIV of 1921 (78); Iceland: Law 13 of 1905, am. 1943 and 1947 (27); India: Act of 1957 (40); Israel: Copy. Ord. (amend.) Law of 1953 (6);

The report of the Register states that the extension of copyright protection to all works, without regard to reciprocity, would simplify our international copyright relations and the determination of the copyright status of foreign works, serve our best interests and encourage countries to adhere to the U.C.C.¹⁰⁰ The recommendation that the so-called "French system" be adopted (protection without regard to reciprocity) has been stated to be "one of the most important innovations recommended by the report."¹⁰¹

Assuming that the adoption of the "French system" will accomplish what the Register's report so hopefully states it will do, this "system" is based on the Act of March 28-31, 1852, which prohibited the unlawful reproduction on French territory of works published abroad. From 1840 to 1852, France attempted to secure protection for French works by the conclusion of treaties granting reciprocal treatment, but the effort failed.¹⁰² Under the Act of 1852, the only requirement was that no prosecution could be instituted unless there had been deposited two copies in the National Library.¹⁰³ Between 1852 and 1862, France concluded twenty-three treaties for reciprocal protection of authors' rights, whereas in the preceding decade she had only concluded four.¹⁰⁴

Italy: Law 633 of Apr. 22, 1941 (185 to 189); Japan: Law 39 of 1899 (as am.) (28(1)); Korea: Law 432 of 1957 (46); Liechtenstein: Law of Oct. 26, 1928 (6); Mexico: Law of Dec. 29, 1956 (28); New Zealand: Law 33 of Dec. 5, 1962 (49, 51); Nicaragua: C.C. (865); Norway: Act of May 12, 1961 (59); Pakistan: Copy. Act of 1914, See India; Panama: Admin. Code (1910); Peru: Law 13714 of 1961 (6); Philippines: Law of Mar. 6, 1924 (10); Poland: Law 234 of 1952 (6(4)); Rumania: Decree 321 of 1956 (1); South Africa: Law of Apr. 7, 1916 (143); Spain: Law of Jan. 10, 1879 (50, 51); Sweden: Law 729 of Dec. 30, 1960 (62); Switzerland: Act of Dec. 7, 1922, am. 1955 (6); Thailand: Act of June 16, 1931 (28); Tunis: Law of June 15, 1889 (1); Turkey: Law of Dec. 10, 1951 (88); U.S.S.R.: Law of Dec. 8, 1961 (97); United Kingdom: Act of 1956 (32); United States: 17 USC 9; Venezuela: Act of Nov. 29, 1962 (109); Yugoslavia: Act of July 10, 1957 (2).

100. REPORT OF REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 118 (July 1961).
101. Bogsch, "Toward the General Revision of the Copyright Law of the United States of America," 74 D.A. 268, 283 (1961).
102. Ladas, INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 27 (1938).
103. Article 6, Decree of July 19-24, 1793, which was repealed by Article 22, Law of May 19, 1925 (*Journal Officiel*, May 27, 1925).
104. See Ladas, *op. cit.*, *supra*, footnote 102 at 29.

France is a member of Berne,¹⁰⁵ U.C.C.,¹⁰⁶ is bound to Argentina and Paraguay by virtue of the Montevideo Convention¹⁰⁷ and has treaties with thirteen countries.¹⁰⁸ Ordinarily, a treaty between countries involves a *quid pro quo*, but if foreign works were protected in France under the Act of 1852, what advantage would have been gained by another country entering into a copyright treaty with France? The only benefit would have accrued to French works—was it not possible that there was some question whether or not foreign works were protected in France and might it not have been for that reason that these treaties were concluded? If the Act of 1852 applied in favor of foreign authors, it would not appear to have been in the interest of foreign countries to enter into arrangements with France to obtain additional protection if their nationals already received the benefit of the French legislation.¹⁰⁹ In addition, what would be the value of the Berne Convention if all foreign works were to be protected in France, without reciprocity?¹¹⁰

The French Copyright Act of 1957 provides that the author enjoys a property right upon creation¹¹¹ and specifically repeals the Law of 1852.¹¹² There is a great doubt as to whether or not there still is protection in France for foreign works, in the absence of treaty or reciprocity.¹¹³ The fact that treaties and conventions based upon the

105. See footnote 2, *supra*.

106. See footnote 1 (a), *supra*.

107. Convention on Literary and Artistic Property, 1889.

108. *Unesco Copyright L. & T. of the World* (1956-63).

109. Masouyé, "Les prorogations de guerre—II," IV R.I.D.A. 81, 99 (1954); Dubin, "Extensions of Copyright in Europe," 8 U.C.L.A. L. Rev. 682, 694 (1961).

110. Desbois, II PINNER WORLD COPYRIGHT 660, et seq. (1955).

(a) Nationals are entitled to protection of unpublished works (Br. 4); countries of Berne may enter into separate arrangements if greater rights are granted or if the provisions are not contrary to Berne (Br. 20); the Convention does not prevent a claim for wider protection in any Union Country (Br. 19).

111. Article 1.

112. Article 77.

113. (a) Alphonse Tournier, "An Appraisal of the Law," XIX R.I.D.A. 73, 87 (1958).

"... the repeal of the Law of 28th—30th March, 1852 has a totally different implication, and is most significant in that it marks a departure from traditional French generosity in cultural matters.

"By granting the same unconditional protection, one of the highest order, to all foreigners as to its nationals, Imperial France showed her willingness to bestow her intellectual riches on the rest of the world: this noble and spontaneous gesture might have,

principle of reciprocity do exist proves that laws regarding literary and artistic property are in some ways exceptional, falling outside the scope

and, according to some people, should have, met with a similar gesture on the part of its beneficiaries. Without going so far as to say that French liberalism is without response, we regret to say that it is not often reciprocated. It is even rather disappointing to find that certain countries could presume they are entitled, by reason of their undeveloped state, to benefit without reciprocity from foreign culture.

"Be that as it may, the French Legislator decided that this period of unilateral generosity would have to end. He duly abrogated the Law of 1852, preferring reality to a hopeless ideal. Perhaps this repeal should have been matched by a positive disposition on the status of foreign authors not benefiting from assimilation to French authors, as a result of the conclusion of bilateral treaties and international conventions. We do not think that the absence of any such clause will in any way lessen the effect of the French Legislator's bill. The fact the treaties and conventions based on the principle of reciprocity do exist, proves that the Laws re literary and artistic property, with which we are dealing here, are in some ways exceptional, falling outside the scope of Common Law, and granting special privileges; it would therefore seem strange if all foreigners were entitled to claim unconditional benefit from them."

- (b) Jean Loup Tournier, "The French Act of March 11, 1957," 6 BULL. CR. SOC. 1, 25 (1958).

"The French Law of March 11, 1957, is, in our opinion, characterized by its remarkable homogeneity; however, it does, doubtless, possess its lacunae. It is regrettable, for example, that none of its dispositions regulates the protection of foreign works in France. The Law does not even possess a definition of 'French works' as opposed to the latter.

"If it is at all possible to define the 'French works' or the protection of foreign works in France, such definitions must be found in the terms of the international conventions which France has bound, such as the Brussels Convention, or the Universal Convention. The question of knowing if all foreign works receive the benefit of French protection, without condition of reciprocity, also remains without an answer in the law.

"The abrogation of the Decree of March 28-30, 1852, on which an extremely liberal jurisprudence was based for the benefit of Russian works, in particular, will perhaps have the effect of reversing the tendency which may have been too generous. But it is not possible to anticipate in this connection."

- (c) But see, *contra*: Desbois, II PINNER WORLD COPYRIGHT 660 *et seq.* (1955); Ladas, *op. cit.*, *supra*, footnote 102 at 181-183, 187-188; Desbois, "Le Droit d'Auteur des Etrangers en France," XXVIII R.I.D.A. 79, 83, 85 (1960).

of common law and granting special privileges. Foreigners would not thus be automatically entitled to claim unconditional benefits from them.¹¹⁴ What inducement could be held out to cause a country to adhere to the U.C.C. when the works of an author of that country enjoy protection in the United States?

But even if it is assumed that the "French system" still exists, France, by introducing legislation to do away with this "system", has recognized the fact that generosity is not appreciated but too often abused.¹¹⁵

There have been no decisions in France construing the "French system" subsequent to the enactment of the 1957 Act. The Iron Curtain case,¹¹⁶ which granted protection to Soviet composers (who had assigned to a French company), involved the system before the 1957 Act and arose out of seizure for infringement under the Law of July 19-24, 1793 and the Act of 1852. Both of these latter acts were repealed by the 1957 Act.¹¹⁷ It is of interest to note that Shostakovich, Khachaturian, Prokofieff and Miaskovsky (the successful Soviet composers in the French Iron Curtain case) were the unsuccessful Soviet composers in the United States Iron Curtain case.¹¹⁸

France, in applying the "French system", never went as far as the proposal of the Register, which would grant protection to the works of nationals of countries where there might be no copyright protection for the works of its own nationals. Under the Act of 1852, it was held that protection in France could not be broader than that afforded in the country of origin, nor could the law be availed of by citizens of a country with which France had a treaty granting a lesser degree of protection.¹¹⁹ A United States work is protected in France only as long

114. (a) See footnote 113 (a) *supra*.

(b) But see, *contra* footnote 113 (c), *supra*; Desbois, "La protection des oeuvres etrangeres en France (en l' absence de Convention), 76 D.A. 225 (1963).

115. See footnote 30 (a), *supra*.

116. *Societe Le Chant du Monde v. Societe Fox-Europa* (Court of Appeal, Paris, 1st Ch.) Jan. 13, 1953, XXVIII R.I.D.A. 130 (1960); *aff. Court of Cassation* (Civ. Ch., 1st Sec., Civ.) Dec. 22, 1959, XXVIII R.I.D.A. 120 (1960); See: Desbois, "Le Droit d'Auteur des Etrangers en France," XXVIII R.I.D.A. 79, 83, 85 (1960); Desbois, "La protection des oeuvres etrangeres en France (en l' absence de Convention)," 76 D.A. 225 (1963).

117. Article 77.

118. *Shostakovich v. 20th Century-Fox Film Corp.*, 80 N.Y.S. 2d 575, 196 Misc. 67 (1948); *aff. 87 N.Y.S. 2d 430, 275 A.D. 692* (1949).

119. *Ladas, op. cit., supra*, footnote 102 at 28.

as it is protected in the United States¹²⁰ and the highest court in France has held that if the work is not protected in the country of origin it will not be protected in France.¹²¹

The Register's proposal, for example, would give protection to Soviet works having as their country of origin the Soviet Union, and this despite the fact that United States works do not enjoy protection in the U.S.S.R. (nor does any foreign work)¹²² and any published work may be translated without the consent of the author.¹²³ True, as an afterthought, the President could restrict, suspend or revoke the proclamation but by the time this was accomplished, the extended hand of friendship offered by the United States might well have been gobbled up to the elbow before the hand had even been clasped in the spirit of international cooperation.

120. Note of French Ambassador Bonnet to Dean Acheson, Mar. 27, 1947.

121. (a) *Grus v. Ricordi*, July 12, 1887 (Cour de Cassation); *Leduc v. Bessel*, May 6, 1924 (Cour de Cassation); see: Ladas, *op. cit. supra*, footnote 102 at 195; Desbois, II *PINNER WORLD COPYRIGHT* 660, *et seq.* (1955).

122. See footnote 49, *supra*.

123. Law of Dec. 8, 1961 (102).

4. RECENT JUDICIAL DEVELOPMENTS

By WALTER J. DERENBERG*

Today's symposium and, in fact, the entire copyright program of this year's meeting bears the imprint of and is keyed to the proposed General Copyright Law Revision Act, introduced in Congress on July 20, 1964, which if enacted will replace the present Act of 1909 in its entirety.¹ But even the optimists among members of the Copyright Bar will readily admit that this most recent and ambitious legislative effort toward copyright law revision may not come to fruition in the immediate future. Until that moment ultimately arrives, a systematic review of significant court decisions under existing law will remain of timely interest and value to the Bar. We must bear in mind in this connection that numerous copyright problems of basic significance have never been adjudicated during the 45 years which have elapsed since the 1909 Act came into effect; indeed, during the last twelve months there have been several occasions on which some of our highest federal courts expressed a sense of astonishment with regard to the absence of guiding precedents on copyright fundamentals. Thus, Judge Kaufman of the Second Circuit in *Shapiro, Bernstein & Co. v. H. L. Green Company, Inc.*² observed at the very outset of the court's opinion:

This action for copyright infringement presents us with a picture all too familiar in copyright litigation: a legal problem vexing in its difficulty, a dearth of squarely applicable precedents, a business setting so common that the dearth of precedents seems inexplicable, and an almost complete absence of guidance from the terms of the Copyright Act, 17 U.S.C. §1 *et seq.*

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1. H.R. 11947, "A Bill for the general revision of the Copyright Law, Title 17 of the United States Code, and for other purposes," introduced July 20, 1964 by Congressman Celler, 88th Cong. 2d Sess.
2. 316 F.2d 304 (2d Cir. 1963).

And only a few months earlier, in *The Platt & Munk Co., Inc. v. Republic Graphics, Inc.*,³ Judge Friendly remarked with regard to the resale rights of an unpaid manufacturer of copyrighted goods:

It seems exceedingly strange that these questions should arise for the first time, as is apparently the case, one hundred and seventy-three years after the initial grant of copyright protection by Congress, 1 Stat. 124 (1790), and two hundred and fifty-four after the Statute of Anne, 8 Anne, c. 19 (1709).

In surveying these "grey areas" of existing copyright law, this report will be divided into three parts: It will in the first part discuss court decisions with regard to copyrightability; the second part will be devoted to copyright infringement; and the final part will attempt a brief evaluation of the probable effect of the recent Supreme Court decisions in *Sears, Roebuck & Co. v. Stiffel Company*⁴ and *Compco Corporation v. Day-Brite Lighting, Inc.*⁵ on the law of copyright.

I. COPYRIGHTABILITY

(a) *The Requirement of Originality: The "Flash Card" Litigation.* Throughout the year there has been a noticeable trend toward liberality in determining the minimum literary or artistic merit of works for which judicial protection is sought. Probably the most important of these cases was the "flash card" decision by the Seventh Circuit in *Gelles-Widmer Co. v. Milton Bradley Co.*⁶ In that case a set of educational flash cards was held to meet the standard of originality as the result of the "selection, arrangement and combinations" of certain basic materials, such as standard arithmetic examples. The court said: "We agree with plaintiff that these combinations of problems selected as they were, together with the test sheets and the instructions, were more analogous to an educational book."⁷

(b) *Maps.* While no recent court decision appears to have adopted a more liberal standard of originality since the decision in *Carter v.*

3. 315 F.2d 847 (2d Cir. 1963).

4. 376 U.S. 225 (1964).

5. 376 U.S. 234 (1964).

6. 313 F.2d 143 (7th Cir. 1963).

7. *Id.* at 147. On the general problem regarding authority of the Register of Copyrights to refuse registration and the present consequences of such refusal, see Beran, "Refusal to Register—A Roadblock to Copyright Owners," 10 BULL. CR. SOC. 147 (1963).

Hawaii Transportation Co. in 1961,⁸ considerable criticism has been expressed by leading experts with regard to the tendency of some courts to apply stricter tests of copyrightability in connection with maps than with regard to other copyrightable works.⁹

(c) *Architectural Works.* Only two recent reported cases dealt with copyright in architectural plans. A Florida district court held in *DeSilva Construction Corporation v. Herral*¹⁰ that the filing of architectural plans in accordance with local building laws was a "publication" which resulted not only in the loss of common law copyright protection but also in the forfeiture of all copyright because it was a publication without copyright notice. The court observed: "Research of counsel and independent research failed to disclose any Federal authority for this proposition. However, state courts, considering the same problem, held, with one exception, that the filing of architectural plans in a public office, even though it is required by statute or ordinance, is tantamount to publication of said plans and amounts to a dedication to the public, terminating the author's common law copyright in said plans."¹¹ The harshness of the result is hardly mitigated by the court's stated opinion that the construction of the building, as such, would not amount to a publication of its plans and that the "building is not a copy of the plans".¹²

The exact opposite result was recently reached in a significant decision by the Supreme Court of Massachusetts in *Edgar H. Wood Associates, Inc. v. Skene*,¹³ which held that neither the deposit of architectural plans nor the erection of the building itself amounted to a dedication of the copyright and that the originator remained entitled to common law copyright protection. The case would appear particularly noteworthy because it was handed down after the Supreme Court's decisions in the *Sears, Roebuck* and *Day-Brite* cases, which were distinguished by the court. Since in the court's opinion the architectural works had not

8. 201 F. Supp. 301 (D. Hawaii 1961).

9. See Whicher, "Originality, Cartography, and Copyright," 38 N.Y.U.L.Rev. 280 (1963).

10. 213 F. Supp. 184 (M.D. Fla. 1962).

11. *Id.* at 194. In this writer's opinion, much could be said in favor of the California court's contrary decision in *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546 (Dist.Ct.App. 1959).

12. See generally, *Study of the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary*, 86th Cong., 2d Sess., Copyright Law Revision Study No. 27, "Copyright in Architectural Works" (Comm. Print 1961).

13. 197 N.E.2d 886, 141 U.S.P.Q. 454 (Mass. Sup. Jud. Ct. 1964).

become part of the public domain, the *Sears, Roebuck* and *Day-Brite* cases were held inapplicable; the court said: "A careful reading of these two opinions does not convince us that they have struck down common law copyright, which protects unpublished material, in those States which recognize its existence, or deprived such States of the right to regulate it. There is a distinction between that protection afforded under State unfair competition laws to the unpatentable article in the public domain and the protection extended through common law copyright to an unpublished work."¹⁴

(d) *Choreographic Works*. In one interesting recent infringement suit, the plaintiff claimed to have originated a comedy dance in which she asserted a common law copyright as a choreographic creation.¹⁵ The court held, however, that plaintiff's dance routine, in which she did "bumps" and "grinds" while playing a stylized version of *Reveille* on a trumpet, was not a "dramatic or dramatico-musical" composition, and was, therefore, not copyrightable. According to the state court judge, copyright protection could only be claimed for a choreographic work which was dramatic in nature. He said: "Where a performance contains nothing of a literary, dramatic or musical character which is calculated to elevate, cultivate, inform or improve the moral or intellectual natures of the audience, it does not . . . fall within the purview of the statute as a production tending to promote the progress of science and useful arts."¹⁶ It would seem that the court in so deciding failed to give adequate consideration to the fact that plaintiff did not even claim statutory copyright protection but based her action on an alleged common law copyright which would not have to meet the constitutional test of promoting "the progress of science and useful arts" or fall within one of the narrower classes of copyrightability as defined in section 5 of the Act of 1909.

(e) *News Items and Fact Gathering; Inverse "Passing Off"*.¹⁷ It is, of course, hornbook law that there can be no statutory or common law

14. 141 U.S.P.Q. 454, 456.

15. *Dane v. M. & H. Co.*, 136 U.S.P.Q. 426 (N.Y.Sup.Ct. 1963).

16. *Id.* at 429.

17. See generally Gorman, "Copyright Protection for the Collection and Representation of Facts," 76 Harv. L. Rev. 1569 (1963). Mention should be made in passing of the problems arising in connection with the copyrighting of computer programs. Various aspects of these problems are discussed by George D. Cary, Reed C. Lawlor, George Schiffer and John Schulman in the August 1964 issue of THE BULLETIN of the Copyright Society of the U.S.A. Since copyrightability of computer programs has not as of this time

copyright protection for news items or the gathering thereof as such, but news-gathering agencies have been able to derive some comfort and protection from the famous Supreme Court decision in the *Associated Press* case,¹⁸ which recognized a "quasi-property right" in such material and protected the Associated Press against misappropriation on the basis of unfair competition. However, it is a well known, although perhaps regrettable, fact that this decision has in subsequent years been somewhat emasculated by the courts in other instances of "free ride" and misappropriation—even before the Supreme Court's two recent decisions in *Sears, Roebuck* and *Day-Brite*—or at least limited to the specific facts involved in *Associated Press*. It is encouraging, therefore, to find that the Pennsylvania Supreme Court last summer breathed new life into the *Associated Press* doctrine by awarding a newspaper publisher effective protection against a radio station which had used items gathered by the plaintiff's trained personnel and specialized methods without plaintiff's authorization.¹⁹ The court observed that the law should not "countenance the usurpation of a competitor's investment and toil" and then stated: "Taking into consideration the circumstances and the character of the businesses of the respective parties, as averred, the News Company has a commercial package of news items to service its advertising business upon which to base a cause of action in tort against a competitor allegedly converting the news items to its own uses in pursuit of advertising."²⁰

(f) *Title Protection.* There has been a considerable number of cases involving questions of the protectibility of program, motion picture and book titles even in the absence of statutory copyright protection. In one of these, *Dugan v. American Broadcasting Corporation*,²¹ summary judgment was granted in favor of defendant broadcaster, who was charged with having infringed plaintiff's copyrighted playlet entitled "Opportunity" by a television program, "About Faces". Details of the format of plaintiff's playlet and defendant's program were found to be basically dissimilar, so that no triable issue was raised even if it were

been involved in any litigation, this question will not be discussed in detail in this report.

18. *International News Service v. Associated Press*, 248 U.S. 215 (1918).

19. *Pottstown Daily News Publishing Co. v. Pottstown Broadcasting Co.*, 411 Pa. 383, 192 A.2d 657 (1963).

20. *Id.* at 393, 192 A.2d 663.

21. 216 F. Supp. 763 (S.D. Cal. 1963). For a comprehensive review of protectibility of program titles, see the prize-winning essay by Kerson, "Sequel Rights in the Law of Literary Property," ASCAP COPYRIGHT LAW SYMPOSIUM No. 12, 76 (1963).

assumed that defendant may have had access to plaintiff's work. In another case, the copying and alleged infringement of plaintiff's television board game, "By the Numbers," was involved. In *Borden v. Andrews*,²² the state court sustained defendant's demurrer (with leave to amend) on the ground that what plaintiff sought to protect by copyright was an idea rather than a protectible literary expression. The court found that except for the basic cryptographic principle itself, the only minor similarity between the two concepts was the use of the game board, which was outside the protection of the copyright law.

While not a suit for copyright infringement, the case of *Metro-Goldwyn-Mayer, Inc. v. Monte Lee Enterprises*²³ should be mentioned, where the plaintiff secured a preliminary injunction against defendant's use of an advertising slogan, "A Wonderful World of the Grimm Brothers, etc." It was plaintiff's contention that the use of these words unfairly capitalized on the extensive publicity for plaintiff's motion picture, "The Wonderful World of the Brothers Grimm," which had not yet been completed. The court noted that defendants were employing the objectionable phrase in larger type than the rest of the lettering in the advertisements and that under California law this constituted unfair competition, since plaintiff's title had acquired a secondary meaning despite the fact that the title was at the time of suit only a *proposed* title which had been the subject of considerable advertising and publicity. The court said: "If an association is thereby formed in the minds of the public which fixes plaintiffs as the source of something of a particular nature to be available at a particular place, this is sufficient because it follows that public deception may result if a distinguishing feature of the plaintiffs' program is adopted and used in an unfair and misleading manner by another."²⁴

On the other hand, the District Court of New York in *Willpat Productions, Inc. v. Sigma III Corp.*²⁵ denied a preliminary injunction where plaintiff had obtained some pre-production publicity in 1962 for a film entitled "Thundering Wheels" and defendant was about to distribute a motion picture under the same title. The court was "not convinced that [plaintiff's] publicity was sufficient to create any secondary meaning, or that if a secondary meaning was created by the publicity, that the secondary meaning now exists."

22. 139 U.S.P.Q. 567 (Cal. Super. Ct. 1963).

23. 212 Cal.App.2d 23, 27 Cal.Rptr. 833 (Dist.Ct.App. 1963).

24. *Id.* at 27, 27 Cal. Rptr. at 837. See Note, "Entertainment Title Duplication Cases: A Process of Evolution," 39 Ind. L. J. 110 (1963).

25. 141 U.S.P.Q. 15 (S.D. N.Y. 1964).

Perhaps the most interesting recent litigation concerning book and motion picture titles was *Brown v. Lyle Stuart, Inc.*²⁶ In that case, plaintiff, the author of the much publicized book, "Sex and the Single Girl," sought an injunction against publication by defendant of a book under the title, "Sex and the Single Man" and production of a motion picture under the title of defendant's book. It appeared that the motion picture based on plaintiff's book had been produced by Warner Bros. Pictures but had not yet been released. The court reached the rather unique conclusion that there was no unfair competition on the part of the defendant with regard to using the title in his book, but that an injunction should issue enjoining use of defendant's title on a motion picture. The court accepted defendant's allegation that in publishing defendant's book, no unfair effort to capitalize upon the success of plaintiff's work had been made and that the purchasing public would be influenced in buying defendant's book by the reputation of its author, rather than by the name of the book. However, with regard to the potential use of defendant's book title for motion picture purposes, it was pointed out that thus far, at least, defendant had not taken a single step to explore motion picture rights and that, moreover, the book itself would not lend itself to that method of exploitation so that the defendant would suffer no harm if Warner Bros.'s request for injunctive relief were granted. With regard to the title of a song it was quite recently held by a New York State court in *David v. Paramount Picture Corp.*²⁷ that plaintiff, who had composed a song in 1921 entitled "Moon River", which had almost fallen into oblivion since that time, was not entitled to recover against defendant, who had recently scored a hit with a song under the identical title, which was introduced in the motion picture, "Breakfast at Tiffany's". The court found that even if the song may have had some secondary meaning during the period 1921-23, any vestige of such meaning had vanished in more recent years, so that plaintiff had suffered no harm from an alleged "dilution" or misappropriation of the title of its song.²⁸

26. 141 U.S.P.Q. 936 (N.Y.Sup.Ct. 1964).

27. *Not yet officially reported*, N.Y. Sup.Ct. June 10, 1964.

28. In *Mercury Record Corp. v. Buckingham Record Co.*, 226 F.Supp. 427, 140 U.S.P.Q. 321 (S.D. N.Y. 1963), a preliminary injunction issued against defendants' copying of plaintiff's phonograph record album jackets. Cf. also, *United Artists Records, Inc. v. Theatre Productions Records, Inc.*, N.Y.L.J. April 13, 1964, p. 14, in which the court granted a preliminary injunction on the ground that the public might be deceived into confusing defendants' album, issued in a jacket with the words "The Original Musical

(g) *Textile and Fashion Designs*.²⁹ As has been true ever since the United States Supreme Court's decision in *Mazer v. Stein*,³⁰ there has been more copyright litigation with regard to infringement of copyrighted or allegedly copyrighted textile and fashion designs than in any other single area. However, it should not be assumed that, despite the present liberal standards of copyrightability, the plaintiffs in these cases have always had clear sailing. Not only were the plaintiffs on many occasions met with defenses of defective copyright notice but in a number of instances copyright protection was denied for lack of copyrightable subject matter. Among the cases in which the plaintiff was successful, first mention should be made of *Cortley Fabrics Co. v. Slifka*,³¹ where the Second Circuit sustained summary judgment in favor of the plaintiff, who claimed copyright protection for a printed fabric which had been copied by the defendant after he had bought a woman's garment embodying plaintiff's design in a large department store. According to the court, plaintiff had conclusively demonstrated that the design was an original work within the meaning of the Copyright Act. The same court affirmed the granting of permanent injunctive relief in *H. M. Kolbe Co. v. Armigus Textile Co.*,³² in a case involving a copyrighted textile design consisting of clusters of purple roses which were so arranged as to form an allover checkerboard design. This was held to be a composite design "which depends for its aesthetic effect upon both the rose figure and the manner in which the reproductions of that figure are arranged in relation to each other upon the fabric." Thus considered, the design was held sufficiently original for copyright purposes, even though the checkerboard configuration, considered apart from the original component squares, may not show "even the modest originality" that the copyright laws require. "[W]e find no authority for the proposition that every element of an original work must itself bear the marks of originality."³³ Preliminary injunctive relief was also granted in *John Wolf Textiles, Inc. v. Andris Fabrics*,

Cast Recording" and "The musical version of Tom Jones", with plaintiff's original sound track album of the movie "Tom Jones".

29. See generally Helfat, "Copyright Protection for Fashions," 3 Publishing, Entertainment, Advertising and Allied Fields L. Q. 173 (1963); Jackson, "Unfair Competition by Product Simulation v. Copyright Protection for Designs," 45 J. Pat. Off. Soc'y 422 (1963); and Silverman, "The Scope of Protection of Copyrights and Design Patents in the United States," 24 U. Pitt. L. Rev. 21 (1962).
30. 347 U.S. 201 (1954).
31. 138 U.S.P.Q. 110 (S.D. N.Y.), aff'd per curiam, 317 F.2d 924 (2d Cir. 1963).
32. 315 F.2d 70 (2d Cir. 1963).
33. Id. at 72.

Inc.,³⁴ where plaintiff's copyrighted fabric design was held both valid and infringed, although some disparities between defendant's and plaintiff's designs were found to be not readily noticeable to the ordinary observer. Defendant's contention that plaintiff's design was based upon an Egyptian motif, and consequently in the public domain, was rejected. The fact that the characters were replicas of people of the Cleopatra era both in appearance and dress was not fatal to plaintiff's claim of originality. Again, in *Loomskill, Inc. v. Slifka*,³⁵ plaintiff secured a summary judgment even though its design stemmed from an Audubon book of birds. It was held that plaintiff's designs, while "derived from pictures and drawings in the public domain," were created by an expert designer and were sufficiently original to satisfy the originality requirements of the copyright law. The district court's decision was affirmed by the Second Circuit in a per curiam decision.³⁶

On the other hand, the same defendant who had been found guilty of plagiarism in this and other cases was recently successful in *Condotti, Inc. v. Slifka*,³⁷ not on a defense of lack of copyrightability of plaintiff's fabric design, but on the ground that defendant had only used plaintiff's basic ideas in creating the accused designs, which were found to be an "aesthetic mutation", sufficiently different from plaintiff's designs to defeat a charge of infringement or unfair competition. Again, the same defendant resisted the issuance of a preliminary injunction in *Clarion Textile Corp. v. Slifka*,³⁸ in which it succeeded in satisfying Judge Dimock that plaintiff's design, while serving as "an inspiration" to defendant, had not been plagiarized. The court said: "As far as the designs are concerned all that can be said about their similarity is that each consists of flowers enclosed in staggered rectangles formed by fine lines. Plaintiff's flowers are in impressionistic masses which would overflow the boundaries if not cut off by them. Defendant's are individual sprays clearly defined and carefully fitted into the rectangles with unoccupied margins to spare."³⁹ As a result, plaintiff was found not entitled to a preliminary injunction before trial.⁴⁰

34. 139 U.S.P.Q. 365 (S.D. N.Y. 1962).

35. 223 F. Supp. 845, 139 U.S.P.Q. 476 (S.D. N.Y. 1963).

36. *Loomskill, Inc. v. Slifka*, 330 F.2d 952 (2d Cir. 1964).

37. 223 F. Supp. 412 (S.D. N.Y. 1963).

38. 139 U.S.P.Q. 340 (S.D. N.Y. 1961).

39. *Id.* at 341.

40. The same result was reached by Judge Bryan in *Manes Fabrics Co. v. Acadia Co.*, 139 U.S.P.Q. 339 (S.D. N.Y. 1963), where preliminary injunctive relief was denied despite an overall similarity of the designs involved.

(h) *Dolls, Toys and Games.* An issue of copyright infringement and unfair competition was also raised and decided in recent months involving alleged copying of the well known teen-age doll called "Tammy," which bore a copyright notice on the shoulder blades. A preliminary injunction against defendant's copying the manner of dressing and packaging plaintiff's doll was granted, although the court failed to find copyright infringement with regard to the two dolls without clothing.⁴¹ The court agreed with defendant's assertion that both dolls were in "an ordinary and common doll size utilized by many companies . . . for many years" but held that plaintiff's doll as dressed and packaged had acquired considerable secondary meaning, so that likelihood of confusion may well result from the similar appearance of the dolls, particularly since defendant's doll had no name. More recently, it was held in the first copyright infringement case dealing with the "Beatle" dolls that such dolls made under license and bearing an appropriate copyright notice had been infringed by defendants who made a substantial copy thereof, although there were certain minor differences between the parties' respective "Beatle" dolls.⁴²

II. COPYRIGHT INFRINGEMENT

(a) *The Defense of Defective Notice.* 1. *Wrong Location of Notice.* As in past years, the defense of defective notice continues to be alleged even in areas where its unavailability has become quite well established. Despite the fact that the courts, at least in the Second Circuit, do not look with favor on this defense in cases in which the notice had originally been properly placed on the selvage of the fabric, it is offered in almost all cases of textile or fashion design infringement. In the *Kolbe* case,⁴³ the notice, which appeared every sixteen inches along the selvage, was held sufficient since it appeared once every turn of the printing roller and at least once for each commercial unit of fabric. It was also held in this important decision that no forfeiture of copyright occurred

Another important copyright infringement case dealing with textile designs will be discussed subsequently in connection with the question of appropriate monetary relief to victorious plaintiffs in copyright litigation, see discussion of *Peter Pan Fabrics, Inc. v. Jobela Fabrics, Inc.*, at "Damages and Profits," text at footnote 84.

41. *Ideal Toy Corp. v. Adanta Novelties Corp.*, 223 F. Supp. 866 (S.D. N.Y. 1963).
42. *Remco Industries, Inc. v. Goldberger Doll Mfg. Co., Inc.*, 141 U.S.P.Q. 898 (E.D. N.Y. 1964). With regard to other recent litigation involving "Beatles" recordings, see below, text at footnotes 80 and 96.
43. *H. M. Kolbe Co. v. Armagus Textile Co.*, supra, note 32.

where plaintiff had permitted a number of dressmakers to sell dresses made from the infringing fabric which no longer disclosed the copyright notice. In the *Cortley* case,⁴⁴ the same court reiterated its view that a notice of copyright engraved on the rollers and mechanically imprinted on the selvage of each and every repeat of the design satisfied the notice requirements of the statute, particularly where it could not be established by the defendant that the notice could have been embodied in the design itself without impairing the market value of the product.

In addition to the numerous Second Circuit decisions on the sufficiency of copyright notice in cases involving textile and fashion design, two important decisions upholding the validity of copyright notice despite technical defects were rendered by the Seventh Circuit and, most recently, the Ninth Circuit. In the "flash card" case,⁴⁵ the defendant had alleged, inter alia, that the copyright notices were invalid because of the use of the name of the wrong corporation as proprietor of the copyright. The court found, however, that the actual proprietor and the corporation whose name was used had the same officers, directors and shareholders, that the interests of the two companies were precisely the same, and that no one would in any way be prejudiced by reliance on the inaccurate notice. In so deciding, the court relied on the liberal standards set forth by Judge Learned Hand in the well known "Superman" decision.⁴⁶ More recently, the Ninth Circuit found it necessary to render an unusually detailed and comprehensive opinion concerning the validity of plaintiff's copyright in a self-instruction manual which the plaintiff supplied for the playing of the defendant company's electric organ. The original agreement between the parties expressly provided that plaintiff was to retain the copyright in the manual, but the defendant proceeded to copy and distribute it independently.⁴⁷ The lower court decided in favor of the defendant, both as to copy-

44. *Supra*, note 31. In *Loomskill, Inc. v. Slifka*, *supra* note 35, the notice was held sufficient, even though it was not printed on the selvage but added by a separate printing operation; moreover, defendant was held to have failed to sustain the burden of proof that the copyright notice might have been embodied in the design itself. And in *John Wolf Textiles, Inc. v. Andris Fabrics, Inc.*, *supra* note 34, it was held immaterial whether the defendant had actual notice of plaintiff's copyright even though the copyright notice had not been on the selvage at the time of defendant's purchase.

45. *Gelles-Widmer Co. v. Milton Bradley Co.*, 313 F.2d 143 (7th Cir. 1963), *supra*, text at note 6.

46. *National Comics Publications, Inc. v. Fawcett Publications*, 191 F.2d 594 (2d Cir. 1951).

47. *Neal v. Thomas Organ Co.*, 325 F.2d 978 (9th Cir. 1963).

right infringement and unfair competition, on the ground that plaintiff's copyright was invalid as the result of improper position of the copyright notice.⁴⁸ Judge Barnes, speaking for the appellate court, indicated little sympathy for this technical defense raised by a former contract partner of the copyright owner, and concluded that the copyright notice in the book should be considered valid in a case where the title of the book appeared only on the cover itself and the notice on the first inner leaf. It was held that such page, although it might be for some purposes considered the "first" page, could be deemed the page "immediately following" the title page under section 20 of the Copyright Act. The court, while not agreeing with the appellant's argument that the third page in this instance "could be deemed to be the title page," correctly held that despite this, the third page was the page "immediately following" the title page. The court said:

Thus it seems reasonable for an average citizen to conclude that the page immediately following the title page could be the third page because that is the first page on the first leaf. Of course, it would also be reasonable to conclude that notice on the inside front cover is sufficient. We think notice on either is sufficient, but limit our opinion to the peculiar circumstances of this case in which the title appears only on the cover and in which the cover is of a harder and less malleable material than the leaves within.⁴⁹

Most recently, however, the opposite result was reached by the Seventh Circuit in *OA Business Publications, Inc. v. Davidson Publishing Company*.⁵⁰ No trace can be found in this opinion of the liberal approach by the same court in the abovementioned "flash card" case⁵¹ or that of the Ninth Circuit in *Neal v. Thomas Co.*,⁵² which had involved closely analogous situation. The Seventh Circuit now held that the page on which the copyright notice appeared in plaintiff's trade magazine was neither the title page nor the page following it, but was in fact the third page of the publication on which a valid copyright notice could not be placed under the present statute. According to the appellate court, the notice on that page was invalid because the "purported masthead" carried a part of the registered title and no

48. The lower court's basic findings are printed at 325 F.2d 979, n. 1.

49. 325 F.2d 978, at 982.

50. 334 F.2d 432, 142 U.S.P.Q. 119 (7th Cir. 1964).

51. Note 45 *supra*.

52. Note 47 *supra*.

volume number or number of issue. In the writer's opinion, this and other decisions reaching the same conclusion strongly suggest that a change be made in the forthcoming revision statute eliminating the present overtechnical notice requirements and substituting therefor— if the notice requirements are to be retained at all— the flexible approach embodied in article 3 of the Universal Copyright Convention, under which the notice may be placed “in such manner and location as to give reasonable notice of claim of copyright.” There would then be no room for argument that, in litigation of the *OA Business Publications* type, the plaintiff's publication was invalidly copyrighted.⁵³

2. *Substitution of Assignee's Name before Recordation.* One of the many pitfalls resulting in invalidation of copyright is found in section 32 of the Act of 1909, which provides that an assignee of copyright may substitute his name in the statutory notice of copyright only after the assignment has been recorded in the Copyright Office. It was held in the leading *Winchell* case⁵⁴ that substitution of the assignee's name prior to recordation of the assignment resulted in dedication of the work to the public, since strict compliance with the statutory requirements was essential. It would seem that there never has been any real justification or need for this drastic provision and that those of us, who have participated in the proposed enactment of a new copyright act are almost unanimous in recommending the elimination of this section of the present act. However, for the present we will, of course, have to live with it but should at least welcome any trend on the part of our courts to restrict, rather than expand, the applicability of this technical defense. It is gratifying, therefore, that the district court in a recent case involving infringement of plaintiff's song, “A Thousand Miles Away,” held this defense to be inapplicable in a case in which the assignee's name had been used in the copyright notice in advance of recordation but before there had been any general publication of the song at all. In relying on Professor Nimmer's reasoning in his recent text, “NIMMER ON COPYRIGHT,” the court said:

The words “statutory copyright” as used by the author clearly refer to a copyright obtained by publication. Prior to the time such a “statutory copyright” is obtained, there can be no “substitution” of the assignee's name for that of the assignor in the notice of copyright since there has never been a publication of the work

53. H.R. 11947, supra note 1, actually does adopt to a large extent this more liberal approach in sections 24 and 28.

54. *Group Publishers, Inc. v. Winchell*, 86 F. Supp. 573 (S.D. N.Y. 1949).

by the assignor. Section 32 must, if it is to be a meaningful legislative pronouncement, refer only to those cases where, as in *Winchell*, a statutory, or published copyright is assigned, and not where, as in the case at bar, the statutory copyright is first obtained by the assignee of an unpublished copyright.⁵⁵

3. *Notice Requirement on Works First Published Abroad.* In *Ross Products, Inc. v. New York Merchandise Co., Inc.*,⁵⁶ the important question arose whether a work first published abroad by a U.S. concern in a U.C.C. country would be entitled to copyright protection in the United States, even though it did not carry at the time of first publication a copyright notice which would satisfy the requirements of Article 3 of the Universal Convention or those of our domestic law. The case involved a toy representing an inflated figure of a baseball catcher, first exhibited at a toy show in Japan with a red tag around the figure's neck which included the word "copyright" in Japanese followed by a number apparently identifying a patent for the material rather than a copyright registration. It will be recalled that Judge Jerome Frank, in his now famous dictum in the *Heim* case,⁵⁷ had stated that, contrary to the previous position taken in the United States on this point in the leading case of *Basevi v. The Edward O'Toole Co., Inc.*,⁵⁸ publication abroad without notice would suffice if such publication would not throw the work into the public domain under the laws of the country of first publication. It appears, however, that Judge Frank's observation specifically referred to a publication by a "foreign author" and was, moreover, deemed by the Copyright Office to have been overruled by the ratification by the United States of the Universal Convention. Accordingly, the now prevailing regulations of the Copyright Office specifically provide in § 202.2 (a) (3) :

Works first published abroad, other than works eligible for ad interim registration, must bear an adequate copyright notice at the time of their first publication in order to secure copyright under the law of the United States.

In relying on this regulation, the court denied preliminary injunctive relief despite the fact that the defendant had admittedly seen plaintiff's toy at the Japanese exhibition and that he then proceeded to have

55. *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922, 925 (S.D. N.Y. 1964).

56. 141 U.S.P.Q. 652 (S.D. N.Y. 1964).

57. *Heim v. Universal Pictures Co., Inc.*, 154 F.2d 480 (2d Cir. 1946).

58. 26 F. Supp. 41 (S.D. N.Y. 1939).

an "exact replica" made of the toy which he had seen at the Japanese fair and in a department store in Japan. The court, in denying plaintiff any relief, referred to the issue of the validity of the copyright with a defective foreign notice as "a simple one" which would require a finding of invalidity even if the view of the majority opinion in the *Heim* case, rather than the rule of the Copyright Office regulation were followed, since even the *Heim* dictum appeared to be applicable only in case of an alien author and would not apply to domestic copyright proprietors. Accordingly, relief was denied despite the fact that, according to defendant's own affidavit, its representative had known that the U.S. manufacturer had applied for copyright protection in Japan, since there was no effective notice of copyright on the toy at the time of the exhibition. It may not be amiss at this point to mention that the Office's interpretation of the effect of ratification by the United States of the Universal Copyright Convention on the *Heim* decision has recently been questioned.⁵⁹

(b) *The Defense of "Fair Use"; the "Mad" Magazine Case*.⁶⁰ A rather novel and interesting charge of infringement was made by Irving Berlin against the satirical humor magazine "Mad" on the ground that in one of its issues there appeared as a "special bonus" a collection of parody lyrics to "57 Old Standards" (songs) "which reflected the idiotic world we live in today." Among the collection, entitled "Sing Along with 'Mad'", there appeared, after the title of each lyric, a statement reading either "Sing to the tune of" or "To the tune of" and inserted was the title of one of the "old standard" songs, including twenty-five songs in which the plaintiff-composer owned the copyright. Despite the fact that no music was provided in the book, the plaintiff took the view that defendant's lyrics were a "counterpart" of the lyrics of plaintiff's compositions and constituted a "colorable copy or paraphrase" of the copyrighted works. It was held, however, by both the district court and the appellate court,⁶¹ that defendant had created original, ingenious lyrics, which had little in common with plaintiff's and that, contrary to the famous parody

59. See NIMMER ON COPYRIGHT, p. 332 et seq. The viewpoint of the Copyright Office was first expressed in an article by George D. Cary, "The United States and Universal Copyright: An Analysis of Public Law 743", UNIVERSAL COPYRIGHT CONVENTION ANALYZED, edited by Theodore Kupferman and Matthew Foner (1955), at p. 83 et seq.

60. For a recent article on fair use, see Cooper, "Withol v. Crow: Fair Use Revisited," 11 U.C.L.A. L. Rev. 56 (1963).

61. *Berlin v. E. C. Publications*, 329 F.2d 541 (2d Cir. 1964), aff'g 219 F. Supp. 911 (S.D. N.Y. 1963).

cases,⁶² defendant's lyrics did not constitute an actionable parody; rather, "they have satirized, in original words and thought, several aspects of modern life."⁶³ Defendant's activities were held not to constitute either copying or the making of a new arrangement or adaptation of plaintiff's copyrighted songs. Judge Kaufman, speaking for the Second Circuit court said:

We believe in any event that the parody lyrics involved in this appeal would be permissible under the most rigorous application of the "substantiality" requirement. The disparities in theme, content and style between the original lyrics and the alleged infringements could hardly be greater. In the vast majority of cases, the rhyme scheme of the parodies bears no relationship whatsoever to that of the originals. While brief phrases of the original lyrics were occasionally injected into the parodies, this practice would seem necessary if the defendant's efforts were to "recall or conjure up" the originals; the humorous effect achieved when a familiar line is interposed in a totally incongruous setting, traditionally a tool of parodists, scarcely amounts to a "substantial" taking, if that standard is not to be woodenly applied.⁶⁴

The plaintiff recently filed a petition for certiorari, which is pending in the Supreme Court at the time of this writing; in its petition, plaintiff specifically challenges the appellate court ruling that a parody version of a copyrighted work should be considered as a "fair use" and that "parody and satire *are* deserving of substantial freedom—both as entertainment and as a form of social and literary criticism . . .".⁶⁵ Perhaps the Supreme Court will thus have occasion for the second time to consider the scope of the "fair use" defense as applied to parody and burlesque, an issue which was in effect left undecided by the court in the "*Gaslight*" appeal,⁶⁶ in which the lower court's decision⁶⁷ was affirmed as the result of an equally divided court.

"*Fair Use*" and *De Minimis*. In *Toulmin v. Rike-Kumler Co.*,⁶⁸ the plaintiff, author of a book entitled "With Pershing in Mexico,"

62. *Benny v. Loew's*, 239 F.2d 532 (9th Cir. 1956), aff'd per curiam, 356 U.S. 43 (1958).

63. 219 F. Supp. 911, 914.

64. 329 F.2d 541, 545.

65. Petitioner's Brief for Writ of Certiorari, p. 17, June 1, 1964.

66. *Benny v. Loew's*, 356 U.S. 43 (1958).

67. 239 F.2d 532 (9th Cir. 1956).

68. 137 U.S.P.Q. 533 (S.D. Ohio 1962), aff'd per curiam, 316 F.2d 232 (6th Cir.), cert. denied, 375 U.S. 825 (1963).

which had been published in 1935, brought an infringement action against the author of an historical novel, "They Came to Cordura," on the ground that one part of one paragraph from plaintiff's book was quoted in the introduction to the novel. Finding that only a sentence and part of another was alleged to have been plagiarized, the district court dismissed the action on the ground of de minimis since such copying, even if proved, "did not in any degree prejudice the sale, diminish the profits or supersede the objects of the original work, and was thus a 'fair use' thereof." The court also dismissed the charge of alleged unfair competition since plaintiff's book had been out of print for at least twenty-two years when defendant's work was published.

(c) *The Defense of "General Publication" and "Dedication"*. One of the most interesting litigations in recent months was the successful effort on the part of Dr. Martin Luther King to enjoin by preliminary injunction the sale of phonograph records embodying his famous speech, "*I have a dream . . .*"⁶⁹ which had first been delivered in an auditorium in Detroit in June 1963, but which in somewhat revised form was again delivered in August 1963, on the occasion of the historical "March on Washington." The Washington speech was much longer and contained a great deal of material which had not been included in the original speech, and was publicly delivered in front of the Lincoln Memorial before an estimated audience of 200,000 people. It appeared that the speech had been mimeographed as an advance text and had been put into a "press kit" which was made available to the press in advance of delivery of the speech. The copies thus distributed to the press did not bear a copyright notice, and it was the plaintiff's contention that he had no personal advance knowledge of such distribution and had not consented thereto. The speech got broad coverage in the press and one New York newspaper offered reprints of the entire speech for sale without express authorization by the plaintiff. The defendant had made a sound recording of Dr. King's speech on August 28 and of other speeches made on the same occasion by others and had commenced selling phonograph records under the title, "Freedom March on Washington, August 28, 1963." These records carried both the voice and the words of Dr. King.

After the speech, on the last day of September 1963, Dr. King sent a copy of it to the Copyright Office for registration as an unpublished lecture, in accordance with section 12 of the Copyright Act and shortly thereafter filed the present complaint. Immediately before filing the

69. King v. Mister Maestro, Inc., 224 F. Supp. 101 (S.D. N.Y. 1963).

complaint, Dr. King authorized general publication of his speech with notice of copyright and at that time secured a copyright registration in Class A., i.e., as a "published book". In granting a preliminary injunction, the court observed that it not only seemed "unfair and unjust" for defendants to use the voice and words of Dr. King without his consent for their own financial profit, but that such action also constituted copyright infringement since the delivery of the speech even before an audience of 200,000 people did not constitute a "general publication". The court emphasized that it had never been suggested that oral delivery of an address as such resulted in dedication to the public and that the number of persons in the audience did not have any effect on this principle. Nor did the court agree with the defendant that distribution of copies of the speech without copyright notice constituted "general publication", moreover, the two-to-one decision in the recent *Rickover* case⁷⁰ was readily distinguishable, since, according to the court, Admiral Rickover had gone "beyond the customary sources of press or broadcasting in distributing the addresses to any interested individual." In other words, it was held that the issuance of copies to the press in Dr. King's case was a "limited", as opposed to a "general", publication and that in view of the fact that plaintiff had made his own arrangements to market phonograph records of his speech, the sale by the defendant of unauthorized phonograph records entitled plaintiff to preliminary injunctive relief.⁷¹

(d) *Joint Tortfeasors and Contributory Copyright Infringement; The H. L. Green Department Store Case.*⁷² In this case of first impression, quoted in the introduction to this report, the Second Circuit de-

70. *Public Affairs Associates, Inc. v Rickover*, 177 F. Supp. 601 (D. D.C. 1959), rev'd 284 F.2d 262 (D.C. Cir. 1960), rev'd 369 U.S. 111 (1962).

71. In *Columbia Broadcasting System, Inc. v. Documentaries, Unlimited, Inc.*, 248 N.Y.S.2d 809, 140 U.S.P.Q. 686 (N.Y.Sup. Ct. 1964), the incorporation of a well known news commentator's announcement of the assassination of President Kennedy in an off-the-air phonograph recording was held to be an infringement of plaintiff's common law copyright since the broadcast had not constituted "general publication" and since more was involved than a mere flash news item. With regard to motion for reargument of this case after the Supreme Court decisions, see below, Part III. In the above-mentioned *Nom Music* case, supra note 55, it was held, inter alia, that a phonograph record was not a "copy", that the sale thereof does not constitute a "publication" of the composition, and that it therefore was irrelevant that the labels on the records included some improper copyright information.

72. *Shapiro, Bernstein & Co. v. H. L. Green Co.*, 316 F.2d 304 (2d Cir. 1963). See also Introduction, and text at note 3, supra.

cided that a department store was liable as joint tortfeasor in conjunction with a phonograph record concessionaire who had been selling bootleg records made by the co-defendant manufacturer. It was the appellate court's view that under such circumstances the department store itself constituted a "seller" of the records and was jointly liable for copyright infringement. Since the licensing agreement provided that the concessionaire was "to abide by, observe and obey all rules and regulations promulgated from time to time by H. L. Green Company, Inc.," and that the latter had "unreviewable discretion" to discharge employees and, moreover, was to receive a percentage of the concessionaire's gross receipts from the sale of records, the store was itself liable for copyright infringement even though it had not actually participated in the sale of the records and had no knowledge of their unauthorized manufacture. Basing its decision on precedents which had held a landlord liable for copyright infringement by his tenants and a proprietor of dance halls responsible for unauthorized performance of copyrighted music, the court concluded that the department store's participation in the receipts from the sale of bootleg records resulted in infringement liability on the part of the store itself. The court said: "We therefore conclude, on the particular facts before us, that Green's relationship to its infringing licensee, as well as the strong concern for the financial success of the phonograph record concession, renders it liable for the unauthorized sales of the 'bootleg' records." Moreover, the court reached the conclusion that since the judgment against the concessionaire related only to the "manufacture of the records," the department store was severally, rather than jointly, liable for infringement.⁷³

(e) *Rights and Liability of an "Unpaid Seller"; The Platt & Munk Litigation.*⁷⁴ In another case of first impression, the Second Circuit had to pass upon the question whether an unpaid manufacturer of copyrighted goods, which were alleged by the copyright proprietor who had ordered them made to be defective, could sell them in satisfaction

73. In *Gordon v. Goren*, 17 App.Div.2d 381, 235 N.Y.S.2d 314 (1st Dept. 1962), the Appellate Division held that the well known bridge expert, Charles Goren, was improperly joined as a contributory infringer in a common law copyright action based on an idea for a television pilot film allegedly embodying plaintiff's idea of showing a bridge hand being played and subsequently analyzed. The majority held that: "To be liable it must be shown that the defendant not only contributed to the production but to the infringement."

74. *Platt & Munk Co. v. Republic Graphics, Inc.*, 218 F. Supp. 262 (S.D. N.Y. 1962), modified 315 F.2d 847 (2d Cir. 1963).

of his claim for the contract price under the remedies available to an unpaid seller in accordance with New York State Law, without at the same time infringing the exclusive publishing and vending rights of the copyright proprietor under the federal copyright statute. After commenting that it seemed "exceedingly strange" that this question should never have arisen during the past 173 years, the appellate court modified the preliminary injunction granted by the district court on a theory of copyright infringement and reached the conclusion that an unpaid seller may exercise his remedies under state law once it had been adjudicated that the supplier was in breach of contract but not before that time. The court said:

Where the copyright owner makes a good faith claim that his failure to pay for the goods was justified, the manufacturer ought not to be allowed to resort to the normal remedy of self-help with the result of impairing the rights granted by the federal copyright law; to that extent state contract or lien law must yield to the federally created right. The District Court thus properly issued an injunction to maintain the status quo until this critical issue could be determined.

As a result, the case was remanded for the purpose of an immediate trial of the issue of whether the copyright proprietor was justified in its refusal to accept the goods or whether it had acted unjustifiably and in breach of contract.⁷⁵

(f) *Disaffirmance of Contract with Artist Under Age.* Although not involving an issue of copyright infringement, brief mention should perhaps be made in this report of the recent case of *Bright Tunes Productions, Inc. v. Lee*,⁷⁶ in which an attempt was made to enjoin a group of young artists known as "The Chiffons" from rendering services to phonograph record manufacturers during the term of their initial exclusive contract with plaintiff. The defendants' motion to dismiss was granted on the ground that they had all been under the age of twenty-one when the contract had been entered into and that under Section 74 of the New York State Domestic Relations Law, a contract for the services of infant entertainers covering a period of over three years was "unreasonable and improvident" as a matter of law.

75. For a comprehensive note on this case, see "The Manufacturer's Right to Resell Patented and Copyrighted Goods," 38 N.Y.U.L.Rev. 948 (1963).

76. 249 N.Y.S.2d 632 (N.Y.Sup.Ct. 1964).

(g) *What Constitutes Public Performance for Profit?* Several precedents have been added to the line of cases holding an alleged private club liable for copyright infringement based on publicly performing copyrighted music. In *Porter v. Marriott Motor Hotels, Inc.*,⁷⁷ every lodger automatically became a temporary "member" of the club, and the court, in granting summary judgment, held the alleged club to be "a place of business for public entertainment" and, therefore, liable under section 1 (e) of the Act of 1909. Similarly, it was held in *Lerner v. Schectman*⁷⁸ that the performance of music in defendant's enterprise named "The Apartment", although a "bona fide membership club", was nevertheless "in public" within the meaning of section 1 (e) of the statute since there were no membership qualifications and "virtually any member of the general public who had good appearance and behavior . . ." would be admitted to membership. The court said:

To allow the unlicensed performance of copyrighted compositions in a membership club such as the one involved here, which is apparently representative of an expanding type of night club entertainment, and which virtually encompasses an unlimited segment of the general public would effectively emasculate the intent and purpose of the Copyright Act.

Most recently, it was held in *Chappell & Co., Inc. v. Middletown Farmers Market & Auction Co.*,⁷⁹ that a farmers' market and the licensee of its music department were both guilty of copyright infringement by using a loud speaker system playing records of copyrighted music allegedly for the purpose of promoting and advertising the sale of the records. It was held both by the district court and by the Third Circuit that section 1 (e) did not authorize the public performance for profit of copyrighted music even in connection with the sale of phonograph records thereof, and that "the atmosphere created by the playing of recordings made shopping at the Mart more pleasurable and attractive to the patrons" and that therefore the playing of the records should be deemed to be a performance "for profit".

(h) *Extraterritorial Effect of "U" Notice Requirement of Section 1(e)? The Beechwood Music Case.*⁸⁰ In one of the infringement suits

77. 137 U.S.P.Q. 473 (N.D. Tex. 1962).

78. 228 F. Supp. 354, 141 U.S.P.Q. 339 (D. Minn. 1964).

79. 142 U.S.P.Q. 54 (3d Cir. 1964).

80. *Beechwood Music Corporation v. Vee Jay Records, Inc.*, 328 F.2d 728 (2d Cir. 1964).

involving the "Beatles" records, the defendant raised the novel defense that he should have been held entitled to a compulsory license for the manufacture of recordings of two "Beatles" songs from the album, "Introducing The Beatles", because the two compositions had been previously released in Great Britain. In other words, it was the defendant's contention that the compulsory license provision of section 1 (e) could be invoked even though the copyright proprietor had not approved or authorized the mechanical reproduction or commercial release thereof in the United States, as long as the composition had been previously released in another country. But more than that: defendant alleged that since the plaintiff had not filed the "U" notice after such publication in England, anyone in the United States was free to manufacture phonograph records of these compositions. In affirming the district court's grant of a preliminary injunction, the Second Circuit held in a per curiam decision that the compulsory license provision of section 1 (e) did not have extraterritorial application. The court said:

Defendants' construction would lead to the absurd conclusion that a foreign copyright owner who licenses mechanical reproduction in his own country, without any intention of ever entering the United States market, must promptly file a notice in the copyright office in Washington or else lose even the 2 cent per record royalty given by the compulsory license clause.⁸¹

(i) *Sale of Solution Manuals as Copyright Infringement; The Addison-Wesley Case.*⁸² In another case of first impression, the publisher of a set of physics textbooks secured a preliminary injunction against defendants who published, and sold in mimeographed form, books with ready-made solutions to the problems which were added at the end of each chapter of the textbooks. The defendant had not copied the actual problems themselves, but had referred to them by page number and then proceeded to offer answers to the problems in diagram form. The complaint had alleged not only unfair competition, but copyright infringement as the result of transforming the problems

81. A far more interesting and possibly meritorious issue of extraterritoriality was recently raised before the Canadian Supreme Court in *Composers, Authors & Publishers Ass'n of Canada, Ltd. v. International Good Music, Inc.* (reported 10 BULL. CR. SOC. 278, 1963), where the Court held, in a preliminary decision, that a complaint which alleged reception and transmission of a television broadcast in Canada which had originated in the United States stated a "good and arguable case" of copyright infringement under Canadian law.

82. *Addison-Wesley Publishing Co. v. Brown*, 223 F.Supp. 219 (E.D. N.Y. 1963).

into a new diagrammatic version, but the court granted preliminary injunctive relief solely on a theory of misappropriation and unfair competition.⁸³ After trial, however, the court expressly found copyright infringement despite the fact that the solution manual did not copy the problems themselves. In the court's opinion, the use of diagrams in connection with the solutions was a device conceived by the defendants for "substituting paraphrase for direct quotation." The court actually based its finding of copyright infringement on the rather novel theory that the solutions had "no independent viability" but would exist *in vacuo* and be meaningless except for defendant's efforts to translate "what they have purloined." The defendants were found to have "transmuted only the lexical statement of the problems into another version, purporting to translate that portion into another language . . ." The court, however, then observed that its decision was more broadly based upon a finding of unfair use by defendants of plaintiff's original effort than on the narrower theory of technical copyright infringement. Since the case was settled after the rendering of the decision, the Court of Appeals for the Second Circuit did not have an opportunity to pass on plaintiff's rather novel and intriguing theory of copyright infringement.

(j) *Damages and Profits.* With regard to the measure of financial recovery in copyright infringement cases, several significant decisions were rendered by the federal courts last year. In *Peter Pan Fabrics, Inc. v. Jobela Fabrics, Inc.*,⁸⁴ the Second Circuit held that the measure of recovery under section 101 (b) of the Copyright Act was "cumulative" rather than "alternative"; in other words, it was held to include both the net profits of the infringer and the damage to the copyright holder, rather than only one of these elements. It was further held that under the "in lieu" clause of the same section, lack of proof of damages or profits will not preclude the recovery of a larger amount of damages which may not be capable of exact proof, in addition to actual profits made by the infringer.⁸⁵

83. For the court's decision on preliminary injunction, see 207 F. Supp. 678 (E.D. N.Y. 1962).

84. 329 F.2d 194 (2d Cir. 1964).

85. Cf. also, *Fruit of the Loom, Inc. v. Andris Fabrics, Inc.*, 227 F. Supp. 977 (S.D. N.Y. 1963), in which Judge Palmieri ruled that plaintiff's damages for loss of a "potential" market came well within the "considerable latitude in speculation" which the court was permitted to exercise in copyright infringement litigation.

One of the large music publishers was recently admonished by a California district court that, in seeking summary judgment against defendants' sale in their music store of a "fake book", containing the right-hand melodies of 100 songs including twelve copyrighted melodies written by the plaintiff, it had misconceived the law in seeking minimum statutory damages of \$250 with regard to each of the copyrighted items.⁸⁶ The court observed that if plaintiff's theory were correct, defendants might be liable for damages in an amount of \$250,000 for sale of a single book if all 1000 melodies had been copyrighted by the plaintiff and that any such result would, of course, be grossly unjust. In the court's opinion, it would be equally unjust to grant summary judgment to the plaintiff to recover \$3,000 in damages without proof of actual damage or of defendants' profits. Before the submission of any proof as to damages or profits, the court would not be in a position to exercise its discretion with regard to the imposition of statutory minimum damages. The court at the same time denied defendants' motion for summary judgment based on the latter's contention that they had not "copied" the songs but were only selling them. The court pointed out that the defendants, too, were under a misconception of the law since under section I of the act not only the copying but also the vending of a copyrighted work constituted infringement of copyright.⁸⁷

(k) *Problems of Federal Jurisdiction; When Does an Action "Arise" under the Copyright Law?* In *T. B. Harms Co. v. Eliscu*,⁸⁸ one of the two defendants had instituted an action in the state court against the plaintiff in the present suit, seeking an adjudication that he was the owner of an undivided one-third interest in the renewal term of four copyrighted musical compositions and had also sought an accounting for his alleged share. The plaintiff in the present action then sued in the federal court for infringement based solely on his alleged participation in the renewal terms. On motion to dismiss for lack of jurisdiction over the subject matter, it was held by Judge Weinfeld that

86. *Shapiro, Bernstein & Co. v. Bleeker*, 224 F. Supp. 595 (S.D. Cal. 1963).

87. Cf. also *Hedeman Products Corp. v. Tap-Rite Products Corp.*, 228 F. Supp. 630 (D. N.J. 1964), where it was held that the copying of several illustrations from a copyrighted catalog constituted only one copyright infringement regardless of how many illustrations were copied. Under the "in lieu" provision and applying the statutory minimum of \$250 for each separate infringement, the court found five such infringements; plaintiff was held entitled to a minimum award of damages of \$1250. The court in the exercise of its discretion did not award any damages in addition to such statutory minimum.

88. 227 F.2d 337, 141 U.S.P.Q. 11 (S.D. N.Y. 1964).

despite the allegation of copyright infringement in the complaint, no infringement issue was actually presented, and that the only point at issue was the interpretation of a certain agreement between the parties with regard to their respective interests in the renewal terms of the copyright. It was held that, in the absence of actual or threatened infringement, a declaratory judgment action to determine the ownership of the renewal right was not within the jurisdiction of the federal court and that title disputes referring to interpretation of agreements with regard to copyright renewal did not constitute claims "arising under the laws of the United States". As a result, the court concluded that the only issue now before the court should be decided by the state court.

III. COPYRIGHT AND UNFAIR COMPETITION

Simulation and Imitation of Uncopyrighted Material; The Probable Effect of the Supreme Court's Sears, Roebuck and Day-Brite Decisions.

This report would not, of course, be complete without at least some mention of the Supreme Court's recent decisions in the cases of *Sears, Roebuck & Co. v. Stiffel Company* and *Compco Corporation v. Day-Brite Lighting, Inc.*⁸⁹ and their probable effect on the law of copyright. However, since these cases also form the subject of at least one separate symposium at this convention, and some of its effects on the law of unfair competition are referred to in this writer's report, "The Seventeenth Year of Administration of the Lanham Trademark Act of 1946", presented almost simultaneously with this report,⁹⁰ it must suffice for present purposes to highlight the repercussions of these decisions which have thus far been noted in the copyright field. In this respect, two initial observations should be made:

(a) While both cases involved products which had been invalidly patented either by mechanical patent or design patent, the federal supremacy doctrine formulated in Mr. Justice Black's opinions does not distinguish between patents or copyright. The opinions refer to both the federal patent and copyright laws as being preempted so as to preclude state law to touch upon these areas in a way which would set federal policy "at naught". However, while the major portions of the

89. 376 U.S. 225; 376 U.S. 234 (1964).

90. This report will be submitted to the Section of Patent, Trademark and Copyright Law of the American Bar Association on August 11, 1964, and will also be available in printed form as Part II, advance sheet, United States Patents Quarterly, issue of August 10, 1964.

decisions deal with patent monopoly and its history, there is a footnote reference in the *Sears, Roebuck* decision to the preservation of state court jurisdiction over common law copyright under section 2 of the Copyright Act of 1909. On the other hand, the Court's statement that "As a state court cannot encroach upon the federal patent laws directly, it can not, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws," was obviously intended to apply to statutory copyright as well, particularly since the very last sentence in the *Sears* decision reiterates the Court's position that ". . . because of the federal patent laws a state may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying."⁹¹

(b) Both cases dealt specifically with situations of product simulation or, more correctly, exact imitation, and the question will now arise—indeed, has already arisen in a number of cases—whether the same philosophy will have to be applied to other traditional forms of unfair competition not involving product simulation and "copying" but misappropriation, instances of "passing-off in the reverse" (the *International News* case)⁹² and other instances of unfair acts and practices. In this latter respect, the present situation and future judicial trend is far from clear except that it can be considered as settled even now that the Supreme Court decision will have no effect on continued state court protection of common law copyright in "unpublished works", including, in this category, phonograph records and radio broadcasts, which under prevailing law are not considered "generally published" even though they may have been widely performed.⁹³ The Supreme

91. Emphasis added. For a rather extreme recent illustration in which no protection whatever was granted against deliberate product simulation, see *Wolf and Vine, Inc. v. Pioneer Display Fixture Company*, 142 U.S.P.Q. 112 (N.Y.Sup.Ct. June 24, 1964).

92. *Supra* note 18. Most recently, a New York Court held in the "Bongo" drum case, *Mastro Plastics Corp. v. Emenee Industries, Inc.*, 141 U.S.P.Q. 311 (NY Sup.Ct. 1964), that in a case involving "inverse passing off" a motion to dismiss based on the *Sears, Roebuck* and *Day-Brite* decisions should be denied. See also Derenberg, "The Seventeenth Year of Administration of the Lanham Trademark Act of 1946," 142 U.S.P.Q. Pt. II, 31, August 10, 1964.

93. On the other hand, the question must now arise what effect these cases will have in situations in which there have been unlimited "sales" of phonograph records; it would seem likely that such sales may now be held to constitute general "publication" under the theory of *RCA Manufacturing Co. v. Whiteman*, 114 F.2d 86 (2d Cir.), certiorari denied, 311 U.S. 712

Court of Massachusetts in the previously mentioned *Wood* case⁹⁴ made it perfectly clear "at the outset" that the Supreme Court decisions would have no effect on the common law copyright in "unpublished" architectural works since in that particular case the deposit of architectural plans and the actual structure of the building were held not to constitute "publication". The court held the plaintiff entitled to common law copyright protection against the "predatory" situation there involved. The same result had been previously reached by a New York State court in denying a motion for reargument in *Columbia Broadcasting System, Inc. v. Documentaries Unlimited Inc.*,⁹⁵ where it had been held that defendant's use of an "off-the-air" recording of a phonograph record, "JFK, the Man, the President," constituted unfair competition. Again, it was argued before a New York State court that distribution and exhibition by defendant of a television program which included a "substantial segment" of a motion picture in violation of plaintiff's exclusive license stated a cause of action in unfair competition, the *Sears* and *Day-Brite* decisions notwithstanding.⁹⁶ Judge Hecht, in distinguishing those decisions, said:

However, in those cited cases the court was concerned with the *copying* of an unpatented and uncopyrighted product. This is to be distinguished from the instant case where the complaint, essentially, is of an *appropriation* of the very item licensed. It is clear, under these cases, that if defendants had copied the movie concerned and produced their own movie based upon the same plot and themes, plaintiff would be entitled to no protection outside of the Federal copyright laws. There is a distinction between such an act, i.e., the copying of an idea, and the actions complained of herein, to wit, the use of the identical product for the profit of another. The "property right" allegedly interfered with by defendants has long been recognized as entitled to protection, *Fisher v. Star Co.*, 231 U.S. 414; *International News Service v. Associated Press*, 248 U.S. 215.

(1940), and that Judge Learned Hand's dissenting opinion in *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955), will now be followed.

94. *Supra* note 13.

95. 248 N.Y.S.2d 809, 140 U.S.P.Q. 686 (N.Y.Sup.Ct. 1964).

96. *Flamingo Telefilm Sales, Inc. v. United Artists Corp.*, 141 U.S.P.Q. 461 (N.Y.Sup.Ct. 1964).

Justice Quinn, in the "*Beatles*" record case,⁹⁷ came to the same conclusion, holding that the sale of plaintiff's "Beatles" records did not constitute a "dedication" and that the Supreme Court decisions had not changed New York State law as embodied in the *Metropolitan Opera* and *Capitol Record* cases.⁹⁸

On the other hand, a different wind seems to be blowing from the direction of the Ninth Circuit Court of Appeals, which, in a decision handed down only about two weeks before this meeting, reversed the second decision of the District Court of Idaho in the "*community antenna*" litigation, which had protected a local radio station against tortious interference with its exclusive contractual rights concerning the first run of certain affiliated network television programs and had also considered the activities of the community antenna operators to constitute unfair competition.⁹⁹ It should be noted that this particular litigation involved no claims based on either statutory or common law copyright. The Ninth Circuit, in distinguishing the *International News* case on several grounds, refused to grant the exclusive licensee relief on either a theory of contract interference or unfair competition. The court said:

But to grant appellees relief without Congressional authorization on other grounds not consistent with the copyright act is, in effect, to recognize a new protectible interest.

According to Judge Koelsch's opinion, common law theories of recovery may not be resorted to "to redeem what are in essence copyright interests". "As we read *Sears and Compco*, however, only actions for copyright infringement or such common law actions as are consistent with the primary right of public access to all in the public domain will lie." Interestingly enough, however, the court's opinion does not quite end at this point but in a final paragraph remands the case to the district court for the purpose of permitting an amended claim which the station might be able to file, based on statutory or common law copyright protection. Such claim could not have been included without

97. *Capitol Records, Inc. v. Greatest Records, Inc.*, 142 U.S.P.Q. 109 (N.Y. Sup.Ct. 1964).

98. *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 87 U.S.P.Q. 173, aff'd 279 App. Div. 632; *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 105 U.S.P.Q. 163.

99. *Cable Vision, Inc., and Idaho Microwave, Inc. v. KUTV, Inc., The Klix Corporation, et al.*, not yet officially reported. For the decision below, see 211 F. Supp. 47 (D.C. Ida. 1962).

joining the licensor or copyright proprietor as an indispensable party. It seems clear that in the court's opinion, the broadcast as such would not have constituted "publication" of the material thus broadcast so that common law copyright protection may yet be available to the extent that the broadcast programs or messages themselves constituted original contributions to which title can be asserted by the originator or, derivatively, by an exclusive licensee. But even in the light of this probably rather dim prospect of ultimate success, the fact remains that the court did not feel justified to grant protection based on principles of unfair competition against willful interference with contracts dealing with the use and distribution of uncopyrighted subject matter in the absence of an express congressional mandate as proposed in the pending Unfair Commercial Activities bill.¹⁰⁰

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100. H.R. 4651, 88th Cong., 1st Sess., introduced by Congressman Lindsay March 7, 1963. Hearings were held on the bill, which is entitled "A Bill to provide civil remedies to persons damaged by unfair commercial activities in or affecting commerce," before the House Committee on Interstate and Foreign Commerce on June 16, 1964.

It may be worth noting that the New York World's Fair Corporation recently sought and obtained a preliminary injunction restraining defendant from manufacturing, distributing, and selling postcards, photographs and similar items disclosing reproductions of buildings, exhibits and various activities of the World's Fair and from using the name "New York World's Fair" in connection therewith. Defendant's argument that the Sears, Roebuck and Day-Brite decisions had "overruled the various state cases which created a monopolistic right to be free of competition by giving the originator of an item, having commercial value, protection against copies under the theory of unfair competition," was rejected. *New York World's Fair 1964-1965 Corp. v. Colourpicture Publishers, Inc.*, 141 U.S.P.Q. 939 (N.Y. Sup.Ct. June 1964). The Court's opinion was recently upheld in a three-to-two decision by the Appellate Division, *New York World's Fair 1964-1965 Corp. v. Colourpicture Publishers, Inc.*, 142 U.S.P.Q. 237 (App.Div. July 1964). The two dissenting judges questioned whether the plaintiff had established a property right sufficient to permit control of the taking of photographs of the exteriors of buildings and exhibits situated within the World's Fair grounds. The dissenting judges added the following observation with regard to the Sears, Roebuck and Day-Brite cases: "Thus, if the buildings and exhibits, the designs of which have not been patented, could themselves have been copied by others, it would appear that photographic reproductions of these buildings and exhibits for the purpose of sale cannot be enjoined." It seems to this writer that the principal issue involved was not one of "product simulation", but a form of unfair competition based on interference with exclusive contractual arrangements, i.e., an issue which neither in the community antenna case nor in the World's Fair case would justify a reliance on the holding or dicta in Sears, Roebuck and Day-Brite.

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. UNITED STATES OF AMERICA AND TERRITORIES

5. U. S. CONGRESS. HOUSE.

H.R. 12354. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. St. Onge August 12, 1964, and referred to the Committee on the Judiciary. 36 p. (88th Cong., 2d sess.)

Identical with H.R. 11947 and S. 3008 of the same Congress. See 11 BULL. CR. SOC. 410, Item 276 (1964).

2. FOREIGN NATIONS

6. AUSTRALIA. *Laws, statutes, etc.*

Loi portant modification de la loi sur le droit d'auteur de 1912-1950, no. 7 du 14 mai 1963. (*Revue Internationale du Droit d'Auteur* 189-191, no. 43, May 1964.)

A French translation of the Act of May 14, 1963, amending the Australian copyright statute. See 11 BULL. CR. SOC. 262, Item 149 (1964).

7. GREAT BRITAIN. *Laws, statutes, etc.*

Loi de 1963 sur la protection des artistes interprètes ou exécutants, du 31 juillet 1963; loi destinée à modifier la loi concernant la protection des artistes interprètes ou exécutants en vue de donner effect à la Convention conclue à Rome le 26 octobre 1961. (*Revue Internationale du Droit d'Auteur* 201-203, no. 43, May 1964.)

A French translation of the British law of July 31, 1963, which was passed for the purpose of ratification of the Rome Convention on Neighboring Rights of 1961. See 11 BULL. CR. SOC. 413, Item 281 (1964).

8. MEXICO. *Laws, statutes, etc.*

Decree amending and amplifying the Federal law of copyright, of November 4, 1963. (77 *Le Droit d'Auteur* (English inset) 118-125, no. 7, July 1964; 133-142, no. 8, Aug. 1964.)

"Decree adding to the Federal Law of Copyright of December 29, 1956 (of November 16, 1963)": p. 142. Also appears in French in the main sections of the same issues of *Le Droit d'Auteur*.

An English translation of the new Mexican copyright statute of 1963. See 11 BULL. CR. SOC. 329, Item 203 (1964).

9. NEW ZEALAND. *Laws, statutes, etc.*

Règlement de 1963 concernant le droit d'auteur (Douanes), no. 85, du 5 juin 1963. (*Revue Internationale du Droit d'Auteur* 197-201, no. 43, May 1964.)

Another French translation of the New Zealand regulation governing matters which, by section 29 of the Copyright Act 1962, "are left to be prescribed in connection with the provisions under which the owner of the copyright may give notice in writing to the Minister of Customs restricting the importation of copies of a work or edition." See 11 BULL. CR. SOC. 329, Item 204 (1964).

10. NEW ZEALAND. *Laws, statutes, etc.*

Règlement de 1963 concernant le droit d'auteur (Redevances afférentes aux phonogrammes), no. 84, du 5 juin 1963. (*Revue Internationale du Droit d'Auteur* 193-197, no. 43, May 1964.)

Another French translation of the New Zealand Copyright (Record Royalties) Regulations 1963. See 11 BULL. CR. SOC. 330, Item 205 (1964).

11. SALVADOR. *Laws, statutes, etc.*

Décret no 376. (*Revue Internationale du Droit d'Auteur* 203-217, no. 43, May 1964.)

Another French translation of the copyright statute of El Salvador. See 11 BULL. CR. SOC. 330, Item 206 (1964).

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

12. **UNIVERSAL COPYRIGHT CONVENTION. GUATEMALA.**

The Government of Guatemala has deposited with UNESCO its instrument of ratification of the Universal Copyright Convention, to become effective on October 28, 1964.

PART IV.

JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

13. *OA Business Publications, Inc. v. Davidson Publishing Co.*, 334 F.2d 432, 142 U.S.P.Q. 119 (7th Cir., June 29, 1964) (Knoch, J.)

Appeal from judgment for defendant in action for copyright infringement, unfair competition and trademark disparagement. Plaintiff and defendant publish competing trade periodicals. Defendant published an advertising brochure in which it reproduced two pages of an issue of plaintiff's special daily edition for the annual convention of the National Stationers and Office Equipment Association, contrasting these two pages with two pages of defendant's own special convention edition.

Held, affirmed.

I. *Copyright infringement*. Plaintiff argued that there was a valid copyright on the issue of its publication from which defendant had copied the two pages, because there was a notice of copyright on page 3, the "masthead" page. The court held however, that the title of the publication (as shown on the copyright certificate) was "Daily Office Appliances NSOEA Convention Edition" rather than just "Daily Office Appliances." The court then held that since the full and proper title appeared only on page 1, that was the "title page" and that the copyright notice on the masthead page, which page carried only the words "Daily Office Appliances" and thus could not be the "title page," was ineffective. Consequently, the issue of plaintiff's periodical from which defendant had copied was in the public domain.

II. *Unfair Competition and Trademark Disparagement*. The court also held that defendant's comparison of its own two pages with two of plaintiff's pages, even though nontypical pages may have been selected, was neither false nor misleading, and that, therefore, defendant was not guilty of unfair competition or of trademark disparagement.

14. *Edwin H. Morris & Co., Inc. v. Munn*, 233 F. Supp. 71, 142 U.S.P.Q. 440 (E.D. S.C., Sept. 4, 1964) (Simons, J.)

Action for copyright infringement. Plaintiffs charged that their copyrighted songs, "Sentimental Journey" and "The Waltz You Saved For Me", had been performed without plaintiffs' permission at defendant's El Roco Club. Plaintiffs moved for summary judgment.

Held, judgment for plaintiffs.

I. The court held that plaintiffs had established that defendant had given unauthorized performances for profit of the plaintiffs' musical compositions.

II. It was also held that "The two plaintiffs and their respective separate claims are properly joined in this cause of action in that the separate claims for copyright infringement arose out of the same series of occurrences, and the questions of fact and law establishing copyright infringements are common to both claims."

A permanent injunction was granted, restraining defendant from performing the two songs, in addition to damages of \$500 (\$250 minimum statutory damages on each of the two counts) and attorneys' fees of \$500.

2. State Court Decisions

15. *Sterner v. Hearst Corporation*, N.Y.L.J., May 7, 1964, p. 14, c. 2 and June 17, 1964, p. 13, c. 3 (Sup., N.Y. Co.) (Amsterdam, J.)

Action for infringement of common law copyright, infringement of property rights in an "unfinished party program" and unfair competition. Defendants moved to dismiss the complaint.

Held, motions granted.

The court held that plaintiff had not shown that he had any protectible property rights, the claimed property right alleged being in an idea or combination of ideas in the public domain, and that there was no allegation of contract or of any act which could be described as unfair competition. The court said:

The claimed right of property, as alleged, is an idea or combination of ideas centering around party foods and non-foods and presented as a "Party Program Package". To this extent there is nothing copyrightable in the words, phrases and ideas disclosed. All are of commonest vintage, out of the public domain, and freely copyable. They have not been put into any concrete form by plaintiff and not so alleged in the complaint and, consequently, there is nothing from which to infer that the form is not legally copyable or may not be fairly used in competition. There is no

allegation of the copying or of unfair use otherwise of a unique form and context embodying the non-protected ideas. In fact, there is no allegation that defendants have to any extent simulated anything which plaintiff created as the embodiment of any idea and which is made at all identifiable. Nor does plaintiff allege any contractual relationship with the defendants, nor any approach whatever by any of them to him or by the plaintiff to the defendants. Consequently, there is total absence of any relationship out of which any liability could flow.

16. *Baez v. Fantasy Records, Inc.* (Cal. Super., June 3, 1964) (Karesh, J.) (Unreported) (no opinion) *

Action to restrain manufacture and sale of phonograph record album entitled "Joan Baez in San Francisco" containing certain performances by singer Joan Baez. Miss Baez contended that the performances in question were recorded in 1958 not intended for public release, and that she was an infant at the time the recordings were made, and therefore entitled to disaffirm the contract for services allegedly entered into in connection with the performance in question.

Held, preliminary injunction granted.

The defendants were enjoined from selling, distributing or publicly performing any of Miss Baez's 1958 performances including those contained in the "Joan Baez In San Francisco" album.

ALSO OF INTEREST:

17. *Clark v. Synthetic Plastics Co.*, N.Y.L.J. May 20, 1964, p. 15, c. 1 and June 22, 1964, p. 13, c. 3 (Chimera, J.)

A preliminary injunction was denied to a plaintiff seeking to restrain the use of his name and likeness in connection with the manufacture, distribution and sale of phonograph records made without authority from a tape of a live performance. The court said that "the circumstances under which plaintiff's recordings and photograph gained circulation should be further explored before granting drastic injunctive relief to the end that it may be discovered whether there was an unprotected publication at any time."

On reargument the court said that while it was "quite true that only written consent will authorize use of a person's name and likeness unless they are integrated with the use of unprotected recordings made

* A copy of the order was furnished to the Editors by Benjamin Dreyfus, Esq., of the California Bar.

by the person whose name and likeness are used", injunctive relief should await trial.

18. *Opinion of the Attorney General of the State of New York*, July 21, 1964. 142 U.S.P.Q. 288 (1964).

COPYRIGHTS

1. Infringement—In general (§24.201) Matter copyrightable—In general (§24.301)

Texts of opinions of New York courts are in public domain and may be published and used without fear of copyright infringement; however, in view of coverage of copyright taken in name of New York Secretary of State under section 438 of New York Judiciary Law, copyrighted statements of fact, headnotes, and all other matter prepared by Law Reporting Bureau and appearing in official reports may not be used as part of any publication of such texts in absence of express legislative authorization.

Hon. John P. Lomenzo
Secretary of State
162 Washington Avenue
Albany, New York

Dear Judge Lomenzo:

This is in reply to your inquiry of March 27, 1964 concerning the use of the official law reports of this State by a commercial legal research service. Although your letter refers to the New York Reports (the official publication of this State of cases determined in the Court of Appeals), I assume you also have in mind the Appellate Division Reports, the official State publication of cases determined in the Appellate Divisions of the Supreme Court, and the Miscellaneous Reports, the official State publication of cases determined in any other court (Judiciary Law, §433-a).

Briefly, the service in question utilizes Univac (computer) machines which, having been preadjusted for the purpose, lead to the selection of adjudicated cases relevant to a given legal problem and reported in the official law reports and such cases are then reproduced from the official law reports for the use of subscribers to the service. In essence, your question is whether such use of the official law reports amounts to an infringement of the copyright held by the Secretary of State pursuant to Judiciary Law, §438, which provides as follows:

The copyright of the statements of facts, of the head notes and of all other notes or references prepared by the law reporting

bureau must be taken by and shall be vested in the secretary of state for the benefit of the people of the state. The secretary of state is authorized by a writing filed in his office to grant to any person, firm or corporation, under such terms and conditions as he may determine to be for the best interests of the state, the right to publish the above mentioned copyrighted matter in an annotated edition of the volumes of law reports prepared by the law reporting bureau or its predecessors which have been heretofore issued. Such publication shall be made without cost to the state, and nothing in this section contained shall otherwise affect the obligation of any contract for the publication of such reports.

(For matter required to be included in the official law reports by the Law Reporting Bureau, see Judiciary Law, §§433, 433-a.)

[1] There is no doubt that the texts of the opinions of the courts of this State are in the public domain and may be published and used without fear of copyright infringement. At the same time, however, in view of the coverage of the copyright taken in the name of the Secretary of State under §438 (first sentence), it is equally clear that so long as such copyright endures, the statements of fact, headnotes and all other matter prepared by the Law Reporting Bureau and appearing in the official reports may not be used as part of any publication of such texts in the absence of express legislative authorization similar to that now provided in that section for other use. As I read the existing authorization provision it is not broad enough to be applied to the instant situation.

In reaching this conclusion I am not unaware of the potential value of the service in question as a timesaving aid in the search for legal precedent, thus benefiting the public in general and the legal profession in particular. Even so, the problem is not one with respect to which I have any discretion or latitude but rather one to be brought to the attention of the Legislature.

Very truly yours,

LOUIS J. LEFKOWITZ
Attorney General

B. DECISIONS OF FOREIGN COURTS

1. England

19. *Dorling v. Honnor Marine Ltd.*, (1964) 2 W.L.R. 195 (Eng., Court of Appeal, Dec. 13, 1963). *For decision below, see* (1963) 3 E.L.R. 397; (1963) 2 All E.R. 495.

Appeal from judgment for defendant in action for copyright infringement. Plaintiff had designed a 14-foot sailing dinghy which he named the "Scorpion." He sought an injunction to restrain the defendant from infringing his copyright in the plans for the "Scorpion" by selling to the public photographs of parts of the dinghy, and actual parts and kits of parts. The trial court held that plaintiff had lost his copyright in the plans because he could have registered the design of the "Scorpion" under the Registered Designs Act of 1949.

Held, reversed.

I. It had been agreed by the judges that neither the plans themselves nor the kits of parts, the parts being "essentially functional", were registrable under the Registered Designs Act, but it was contended that the shape of the boat could have been so registered. Since the Registered Designs Act, which deals with "industrial copyright", provides that artistic copyright in a design is forfeited if the design should be registered under the Act as an industrial design, but the proprietor fails to make such registration, defendant argued that he was free, by reason of such failure to register, to copy the dinghy and its parts by way of reproducing actual parts and photographs despite the originally valid artistic copyright in the plans. The justices agreed, however, that no significant registration was possible under the Registered Designs Act. Since there was no failure to register a registrable design, the copyright in the plans remained valid. Harman, *L.J.*, said:

I now turn to the Copyright Act, 1956, section 10 of which starts by re-enacting the old provision that articles protected by the Registered Designs Act, 1949, are not, while that protection lasts, also to be protected under the Copyright Act, 1956. . . .

Subsection (2) of section 10 is as follows: "Where copyright subsists in an artistic work, and—(a) a corresponding design is applied industrially" . . . subsection (3) comes into force . . . (a) "during the relevant period of fifteen years, it shall not be an infringement of the copyright in the work to do anything which, at the time when it is done, would have been within the scope of the copyright in the design if the design had, immediately before that time, been registered . . ." Are, then, the plans and the parts made from them "within the scope of the copyright in the design"? I think not. The only design which could have been registered was the mere shape of the boat and I am of opinion, therefore, that the details in the plans are not within the scope of the design copyright. It follows, I think that the company (defendant) does

not bring itself within section 10 and that this is no bar to the action.

To hold otherwise would I think amount to saying that no artistic copyright existed in the plans, which could therefore be freely taken and copied and which at the same time could not be protected as a design either. I do not think the legislature intended any such result.

Danckwerts, *L.J.*, said:

It was common ground that the plans were not registrable under the Registered Designs Act, and that also the parts or kits were not registrable under that Act because they were essentially functional. It was suggested that the one thing which was registrable under the Act was the shape of the completed dinghy and the arguments proceeded on the footing that the shape of the completed boat was a registrable design. I feel the greatest doubt whether that was correct. I should have thought that the shape of the boat was necessarily functional, and was, therefore, not registrable under the Registered Designs Act, 1949. If it is not registrable, of course, the provisions of the Registered Designs Act, 1949 and provisions in section 10 of the Copyright Act, 1956, designed to prevent the proprietor of a design having both artistic copyright and the protection of a registered design, would be irrelevant.

II. It was held that the copyright in the plans was infringed by their reproduction in three-dimensional form as parts and kits of parts for the "Scorpion" and also by the photographs of the parts. Harman, *L.J.*, said:

Section 9 (8) [of the Copyright Act of 1956] is in these terms: "The making of an object of any description which is in three dimensions shall not be taken to infringe the copyright in an artistic work in two dimensions, if the object would not appear, to persons who are not experts in relation to objects of that description, to be a reproduction of the artistic work." This in my opinion is a question of fact. As to it the judge held that each drawing of a part was an object within the subsection and that it would appear to him as a non-expert that these parts when made were a reproduction of the corresponding plan, each drawing in the plan having, I take it, artistic copyright. That is enough to decide the question. . . .

With reference to the photographs, Danckwerts, *L.J.*, said:

. . . These . . . are not photographs of the plans, but are photographs made of the parts made with the use of the plans, and of the completed boat. The result is representations which so resemble the drawings in the plans, as to appear to be reproductions of them. . . . The parts and the completed boat are reproductions of the two-dimensional plans (which admittedly are not registrable under the Registered Designs Act, 1949) and the plans thus having been converted into a three-dimensional form are reproduced by the photographs in a two-dimensional form. It is clearly a case of copying a copy of an artistic work protected by the Copyright Act, 1956, and, therefore, an infringement of that copyright. It is well established that "Copyright may be infringed by copying something which is itself a copy of the plaintiff's work. If the original work has been reproduced it is no answer to say that it has been copied from a work which was itself, whether licensed or unlicensed, a copy of the original": See Copinger and Skone James on Copyright, 9th ed., p. 180.

Davies, *L.J.*, concurred.

20. LATER NOTICE FROM THE COPYRIGHT OFFICE ON REGISTRATION IN MEXICO.

Supplementing our recent announcement (*supra*, page 1), with respect to the 1963 Mexican copyright law, all interested parties are advised that it is *not* necessary to obtain any certification of the U. S. Copyright Office as a part of the Mexican registration procedure.

Registration under Article 6 (transitional) of the "Decree adding to the Federal Law of Copyright of December 29, 1956" (dated November 16, 1963 and effective December 22, 1963), for the purpose of obtaining the protection of the 1963 law with respect to non-registered works which fell into the public domain in Mexico prior to January 1, 1948, may be accomplished by filing, on or before December 21, 1964, directly with:

Director General de Derecho de Autor
Secretaría de Educación Pública
Rio Lerma No. 4-5 piso
Mexico, D. F. Mexico

the following:

1. *Application.* This may consist of a letter requesting registration under Article 6 (transitional) of the above-mentioned Decree for the

list of works enumerated in the letter. This must be accompanied by a translation of the letter into Spanish.

2. *Affidavit* of sole ownership of the listed works, which must be categorized by title, copyright proprietor, author(s), U. S. copyright registration number, and date of copyright. If any author is deceased, his date of death must be specified and reference thereto made in the affidavit. This is to be accompanied by a translation of the affidavit into Spanish.

The affidavit must be duly acknowledged and the signature of the notary authenticated. A certification of the local Mexican Consul may also be advisable, but it is understood that an otherwise properly executed affidavit will not be refused if the latter is not included.

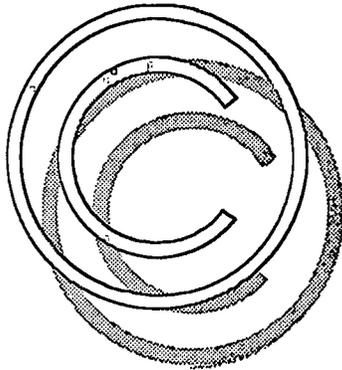
3. *Three Copies* of each work listed, signed by the copyright proprietor.

4. *Copyright Registration Fees* of 5 pesos (approximately \$0.40) for each work listed and 5 pesos for the single certificate. (These are exclusive of any documentary or other similar fees.)

Registration of any works which were published during the period January 1, 1948 to May 11, 1957, and which are in the public domain in Mexico by reason of non-registration, may be accomplished by the same procedure, except that

- (1) The deadline of December 21, 1964 is not applicable, and
 - (2) Reference should be made in the application and affidavit to Article 28 of the "Decree Amending and Amplifying the Federal Law of Copyright" (dated November 4, 1963 and effective December 22, 1963) instead of to Article 6 (transitional) referred to above.
-

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PART I.

ARTICLES

21. IMPORTATION AND PROTECTION OF WORKS OF AMERICAN AUTHORS MANUFACTURED ABROAD VIA THE U.C.C. EXEMPTION FROM FORMALITIES: *HOW NOW SACRED COW?*

By DONALD S. ENGEL*

Among the countries which are major producers of copyrighted material, the United States is unique in its insistence upon certain formalities as conditions for securing and enforcing copyrights. It is virtually alone in requiring that a specified form of notice be affixed in a designated place on copies of the published work as a condition precedent to securing copyright protection¹ and that copies be deposited and registration made as prerequisites to the institution of infringement proceedings.² In the case of all printed books and periodicals, the copies deposited and all copies accorded protection under United States copyright law must be manufactured in the United States,³ with certain exceptions which will be discussed below. Books and periodicals which claim United States copyright protection cannot be imported unless they comply with the domestic manufacturing requirements.⁴ These so-called formal requirements and the general reluctance of the United States to extend statutory copyright protection to foreign nationals presented formidable barriers to the establishment of beneficial international arrangements for many years.⁵

* Asst. Professor of Law, Rutgers, The State University School of Law.

1. 17 U.S.C. §10 (1958).

2. 17 U.S.C. §13 (1958).

3. 17 U.S.C. §16 (1958).

4. 17 U.S.C. §107 (1958).

5. See Garland, "Our Copyright Law: Growing Pains in International Society," 11 ASCAP COPYRIGHT LAW SYMPOSIUM 82, 87-89 (1962); Sherman, "The Universal Copyright Convention: Its Effect on United States Law," 55 Colum. L. Rev. 1137, 1141, 1159 (1955); Zines, "Revision of Copyright Law," 37 Austl. L. J. 247, 248 (1963). See also Loh, "Chinese Reprinters and World Copyright Practice," Publishers' Weekly, Mar. 30, 1964, pp. 20, 24.

The manufacturing clause and the import restrictions which help implement it contain a myriad of exceptions to the apparently pervasive provisions requiring domestic manufacture. Despite these inroads made to accommodate various legitimate interests, all of which could have been served by total repeal of the clause, the manufacturing clause retains vitality and importance, especially with respect to the American author. It is a sad fact that today, as a result of the partial emasculation of the manufacturing clause, a foreign author who desires to have his book or periodical produced abroad for importation into the United States is in a more favorable position than an author who is a citizen of the United States. If the author is a foreign national he is better off for copyright purposes if he is not domiciled in the United States; if he does come to this country to live and work he may, nonetheless, retain some freedom to obtain copyright on works in his native language manufactured abroad if he does *not* become an American citizen.⁶ If we accept as true the sole argument advanced in support of the desirability of the manufacturing clause—that books can be manufactured abroad and imported for sale here at a cost substantially below that of domestic manufacture to the irreparable damage of the domestic printing and binding industry—the current law places the American author in an unfair and grossly unjust position and may substantially diminish his ability to compete in certain fields with foreign authors.⁷

The ratification by the United States of the Universal Copyright Convention⁸ represented a significant step towards universal reciprocal

6. See generally Derenberg, "The Status of United States Authors and Works First Published in the United States under the Universal Copyright Convention," 5 BULL. CR. SOC. 206 (1958), Paul, "A Reappraisal of the Manufacturing Clause of the Copyright Act in Light of Its History and the Universal Copyright Convention," 13 U. Miami L. Rev. 304 (1959); Younger, "Citizens Who Publish Abroad: A Study in the Pathology of American Copyright Law," 44 Cornell L. Q. 215 (1959).
7. See House Comm. on the Judiciary, 88th Cong., 1st Sess., DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE COPYRIGHT LAW, 196, 197, 244, 385, 386 (Comm. Print 1963) (hereinafter cited as DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER).
8. The Universal Copyright Convention, Sept. 6, 1952 [1955] 3 U.S.T. & O.I.A. 2731 (hereinafter cited as U.C.C.), by its terms, was to become effective three months after deposit of twelve instruments of ratification or acceptance. U.C.C. art. IX. The United States ratified the Convention on December 6, 1954. By virtue of the deposit on June 16, 1955 of the ratification instrument of Monaco, the twelfth country to adhere to the Convention, the Convention became effective on September 16, 1955 with respect to those countries which had already ratified. See 17 U.S.C. §9 (1958).

copyright relations which may eventually afford to all authors worldwide protection of the fruits of their intellectual and artistic efforts. In order to comply with the terms of the Convention, the copyright laws were amended to exempt from the domestic manufacturing requirements certain works entitled to copyright protection in the United States by virtue of the Convention. This exemption is by far the most important loophole in the general scheme of the copyright law which bars the importation of copyrighted books and periodicals manufactured abroad. Despite a proviso which purports to deny the exemption with respect to works of American nationals and domiciliaries, it is possible to import foreign manufactured books and periodicals containing material created by American writers, translators, illustrators and photographers without forfeiting United States copyright protection. This paper will investigate several techniques which may be utilized to accomplish this result.

THE MANUFACTURING CLAUSE AND IMPORT RESTRICTIONS

According to spokesmen for the printing industry, the provisions of the copyright law which prevent the importation into the United States of most copyrighted books and periodicals manufactured abroad are absolutely essential to the welfare of that industry.⁹ The available economic evidence is inconclusive and the importation figures may be used to draw conflicting inferences which do not appear to resolve the issues involved.¹⁰ In any event, the pressure brought by proponents of domestic manufacturing requirements for copyrighted books has succeeded in retaining the basic restriction.

Authors cannot help but resent a law which sometimes forces a choice between forfeiture of copyright protection for their works, including the often valuable right to authorize the making of other versions of the work, and manufacture in the United States at a competitive disadvantage (or no publication at all). Despite almost unanimous opposition to the clause by scholars and the copyright bar, and although the Register of Copyrights is apparently in full accord with their viewpoint, proposals for elimination of the current restrictions in the revision of the copyright law have been coupled with alternative recommendations which

9. McCannon, "The Manufacturing Clause of the U.S. Copyright Law," in 2 STUDIES ON COPYRIGHT (*Arthur Fisher Memorial Edition*) 1123, 1146, 1173-75 (1963); Publishers' Weekly, Dec. 24, 1962, pp. 14, 15; Publishers' Weekly, Nov. 5, 1962, pp. 54, 55.

10. See generally McCannon, *supra* note 9, at 1123. The study concludes that the manufacturing clause "is not achieving much protection for the domestic printing industry" and "seems incongruous in a world dedicated to the removal of trade barriers." *Id.* at 1189. See H.R. Rep. No. 2608, 83rd Cong., 2d Sess. (1954).

continue in effect the present law with only minor modification.¹¹ Thus, although the copyright law is obviously an inappropriate vehicle for enforcing what is essentially an international trade policy, it appears that the manufacturing clause, the sacred cow of the American printing industry,¹² will continue to plague authors, proprietors and their representatives for some time to come.¹³

Section 16 of the copyright law provides in substance that all copies of books and periodicals accorded United States copyright protection be manufactured in the United States. Specifically, the text of such copies must be printed and bound in the United States from type set or plates made within the United States or, if produced by a lithographic or photoengraving process, be manufactured by a process wholly performed within the United States.

Dramas and musical works, although published in book form, were held under the prior law not to be "books" for the purpose of the domestic manufacturing requirements.¹⁴ The manufacturing requirements

11. See House Comm. on the Judiciary, 87th Cong., 1st Sess., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 124 (Comm. Print 1961) (hereinafter cited as REPORT OF REGISTER); Preliminary Draft of Proposed Revision of the U.S. Copyright Law 84-87 (mimeo 1963-1964) (hereinafter cited as Preliminary Draft of Revision).
12. "The Manufacturing Clause as it was incorporated in the 1909 Act is an anomaly, replete with exceptions and ambiguities. . . . its inclusion was claimed to have been the result of pressure from the Typographical Unions." Tannenbaum, "The U.S. Copyright Statute—An Analysis of its Major Aspects and Shortcomings," 10 N.Y.L.F. 12, 18 (1964).
13. The Copyright Office general revision bill, introduced in the Senate on July 20, 1964, contains a clause which prohibits
 "importation into the United States of copies of a book consisting preponderantly of nondramatic literary material that is in the English language and is protected under this title . . . unless the portions consisting of such material have been wholly manufactured in the United States." S. 3008, 88th Cong., 2d Sess. §43(a) (1964).

An identical bill was introduced simultaneously in the House of Representatives as H.R. 11947, 88th Cong., 2d Sess. (1964), and the same bill was subsequently introduced in the House as H.R. 12354, 88th Cong., 2d Sess. (1964). See Kaminstein, "The McClellan-Celler Bill for General Revision of the United States Copyright Law," 10 N.Y.L.F. 147, 153 (1964).

14. *Hervieu v. J.S. Ogilvie Pub. Co.*, 169 Fed. 978 (C.C. S.D.N.Y. 1909) (published drama); *Littleton v. Oliver Ditson Co.*, 62 Fed. 597 (C.C. D. Mass. 1894), *aff'd per curiam* 67 Fed. 905 (1st Cir. 1895) (musical composition). The regulations of the Copyright Office permit the registration of published lectures as "books." 37 C.F.R. §202.6 (1960). The proposed bill for the general revision of the copyright law would limit the prohibition

of section 16 do, however, apply to illustrations produced by lithographic or photoengraving process in a book containing printed text and to separate lithographs and photoengravings.¹⁵ In *Basevi v. Edward O'Toole Co.*,¹⁶ the court held that a catalogue of paintings containing only incidental text consisting solely of titles and captions was a "book" and could have been copyrighted as such; there was, however, no need to allege domestic manufacture pursuant to section 16 in a suit seeking an injunction against copyright infringement since the catalogue did not consist of "text" in any proper sense and the illustrations were expressly excepted from the manufacturing requirements as reproductions of works of art located in a foreign country. It may be that where a "book" does not contain copyrightable text the domestic manufacturing requirements are not at all applicable even to illustrations therein since the requirements of section 16 extend only to "illustrations within a book consisting of printed *text* and illustrations" and "separate lithographs and photoengravings."¹⁷ For the purposes of this paper, it will suffice to conclude in summary that the domestic manufacturing requirements of section 16 purportedly cover books containing copyrightable text, lithographed and photoengraved illustrations in such books and separate lithographs and photoengravings.¹⁸

Section 16 does not contain any enforcement provisions. However, an affidavit evidencing compliance with the domestic manufacturing requirements must accompany copies of books deposited for the purpose of registering a claim to copyright and the making of a false affidavit with knowledge is a misdemeanor and results in forfeiture of copyright protection.¹⁹ Section 107 prohibits the importation, "during the existence of the American copyright," of copies not produced in accordance with

against importation of foreign-manufactured copies to "nondramatic literary material." S. 3008, §43(a).

15. See 28 OPS. ATT'Y GEN. 150 (1910). Excepted are illustrations where "the subjects represented are located in a foreign country and illustrate a scientific work or reproduce a work of art." 17 U.S.C. §16 (1958).
16. 26 F.Supp. 39 (S.D.N.Y. 1937) (denial of motion to dismiss); 26 F.Supp. 41 (S.D.N.Y. 1939).
17. See Howell, COPYRIGHT LAW 101 (1962); McCannon, *supra* note 10, at 1151, 1152.
18. A more extensive consideration of the applicability of the manufacturing clause is beyond the scope of this paper. An excellent discussion of the subject may be found in the study made for the purpose of making recommendations for revision of the copyright law, McCannon *supra*, note 10, and also in Amdur, COPYRIGHT LAW PRACTICE 620-49 (1936).
19. 17 U.S.C. §§17, 18 (1958).

the domestic manufacturing requirements of section 16.²⁰ The major responsibility for enforcement of the import restrictions falls upon the personnel of the Bureau of Customs at the various ports of entry throughout the United States,²¹ but because of the many highly technical problems which arise, and despite the cooperation of the Copyright Office, enforcement is spotty at best.²² The importation of copies of a work in violation of section 107 does not result in a forfeiture of previously existing copyright protection and is no defense to an infringement action.²³ However, section 105 provides that the affixation of a copyright notice with fraudulent intent is a misdemeanor and would appear to cover a situation where the notice is affixed and an attempt made to import the book for later publication with knowledge that section 107 prohibits the importation.²⁴

The last proviso of section 16 states that "the provisions of this section shall not affect the right of importation under the provisions of section 107 of this title." Since section 107 depends wholly upon section 16 for its vitality, the only meaningful interpretation of the proviso is that copies of a book or periodical may be imported if so provided in section 107 notwithstanding the fact that they were manufactured in violation of section 16. Although permitted entry by an expressed exemption of section 107, such books could not lawfully be used as deposit copies to register copyright and, unless they are entitled to copyright protection by virtue of prior publication of lawfully manufactured copies or pur-

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20. 17 U.S.C. §107 (1958). Literally, the language of §107 applies only where there is already existing American copyright in the work. Since, under the present law, copyright is obtained upon publication of the work with notice affixed, §107 by its terms does not prohibit the importation prior to their first publication of copies of works containing copyright notice. It appears highly unlikely that any court would accord to section 107 such a technical interpretation since Congress obviously intended that it form the cornerstone of a pervasive statutory scheme which would enable the Treasury Department and the Post Office Department to prevent the importation of books which are not and will not become entitled to copyright protection because of non-compliance with section 16 but which nevertheless purport to be copyrighted.
 21. See 17 U.S.C. §§108, 109 (1958).
 22. See McCannon, *supra* note 10, at 1156.
 23. *Bentley v. Tibbals*, 223 Fed. 247, 252 (2d Cir. 1915). The proposed bill for the general revision of the copyright law provides that it shall be a complete defense to an infringement action if the owner of copyright has knowingly authorized or acquiesced in a violation of the import restrictions against foreign-manufactured copies. S. 3008, §43(d).
 24. 17 U.S.C. §105 (1958).

suant to the Universal Copyright Convention, the purported copyright is probably unenforcible.

The first exception to the import restrictions of section 107 repeats word for word an exemption contained in section 16 and apparently neither adds to nor detracts from the basic provisions of section 107.²⁵ The redundancy may conveniently be attributed to an overly solicitous attitude towards the persons who would benefit from the first exception or to legislative oversight in this instance similar to that which resulted in a duplication of exemptions in section 16.²⁶

Section 16, by its terms, exempts periodicals of foreign origin in a language or languages other than English, but exception (b) of section 107 appears to be broader, since it would include foreign newspapers and magazines in English which contain articles copyrighted in the United States. Thus, unless covered by an exception, books or pe-

-
25. The portions of the two sections pertinent to the text discussions are set forth below.

"Of the printed book or periodical specified in section 5, subsections (a) and (b) of this title, except the original text of a book or periodical of foreign origin in a language or languages other than English, the text of all copies accorded protection under this title, except as below provided, shall be printed . . . *Provided, however,* that said requirements shall not apply to works in raised characters for the use of the blind, or to books or periodicals of foreign origin in a language or languages other than English, or to works printed or produced in the United States by any other process than those above specified in this section . . ." 17 U.S.C. §16 (1958).

". . . [The prohibition during the existence of American copyright against importation of copies of works not produced in accordance with the manufacturing provisions specified in section 16] shall not apply:

- (a) To works in raised characters for the use of the blind.
 - (b) To a foreign newspaper or magazine, although containing matter copyrighted in the United States printed or reprinted by authority of the copyright proprietor . . .
 - (c) To the authorized edition of a book in a foreign language or languages of which only a translation into English has been copyrighted in this country. . . ." 17 U.S.C. §107 (1958).
26. Although §16 contains a proviso that its requirements "Shall not apply . . . to books or periodicals of foreign origin in a language or languages other than English," the section also excepts "the original text of a book or periodical of foreign origin in a language or languages other than English." The former appears to encompass the latter. This peculiarity in draftsmanship has caused some consternation. See Treasury Decision (1910), 17 Copyright Office Bulletin 275 (1909-1914); Amdur, *COPYRIGHT LAW AND PRACTICE*, 626, 627 (1936).

riodicals made up *in part* of matter copyrighted in the United States may *not* be imported unless manufactured in compliance with section 16.²⁷

Exception (c) of section 107 permits importation of "copies of the authorized edition of a book in a foreign language or languages of which only a translation into English has been copyrighted in this country." Since section 16 already exempts such books if of foreign origin,²⁸ the section 107 exception would be important only with respect to works by an American author or works first published in the United States.²⁹ That such an exception is necessary implies that section 16 requires domestic manufacture if any version of a work is protected by United States copyright, at least where it is difficult or impossible to separate the copyrighted from the uncopyrighted matter, as in the case of translations.

Based upon the conclusions drawn from the examination of the several exceptions, the phrase "all copies accorded protection under this title" in section 16 appears to mean "all copies accorded *any* copyright protection under this title" and domestic manufacture is required if any part of the imported work is protected either because it is separately copyrighted or because another version of the imported work is copyrighted.

THE EFFECT OF THE UNIVERSAL COPYRIGHT CONVENTION

Section 9 of the current law governs eligibility to secure copyright;³⁰ true to its ignoble heritage,³¹ it limits the right to works of American nationals with three basic exceptions. Subsection (a) of section 9 extends the right to secure copyright to an alien author or proprietor "domiciled within the United States at the time of the first publication of his work." The second exception provides for the extension of the right to secure

27. "A statute should be construed so that effect is given to all of its parts, so that no part will be inoperative or superfluous . . ." Sutherland, *STATUTORY CONSTRUCTION* §4705 (3d Ed. 1943). See 22 *OPS. ATT'Y GEN.* 29 (1898) (prior law).

28. The words "of foreign origin" refer to books of foreign authorship first published abroad. See Howell, *COPYRIGHT LAW* 102, 103 (1962). See also Younger, *supra* note 7, at 127-29.

29. Exception (c) is even narrower, since it appears to cover only copies of original foreign language books, or translations into a second foreign language or original foreign language books, where *only a translation into English* has been copyrighted in the United States, not copies of translations into a foreign language of original English language books.

30. 17 U.S.C. §9 (1958).

31. See *Houghton Mifflin Co. v. Stackpole Sons, Inc.*, 104 F.2d 306, 308, 309 (2d Cir.), *cert. denied*, 308 U.S. 597 (1939); *Yeungling v. Schile*, 12 Fed. 97, 103-06 (C.C. S.D.N.Y. 1882).

copyright to the nationals of a country with respect to which there exists a presidential proclamation to the effect that such country grants reciprocal rights or national treatment to United States citizens.³² Subsection (c) of section 9, which became effective concurrently with the coming into force of the Universal Copyright Convention, provides that works of authors who are citizens or subjects of foreign countries which adhere to the Convention and works first published in such countries may be protected by copyright in the United States.³³ Works to which copyright is extended pursuant to subsection (c) are exempted from certain so-called formal requirements of the copyright law, including the manufacturing clause and the import restrictions on foreign manufactured books and periodicals, provided that all authorized copies published bear a copyright notice in the form and manner prescribed by the Convention.³⁴

The last paragraph of subsection (c) provides, however, that:

The provisions of this subsection shall not be extended to works of an author who is a citizen of, or domiciled in the United States of America regardless of place of first publication, or to works first published in the United States.³⁵

32. See *Bong v. Alfred S. Campbell Art. Co.*, 214 U.S. 236, 247, 248 (1909). Cf. *Todamerica Musica Ltda. v. R.C.A.*, 171 F.2d 369 (2d Cir. 1948); *Portuondo v. Columbia Phonograph Co.*, 81 F.Supp. 355 (S.D.N.Y. 1937).

33. 17 U.S.C. §9(c) (1958).

34. *Ibid.* See U.C.C. art. III, §1; 17 U.S.C. §§16, 17, 18, 19, 20, 107 (1958). Apparently, only the exemption from formalities is dependent upon the use of the Convention form of notice. Works eligible for copyright under subsection (c) but not within subsection (b) because of the absence of presidential proclamation would be protected if in compliance with the usual formalities of United States copyright law. It should be noted that compliance with the notice requirements of the Convention may not always be sufficient compliance with United States copyright law since, although §19 has been amended to permit the Convention approved wording, §20 still requires that the notice appear at one of the specified places in a printed publication whereas works eligible for protection by virtue of the Convention need only bear such notice "placed in such manner and location as to give reasonable notice of claim of copyright." Conversely, American authors who desire Convention protection should comply with Convention requirements by adding the year date to the form of notice prescribed for works enumerated in 17 U.S.C. §§5(f)-(k) (1958).

35. 17 U.S.C. §9(c) (1958). It is probable that the citizenship and domicile of the author "at the time of first publication" control, at least with respect to the right to secure copyright protection under §9(c), although the quoted language, which appears in §9(a), has not been repeated in §9(c). To hold otherwise would permit an author of a work which was ineligible to obtain copyright protection at the time of first publication, the act which secures statutory copyright, to perfect theoretically non-existent rights by a

It is not clear from the text whether it is merely the exemption from formalities or the basic right to secure copyright protection by virtue of compliance with the Convention which is denied the enumerated works by this proviso. The issue is largely academic since, if there is compliance with the formalities of the United States copyright law, an author eligible to obtain copyright pursuant to subsection (c) will, in most cases, also have available the alternative of claiming copyright under another provision of section 9. Citizens of the United States are eligible pursuant to the introductory paragraph; aliens domiciled in the United States at the time of first publication meet the conditions specified in subsection (a); and in the case of works of a foreign national not domiciled in the United States first published in the United States, the vast majority of nationals of countries which adhere to the Convention would be eligible to secure copyright pursuant to subsection (b), most convention countries also having previously been covered by presidential proclamation.³⁶ Thus, however interpreted, except with respect to works first published in the United States and authored by a national of a foreign country which is a member of the Convention but with respect to which no proclamation applies,³⁷ the effect of the above quoted proviso of subsec-

subsequent change of domicile or nationality. Cf. *Bong v. Alfred S. Campbell Art. Co.*, 214 U.S. 236 (1909); *Carte v. Evans*, 27 Fed. 861 (C.C. D. Mass. 1886). The bill for the general revision of the copyright law clarifies the situation. With respect to the right to secure copyright, the nationality and domicile of the author "on the date of first publication" governs. S. 3008, 88th Cong., 2nd Sess. §3(b)(1). Copies of the work manufactured abroad may be imported, however, if the author of any substantial part of such material is neither a citizen nor domiciliary of the United States "on the date when importation is sought." S. 3008, §43(b)(1). This would appear to permit the current proprietor to import foreign-manufactured copies of the protected work if the author, who may have long since parted with all interest in the work, is not then a citizen or domiciliary of the United States even if he was such at the time of first publication.

36. A list of the significant proclamations, treaties and conventions may be found in 17 U.S.C. §9 (Supp. V, 1964). A more recent compilation may be found in the appendix to TREATY AFFAIRS STAFF, DEP'T. OF STATE, TREATIES IN FORCE. Even though they do not come within any of the provisions of §9, foreign authors may be entitled to United States copyright protection by virtue of other copyright treaties. NIMMER ON COPYRIGHT 259 (1963).
37. Although all countries which adhere to the Convention meet the qualifications of subsection (b), presidential proclamations have not been forthcoming with respect to Convention member countries not previously covered by proclamation. Nationals of such countries are, therefore, not eligible to obtain copyright under subsection (b). *Bong v. Alfred S. Campbell Art. Co.*, 214 U.S. 236 (1909). Apparently, it has been assumed that

tion (c) is solely to deny to the enumerated works exemption from the domestic manufacturing requirements and other formalities of the copyright law.³⁸

Despite the proviso, there are two basic techniques whereby works which are accorded copyright protection in the United States may be manufactured abroad and imported although they contain matter created by an individual who is a United States national or domiciliary. One involves the use of the concept of works made for hire and the other involves partial abandonment or dedication of copyright.

IMPORTATION OF WORKS MADE FOR HIRE:
THE PROBLEM OF AUTHORSHIP

A brief look at the criteria for determining whether a work is "made for hire" might be helpful at this point. It appears that the dominant factor in establishing the existence of an employment relationship is the employer's right to control the manner of doing the actual work.³⁹ Where the effect of recognizing the employment relationship would be to circumvent the requirements of section 9 with respect to nationality of the

proclamations are unnecessary in view of the provisions of subsection (c). If the proposed bill for general revision of the Copyright Law is enacted, it would be unnecessary to make proclamations with respect to countries which adhere to the convention. See S. 3008, 88th Cong., 2d Sess. §3(b)(1) (1964).

38. A literal interpretation of the last paragraph of subsection (c) would deny copyright protection entirely to those works of nationals of Convention member countries first published in the United States with respect to which no proclamation exists. This interpretation would constitute a failure of the United States to meet its obligations under the Convention to provide "national treatment" to published works of nationals of any member country. U.C.C. art. II, §1. The Convention does, however, permit any member state to require that works of its nationals and domiciliaries and works first published in its territory comply with "formalities" in order to secure copyright protection. U.C.C. art. II, §3, art. III, §2. Since the purpose of adding subsection (c) to section 9 was to modify the United States copyright law to comply with the terms of the Convention, the obvious legislative intent was to enact law compatible with the Convention. See Cary, "The United States and Universal Copyright: An Analysis of Public Law" 743, in *UNIVERSAL COPYRIGHT CONVENTION ANALYZED* 83, 86, 87 (1955). Such intention should be given effect by interpreting the proviso as merely a denial to the enumerated works of the exemption from formalities contained in subsection (c), although such interpretation concededly involves some "bending" of the statutory language. The proposed bill for the general revision of the Copyright Law eliminates this problem. S. 3008, §43(b)(1).
39. *French's Estate v. Glander*, 146 Ohio St. 225, 65 N.E.2d 61 (1946).

author, the putative employer might actually have to exercise supervision over the work so as to control the final result,⁴⁰ although the cases clearly demonstrate that the employer need not actually contribute anything of value to the work.⁴¹ There is substantial flexibility respecting remuneration, employment for hire relationships having been sustained where the actual author was paid a conventional salary,⁴² a fixed fee⁴³ and an advance against royalties plus royalties.⁴⁴ Furthermore, there does not appear to be any limit upon the creativity and originality which the employee-author contributes to the work; the employment relationship, however, must exist at the time of the creation of the work.⁴⁵ There is no apparent reason why such employment relationship could not exist in a case where the employer and employee are located in different countries, although it is obvious that if the employee-author does at least part of the work in the country of the employer the bonafides of the relationship would be easier to establish.⁴⁶

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40. See *National Cloak & Suit v. Kaufman*, 189 F.2d 215, 216 (C.C. M.D. Pa. 1911).
41. See *Von Tilzer v. Jerry Vogel Music Co.*, 53 F.Supp. 191, 193, 194 (S.D.N.Y. 1943), *aff'd per curiam sub nom. Gumm v. Jerry Vogel Music Co.*, 158 F.2d 516 (2d Cir. 1946); *Gaumont Co. v. Hatch*, 208 Fed. 378, 381 (W.D.Pa. 1913). See also cases cited notes 42-45, *infra*.
42. *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57 (2d Cir.), *cert. denied*, 305 U.S. 650 (1938); *Von Tilzer v. Jerry Vogel Music Co.*, *supra* note 41; *Brown v. Molle Co.*, 20 F.Supp. 135 (S.D.N.Y. 1937).
43. See *Brown v. Select Theatres Corp.*, 56 F.Supp. 438, 439 (D.C. Mass. 1944) (foreign law). But see Varmer, *Works Made for Hire and on Commission*, in 1 STUDIES ON COPYRIGHT 717, 722 (1963).
44. *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d (2d Cir. 1941); *Fred Fisher Music Co. v. Leo Feist, Inc.*, 55 F.Supp 359 (S.D.N.Y. 1944).
45. See *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 698, 699 (2d Cir. 1941); *cf. Rohauer v. Friedman*, 306 F.2d 933, 936 (9th Cir. 1962).
46. The proposed bill for the general revision of the copyright law includes as author of a "work made for hire," in addition to the employer, any "other person for whom the work was prepared," S. 3008, §14(b), and defines "work made for hire" to include both works prepared by an employee within the scope of his employment and works "prepared on special order or commission if the parties expressly agree in writing that it shall be considered a work made for hire." S. 3008, §54. The new bill, if enacted, would apparently enlarge the scope of the artificial designation of persons other than the creator as "authors." Although the effect of this artificial attribution of authorship upon eligibility for copyright protection and exemption from formalities has been recognized, see Varmer, "Works Made for Hire and on Commission," in 1 STUDIES ON COPYRIGHT 717, 719 (1963), the problem appears to have been largely overlooked in the discussions about the general revision. The provisions governing authorship of works made for hire appear to have been influenced most

Section 26 of the copyright law provides in part:

In the interpretation and construction of this title . . . the word "author" shall include an employer in the case of works made for hire.⁴⁷

Does the word "author" as used in subsection (c) of section 9 refer in the case of a work made for hire to the employer, the employee, or both? If it refers only to the employer, the use of the employment relationship by foreign publishing or printing firms would permit the importation of unlimited quantities of all types of books and periodicals manufactured and first published abroad by virtue of the exemption from formalities provided in that subsection, although the actual work of individual authorship were performed by an American national. There has been no litigation of this issue since these provisions became effective in 1955. Surprisingly, neither has the reverse situation, e.g. employment for hire of a foreign national by an American firm to obtain copyright where the work of the employee-author would not have been eligible for copyright under section 9, been passed upon by any court although the law has not been substantially altered since 1909.

The only part of the copyright law which has received any considerable attention by the courts with respect to authorship of works made for hire is that dealing with renewal of copyright. In *Tobani v. Carl Fischer, Inc.*,⁴⁸ the meaning of the word "author" as used in section 24 of the Act of 1909,⁴⁹ which contained provisions for renewal of original term copyrights subsisting at the time, was at issue. The basic provisions of section 24 granted renewal rights to the author, if living, or otherwise to the widow, children, executor or next of kin of the author; expressly excepted were composite works upon which copyright was originally secured by the proprietor, which works were renewable by the proprietor at the time. The defendant claimed the right to use the works which were the subject of the infringement action as assignee of the employer for whom the works were made for hire and asked that the court order that the plaintiffs, the deceased employee-author's children, who had re-

directly by those groups who have the greatest direct financial involvement, the prospective "authors" who will employ or commission such works, who appear to have been most concerned with being assured that they will have *all* the incidents of ownership of such works. See e.g. Meeting on General Revision of the U.S. Copyright Law (*mimeo* June 11, 1963).

47. 17 U.S.C. §26 (1958).

48. 98 F.2d 57 (2d Cir.), *cert. denied*, 305 U.S. 650 (1938).

49. Copyright Act of 1909 §24, 35 Stat. 1075 (1909).

newed the original copyrights secured by the employer, assign the renewal copyrights to it. Despite the fact that the parallel section 23 of the Act,⁵⁰ which covered renewal of original term copyrights secured after the effective date of the Act, specifically provided for renewal by the proprietor of works made for hire whereas section 24 did not, the court held that section 62 of the Act⁵¹ defines the employer in the case of works made for hire as the author for all parts of the statute and, therefore, the grant in section 24 of the renewal right to the "author" or his successors gave such right only to the employer-author or proprietor at the time. Thus, the children of the deceased employee-author had no right to renew, their acts of renewal were wholly ineffective and the failure of defendant to renew its copyrights could not be cured by assignments to defendant of the void renewal registrations of plaintiffs.⁵²

In *Shapiro, Bernstein & Co. v. Bryan*,⁵³ the leading case interpreting section 23 of the Act of 1909, the court was presented with issues similar to those of the *Tobani* case. Section 23, the only currently effective provision with respect to renewal copyrights, provided specifically for renewal by the proprietor of works copyrighted by an employer for whom such works are made for hire and renewals were registered on behalf of both the employer and the employee-authors. Judge Learned Hand, speaking for the court, refused to apply the definition of "author" contained in section 62 to section 23, stating:

The defendants seem to suppose that the definition of "author" in §62 . . . which declares that it, "shall include an employer in the case of works made for hire" has some importance in construing §23. We cannot see that it has. Certainly it can have none in the first proviso because the word does not appear in it. If we suppose it defines "author" in the second proviso, it adds nothing to what has been already provided for in the fourth class of the first proviso, except the absurd possibility that if the work is "done for hire," the proprietor who then has the right of renewal must survive the copyright, or it will pass to his widow, children, next of kin or executors . . . ⁵⁴

50. Copyright Act of 1909 §23, 35 Stat. 1075 (now 17 U.S.C. §24 (1958)).

51. Copyright Act of 1909 §62, 35 Stat. 1075 (1909) (now 17 U.S.C. §26 (1958)).

52. *Accord*, *Von Tilzer v. Jerry Vogel Music Co.*, 53 F.Supp. 191 (S.D.N.Y. 1943), *aff'd per curiam sub nom. Gumm v. Jerry Vogel Music Co.*, 158 F.2d 516 (2d Cir. 1946).

53. 123 F.2d 697 (2d Cir. 1941).

54. *Id.* at 699, 700.

Possibly the clearest statement of the import of the renewal section is the statement by the District Court in the opinion below in the *Bryan* case:

The right of renewal in a work made for hire is not given to the author, nor to the employer as author, but to the proprietor . . . ⁵⁵

Although generalizations based upon the attempted application by the courts of the definition of "author" contained in current section 26 (section 62 of the Act of 1909) to what were essentially confused and poorly drafted sections of the copyright law may not be entitled to great weight, the *Tobani* and *Bryan* cases demonstrate that the definition is not always applied by the courts to all parts of the copyright law despite the contrary import of the section and that it adds nothing to the current law governing renewal rights of employers in the case of works made for hire.

Other than the renewal sections discussed above, only section 9,⁵⁶ which designates the persons entitled to obtain copyright in the United States, presents any substantial questions concerning the interpretation of the word "author" and if the section 26 definition was intended to have some substantive effect it is here that we must look for its application.

Unless there is some special class of works where the nationality of the "author", as the word is used in section 9, would not be the sole determining factor of eligibility to copyright, the words "or proprietor" in section 9 appear to be mere surplusage. In most cases, of course, the proprietor would be either an assignee or an employer in the case of a work made for hire. Since assigns are separately designated, the apparent reason for including the words "or proprietor" in section 9 was to provide for employers in the case of works made for hire.⁵⁷ However, by virtue of section 26 the employer is entitled to copyright as "author".⁵⁸ This

55. *Shapiro, Bernstein & Co. v. Bryan*, 36 F.Supp. 544, 545 (S.D.N.Y. 1940), *aff'd*, 123 F.2d 697 (2d Cir. 1941). The "proprietor" means the proprietor at the time of renewal, not at the time of obtaining the original copyright. *Shapiro, Bernstein & Co. v. Bryan*, 27 F.Supp. 11 (S.D.N.Y. 1939) (denial of motion to dismiss complaint).

56. 17 U.S.C. §9 (1958).

57. See *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 297 (1907); Ringer, *Renewal of Copyright*, in 1 *STUDIES ON COPYRIGHT* 503, 533-35 (1963).

58. See *National Cloak & Suit Co. v. Kaufman*, 189 Fed. 215, 217 (C.C. M.D. Pa. 1911); *Yale University Press v. Row, Peterson & Co.*, 40 F.2d 290, 291 (S.D.N.Y. 1930). Interestingly, although claiming copyright as an employer in the case of a work made for hire, plaintiff in the *Kaufman* case pleaded

would appear to negate any import which the words "or proprietor" in section 9 might otherwise have had.⁵⁹

Interpreting a prior statute which was not dissimilar to the present section 9, the Supreme Court held that if the author is ineligible to obtain copyright in his work his assignee cannot do so as proprietor since the author had nothing to assign.⁶⁰ With respect to the converse situation, it has been held under the prior law that an eligible author may assign to an ineligible proprietor who could subsequently apply for and secure the copyright.⁶¹ Since the current law was not intended to make any change in pre-existing law with respect to the eligibility of aliens to obtain copyright,⁶² it follows that these prior holdings have some continuing validity. Thus, despite the use of the term "author or proprietor" in section 9, only the nationality and domicile of the "author" is relevant in determining eligibility for copyright.⁶³

It could have been argued that, pursuant to the literal terms of the statute, the nationality and domicile of the employer-author determines

that it "wrote, designed and compiled and caused to be written, designed and compiled by those employed by it for the purpose, *all of them citizens and residents of the United States*, or aliens domiciled within the United States at the time of first publication," the book of which it was the proprietor. (Emphasis added.) 189 Fed. at 217.

59. Congress may have contemplated situations where the proprietor is neither an assign or an employer in case of a work for hire. Possible examples of such situations are composite works copyrighted by a proprietor who has obtained merely licenses for the use of the authors' contributions and a corporation in a case where the work was composed by persons who are related to the corporation neither as employees for hire, nor as assignors or licensors. See *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941); REPORT OF REGISTER 87. The Register of Copyrights has recommended that the words, "or proprietor," be deleted from §9.
60. *Bong v. Alfred S. Campbell Art. Co.*, 214 U.S. 236 (1909).
61. *Carte v. Evans*, 27 Fed. 861 (C.C. D. Mass. 1886); cf. *Black v. Henry G. Allen Co.*, 42 Fed. 618 (C.C. S.D.N.Y. 1890).
62. H. R. Rep. No. 2222, 60th Cong., 2d Sess. 10 (1909).
63. "It is well settled that a 'proprietor,' not the author, stands in no better status in acquiring a copyright than does the author, and hence the Eher firm could not claim the benefits of the statute if Hitler was not in a position to do so." *Houghton Mifflin & Co. v. Stackpole Sons, Inc.*, 104 F.2d 306, 308 (2d Cir.), cert. denied, 308 U.S. 597 (1939). See *Egner v. E. C. Schirmer Music Co.*, 139 F.2d 398 (1st Cir. 1943), cert. denied, 322 U.S. 730 (1944); *Cohan v. Richmond*, 19 F.Supp. 771 (S.D.N.Y. 1937); *Quinn-Brown Pub. Corp. v. Chilton Co.*, 15 F.Supp. 213 (S.D.N.Y. 1936); *Public Ledger v. N. Y. Times*, 275 Fed. 562 (S.D.N.Y. 1921), aff'd per curiam, 279 Fed. 747 (2d Cir. 1922).

eligibility of a work for copyright protection, either because he could secure copyright as original proprietor or as author by virtue of the section 26 definition. The former argument appears to be discredited by the case law and is inconsistent with section 26. The latter is not supported by anything in the legislative history and the case law is not inconsistent with a view that the section 26 definition creates only a presumption of ownership of copyright in the employer-author.⁶⁴

The Register of Copyrights had recommended that the definition of "author" as including an employer in the case of works made for hire be eliminated in favor of a provision that the right to secure copyright in such case vests in the employer.⁶⁵ Several opponents of such a change in the law view the present law as designating the employer as *the author*; they argue that the Constitution of the United States requires that there be *an* author, and, if the employer for hire is not the author, then the employee, or the host of employees who contribute to a joint or composite work, must be the author.⁶⁶ While it is true that other respected commentators appear to agree that section 26 is effective to make the employer in case of works for hire *the* author,⁶⁷ and the Copyright Office is apparently in accord with this view,⁶⁸ the question has never been passed upon directly. The statutory language indicates quite the contrary; the word "author" is defined merely to *include* the employer in case of a work made for hire.⁶⁹

64. See notes 79 and 80 *infra* and accompanying text.

65. REPORT OF REGISTER 88. But see S. 3008, 88th Cong., 2nd Sess. §14(b) (1964).

66. See Bricker, "Ownership of Copyrights," 9 BULL. CR. SOC. 451, 453 (1962); Sargoy, "Formalities and Ownership," 9 BULL. CR. SOC. 20, 39, 40 (1961).

67. See Howell, COPYRIGHT LAW 52 (1962); NIMMER ON COPYRIGHT 239 (1963); Varmer, "Works Made for Hire and on Commission," in 1 STUDIES ON COPYRIGHT 717, 731 (1963).

68. The official application forms of the Copyright Office state that where "a work was made for hire, the employer is the author." Information concerning citizenship and domicile is required only with respect to such employer.

69. Another argument raised against the proposal to eliminate the designation of the employer of a work for hire as an author is that, if the present renewal system is retained, the employer will lose his right to secure the renewal copyright. Sargoy, *supra* note 66, at 39, 40. Since the current law provides specifically that the proprietor is entitled to secure renewal in any case where the original copyright was secured by the employer for whom such work was made for hire, it hardly appears that such employer's rights need be jeopardized. See 17 U.S.C. §24 (1958). Whatever rights are

In *United States Ozone Co. v. United States Ozone Co. of America*,⁷⁰ it was held that the copyright in a work made for hire which had been secured by and registered in the name of the employee-author was valid and held by the employee in trust for the employer. Since the right to secure statutory copyright derives solely from the copyright law and only persons designated therein may secure and register copyright in the original or renewal term,⁷¹ the only basis for the holding in the *Ozone* case is that the employee-author, although not entitled to beneficial ownership, was within the class of persons designated in section 9 to be entitled to secure copyright in the work.⁷² Since he was obviously not a "proprietor" or "assign", nor was he within any other of the designated classes, he must have been entitled to copyright the work as *an author*.⁷³

intended to be granted to the employer with respect to the original term of copyright could be similarly specified.

Unfortunately, the Copyright Office has apparently changed its position. Its proposed bill for the general revision of the Copyright Law provides:

"In the case of a work made for hire, the employer or other person for whom the work was prepared is considered *the* author for purposes of this title, and owns all of the rights comprised in the copyright unless the parties have expressly agreed otherwise." (Emphasis added.) S. 3008, §14(b).

70. 62 F.2d 881 (7th Cir. 1932).
71. See *Société des Films Menchen v. Vitagraph Co.*, 251 Fed. 258 (2d Cir. 1918); *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247 (1st Cir. 1911); 28 OPS. ATT'Y GEN. 162, 165 (1910). If renewal is secured by persons other than those specified in the statute, the renewal is void. *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57 (2d Cir.), *cert. denied*, 305 U.S. 650 (1938). Compare *April Productions, Inc. v. G. Schirmer, Inc.*, 308 N.Y. 366, 377, 126 N.E.2d 283, 296 (1955).
72. *Accord*, *No-Leak-O Piston Ring Co. v. Norris*, 277 Fed. 951 (4th Cir. 1921). See *Sawyer v. Crowell Pub. Co.*, 142 F.2d 497, 499 (2d Cir.), *cert. denied*, 323 U.S. 735 (1944); *W. H. Anderson Co. v. Baldwin Law Pub. Co.*, 27 F.2d 82, 88 (6th Cir. 1928) (dictum).
73. This conclusion is also supported by the language in the first proviso of the renewal section which provides that the proprietor may secure copyright in a work made for hire "*if copyrighted . . . by an employer for whom such work is made for hire.*" (Emphasis added.) 17 U.S.C. §24 (1958). The limitation implies that the employee-author may secure copyright in such case, in which event the second proviso would govern the renewal term (apparently because the implied assignment by the employee of his basic right to copyright protection is overcome by his actions). It could be argued that the limitation was inserted to provide for a situation where the employer in such case assigns the work before copyright is secured and the proprietor, as assignee, secures copyright. However, it is not logical to assume that Congress desired to provide for renewal by the employee's widow and children merely because of such assignment.

Thus, the argument that the definition including the employer in the case of works made for hire as "an author" should not be changed because it will result in the employee being designated "an author" in his stead has no merit, since that situation already exists under the present statute. Furthermore, this does not adversely affect the employer and, in fact, may be of value since it will preserve for him the beneficial ownership of a copyright even if the employee-author's name appears in the copyright application and notice in a case where the employer is entitled to such ownership by virtue of an employment relationship. The new language most recently proposed by the Register goes so far as to designate the employer as *the* author and will, presumably, change the rule of the cases which permit the employee-author to be designated as author in the copyright application.⁷⁴

Furthermore, it is questionable whether a statutory provision which is interpreted to vest copyright in a work made for hire in the employer, as such, is compatible with the provision in the Constitution to the effect that, to promote the progress of science and the useful arts, the exclusive right to their writing may be secured for limited times to authors.⁷⁵ Authorship involves intellectual effort and the person or persons most closely associated with the creation of the original matter entitled to copyright protection, the employee—not the employer—in the case of works made for hire, would generally be viewed as the author.⁷⁶ Only the author, or a person whose rights are derived from the author, may obtain copyright.⁷⁷ Congress is, therefore, powerless to create or designate a fictitious "author" in whom may be vested the copyright in derogation of

74. See note 69, *supra*.

75. U.S. Const. art. I, §8. See NIMMER ON COPYRIGHT 12, 13.

76. ". . . in the nature of the case the 'author' of such a publication is the one who gets the facts and puts them together in the form desired; and this Dolvin did . . . We think it clear that he was the author of the pamphlet, and correctly so named in the application for copyright." No-Leak-O Piston Ring Co. v. Norris, 277 Fed. 951, 954 (4th Cir. 1921). See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 61 (1884).

77. "It is only to 'authors and inventors,' or to persons representing the author or inventor, that Congress is authorized by the Constitution to grant copyright. Const. art. I, §8. The right of any other person than the author or inventor must therefore be a purely secondary and derivative one, and in enforcing any alleged copyright such a person must show an exclusive right lawfully derived from the author or inventor . . ." Yuengling v. Schile, 12 Fed. 97, 100, 101 (C.C. S.D.N.Y. 1882). See Silverman v. Sunrise Pictures Corp., 273 Fed. 909 (2d Cir. 1921); Cohan v. Richmond, 19 F.Supp. 771 (S.D.N.Y. 1937); Quinn-Brown Pub. Corp. v. Chilton Co., 15 F.Supp. 213 (S.D.N.Y. 1936).

the constitutional language⁷⁸ and the only supportable interpretation of section 26 of the copyright law is that it merely creates a presumption of ownership of copyright in the employer for whom a work is made for hire, the rights of the employer arising out of an implied assignment from the true employee-author.⁷⁹ Thus, the section merely serves to codify the prior law.⁸⁰

Whatever may be the construction of section 26 for purposes of meeting the test of constitutionality, Congress obviously may establish a statutory scheme based upon even a fictitious definition of the word "author" which would require the substitution in certain cases of the prescribed definition for the word "author" as it appears in the statute. There are at least five different ways that the section 26 definition can be applied. In the case of works made for hire, the word "author" as used in the copyright law may:

1. Always mean only the employee.
2. Refer to either the employer or the employee, at the option of the copyright proprietor.
3. Always refer to both the employer and the employee.
4. Refer to the employer, the employee, or both, depending upon its use in context and the facts.
5. Always mean only the employer.

The mere inclusion of section 26 in the copyright law rules out the possibility that the word "author" as used in the copyright law always means only the employee-author in the case of works made for hire. Since the cases indicate that the section 26 definition will not be applied uniformly throughout the copyright law and that the employee-author is an author for the purpose of securing valid copyright protection, the fifth possibility may also be eliminated.

With respect to the second alternative, it would be illogical, impractical and inconsistent with the apparent purpose of section 26 to conclude that the copyright proprietor may determine whether the employer-author or employee-author shall be considered the author in each

78. *But see* Vitaphone Corp. v. Hutchinson Amusement Co., 28 F.Supp. 526, 530 (D.C. Mass. 1939) (dictum).

79. See *W. H. Anderson Co. v. Baldwin Law Pub. Co.*, 27 F.2d 82, 88 (6th Cir. 1928) (dictum).

80. See *National Cloak & Suit Co. v. Kaufman*, 189 Fed. 215 (C.C. M.D. Pa. 1911); *Zuhler v. Columbia Pictures Corp.*, 180 Cal. App. 2d 582, 4 Cal. Repr. 612 (Dist. Ct. App. 1960).

case. No problem would arise if the only question is whether the proper person completed the required formalities. However, where substantive rights are at issue, the identity of the proprietor may not be ascertainable without first determining authorship. Also, the proprietor should not be permitted to use a bootstrap technique of designating the author so as to come within the terms of the copyright law and validate what could otherwise be a non-existent copyright.

Viewing the word "author" as always referring to both the employer-author and the employee-author would be consistent with the statutory language. It might, however, make unwarranted changes in the law concerning persons entitled to secure copyright and would not be of assistance in determining nationality for purposes of applying the manufacturing clause and import restrictions. Therefore, the third interpretation is undesirable, at least with respect to some parts of the copyright law.

Thus, it appears that only the fourth alternative, a flexible approach to the definition which would depend upon the facts of each particular situation and the context in which the word "author" is used in the statute, affords a logical and useful basis for reconciling the case law and giving some effect to section 26. For purposes of registration of the initial copyright, the designation "author" would be interpreted to refer to both the employer and the employee; with respect to other rights, such as renewal, the word "author" would be interpreted as referring to either the employer or employee, depending upon the view taken of the purpose and intention of the provision involved.

How should the section 26 definition of "author" be applied to the provisions of subsection (c) of section 9 which excepts works of American authors from the exemption from the manufacturing clause granted to other Universal Copyright Convention works? Since subsection (c) was enacted some 45 years after section 26 became effective, the only fruitful inquiry into legislative intent would involve the question of what the legislature intended by its use of the word "author" in subsection (c). As shown above, the courts had not prior to the enactment of subsection (c) consistently applied section 26 in such manner as to substitute the "employer of a work made for hire" for the word "author" where it appears in the copyright laws. It cannot, therefore, be assumed that the legislators expected that it would be so applied to subsection (c). Furthermore, although wherever the word "author" appears in other parts of section 9 it is followed by the words "or proprietor," in subsection (c) only the word "author" is used. Unless the disparity is simply the result of legislative oversight, the apparent purpose of the deletion of the words "or proprietor" was to assure that the criteria of subsection (c) would be applied only to the actual author. Thus, even if the section 26

definition of author applies to other portions of section 9, it may not be effective to designate the employer as the author for purposes of subsection (c).

What are the courts likely to do if confronted with a situation where a United States citizen creates a work under an agreement which purports to establish an employment for hire relationship with a foreign corporation as employer-author, apparently permitting the foreign corporation to import copyrighted foreign manufactured books first published abroad by virtue of the exemption from formalities contained in subsection (c)?

In the converse situation, if the employer in the case of a work made for hire may copyright the work as author pursuant to section 9, an eligible American employer would be entitled to copyright the work even if the actual foreign employee-author is ineligible. Several authorities have speculated that such a holding is unlikely because of the ease with which it would be possible to circumvent the limitations imposed by section 9 upon the right of foreign nationals to secure copyright.⁸¹ There is even less reason to suppose that foreign employers will be permitted to utilize this type of gimmick to reap profits from foreign manufactured copies actually created by employee-authors who are American nationals and not eligible to take advantage of the provisions of section 9(c) exempting certain works from the requirements of the manufacturing clause. Despite its unpopularity, the manufacturing clause still exists and its basic purpose is to protect the domestic printing industry by refusing copyright protection to foreign manufactured works, with only limited exceptions.⁸² Furthermore, it is apparent that there is no great substantive difference between situations where an author produces a work under a contractual arrangement which, although it may contain various provisions concerning the form of the work, permits him to retain "independent contractor" status and where he produces the work pursuant to a so-called contract for hire.⁸³ It would be illogical to permit the existence of the latter relationship to change completely the previously established case law which measures the copyrightability of a work in the hands of an assignee by referring to the status of the actual author.⁸⁴

81. "The possibilities of an evasion of the Act, under color of such employment contracts, may lead to a different conclusion." Weil, *AMERICAN COPYRIGHT LAW* 262 (1917). See *NIMMER ON COPYRIGHT* 262.

82. See *Oxford University Press, Inc. v. United States*, 33 C.C.P.A. 11 (Customs 1945); H. R. Rep. No. 2222, 60th Cong., 2d Sess. 11, 12 (1909).

83. See *Yardley v. Houghton Mifflin Co.*, 25 F.Supp. 361 (S.D.N.Y. 1938), *aff'd* 108 F.2d 28 (2d Cir. 1939), *cert. denied*, 309 U.S. 686 (1940).

84. See notes 60, 61, 62, and 63 *supra* and accompanying text.

However, although the permissive language of section 26 is not determinative of the person with respect to whom the criteria of section 9 are to be applied and despite the cases which recognize the status of the actual employee-author as author, the official Copyright Office applications recognize only the employer as author and determine eligibility of a work for copyright protection by reference to the nationality of the employer-author, and the Bureau of Customs has apparently accepted the validity of this position.⁸⁵ The question has not yet been presented to the courts, but increased activity in this area will almost certainly lead to a need to consider the problems involved. The propensity of the courts, particularly in this muddled area of copyright law, to avoid coming to grips with basic issues presages the achievement of the appropriate results, if any cases of this sort arise, by a series of decisions which refuse to hold that a bona fide employment relationship exists rather than by a direct holding that it is the employee-author's nationality which is determinative of copyrightability under section 9, the only logical reconciliation of the problem.

TRANSLATIONS AND NEW VERSIONS

In the case of translations, abridgements, adaptations, subsequent editions and other versions of copyrighted works produced with the consent of the copyright proprietor where the added material or changes are sufficiently the result of substantial labor and the exercise of judgment to constitute new works entitled to be separately copyrighted, it may be possible to import foreign manufactured copies which are at least partially protected by copyright without resort to the dubious technique of employment for hire.

Pursuant to section 7, a new work may be created by rearranging the basic form of the prior or underlying work or works, as in the case of translations, adaptations, dramatizations and similar revisions of works, or by utilizing the underlying works in their original form and combining them in an original manner or adding to them additional matter.⁸⁶

85. See note 68 *supra*; Demcy, *Importation Problems*, Publishers' Weekly, July 18, 1960, pp. 38, 43.

86. "Compilations or abridgements, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of

Whatever the form of the new work, in order to be eligible to be separately copyrighted pursuant to section 7 the new work must involve a minimal element of originality which results in a distinguishable variation of the underlying matter.⁸⁷ The copyright in the new work protects only the new matter,⁸⁸ which may include or consist solely of the compilation, arrangement or manner of presentation of underlying matter all of which is in the public domain.⁸⁹

The publication of a copyrighted new work will not extend the term of any underlying copyright⁹⁰ nor will it necessarily establish protection for matter previously in the public domain.⁹¹ Despite the language in section 7 negating the effect on subsisting copyright of the publication of a new work, it has been held that the publication of a new work without notice of copyright terminates copyright protection upon all portions of the underlying work contained in the new work.⁹² However, the courts in so holding have been concerned only with substantially identical reproduction of underlying material; these cases do not warrant the con-

the original works, or to secure or extend copyright in such original works." 17 U.S.C. §7 (1958).

87. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903); *Gelles-Widmer Co. v. Milton Bradley Co.*, 313 F.2d 143, 146, 147 (7th Cir.), *cert. denied*, 373 U.S. 913 (1963); *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, 280 F.2d 800, 802 (2d Cir. 1960); *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); *Gerlach-Barklow Co. v. Morris & Bendien*, 23 F.2d 159, 161 (2d Cir. 1927); *Loomskill, Inc. v. Slifka*, 223 F.Supp. 845, 847, 848 (S.D.N.Y. 1963) *aff'd per curiam*, 330 F.2d 952 (1964); *Consolidated Music Publishers, Inc. v. Ashley Publishers, Inc.*, 197 F.Supp. 17, 18 (S.D.N.Y. 1961); *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F.Supp. 285, 287 (E.D. Pa. 1960); *Marken & Bielfeld, Inc. v. Baughman Co.*, 162 F.Supp. 561, 562, 563 (E.D. Va. 1957).
88. *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469, 471 (2d Cir. 1951); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 813 (7th Cir. 1942); *McCaleb v. Fox Film Corp.*, 299 Fed. 48 (5th Cir. 1924); *Hayden v. Chalfant Press, Inc.*, 177 F.Supp. 303, 306 (S.D. Calif. 1959), *aff'd*, 281 F.2d 543 (9th Cir. 1960); *Lake v. C.B.S., Inc.*, 140 F.Supp. 707 (D.C. Calif. 1956); *Stodart v. Mutual Film Corp.*, 249 Fed. 507, 510 (S.D.N.Y. 1917), *aff'd* 249 Fed. 513 (2d Cir.).
89. *Alfred Bell & Co. v. Catalda Fine Arts Inc.*, 191 F.2d 99, 102 (2d Cir. 1951); *Leon v. Pacific Telephone and Telegraph Co.*, 91 F.2d 484, 486 (9th Cir. 1937); *C.S. Hammond & Co. v. International College Globe, Inc.*, 210 F.Supp. 206, 216 (S.D.N.Y. 1962). *But cf.* *Consumers Union of United States, Inc. v. Hobart Mfg. Co.*, 199 F.Supp. 860 (S.D.N.Y. 1961).
90. *Glaser v. St. Elmo Co.*, 175 Fed. 276 (C.C. S.D.N.Y. 1909); *Freedman v. Milnag Leasing Corp.*, 20 F.Supp. 802 (S.D.N.Y. 1937).
91. See *American Code Co. v. Bensinger*, 282 Fed. 829 (2d Cir. 1922).
92. *Sieff v. Continental Auto Supply, Inc.*, 39 F.Supp. 683 (D.Minn. 1941); *cf.* *Beifeld v. Dodge Pub. Co.*, 198 Fed. 658 (S.D.N.Y. 1911).

clusion that publication of a new work always constitutes sufficient publication of all the underlying work contained therein, regardless of the form in which it appears, to place such matter in the public domain if the new work contains no copyright notice.⁹³

If the new work is published with a copyright notice pertaining only to the underlying material, the copyright notice should be effective to continue in force the copyright in all of the underlying material repeated in substantially identical form. The new and revised matter has, however, been dedicated. It is also possible to publish the new work with a copyright notice pertaining solely to it and to abandon copyright in the underlying material. The effect would be to afford copyright protection only to new and revised matter appearing in the new work. The implications of these apparently simple propositions are discussed below.

Importation of New Works Manufactured Abroad.

A copy of a translation or new version of a previously copyrighted book actually consists of two or more separate works, each entitled to separate copyright protection. If one of the component or underlying works is entitled to United States copyright protection by virtue of publication abroad pursuant to the terms of the Universal Copyright Convention and is exempted from the domestic manufacturing requirement by section 9 (c), the dedication or abandonment of copyright in the other component work may enable foreign manufactured copies of the new work to be imported.

There are few guides available for the determination of borderline issues concerning the importability of such partially protected books. Moreover, importing and selling the work and registering the copyright, although it may be the short-term answer to the client's problem, is only part of the story as far as the copyright law is concerned. The same result could have been achieved by foregoing copyright protection entirely and it remains to be seen whether anything more has really been accomplished.⁹⁴

93. See *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955); *S.C. Johnson & Son, Inc. v. Drop Dead Co.*, 201 F.Supp. 442 (S.D. Calif., 1961); *Siewek Tool Co. v. Morton*, 128 F.Supp. 71 (E.D. Mich. 1954) (semble).

94. The importing publisher who wishes to effect a partial or total abandonment of pre-existing copyright protection should experience little difficulty if he is the proprietor of the copyrights which he desires to abandon. However, a licensee cannot without the authority of the copyright proprietor, either by omitting the copyright notice or affirmatively indicating that the material is dedicated to the public, effectively abandon such copyright protection. See *National Comics Publications, Inc. v. Fawcett Pub-*

There is a great demand in this country for art books and other books containing elaborate illustrations, usually in color, which have previously been published and sold abroad. Foreign manufacture of these works can often effect substantial savings. Where there is involved a considerable amount of costly preparation of plates for illustrations, publishers often arrange for simultaneous publication and sale of the work in various countries of the world. Where the book is originally published in a foreign language, it is necessary to make an English translation for sale in the United States; even in cases where the original book is in the English language, it is often necessary to make substantial revisions in the American edition. The following discussion of two illustrative fact patterns deals with typical problems which arise in situations where it may be practical to import copies of books which are only partially protected by copyright.

1. If a book of foreign origin is entitled to United States copyright protection and is exempted from the domestic manufacturing requirements by virtue of section 9 (c), a translation or new version authored by a United States national or domiciliary may be dedicated by publication without notice of copyright pertaining to it in order to permit importation of foreign manufactured copies.

If the publisher is able to have the American version performed competently by a foreign national not domiciled in the United States, it may be feasible to first publish the American edition abroad so as to bring the entire work within the Universal Copyright Convention exemption and import copies fully protected by United States copyright.⁹⁵ Most often, however, the author of the new version is an American and the new work would ordinarily not be exempted from the domestic manufacturing requirement. However, if the book can be imported with only the repeated matter protected by copyright there may be sufficient protection against harmful infringement.

If the year of the original copyright antedates the first publication of the American edition, publication solely with a repeated notice of the copyright in the original foreign version may be effective to dedicate

lications, Inc., 191 F.2d 594 (2d Cir. 1951); American Press Ass'n. v. Daily Story Pub. Co., 120 Fed. 766 (7th Cir. 1902), *appeal dismissed on appellant's motion*, 193 U.S. 675 (1904); cf. Harper & Bros. v. M. A. Donohue & Co., 144 Fed. 491 (C.C.N.D. Ill. 1905), *aff'd per curiam*, 146 Fed. 1023 (7th Cir. 1906).

95. This may more easily be accomplished by having the work performed as a work made for hire by an American employee-author for a foreign employer. The problems involved in such a situation have been discussed above.

all new matter added to the original foreign version.⁹⁶ If it is not, a statement of abandonment of the underlying copyright must appear in juxtaposition with the copyright notice and a formal abandonment by the proprietor should be filed with the Copyright Office.⁹⁷

The Bureau of Customs has accepted for importation literal English translations of foreign language books under such circumstances; the only information about nationality and domicile required to be furnished is that relating to the author of the original version for which copyright has been claimed. The Copyright Office appears to agree that this is the appropriate action in such cases. The action of the Bureau, however, may be based upon its viewpoint that for duty rate purposes a literal translator or an editor who merely adapts or abridges a work is not considered the author,⁹⁸ even though it seems clear that he is the author for purposes of securing and enforcing copyright in the new

96. The use of a prior year will not itself result in the loss of copyright protection but may only be effective to reduce the initial term of copyright. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (2d Cir. 1946) *cert. denied*, 331 U.S. 820 (1947). However, if the copyright notice does not bear the name of the proprietor of the new work, as would normally be the case where only a notice pertaining to underlying matter is used, the notice is ineffective to protect the new matter. 17 U.S.C. §19 (1958). See *Klasmer v. Baltimore Football Inc.*, 200 F.Supp. 255 (D.C.Md. 1961) (*semble*); *Moger v. WHDH, Inc.*, 194 F.Supp. 605 (D.C. Mass. 1961).

97. See 19 Treas. Dec. 3 (1910); Report of the Register of Copyrights for the Fiscal Year 1912-1913, p. 62 (1913).

98. "If the translator changed, modified or added to the book in a material way, he would be deemed to be the author. The rate of duty would be based on his citizenship . . .

"If the translation was merely a literal one, the citizenship of the author would apply . . ." Letter from Marshall Stramiello, Jr., U.S. Appraiser of Merchandise, to the writer, April 2, 1964.

The validity of the viewpoint of the Bureau of Customs with respect to literal translators is open to question. In *Oxford University Press, Inc. v. United States*, 33 C.C.P.A. 11 (Customs 1945), it was held that the tariff provisions and the copyright law concerning authorship were in *pari materia* and should be construed together; the compiler of an anthology or compilation produced by application of "intellectual labor" and "literary skill" was said to be the author. *Id.* at 20, 21. Although the question of whether a mechanical compilation involving *no* intellectual effort would be similarly treated was not answered, it is apparent that even the simplest translation involves sufficient originality to entitle the translator to copyright the work as author. See *Brecht v. Bentley*, 185 F.Supp. 890, 894 (S.D.N.Y. 1960). Furthermore, 17 U.S.C. §7 (1958) expressly designates translations as one type of new work separately copyrightable.

work, if, indeed, it qualifies as such and is separately copyrightable.⁹⁹ Thus, according to the standards of the Bureau, there is *no* author who falls within the class of persons to whom the privileges of Convention copyright and exemption from import restrictions is denied. If, however, the author of the American edition does more than a literal translation he would be considered the author for customs duty purposes and his nationality would have to be determined, a circumstance which might affect the position of the Bureau although, logically, it should make no difference with respect to the copyright situation.

The validity of the Bureau's position even with respect to literal translations must, therefore, turn upon whether it is proper to interpret the word "works" as used in the last clause of section 9 (c) to refer only to the specific work for which copyright protection is actually claimed upon importation. If so, the matter in the imported edition which is protected by the original copyright is entitled to come in because it is exempted from the domestic manufacturing requirement by virtue of section 9 (c) and the new matter is in no way restricted from free importation, despite American authorship, because not accorded copyright protection in the United States. On the other hand, if the word "works" as used in the last clause of section 9 (c) refers to the work which is being imported, there is no exemption from the import restriction because the author of the American edition is within the proscribed class and is not exempted from the manufacturing clause. Thus, copies of the work are not importable because they consist of text accorded protection (though only in part) under the copyright law.¹⁰⁰

If the proviso in section 9 (c) is meant to deny United States copyright protection to those Universal Copyright Convention works enumerated, the word "works" appearing therein would appear to refer to the work for which copyright is claimed upon importation since the question at issue is whether copyright should be extended to such work by virtue of subsisting Universal Copyright Convention copyright. To hold otherwise would deprive the original version of copyright protection in this country in violation of the terms of the Convention.¹⁰¹ If, however, the import of the proviso is to deny only the exemption from formalities (including domestic manufacture), then it appears to

99. *Shook v. Rankin*, 21 Fed. Cas. 1335 (No. 12,804) (C.C.N.D. Ill. 1875); *Brecht v. Bentley*, supra note 98; *Gilberton Co. v. United States*, 24 Cust. Ct. 233 (1950).

100. A book must be treated as an entirety, and if a part of a book is obnoxious to a provision of the copyright law the whole is and may not be imported. 22 Ops. Att'y Gen. 29 (1898). See notes 27, 28 and 29 *supra* and accompanying text.

101. U.C.C. art. II §1.

refer instead to the work which is being imported because attention should be directed to the actual work which is attempting to rely on this exemption to get into the country. Although there is no authority to support either view of the meaning of the last proviso in section 9 (c), the proviso must be read to deny only the exemption from formalities to provide consistency with the terms of the Convention.¹⁰² There is, therefore, grave doubt whether it is proper to permit the entry of copies of unprotected new works authored by an American citizen or domiciliary where any copyright protection subsists in even a part of the work.¹⁰³

2. If an original version of a book is not within the purview of section 9 (c), the copyright in the original version may be abandoned and a translation or new version prepared and published abroad so as to be eligible for United States copyright protection and exemption from the domestic manufacturing requirement by virtue of section 9 (c).

By claiming copyright only in the new work, it would appear that copies manufactured abroad could be imported under a rationale similar to the one applied in the reverse situation where copyright is claimed only in the underlying work. The argument in favor of importability in such a case (where only the unprotected underlying work has been authored by a person not entitled to the exemption from the domestic manufacturing requirement pursuant to section 9 (c)) is, however, a stronger one. Whether the word "works" contained in that section is interpreted to refer to the work for which copyright is claimed upon importation or to the work which is being imported, the exemption should apply. The creator of the additional matter for which copyright is claimed and the author of the new work being imported are one and the same and such author qualifies for the exemption. Only if it is held that the last proviso of section 9 (c) deprives a work of the exemption even where only one of the underlying works, itself not protected by copyright, is authored by an American national or domicil-

102. See note 38 *supra*.

103. It may be tempting to argue that, even if the word "work" refers to the work copies of which are being imported, the effect of the *total* dedication of the American version is sufficient to permit its importation without regard to its place of manufacture. The trouble with this argument is that its logical extension forces the conclusion that the American version is not in any way protected by copyright. Therefore, nothing more is accomplished than could have been accomplished by importing without any claim of copyright protection (except for any possible deterrent value the invalid copyright notice may have) and it might be required that the notice be stricken before the copies are permitted to enter the country.

ary could such work be denied entry because not domestically manufactured.¹⁰⁴

Protection Accorded to Imported Copies.

Assuming that copies of books falling within the two fact patterns under consideration have been manufactured abroad and imported and sold in this country, either because they have been overlooked by the Bureau of Customs or because the Bureau has taken the position that they are importable under the Universal Copyright Convention exemption contained in section 9 (c), the question of the effectiveness of the remaining copyright protection now becomes paramount. The mere fact that copies have been imported unlawfully will not bar an infringement action,¹⁰⁵ but the consequences of the dedication or abandonment of part of the copyright protection in the copies imported must be considered.

The Copyright Notice. Although in a case where there is any doubt about whether there is sufficient original matter in the book to constitute a new work capable of being separately copyrighted the prudent publisher may choose to repeat the copyright notice pertaining to underlying protected matter,¹⁰⁶ a single copyright notice containing the year of first publication of the new work is effective to secure copyright protection for the new work and to continue the protection of the matter in

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104. Publication with a new copyright notice only would not result in an abandonment of the underlying copyright. *Wrench v. Universal Pictures Co.*, 104 F.Supp. 374 (S.D.N.Y. 1952). If copyright in the underlying material subsists at the time of the publication of the new work, a statement of abandonment of the underlying copyright would have to be printed in conjunction with the new copyright notice and a formal declaration to that effect should be filed with the Copyright Office. See note 97 *supra*. However, prior authorized publication of the underlying work without any copyright notice would serve to effect an abandonment and, thereafter, importation and publication of the new work with an unqualified copyright notice would have no effect upon the unprotected underlying material. It would be advisable in the latter case to file with the Copyright Office at the time of importation a formal declaration of abandonment with proof of the prior dedicatory publication.
105. *Bentley v. Tibbals*, 223 Fed. 247 (2d Cir. 1915); *Cf. Meccano Ltd. v. Wagner*, 234 Fed. 912 (S.D. Ohio 1916) *modified on other grounds*, 246 Fed. 603 (6th Cir. 1918). *But cf. Harper & Bros. v. M. A. Donohue & Co.*, 144 Fed. 491 (C.C.N.D. Ill. 1905), *aff'd per curiam*, 146 Fed. 1023 (7th Cir. 1906).
106. See *Caliga v. Inter Ocean Newspaper Co.*, 215 U.S. 182 (1909) (prior law); *Herbert v. Shanley Co.*, 229 Fed. 340, 343 (2d Cir. 1916), *rev'd on other grounds*, 242 U.S. 591 (1917); *Markham v. A.E. Borden Co.*, 108 F.Supp. 695 (D. Mass. 1952), *rev'd on other grounds*, 206 F.2d 199 (1st Cir. 1953).

the new work which is covered by copyright in the underlying work.¹⁰⁷ Where only a single unqualified copyright notice is used, the reader may well assume incorrectly that the contents are fully protected by copyright. This situation is not peculiar to cases involving imported books, but is prevalent in all cases of the publication of copyrighted new works—whether they be translations, adaptations, abridgements or composite works with new matter added—which contain unchanged matter previously in the public domain. Similarly, in the reverse situation where the new work is not copyrighted, one or more copyright notices which protect material repeated from earlier copyrighted versions may appear.

In all of these cases it is often difficult, if not impossible, to separate the matter for which copyright protection is claimed from the newly dedicated or repeated public domain matter. Indeed, only rarely can it be ascertained even by a knowledgeable reader whether the notice is in any way limited. While it is apparent, when there is published with a new copyright notice a collection of Shakespearian works copied from the original folios containing also new introductory material or essays, that only such additional material is intended to be, and is, protected by virtue of such notice, in most other instances the reader or competitor is wholly unaware of the extent of the claim which is being asserted. It is no answer to require that such person check with the records of the Copyright Office, since even if this were practicable there is no absolute requirement that copyright be registered and, absent a demand, the consequences to the copyright proprietor of failure to register until a suit is contemplated are insufficient fully to protect an innocent infringer in these circumstances.¹⁰⁸ In the case of works claiming copyright by virtue of the Universal Copyright Convention, there is no requirement that such copyright ever be registered except as a prerequisite to an infringement suit.¹⁰⁹

The inherently deceptive nature of unqualified copyright notices used in cases where only part of the work is protected raises serious questions which have not received adequate consideration by the courts or

107. *Hedeman Products Corp. v. Tap-Rite Products Corp.*, 228 F.Supp. 630 (D.N.J. 1964); *B & B Auto Supply, Inc. v. Plesser*, 205 F.Supp. 36 (S.D.N.Y. 1962); *Harry Alter Co. v. A. E. Borden Co.*, 121 F.Supp. 941 (D. Mass. 1954); *Wrench v. Universal Pictures Co.*, 104 F.Supp. 374 (S.D.N.Y. 1952). Even if one or more copyright notices pertaining to the underlying work are repeated, all such notices need not be shown. *Id.* at 378, 379.

108. See *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939). *But cf.* *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406, 409 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

109. See U.C.C. art. III, §3; 17 U.S.C. §§9, 13 (1958).

the legislature. The holding of the court in *Bentley v. Tibbals*,¹¹⁰ although decided under the prior copyright law, is based upon reasoning equally applicable today. The Second Circuit refused to enjoin the copying of copyrighted material contained in a book consisting also of substantial unprotected matter but containing a repeated copyright notice pertaining to the previously copyrighted material, stating:

In our opinion one who so embodies copyrighted with uncopyrighted matter that one reading his work cannot distinguish between the two has no right to complain if the book is republished by third parties . . . If one intends to assert his exclusive right to publish and sell copyrighted matter, he must so clearly indicate the matter in which he has the exclusive right that the public upon inspection can determine the question of its own rights therein. He cannot require the public to search the markets to find a copy of his copyrighted book, then purchase it, and then compare it word by word with the uncopyrighted work.¹¹¹

Bentley v. Tibbals appears to be sound and should be applied to prevent recovery by or the granting of relief to a copyright proprietor in cases where previously copyrighted material is repeated in a work which also contains unprotected matter and the copyright notice fails to specify, at least in general terms, the matter which is protected.

However, although the same confusion may exist where a new version is published with an unqualified copyright notice which protects only part of the material appearing in the work, if the new version is entitled to be separately copyrighted a different situation exists and an unqualified copyright notice may be appropriate. The distinguishing feature is that the copyright protection granted by section 7 to new works *does* pertain to the entire work and may be effective to prevent even the copying of material which was previously in the public domain. Thus, substantial work effort involved in compiling unprotected matter will be protected and, although the same result may be achieved by access to unprotected sources, the copyist may not take advantage of the work product of the author of the derivative work by copying directly from such work.¹¹² Although the cases do not go so far as to

110. 223 Fed. 247 (2d Cir. 1915).

111. *Id.* at 256, 257.

112. *Toksvig v. Bruce Pub. Co.*, 181 F.2d 664 (7th Cir. 1950); *College Entrance Book Co. v. Amsco Book Co.*, 119 F.2d 874 (2d Cir. 1941); *Yale University Press v. Row, Peterson & Co.*, 40 F.2d 290 (S.D.N.Y. 1930); *Fred Fisher, Inc. v. Dillingham*, 298 Fed. 145 (S.D.N.Y. 1924); *Johnson v. Donaldson*, 3 Fed. 22 (C.C. S.D.N.Y. 1880).

indicate that one may not copy from a derivative work an unprotected play or story which appears therein without change, there is not in the case of derivative works any reason why the copyist should not be put to the trouble of finding for himself a copy of the unprotected work or at least ascertaining at his peril which matter he is free to copy. Certainly, even the republication without change of public domain material has served the useful purpose of calling such material to the attention of the copyist, a service which can be of substantial value in a case where the underlying material is hard to find. Thus, the author of a protected new work should not be required to qualify the copyright notice to apprise the reader of the exact nature of the protection he is claiming and the copyright notice pertaining to the new work should be effective for all purposes.

Effect of Lack of Full Copyright Protection. There are only a handful of cases which involve claims of infringement of works which consist of several versions, one or more of which are not protected by copyright. The cases have gone little beyond the statement of the general proposition that an action lies only where new matter protected by the copyright in a particular version is copied.¹¹³

Applying the general rule to the first of the illustrative fact patterns used to investigate the importability of such works—involving books which have been manufactured abroad and imported by virtue of a dedication of the new work—we first consider the effect upon composite or combined works, such as new text with previously protected illustrations. Since matter is usually repeated without change, only by the inclusion of the prior copyright notice may protection be continued.¹¹⁴ Unless it has been necessary to obliterate all notices to get through customs or the failure to qualify the notice presents a bar to suit, the repeated notice of the underlying copyright would protect the illustrations against copying, probably providing sufficient protection for the entire work. The importer has thus been able to have his cake and eat it too. The fly in the ointment—rather, on the cake—is the possibility that a court would cut through the technicalities and decide that, consistent with the legislative intent of the manufacturing clause, the proprietor must be deemed to have abandoned the entire work at the time of importation thereby precluding any action against a copyist who confined himself to copying from a copy of the book which was manu-

113. See *McCaleb v. Fox Film Corp.*, 299 Fed. 48 (5th Cir. 1924); *American Code Co. v. Bensinger*, 282 Fed. 829 (2d Cir. 1922).

114. *But cf. Unistrut Corp. v. Power*, 280 F.2d 18, 23 (1st Cir. 1960) (question not reached by court).

factured abroad.¹¹⁵ The proprietor could argue that his intention was clearly contrary and should prevail, and that the most that could be said is that the book was imported unlawfully, which is no bar to an action based upon the underlying copyrights. If only the latter argument prevails, it may permit the proprietor to win an action but the decision of the court should be effective to prevent future importation of such works if they contain a copyright notice of any kind.¹¹⁶

Translations and other versions of previously copyrighted works which commingle new matter with the underlying matter to result in an inseparable, conglomerate whole present more difficult problems. The following possible results of the dedication of a translation into English of a protected underlying work must be considered:

1. Copyright in both the new work and the underlying work has been fully divested.
2. All translation rights into English are now in the public domain.
3. Anyone may copy the English translation for all purposes.
4. Only a substantially identical copying of the dedicated English translation is permitted.
5. No copying of either work, except for the wholly new matter contained in the new work, is permitted without the consent of the proprietor of the underlying copyright.

The first result appears erroneous where there is a clear intention to dedicate only the new matter and the notice referring to the underlying copyright is repeated in the new work.¹¹⁷ Even without the repetition of such notice, a strong argument against total divestment can be made since the underlying work is not repeated in substantially identical form. The proviso in Section 7 that the publication of a "new work shall not affect the force or validity of any subsisting copyright upon the matter employed" has been given effect in a case where pictures appearing in a validly copyrighted 1933 catalogue were incor-

115. If, however, the proprietor of the new work is not the proprietor of the underlying material but has only a license to republish, his unauthorized omission of adequate copyright notice will not affect the right of the proprietor of the underlying copyright to sue for infringement. See note 94 *supra*.

116. The decisions determining authorship of imported books are not noted for consistency. For an interesting report of how one importer was able to prevail in two similar cases which turned upon the same question of authorship, although the positions taken by the importer in the two cases were diametrically opposed to each other, see *Oxford University Press, Inc. v. United States*, 33 C.C.P.A. 11, 22 (Customs 1945).

117. *Sieff v. Continental Auto Supply, Inc.*, 39 F.Supp. 683 (D. Minn. 1941).

porated in an unprotected 1948 catalogue in sufficiently altered form as to constitute new matter.¹¹⁸

In *Rushton v. Vitale*,¹¹⁹ authorized photographs of a copyrighted three-dimensional doll called "Zippy" appeared without any copyright notice in trade journals. The court cited one of its earlier decisions¹²⁰ as authority to hold that the publication of the photographs did not result in loss of the copyright in the doll, each reproduction of the doll having been shown to contain an appropriate copyright notice. In reversing the refusal of the court below to issue a temporary injunction, the court went on to say that "defendants' copy could in any case have been derived only from the three-dimensional figure."¹²¹ While the court may have been unduly influenced by the extent of the slavish copying engaged in by the defendants—the defendants used plaintiffs' doll to prepare its molds, plaintiffs' copyright notice and mold number appearing on each of defendants' copies—implicit in its holding is the conclusion that the publication without any copyright notice of a photograph of a copyrighted work does not effect a dedication of the copyrighted work and that the proprietor thereof may maintain an infringement action based upon copying from the copyrighted work.¹²²

118. *Siewek Tool Co. v. Morton*, 128 F.Supp. 71 (E.D. Mich. 1954) (semble).
But see NIMMER ON COPYRIGHT 220, 221.

119. 218 F.2d 434 (2d Cir. 1955).

120. *Alfred Bell & Co. v. Catalda Fine Arts Inc.*, 191 F.2d 99 (2d Cir. 1951). Professor Nimmer calls the reliance upon this case "erroneous" and correctly points out that *Bell v. Catalda* involved a copyrighted reproduction of uncopyrighted works of art, held to be protected from copying, the reverse of the situation in *Rushton v. Vitale*. See NIMMER ON COPYRIGHT 222, n. 195a. However, the court was apparently aware of the factual distinctions, having previously quoted the *Bell* case correctly on the issue of originality. The second reference to the case may have been for the broad proposition that even supposedly exact reproductions of paintings by mezzotint process were "sufficiently distinguishable variations," even if unintentional, to constitute separately copyrightable new works. This would support the view that *Rushton v. Vitale* holds that the publication without copyright notice of the photograph, a *distinguishable variation* of the doll, does not abandon the copyright in the doll. See also *Siewek Tool Co. v. Morton*, 128 F.Supp. 71 (E.D. Mich. 1954) (semble).

121. 218 F.2d at 436.

122. *Accord, S. C. Johnson & Sons, Inc. v. Drop Dead Co.*, 201 F.Supp. 442 (S.D. Calif. 1961). The *Johnson* case held that the distribution of advertising placards containing a picture of plaintiff's cans of "Pledge," with the label visible but with no copyright notice, to grocers throughout the nation did not as a matter of law constitute a sufficient dedication to void plaintiff's copyright in the "Pledge" label. *Rushton v. Vitale* was cited as holding that the trade journal publication of the "Zippy" photo-

The cases can be reconciled by giving effect to the proviso in section 7 to conclude that where previously copyrighted material is repeated in such form as to constitute new matter within the meaning of section 7, the incorporation of such new matter in an uncopyrighted new work does not constitute a publication of the underlying material and the lack of a copyright notice does not affect the validity of the underlying copyright. Thus, the publication of the new work without any copyright notice will dedicate all of the new and revised matter contained therein but will constitute an abandonment only of copyrighted underlying matter to the extent it is repeated in substantially identical form. The original text of a foreign language book would, therefore, not lose its pre-existing copyright protection even if the English translation is published without any copyright notice.

Nor is there any reason to conclude that all translation rights into the English language have been lost by the dedication of the particular translation.¹²³ The subsisting copyright in the underlying work is still effective to protect certain aspects of the plot, including specific characterizations and incidents and other elements of the author's expression of ideas, and would appear to preclude any copying or translating which utilizes the underlying work as its source.¹²⁴ Thus, one who utilizes the underlying work to make a translation substantially identical to the new work has infringed the underlying copyright although he may be free to make an exact copy of the new work even to the extent of utilizing photo-reproductions for making plates from which additional copies of the new work are printed.¹²⁵

At first blush, it would appear to be axiomatic that the dedication of the translation would permit anyone to copy from it for all purposes and that result number three is the correct one. Reconciling this view with the prohibitions noted in the previous paragraph, we might conclude that the sole question in any infringement action based upon a copyrighted underlying work and involving also an uncopyrighted new

graph did not effect a dedication because such publication was for a limited purpose. In both cases, however, the publications appear to be sufficient to dedicate all matter contained therein. It would be particularly difficult to justify a holding that the distribution of placards to grocers for display purposes is anything but a general, unlimited publication.

123. Cf. *O'Neill v. General Film Co.*, 171 App. Div. 854, 157 N.Y.Supp. 1028 (1916).
124. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).
125. *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952). *But see E. P. Dutton & Co. v. Cupples*, 117 App. Div. 172, 102 N.Y.Supp. 309 (1907).

work is the source from which the copyist worked. This rule is also attractive because of its simplicity of application; the court could avoid the almost impossible question of how to separate protected from unprotected matter in a new work which consists of a commingling of the underlying matter with new matter in such manner as to fuse the material into a conglomerate whole. Thus, in *Rushton v. Vitale*, defendant might have fared better had he used only the uncopyrighted photograph to reconstruct "Zippy."

Although undoubtedly the correct view in a case where the translation or other version is published without any copyright notice, a rule permitting unlimited copying from the translation if it contains a notice pertaining to the underlying foreign text ignores the effect, if any, of such notice. Where the new work has been dedicated but the underlying matter is protected by a repeated notice of copyright it would appear that a copyist should not be able to make any greater use of the copyrighted underlying material without authorization than could the proprietor of the new work. The cases indicate that the proprietor of the copyright in an authorized new work who no longer has authorization to use the underlying work may continue to use the new work in substantially identical form but may not create a new version of the new work which also constitutes a new version of the underlying work.¹²⁶ Thus, anyone may be free to copy the dedicated

126. In *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469 (2d Cir.), *cert. denied*, 342 U.S. 849 (1951), plaintiff was the proprietor of the copyright in the opera "Madame Butterfly." The copyright in the novel upon which the opera was based had been renewed and plaintiff had acquired no rights under the renewal. The court held that plaintiff could not make general use of the novel in the production of a motion picture without a license from the current proprietor of the renewal copyright in the novel, but was restricted to use of copyrightable new matter in the opera.

In *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 115 F.Supp. 754 (S.D.N.Y. 1953), *rev'd*, 221 F.2d 569 (2d Cir.), *modified per curiam*, 223 F.2d 252 (2d Cir. 1955), the court, citing the "Madame Butterfly" case as authority, held: "A publisher, who is the owner of a copyright of a 'new work' is entitled to the exclusive use of the old material in conjunction with the new only during the original term of the copyright of the old material, unless he acquired the renewal interest of the author of the old material. . . ." *Id.* at 760.

Despite contrary statements by respected authorities in the field, see NIMMER ON COPYRIGHT 179, 281; Bricker, "Renewal and Extension of Copyright," 29 So. Cal. L. Rev. 23, 43 (1955); Ringer, "Renewal of Copyright," in 1 STUDIES ON COPYRIGHT 503, 565, 566 (1963), the "Madame Butterfly" case did *not* hold that the proprietor of the copyright in the new work was precluded from making copies of or permitting public per-

new work in substantially identical form but should not be free to create any other versions of the work which utilize any of the protected underlying matter if the new work contains a copyright notice which continues the protection of the underlying material. Where such new work is a translation, this analogous line of cases supplies strong reasoning to support the fourth result—that only a substantially identical copying of the English translation is permissible and that a new version, even if created by copying from the dedicated new work, does infringe the subsisting copyright in the underlying foreign text.¹²⁷

Any argument in favor of the fifth result which would, in effect, achieve the same result as would the copyrighting of the new work appears on the surface to be facetious. However, some of the language in the leading case which deals with the ramifications of partial dedication does imply that even after a play based upon the novel had entered the public domain it could not be copied in its entirety.¹²⁸ There

formances of the opera, but merely held that he could not make *general* use of the protected underlying material for the creation of a motion picture, itself a new work based upon the underlying copyright which he no longer had authorization to use. This should be apparent from the following language which appears in that opinion: “. . . [T]he expiration of Long’s copyright of the novel did not affect the plaintiff’s copyright of so much of the opera as was a ‘new work’ and entitled to be independently copyrighted as such. . . .” 189 F.2d at 471.

“So much of the judgment as declares that the plaintiff is ‘the rightful owner and sole proprietor of the valid renewal copyright in the Opera entitled *Madame Butterfly* and of all rights and interest therein including the sole and exclusive motion picture rights’ is affirmed. . . .” *Id.* at 472.

Obviously, the entire opera qualifies as a “new work” and the termination of the proprietor’s right to use the underlying matter does not in any way interfere with his exploitation of the opera, as such. Moreover, the language of the decision implies that he may even make a motion picture based upon the opera, which would apparently have to be merely a faithful representation of the opera which would not constitute yet another version of the underlying novel.

See *Edmonds v. Stern*, 248 Fed. 897 (2d Cir. 1918); *But cf.* *Fitch v. Shubert*, 20 F.Supp. 314 (S.D.N.Y. 1937).

127. *Cf.* *Wihtol v. Crow*, 309 F.2d 777, 781 (8th Cir. 1962). *But cf.* *Champney v. Haag*, 121 Fed. 944 (C.C.E.D. Pa. 1903). It could, however, be argued that the repeated copyright notice does not continue the protection of the underlying matter contained in the new work because it is so changed in form. *Cf.* *Siewek Tool Co. v. Morton*, 128 F.Supp. 71 (E.D. Mich. 1954) (*semble*). Therefore, an action for infringement cannot be predicated upon copying from the new work.
128. In the “*Madame Butterfly*” case, the language in the original opinion holding that “when the copyright expired, the play was property in the public demesne, since the record discloses no renewal of the copyright,”

is considerable case law, however, which indicates that once a copyright expires anyone is free to copy all of the work even if parts of the work would otherwise have been protected other than by the expired copyright.¹²⁹

Thus, at least exact copies may be made of new works in the public domain despite the existence of copyright in underlying matter. A holding to this effect would appear to be guaranteed in a case where the books have been imported with the old copyright notice only because of the supposed dedication of the new work.¹³⁰

was clarified on rehearing to read, "when the copyright expired, the copyrightable new matter in the play was property in the public demesne, since the record discloses no renewal of the copyright." 189 F.2d at 472. The opinion does not indicate whether the play was published after expiration of the copyright nor, if so, whether the valid copyright notice covering the novel was repeated in the published copies. If the play was not published, the court's statement that "what is dedicated to the public as a condition of obtaining a copyright is only such matter as is copyrightable" serves to distinguish the holding from the fact patterns under consideration in this paper since it may be that the expiration of copyright in an unpublished work would not effect a dedication of protected underlying matter, whereas the same would not be true had the work been published. See also NIMMER ON COPYRIGHT 181.

129. Upon publication or copyrighting of a work, all common law rights are relinquished; the work is protected only by statutory copyright. *Holmes v. Hurst*, 174 U.S. 82 (1899); *Bobbs-Merrill Co. v. Straus*, 147 Fed. 15 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908). Upon expiration of the copyright, the right to copy the work in its entirety, including the right to use incidental parts of the work which may not have been within the protection of the statutory copyright, passes to the public. See *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952); *Underhill v. Schenck*, 238 N.Y. 7, 143 N.E. 773 (1924); *cf. Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581 (6th Cir.), *cert. denied*, 350 U.S. 840 (1955); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F.Supp. 670 (S.D.N.Y. 1963); *Zippo Mfg. Co. v. Manners Jewelers, Inc.*, 180 F.Supp. 845 (E.D.La. 1960). However, although the cases tend to hold that the copyrighted or patented article is, upon expiration of the basic copyright or patent, dedicated to the public in the identical form for which protection had previously been granted, they do not deal with a situation where some protection is nonetheless claimed *by virtue of the same patent or copyright law*, as in a case where an underlying copyright still exists.

130. A similar result could be achieved by reliance upon *Bentley v. Tibbals*, 223 Fed. 247 (2d Cir. 1915). See notes 110 and 111 *supra* and accompanying text. In the case of translations and similar conglomerate new works it might prove impossible to specify adequately which matter is protected

In the second illustrative fact pattern—where the underlying matter is unprotected but the new work is copyrighted—it is clear that anyone may use the underlying matter for all purposes.¹³¹ Thus, if only an English translation is protected, anyone may make other translations of the work into English.¹³²

Unless the form of copying, organization or compilation of matter repeated in substantially identical form is sufficient to entitle such repeated matter to be protected by the new copyright, it appears that such matter may be copied even from the new work.¹³³ In *Kashins v. Lightmakers, Inc.*,¹³⁴ plaintiff had published a copyrighted catalogue containing photographs of lamps which were not protected by copyright or patent. Defendant used the copyrighted photographs to produce substantially similar lamps and published its own catalogue containing photographs of its lamps. Although the resulting photographs closely resembled those of plaintiff, it was held that there was no infringement since the lamps were not protected from copying and there was no showing that the protectible elements of the catalogue were copied.¹³⁵ Thus, whereas copying from a protected three-dimensional object constitutes infringement even where there has been published without notice of copyright a photograph of the object, in the converse situation it has been held not to be an infringement to copy from a protected photograph an unprotected three-dimensional object.¹³⁶

In the case of repeated illustrations adopted without rearrangement from a single source, there may be insufficient changes to entitle the illustrations to protection and it may be practicable to copy them from the new work. However, it would appear to be almost impossible to copy from an English translation the unprotected elements, such as the plot and incidents in the story, without also copying the protected new matter which in such case consists of the expression of the story in the

by the repeated copyright notice. If the repeated notice is held ineffective because of failure clearly to indicate the matter protected, the translation could be freely copied for all purposes and used as the basis for other versions of the work.

131. *McCaleb v. Fox Film Corp.*, 299 Fed. 48 (5th Cir. 1924); *Glaser v. St. Elmo Co.*, 175 Fed. 276 (C.C. S.D.N.Y. 1909).

132. *Shook v. Rankin*, 21 Fed. Cas. 1335 (No. 12,804) (C.C.N.D. Ill. 1875).

133. See *Ebenstein*, "What Does Copyright Protect?" 10 N.Y.L.F. 1, 5 (1964). But see note 112, *supra*.

134. 155 F.Supp. 202 (S.D.N.Y. 1956).

135. *Accord*, *Lamb v. Grand Rapids School Furniture Co.*, 39 Fed. 474 (C.D. W.D. Mich. 1889).

136. Cf. *Muller v. Triborough Bridge Authority*, 43 F.Supp. 298 (S.D.N.Y. 1942). But cf. *Home Art, Inc. v. Glensder Textile Corp.*, 81 F.Supp. 551 (S.D.N.Y. 1948).

English language.¹³⁷ Thus, it would appear to be essential that any copyist obtain a copy of the underlying work to avoid infringing the copyright in the new work and, in the case of translations and other new versions of books and periodicals, copying from the protected new work would probably constitute an infringement.¹³⁸

Where a new work is only partially protected by copyright, the nature and extent of the proprietor's right to prohibit copying has rarely been considered in detail by the courts. The few cases dealing with the problem have not delved into the different classes of matter embodied in the new work. An example of the confusion which exists is the opinion in one of the leading cases, which contains sufficient ambiguous language so that it can be quoted out of context to support several conflicting views of the possible results of the dedication of a translation of a protected work.¹³⁹

The summary tabulation which follows may be of some use in evaluating the various problems a potential plaintiff must consider. For purposes of tabulating the conclusions reached, an attempt has been made to separate and define the various elements which appear in a new work. Although the following terms may not always be defined with absolute precision and some of the distinctions appear to be artificial, it is hoped that they serve some useful purpose and will lead to a more detailed consideration of the many specific problems involved.

new matter—wholly new and original matter added by the author of the new work.

repeated matter—matter repeated from the underlying work or works in substantially identical form.

new version—alteration, sufficient in itself to constitute protectible new matter, made in matter derived from underlying work, e.g. the translation, a photograph of an object, a play based on a novel, compilation of matter.

old version—underlying matter contained in matter constituting *new version*.

old matter—underlying matter not used in the new work.

137. See *Toksvig v. Bruce Pub. Co.*, 181 F.2d 664 (7th Cir. 1950); *Home Art, Inc. v. Glensder Textile Corp.*, 81 F.Supp. 551 (S.D.N.Y. 1948); *Yale University Press v. Row, Peterson & Co.*, 40 F.2d 290 (S.D.N.Y. 1930); *Warren v. White & Wyckoff Mfg. Co.*, 39 F.2d 922 (S.D.N.Y. 1930).

138. Note that, if the copyrighted new work was not copied from an underlying work but is an independent work, copying from it will constitute infringement even if it is identical to a work already in the public domain. *Fred Fisher, Inc. v. Dillingham*, 298 Fed. 145 (S.D.N.Y. 1924).

139. See notes 126 and 128, *supra*.

Protection Accorded to Component Parts of a New Work Published with		<i>new matter</i>	<i>repeated matter</i>	<i>new version</i>	<i>old version</i>	<i>old matter</i>
(a)	No copyright notice	not protected	not protected	not protected	not protected	protected
(b)	Only a notice continuing protection of the underlying work or works	not protected	protected	not protected	not protected	protected ¹⁴⁰
(c)	A new copyright notice	protected	protected	protected	protected	protected
(d)	A new copyright notice, underlying copyright(s) expressly abandoned	protected	not protected	protected	not protected	not protected ¹⁴¹

140. This matter is not protected against substantially identical reproduction of the new work. Any other copying might infringe the subsisting copyright in the underlying work. See notes 126-30 *supra* and accompanying text.

141. It may be, however, that this matter would have to be copied from the underlying work. See notes 134-38 *supra* and accompanying text.

CONCLUSION

The manufacturing clause has been unanimously condemned by thoughtful scholars and there is no valid reason for its inclusion in the copyright law. Not only is it contrary to the basic purposes of the copyright law to require that an author or proprietor forego all protection for his work in order to take advantage of benefits which may accrue from foreign manufacture of copies of his work, the clause and the implementing import restrictions, as presently enforced, patently discriminate against American authors. If, indeed, it is essential to afford to the domestic printing industry some protection against foreign competition, such protection should be achieved via the tariff laws without distinction between copyrighted and uncopyrighted works. The long overdue repeal of the domestic manufacturing requirements would end the anomalous situation, wherein the same law which is so protective and solicitous of the rights of authors and their heirs with respect to the less valuable right of renewal of copyright, presumably because authors are often in poor bargaining positions, creates a situation which encourages forfeiture of the same author's entire copyright.¹⁴² Furthermore, there would no longer be any need to restrict the rights of American authors under the Universal Copyright Convention and most of the problems discussed in this article would become moot. Unhappily, this is not likely to occur.

Therefore, at least the following changes in the copyright law should be sought and the proposed copyright revision, which appears imminent, provides an excellent opportunity for making the necessary changes.

1. The words "or proprietor" should be eliminated wherever they appear in section 9 since they are meaningless and can only cause confusion in the future.¹⁴³

2. The definition of "author" contained in section 26 should be deleted in favor of a provision granting to the employer in the case of works made for hire the presumptive right to secure original copyright.¹⁴⁴

142. See REPORT OF REGISTER 122. Any provisions in the revised law for the protection of authors against "improvident transfers" will not help those authors who are forced to acquiesce in the destruction *ab initio* of all of their rights. See *id.* at 92-94; S. 3008, 88th Cong., 2d Sess., §16(a) (1964).

143. The proposed general revision bill would accomplish this. See S. 3008, §§3, 14.

144. See note 69, *supra*.

3. If the definition is retained, the new law should indicate specifically whether the word "author" as used in various parts of section 9 refers to the actual employee-author or the employer-author.

4. The importability of copies of works which consist of copyrighted matter which is importable by virtue of the exemption afforded to Universal Copyright Convention works pursuant to section 9(c) and uncopyrighted material authored by American nationals should be specified.¹⁴⁵ It would appear that this entire subject, as well as the question of what protection should be afforded to copyrighted works where there also exist uncopyrighted versions of the same work, has received too little attention in the studies preparatory to the submission of recommendations for the revision of the copyright law.

5. The desirability of continuing to permit the use of unqualified copyright notices which, in fact, may protect only a small portion of the work to which they are affixed is at least doubtful. In some cases, it would appear that the use of such unqualified notice is a valid defense to an infringement action. Here, too, it would be desirable to study the advisability of including in the proposals for revision some clarification of this subject. Perhaps it is time to recognize that the copyright notice is really no notice at all in many circumstances.¹⁴⁶

Today knowledgeable attorneys are able, with the aid of "elaborate contractual arrangements,"¹⁴⁷ to avoid the operation of the domestic manufacturing requirements, although they may be uncertain of the consequences of such action. Those authors not adequately represented by counsel or who are economically at the mercy of their publishers

145. The proposed revision bill would exempt from the domestic manufacturing requirements all works of which the "author of any substantial part is neither a citizen nor a domiciliary of the United States." S. 3008, §43(b)(1). This proposal appears to raise more questions than does the prior law. For example, in the case of derivative works, if the author of an underlying work which forms a "substantial part" of the derivative work is not a citizen or domiciliary of the United States may such derivative work authored by a United States citizen be manufactured abroad and imported with full copyright protection?

146. Although the notice requirements of the proposed revision bill contain provisions substantially mitigating the harsh effects under present law of faulty copyright notice, the general requirements of copyright notice now in effect are carried over into the proposed bill. The rule that a derivative work need contain only a single copyright notice with the year of first publication of the derivative work has been incorporated in §24(b)(2) of the proposed bill.

147. DISCUSSIONS AND COMMENTS ON REPORT OF REGISTER 386.

do not even fare as well.¹⁴⁸ It is, furthermore, unsound to build an industry upon dubious techniques which may prove to be unlawful when, and if, they are tested in court. As a practical matter, it is not difficult to avoid the operation of the restrictions against importation of foreign manufactured books and periodicals by one or another of the methods discussed above. However, if we must live with the domestic printing industry's sacred cow, let us do so with honor and let it be applied with equal vigor to all concerned. If the political situation is such that it is impracticable to go to the heart of the matter and eliminate the basic problem, at least the legislative process should be intelligently applied to clarify and define the rights of all concerned. Only then will enforcement officials be able properly and equitably to enforce the law. The time has come to stop playing Russian roulette with the substantial rights of the creators of intellectual property who are, after all, the intended beneficiaries of the protection afforded by the copyright law.

148. The following commentary by two leading copyright attorneys is illuminating: "Those photographers with established reputations have sometimes been able either to have their works produced in this country or to retain counsel to work out elaborate contractual arrangements for nominal compliance with the manufacturing clause for editions of their works produced abroad. Lesser known photographers, however, have usually not been able to work out either such arrangement, with the net result that the encouragement of their art and the wide dissemination of their works has been inhibited." *Ibid.*

PART II.**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS****2. FOREIGN NATIONS****22. FRANCE. *Laws, statutes, etc.***

Loi sur l'application du principe de réciprocité en matière de protection du droit d'auteur (No. 64-689, du 8 juillet 1964). (77 *Le Droit d'Auteur* 217, no. 9, Sept. 1964.)

An amendment of the French copyright statute which provides, in essence, that France will not grant copyright protection to works first published in a foreign country if such country does not adequately protect works first published in France. An exception is provided for works protected by international conventions of which France is a member. The amendment does not affect the protection of the right of the integrity and paternity of the work.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

23. *Pic Design Corp. v. Sterling Precision Corp.*, 231 F. Supp. 106, 142 U.S.P.Q. 431 (S.D.N.Y., June 29, 1964) (Ryan, C.J.)

Action for copyright infringement and unfair competition. Plaintiff and defendant manufacture precision instrument components. Plaintiff alleged that defendant's catalogs for this merchandise contained material copied from plaintiff's catalogs.

Held, judgment for plaintiff.

I. *Copyright Infringement*. It was held that plaintiff's copyrights were valid, not only with respect to the original drawings of instrument components which it contained, but also with respect to the compilations of public domain material which were also included. Plaintiff's method of tabulating figures was held not to present even that low degree of originality of expression which is necessary to sustain copyright, and therefore not to be protectible here. The court said:

The published items are trade catalogs and are copyrightable under 17 U.S.C. §5 (a), even though the subject matter contained in the catalog is within the public domain. This is so even though the same facts could be gathered by another through independent research. One must do this research himself and not merely copy the material from one who has already gathered, arranged and collated it. . . .

Plaintiff's catalogs are even more clearly entitled to copyright protection in that much of the contents of the catalogs—particularly though not exclusively the drawings—are the result of plaintiff's creativity. The precise degree of originality involved here is largely immaterial since, "it is now settled beyond question that practically anything novel can be copyrighted." *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, 2 Cir., 309 F. 2d 745, 746 (1962). Thus, plaintiff's catalogs and the drawings of the components contained

therein are found to be copyrightable and entitled to protection from copying. . . .

In regard to the tables of specifications claimed to have been copied from the plaintiff's catalogs and allegedly infringing on the copyrights, we observe that the figures in these tables are facts in the public domain determined by commonly known and applied formulae. As such, the numbers cannot be copyrighted. It would be impossible to tell who worked out a formula in order to arrive at the correct figure, and who merely copied figures from someone else. Where, however, the same errors (or "printer's traps") appear in an earlier and later publication, it is fair and reasonable under the circumstances here present to infer copying. . . .

A separate argument is made by the plaintiffs for their claim to protection for the tabular arrangements of these figures. If numbers of formulae are facts in the public domain and so not subject to copyright, an original and novel arrangement of these facts is copyrightable.

While the degree of originality necessary to sustain a copyright is very low . . . the copyright covers only a specific mode of expression of an idea. The idea is public property and there is no infringement unless the mode of expression is identical. Substantial similarity is not infringement ". . . where such similarity is necessary because the idea or system being described is the same." *Gaye v. Gillis*, D.C., 167 F. Supp. 416, 418 (1958). This is the case before us now. To some extent the substantial similarities which do appear as to the arrangement of the tables in PIC No. 20 and Sterling No. 60 are a natural result of the subject matter. There are a very few ways of listing such information and the general method used by both plaintiff and defendants is logical and to be expected. . . .

It is difficult to see how, even under the extremely liberal view and approach taken by *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, *supra*, plaintiff can claim a valid copyright on the "format" or "visual impact" of the PIC catalog. . . . The fact that most of the pages in all three catalogs consist of drawings of the particular item followed by tables relating to its specifications is not so persuasive as to indicate copying in light of the logic of this method of presentation. That there are only limited ways of producing such a catalog in handbook form is further illustrated by the Boston Gear Catalog which antedates plaintiff's PIC No. 20, and from which plaintiff admittedly copied. . . .

The "visual impact" of all these catalogs is in some aspects quite similar; this is inherent in the nature of such a presentation, and may not validly be afforded the protection of a copyright.

The court also held that a number of drawings had been copied by defendant from plaintiff's catalog and that this constituted a "substantial" taking, sufficient to constitute copyright infringement.

II. *Unfair Competition*. Plaintiff argued that defendant had been guilty of unfair competition in copying the general appearance and format of plaintiff's catalogs, contending that the catalogs had acquired a secondary meaning. The court held that the catalogs had not, in fact, acquired secondary meaning. The court said:

We find that there is no credible testimony that plaintiff's catalogs have acquired a "secondary meaning". If any catalog can at all be said to have acquired a "secondary meaning" it would be the old "Boston Gear Catalog" . . . antedating both plaintiff's and defendants' catalogs. There is nothing in the size, shape, contents, format or general nature of any handbook catalog before us, sufficiently unique as to support an inference of a link between the public mind and that catalog.

24. *Burke & Van Heusen, Inc. v. Arrow Drug, Inc.*, 223 F. Supp. 881, 143 U.S.P.Q. 17 (E.D. Pa., Sept. 23, 1964) (Freedman, J.)

Action for copyright infringement. Plaintiff granted a license to Beecham Products, Inc. by which it was authorized to record certain musical compositions owned by plaintiff on long-playing phonograph records which were to be used only as a premium in connection with the sale of a certain shampoo. Beecham Products, Inc. sold both the shampoo and the records to defendants, and defendants resold the records separately, without the shampoo. Defendants moved for summary judgment.

Held, judgment for defendants.

Plaintiff contended that the resale of the records in violation of the restrictive license under which they had been made constituted a copyright infringement. The court invoked the "first sale" doctrine, however, and held that his exclusive right to vend does not give a copyright proprietor the right to restrict the resale or use of a physical embodiment of his copyrighted work once there has been an initial authorized sale of the particular physical object. The court said:

The Copyright Act grants to the copyright proprietor the exclusive right to print, reprint, publish, copy and vend the copyright work (17 U.S.C. §1), but it gives him no further right of control over the use or disposition of the individual copies of the work once he has sold or otherwise disposed of them. Thus it has long been established that the purchaser of a copy of a literary work may use or dispose of that copy as he wishes, unrestricted by the copyright law, although, of course, he may not publish or produce other copies of the work without the license of the copyright owner. The same rule applies to musical compositions except that once the copyright owner has recorded or permitted the recording of the composition, §1 (e) of the Act permits anyone to make a recording of the composition upon notice and payment of a specified royalty to the copyright owner. (*Harrison v. Maynard, Merril & Co.*, 61 F. 689 (2d Cir. 1894); *Bobbs Merrill Co. v. Straus*, 210 U.S. 339 (1908)). . . .

The "first sale" doctrine was first incorporated in the Copyright Act in 1909, and now appears as §27 of 17 U.S.C.: "The copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this title shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained."

Plaintiff relies heavily on the recent case of *Platt & Munk Co. v. Republic Graphics, Inc.*, 315 F.2d 847, 137 U.S.P.Q. 268 (2d Cir. 1963). That case, however, expressly recognizes and reaffirms the "first sale" doctrine. It decided that where the "first sale" had not yet occurred, the copyrighted goods, nevertheless, were subject to the normal remedies of an unpaid manufacturer on obtaining a judicial determination of the amount due him.

The "first sale" doctrine applies to the sale of a copy which is combined with a non-copyrighted work. In *Fawcett Publications, Inc. v. Elliot Publishing Co., Inc.*, 46 F. Supp. 717, 54 USPQ 137 (S.D.N.Y. 1942), defendant purchased copies of plaintiff's copyrighted comic books, combined them with other comics, and sold the combination under covers labelled "Double Comics". It was held that plaintiff's copyright was not infringed. In *Kipling v. G. P. Putnam's Sons*, 120 F. 631 (2d Cir. 1903), it was held that the binding of unbound sheets of copyrighted works of Kipling,

together with some of his uncopyrighted poetry and an index, did not infringe plaintiff's copyrights. (But cf. *National Geographic Society v. Classified Geographic, Inc.*, 27 F. Supp. 655, 41 USPQ 719 (D. Mass. 1939)).

In the present case defendants separated the copyrighted work from another product and sold it separately. The principle which applies to the sale of a combination of a copyrighted and non-copyrighted work is equally applicable here. For the ultimate question under the "first sale" doctrine is whether or not there has been such a disposition of the copyrighted article that it may fairly be said that the copyright proprietor has received its reward under the copyright statutes. Royalties were paid to it by Beecham. Plaintiff chose to authorize Beecham to sell the records under a restrictive license agreement. Although its ownership of the copyright remains, it transferred the ownership of the records. The fact that defendants knew of the restrictions which were part of the license agreement between plaintiff and Beecham neither binds defendants to a contract to which they were not parties nor widens the scope of control granted by the Copyright Act.

25. *Tempo Music, Inc. v. International Good Music, Inc.*, 143 U.S.P.Q. 67 (W.D.Wash., Sept. 15, 1964) (Solomon, J.)

Action against three radio broadcasting corporations for copyright infringement of musical compositions. Defendants admitted that they had performed plaintiffs' musical compositions without ASCAP or other license. Defendants moved to join ASCAP as a defendant, which motion was denied, and the infringement suit came on for trial.

Held, judgment for plaintiffs.

Defendants argued that plaintiffs were barred from maintaining this action because, among themselves and in conjunction with ASCAP, plaintiffs had conspired to fix prices and engage in other unlawful practices in violation of the State of Washington laws (particularly RCWA, Chapter 19.24) and the federal antitrust laws. The defense of "unclean hands" was also raised. The court held, however, that the plaintiffs had not significantly violated either Washington law or federal law. The court also said that to construe the provisions of the Washington statute so as to make the acts of plaintiffs or ASCAP unlawful "would raise grave questions concerning the constitutionality of the Washington statute".

The court said:

Defendants admit the expropriation and the infringement of plaintiffs' copyrights, but they assert that plaintiffs are barred from maintaining this action because, among themselves and in conjunction with the American Society of Composers, Authors and Publishers (ASCAP), plaintiffs have conspired to fix prices and to engage in other unlawful practices in violation of the Constitution and the laws of the State of Washington, particularly Chapter 218, 1937 Session Laws (RCWA, Chapter 19.24) and the federal anti-trust laws. Defendants also assert that plaintiffs have unlawfully extended their individual copyright monopoly in violation of the copyright laws, and that by reason of "unclean hands" they have neither legal nor equitable standing to maintain these actions.

I find that plaintiffs have complied with the statutory requirements of the State of Washington. Defendants have failed to prove that ASCAP's registration of the songs in its repertory was inadequate or that plaintiffs or ASCAP violated the Washington law relating to the pooling of copyright interests without providing for per piece licensing (RCWA 19.24.020); or that the filing of these and other actions by the plaintiffs to enforce their rights under the copyright laws constituted an abuse of either State or Federal process. There is no evidence of any abusive practices by either the plaintiffs or their licensing agent which would deny them copyright protection.

I further find that there is no merit in defendants' contention that they did not take licenses with ASCAP because they feared State prosecution. I find that they failed to take licenses only because they wanted to avoid paying license fees on the same basis charged other broadcasting companies. I further find that defendants made no attempt to contact plaintiffs individually for the purpose of obtaining licenses to play plaintiffs' songs on a per piece or any other basis.

Defendants have admitted that it would be virtually impossible to deal with the composers on an individual basis for the rights to perform their songs for profit. Their contentions as to what the law requires would not only make it virtually impossible to police the use of copyrighted songs, but would also greatly increase the cost of administration. The enforcement of the Washington statute, as construed by the defendants, would not only jeopardize the efficient licensing and policing of performances for profit, which can only be done by licensing organizations such as ASCAP, BMI or SESAC, but it would also deprive plaintiffs and all other copy-

right owners of the privilege of profiting from their federally granted copyright monopoly.

To construe the provisions of the Washington statute (RCWA, Chapter 19.24) so as to make the acts of the plaintiffs or ASCAP in this case unlawful would raise grave questions concerning the constitutionality of the Washington statute under the Fourteenth Amendment to the Constitution of the United States.

Plaintiffs have not unlawfully extended their copyright monopolies through a combination among themselves or with ASCAP, nor are they guilty of violating the federal antitrust laws in any respect alleged by the defendants. However, even if plaintiffs' conduct in any respect can be considered a violation of either RCWA, Chapter 19.24, or the federal copyright or antitrust laws, their violations are so minimal and the violations of the defendants so unconscionable that plaintiffs should not be deprived of the right to maintain these actions for the deprivation of their property.

I also find the defendant Rogan Jones, who is and has been the dominant influence in defendant International Good Music, Inc., and who has determined its policies for more than 25 years, is equally liable with the corporation for these infringements.

26. *Manning v. Time, Inc.*, 143 U.S.P.Q. 113 (E.D. La., Sept. 22, 1964) (Ainsworth, J.)

Action for damages for violation of "rights of privacy, the rights of property, [and] privileges of complainant." Plaintiff alleged that he was the creator of "Manning's Moonball," a relief map of the moon in ball form for which he had secured copyright registration, and that defendant had twice published in "Life" Magazine a photograph of the "moonball" without his permission and without giving him credit as the creator of the object. Defendant moved to dismiss the complaint.

Held, motion denied.

Defendant contended that the court lacked jurisdiction because of improper venue since, inter alia, plaintiff's claim was not a personal action for damages under Louisiana law, but was in the nature of a suit for copyright infringement or of unfair competition joined with a copyright infringement. Defendant's argument was that the special venue provisions of 28 U.S.C. §1400 (a) for suits relating to copyrights was, therefore, applicable rather than the general venue provisions of 28 U.S.C. §1391 (c), permitting a suit against a corporation in any judicial district where it is incorporated, licensed to do or doing

business. Section 1400 (a) provides that "Civil actions . . . arising under any Act of Congress relating to copyrights may be instituted in the district in which the defendant or his agent resides or may be found." And defendant alleged that it could not "be found" in Louisiana. The court held, however, that a corporation is "found" in any district where it is doing business, that the test under either section is substantially the same, and that Time, Inc. was doing business in Louisiana. The court said:

Jurisdiction is found either under 28 U.S.C. 1338 (a), which provides for original and exclusive jurisdiction of the district courts in actions arising out of copyrights, or under 28 U.S.C. 1332, involving civil actions between citizens of different states with the requisite jurisdictional amount, or a combination of both.

Venue lies either under 28 U.S.C. 1400 (a), concerning suits relating to copyrights which "may be instituted in the district in which the defendant or his agent resides or *may be found*." (emphasis added), or under 28 U.S.C. 1391 (c), permitting suits in any judicial district where a corporation is doing business. We construe the phrase in §1400 (a) "may be found" to mean that a corporation is *found* in any district in which it is doing business. The test under either section is substantially the same. . . .

Defendant is not only doing business in Louisiana, but the alleged cause of action on which the complaint is predicated grows out of and is related to such business or business activities in the alleged publication and circulation on two occasions of Life Magazine in Louisiana of a photograph of plaintiff's "moonball," thus satisfying the requirements of LSA-R.S. 13:3471 (1).

2. State Court Decisions

27. *New York World's Fair 1964-1965 Corp. v. Colourpicture Publishers, Inc.*, 141 U.S.P.Q. 939 (N.Y.Sup., June 10, 1964) (Margett, J.), *affirmed* 142 U.S.P.Q. 237 (App. Div., 2d Dept., July 9, 1964) (*per curiam*).

Action for unfair competition. Plaintiff granted an exclusive license to Dexter Color New York, Inc. to produce and sell picture postcards depicting the New York World's Fair and its exhibits. Defendant has been producing and selling, outside the Fair premises, postcards containing pictures of Fair exhibits. Plaintiff moved for preliminary injunction.

Held, preliminary injunction granted; affirmed.

I. Defendant argued in the trial court that by reason of the decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 276 U.S. 225 and *Compco*

Corp. v. Day-Brite Lighting, Inc., 276 U.S. 234, such cases as *Metropolitan Opera Association v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, aff'd 279 App. Div. 632, *lv. to app. denied* 279 App. Div. 790, upon which plaintiff relied, could no longer be relied upon. The court held, however, that the two U.S. Supreme Court decisions did not "strike down all state laws of unfair competition in all cases and for all purposes" and that protection "for a brief two-year period" to the Fair's property rights in its exhibit was both necessary and possible. Holding also that the Fair buildings were not in public domain, the court said:

The necessity for such protection is manifest. Plaintiff is a non-profit corporation the purpose of which is to hold a world's fair for educational purposes with all revenues remaining after the discharge of its obligations to go to the City of New York for the restoration and improvement of Flushing Meadow Park and the remaining balance to the City of New York for educational purposes. *Matter of Froslid v. Hults*, 20 App. Div. 2d 498, 501.

Plaintiff, however, has been charged with the mission of planning, organizing, operating and supervising the World's Fair. Accomplishment of that mission has entailed enormous expenditures of time, effort, money and skill, and will entail more. Revenues it must raise. Its exclusive licensing program is not only an integral part of its revenue-raising activity, but is necessary to insure that the publicity the Fair receives will not demean it or the purpose for which it was created.

The short duration of the Fair renders meaningless any charge that plaintiff seeks to create a monopoly. And to argue that each building, exhibit or scene is in the public domain, in the strict sense, is to ignore the plain fact that each building, exhibit and scene is an integral part of the Fair. If, after the Fair is over, a building is permitted to remain, it may then pass into the public domain, in the strict sense. It has not done so while it is part of a show second to none, which is enclosed and which is viewable only upon the payment of admission and subject to conditions imposed by plaintiff.

In the opinion of this court plaintiff has ample power and right, perhaps the prime duty, to protect the integrity of its licensing program of which the license to Dexter is but a part.

The papers before the court indisputably establish that Colourpicture made an unsuccessful attempt to obtain for itself the very license—and the very protection—which plaintiff granted to Dexter and which Colourpicture now asserts plaintiff had no right to grant.

While the court does not say that Colourpicture is estopped from now making that assertion, the court does say that Colourpicture's prior participation conclusively establishes its knowledge of plaintiff's position and renders unpersuasive to a court of equity any present claim of irreparable injury which would allegedly result from a preliminary injunction.

That others may be guilty of the same or worse conduct than that charged to Colourpicture is, of course, no defense to it. *Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 805, 87 USPQ 173, aff'd 279 App. Div. 632, *lv. to app. denied* 279 App. Div. 790 *supra*. Indeed, such other conduct, if anything, underscores the necessity of declaring that plaintiff has the legal right to grant exclusive licenses.

As Mr. Justice Dore stated for a unanimous court in *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 App. Div. 459, 467, 39 USPQ 551, 556 *lv. to app. denied* 256 App. Div. 807, *supra*, "In all cases where the equitable power of the court is invoked, the controlling question is whether the acts complained of are fair or unfair." This court believes that the acts of Colourpicture which are complained of in this case are unfair.

II. The Appellate Division affirmed and held that the Fair, including the buildings, is a "show" in which plaintiff had protectible property rights. The court said:

We take judicial notice that the New York World's Fair is universally acclaimed as one of the world's greatest shows in 1964-1965. In our opinion, a photograph of a unique building, structure or object situated within the World's Fair grounds, to which an admission fee is charged, is a photograph of a show in which plaintiff has a property right. Therefore, defendants may not photograph that building, structure, or object without the plaintiff's permission. *Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 87 USPQ 173 aff'd 279 App. Div. 632; see also 279 App. Div. 646; and 279 App. Div. 790 (*lv. to app. to Court of Appeals denied*).

III. Judges Hill and Rabin dissented, stating that the Fair corporation had no property right enabling it to control the taking or reproduction of pictures of Fair buildings. The dissenting opinion said:

We are of the opinion that with respect to the buildings and exhibits situated within the World's Fair grounds, the plaintiff does

not have a property right therein which is sufficient to permit it to control the taking of photographs of the exteriors thereof for the purpose of sale. In our view, a photograph of a building cannot be deemed the equivalent of a reproduction of a "performance" or "show" in which a party may have a legally recognized property right. Cf. *Societe Comptoir De L'Indus. v. Alexander's Dept. Stores*, 190 F.Supp. 594, 128 USPQ 242, aff'd 299 F.2d 33, 132 USPQ 475. Thus *Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 87 USPQ 173, aff'd 279 App. Div. 632, cited by the majority, is clearly distinguishable. Moreover, it has been recently held by the Supreme Court of the United States that when an article is unprotected by a patent or a copyright, state law may not forbid others from copying that article. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 140 USPQ 524; *Compco Corporation v. Day-Brite Lighting*, 376 U.S. 234, 140 USPQ 528. Thus, if the buildings and exhibits, the designs of which have not been patented, could themselves have been copied by others, it would appear that photographic reproductions of these buildings and exhibits for the purpose of sale cannot be enjoined. Under all the circumstances and in view of the disputed issues of law and fact involved, we conclude that the issuance upon this record of an injunction pendente lite constituted an abuse of discretion as a matter of law.

28. *Joan Baez v. Fantasy Records, Inc.* (Cal. Super, San Francisco Co., October 30, 1964) (Molkenbuhr, J.) (not yet reported).*

Action to restrain defendants from distributing phonograph records containing performances by Joan Baez. In 1958, when Miss Baez was under 18 years of age, she recorded certain performances on tape. The tape was made at the request of defendant Tognazzini and remained in his possession. Tognazzini discussed a proposed written contract with Miss Baez and her parents, but none was ever signed. In 1964, defendant Fantasy Records, Inc., released an album called "Joan Baez in San Francisco" which was made from this tape. A preliminary injunction was granted.

Held, judgment for plaintiff.

It was held that the defendants had no right, title or interest in the 1958 tape recording and no authority to manufacture and distribute phonograph records made therefrom on the ground that plaintiff and her parents had not made a valid or enforceable contract with de-

* A copy of the court's Findings of Fact and Conclusions of Law was supplied to the Editors by Benjamin Dreyfus, Esq., of the California Bar.

pendant Tognazzini. The court also held that if there had been a verbal agreement, it was timely disaffirmed by plaintiff upon reaching her majority and learning of the alleged existence of such a verbal agreement.

The court further stated as a conclusion of law that "plaintiff's acts in making the said 1958 tape recording did not constitute a publication of her musical renditions, interpretations and performances thereon", and that "manufacture, distribution and sale, or any of them, by defendants or any of them, of phonograph records or tape recordings made from the tape recording made by plaintiff in 1958 will:

- (a) Violate plaintiff's common law copyright in her musical interpretations, renditions and performances as recorded on the said 1958 tape recording.
- (b) Constitute unfair competition.
- (c) Interfere with plaintiff's contract with Vanguard Recording Society, Inc.

Also of Interest:

29. *Piel Manufacturing Co., Inc. v. George A. Rolfes Co.*, 143 U.S.P.Q. 107 (S.D. Iowa, Oct. 2, 1964) (Hanson, J.)

In a case involving a charge of unfair competition based on similarity of products, the court found for defendants, stating that under *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 and *Compco Corp. v. Day-Brite Lightning*, 376 U.S. 234, "The law may now be that secondary meaning can never have such importance as to require more than truthful labelling."

30. *Spangler Candy Co. v. Crystal Pure Candy Co.*, 235 F.Supp. 18, 143 U.S.P.Q. 94 (N.D. Ill., Oct. 9, 1964) (Decker, Jr.)

Action for trademark infringement and unfair competition involving polyethylene packaged lollipops. Defendant admitted that it had come as close to plaintiff's packaging as it could "without copying it". Having held that the plaintiff's and defendant's trademarks were not similar, the court went on to hold that under *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), plaintiff had no protectible property right in its package format absent a showing of palming off.

31. *Ford v. Camay Record Corp.*, N.Y.L.J. 15, Sept. 23, 1964 (Sup. N.Y. Co.) (Schweitzer, J.)

Tennessee Ernie Ford charged that defendant's use of his name and likeness in connection with certain phonograph records was an invasion

of his right of privacy. The court held that the question whether plaintiff's contract for his performances on "telesccriptions" also authorized the manufacture of the phonograph records complained of from the audio portion of the "telesccriptions" was within the scope of the arbitration clause in Ford's contract with Snader Telesccriptions Corporation. The court also held, however, that defendant had not yet established that it had succeeded to Snader's right to arbitration. Plaintiffs' motion for preliminary injunction and defendant's motion to compel arbitration were both denied.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

I. United States Publications

32. BOGSCH, ARPAD. The law of copyright under the Universal Convention. Leyden, A. W. Sythoff [and] Bowker, New York, 1964. 591 p.

A comprehensive analysis of the Universal Copyright Convention, organized into two main parts. The first part is a revised and updated edition of the author's "Universal Copyright Convention" (New York: Bowker, 1958); and the second—entirely new—is a comparative exposition of the cumulative effect of the Convention and domestic copyright laws on the protection available to foreign works.

33. SIEBERT, FRED S. Copyrights, clearances, and rights of teachers in the new educational media; report of a study made for the Commission on Academic Affairs of the American Council on Education. Washington, American Council on Education [1964]. 62 p.

An edited version of a work first issued in 1963.

"The purpose of this study is to explore and, wherever possible, recommend solutions for three groups of problems growing out of the use of the new instructional media in American education.

"These problems can be identified as: (1) methods of protecting educational materials for the new media from unauthorized use through such legal concepts as copyright and literary property; (2) identification and description of educational materials which can and cannot be incorporated in the new educational media without infringing the rights of others; and (3) analysis and evaluation of various types of compensation policies in the new media and teacher relationships."

2. Foreign Publications

34. ARE, MARIO. *L'oggetto del diritto di autore*. Milano, A. Giuffrè, 1963. 520 p. (Saggi di diritto commerciale.)

A comprehensive treatise on the subject matter of copyright, which includes an analysis of the notion of an intellectual work in general and its legal protection, as well as a discussion of copyright protection for various categories of works, such as literature, music, and works of art.

35. DUPERTUIS, PIERRE ROBERT. *Le droit d'auteur dans le domaine de la publicité commerciale*. Lausanne, Impr. Rencontre, 1964. 151 p. Thesis—Lausanne.

A dissertation on the copyright aspects of advertising, with special reference to Switzerland. The study is divided into three parts, the first of which briefly describes the essential elements of advertising, the second traces the pertinent copyright legislation and jurisprudence, and the third offers a synthesis showing that the provisions of the copyright law are applicable to advertising as a proper subject matter of copyright, because, as a rule, the requirement of originality is fulfilled.

36. FABIANI, MARIO. *Il diritto di autore nella giurisprudenza*. Padova, Edizioni CEDAM [1963] 205 p. (Raccolta sistematica di giurisprudenza commentata, 1).

A systematic casebook—consisting for the most part of Supreme Court decisions—of Italian copyright law, prepared for the use of law students.

37. HOLZER, BOTHO. *Die Übertragung urheberrechtlicher Befugnisse an künftigen Werken; eine Betrachtung zum Verlags- und Urheberrecht*. Frankfurt am Main, V. Klostermann, 1963. 94 p.

A study of legal problems arising out of transfers of copyright and publishing rights in works which are to be created in the future, with special reference to the Federal Republic of Germany.

38. MORF, HANS. *75 Jahre Eidgenössisches Amt für geistiges Eigentum, 1888-1963*. [Bern, 1963]. 165 p. At head of title: *Jubiläumsschrift*.

The history and organization of the Swiss Office for Intellectual Property, published in commemoration of the 75th anniversary of its founding.

39. SCHMIEDER, HANS HEINRICH. *Das Recht des Werkmittlers*. Baden-Baden, Verlag für angewandte Wissenschaften, 1963. 101 p. (Schriftenreihe der UFITA, Heft 25.)

A comparative study of the legal situation of those persons and organizations which stand as intermediaries between the author and the public, and make it possible for others to enjoy the fruits of creative activities, including not only the performing artists but also publishers, manufacturers of phonograms, producers of motion pictures, broadcasters, theatrical enterprises, concert agents, museums, libraries, archives and the like. Includes an extensive bibliography.

NEWS BRIEFS

40. OLD CONTRACTS AND PERSONAL DOCUMENTS GIVEN TO THE LIBRARY OF CONGRESS.

The following interesting announcement appeared in the *Library of Congress Information Bulletin* of November 9, 1964, reported by William Lichtenwanger:

Photocopies of business and personal documents relating to important musical figures of the 20th century have recently been received in the Library (Music Division) by transfer from the Office of Alien Property, Department of Justice, through the kind services of a former specialist in that Office, dramatist George Middleton. These supplement a similar group of 25 items given to the Music Division earlier.

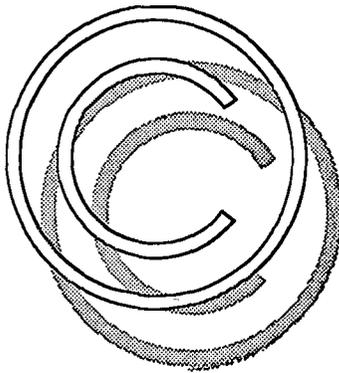
Among the documents are copies (accompanied by English translations) of the lengthy contracts between Richard Strauss and his Berlin publisher, Adolph Fürstner, detailing royalties as well as publication, performance, mechanical reproduction, and other rights to the early Strauss operas "Salome," "Elektra," and (as the translator would have it) "Ox of Lerchenau," the last being the original title of "Der Rosenkavalier." A "Supplementary Agreement" reflecting the technological advances of the years between the wars is dated March 31, 1935, and extends the existing contracts for "Arabella" and other Strauss works to cover all manner of sound and visual reproduction, including "Televisions-Rechte" plus any new forms of reproduction that might be devised in the future. Of a still later date, and reflecting the impact of World War II, is a "Consent" ("as far as such consent is required") to the 1943 assign-

ment of Fürstner's rights in Strauss works to the London firm of Boosey & Hawkes.

Most interesting among the Strauss material, however, are copies of four letters written by the composer. One is an unsigned transcript (source not disclosed) of the curiously brash and not entirely sympathetic letter that Strauss wrote to his librettist, Stefan Zweig, the famous novelist, on June 17, 1935, just a week before the première of their "The Silent Woman" in Dresden. It was intercepted by the Gestapo and led to Strauss' forced resignation from the post of "Reichsmusikkammer-Präsident" and to his "Memorandum" of July 10, 1935, regarding his views on politics and art. The other three letters, received by the Library in the form of photostats of the originals in Strauss' handwriting, are addressed to Walter Thomas, whose book "Bis der Vorhang fiel" (Dortmund, 1947) gives many insights into the lives of musicians and other artists during the surge and ebb of the Nazi tide. English translations of pertinent extracts in regard to Strauss are supplied. These letters seem to be little known and may well be unpublished. Although they contain nothing of a startling nature, they do provide a pathetic picture of a Strauss in his 80th year who despises the common man, feels himself persecuted by those in power, and in the autumn after the fall of Stalingrad dares hope that his gardener can be released from military service for the winter.

There are other interesting items among the 20-odd documents that do not concern Richard Strauss. They range from the 1908 contract covering the American rights for "The Chocolate Soldier" (by Oscar Straus) to a 1950 letter from the Office of Alien Property to the French Société des Auteurs & Compositeurs Dramatiques that incidentally demonstrates the scrupulous and extensive care given by the Office of Alien Property to the copyright interests of French nationals during and after World War II. One contract relates to the English-language rights for the United States on Marcel Proust's series of novels, *À la recherche du temps perdu*; this document will be available to investigators in the Manuscript Division rather than in the Music Division.

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COPYRIGHT LAW REVISION

Announcement from the Copyright Office

Part 4—Further Discussions and Comments on the Preliminary Draft for Revised U. S. Copyright Law

This is the fourth of a series issued by the House Committee on the Judiciary. It completes the documentation of the proposals and discussions on copyright law revision preceding the introduction of a revision bill (H. R. 11947, S. 3008) on July 20, 1964. It contains a full transcript of the last four of eight meetings convened by the Register of Copyrights during 1963 and 1964, and comments submitted, on sections of a Preliminary Draft for a new copyright law prepared by the Copyright Office in 1963.

Copies are available from the Superintendent of Documents, U. S. Government Printing Office, Washington, D. C. 20402, at \$1.25.



A limited supply of the three earlier volumes in this series is still available from the Superintendent of Documents as follows:

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PART I.

ARTICLES

41. COPYRIGHT PROTECTION AND COMMUNITY
ANTENNA TELEVISION SYSTEMS

By DAVID EPSTEIN*

BACKGROUND

In 1959 the Federal Communications Commission (FCC) conducted an inquiry into the impact of four "auxiliary services" upon existing or potential regular television broadcast stations.¹ These "auxiliary services" included "satellites," translators, VHF repeaters, and community antenna television systems (CATV's). CATV's receive, either by off-air pick-up or microwave facilities,² and distribute television broadcast signals of stations located both nearby and at a distance by cable on a subscription basis. The other systems disseminate their signals through the air waves for free reception by the viewing public. CATV systems, which are generally business enterprises conducted for profit, obtain revenue by charging subscribers a fee.

In two recent cases suit was brought under state law by originating television stations and local television stations who rebroadcast the original stations' programs to prohibit CATV's from transmitting the programs without the stations' consent. In these cases the question of copyright infringement was not the central issue. In *Intermountain Broadcasting and Television Corporation v. Idaho Microwave, Inc.*,³ three originating television stations sought to enjoin reception and transmission of their signals by microwave to a CATV. The signals had been

* Member of the District of Columbia Bar.

1. See In the Matter of Inquiry Into the Impact of Community Antenna Systems, TV Translators, TV "Satellite" Stations, and TV "Repeaters" on the Orderly Development of Television Broadcasting, Docket No. 12443, Report and Order No. FCC 59-292, 24 Fed. Reg. 3004, 18 Pike & Fischer Radio Reg. 1573 (1959).
2. A point-to-point microwave radio service is defined as a "domestic public radio service rendered . . . by fixed stations between points which lie within the United States or between points in its possessions or to points in Canada or Mexico." 47 C.F.R. §21.1 (Supp. 1963).
3. 196 F.Supp. 315 (S.D., Idaho 1961).

intended for a local television station under contracts for non-exclusive rebroadcast rights. The court held there was no quasi-property right involved in the instant situation because the rebroadcast contracts with the television station granted no exclusive right. Soon after, *Cable Vision, Inc. v. KUTZ, Inc.*⁴ was decided by the same judge. This time the local television station was a party to the action and alleged unfair competition and tortious interference with contractual relations. It relied on a contractual right of "first call" on network programs in the local area and argued that this right created exclusivity sufficient to constitute a quasi-property interest. The court held that the contracts were exclusive, thus giving a defensible quasi-property right.

However, on appeal before the United States Court of Appeals for the Ninth Circuit the *Cable Vision* case was reversed.⁵ The court held that the companion cases of *Sears Roebuck & Co. v. Stiffel Co.*⁶ and *Compco Corporation v. Day Brite Lighting, Inc.*⁷ were controlling. In the *Stiffel* case the Supreme Court held that because of the federal patent laws a state may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying. In *Compco* the Court reasoned that "to forbid copying would interfere with the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."⁸ The public domain was broadly delineated in *Stiffel*: that which is either not copyrighted, not copyrightable or on which the copyright has expired. In *Compco*, however, the Court recognized that valid areas of state law remained operative as long as consistent with the paramount federal interest. The Court pointed out that state law, statutory or decisional, may in appropriate circumstances grant relief where deceptive or fraudulent practices are shown, such as in passing off one's goods as those of another or in labeling of goods. In reaching its holding the court in *Cable Vision* relied on subsequent state court cases in which *Compco* and *Stiffel* were interpreted as including an action based on common law copyright within the ambit of state protection.⁹ In these cases the courts' rationale was based on the reasoning in *Compco* that free access should be allowed to whatever the copyright laws leave in the public domain and on the reference in *Sears* to Section 2 of the

4. 211 F.Supp. 47 (D. Idaho 1962).

5. 335 F.2d 348 (9th Cir. 1964).

6. 376 U.S. 225 (1964).

7. 376 U.S. 234 (1964).

8. 376 U.S. at 237.

9. See *Edgar H. Woods Associates v. Skene*, 197 N.E.2d 886 (1964); *CBS v. Documentaries Unlimited, Inc.*, 42 Misc.2d 723, 248 N.Y.S.2d 809 (1964).

Copyright Act which preserves common law copyright. Thus *Compco* and *Sears* were regarded as recognizing that common law copyright might exist in unpublished material which had not become a part of the public domain. On the basis of these holdings the court in *Cable Vision* concluded that recovery could be based either on the common law action of unfair competition where "passing off" existed or on common law copyright. The court found that the enjoined activity lacked the element of "passing off" and that property rights had not been created by the mere expedient of an exclusive contract. The appellees conceded that copyright infringement was not in issue in the present proceeding. However, the court determined that appellees might be able to maintain an action for infringement of those programs protected by statutory copyright and to prosecute a claim for common law copyright violation as to any others which they contend have not been "published" within the contemplation of common law copyright.

In a Montana case, *Z Bar Net, Inc. v. Helena Television, Inc.*,¹⁰ the question of copyright infringement was part of the cause of action. The plaintiffs were the owners of the originating station and sued for copyright infringement and interference with its alleged property rights. The local television station had at times rebroadcast programs broadcast on plaintiff's stations and plaintiff had consented to such rebroadcasting upon the condition that the local television station obtain the consent of others, where such consent was required. The court held that plaintiff had no property interest, by copyright or otherwise, in any signals or programs received on defendant's CATV system and that by broadcasting the programs on the station and by consenting to their rebroadcast on another station, the station had intentionally made them public under Montana statute. The question of whether the original broadcasts amount to a general publication will be discussed in a separate topic.

TOPICS TO BE DISCUSSED

The neighboring rights problems in issue in these recent cases will not be treated in this paper except insofar as they may have bearing on copyright problems in this area. Instead, this paper will focus on three main areas: (1) whether CATV operation constitutes a copyright infringement of television programs which are transmitted to its subscribers; (2) whether original broadcasts amount to a publication sufficient to destroy such copyrights before the program ever reaches CATV; and (3) statutory and common law rights of broadcasters in program

10. 125 U.S.P.Q. 595 (1960).

material. Also, the legislative and judicial action taken in this area will be discussed and analysed.

PERFORMANCE

At the outset a determination must be made as to whether the service rendered by the CATV operation is a "reproduction" or performance sufficient to constitute a copyright infringement, either statutory or common law. The principle case which determined this question in the area of radio transmission is *Buck v. Jewell-La Salle Realty Company*.¹¹ In that case the question certified to the Court was:

Do the acts of a hotel proprietor, in making available to his guests, through the instrumentality of a radio receiving set and loudspeakers installed in his hotel and under his control and for the entertainment of his guests, the hearing of a copyrighted musical composition which has been broadcast from a radio transmitting station, constitute a performance of such composition within the meaning of 17 U.S.C. Sec. 1 (e) ?¹²

The defendant contended that there was no performance because the reception of a radio broadcast is no different from listening to a distant rendition of the same program. The Court disposed of this argument by stating that the reception of a radio broadcast and its translation into audible sound is not a mere audition of the original program, but essentially a reproduction.¹³ The Court reasoned that radio waves are not audible and that a receiving set is required for their detection and translation into audible sound waves.¹⁴ The Court held that the acts of the hotel in (1) installing, (2) supplying electric current to, and (3) operating the radio receiving set and loud speakers enabled the guests of the hotel to hear a reproduction and that the amplifying devices on the ordinary set were more than the use of mere mechanical acoustic devices for the better hearing of the original program.¹⁵

By analogy it has been reasoned that the reception of a television program should be governed by the *Buck* principle making the owner of the set liable for a "public performance for profit" in a suit for statu-

11. 283 U.S. 191 (1931).

12. *Id.* at 195, 196.

13. *Id.* at 200.

14. *Id.* at 200-201.

15. *Id.* at 201.

tory copyright infringement.¹⁶ CATV operators have attempted to distinguish their situation from the *Buck* case, arguing that unlike a hotel a CATV system neither owns nor controls the receiving sets, and that it is a reception service only, which does not select the programs to be seen and therefore does not "reproduce" anything. The CATV operators have urged that a CATV "merely furnishes an attachment to a television receiving set which enables a set disadvantageously located to operate like an ordinary set."¹⁷

In spite of the distinctions which exist between the CATV operation and radio reception, the *Buck* principle could no doubt be applied to CATV. The extension of the *Buck* holding in subsequent cases involving different factual situations demonstrates the flexibility of the rule. In *Society of European Stage Authors and Composers, Inc. v. New York Hotel Statler Co.*,¹⁸ the facts differed in some respects from the *Buck* case. The defendant hotel transmitted two different stations to the individual loudspeakers which were located only in the guests' rooms. The determination of which station was to be heard was determined by loudspeaker controls operated by the guest rather than by the hotel. In the *Buck* case the hotel operated the radio receiving set and loudspeaker. The defendant argued in the *Statler* case that control of the loudspeaker by the guest negated the contention that there is a performance by the hotel when a guest turns on the loudspeaker in his room. The court dismissed defendant's contention and stated that it was more than the last step of turning on the loudspeaker which constituted the performance.¹⁹ It held that the reception of a broadcast program by one who listens to it is not any part of the performance thereof.²⁰ The court reasoned that when the owner of a hotel does as much as was done in this case to promote the reproduction and transmission of a broadcast program received by it, it must be considered as giving a performance within the principle laid down in *Buck*.²¹

The same reasoning could be applied in CATV operation. Although it is the subscriber who "flicks the switch", it is the CATV operator who controls the antenna system by which the television broadcast sig-

16. Solinger, "Unauthorized Uses of Television Broadcasts," 48 Colum. L.Rev. 848, 852-3 (1948).

17. Comments in opposition to Proposed Rule Making by National Community Television Association (NCTA), p. 16, FCC Docket No. 14895 (Dec. 14, 1962).

18. 19 F.Supp. 1 (S.D.N.Y. 1937).

19. *Id.* at 4.

20. *Ibid.*

21. *Id.* at 4-5.

nals are received and redistributed by wire or cable to the subscriber's set. It does not appear that the Court in the *Buck* case intended to restrict the performance theory to the party who actually performed the final act of converting the electrical impulses into sound and light waves. Instead the Court implied that the party which had under its control the instrumentalities responsible for the transmission and reception of the radio broadcast would be held to have rendered the performance thereof.²² The *Statler* case represents the logical extension of the *Buck* ruling in holding that the performance was more than the last act of turning on the speaker and that the listener was not any part of the performance of the broadcast program. The same rationale would apply in CATV operation where the CATV operator controls the instrumentalities by which the television broadcast signals are retransmitted and relayed to the subscriber's set, and the subscriber only provides the last step of turning on the set.

PUBLICATION

Another major determination is whether performance over the air constitutes a general publication. In *Uproar Co. v. NBC*,²³ the general rule was first set forth that a radio performance did not constitute an abandonment of ownership by the proprietors or a dedication of it to the public. This theory was adopted from the rule enunciated in *Ferris v. Frohman*,²⁴ that performance does not constitute publication. Performance of a motion picture has also been held not to constitute a publication which would deprive the creator of his common law copyright.²⁵ Similarly, the broadcast of a television program containing original literary material has been regarded as not destroying the common law copyright in the material.²⁶

Since *Erie Railroad Co. v. Tompkins*,²⁷ state courts are no longer bound by the rule in the *Uproar* case. Several state courts have relied on state copyright statutes in reaching the conclusion that a radio broadcast and an original broadcast transmitted over CATV constituted a general publication. In *Blanc v. Lantz*,²⁸ a California court construing the California Civil Code copyright statute held that the rendition of

22. 283 U.S. at 201.

23. 8 F.Supp. 358 (D. Mass. 1934), *aff'd as modified*, 81 F.2d 373 (1st Cir. 1936), *cert. denied*, 298 U.S. 670 (1936).

24. 223 U.S. 424 (1912).

25. *Patterson v. Century Products, Inc.*, 93 F.2d 489 (2d Cir. 1937).

26. See Solinger, *supra*, note 23, at 854.

27. 304 U.S. 64 (1938).

28. 83 U.S.P.Q. 137 (Cal. Sup. Ct. 1949).

the Woody Woodpecker musical laugh in a radio broadcast extinguished the plaintiff's common law copyright in the laugh. In *Z Bar Net, Inc. v. Helena Television, Inc.*,²⁹ a Montana court held the plaintiff, in broadcasting television programs which were received on defendant's CATV system, to have intentionally made them public under Montana statute. The state statutes in the *Blanc* and *Z Bar Net* cases were the same:

If the owner of a product of the mind intentionally makes it public, a copy or reproduction may be made public by any person without responsibility to the owner, so far as the law of this state is concerned.³⁰

Although these cases solidly depart from the ruling in *Uproar*, they are unclear in their holdings and constitute an unreliable body of opinion. First, the *Blanc* case did not discuss the radio cases which hold that a broadcast performance is not a general publication. Moreover, the *Blanc* case represented a repudiation of the doctrine set forth in *Stanley v. CBS*,³¹ wherein the court ruled that under the same California copyright statute an audition recording made by plaintiff over a microphone in defendant's studio amounted to a limited publication and did not render the work "public property".

The *Z Bar Net* case also constitutes questionable authority. The sparse opinion in that case fails to provide a clear basis for the holding that plaintiff had intentionally made its broadcasts public within the meaning of the statute. In reaching this conclusion the court stressed that in addition to broadcasting its programs over its own station, the originating station had also consented to the rebroadcasting of such programs by a local television station located in the same community as the defendant CATV company. The plaintiff had consented to such rebroadcasting on the condition that the local television station obtain the consent of others, where such consent was required. It is possible that part of the basis of the holding that the broadcast constituted an "intentional" abandonment was the originating station's consent to the rebroadcast of its programs over the local station, and that in the absence of this factor the court would not have ruled that a broadcast alone constituted a general publication. Nonetheless, the holding of the case represents a clear departure from the *Uproar* ruling.

29. 125 U.S.P.Q. 595 (1960). See page 149.

30. Cal. Civil Code §983 (1941), Rev. Code Montana §67-1107 (1947).

31. 208 F.2d 9 (Cal. 1949).

Besides the *Stanley* case other state court cases have held that broadcasting constitutes a limited performance.³² Aside from the several cases mentioned which have held that broadcasting constitutes a general publication the rule of the *Uproar* case is still imbedded in the law today. It does not appear that those courts which follow the *Uproar* case would have any difficulty in applying the rule to CATV as well as to broadcasting. Thus, the *Z Bar Net* case will constitute good law only in those jurisdictions which do not follow the *Uproar* case.

STATUTORY AND COMMON LAW PROTECTION

Statutory Copyright

As previously mentioned, the *Buck* case established that radio broadcasting constitutes a performance within the meaning of Section 1 (e) of the Act. In this case and the *Statler* case, hotel owners were held to have violated the "public performance for profit" provision of this section for the benefit of their guests. Likewise, in the area of television, the owner of a receiving set, by showing a program in a hotel, restaurant, private auditorium or theatre, has been included as a possible infringer under this provision.³³

In the area of CATV, liability under the "public performance for profit" provision of Section 1 (e) could extend to the CATV company down to the individual subscriber. Liability on the part of the CATV company would be based on the principles of the *Buck* and *Statler* cases that the instrumentality primarily responsible for the transmission and reception of the performance should be held responsible for the infringement. Also, there would be no difficulty in establishing an operation for profit. Liability on the part of the individual CATV subscriber would depend on whether he could be held to have rendered a "public performance for profit" as in the case of a tavern owner or hotel proprietor, etc. In most situations an ordinary "private home" subscriber would not appear to come within the meaning of "public performance for profit". In a Canadian case,³⁴ CATV wire communications, to the extent that they included private homes, were held not to be a "performance in public" within the Canadian Copyright Act. However, to the extent that public places of business were included, the wire com-

32. *Twentieth Century Sporting Club, Inc. v. Transradio Press Service, Inc.*, 165 Misc. 71, 300 N.Y.Supp. 159 (Sup. Ct. 1937); *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 Atl. 631 (1937).

33. See Solinger, *supra*, note 23, at 858.

34. *Canadian Admiral Corporation v. Rediffusion, Inc.*, 20 Can. Exch. 382 (1954).

munications were held to constitute a "performance in public" within that Act. Unlike our Copyright Act the Canadian statute had abolished common law copyright and required "performance in public" to constitute infringement.

Aside from the protection afforded musical compositions under Section 1(e), the provisions of Section 1(c) confer upon the copyright holder the exclusive right to perform "in public for profit" a lecture, sermon, address or similar production, or other non-dramatic literary work. Also, under Section 1(d) any public performance of a dramatic work is an infringement. Although the reported cases appear to deal exclusively with musical compositions under Section 1(e), there is no reason why the "public performance" of these other works would not be entitled to similar protection.³⁵ Under a regulation of the Copyright Office television scripts can be copyrighted.³⁶ Their protection falls under subsections (b) or (d) which give the owner ". . . the exclusive right; . . . to exhibit, perform, represent, produce or reproduce and in any manner or by any method whatsoever. . . ."

Common Law Copyright

Section 2 of the Act preserves common law copyright. This protection would extend to a television program containing original literary material which has not been copyrighted under the statute. Television broadcasters rely heavily on common law copyright to protect the content of their material. The great bulk of live television programs which are presented only once are not copyrighted. As to these programs, common law copyright affords adequate protection.³⁷ Also, the literary materials in programs of an impromptu nature, such as forums, quiz-shows, etc., receive the protection of common law copyright.³⁸ This protection does not extend to programs which consist solely of live material in the public domain or of a news event.³⁹ However, even with respect to this material, there may be an absolute property right in the television broadcast itself.⁴⁰ This theory is based on the holding in *Ketcham v. New York World's Fair 1939, Inc.*,⁴¹ wherein the court stated that "an

35. See Solinger, *supra*, note 23, at 853.

36. 37 C.F.R. §202.4 (1952).

37. See Warner, "Protection of the Content of Radio and Television Programs by Common Law Copyright," 3 Vand. L.Rev. 209, 210 (1950).

38. See Solinger, *supra*, note 23, at 855.

39. *Ibid.*

40. *Id.* at 856.

41. 34 F.Supp. 657, 658 (E.D.N.Y. 1940).

individual has a property right in his original, unpublished, intellectual productions.”

FUTURE LITIGATION

As a result of the *Stiffel* case, suits in this area will be based to a large extent on statutory and common law copyright rather than on property rights concepts. As previously mentioned, under *Stiffel* suits based on property rights concepts will be limited to certain areas of state law such as the common law action of unfair competition where the element of “passing off” has been found to exist. The difficulty of proving the existence of “passing off” and the restrictions placed in *Stiffel* on quasi-property right concepts will force plaintiffs to seek relief on statutory and common law copyright grounds. Action based on common law copyright would be precluded in states which follow the holding of the *Z Bar Net* case that broadcasting constitutes a general publication. Under the *Erie* doctrine state cases could produce inconsistent results with some courts following the *Z Bar Net* holding and others the *Uproar* case.

Where copyright infringement is alleged, either statutory or common law, courts may inquire into whether the plaintiff is the copyright holder or someone holding the exclusive right to such protection of the program contents broadcast over its station. As the Court of Appeals recognized in *Cable Vision*, the copyright owner is an indispensable party to the enforcement of a copyright claim. However, the court added that while the exclusive licensee could not maintain the action alone, he might do so if the copyright owner were joined. In such cases the local station could claim protection in the content of locally originated programs as well as in programs rebroadcast from other stations.

PROPOSED LEGISLATION

The proposed Bill for the revision of the Copyright Law was recently introduced in the Congress.⁴² Under Section 5(a) of the proposed Bill the owner of a copyright has the exclusive right to perform or exhibit a copyrighted work publicly. Under Section 5(b)(3) to perform or exhibit a work “publicly” means the following:

- (A) to perform or exhibit it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered;

42. S. 3008, 88th Cong., 2d Sess. (1964), H.R. 11947, 88th Cong., 2d Sess. (1964).

- (B) to broadcast a performance or exhibition of the work to the public, or to transmit to the public a broadcast of any performance or exhibition otherwise than as a common carrier;
- (C) to communicate a performance or exhibition of the work to the public by means of any device or process.

Section 13 proposes two limitations on the provisions of Section 5 which do not constitute infringements on the exclusive right to perform or exhibit a copyrighted work. These are the following:

- (1) communication of a broadcast embodying a performance or exhibition of the work to the private rooms of a public establishment by means of a system of loudspeakers or other devices. . . .
- (2) reception of a broadcast embodying a performance or exhibition of the work on a single receiving apparatus of a kind commonly used in private homes. . . .

Under Section 5(b)(3)(B) the broadcast of a performance and the transmission of a broadcast of a performance are treated separately. The use of *transmission*, as distinguished from broadcasts, indicates that systems such as CATV were meant to be included within the scope of this subsection. The panel discussions held on the general revision of the Copyright Law between representatives of the Copyright Office and of various private organizations reveal that "transmission"⁴³ was used to refer to "something beyond the initial broadcast transmission."⁴⁴ The discussions specifically relating to the inclusion of CATV within the scope of the proposed Bill were held in connection with proposed Section 13.⁴⁵ Some attempt was made to exclude CATV on the ground that it could not be distinguished from other systems, such as boosters, relays, and cooperative antenna systems (master antennas on apartment house roofs), which are outside the scope of protection in the proposed Bill. However, the Copyright Office and others present took the position that these systems were unrelated to CATV inasmuch as CATV is operated for profit and the other systems are either installed for the public's benefit or, as in the case of cooperative antenna systems, incidental to another operation.

43. "Retransmitted" was used in the original preliminary draft.

44. Committee on the Judiciary, COPYRIGHT LAW REVISION PART 3, PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW AND DISCUSSIONS AND COMMENTS ON THE DRAFT 138 (September, 1964).

45. *Id.* at 240.

The main hope for statutory protection in this area lies in the passage of the proposed Copyright Bill pending before Congress. As previously mentioned, under the provisions of the proposed Bill copyright protection extends to transmission of broadcasts via CATV. Common law protection in this area will depend on whether or not courts in state actions conclude that broadcasting constitutes a general publication.

Since the *Stiffel* case has been interpreted as preserving common law copyright, it is not believed that this case will have a limiting effect in affording copyright protection in this area. In fact, it is likely that the *Stiffel* case will result in an increase in suits based on statutory and common law copyright in view of the restrictions placed in that case on property right and quasi-property right concepts as grounds for relief.

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

I. UNITED STATES OF AMERICA AND TERRITORIES

42. U. S. CONGRESS. HOUSE.

H.R. 4347. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. Celler, February 4, 1965, and referred to the Committee on the Judiciary. 39 p. (89th Cong., 1st Sess.). An identical bill, S. 1006, was introduced in the Senate.

The Register of Copyrights expects to issue a comprehensive report to the Congress on the new bill and the changes which have been embodied as compared with the previous Celler and McClellan bills, H.R. 11947 and S. 3008, 88th Cong., 2d Sess., July 20, 1964. (See 11 BULL. CR. SOC. 410, Item 276, August 1964.) In the meantime, the Copyright Office has issued a circular indicating the following "highlights" of the new bill:

Single national system. Instead of the present dual system of protecting works under the common law before they are published and under the Federal statute after publication, the bill would establish a single system of statutory protection for all works whether published or unpublished.

Duration of term. The present term of copyright is 28 years from first publication or registration, renewable by certain persons for a second period of 28 years. The bill provides for a term of the author's life plus 50 years, in order to bring it into line with the copyright term in most countries. For anonymous works and works made for hire, the term would be 75 years from publication, with a maximum limit of 100 years from creation of the work. The life-plus-50 or the 100-year term would apply to unpublished works, which are now protected under the common law without time limit.

Limitation on author's assignments. Under the present law, the renewal copyright after the first term of 28 years reverts in certain situations to the author or other specified

beneficiaries. The bill drops this renewal device, but permits the author or his widow and children to terminate a grant of his rights after 35 years (or up to 40 years in certain situations) by serving written notice on the grantee. Grantees who have made derivative works during the 35 years could continue to use them.

Sound recordings. Sound recordings would be added to the list of protected works, but the exclusive rights would be limited to protection against actual duplication and the sale of "dubbed" records.

Government publications. The revised bill continues the prohibition in the present law against copyright in "Government publications" and provides for no exceptions, but it attempts to clarify the scope of the prohibition.

Fair use. The bill would add a provision to the statute specifically recognizing the doctrine of fair use, but without any attempt to indicate the application or define the scope of the doctrine.

Compulsory license. The bill would modify the present compulsory license for the recording of music. It would, among other things, increase the statutory royalty ceiling and provide a broader recovery against infringers.

Exempt performances. The bill removes the present exemption of public performances of nondramatic literary and musical works where the performance is not "for profit." Instead, it provides specific exemptions for certain types of nonprofit uses, including performances in classrooms and "in-school" educational broadcasting. The revised bill would give broadcasting organizations a limited privilege of making "ephemeral recordings" of their broadcasts.

Jukebox exemption. The bill includes the text of the jukebox bill which was favorably reported by the Judiciary Committee of the House of Representatives in 1963 and has been reintroduced in the 89th Congress. It would repeal the present exemption of jukebox operators from payment of performance royalties.

Notice of copyright. The statute now requires, as a condition of copyright protection, that the published copies of a work bear a copyright notice. The bill calls for a notice on published copies, but omission or errors would not forfeit the

copyright. Innocent infringers misled by the omission or error would be shielded from liability.

Registration. As under the present law, registration would not be a condition of copyright protection but would be a prerequisite to an infringement suit. In general, the extraordinary remedies of statutory damages and attorney's fees would not be available for infringements occurring before registration.

Manufacturing clause. Certain works must now be manufactured in the United States to have copyright protection here. The bill proposes several modifications that would narrow the scope of this clause and would permit the importation of 3,500 copies manufactured abroad instead of the present limit of 1,500 copies.

43. U. S. CONGRESS. HOUSE.

H.R. 18. A bill to amend the Copyright Act by repealing the jukebox exemption, and for other purposes. Introduced by Mr. Celler, January 4, 1965, and referred to the Committee on the Judiciary. 2 p. (89th Cong., 1st sess.)

Identical with H.R. 7194 and H.R. 8457 introduced during the 88th Congress, with the exception that the effective date has been changed to January 1, 1967.

44. U. S. CONGRESS. HOUSE.

H.R. 94. A bill to amend title 17 of the United States Code, "Copyrights", to bar actions for infringement of copyright in certain instances, and for other purposes. Introduced by Mr. Lindsay, January 4, 1965, and referred to the Committee on the Judiciary. 2 p. (89th Cong., 1st sess.)

This bill would amend the copyright statute by adding a new section at the end of chapter 2 which would bar any action for copyright infringement with respect to sound reproductions made for use by the blind or quadriplegic residents of the United States. Identical with H.R. 6745, 88th Cong., 1st Sess. (1963). See 10 BULL. CR. SOC. 325, Item 328 (1963).

45. U. S. CONGRESS. HOUSE.

H.R. 450. A bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such

designs for a limited time against unauthorized copying. Introduced by Mr. Ford, January 4, 1965, and referred to the Committee on the Judiciary. 27 p. (89th Cong., 1st sess.)

A reintroduction, by Mr. Ford, of H.R. 769, 88th Cong., 1st Sess. (1963). A companion bill, S. 776, was passed by the Senate on December 6, 1963, but no further action was taken.

46. U. S. CONGRESS. HOUSE.

H.R. 2793. A bill to amend the Copyright Act by repealing the jukebox exemption, and for other purposes. Introduced by Mr. Corman, January 14, 1965, and referred to the Committee on the Judiciary. 2 p. (89th Cong., 1st sess.)

Identical with H.R. 18, introduced by Mr. Celler during the present session. See Item 43 *supra*.

47. U. S. CONGRESS. HOUSE.

H.R. 2853. A bill to amend title 17, United States Code, with relation to fees to be charged. Introduced by Mr. Steed, January 14, 1965, and referred to the Committee on the Judiciary. 3 p. (89th Cong., 1st sess.)

Identical with H.R. 5136, 88th Cong., 1st Sess. (1963), except that the instant bill provides for an increase in the fee for registration of a renewal claim to \$4.00 instead of \$6.00 as was proposed by the previous bill.

2. FOREIGN NATIONS

48. GREAT BRITAIN. *Laws, statutes, etc.*

The Copyright (International Conventions) (Amendment) Order, 1964, no. 1194 of July 27, 1964, coming into force on August 14, 1964. (77 *Le Droit d'Auteur* [English inset] 184-185, no. 11, Nov. 1964.)

Also appears in French in the main section of the same issue of *Le Droit d'Auteur*.

"This Order amends the Copyright (International Conventions) Order 1964 to take account of the accession of Czechoslovakia to the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations.

"It extends the copyright in sound recordings originating in Czechoslovakia to include the exclusive right of public performance and broadcasting and affords Czech broadcasting organisations copyright protection in respect of their sound and television broadcasts.

"The change in relation to sound recordings extends to dependent countries of the Commonwealth where the Copyright Act 1956 is law."

49. NORWAY. *Laws, statutes, etc.*

Royal decree of April 10, 1964, coming into force on May 1, 1964. (77 *Le Droit d'Auteur* [English inset] 166-167, no. 10, Oct. 1964.)

Also appears in French in the main section of the same issue of *Le Droit d'Auteur*.

A decree extending the provisions of the Norwegian copyright law to nationals of member states of the Berne and Universal Copyright Conventions.

50. UGANDA. *Laws, statutes, etc.*

Copyright Act 1964, of June 22, 1964. (77 *Le Droit d'Auteur* [English inset] 180-184, no. 11, Nov. 1964.)

Also appears in French in the main section of the same issue of *Le Droit d'Auteur*.

The new copyright law of Uganda which replaces the Copyright Act 1956 of the United Kingdom in so far as it forms part of the laws of Uganda. The present Act will become effective on a date to be designated by a statutory instrument.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

51. INTERGOVERNMENTAL COPYRIGHT COMMITTEE. *7th Session, New Delhi, Dec. 2-7, 1963.*

Records. (17 *UNESCO Copyright Bulletin*, 9-28; 75-95; 149-169. 1964.)

Contents: Report. Resolutions. List of participants.

The records, in English, French and Spanish, of the seventh session of the I.G.C.C. held jointly with the eleventh session of the Permanent Committee of the Berne Union.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

52. *Cranford v. United States*, 143 U.S.P.Q. 313 (U.S. Ct. Cl., Nov. 13, 1964) (Jones, J.)

Action to recover overpayment of tax. The creator of the idea and format of the radio show "Take It or Leave It" received a share of the licensing fees paid by the producers of "The \$64,000 Question," a television show based on "Take It or Leave It". He paid tax on the \$7,500 he so received on the basis that it was ordinary income, and now seeks to recover part of the tax paid on the basis that the payments in question actually represented a capital gain.

Held, petition dismissed.

Plaintiff argued that a format is a kind of property different from a copyright and therefore does not fall under the provisions of §1221(3) of the Internal Revenue Code of 1954, which section excludes copyrights "or similar property" in the hands of the creator of a work from the Code's definition of "Capital asset". The court held, however, that a format, although not subject to copyright (plaintiff's attempt to secure registration in 1939 had been unsuccessful), was nevertheless "similar property" for the purposes of the section, and that the money received by plaintiff, therefore, could not be a capital gain. The court said:

We find it unnecessary to decide the question of whether plaintiff's format is or is not "property" because we are of the opinion that plaintiff's idea is within the definition of the term "similar property" in §1221(3) of the 1954 Code.

. . . . The legislative history of this provision shows that the Congress intended to close a loophole with respect to capital gain treatment. . . . The Committee Reports for the Revenue Act of 1950 show that the Congress intended to provide uniform ordinary income treatment for the sale of a product created by personal effort. . . . To escape the application of §1221(3) of the 1954 Code,

plaintiff contends . . . that the term "similar property" as used in §1221 (3) means property *similar to those specifically named* which are all property eligible for copyright protection. . . . Obviously, this language does not limit the "similar property" to those already enumerated or there would be no reason to add this category at all. We believe that the limitation is disclosed by the adjective "similar". In other words, properties having important characteristics common to those named items are "similar property" within the meaning of the statute. . . . It seems to us that the important point common to the specified categories [a copyright, a literary, musical or artistic composition] aside from their artistic nature, is that they are all products of personal effort. Plaintiff has not shown us any reason why copyrightable property should be singled out and be denied capital gain treatment while products of personal effort which are not subject to copyright should enjoy a tax advantage. . . . [W]e conclude that all types of artistic works which are products of personal effort and skill are excluded from the definition of a capital asset, by virtue of the term "similar property," unless specifically excepted. It is beyond dispute that a radio program itself is within the definition of a "similar property." We see no relevant distinction between a radio program and a format for the radio program for the purpose of a definition of a "similar property." Accordingly, we conclude that plaintiff's format is not a capital asset.

53. *T. B. Harms Company v. Eliscu*, 339 F.2d 823, 144 U.S.P.Q. 46 (2d Cir., Dec. 23, 1964). *For decision below, see* 227 F.2d 337, 141 U.S.P.Q. 11, 11 BULL. CR. SOC. 341, Item No. 214.

Appeal from order granting defendant's motion to dismiss complaint in action for copyright infringement. Vincent Youmans, Gus Kahn and defendant Edward Eliscu wrote four songs in 1933 for the movie "Flying Down to Rio". Plaintiff asserts, and defendants deny, that Eliscu entered into an agreement in 1933 assigning his rights to the existing and renewal copyrights to plaintiff's predecessors in interest. In 1962, Eliscu assigned his interest in the renewal copyright to defendant Ross Jungnickel, Inc., subject to a judicial determination of his ownership. Thereafter Jungnickel advised ASCAP and the Harry Fox office of its interest in the songs. Defendant Eliscu began a state court action seeking an accounting and a declaratory judgment and plaintiff began this action. The court below granted the defendant's motion to dismiss the complaint on the ground that plaintiff's suit was, essentially, a contract action not arising under the copyright laws.

Held, affirmed.

The court fully agreed with the trial court that this was an action to determine ownership of an interest in copyrights which turned on contract law, rather than "arising under" the copyright laws and that, therefore, the federal courts did not have jurisdiction. The court said:

. . . [T]he jurisdictional statement does not speak in terms of infringement, and the undoubted truth that a claim for infringement "arises under" the Copyright Act does not establish that nothing else can. Simply as a matter of language, the statutory phrasing would not compel the conclusion that an action to determine who owns a copyright does not arise under the Copyright Act, which creates the federal copyright with an implied right to license and an explicit right to assign. But the gloss afforded by history and good sense leads to that conclusion as to the complaint in this case.

Although Chief Justice Marshall, construing the "arising under" language in the context of Article III of the Constitution, indicated in *Osborn v. Bank of the United States*, 22 U.S. (9 Wheat.) 738, 822-27 (1824), that the grant extended to every case in which federal law furnished a necessary ingredient of the claim even though this was antecedent and uncontested, the Supreme Court has long given a narrower meaning to the "arising under" language in statutes defining the jurisdiction of the lower federal courts. *Romero v. International Terminal Operating Co.* 358 U.S. 354, 379 n. 51 (1959); Mishkin, *The Federal "Question" in the District Courts*, 53 Colum. L. Rev. 157, 160-63 (1953). If the ingredient theory of Article III had been carried over to the general grant of federal question jurisdiction now contained in 28 U.S.C. Par. 1331, there would have been no basis—to take a well-known example—why federal courts should not have jurisdiction as to all disputes over the many western land titles originating in a federal patent, even though the controverted questions normally are of fact or of local land law. Quite sensibly, such extensive jurisdiction has been denied. *Shoshone Mining Co. v. Rutter*, 177 U.S. 505 (1900).

The cases dealing with statutory jurisdiction over patents and copyrights have taken the same conservative line. The problem apparently first reached the Supreme Court in *Wilson v. Sanford*, 51 U.S. (10 How.) 99 (1850), under the Act of July 4, 1836, Par. 17, 5 Stat. 17, which allowed appeal to the Court, irrespective of the amount, in actions "arising under" the patent laws. The suit aimed to prevent use of a patented invention by a licensee who allegedly had failed to comply with the terms of the license and thus had forfeited its rights. Chief Justice Taney, dismissing the appeal, held the statute inapplicable to a dispute as to license or contract rights

which “depended altogether upon the rules and principles of equity, and in no degree whatever upon any act of Congress concerning patent rights.” The same principle was applied, and sometimes stated less cautiously, in decisions construing later legislation granting the federal courts exclusive jurisdiction of all suits “arising under” the patent or copyright laws of the United States. Act of July 8, 1870, Paragraphs 55, 106, 16 Stat. 206, 215; Rev. Stat. Par. 629 Ninth and 711 Fifth (1875); Judicial Code of 1911, Par. 24 Seventh, 256 Fifth, 36 Stat. 1092, 1161. To take one of many examples, the Court said in *New Marshall Engine Co. v. Marshall Engine Co.*, 223 U.S. 473, 478 (1912):

“The Federal courts have exclusive jurisdiction of all cases arising under the patent laws, but not of all questions in which a patent may be the subject-matter of the controversy. For courts of a State may try questions of title, and may construe and enforce contracts relating to patents. *Wade v. Lawder*, 165 U.S. 624, 627.”

Just as with western land titles, the federal grant of a patent or copyright has not been thought to infuse with any national interest a dispute as to ownership or contractual enforcement turning on the facts or on ordinary principles of contract law. Indeed, the case for an unexpansive reading of the provision conferring exclusive jurisdiction with respect to patents and copyrights has been especially strong since expansion would entail depriving the state courts of any jurisdiction over matters having so little federal significance.

In an endeavor to explain precisely what suits arose under the Patent and Copyright Laws, Mr. Justice Holmes stated that “A suit arises under the law that creates the cause of action . . .” It has come to be realized that Mr. Justice Holmes’ formula is more useful for inclusion than for the exclusion for which it was intended. Even though the claim is created by state law, a case may “arise under” a law of the United States if the complaint discloses a need for determining the meaning or application of such a law.

. . . Mindful of the hazards of formulation in this treacherous area, we think that an action “arises under” the Copyright Act if and only if the complaint is for a remedy expressly granted by the Act, e.g., a suit for infringement or for the statutory royalties for record reproduction, 17 U.S.C. Par. 101, cf. *Joy Music, Inc. v. Seeco Records, Inc.*, 166 F. Supp. 549, 119 U.S.P.Q. 460 (S. D. N. Y. 1958), or asserts a claim requiring construction of the Act, as in *De Sylva*,

or, at the very least and perhaps more doubtfully, presents a case where a distinctive policy of the Act requires that federal principles control the disposition of the claim. The general interest that copyrights, like all other forms of property, should be enjoyed by their true owner is not enough to meet this last test.

54. *Williams, d.b.a. Trophy Center v. Kaag Manufacturers, Inc.*, 143 U.S.P.Q. 369 (9th Cir., Dec. 2, 1964) (Barnes, J.)

Appeal from judgment for defendant in action for copyright infringement. Plaintiff alleged that defendant was manufacturing and distributing a cowboy trophy copied from a similar trophy which defendant had previously manufactured for plaintiff, and in which plaintiff had secured copyright registration. The trial court held that the two trophies were not sufficiently similar to show copying.

Held, affirmed.

The court agreed with defendant's argument that "a Chinese copy" is not required to show infringement, *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 193 F.2d 162, but held that the trial court's finding of fact, that the two figures were not so similar as to show copying, was not "clearly erroneous" and therefore could not be disturbed on appeal. The court said:

We have commented frequently on the inappropriateness of substituting our judgment for that of the trial judge on questions of fact. The more vague the test, the less inclined are we to intervene. *Caddy-Imler Creations, Inc. v. Caddy*, 299 F.2d 79, 132 USPQ 384 (9th Cir. 1962).

. . . Appellant urges the court's finding that there was no deliberate copying by appellees of his cowboy figurine is "unrealistic," because access was proved. Access is important, and should be given due weight by the trier of fact, but is not decisive. To make proof of access the one controlling factor would eliminate the necessity for proof of any real identity or similarity. "Noteworthy" similarity must still be found. *Bradbury v. Columbia Broadcasting System, Inc.*, 287 F.2d 478, 128 USPQ 376 (9th Cir. 1961). Here it was not.

2. State Court Decisions

55. *Flamingo Telefilm Sales, Inc. v. United Artists Corp.*, 144 U.S.P.Q. 168 (N.Y. Sup., App. Div., 1st Dept., Nov. 19, 1964) (*per curiam*). For

decision below, see 141 U.S.P.Q. 461, 11 BULL. CR. SOC. 346, Item No. 217 (1964).

Appeal from denial of motion to dismiss complaint. Plaintiff, claiming it was exclusive licensee for television of a motion picture, charged that defendant distributed and exhibited a television program incorporating parts of this motion picture. On a motion to dismiss, the court rejected defendants' argument that the *Compco Corp. v. Day-Brite Lighting Co.*, 376 U.S. 234 and *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) cases prevented the application of state laws of unfair competition, holding that the acts of which defendant was accused constituted "appropriation of the thing itself" rather than "copying."

Held, reversed and complaint dismissed with leave to replead.

The court held that the complaint did not comply with the statutory procedural requirement that the "[s]tatements in a pleading shall be sufficiently particular to give the court and parties notice of the transactions, occurrences, or series of transactions or occurrences intended to be proved and the material elements of each cause of action . . ." CPLR §3013, in that the chains of title by which plaintiff claimed ownership of either common law copyright or of the artistic performances alleged to be appropriated were not shown. The court said:

. . . The plaintiff contends that it has "common law property rights" in a certain motion picture film; that the defendants "have illegally misappropriated" such rights in the matter of the telecast of segments of such film without plaintiff's consent. The plaintiff's alleged rights, according to its complaint, are grounded upon the alleged acquisition by it under a written agreement with a third person of the "sole and exclusive right, license and privilege to distribute, exhibit, license for subdistribution, lease and otherwise exploit" the motion picture "by means of television broadcasts thereof throughout the United States, Hawaii, and Porto Rico . . ." Of course, the nature and extent of the rights acquired by plaintiff by virtue of said alleged written agreement would depend upon the title and rights possessed by the licensor in the particular motion picture, but the complaint does not purport to show what they were, if any. The decisions of *Fisher v. Star Co.*, 231 N.Y. 414, and *International News Service v. Associated Press*, 248 U.S. 215 cited by Special Term, will not sustain the complaint. The plaintiff does not claim that the story or the sound track used in the motion picture film was authored or created by the plaintiff or by its licensor, or that the film itself was created, arranged or originally produced by

the plaintiff or by its licensor, and the complaint lacks allegations tending to show that the public was in any way deceived or confused by the actions of the defendants. On the complaint, this is not a case where the exploiting and use of the film is "unfair to the public and to the plaintiff" or where the defendants have sought "to pass off as [their] own the thoughts and works of another." See *Fisher v. Star Co.*, supra, p. 433. Nor is this a case of unfair competition grounded on the theory of the misappropriation by defendants of material originated and developed by the plaintiff or its licensor and the use thereof by the defendants in competition with the plaintiff. See *International News Service v. Associated Press*, supra. If the particular motion picture film was in the public domain, and the contrary does not appear, the defendants would be entitled to duplicate and use all or portions of the picture film for telecast or other legitimate purposes, and if their acts were not such as to deceive the public or defraud the plaintiff, they would not incur any liability to plaintiff. See *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348, 142 USPQ 249; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225; *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234. . . . Special Term apparently assumed that this was the law but held that the plaintiff would have a cause of action if the defendant had appropriated "the very item licensed" to plaintiff as distinguished from a mere copying thereof and reasoned that the defendants may be held liable under precedents allowing recoveries for "the unauthorized appropriation of artistic performances to the profit of others" Special Term, citing *Metropolitan Opera v. Wagner-Nichols R. Corp.*, 199 Misc. 786, 87 USPQ 173, aff'd 279 App. Div. 632; *Mutual Broadcasting System, Inc. v. Muzak Corp.*, 177 Misc. 489, 51 USPQ 146; *20th Century Sport Club v. Transradio Press Service*, 165 Misc. 71; *C.B.S., Inc. v. Documentaries Unlimited, Inc.*, 42 Misc. 2d 723, 726, 141 USPQ 310. Under the theory of these decisions, however, the cause of action would be one which would be vested in the artist or the creator or in his licensee or assignee; and the plaintiff does not claim to so qualify. The area of the law dealing with the rights and liabilities in connection with the republication of motion pictures via the television medium is in the formative stage. Until the law is settled, it is generally preferable that a court limit its conclusions to the precise problem involved in the particular case.

Therefore, in repleading, the plaintiff should restate his alleged cause or causes of action with sufficient particularity to show fully the exact basis and the material elements thereof.

Also of Interest:

56. *Kingsway, Inc. v. Werner*, 142 U.S.P.Q. 320 (E.D. Mo., July 24, 1964) (Harper, J.)

Action for unfair competition. Citing the *Sears* and *Compco* cases, the court held in dismissing plaintiff's complaint that the fact that defendants had marketed and sold figurine chessmen very much like plaintiff's did not constitute unfair competition, even if the appearance of plaintiff's chessmen had acquired secondary meaning. The court said:

Two very recent United States Supreme Court opinions make it very clear that a design, not protected by a design patent or other federal statutory protection, can be copied in every detail by whoever pleases. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225. This is true even if we assume, *arguendo*, that the plaintiff's chessmen, because of their design, had acquired a "secondary meaning" prior to defendants' copying.

PART V.

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57. COPYRIGHT LAW SYMPOSIUM, no. 13. New York, Columbia University Press, 1964. 228 p. Nathan Burkan Memorial Competition, sponsored by the American Society of Composers, Authors and Publishers, 1963.

The prize essays are analyzed separately, *infra*.

58. LOS ANGELES COPYRIGHT SOCIETY. Copyright and related topics: a choice of articles. Edited by the Los Angeles Copyright Society and the UCLA School of Law. Berkeley, University of California Press, 1964. 609 p.

Contents: Reflections on the law of copyright, by Zachariah Chafee, Jr.; The right to privacy, by S. D. Warren and L. D. Brandeis; Renewal and extension of copyright, by S. M. Bricker; Fair use in the law of copyright, by Saul Cohen; Motion picture rights: United States and international, by J. S. Dubin; "Magazine rights," a division of indivisible copyright, by H. G. Henn; Performer's rights and copyright: the Capitol Records case, by Benjamin Kaplan; Piracy and privilege in literary titles, by V. S. Netterville and B. L. Hirsch; The right of publicity, by M. B. Nimmer; Borderland: where copyright and design patent meet, by R. W. Pogue; UCC protection in the United States: the coming into effect of the Universal Copyright Convention, by E. A. Sargoy; Should performance dedicate? By H. F. Selvin; Originality in the law of intellectual property, by L. B. Yankwich; Extension of restitutional remedies in the tort field, by K. H. York; Monetary recovery for copyright infringement; note; Accountability among co-owners of statutory copyright, comment; and Bibliography, 1950-1963 (pp. 587-609).

An anthology of law review articles "which lawyers active in the practice of entertainment law refer to most often and which constitute some of the outstanding literature in the field."

59. McTIERNAN, CHARLES E. The protection of programs through copyright and other methods. Abington, Pa., Association of Data Processing Service Organizations, 1964. 10 p.

A lecture on copyright and patent protection of computer programs, delivered at ADAPSO's Kansas City Management Symposium.

60. SHEMEL, SIDNEY, and M. WILLIAM KRASILOVSKY. This business of music. Edited by Paul Ackerman. 1st ed. New York. Billboard Pub. Co. 1964. 420 p.

A comprehensive reference book covering legal and economic aspects of the music and recording industries, with numerous sections on domestic and international copyright protection. Includes working samples of contracts, licenses, agreements, payment formulas, writer and publisher applications, the text of the general revision bill (H.R. 11947), and texts of copyright laws and regulations.

61. SIEBERT, FRED S. Copyrights, clearances, and rights of teachers in the new educational media; report of a study made for the Commission on Academic Affairs of the American Council on Education. Washington, American Council on Education, 1964. 62 p.

An edited version of a work first issued in 1963. "The purpose of this study is to explore and, wherever possible, recommend solutions for three groups of problems growing out of the use of the new instructional media in American education.

"These problems can be identified as: (1) methods of protecting educational materials for the new media from unauthorized use through such legal concepts as copyright and literary property; (2) identification and description of educational materials which can and cannot be incorporated in the new educational media without infringing the rights of others; and (3) analysis and evaluation of various types of compensation policies in the new media and teacher relationships."

2. Foreign Publications

62. SECRETAN, HUBERT. La protection des dessins et modèles industriels et des oeuvres d'art appliqué aux Etats-Unis et en Suisse; étude de droit comparé. Genève, Editions Médecine et Hygiène, 1964. 180 p. Thesis—Lausanne.

A dissertation which compares the legal protection of industrial designs and models and works of applied art in the United States with that of Switzerland. Mention is made of United States design bills, especially of S. 1884, 87th Cong., 1st Sess. (1961), with the conclusion that Switzerland could benefit from an adaptation to its domestic legislation of certain solutions offered by the American legislative proposals.

63. ZWEIGERT, KONRAD. *Private Werkvervielfältigung durch Magnetongeräte und verfassungsrechtliche Eigentumsgarantie*. Köln, W. Kohlhammer [©1963]. 51 p.

A study, based on an earlier legal opinion prepared by the same author, of the constitutional implications of royalty-free tape recording for private use as envisaged by the draft copyright laws of the Government of the Federal Republic of Germany, with special reference to Article 14 of the Bonn Constitution which guarantees the right to own property, and permits expropriation only under certain conditions.

B. LAW REVIEW ARTICLES

1. United States

64. American Bar Association. *Section of Patent, Trademark and Copyright Law*. 1964 committee reports to be presented at the Annual Meeting, to be held August 7-13, 1964, New York, New York. Chicago, American Bar Center, 1964. 149 p.

Includes reports of the Copyright Division committees dealing with copyright law revision, international copyright relations and conventions, Copyright Office affairs, program for revision of the copyright law, program for protection of industrial designs, related rights, authors, and Government relations to copyrights.

65. ARNOLD, TOM. A philosophy on the protection afforded by patent, trademark and unfair competition law. (*APLA Bulletin* 283-307, June 1964.)

"A commentary upon the product stimulation [sic] law of *Sears, Roebuck & Co. v. Stiffel Company* . . . (Supreme Court Mar. 9, 1964); *Compco Corp. v. Day-Brite Lighting, Inc.* . . . (Supreme Court Mar. 9, 1964); and *In re Mogen David Wine Corp.*, 140 USPQ 575 (CCPA Mar. 12, 1964).

66. BANGS, ROBERT B. The taxation of ideas. (8 *IDEA—The Patent, Trademark, and Copyright Journal of Research and Education* 297-302, no. 2, Summer 1964.)

A brief note on the "economics of intellectual property," and the taxation of income resulting from writing, composing and inventing in the United States.

67. [BANZHAF, JOHN F., III] Copyright protection for computer programs. (64 *Columbia Law Review* 1274-1300, no. 7, Nov. 1964.)

An essay, which won the second prize in the 1964 Nathan Burkan Memorial Competition at Columbia University School of Law, on the requirements and scope of protection available for computer programs under the existing and proposed copyright law, and the effect such protection may have on the computer industry and the public.

68. BARKER, FRANK E. Design piracy problems: the Libonati bill. (33 *University of Cincinnati Law Review* 382-401, no. 3, Summer 1964.)

A brief summary of the Libonati bill (H.R. 5523, 88th Cong., 1st Sess.), preceded by a survey of the case law on design piracy, with particular emphasis on dress designs.

69. BEILSTEIN, ROBERT W. Patent law—unfair competition—the federal patent laws prevent a state from prohibiting or imposing liability for the copying of articles which are not protected by either the federal patent or copyright grant. (25 *University of Pittsburgh Law Review* 769-773, no. 4, June 1964.)

A note on the *Sears and Compco* decision.

70. CHAPMAN, LELAND L. The Supreme Court and Federal law of unfair competition. (54 *The Trademark Reporter* 573-580, no. 8, August 1964.)

A critical note on the Supreme Court decision in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

71. COOK, JOSEPH G. The fine arts: what constitutes infringement. *COPYRIGHT LAW SYMPOSIUM*, No. 13, 65-86 (1964).

This essay, which was awarded the National Third Prize in the 1963 Competition, first appeared in 16 *Alabama Law*

Review 41-59, no. 1, Fall 1963. See 11 BULL. CR. SOC. 351, Item 227 (1964).

72. Copyright—Author entitled to copyright protection of speech delivered before audience of 200,000 at public demonstration and extensively publicized in all news media. (50 *Virginia Law Review* 939-945, no. 5, June 1964.)

A case note on *King v. Mister Maestro, Inc.*, 224 F. Supp. 101, 11 BULL. CR. SOC. 183, Item 83 (S.D.N.Y. 1963).

73. DERENBERG, WALTER J. Copyright law. 1963 ANNUAL SURVEY OF AMERICAN LAW 437-456 (1964).

The 1963 annual survey of legislative and judicial developments in the United States in the field of copyright and related subjects.

74. FINKELSTEIN, HERMAN. Music and the copyright law. (10 *New York Law Forum* 155-173, no. 2, June-July, 1964.) "Symposium on Copyright, part 2."

A survey of the copyright protection of music under the present law and the McClellan-Celler general revision bill (S. 3008 and H.R. 11497, 88th Cong., 2d Sess.)

75. FINNISS, G. The theory of "unity of art" and the protection of designs and models in French law. (46 *Journal of the Patent Office Society* 615-630, no. 9, Sept. 1964.)

An essay on the development of the French concept of the "unity of art," which evolved from the French judicial system, originally "based on a rigorous differentiation of the domains of 'pure art' and 'applied art.'"

76. FREEDMAN, ROBERT. Is choreography copyrightable? A study of the American and English legal interpretations of "drama." (2 *Duquesne University Law Review* 77-95, no. 1, Winter 1963.)

A study of the copyrightability of choreographic works under the United States and British copyright laws, with the recommendation that, in the revised copyright law of the United States, choreographic works should be named specifically as a separate category of subject matter entitled to copyright.

77. FRITCH, BRUCE E. Some copyright implications of videotapes; suggesting the need for statutory revision. *COPYRIGHT LAW SYMPOSIUM*, No. 13, 87-132 (1964).

This essay, which received first prize in the Nathan Burkan Memorial Competition at Yale Law School in 1963 and later won honorable mention in the 1963 National Competition, was first published in 37 *Southern California Law Review* 214-246 (No. 2, 1964).

78. FROST, GEORGE E. Design patent and copyright. (*APLA Bulletin* 307-316, June, 1964.)

A discussion of the *Sears, Roebuck* and *Compco* Supreme Court decisions at the APLA meeting on April 17, 1964, and a transcript of the questions and answers which followed the discussion.

79. (GEORGE WASHINGTON UNIVERSITY). *Patent, Trademark, and Copyright Research Institute*. Proceedings [of the] Eighth Annual Public Conference. Washington, George Washington University [1964] 223 p. (8 *IDEA*, the Patent, Trademark, and Copyright Journal of Research and Education 153-201, Conference number, 1964.)

Includes the proceedings of a session devoted to copyright and related subjects, entitled "New Dimensions and Directions", and moderated by A. L. Kaminstein, Register of Copyrights. Some of the invited contributors were: Professors Harry G. Henn and Benjamin Kaplan, who spoke on "Impacts of Proposed Copyright Legislation: the Businessman, the Government, and the Public"; Philip Dalsimer, who spoke on "New Concepts of Design Protection"; and Alexander J. Etienne and Morton David Goldberg, who spoke on "Patent and Copyright Implications of Electronic Data Processing." A "Panel Discussion and Question Period" follows the presentations.

80. GOLDBERG, GEORGE. Proposed copyright law—a study in statutory elephantiasis. (17 *The Cornell Law Forum* 3-4, no. 2, Oct. 29, 1964.)

A critical comment on H.R. 11947, 88th Cong., 2d Sess. (1964).

81. HARRIS, L. JAMES [A review of] *Studies on copyright*, Arthur Fisher memorial edition, edited by the Copyright Society of the U.S.A. . . . (41 *University of Detroit Law Journal* 559-581, no. 5, June 1964.)

"[The reviewer surveys] the contents of the studies by discussing a sampling of the recommendations in the Register's Report, particularly, the effect of the recommendations in furthering the major purpose of the studies, namely—'providing the focus for isolating and resolving the key issues in a general revision of the law.' In furtherance of this objective, . . . [he] interpolate[s] additional comments to underscore the issues that require resolution."

82. HENN, HARRY G. [A review of] *Nimmer on copyright* . . . (16 *Stanford Law Review* 1146-1150, no. 4, July 1964.)

Professor Henn describes the *Nimmer* treatise as "a *sine qua non* . . . for the copyright industries."

83. HORSLEY, W. F. *Architectural plans: loss of common-law copyright*. (16 *Alabama Law Review* 451-460, no. 2, Spring 1964.)

This comment, which was entered in the 1963 Nathan Burkan Memorial Competition at the University of Alabama School of Law, is concerned with the protection offered to architectural plans prior to their publication, and analyzes two fundamental questions: "(1) Are architectural plans within the sphere of common-law copyrights? (2) If the protection of common-law copyrights does extend to architectural plans, how will the right be extinguished?"

84. HUDON, EDWARD G. *Literary piracy, Charles Dickens and the American copyright law*. (50 *American Bar Association Journal* 1157-1160, no. 12, Dec. 1964.)

"[T]he story of the struggle in this country to obtain passage of a copyright law to protect foreign authors from literary pirates. The leader in the struggle was Charles Dickens, who received nothing from the American editions of his novels although they were even more popular in this country than in England."

85. HUTTENBRAUCK, DANIEL. *Copyright litigation*. (10 *New York Law Forum* 184-204, no. 2, June-July, 1964.)

"Symposium on Copyright, part 2."

"This paper is limited to a consideration of litigation to recover damages for infringement of statutory copyright. Its primary purpose is to give lawyers handling the litigation of a copyright matter some idea of the various problems to be encountered."

86. Joint and several liability for copyright infringement: a new look at section 101 (b) of the Copyright Act. (32 *University of Chicago Law Review* 98-123, no. 1, Autumn 1964.)

This comment, which received first prize in the Nathan Burkan Memorial Competition at the University of Chicago Law School, "considers the applicability of the joint tort concept to copyright infringement cases in general, and to the damage provisions in particular."

87. KAMINSTEIN, ABRAHAM L. The McClellan-Celler Bill for general revision of the United States Copyright Law. (10 *New York Law Forum* 147-154, no. 2, June-July, 1964).

"Symposium on Copyright, part 2."

An analytical summary, by the Register of Copyrights, of S. 3008, 88th Cong., 2d Sess. (1964) which was also introduced in the House as H.R. 11947.

88. KENNEY, EDWARD. Commonwealth copyright law on compilations and telephone directories. (50 *American Bar Association Journal* 652-654, no. 7, July 1964.)

The author "traces the development of the law regarding copyright protection afforded compilations, directories, statistical tables and other listings. He concludes that telephone directories combine elements of scientific ingenuity and experience that are sufficient to afford them protection against commercial piracy and exploitation."

89. KUNIN, LOUIS. The Lindsay bill before and after the Stiffel case. (54 *The Trademark Reporter* 731-751, no. 10, Oct. 1964.)

A case is made for the enactment of the Lindsay bill, H.R. 4651, 88th Cong., 1st Sess. (1963), in the light of the *Sears* and *Compco* decisions.

90. KURY, ELIZABETH HEAZLETT. Protection for creators in the United States and abroad. COPYRIGHT LAW SYMPOSIUM, no. 13, 1-32 (1964).

This essay [which was awarded the National First Prize in the 1963 Competition] first appeared in 24 *University of Pittsburgh Law Review* 817-842, no. 4, June 1963, under the author's maiden name. See 11 BULL. CR. SOC. 213, Item 107 (1964).

91. LATHAM, PAUL L. Copyright duration. (50 *American Bar Association Journal* 958-960, no. 10, Oct. 1964.)

"Mr. Latham argues against the proposed extension of copyright duration beyond its present fifty-six years. Such an extension, he contends, would have a deadening effect on the production of new and useful works, and this would defeat the basic purpose of copyright protection."

92. MCGUIRE, CHARLES S. Common-law overtones of statutory copyright: an inquiry into the status of a federal common law of unfair competition. COPYRIGHT LAW SYMPOSIUM, no. 13, 33-64 (1964).

"The purpose of this essay [which was awarded the National Second Prize in the 1963 Competition] is to examine the problems incident to linking a common-law claim with a remedy provided by the federal copyright statutes, with special emphasis on the question of whether state or federal law is to be applied to the common-law claim in such actions."

93. MARKS, FRANK H. Copying an article of commerce not necessarily unfair competition. (46 *Journal of the Patent Office Society* 660-665, no. 9, Sept. 1964.)

A note on the *Sears* and *Compco* cases.

94. MOELLENBERG, JOHN M. The question of choice between copyrighting or patenting a design. COPYRIGHT LAW SYMPOSIUM, no. 13, 165-179 (1964).

"The purpose of this essay [which received honorable mention in the 1963 Competition] is to examine this question [*i.e.*, 'of whether the same thing may be the subject of both a design patent and a copyright as a work of art or a design therefor'] in the light of the provisions of the Federal Constitution and statutes, and expressions of the judiciary, and to offer a recommendation."

95. OLSON, DOUGLAS E. Copyrights—newspaper publication of a speech as limited publication. (32 *The George Washington Law Review* 1148-1153, no. 5, June 1964.)

A case note on *King v. Mister Maestro, Inc.*, 224 F. Supp. 101, 11 BULL. CR. SOC. 183, Item 83 (S.D.N.Y. 1963).

96. Product simulation: a right or a wrong? By Daphne R. Leeds, Milton Handler, Walter J. Derenberg, Ralph S. Brown, and Paul Bender. (64 *Columbia Law Review* 1178-1242, no. 7, Nov. 1964.)

Comments, by eminent scholars, on the potential effect of the *Sears* and *Compco* decisions on several related areas of the law.

97. RINGER, BARBARA A. Copyrights—Relationship to patents. (*In* Calvert, Robert, ed. *THE ENCYCLOPEDIA OF PATENT PRACTICE AND MANAGEMENT*, 165-170. New York, Reinhold, 1964.)

An article comparing and contrasting copyright and patent protection, with special attention to the relationship and overlapping between the two.

98. RINGER, BARBARA A., and KELSEY MARTIN MOTT. Design patents. (*In* Calvert, Robert, ed. *THE ENCYCLOPEDIA OF PATENT PRACTICE AND MANAGEMENT*, 198-203. New York, Reinhold, 1964.)

An article on the protection afforded designs under the patent law, including a comment on originality as a standard of protection under both the copyright and patent laws.

99. SALONY, JAMES M. A study of the "version": a reflection on the copyright law's policy of protection. (9 *Villanova Law Review* 467-482, no. 3, Spring 1964.)

This comment, which was entered in the 1964 Nathan Burkan Memorial Competition at Villanova University School of Law, deals "exclusively with 'versions' of works in the public domain, on the theory that all the dissatisfaction with copyright protection is reflected and magnified in this narrow area."

100. SAVELSON, ROBERT STEPHEN. Electronic music and the copyright law. *COPYRIGHT LAW SYMPOSIUM*, no. 13, 133-164 (1964).

This essay, which received honorable mention in the 1963 Competition, first appeared in 11 BULL. CR. SOC. 144, Item 65 (1964).

101. SCHULMAN, JOHN. Patents, trademarks and copyright—an informal comparative analysis. (10 *New York Law Forum* 174-183, no. 2, June-July, 1964.)

“Symposium on Copyright, part 2.”

A survey of some of the basic characteristics of patents, trademarks and copyright, “some outstanding aspects of their similarities and differences, as well as some areas in which they may overlap.”

102. SIANO, VINCENT A. Unfair competition—preemption by federal patent law. (6 *Boston College Industrial and Commercial Law Review* 138-142, no. 1, Fall 1964.)

A note on the *Sears* and *Compco* decisions.

103. SMITH, ARTHUR ALLAN. “In vino (Mogen David brand) veritas”? (54 *The Trademark Reporter* 581-589, no. 8, August 1964.)

A note on the Court of Customs & Patent Appeals decision in the *Mogen David Wine* case, 328 F. 2d 925 (1964), which the commentator finds not incompatible with the decisions in the *Sears* and *Compco* cases.

104. SPELTS, RICHARD J. Battle over the compulsory license: mechanical recording of music. (36 *University of Colorado Law Review* 501-518, no. 4, summer, 1964.)

This comment, which has been entered in the Nathan Burkan Memorial Competition at the University of Colorado School of Law, purports “to bring together in a single source some of the background [of the mechanical recording rights in musical compositions under the U. S. copyright statute], the crux of major research projects and recommendations of the Copyright Office, and the arguments as they stand in early 1964.”

105. SPIEGEL, IRWIN O. Variety: Beatles beware! (39 *The Los Angeles Bar Bulletin* 245-247, no. 7, May 1964.)

A brief discussion of the question whether one of the effects of the *Sears* and *Compco* decisions is to “place the performances contained in all released commercial records in the public domain.”

106. The Supreme Court, 1963 term. VII: Patent law. (78 *Harvard Law Review* 305-312, no. 1, Oct. 1964.)

Includes a comment on the *Sears* and *Compco* decisions.

107. SUTTON, JOHN P. Protecting Government contractors' unpatented proprietary information. (8 *IDEA—The Patent, Trademark, and Copyright Journal of Research and Education* 239-254, no. 2, Summer 1964.)

"With respect to government contracts, special difficulties arise as to the protection of unpatented proprietary information. These difficulties are explored from the opposing viewpoints of:

- (1) Those who seek greater protection of unpatented proprietary information, and
- (2) those who seek a limited protection of unpatented proprietary information.

"The scanty case law is analyzed with the observation of a possible trend of greater protection for unpatented proprietary information disclosed to the government."

108. TREECE, JAMES M. Patent policy and preemption: the *Stiffel* and *Compco* cases. (32 *University of Chicago Law Review* 80-96, no. 1, Autumn 1964.)

The conclusion is reached that "the decisions . . . can be read as a return to traditional principles of unfair competition law. . . . By expressly recognizing the state interest in promoting product identification, *Compco* and *Stiffel* saved to the states their traditional area of competence; but by resting on preemption grounds, the decisions ensured that state protection could not be the basis for acquiring monopoly powers similar to those conferred by the federal statutes."

2. Foreign

1. English

109. BIRPI Working Party on an Administrative Agreement (Geneva, May 20 to 26, 1964). (3 *Industrial Property* 139-140, no. 7, July 1964.)

A brief article on the activities of a working party organized by the Paris and Berne Unions for the purpose of preparing a

diplomatic conference for the revision of some of the administrative clauses of the existing conventions. The working party drew up a draft "administrative convention," entitled "Draft Convention of the World Intellectual Property Organization" (WIPO), which, according to the draft, would take the place of what is today known as BIRPI. "The draft is going to be circulated to the member states of the Paris and Berne Unions." An appendix contains the names of the participants.

110. EVANS, ROBERT V. Broadcasting and the new United States copyright bill. (*EBU Review* 53-55, no. 88B, Nov. 1964.)

A brief summary of the main provisions of the U. S. general revision bill, with an analysis of the sections dealing with broadcasting.

111. LUND, TORBEN. Letter from Denmark. (77 *Le Droit d'Auteur* [English inset] 167-171, no. 10, Oct. 1964.) Also appears in French in the main section of the same issue of *Le Droit d'Auteur*.

A survey of recent legislative and judicial developments in Denmark in the field of copyright and related matters.

112. MENTHA, BENIGNE. The right of public presentation and performance in the Berne Convention. (*EBU Review* 36-40, no. 87B, Sept. 1964.)

Essentially a critique of Articles 11, 11bis, 13 and 14 of the Brussels revision of the Berne Convention concerning the rights of public presentation and performance, with reference to restrictions permitted to be imposed on such rights by national legislation. The conclusion is reached that it is up to Stockholm Revision Conference scheduled for 1967 to remedy the shortcomings.

113. MORLEY, M. G. Infringement of copyright by reproduction, by M. G. Morley and I. McG. Wylie. (5 *The Australian Lawyer* 102-109, pts. 6 & 7, July 1964.)

A brief article on U.K. statutory and case law relating to infringement of copyright by unauthorized reproduction of an original work, with special reference to the "Little Spanish Town" case (*Francis Day & Hunter, Ltd. v. Bron*, 2 All E.R. 16, 1963). [See also *Leo Feist, Inc. v. Debmar Publishing Co.*, 232 F. Supp. 623 (E.D. Pa. 1964), in which the finding of the English court

in the *Little Spanish Town* case received recognition under the doctrine of collateral estoppel].

114. SEYFFERT, WARREN S. Copyright restrictions on the vitality of Canadian theatre. (10 *Faculty of Law Review, University of Toronto* 139-147, April 1964.)

A criticism of the Canadian copyright law as being obsolete and hampering renditions in Canada of new dramatic and musical productions appearing in the United States and England. A proposal is made for a far-reaching new compulsory licensing system, under which the owner of Canadian performing rights may be ordered, under certain conditions, to grant a license to perform a literary, dramatic or musical work, if such work has been previously performed in public and the owner of the performing rights has refused to license its public performance in Canada.

115. TAMMES, A. J. P. Freedom of the high seas: legitimacy of a "television island." (*EBU Review* 38-40, no. 86B, July 1964.)

The purpose of this article is to examine "whether it is legitimate to set up and operate a 'television island' on the high seas, and in particular in the North Sea, in that area of the sea which forms part neither of territorial waters nor of the internal waters of any coastal states." The conclusion is reached that "the installation of a 'television island' in the North Sea would be in contravention of international law."

116. TROLLER, ALOIS. Intellectual property and justice. (3 *Industrial Property* 119-124, no. 6, June 1964.) Also appears in French in 80 *Propriété Industrielle* 119-124, no. 6, June 1964.)

An English translation of Professor Troller's address delivered upon the occasion of the 75th anniversary of the Swiss Office for Intellectual Property. See 11 BULL. CR. SOC. 293, Item 193 (1964).

117. VAUGHAN, DENIS. The availability of musical scores. (*EBU Review* 40-45, no. 86B, July 1964.)

A discussion of the problem of the general scarcity of full musical scores, and the textual inaccuracy of the presently available printed scores, with suggestions for improvement through international copyright regulation.

2. English, French and German

118. TROLLER, ALOIS. Die Anknuepfung des Konventionsrechtlichen Schutzes in der RBUE. (*Revue Internationale du Droit d'Auteur* 60-87, no. 43, May 1964.)

A study, in English, French and German which is concerned with particular problems arising in connection with multilateral conventions, such as those dealing with copyright and industrial property rights. A point is made that, since the immediate purpose of these conventions is to grant protection in the member countries to foreign creators of literary and artistic works, models and designs as well as to inventors and proprietors of trademarks, it is necessary that the conventions also determine the conditions under which the protection can be claimed. The present article is, in essence, a critical analysis of the two basic criteria for protection under the revised Berne Convention, *i.e.*, the nationality of the author and the place of the first publication, with recommendations for possible improvement of the present situation at the forthcoming conference for the revision of the Berne Convention.

3. English, French and Spanish

119. COLBY, RICHARD. International copyright protection. (*Revue Internationale du Droit d'Auteur* 98-173, no. 44, Sept. 1964.)

A reprint, with French and Spanish translations, of an article which first appeared in the Symposium on Copyright, *New York Law Forum* 45-67, no. 1, March 1964.

120. HENNINGS, HELMUT DIETER. Magnetic tape; a controversy. (*GEMA News* 20-23, no. 1, June 1964.)

An article, in English, French and Spanish, advocating the payment of royalties for tape recordings made for personal use in the Federal Republic of Germany.

121. JOUBERT, CLAUDE. La durée du droit exclusif d'exploitation des oeuvres posthumes et les conflits entre la loi ancienne et la nouvelle. (*Revue Internationale du Droit d'Auteur* 110-151, no. 43, May 1964.)

A study, in English, French, and Spanish, of the problems concerning the duration of the exclusive rights of exploitation of posthumous works, arising out of the conflict between the old French copyright laws and the copyright statute of 1957.

122. KOUMANTOS, GEORGES A. La notion de publication dans la Convention de Berne. (*Revue Internationale du Droit d'Auteur* 4-51, no. 44, Sept. 1964.)

A report, in English, French and Spanish, to the 50th Congress of the International Literary and Artistic Association held at Munich in September 1963. The French text first appeared in 34 *Il Diritto di Autore*, 545-560, no. 4, Oct.-Dec. 1963. See 11 BULL. CR. SOC. 357, Item 253 (1964).

123. LIMPERG, THEODOR. La protection juridique des caractères typographiques. (*Revue Internationale du Droit d'Auteur* 174-229, no. 44, Sept. 1964.)

An article, in English, French and Spanish, on the work of the Committee of Experts on the International Protection of Type Faces, which held its fourth meeting on October 7-10, 1963, in Geneva, and whose task it was to re-examine the text of the draft convention prepared at its third meeting in November 1962, to decide on the form of the international instrument to be adopted for the protection of type faces, and to indicate ways for the implementation of the proposed regulation.

124. MASSOUYE, CLAUDE. Perspectives de revision de la Convention de Berne. (*Revue Internationale du Droit d'Auteur* 4-59, no. 43, May 1964.)

An examination, in English, French and Spanish, of the present state of the proposals for revision of the Berne Copyright Convention at the 1967 Stockholm Conference and the solutions towards which the responsible authorities seem to be steering.

125. Photographic reproduction and copyright: the photographic reproduction of protected works by or on behalf of libraries, documentation centres and scientific institutions. (17 *UNESCO Copyright Bulletin* 29-68; 97-141; 171-214, 1964.)

A reproduction, in English, French and Spanish, of one of the working documents, submitted jointly by the Secretariats to the Intergovernmental Committee and to the Permanent Committee of the Berne Union during their last joint session (New Delhi, Dec. 2-7, 1963). The document is a brief comparative analysis of various national approaches to the problem of photo-

copying by libraries, with an appendix containing excerpts from pertinent legislative texts.

126. PLAISANT, ROBERT. La protection des titres. (*Revue Internationale du Droit d'Auteur* 88-109, no. 43, May 1964.)

A study, in English, French and Spanish, of the protection of titles under the laws of copyright and unfair competition in France.

127. TOURNIER, JEAN LOUP. La loi française du 11 mars 1957; sept ans après. (*Revue Internationale du Droit d'Auteur* 52-97, no. 44, Sept. 1964.)

The text, in English, French and Spanish, of a lecture jointly sponsored by the Copyright Society of the U.S.A. and the New York University School of Law, and delivered on April 9, 1964, as the second Jean Geiringer Memorial Lecture. The English version first appeared in 11 BULL. CR. SOC. 295, Item 196 (1964).

4. French

128. FABIANI, MARIO. Le droit de reproduction et la révision de la Convention de Berne. (*77 Le Droit d'Auteur* 286-290, no. 11, Nov. 11, 1964.)

A plea for the revision of those provisions of the Berne Convention which are concerned with the right of reproduction.

129. MODRZEJEWSKI, EUGENIUSZ. Lettre de Pologne. (*77 Le Droit d'Auteur* 207-209, no. 8, Aug. 1964.)

A comment on Article 56 of the Polish Copyright Statute of 1962 concerning the protection of patrimonial rights.

130. MOUCHET, CARLOS. Situation des pays américains vis-à-vis des conventions internationales sur le droit d'auteur. (*Interauteurs* 120-123, no. 155, 2d quarter 1964.)

A survey, in form of synoptic tables, of the membership of the countries of the Western Hemisphere in international copyright conventions.

131. NAWROCKI, BOLESŁAW. Evolution de l'art et droit d'auteur; examen de quelques problèmes d'actualité. (*77 Le Droit d'Auteur* 223-231; no. 9; Sept. 1964; 249-263, no. 10, Oct. 1964.)

A discussion of copyright problems raised by modern development of electronic machines such as computers and apparatus for the production of musical and artistic works.

132. RADOJKOVIC, ZIVAN. Les droits personnels et leur rapport avec les éléments personnels du droit d'auteur. (*77 Le Droit d'Auteur* 172-180, no. 7, July 1964.)

An exposition of the theoretical foundation of personal rights in general and their relationship to the personal or moral elements of copyright.

133. REIMER, DIETRICH. Allemagne Fédérale: la réforme du droit d'auteur devant le "Bundestag." (*Revue Internationale du Droit d'Auteur* 157-160, no. 43, May 1964.)

A brief summary of the 100th session of the West German Bundestag which was devoted to the first reading, on December 6, 1963, of the official draft copyright laws.

134. SAVELSON, ROBERT STEPHEN. La musique électronique et la législation sur le droit d'auteur. (*Interauteurs* 203-225, no. 156, 3d quarter 1964.)

A French translation of an essay which was awarded first prize at Columbia University School of Law in the 1963 Nathan Burkan Memorial Competition, and which has been chosen for inclusion in the next ASCAP COPYRIGHT LAW SYMPOSIUM. Reprinted from 11 BULL. CR. SOC. 144, Item 65 (1964).

135. SPAIC, VOJISLAV. De la succession en matière de droit d'auteur. (*Interauteurs* 194-202, no. 156, 3d quarter 1964.)

A comparative study of the law and jurisprudence relating to inheritance of copyrights, with special attention to Yugoslavia.

136. VAUNOIS, LOUIS. Lettre de France. (*77 Le Droit d'Auteur* 181-187, no. 7, July 1964.)

A survey of judicial and other developments concerning copyright and related fields in France.

5. German

137. BAPPERT, WALTER. Urheberrechtsgedanken in Privilegienwesen? (*42 Archiv für Urheber-, Film-, Funk- und Theaterrecht* 90-141, no. 1/2/3/4, June 15, 1964.)

Essentially a reply to Walter Becker-Bender's critique of Bappert's studies of the origins of copyright in Germany. Becker-Bender's article appeared in 40 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 293-312, no. 5/6, Dec. 1, 1963. See 11 BULL. CR. SOC. 454, Item 336 (1964).

138. BAUM, ALFRED. Die Vervielfältigung zum privaten Gebrauch durch Magnettongeräte aus der Sicht der RBÜ. (*Gewerblicher Rechtsschutz und Urheberrecht*, Auslands- und Internationaler Teil 510-512, no. 10, Oct. 1964.)

An interpretation of Article 13 of the Brussels revision of the Berne Convention with respect to the question of tape recording for private use.

139. BRUGGER, GUSTAV. Die Stellung des Fernsehens im Entwurf des Gesetzes über Urheberrecht und verwandte Schutzrechte. (41 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 257-279, no. 5/6, Apr. 15, 1964.)

An analysis of those provisions of the West German draft copyright law which deal with the copyright and neighboring rights aspects of television.

140. FROMM, FRIEDRICH KARL. Der Apparat als geistiger Schöpfer. (66 *Gewerblicher Rechtsschutz und Urheberrecht* 304-306, no. 6, June 1964.)

A brief article on some fundamental problems concerning copyright in literary, musical and artistic works created by means of electronic and other mechanical devices, with special reference to the Federal Republic of Germany.

141. HERETH, FRANZ. Urheberrechtlicher Schutz bei technischen Zeichnungen von Bauwerken oder Bauwerksteilen. (16 *Neue Juristische Wochenschrift* 2256-2260, no. 49, Dec. 5, 1963.)

A discussion of the question whether technical drawings in architecture are protectible by copyright under the law of the Federal Republic of Germany, in which a conclusion is reached that, as a rule, technical drawings of architectural works or their parts which are not otherwise protected as works of art, are not copyrightable. It is pointed out that, if, by exception, such drawings are protected under the West German statute concerning copyright in the works of literature, copyright in those drawings

which show an originality of presentation protects merely against copying and commercial diffusion of the drawings, but does not cover unauthorized construction of architectural works based on them.

142. HIRSCH, ERNST E. Die Rechtsfolgen der Veröffentlichung oder des Erscheinens einer Bearbeitung auf die Rechte des Urhebers am noch nicht veröffentlichten oder noch nicht erschienenen Originalwerk. (42 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 8-40, no. 1/2/3/4, June 15, 1964.)

A study of the legal effects, under the West German copyright law, on the rights of an author in a work not yet published, which result from the publication of an adaptation of the work. Written as a contribution to a Festschrift in honor of Professor Ulmer.

143. JOHNSTON, KENNETH. Vorschläge zur Reform des Musterschutzes in Grossbritannien. (*Gewerblicher Rechtsschutz und Urheberrecht, Auslands- und Internationaler Teil* 352-358, no. 7, July 1964.)

A summary of, and a commentary on, the Report of the Departmental Committee on Industrial Designs of the British Board of Trade, published in 1962 as command paper 1808. See 10 BULL. CR. SOC. 47, Item 27 (1962).

144. KAUFFMANN, HERMANN. Leistungsschutz des Bühnenkünstlers und Bühnenarbeitsvertrag. (41 *Archiv für Urheber-, Film-, Funk-, und Theaterrecht* 279-311 no. 5/6, Apr. 1964.)

An examination of the legal means which are at the disposal of a stage artist for the protection of his performance. The problems are approached from the viewpoint of the copyright law, the principle of the general right of personality under the Bonn Constitution, and the labor law in West Germany.

145. LEINVEBER, GERHARD. Urheberrechtlicher Denkmalschutz—ja oder nein? (66 *Gewerblicher Rechtsschutz und Urheberrecht* 364-369, no. 7, July 1964.)

An examination of the problem of whether or not a work in public domain should be protected with respect to its integrity under the West German revised copyright law, with a brief survey of pertinent legislation in Great Britain, France, Italy, Czechoslovakia, Spain, Yugoslavia and Sweden.

146. PEDRAZZINI, MARIO M. Gedanken zur Neuheit. (42 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 262-272, no. 5/6, July 15, 1964.)

A study of the concept of novelty under the patent, trademark, design and copyright laws, written as a contribution to a Festschrift in honor of Professor Ulmer.

147. RAUSCHER AUF WEEG, H. H. Alfred Baum: ein Leben für das internationale Urheberrecht; Betrachtungen aus Anlass der Vollendung seines 80. Lebensjahres. (41 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 76-84 no. 1/2/3/4 Feb. 1, 1964.)

An eulogy of the life and works of the prominent European copyright jurist, Alfred Baum, upon the occasion of his 80th birthday.

148. [ROEBER, GEORG.] Die Auseinandersetzungen um die Tonbandtantieme; neue Tatsachen, parlamentarischer Fortgang. Eine völlig neue Perspektive. (7 *Film und Recht* 11-15, no. 11, Nov. 1964.)

A survey of recent legislative and judicial developments concerning the controversy whether or not the owners of private tape recording devices in West Germany should pay royalties to GEMA.

149. RUNGE, KURT. Die Schaffung eines europäischen Urheberrechts. (42 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 69-90, no. 1/2/3/4, June 15, 1964.)

A survey of the historical development of the European copyright laws since the Rome Revision of the Berne Copyright Convention in 1928.

150. SCHMIEDER, HANS HEINRICH. Die Löschbandaufnahme zum privaten Gebrauch. (41 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 72-76, no. 1/2/3/4, Feb. 1, 1964.)

A discussion of rights in ephemeral tape recordings under the existing and proposed West German copyright laws. It is argued that, since an ephemeral (erasable) tape recording has none of the typical characteristics of a copy for a multiple use because it serves exclusively the purpose of making possible, technically and organizationally, one single broadcast, the principles governing the legal aspects of the ephemeral recordings

in broadcasting should be applied, by analogy, to tape recordings made by privately-owned home recording devices.

151. SORDELLI, LUIGI. Die Struktur der zusammengesetzten und der komplexen Werke und die Probleme der Zusammenarbeit nach dem italienischen Gesetz über das Urheberrecht. (42 *Archiv für Urheber-, Film-, Funk-, und Theaterrecht* 41-69, no. 1/2/3/4, June 15, 1964.)

An analysis of the legal aspects of composite works and works of complex authorship, under the Italian copyright statute of 1941. Special reference is made to copyright problems raised by collaborative efforts, regardless whether the resulting work is of simple or complex, homogenous or heterogenous structure. Written as a contribution to a Festschrift in honor of Professor Ulmer.

152. TROLLER, ALOIS. Technische Zeichnungen im Urheberrecht. (*Schweizerische Juristen-Zeitung* 369-375, no. 24, 1964.)

An article on the copyrightability of technical drawings under the Swiss copyright statute, as compared with the laws of the German Federal Republic, Austria, and Italy. The study concludes with a recommendation that the future revised Swiss copyright statute should abstain from enumerating technical drawings among copyrightable works of literature and art in order to avoid the confusion which surrounds the meaning of art. 1, para. 1 of the present statute.

153. WITTE, JÜRGEN. Das Urheberrecht an technischen Konstruktionszeichnungen. (66 *Gewerblicher Rechtsschutz und Urheberrecht* 537-538, no. 10, Oct. 1964.)

Essentially a refutation of Hereth's thesis as expounded in his article "Urheberrechtlicher Schutz bei technischen Zeichnungen von Bauwerken oder Bauwerkteilen," 16 *NJW* 2256-2260 (1963). See Item 141, *supra*.

6. Italian

154. FABIANI, MARIO. Problemi in tema di tutela della musica elettronica. (35 *Il Diritto di Autore* 139-145, no. 2, Apr.-June 1964.)

A discussion of the problems concerning the legal protection of electronic music, with special reference to the one raised by

the fact that copyright statutes, as a rule, protect "works of music" or "musical compositions" rather than music in general.

155. FABIANI, MARIO. La Convenzione di Roma sui cosiddetti diritti vicini e le notificazioni di non applicabilità di singole disposizioni. (35 *Il Diritto di Autore* 146-149, no. 2, Apr.-June 1964.)

A note on various reservations made by some countries in their notifications of adherence to the Rome Convention on Neighboring Rights.

156. PASQUERA, FILIPPO. Protezione del titolo di opera collettiva periodica non ancora pubblicata. (35 *Il Diritto di Autore* 1-8, no. 1, Jan.-Mar. 1964.)

A discussion of the question whether titles of "collective periodical works" are protectible, under the Italian copyright law, prior to their publication.

157. PLAISANT, ROBERT. La protezione delle opere di architettura. (35 *Il Diritto di Autore* 9-16, no. 1, Jan.-Mar. 1964.)

A discussion of the protection of architectural works under the French copyright statute, with special reference to plans, maps, sketches, and works of plastic art.

7. Spanish

158. DERENBERG, WALTER J. La ley sobre derecho de autor. (2 *Revista Mexicana de la Propiedad Industrial y Artística* 73-104, no. 3, Jan.-June 1964.)

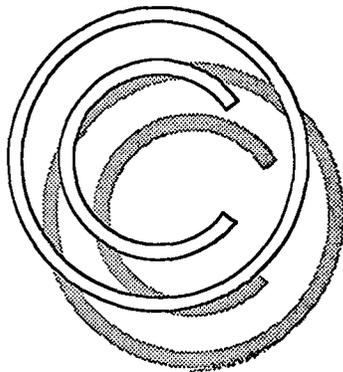
A translation of Professor Derenberg's 1962 annual survey of legislative and judicial copyright developments in the United States. See 10 BULL. CR. SOC. 398, Item 414 (1963).

159. THIRD ANNUAL JEAN GEIRINGER MEMORIAL LECTURE ANNOUNCED.

The third in the series of Jean Geiringer Memorial Lectures on the subject of international copyright will be given at 5:45 p.m. on April 14, 1965, by Dr. Erich Schulze, President of GEMA (Performing Rights) Society of the Federal German Republic. Dr. Schulze, an eminent European copyright expert, will discuss "Copyright Reforms".

The lecture will be given in the Theatre of The Gallery of Modern Art, 2 Columbus Circle, New York. The fund for the series is created by friends of the late Jean Geiringer, a vice president of Broadcast Music, Inc. and a widely known authority on international copyright law. Mr. Harold Orenstein, of 145 West 57th Street, New York, heads the sponsoring group. Two preceding lectures in the series were given by the British expert, Guy Aldous, Q.C. and Jean-Loup Tournier, General Manager of the French Performing Rights Society (S.A.C.E.M.).

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PART I.

ARTICLES

160. A "STATUTORY LICENSING" SYSTEM FOR THE LIMITED COPYING OF COPYRIGHTED WORKS

By IRWIN KARP*

Editor's Note: The proliferation and rapid improvement of copying and duplicating devices has created a new copyright problem and a new medium of publication. The copyright owner has several alternatives for granting permission to use his works in the new media. His authorization, without which copying cannot legally take place, could be given by separate licenses, through licensing organizations patterned on the ASCAP-BMI model, by a system of statutory licensing—or by a combination of these approaches. Mr. Karp's paper describes a statutory licensing plan, under which royalties would be paid on an authorized per-use basis, employing a "stamp" system of payment. The system would be incorporated into the U. S. Copyright Act.

The Need for a Licensing System.

The means of making inexpensive copies of all, or any portion, of a book or periodical are rapidly increasing and improving. Direct copying devices (e.g. Xerox copiers), office sized offset printing equipment (e.g. the multigraph), spirit duplicators, mimeograph machines, and other equipment actually constitute a distinct medium of communicating copyrighted works. It is separate from, and competitive with, the medium of conventional publishing. It is a medium by which an entire work, or any portion of it, can be brought to a few or to many readers by copies made quickly and cheaply from a single copy of the published edition.

This separate copying medium is having, and will increasingly have, an impact on authors and publishers, and on the medium of conventional publishing. The results may approach those that occurred in the field of music, when the electronic media of communication—broadcasting and records—obliterated conventional music publishing as a means of disseminating music and as a means of compensating authors for their creative work.

* Mr. Karp is Counsel to The Authors' League of America, Inc. and has served as a Trustee of The Copyright Society of the U.S.A.

Obviously, the copying medium can decrease sales of published copies of a book, whether all, or a part of it, is copied. Many readers use different portions of an encyclopedia, anthology, text or book at different times. To meet this need, a library or university or industrial concern might buy several copies of such a work. Now, a single copy plus a copying machine could serve the same demands. Similarly, a poem or section of a novel could become part of a de facto anthology or text, created for a classroom, or a school, or entire school system by the copying medium—and a single published copy of the work. This, too, could reduce sales of the published edition, or of an anthology containing the work. In this, and other ways, the copying medium could seriously injure authors and publishers.

Conversely, the copying medium offers a vitally needed opportunity for writers. It is now possible for an author to communicate any portion of his book—one page or several pages—to any number of readers. A few copies, or many copies, of the desired segment can be made at the same time; or they can be made, as ordered, on a one-at-a-time basis. The copying medium can thus multiply the audience for an author's work, and provide him with a new means of compensation—the royalty on each copy. This is additional income which the author needs. Writing is—with a few highly publicized and spectacular exceptions—an economically sub-marginal profession. For most authors, publishing of a book produces a meager return, grossly inadequate as compensation for the creative labor required. Unlike the composer, whose work is used and paid for in various media, writers of books have had only the single medium of publishing. The opportunity to earn royalties in the copying media is therefore of vital importance to them.

The legal basis for collecting royalties exists. Under the Copyright Act, the exclusive right to make copies of a copyrighted book—one copy (or ten thousand copies) of one page of the work or of ten pages, or of the entire work—belongs to the author. To make copies, his permission is required, and he can ask for payment as a condition for granting it. What is needed is an effective system for granting permission, for licensing the right to make copies.

The Alternatives.

There are two possible approaches to licensing. Authors and other copyright owners could establish licensing agencies, similar to ASCAP or BMI in the field of music, to authorize the copying of works owned by their members on a royalty basis. Or, authors and publishers could

ask Congress to aid them in licensing the right to make copies, by writing a "statutory licensing" system into the Copyright Act.

"Statutory licensing" would appear to be the more workable method. It could be supplemented by licensing agencies, to make arrangements with large users of copyrighted works, such as the research centers of industrial concerns. Licensing agencies and these users could agree on terms other than those provided in the Copyright Act, which might be more convenient to them, particularly where they are dealing with a comparatively narrow range of publications such as technical journals.

However, it is proposed that the starting point be a statutory licensing system that can serve all authors, publishers and users. A description of the proposed system appears below, followed by a discussion of its provisions, possible alternatives, and some of the problems involved.

The Statutory Licensing System.

1. *Summary.*

The Copyright Act would provide that any person could make a single copy of a specifically limited portion of a published, copyrighted work by paying the stipulated per-page/per-copy royalty. Non-profit educational institutions below the college level would pay a lower rate, and be permitted to make multiple copies for classroom use.

Payments would be sent to the publisher of the copied edition, at a central address (the same address for all publishers) in Washington, D.C.

The license would only permit the making of visible copies of published literary and dramatic works for normal reading purposes. It would not permit the making of tapes, recordings, films, translations or other new versions of a work.

2. *Extent of Copying Permitted.*

The statutory license would limit copying by a user in any 24 month period to no more than a given number of pages, or a stated proportion of an entire work, whichever was greater. Each contribution to an anthology or other collective work would be treated as a separate work. For example, the Act might provide that no more than 2 pages, or 2% of the total number of pages in a copyrighted work, whichever is greater, could be copied. Different limitations might

be specified for contributions to periodicals published quarterly or more frequently.

3. *Limitations on Number and Transfer of Copies.*

An individual could make a single copy for his own use and could not transfer it to others.

A non-profit educational institution could make one copy for each student in a class, for use in class room teaching. Copies could not be transferred to other students or other persons.

An employer could make a copy for each of his employees who actually required it in the course of his duties. Copies could not be transferred to other persons or other employees.

The user would be required to place on each copy the date the copy was made.

4. *Royalties.*

The royalty would be ϕ per page for each copy thereof.

Non-profit educational institutions below the college level would pay a lower royalty—e.g. $\frac{3}{4}$ or $\frac{2}{3}$ of the full rate.

5. *Method of Payment.*

Royalties would be paid by "copyright stamps", to be sold in various denominations by the Copyright Office, post offices and banks. Pitney-Bowes type meter machines could also be used.

The user would paste or meter-stamp copyright stamps in the amount of the royalty on a 4" x 6" card. On the same side he would write the name of the author and the publisher. That is all he need write unless he wants a receipt. In that event, he would also write in the title of the book, the number of the pages copied from, the number of copies, date of copying and his name and address; and add 5¢ to the fee.

6. *Place of Payment.*

All remittance cards would be mailed to

"Copyright Box
Washington, D. C. 20540"

The Box would be maintained by a Central Collection Agency, established by publishers under the Act.

The Collection Agency would sort the cards by publisher.

7. *Collection of Royalties.*

Each publisher would collect his cards from the Agency, record such data as he needed for disbursement of royalties to authors and other purposes, and collect royalties by redeeming the remittance cards at a disbursing agency (bank, post office or other agency designated in the Copyright Act.) The publisher would remit royalties to the author of the work in accordance with their contract, annually or semi-annually.

8. *Proof of Payment.*

The disbursing agency would cancel the stamps, on payment to the publisher. If a return address had been placed on the card, it would be mailed to the user as a receipt and proof of payment. If not, the card would be destroyed.

In any action for infringement, there would be a presumption that the statutory royalty had not been paid, if the person who made the copies could not produce a cancelled remittance card covering the work and pages copied, and the date of copying marked on the copies which were the subject of the infringement action.

DISCUSSION

Clearance.

With tens of thousands of copyrighted works, innumerable individuals and institutions as potential users, and uses varying from one or two pages to hundreds or even thousands of pages by large public and private organizations, a licensing system can only function effectively in the copying medium if every prospective user can easily determine what works can be copied, how much can be copied, what the fees are and where they are to be paid. "Clearance"—permission to make allowable uses—must be automatic, so long as the terms of the license are complied with.

Under a statutory licensing system, the Copyright Act, and each published work, provide the necessary information—and clearance. A licensing agency could only do this with comparable facility if an author had to make the choice of joining the agency or having his work copied without sharing in the royalties—which is simply another form of statutory licensing.

Limitations on the License.

It would be feasible to provide that a copyright owner could fix a different royalty or permissible copying limit, or prohibit copying

entirely, for a limited time after first publication. This could be done by a printed legend under the copyright notice. For example, a novel first published on May 1, 1965 might carry a notice:

“From May 1, 1965 to April 30, 1968, the maximum number of pages which may be copied under the Statutory Licensing Clause of the United States Copyright Act shall be pages, and the royalty shall be ¢ per page. After April 30, 1965 the rates and limitations specified in the Statutory Licensing Clause shall apply.”

or

“From May 1, 1965 to April 30, 1968, no license to copy any portion of this book is granted under the Statutory Licensing Clause of the United States Copyright Act. After April 30, 1968, the license granted by the Statutory Licensing Clause shall be available on the terms, and subject to the limitations, therein specified.”

Since any variation could not be changed once a book were published, and in the hands of the public, it would not be feasible to have it apply for too long a period of time.

Scope of the License.

It is intended that the Statutory License shall only permit the copying of published copies of literary and dramatic works and to allow the making of like copies of portions of such works. It is not intended to grant any other right to use these works. Whether the copying right should, or could fairly, be extended to paintings, illustrations, maps and other graphic material is not considered in this memorandum. The special problems involved, the high cost per page of publishing such works, and the impact that the copying of even a few pages could have, require further study by those groups most directly involved.

Limitations on the Extent of Copying.

It is essential that the Statutory License Clause set limits on the amount of any work that may be copied. This requires physical limitations as well as a fee that could make large scale copying impractical. Without restriction, copying might reduce the sale of published editions to the point where it would be impractical for authors to write and/or publishers to publish. Aside from the injury to both groups, this would defeat the purpose of the licensing clause—there would be little or nothing to copy from.

The Royalty.

No attempt has been made to suggest a royalty or the amount of reduced royalty for educational institutions below the college level. The royalty would have to be adequate enough to offset losses of sales and reasonable enough to compensate the author for his labor in creating the work, and the publisher for his investment and expense in producing the published book which makes copying possible.

Obviously, further discussion should be conducted between all groups affected and the Copyright Office to explore and develop a solution to this problem.

CAN THE SYSTEM WORK?

Obviously, the basic features of the proposed system will provoke doubts—and questions. Is it too burdensome or impractical to require users to furnish information as to each copying? Why use “copyright stamps”? Can publishers handle the collection of royalties, and their distribution to authors? Would it be necessary to “police” the system, and would it function without policing?

We can start judging the practicality of the proposed system at its starting point—payment of royalties on a per use basis.

Per-use Compensation.

A fundamental premise of this proposal is that when a work is copied, the royalty for that use be paid to its author and publisher. To accomplish this, the user must give the necessary, identifying information with his payment. He is the only one who can.

The only alternative to a per-use approach, and the *minimal* information it requires, is to distribute all royalties collected annually among the thousands of authors and publishers whose works are copied, on a sampling and averaging basis. While this may be suitable to the licensing of public performances of music, it would not be feasible for the types of uses that occur in the copying medium. ASCAP, the leading practitioner of the sampling and averaging approach, collects the bulk of its income by licensing radio and television stations, its principal customers, on a gross fee basis—fees based on the broadcasters' gross receipts. Obviously, licenses could not be issued on this basis in the copying medium.

True, it is possible that license fees could be paid for each copying without any accompanying information and in that event a sampling approach would have to be used. But could it work? ASCAP samples

performances, i.e., keeps records of representative numbers of performances of its members' compositions on a comparatively few radio and television stations throughout the United States—and from these projects the total number of performances each composition was likely to have had. These are *public* performances; they are checked by turning on a radio or television set. Copying is not public; and the number of users could be many times greater. Accurate sampling would be much more difficult; the projections might be harmful to individual authors.

Moreover, the sampling and averaging approach is complex—ASCAP takes other factors than number of uses into account. It is costly, possibly much more so than the cost of distributing royalties on a per-use basis. And, it is far from acceptable to all concerned; it produces considerable controversy as to whether various composers and publishers are receiving their fair share of the pool of royalties.

There is another factor to be considered. Composers are not required by statute to belong to ASCAP and accept its distribution system. But if Congress should adopt a statutory license, all authors and publishers would be subject to it. It is questionable whether Congress should, or could, require any author to make his work available without receiving the royalties paid for a given use of it. It should be remembered that the only license clause in the Copyright Act, the license to record copyrighted musical compositions, provides for per-use payment of royalties directly to the owner of the composition used under the license. And the user is required to furnish the copyright owner with a written statement of the number of records made during the month—under oath.

Filling Out the Remittance Card.

Requiring the user to provide the information necessary to distribute royalties would not place an unbearable burden on him. He is asked to write down on a card—names of the author and publisher. (Ultimately, the author's name might be replaced by a Library of Congress card number; the publisher's name by a code number printed in all of his books.)

If he wants a receipt he also adds the title of the book, his name and address, the date of copying, the pages copied and the number of pages.

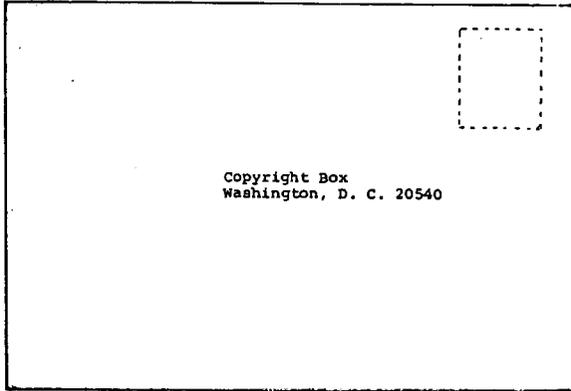
A school, business concern, library and other institutional user would be able to reduce the amount of writing even further by pre-printing or rubber-stamping cards with its name and address. The address of the collection agency would also be preprinted.

Moreover, the time needed to write even the maximum of information called for is negligible. Filling out requisition slips for library books has not broken the health or will of millions of readers in our libraries and schools over the last several decades. To get a book in the main reading room of the New York Public Library, for example—a reader must still write its title, the name of its author, its class mark (which he has to look up), and his name and address. The time this requires is not significantly less than the time it would take to complete the entire proposed remittance card. Certainly, if a school or business concern can afford the time needed to make copies of a work by ditto, mimeograph or multigraph machine, it can spare one or two minutes more. A person making a single copy solely for his own use would not ordinarily need a receipt. He would therefore only have to write in the publisher's name and address. Even if he filled out the entire card, the time involved is minimal.

For example, in less time than it took for a single copy of three pages of this letter to run through a Xerox 914 copier, the following information was filled in, and (simulated) remittance stamps attached: (The writing was done while *waiting* for the copies to come through the machine.)

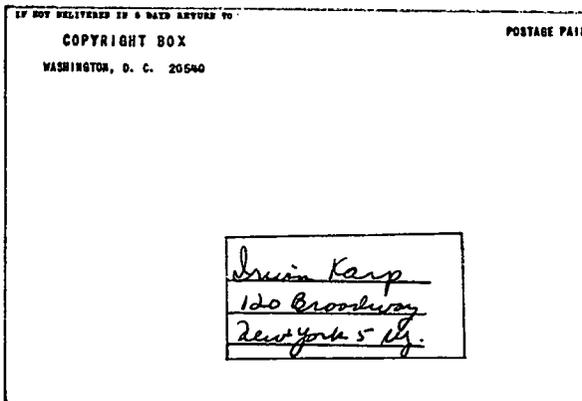
NAME OF PUBLISHER <u>MATTHEW BENDER</u>		PLACE COPYRIGHT STAMPS HERE. _____ OF PER COPY. AND IF RECEIPT IS REQUIRED.					
NAME OF AUTHOR <u>MELVILLE B. NIMMER</u>		U. S. S. S. U. S. S. S. U. S. S. S. U. S. S. S.		U. S. S. S. U. S. S. S. U. S. S. S. U. S. S. S.		U. S. S. S. U. S. S. S. U. S. S. S. U. S. S. S.	
IF RECEIPT IS DESIRED, CHECK. <input checked="" type="checkbox"/>		CONTRACT COPIES CONTRACT COPIES CONTRACT COPIES		CONTRACT COPIES CONTRACT COPIES CONTRACT COPIES		CONTRACT COPIES CONTRACT COPIES CONTRACT COPIES	
AND FILL IN: <u>Nimmer on Copyright</u> TITLE OF WORK		YOUR NAME AND ADDRESS: <u>Sandra Karp</u> <u>120 Broadway</u> <u>New York 5, N.Y.</u>					
<u>651-654</u> PAGE NUMBER							
<u>4</u> TOTAL NUMBER OF COPIES							
<u>12/15/64</u> DATE OF COPYING							

The reverse side of the card could be preprinted as follows:



Copyright Box
Washington, D. C. 20540

If a school, library or business concern wants a receipt, it would simply add 5¢ to the copying charge and fill in the necessary information. When a card is redeemed the disbursing agency would return it to the user in a "window glass" envelope; the return postage having been paid for by the additional 5¢ added to the fee. For example, the card shown above could be returned thusly:



IF NOT DELIVERED IN 6 DAYS RETURN TO

COPYRIGHT BOX
WASHINGTON, D. C. 20540

POSTAGE PAID

Irwin Karp
120 Broadway
New York 5 N.Y.

While it would be simpler for a user not to have to fill out anything, this would make the licensing system unfeasible. Only a miniscule effort is required by each user to make it work; and it is not unreasonable to ask those who would be able to make copies under the system to contribute to its successful operation. The fees, in many cases, will be pennies, but the cumulative effect upon the economy of writing could be highly significant. A few thousand individual uses, even at pennies each, could add several hundred (or more) dollars to the income of many authors. The effect can be appreciated if one considers the significance to a teacher or librarian of a \$500 or \$1000 raise. Since the average author's annual income is considerably lower than the teacher's or librarian's, the importance of any additional income, whether it be \$250, \$500 or \$1000 a year, cannot be over-emphasized.

The Central Collection Agency.

It is proposed that the remittance card for each copying use be sent to a Central Collection Agency established by the publishers under the Copyright Act. This will simplify the handling of remittances by users. It would not be necessary to mail each card to a separate publisher. Cards could be accumulated by schools, businesses and other institutions and mailed periodically. Arrangements could also be made for individual users who made copies on Xerox or coin operated machines in libraries and schools, to place their remittance cards in a central box for collective mailings to the collection agency. This would be more convenient for the user and reduce the cost of mailing.

On the other hand, it would obviously be an advantage to publishers to have each remittance card addressed to the publisher of the book, because the Post Office (rather than the collection agency) would be performing the first sorting function—directing each card and payment to the publisher of the particular book copied.

The Use of Stamps.

It is proposed that royalty payments be made by means of copyright remittance stamps to be sold to users by the Copyright Office, post offices and banks—and redeemed for cash by the publisher. The use of stamps for payment of various fees and taxes is, of course, common procedure in this country. Transfer and documentary fees, cigarette taxes, and other taxes are paid by having the payer purchase stamps and attach them to a document or product rather than pay the fee or tax by check, money order or cash. Moreover, the use of

stamps as a medium of exchange and payment is now engrained in our American economy and folkways. Let any one who doubts this try shopping at a supermarket.

A stamp system would be convenient for several reasons. It would enable institutional and private users to avoid the necessity of preparing checks, money orders and vouchers. With stamps attached to remittance cards, libraries and schools could accumulate and mail periodically remittances from individual users. If they had to take cash or a check for each use, this would be impossible. Stamp meters or dispensing machines could be attached to public copying devices, so that an individual user could purchase stamps while his copies were being made.

If a Central Collection Agency is to be used, a stamp system will facilitate the distribution of royalties to each subscribing publisher. Instead of depositing all receipts, keeping records and drawing checks to each publisher—the collection agency would only have to turn over the cards.

Questions may be raised as to whether the post office or other government agency would be willing to handle the preparation, sale and redemption of copyright stamps. The public interest is sufficiently involved so that it should. As an alternative, the Central Collection Agency could administer the sale and redemption of stamps. The costs could be defrayed by a "discount" from the copying royalties, paid by the agency or the government when stamps are redeemed. The Copyright Office, by regulation, could from time to time prescribe that a percentage of royalties would be retained by the government or disbursing agency when stamps are redeemed by each publisher.

The Distribution of Royalties.

Can publishers, and a central collection agency, handle the receipt and distribution of royalties? We believe it could be done without any real difficulty. At the outset, all of the royalties might have to go to meet the cost of handling. Ultimately, there would be a net gain to authors and publishers. Moreover, a minimum fee per use, e.g., 5¢ or 10¢, could be established to assure that the cost of administration could be met. (It has been suggested that it would not be worthwhile for a publisher to go to the trouble of dividing royalties with its authors. To meet that problem, a publisher could simply send on the remittance cards to its authors.)

The basic operations required (of a collection agency) to sort and distribute the cards to publishers, and (by publishers) to divide royalties with their authors, are simple enough. If individual pub-

lishers who have sufficient receipts to warrant the use of the machinery available to handle the job inexpensively, cannot afford the investment on an individual basis—this, too, could be managed collectively through the Collection Agency. Exaggerated fears over basically simple mechanical tasks should not stand in the way of a statutory licensing system.

Policing.

It has been argued that a statutory licensing system cannot be policed. This is an irrelevant objection. Statutory licensing cannot be policed any more, or any less, than violations of the basic copying right which occur whenever anyone makes a copy of a copyrighted work. Establishing a system by which copying can be done legitimately, on payment of royalties, would obviously not increase unauthorized copying—it would reduce it.

There is no reason to assume that schools, libraries and business concerns would violate the law or disregard the author's rights. It is more logical to assume that if a statutory system were established and made known to them—a not too difficult educational task—they would pay royalties voluntarily.

Moreover, it would not require more than one or two infringement suits, where unauthorized copying were detected, to stimulate compliance. Spokesmen for educational groups have asserted that teachers are now refraining from making copies for classroom use because they fear infringement suits. If they are not copying at all because of this concern, would it not logically follow that if the law provided them with a means of legitimately making copies—on payment of royalties—they would pay royalties to be able to copy without fear of suit.

The Public could easily be acquainted with the requirements of a Statutory Licensing System. Among other things, the Act could require that a statement of the provisions of the Statutory Licensing Clause be posted at every public copying machine, or similar facility.

Fair Use.

The doctrine of "fair use" cannot solve the problem. It does not permit the unauthorized making of copies. (See, for example, NIMMER ON COPYRIGHT, at the pages marked in the sample remittance card above.)

161. CHARACTERS — MAY THEY BE KIDNAPPED?

By FRANKLIN WALDHEIM*

Recently a new addition was made to the long line of athletes chosen to enact the part of "Tarzan" in motion pictures based on the famous stories of Edgar Rice Burroughs. Mr. Burroughs died in 1950 and it is understood that all rights relating to his works are now owned by Edgar Rice Burroughs Incorporated. The latter must have experienced a considerable degree of corporate shock recently when a Connecticut publisher placed on the market a certain paperback book. Over the lurid picture, on the front cover, of a man grappling with a lion, there appeared in large bold letters the title "TARZAN" and under the picture, in much smaller letters, a continuation of the title: "and the Silver Globe". Since this book was published without benefit of any permission granted by the author during his lifetime or by his successors in interest thereafter, it is not surprising that the Burroughs Company resorted to the courts.

The Connecticut publisher countered the charges leveled against it by asserting that the copyright to at least one of the "Tarzan" stories had been lost; and that therefore it was free to hire someone to write a new story about the public domain character, "Tarzan"—and that it was such a story which it published. "Not so," rejoined the Burroughs Company, "Even if you *were* right about the copyright (and you are not), you have no right to publish *new* 'Tarzan' stories. The public will believe that they were written by the author of the original 'Tarzan' stories—and that constitutes unfair competition."

This presents a problem which lies in the twilight zone between copyrights and trademarks—and it poses the question: "Characters—May They Be Kidnapped?"

Ordinarily, of course, there is no copyright protection in a character as such. As a California court said in *Burtis v. Universal Pictures*:¹ "Although it might be possible that an author could so carefully delineate a character as to secure a protectible property interest in that character, generally it is held that a character is not included within the monopoly of copyright". Or as the court said in *Nichols v. Universal Pictures*:²

* The author is a member of the Board of Trustees of The Copyright Society of the U.S.A. and Eastern Counsel of Walt Disney Productions. His article is an Address to the Patent Law Association of Pittsburgh, delivered on January 20, 1965.

1. 40 Cal.2d 823, 256 P.2d 933 (1953).
2. 45 F.2d 119 (2d Cir. 1930).

“It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”

Yet characters, as such, have often achieved a great value for their creators when they have become the subject of a series of copyrighted works—and it has seemed ethically wrong that such a character might be seized and exploited by anyone merely because copyright has been lost in one of the works of that series. In the California case of *Kurlan v. Columbia Broadcasting*,³ Judge Carter, in a dissenting opinion, said: “Characters and characterizations which are products of the mind *should* be held to be protectible property interests. The radio industry is a large one, and radio programs are frequently based upon a single character, personality or characterization. To illustrate the extremely valuable theatrical-radio properties which are in existence one only must look as far as the radio column in his daily paper to note the programs, built around a single character, or family, which continue from day to day, week to week, and year to year. It should be apparent to even the least intelligent that these programs are as valuable as the most gilt-edged security listed on the Stock Exchange. No court would hesitate to extend its protection to the lawful owner of a security, and yet equally valuable ‘character-types’ are not given the same protection.”

Perhaps characters are not as bereft of protection as this quotation implies. It might be interesting to note how characters have fared in the courts—and a good starting point would be the case of *Premier-Pabst Corporation v. Elm City Brewing Company*.⁴ Premier Pabst, maker of Pabst “Blue Ribbon” Beer, sponsored a weekly radio program featuring the band leader, Ben Bernie, who introduced himself each week as “Ben Bernie, your old Maestro”. The defendant adopted for its beer the name “Olde Maestro”, and Premier-Pabst sought an injunction against the continued use of this name. Here, then, we had the use merely of a sobriquet of a living personality who performed on a program which advertised the plaintiff’s beer. The late Judge Hincks, in deciding the case, pointed out that the common law has recognized from ancient times a man’s “exclusive right to the identity which he has established for himself”. As a competitive economy emerged, this right of identification was extended to include the goods of the individual as well; but in the march of commerce, skulduggery seems to have kept abreast of science so that new and more subtle means were found to violate the right of identity by introducing confusion into the public mind. The court found that the beer-purchasing public had in substantial part

3. 40 Cal.2d 799, 256 P.2d 962 (1953).

4. 9 F.Supp. 754 (D. Conn. 1935).

become impregnated with the conscious or subconscious association between "Old Maestro" (the characterization of Ben Bernie) and the plaintiff's products—and use of the defendant's name for its product was enjoined.

Coming closer to the question posed by the "Tarzan" case is the case of *Patten v. Superior Talking Pictures, Inc.*⁵ Here the plaintiff was the author of over 1,200 stories, known as the "Frank Merriwell Stories", all of the stories having the names "Frank Merriwell" or "Merriwell" in the titles and revolving around a central character called "Frank Merriwell". These stories achieved great popularity. The defendant proposed to release a series of motion pictures in which "Frank Merriwell" was part of the title. While the court held that the plaintiff's copyrights in the stories do not cover the titles to the stories, it enjoined release of the motion pictures and said: "A name which has become descriptive, and is closely identified in the public mind with the work of a particular author, may not, during the life of the copyright, be used so as to mislead . . . nor may such a name be used even after the expiration of a copyright, unless adequate explanation is given to guard against mistake".

Another character of fiction, "Stella Dallas", was the subject matter of a suit in *Prouty v. National Broadcasting Co.*⁶ The author of the novel of this name complained that the defendant was broadcasting skits as episodes in the life of "Stella Dallas", the character portrayed in her novel. They were, she claimed, of inferior artistic and commercial quality and a degradation from her novel. On a motion to dismiss the complaint, the court held that a cause of action was stated and reasoned that an injury to the author and a fraud upon the reading public constituted the real offense alleged.

In *Gruelle v. Molly-'Es Doll Outfitters*,⁷ the plaintiff had designed a doll in the form of a fanciful character, "Raggedy Ann". He wrote "Raggedy Ann" songs and "Raggedy Ann" books; and he syndicated "Raggedy Ann" cartoons in many papers. The court held that the plaintiff, by ceasing to use it, had abandoned any trademark in the dolls; but nevertheless the defendant was enjoined from selling similar dolls marked "Raggedy Ann". The court held that "'Raggedy Ann' is one in the public mind, whether she be personified by doll, cartoon, drawing, song or book. The valuable good will which Gruelle (the plaintiff) has built up in this character of his creation is being appropriated by the defendants as a result of use of the tag 'Raggedy Ann'

5. 8 F.Supp. 196 (S.D.N.Y. 1934).

6. 26 F.Supp. 265 (D. Mass. 1939).

7. 94 F.2d 172 (3d Cir. 1937).

upon the dolls of the defendants' design and manufacture". The law of copyright was not invoked in the action.

A case in which the plaintiff was a living personality, whom the public readily identified by his unique and comic voice, was that of *Bert Lahr v. Adell Chemical Company*.⁸ The defendant, in a cartoon commercial, used a duck with a voice which imitated that of Bert Lahr. The plaintiff successfully claimed that the defendant's commercial had greater value because the audience believed that it was listening to Bert Lahr and the court held that it could well be found that defendant's duck saturated plaintiff's audience to the point of curtailing his market. Here a well-known characterization of a comedian was held to have been wrongfully seized merely by an imitation of his voice.

Another case of similar import arose in California and involved Charlie Chaplin. In that case, *Chaplin v. Amador*,⁹ the defendant used the name "Charles Aplin" and also used Charlie Chaplin's style of dress and mannerisms. He was enjoined from using both the name and Chaplin's unique style of dress and mannerisms. Here again a character, which had been impressed upon the public consciousness by the unique performance of an actor, was protected from appropriation by a third party.

Another character, which became well-known to the public through the medium of radio, was that of the "Lone Ranger", who thrilled his young audience with his "Hi-Yo Silver" and "Hi-Yo Silver, Away". In *Lone Ranger v. Cox*,¹⁰ the defendant was enjoined from continuing his practice of using the name "Lone Ranger" or the phrases "Hi-Yo Silver" and "Hi-Yo Silver, Away". The court held that the deception practiced by the defendant upon the public was unfair competition and that the plaintiff was entitled to protection against any persons who led "the public to believe that there is some connection or association with . . . the character of the program". Similarly, in *Lone Ranger, Inc. v. Currey*¹¹ the defendant was not only enjoined from using the name "The Lone Ranger" but from portraying any or all of the distinctive garb and characteristics of the "Lone Ranger" or his horse or his Indian companion.

A recent case involved four young men who have developed a characterization which startles our generation but which draws hysterical yelps of delight from our younger set. They are, of course, the "Beatles".

8. 300 F.2d 256 (1st Cir. 1962).

9. 93 Cal. App. 358, 269 P. 544 (1928).

10. 124 F.2d 650 (4th Cir. 1942).

11. 79 F.Supp. 190 (M.D. Penn. 1948).

In *Remco Industries v. Goldberger Doll Manufacturing Company*,¹² it appears that the plaintiff had acquired a copyright in four sculptured doll figures which were created as works of art and which resembled the "Beatles". The plaintiff had also acquired from the "Beatles" themselves the exclusive license to manufacture dolls in their likeness. It placed these dolls on the market and on each package imprinted those immortal words of the "Beatles": "Yeah, Yeah, Yeah". The defendant manufactured, without benefit of any license, dolls which resembled the "Beatles" and called them "Yeah, Yeah Dolls". Although the case was treated as a copyright case and the defendant was enjoined from making its dolls because of their resemblance to the copyrighted sculptures, the court further enjoined the manufacture of a doll having certain specified characteristics "associated with the Beatles". The characterizations which these four men had created were once more protected by the courts.

In *Wyatt Earp Enterprises v. Sackman*,¹³ the plaintiff had popularized a television series featuring Wyatt Earp, an historical person. It licensed various manufacturers to produce "Wyatt Earp" merchandise one of whom was the defendant, which produced "Wyatt Earp" costumes. When its license expired, and without benefit of any renewal, the defendant continued to sell such costumes and marked them "Wyatt Earp". Despite the fact that Wyatt Earp was a character of history, the court held that, by reason of the television series, the name "Wyatt Earp" had become associated in the minds of the public with the television program, and the defendant was enjoined from continuing to sell "Wyatt Earp" costumes.

Perhaps the leading case on this subject is *Fisher v. Star Co.*,¹⁴ decided by the New York Court of Appeals in 1921. Bud Fisher created and for several years drew a series of comic strips utilizing two cartoon characters called "Mutt" and "Jeff". The comic strips containing these two characters were published in newspapers and became well-known. Several books of "Mutt & Jeff" cartoons by Bud Fisher were published and between 300,000 and 400,000 copies of the books were sold. When Fisher severed his connection with the Star Company and drew his cartoons for another syndicate, similarly engaged in licensing the publication of the cartoons in various newspapers, the Star Company engaged its own artists to continue drawing new "Mutt & Jeff" cartoons. The court affirmed a judgment of the lower court which enjoined the Star Company from publishing, advertising or selling any cartoons not drawn by Fisher which were, however, drawn in imitation of Fisher's cartoons

12. 141 U.S.P.Q. 898 (E.D.N.Y. 1964).

13. 157 F.Supp. 621 (S.D.N.Y. 1958).

14. 231 N.Y. 414.

of the characters "Mutt" and "Jeff" and so like the "Mutt & Jeff" cartoons drawn by Fisher as to be likely to deceive the public into believing that the said imitation cartoons were Fisher's genuine "Mutt & Jeff" cartoons. Although one of the seven judges dissented on the ground that plaintiff sought to maintain rights which could only be had under the Copyright Law and that under that law the plaintiff had no rights, the majority held that:

"The figures and names have been so connected with the respondent as their originator or author that the use by another of new cartoons exploiting the characters 'Mutt and Jeff' would be unfair to the public and to the plaintiff. No person should be permitted to pass off as his own the thoughts and works of another.

"If appellant's employees can so imitate the work of the respondent that the admirers of 'Mutt and Jeff' will purchase the papers containing the imitations of the respondent's work, it may result in the public tiring of the 'Mutt and Jeff' cartoons by reason of inferior imitations or otherwise, and in any case in financial damage to the respondent and an unfair appropriation of his skill and the celebrity acquired by him in originating, producing and maintaining the characters and figures so as to continue the demand for further cartoons in which they appear.

"The only purpose that another than respondent can have in using the figures or names of 'Mutt and Jeff' is to appropriate the financial value that such figures and names have acquired by reason of the skill of the respondent".

Running through all the cases here cited there is a single thread by which they hang together. In each of them the character was associated with and therefore identified the author or the characterization identified the performer. The use by another of this identification was an invasion of the author's or the performer's right to his identity and it is this right which the courts protected.

With the vast enlargement of the media of communication in our time, the value of characters used in any series of works has greatly increased. Characters used in one medium, such as plays or books, can be used serially in other media, such as comic strips, radio and television. The many available avenues of publicity, through newspaper columnists, magazine writers and radio commentators, have made it possible to impress the importance of a character upon the minds of the public. Thus, that demure young woman called "Mae West" has impressed upon millions of people the image or characterization of herself in the role of "Diamond Lil" which has been the prototype for her per-

formances in numerous other roles. Only recently the press reported that a decision handed down in Superior Court in Hollywood enjoined another performer from using the name "Diamond Lil"—the court holding that since 1928 Diamond Lil has been identified, both in the theatrical profession, the press and the public, with Miss West and that the other performer had adopted the name for the purpose of trading on its value in obtaining employment.¹⁵

The need for protecting characters has apparently been realized in Mexico for an amendment to the Mexican Copyright Law has added a new Article 25, which provides for reserving the exclusive use and exploitation of fictitious characters in literary works, pictures or drawn stories, or in any periodic publication, when the characters have a significant originality and are habitually or periodically used—this reservation applying also to human characterizations used in artistic performances. What Mexico has provided by statute our courts are prepared to provide under our concepts of the law of unfair competition. They have come a long way from the viewpoint of an earlier day such as the one in the *Nick Carter* decision of 1913. In that case, *Atlas Manufacturing Co. v. Street & Smith*,¹⁶ decided by the Circuit Court of Appeals for the 8th Circuit, it appeared that the plaintiff was the publisher of a series of detective stories, which had been published weekly for many years under the title "Nick Carter", the story revolving around a character of that name. The defendant advertised its intention to release a motion picture under the title "Nick Carter, The Great American Detective, Solving the \$100,000.00 Jewel Mystery". The plaintiff, which had taken out no copyright upon any of its publications, sought an injunction against the release of the motion picture. The Appellate Court dismissed the bill although one of the judges, even in that day, dissented by saying:

"My objection to the above conclusion can be expressed in a sentence: The defendants are engaged in appropriating the fruits of complainants' current endeavors, and are deceiving the public".

It is interesting to note that "Nick Carter" again appears in the news seeking the same protection which had been denied to him more than half a century ago. The trade paper, *Variety*, reported last year that Conde Nast Publications had acquired all rights to the "Nick Carter" stories from Street & Smith and that it planned to take steps to prevent a French producer from filming three feature-length pictures based on the character of "Nick Carter, Detective" (notwithstanding

15. *West v. Lind*, 144 U.S.P.Q. 160 (Calif. Super. Ct. 1964).

16. 204 Fed. 398 (8th Cir. 1913).

the fact that no claim was made that the "Nick Carter" stories were protected by copyright).

The question, of course, occurs: Does the protection of such characters serve to extend the copyright monopoly beyond the copyright term? Upon reflection it becomes apparent that it does not. When the copyright expires in a work using a certain character, anyone is free to reproduce that work. But to write and publish a new work utilizing the character is another matter. The public will assume that the new work emanates from the creator of the original work—and thus the public is misled and the original creator is deprived of good will and property rights belonging to him.

A well-known character is analogous to a trademark. Indeed, considering its essential significance, it *is* a trademark. A certain character, which has appeared in a series of stories, radio or television programs, comic strips or motion pictures, signifies to the public that it is the product of the creator of the works which previously used that character. Does not the character thus achieve a trademark significance? If a housewife sees a package of pancake flour on which is depicted a Negro mammy with a bandana about her head, she knows that that is "Aunt Jemima" pancake flour and that it is made by the same company which makes the pancake flour which she has previously purchased. She may not even know that the flour is packaged by the Quaker Oats Company—but it is sufficient that she knows that it comes from the same source from which other flour bearing that picture emanated. Trademarks are usually static and do not change their appearance—although they do change with the times as, for example, that diaphanously garbed young lady contemplating a spring of "White Rock". The important thing is that the people associate the symbol with the product. There is no less reason why the character of a series of works, having always the same attributes and being readily recognized as the same character, does not declare to the viewer or reader that it is the product of the same creator.

Of course, over any consideration of principles related to trademarks or copyrights, there now hovers the shadow of the *Sears, Roebuck*¹⁷ and *Compco*¹⁸ cases. Does the Supreme Court imply by these cases that the only rights inhering in a character are those which are afforded by the copyright law? The Court did not so hold. There is no copyright protection in a character as such—so we are not here dealing with a matter of copyright protection. According to the *Sears* and *Compco* cases the design of an article may be copied if it is not susceptible to

17. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

18. *Compco Corp. v. Day-brite Lighting*, 376 U.S. 234 (1964).

protection by a design patent. By the same reasoning a story containing a character may be copied when that story is not protected by copyright. But when the character in that story has become a means of identification of a series of stories emanating from the same creator, the character then has become a trademark. The Supreme Court has re-affirmed in its opinion that a State "may protect businesses in the use of their trademarks, labels or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods." The appropriation of someone else's well-known character in a new work has the same effect as the use of another's trademark—and such characters may be protected from kidnapping.

In this connection, the writer has given thought to certain characters who must, at some future time, surrender the shield of copyright. One of them is an actor named "Mickey Mouse". It would not seem fair that this well-known performer could, in that day, be forcefully impressed into the service of every artist who chooses to use him; that his personality and his appearance could be altered to suit each new master's whim; that all standards by which he has been guided could be abandoned; that his fall from grace would be attributed to his original creator; and that his unlimited appearances before the public in countless guises could surfeit his audiences and could make them want to see no more of him or his friends.

The law does not seem to favor so unpleasant a prospect.

162. THE QUEST FOR INTERNATIONAL UNIFORMITY IN THE LAW OF DESIGNS AND ITS RELATION TO THE LAW OF COPYRIGHT.

By JAMES W. MILES*

The establishment or the improvement of the law of designs and international uniformity in regard to its basic principles are current problems in a wide range of industrial countries and this, in its intimate relation to the protection of applied art by copyright, will come up for discussion and decision at the Conference for the Revision of the Berne Copyright Convention at Stockholm in 1967.

The Stockholm Conference will mark the commencement of a new era in the administration and operation of both the Berne Copyright Union and the Paris Convention for the Protection of Industrial Property.

As a result of the decision of the Joint Meeting of the United Bureaux of the International Union for the Protection of Intellectual Property (BIRPI) and the Permanent Committee of the International Union for the Protection of Literary and Artistic Works, it is proposed, in effect, to reorganize, extend and strengthen the United Bureaux at Geneva so that they are better equipped to carry out the administrative functions of the Paris Union for the Protection of Industrial Property, the Special Agreements established in relation with that Union, and the Berne Copyright Union.

The new Organization is envisaged as a worldwide forum for industrial property, copyright, and related questions, and a committee of experts from the principal member States, in association with those of the United Bureaux, will examine the draft of the new Administrative Convention this year.¹ One of the greatest defects of the Berne and Paris Conventions has been in the administrative clauses, with the result that for many years the work of the United Bureaux has been handicapped, particularly in the intervening periods between the conferences of revision. These conferences of revision themselves have been unable, in the time available, to give the expert consideration which the in-

* Dr. Miles, a Barrister of the Supreme Court of New Zealand, has been delegate from his country to various international conferences and has written extensively on the subject of the international protection of designs. Cf., "International Aspects in Regard to the Protection of Industrial Designs," 8 BULL. CR. SOC. 149 (1961) and "Copyright Legislation in New Zealand Affecting Artistic Works," 10 BULL. CR. SOC. 209 (1963).

1. See *Le Droit d'Auteur* 148, No. 9, September 1964.

creasingly more complicated problems require. The preparatory work for these periodic conferences of revision is also highly technical and specialized and the problems to be dealt with become more difficult comparable with the great development of modern technology.

The successful formulation of both the Berne and Paris Conventions, more than three-quarters of a century ago, arose out of the practical necessity for a rational and equitable basis of international cooperation between the rapidly developing industrial nations, and the basic principles so established have not been fundamentally changed. This is a tribute to the wisdom of the founders in formulating wide principles which would not only achieve the immediate objective of international cooperation, but which were also capable of being developed to strike a reasonable and satisfactory balance between the just and necessary recognition of the proprietary rights of the author and inventor on the one hand, and those of the public on the other. Nevertheless, these comparatively modern branches of law—industrial property and copyright—require at each revision of those Conventions, adjustment and modification, and the very rapid advances in technology in recent times have greatly complicated the issues.

The crux of the matter is the need of a more modern organization of the United Bureaux at Geneva to provide an efficient and permanently functioning combined central organization for the administration of these Conventions.

In the case of the Berne Convention, it was undoubtedly a stroke of genius that visualized the possibilities and great advantages of "protection without formalities". This was a conception quite opposed to existing legal principles, and a logical assessment at that time could quite reasonably have forecast that this was Utopian and idealistic—but not practical. The amazingly successful results have been beyond the anticipation of many of those who were favorably disposed to this objective. Today it is reasonable to say that the commercial and industrial advantages of international protection by copyright, under the Berne Convention, without formalities and without cost, are inestimable.

This international copyright protection under the Berne Convention also embraces in most countries the protection of applied art, and because of the valuable features of this form of protection—no formalities, immediate application, and wide international cover—it provides a major contribution to the overall problem of the present day need for the national and international protection of industrial designs. Although the two terms are not synonymous, a large proportion of industrial designs are in the category of applied art.

The present day overall problem arises out of the following factors:

1. The vital importance of artistic design in all branches of industrial production.
2. The subject matter of the whole problem embraces applied art in the field of copyright, and industrial designs or designs and models in the field of industrial property law, and the basic principles of these two branches of law have fundamental differences.
3. There is a long history of conflict of opinions in regard to the overlap between applied art and industrial designs.
4. Design law has been the Cinderella of industrial property law and in many industrial countries there is a need for its establishment or improvement.
5. The fact that this has been a long standing problem at international conferences for the Revision of the Berne Copyright Convention and the Paris Convention for the Protection of Industrial Property makes this modern development of particular importance and interest to all member states of those Conventions and in particular to the United Bureaux at Geneva.
6. A minority of Berne Convention countries take the view that applied art, coming within the category of industrial designs, should not be protected by copyright law.

In making a constructive examination of the problem it is necessary to keep all these factors in mind, and to clarify the position in regard to the essential issues.

COPYRIGHT LAW ASPECT

The oldest and most important single aspect of the whole problem is whether applied art is legitimately within the scope of copyright; it is, therefore, appropriate to deal with this aspect first. It is the most important, by virtue of the existing wide national and international protection of this subject matter in Berne Convention countries, and the value of this legal protection in international trade is very considerable indeed. The real roots of this aspect of the problem lie in the overlap between those forms of artistic works which are applied in industry, and the category of works coming within the scope of the design law—works which are now commonly designated under the single term of “industrial designs”.

If there is no artistic work involved, there is no problem because there can be no question of applied art. "Artistic works" are, of course, clearly within the scope of the Berne Convention and the ordinary law of copyright, and there is no suggestion that this should not continue.

Although "applied art" or "works of art applied in industry" were not specifically enumerated in the Berne Convention when it was formulated in 1886, the interpretation of the majority of member states has always been that such works are within the normal scope of copyright as artistic works, because merit, purpose or objective, has no disabling effect on the acquisition or enjoyment of the right of copyright.

At the Conference for the Revision of the Berne Copyright Convention at Berlin, in 1908, this majority view was not accepted by a minority of two because, inter alia, it was considered that it was in conflict with the industrial property law for the protection of industrial designs.² The view of the majority at Berlin was that the conception of creating an artificial barrier to divide "pure art" from "applied art" was not either feasible or necessary and that such works, whatever their merit or purpose, came within the definition of "literary and artistic works". Although unanimity was not achieved at Berlin, this majority view has been maintained and has been strongly supported by the International Bureau at the Conferences for the Revision of the Berne Convention of Rome in 1928 and at Brussels in 1948 where success was finally achieved in specifically including "works of applied art" in Article 2 of the Convention as being within the meaning of the term "literary and artistic works". Recognition was given to the minority view by the retention of the reservation in paragraph 5 of Article 2 which reads as follows:

It shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected.

Works protected in the country of origin solely as designs and models shall be entitled in other countries of the Union only to such protection as shall be accorded to designs and models in such countries.³

2. Great Britain and Switzerland; Switzerland has since adopted the majority view.

3. See also: Para. 4, Article 2, Berne Convention, Berlin Text, 1908.

The present position is that this majority view in regard to the protection of applied art by copyright as a Berne Convention principle, has been confirmed in the national law of copyright of most Berne Convention countries.⁴ Two of the latest countries to confirm the majority view are Sweden in 1960, and New Zealand in 1962.

The history of this change in the copyright law in New Zealand is of considerable interest:

- (a) in regard to the present overall problem now under consideration in other countries of the British Commonwealth; and
- (b) in regard to Berne and Paris Convention aspects with which the United Bureaux at Geneva are particularly concerned.

The importance of the relationship of applied art in regard to the development and improvement of the law of designs was recognized by the Lisbon Conference of 1958 for the Revision of the Paris Convention for the Protection of Industrial Property, and a Special Resolution of that Conference relegated the whole matter for study by a Committee of Experts representative of both of these fields of law.⁵ This meeting was held at Unesco House at Paris on April 20-23, 1959. Not much progress was made in achieving greater uniformity in either of these aspects. Nevertheless, this international Study Group did provide the opportunity for a constructive examination of the conflicting points of view, and in the result it was agreed that each country should be free to continue its own protection under copyright or design law, or both, and that the forthcoming Revision of The Hague Arrangement in 1960 should concern itself only with designs and models without prejudice to the existing position of applied art.⁶ This, in effect, represents a good deal of progress because it is further confirmation of the Berne Convention principle and its wide application in the national law of copyright, and of the principle of the "totality of copyright" in some countries outside the Berne Convention.

The conclusions of this Study Group were followed at The Hague Conference of 1960 which, although it confined itself to industrial designs, safeguarded the existing position in regard to the protection of applied art by Article 18 which reads as follows:

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4. These countries include: Austria, Belgium, Czechoslovakia, Denmark, Finland, France, Germany, Greece, Iceland, Italy, Liechtenstein, Monaco, Netherlands, Norway, Rumania, Spain.
 5. Resolution No. VII Lisbon Conference 1958.
 6. See *Industrial Property Quarterly* 41-42, No. 3, 1959.

The provisions of this Agreement shall not prevent the claiming of the application of possible wider protection resulting from the national law of a contracting State, nor shall they affect in any way the protection which is granted to works of art or works of applied art by international copyright treaties or conventions.

DESIGN LAW ASPECT

The protection of industrial designs under the design law has assumed a new and greater significance in recent times⁷ and this has become progressively more important in recent years.⁸ Although there has been an obligation upon member states of the Paris Convention of 1883 to protect industrial designs, this protection has been largely ineffective both nationally and internationally.⁹ While it has served some industries well and continues to provide a useful protection, it does not, of itself, provide an adequate protection for the whole field of industrial designs which embraces that of applied art as well as that covered by the scope of industrial designs under the design law. From the beginning, the conditions attaching to registration or deposit and the diversity of formalities in different countries have often resulted in insuperable difficulties.¹⁰ Various solutions have been suggested over a very long period, such as abandoning designs as a separate form of industrial property altogether, and incorporating the whole subject matter to the extent appropriate within the copyright and patent laws, respectively. No satisfactory solution has been found. The Arrangement of The Hague in 1925 was an attempt to improve the position by a system of international deposit or registration, but it has not achieved the hoped for success. The inherent difficulties of formalities, onerous conditions, and cost, remain and the limited nature of the international protection is also a factor which has militated against its success. No spectacular improvement can be expected from the Conference at The Hague in 1960. The new Agreement of 1960 for the International Deposit of Industrial Designs was signed by only 11 countries and is not yet in force.

The conclusions that can be drawn from an examination of the discussions and results of these various international meetings and conferences dealing with the protection of industrial designs from the design law angle, appear to be that:

7. Ladas, *INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY*, 369.

8. See *Industrial Property Quarterly* 57, No. 1, 1960; 260, No. 4, 1961.

9. Ladas, *op. cit.*, 366, et seq.

10. *Ibid.*

- (a) there is no simple solution to the problem of international protection of industrial designs under the design law by a system of international registration;
- (b) in the fast moving tempo of modern international trade a system of national protection under a sui generis design law is necessary;
- (c) a relaxation of the conditions and formalities to obtain protection under the design law is of primary importance;
- (d) international cooperation to achieve greater uniformity in the development of the design law to meet modern conditions of trade is desirable and likely to be of value;
- (e) a single system for the protection of industrial designs embracing both applied art and designs and models is not a practical possibility; it appears clear that copyright law in relation to applied art and design law in respect of industrial designs are each necessary to play a separate but complementary role in meeting the needs of industry. The question whether this is cumulative or alternative must be left for decision under the national law.

The dual aspect of the overall problem becomes more apparent in countries where protection for industrial designs exists only under the design law, such as the United Kingdom, where, notwithstanding the great increase in the range and importance of artistic design in industry,¹¹ the numbers of registered designs have shown a decline.¹² The need of a more effective protection for industrial designs in the United Kingdom has been realized for many years and this was the reason for the setting up of the U.K. Designs Committee 1959 to which the terms of reference included:

consideration of the desirability of enabling U.K. designs to receive cheap and effective protection in other countries on the basis of reciprocity.¹³

The conclusion of this Committee confirmed that there was dissatisfaction with the operation of the design law and substantial support for the application of the principles of the law of copyright to industrial

11. See *Reports of The Council of Industrial Design* (U.K.).

12. *Report of Departmental Committee on Industrial Designs* (Appendix F.), 135, (Cmnd. 1808).

13. *Ibid.*, 5.

designs.¹⁴ The Committee in its report stated that an effort had been made to discover how far these principles have been applied before to industrial designs.¹⁵ In these circumstances it is surprising that the Report makes no mention at all of the Berne Convention, nor is any study made of the long history of the majority view in regard to applied art in Berne Convention countries and at the successive Berne Convention Conferences; nor of the existing wide international protection of industrial designs in this category. It is obviously necessary to consider this vital evidence before one can assess the value of this Report, either in its recommendations for changes in the national law, or in its international aspects.

In the reviews of this problem by British Departmental committees it has apparently been assumed on each occasion that the original minority view at Berlin in 1908 need not be reconsidered and that the problem before the committee on each occasion was merely to review and improve the law which carried this minority view into effect, and it has apparently been assumed that the legal principle making copyright and design law mutually exclusive need not be re-examined. This legal principle, admittedly peculiar to English law, has at subsequent copyright and industrial property conferences been defended by British delegations with ingenuity and tenacity against the majority view. Nevertheless, it appears obviously necessary to consider this whole problem in its international aspects and to investigate the U.K. position and point of view, *de novo*, in a comparative study of the majority Berne Convention view from the records of these conferences and as embodied in the national copyright law in most of the other countries of the Berne Convention. Because this has not been done, the impressive evidence from the Berne Convention Conferences and from the many Berne Convention countries who have maintained this principle in their national copyright law from the inception of the Berne Union, has not been considered by these British Departmental committees. It has (no doubt for this reason) gone unnoticed that, by attempting to make copyright and design law mutually exclusive, U.K. copyright law has gone much further than necessary, in giving effect to the Berlin minority view, and in doing so has given rise to a further difficulty and anomaly. The creation of an arbitrary line of demarcation between these two branches of law has had the result that United Kingdom copyright law has the unique peculiarity of excluding an artistic work from copyright merely by reason of its reproduction in more than 50 copies. The United Kingdom Design

14. *Ibid*, 7, para. 4.

15. *Ibid*, 25, para. 38.

Committee does not recommend any alteration to this criterion and the report virtually deals only with the situation peculiar to English law. Its contribution to the international aspects of the whole problem appears to be mainly to illustrate the difficulties that flow from, or are incidental to, the carrying into effect of the minority view at Berlin in 1908. This attempt to segregate the copyright and design law as has been done in the United Kingdom Copyright law is not a necessary consequence of the view taken by the minority at Berlin. It would, for example, have been possible to refuse to specifically include "applied art" in Article 2 of the Berne Convention and leave the ambit of "artistic works" to be decided by the courts in the interpretation of "artistic work" under the U.K. Copyright Act of 1911 without any necessity for the introduction of Section 22 of that Act.

It may be of assistance by way of contrast and comparison to examine the position that would apply if the minority view at Berlin in 1908 had not been so given effect to in the U.K. Copyright Act of 1911.

1. It would mean that an artistic work, whatever its utilitarian purpose in industry, would be entitled to copyright under the same conditions as "pure art".

The proportion of "pure art" in the total field of copyright however, is comparatively small. Since the dawn of history, art and utility have been inextricably interwoven, and this indeed is the factual position in regard to a very large proportion of the total field of copyright today.

2. There would be no new criterion necessary. The question would be simply whether or not the subject matter comprised an artistic work. In the comparatively rare cases that a judicial decision would be necessary, the matter could be safely left to the courts to decide.¹⁶
3. From the point of view of jurisprudence there is no legal objection or difficulty in two or even more branches of law covering the same subject matter, and even though applied art could come within the scope of both copyright and the design law, no definition of "artistic work" would be necessary, or desirable.

16. See also: J-L Duchemin, *Revue Internationale du Droit d'Auteur*, 325, No. XIX, April 1958; Ladas, *INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY*, 261.

4. The fact that the case law in regard to the protection of applied art under the copyright law is interpreted differently in different Berne Convention countries does not detract from the validity of this copyright principle itself.

In many branches of law we have decisions in borderline cases that are difficult to reconcile but this does not detract seriously from the value and importance of the law as a whole. In this connection we may cite patent law, trademark law as well as design law.

5. In regard to copyright, the great value is that this branch of law in Berne Convention countries works amazingly well with extremely little litigation in relation to the enormous amount of subject matter covered and the wide territorial extent of its international operation—without any formalities.

The value of this branch of law in the protection of applied art in Berne Convention countries scarcely needs stressing.

6. The fact that the term of copyright is often longer than necessary is not a serious objection. In the case of ephemeral works the right ceases to be of any value or interest after the ephemeral life has expired, and since copyright is only a protection against copying, this right, even for a long term, does not preclude others from creating similar original works.¹⁷

In any case, the question of a shorter term for some works, e.g. photographs, anonymous works etc., is a separate issue, and one which does not adversely affect the fundamental rights which copyright confers.

GENERAL CONCLUSIONS

The problem of evolving greater uniformity and reducing formalities and costs in the development of design law in Paris Convention countries and in achieving progress in the international registration or deposit under the Arrangement of The Hague, is relatively much more difficult and complicated than that of achieving greater uniformity in the national and international protection of industrial designs in the category of applied art under the law of copyright. As in the field of patent law, differences in the national law in regard to definitions, procedure, and costs, are likely to continue to cause difficulties which may sometimes be insuperable. Nevertheless, international agreement

17. *Ibid*, §70.

upon general principles can alleviate the situation. By comparison with copyright under the Berne Convention, however, these factors, which are necessarily incidental to a registration system, must inevitably result in limiting the extent to which registration under the design law can meet the present day needs of industry. In regard to international protection, The Hague Agreement of 1960 may yet prove of considerable value and the work done in regard to a common law project for designs for the Benelux countries could lead to similar projects for the EEC and EFTA countries.

The extensive research work carried out in the United States has resulted in general and official agreement in a wide range of interested circles that progress in the establishment and development of a design law to serve the needs of modern industry need not, and should not, be at the expense of the copyright law¹⁸ and this principle is in line with Article 18 of the Agreement of The Hague of 1960.

For several years a great deal of work has been done at the U.S. Copyright Office and in U.S. Senate Committees in regard to a complete revision of the U.S. copyright law and for the establishment of a design law for the protection of artistic design in industry.

In regard to the protection of applied art and its overlap with copyright, this work represents a continuation of the work of the Study Group at UNESCO in Paris in 1959—on a much bigger program, with greater facilities for research, and continued to finality.

The work in regard to the same overall problem in Sweden and New Zealand has been in line with substantially the same program—of considering the closely interrelated aspects of applied art and its design law implications, at the same time. From this vast amount of work and research, there emerges convincing confirmation of the majority view at the Berne Copyright Conferences of 1908, 1928, and 1948 that applied art is legitimately within the scope of copyright.

In regard to the United States the confirmation of this principle in Section 111 of the Copyright Bill just introduced in the 89th Congress will be of great value. The fact that this is the first comprehensive revision of U.S. Copyright law for over 50 years gives added value to the final conclusions taken after a great deal of deliberation.

In this and other important matters the bill will bring U.S. Copyright law in line with most other major industrial countries and this, of course, will be of great practical value in regard to international copyright protection.

18. See U.S. Design Bill, H.R. 3366, Section 27 (1965); and the U.S. Copyright Bill, H.R. 4347, Section 111 (1965).

The radical change in the copyright law of New Zealand which is, in effect, a recognition of this same principle in regard to applied art, also represents progress towards greater international uniformity. This, and the developments in Brussels, Sweden and the United States will provide useful evidence for other countries such as Australia, Canada, South Africa and the United Kingdom when considering the Berne Convention and other international aspects of this world-wide problem.

A comprehensive review of all these developments at the Stockholm Conference will be necessary and decisions there are likely to have far reaching effects in regard to the scope and operation of both the Berne and Paris Conventions. The issues affecting the future development and operation of these Conventions and the United Bureaux are vital ones. Included among them is the need for a final confirmation by the Conference that both Conventions are complementary in the protection of industrial designs and that the existing international protection of applied art does not adversely affect the improvement and development of the design law, either nationally or internationally.

There seems little doubt that recognition of this basic principle at Stockholm would remove many obstacles and pave the way for progress in making modern design law play a more effective role in meeting the needs of industry and international trade.¹⁹

19. One important principle in the new United States Design Bill would be of great value in the national design law of many British Commonwealth and other Paris Convention countries—that of conferring protection from the date of publication and allowing a reasonable period after that date for making application for registration. In the United Kingdom and other countries the condition of non-publication prior to the date of application has resulted in serious loss of protection in many industries. See H.R. 3366, Sections 4 and 9 (1965); see also: Canadian Industrial Designs Act, Section 14.

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. UNITED STATES OF AMERICA AND TERRITORIES

163. U. S. CONGRESS. HOUSE.

H.R. 4332. A bill for the relief of the Students' Association of the University of Texas. Introduced by Mr. Pickle, February 3, 1965, and referred to the Committee on Interstate and Foreign Commerce. 2 p. (89th Cong., 1st Sess.)

A private bill which proposes "that the Students' Association of the University of Texas shall have the exclusive right in interstate commerce to use, copy, and sell and to control the use, copying, and sale of the song entitled 'The Eyes of Texas.'"

164. U. S. CONGRESS. HOUSE.

H.R. 5514. A bill to provide injunctive relief from activities which dilute the distinctive quality of a trademark or trade name or which otherwise constitute unfair commercial activities. Introduced by Mr. Lindsay, February 25, 1965, and referred to the Committee on the Judiciary. 5 p. (89th Congress., 1st Sess.)

A bill, providing, in effect, for a federal law of unfair competition. The bill, which is essentially similar to H.R. 4651 introduced by Mr. Lindsay in the 88th Congress, and to bills introduced in earlier Congresses, was referred to the Judiciary Committee, while the previous bills were referred to the Committee on Interstate and Foreign Commerce. See 10 BULL. CR. SOC. 255 and 256, Items 271 and 273 (1963).

165. U. S. CONGRESS. HOUSE.

H.R. 5680. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. St. Onge, March 2, 1965, and referred to the Committee on the Judiciary. 39 p. (89th Cong., 1st Sess.)

Identical with H.R. 4347 and S. 1006 of the same Congress; see 12 BULL. CR. SOC. 159, Item 42 (February 1965).

166. U. S. CONGRESS. HOUSE.

H.R. 5723. A bill to amend the Internal Revenue Code of 1954 to treat income from property created by the taxpayer as earned income for certain purposes. Introduced by Mr. Keogh, March 3, 1965, and referred to the Committee on Ways and Means. 2 p. (89th Cong., 1st Sess.)

A companion bill to S. 1242. See Item 168, *infra*.

167. U. S. CONGRESS. SENATE.

S. 1237. A bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Talmadge (for himself and Mr. Hart), February 23, 1965, and referred to the Committee on the Judiciary. 26 p. (89th Cong., 1st Sess.)

A companion bill to H.R. 450 introduced earlier during the session; see 12 BULL. CR. SOC. 161, Item 45 (February 1965).

168. U. S. CONGRESS. SENATE.

S. 1242. A bill to amend the Internal Revenue Code of 1954 to treat income from property created by the taxpayer as earned income for certain purposes. Introduced by Mr. McCarthy, February 23, 1965, and referred to the Committee on Finance. 2 p. (89th Cong., 1st Sess.)

This bill would make it possible to place authors, composers and artists under the coverage of the Self-Employed Individuals Tax Retirement Act of 1962.

169. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Patents, trademarks, and copyright; report of the Committee on the Judiciary, United States Senate, made by its Subcommittee on Patents, Trademarks, and Copyrights, pursuant to S. Res. 270, Eighty-eighth Congress, second session. [Submitted by Mr. McClellan, March 10, 1965]. 14 p. (89th Cong., 1st Sess., S. Rept. No. 118).

The annual report on the activities of the subcommittee covering the 2d session of the 88th Congress. Brief mention is made of the following copyright legislation pending in the subcommittee when the 88th Congress adjourned: S. 405 (Ellender), to amend the copyright law with respect to certain rights of copyright holders in musical compositions, and S. 3008 (McClellan) general revision bill.

2. FOREIGN NATIONS

170. MEXICO. *Laws, statutes, etc.*

Agreement establishing the tariffs for the payment of authors' royalties in respect of the exploitation in cinematographic films of works protected by the Federal Law on Copyright (of October 9, 1964). (77 *Le Droit d'Auteur* [English inset] 194, no. 12, Dec. 1964.)

Also appears in French in the main section of the same issue of *Le Droit d'Auteur*.

Translation of an agreement published in the *Diario Oficial* of Mexico on October 14, 1964, which provides for the payment of 3% of the net receipts for each showing of a motion picture, to be paid by the persons exploiting motion picture versions of copyrighted works, and to be distributed to authors (1.2%), composers (1%), producers (0.5%), and performers (0.3%). Exemptions from, or reduction of, payments are authorized when the showing is for educational, cultural or charitable purposes.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

171. INTERNATIONAL COPYRIGHT UNION.

State of the International Union on January 1, 1965. (1 *Copyright* 2-5, no. 1, Jan. 1965.)

The annual report of the Berne Bureau listing member countries and showing the revisions of the Berne Copyright Convention ratified by each, together with their reservations, as of January 1, 1965.

172. MASOUYE, CLAUDE. The International Union on the threshold of 1965. (1 *Copyright* 3, 6-8, no. 1, Jan. 1965.)

The head of the Copyright Division of BIRPI assesses the situation of the International Copyright Union since his "last stocktaking." See 11 *BULL. CR. SOC.* 289, Item 175 (1964).

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

173. *Stuff v. E. C. Publications, Inc.*, 144 U.S.P.Q. 560 (2d Cir., Mar. 2, 1965) (Smith, J.)

Appeal from judgment for defendant in action for copyright infringement. Plaintiff alleged that the grinning-boy cartoon featured in "Mad" magazine ("Alfred E. Neuman") was copied from a caricature called "The Original Optimist" or "Me-Worry?" in which she had the copyright.

Held, affirmed.

The court held that the copyright in "The Original Optimist," originally valid, had been forfeited because of the failure of plaintiff's predecessor in interest to prevent the circulation over the years of a great volume of unauthorized copies, without copyright notice, of the copyrighted cartoon. The court said:

When plaintiff proved her ownership of the validly issued copyright and defendants' copying of the work, she established a prima facie case of infringement under the statute. *H. M. Kolbe Co. v. Armigus Textile Co.*, 315 F.2d 70, 137 USPQ 9 (2 Cir. 1963), *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 124 USPQ 154 (2d Cir. 1960) The court, however, found it established that a great volume of nearly identical prints had appeared over a long period and that plaintiff's husband had been most derelict in preventing others from infringing his copyright. These findings, borne out by the evidence, support the inference suggested by the trial court that the copyright owner authorized or acquiesced in the wide circulation of the copies without notice. On this record we must hold that defendants have met their burden of showing circulation of copies without notice, acquiesced in by the copyright holder. See Nimmer on Copyright, §146. The caricature was thereby dedicated to the public, barring any suit for infringement by the plaintiff.

174. *G. P. Putnam's Sons v. Lancer Books, Inc.*, 144 U.S.P.Q. 530 (S.D.N.Y., Feb. 8, 1965) (McLean, J.)

Action for copyright infringement. Plaintiffs Terry Southern and Mason Hoffenberg, who are American citizens, are the authors of the novel, "Candy." The book was published in France in 1958 under the pseudonym, Maxwell Kenton. A second French edition, in the English language like the first, was published under the title, "Lollipop" and under the Maxwell Kenton pseudonym. These editions were copyrighted in France, but there was no ad interim copyright registration in the United States, and there was no American edition during the first five years after publication. Subsequently, Mason and Hoffenberg gave G. P. Putnam's Sons exclusive rights to publish "Candy" in the United States, and the book achieved a spectacular U.S. success. Defendant published a competing paper-back edition, taken from the first French edition, and showing the author as "Maxwell Kenton." Plaintiffs moved for a preliminary injunction.

Held, preliminary injunction denied.

I. *Copyright infringement.* Plaintiffs argued that the Putnam edition was entitled to copyright protection, regardless of the history of the French editions, because it was a revised work. The court stated that while a revised work is entitled to copyright protection to the extent of the revisions, there was some question as to whether the revisions, consisting of "changes in the wording of certain passages, changes which in no way altered the sense," were sufficient to support copyright. The court held, however, that it was unnecessary to decide whether plaintiffs had a valid copyright in the revised work, since defendant had copied none of the changes. The court said:

The law is clear that when revisions or additions are made to a work which lies within the public domain, the copyright protection secured by registration of the work extends at most only to the revisions and additions, i.e., to the work which was original with the author who seeks the copyright. . . . *Kipling v. G. P. Putnam's Sons*, 120 F. 631 (2d Cir. 1903); *American Code Co. v. Bensinger*, 282 F. 829 (2d Cir. 1922); *Axelbank v. Rony*, 277 F. 2d 314, 125 USPQ 262 (9th Cir. 1960).

If this principle applies here, then plaintiffs have copyright protection, at best, only with respect to the revisions which the authors made to the French edition of "Candy." There may be a question as to whether plaintiffs have even that much protection in this case. In order to copyright revisions or changes made in a

work in the public domain, the revisions must not be "trivial." *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 90 USPQ 153 (2d Cir. 1951); *Ziegelheim v. Flohr*, 119 F. Supp. 324, 100 USPQ 189 (E.D.N.Y. 1954).

It is at least arguable that the revisions made in "Candy" were so slight as not to meet even this lenient standard. It is unnecessary to decide that question upon this motion, since it is conceded that defendants did not copy any of the revisions and therefore it makes no difference for present purposes whether plaintiffs have a copyright on the revisions or not.

Plaintiffs contended that the above-stated limitation of copyright protection for a revised version of a public domain work to the revisions only did not apply to "Candy" because the work was not in the public domain. They argued that American copyright in the original version had not been forfeited because it had never been published without copyright notice in the United States. The court held, however, that a work in English by an American author, published in another country, falls into the public domain in the United States unless the provisions of 17 U.S.C. 22 (ad interim copyright) are complied with. The court said:

. . . [Plaintiffs'] contention is that a book in the English language by American authors which was published only in a foreign country is not in the public domain, within the meaning of the United States copyright laws, and at any time that the authors apply for registration of a United States copyright on that book as revised, they secure United States copyright for the entire book, not merely for the revisions.

Plaintiffs cite no authority for this proposition. Moreover, such authority as can be found appears to be to the contrary. In *American Code Co. v. Bensinger*, supra, for example, the first edition of the book had been published in England. There is nothing to indicate that it had ever been published in the United States. Plaintiff added some revisions and secured copyright registration of the revised work in the United States. The court reaffirmed the principle that the copyright protection extended only to the revision. It would seem that the only reason that plaintiffs secured an injunction in that case was that defendant had copied the revisions as well as the first text, something which the defendants in this case have not done.

. . . [Plaintiffs] assert that if they had applied to the Copyright Office in 1964 for a registration of the copyright on the French

version of "Candy," the application would have been denied on the ground that no application for ad interim registration had been made. They point to a Copyright Office regulation, 37 C.F.R. 202.4 (b) which provides:

"Ad interim registrations. (1) An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered unless an ad interim registration is first made."

This regulation, plaintiffs contend, is contrary to the copyright law and contrary to the Constitution. They then assert that since it would have been futile for them to attempt to register a copyright on the French edition because the Copyright Office would have erroneously denied it, their position in this action should be the same as it would be if they had obtained such a registration.

. . . Obviously it was because of this Copyright Office regulation that the form of application for registration contains questions Nos. 5 ("If any substantial part of this work has been previously published, give a brief general statement of the nature of the new matter in this version.") and 6 ("If this is the U.S. edition of a book in English, and all or a substantial part of the English text of an earlier foreign edition was manufactured and first published abroad . . . was claim to ad interim copyright registered in the foreign edition?"). If, in answer to those questions, Southern and Hoffenberg had disclosed that "Candy" had been published in France, that the text of the French edition was substantially similar to that of the revised edition being offered for registration, and that ad interim copyright on the French edition had not been obtained, the Copyright Office doubtless would have declined to register the copyright. (The answer to question No. 6 . . . that "the present work as revised throughout, has never been published abroad," while literally true, may be thought to be something less than candid . . .) It does not follow, however, that plaintiffs are now entitled to sue for infringement.

In the first place, it is by no means clear that the regulation of the Copyright Office is contrary to the copyright law. No court has ever so held, as far as this court has been advised, or has been able to discover. . . . [S]ection (22) is silent as to whether one who has not complied with it may, after the expiration of the five year period, obtain registration of copyright on the foreign edition. . . . The specific reference (in Section 23) to publication of the book in the United States "within the period of such ad interim protec-

tion," i.e., within the five years, gives rise to a permissible inference that if the book is not published in the United States until after the five year period has expired, no permanent copyright on it can be secured.

Both sections are also silent as to whether it makes any difference that the importation of the foreign edition was impossible during part or all of the five-year period because of other statutes relating to standards of morality and decency.

The court sees no need to decide these novel questions upon this motion. Whether the Copyright Office would have refused registration of the French edition under these circumstances, and whether, if it had, its action would have been illegal or unconstitutional, are questions which are not presented by the present record. Plaintiffs never applied for registration of copyright on the French edition. . . . It is farfetched to argue that they may maintain an action for infringement as though they had complied with the registration requirements when, in fact, they have never attempted to comply with them.

Finally, and most important of all, we must not lose sight of the fact that upon this motion the court is not called upon to decide the entire litigation. The rule is well established that the drastic remedy of a preliminary injunction should not be granted . . . where the probability of (plaintiffs') success at a trial is not clear. . . . The court is satisfied that it is far from clear in this case that plaintiffs are entitled to enjoin the publication of defendants' book on a theory of copyright infringement.

II. *Unfair competition.* The court held that in the absence of palming off, even though the motive was to take advantage of Putnam's success with "Candy," defendant had not committed an act of unfair competition by publishing the uncopyrighted book. The court said:

. . . the court believes that Lancer's reason for publishing its "Candy" when it did, and for distributing it to its customers without even waiting for their orders to be received, was its desire to capitalize upon the unprecedented success which the Putnam hard cover edition had enjoyed. The court so finds, despite the testimony that Lancer had considered bringing out an edition of "Candy" before the Putnam book appeared.

The question remains as to whether the facts make a sufficiently strong showing of unfair competition to justify granting a preliminary injunction on that ground. The recent decision of the Supreme Court in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225

and *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (1964) indicate that the answer to this question must be in the negative. Those cases established the principle that state law may not forbid, on a theory of unfair competition, the copying of an article which is not protected by federal patent or copyright. Mere confusion in the minds of purchasers as to which article is which and as to who is the maker cannot afford a basis for prohibition by a state of the acts of copying and selling. The fact that a defendant copies his competitor's successful product out of a desire to profit thereby would seem to be wholly immaterial. It is unnecessary to consider these cases go as far as to deny the states power to prohibit intentional passing off of a product as that of another for . . . no such passing off has been shown here.

175. *S. C. Johnson & Son, Inc. v. Drop Dead Co., Inc.*, 144 U.S.P.Q. 257 (S.D. Calif., Jan. 13, 1965) (Yankwich, J.). See also 201 F. Supp. 704, 132 U.S.P.Q. 309 (S.D. Calif. 1961), 9 BULL. CR. SOC. 333, Item No. 211; 210 F. Supp. 816, 135 U.S.P.Q. 292 (S.D. Calif. 1962), 10 BULL. CR. SOC. 192, Item No. 213; 326 F.2d 87, 139 U.S.P.Q. 465 (9th Cir. 1963), 11 BULL. CR. SOC. 332, Item No. 209; and 141 U.S.P.Q. 949.

On judgment for plaintiff in action for copyright infringement, trademark infringement and unfair competition in which defendant was found to have copied plaintiff's label for "Pledge" (a furniture polish) in connection with the label for "Promise" (also a furniture polish) an accounting was had, and the Special Master submitted a report to which defendants objected.

Held, judgment for plaintiff on accounting.

The court adopted the Special Master's report and his award to plaintiff of \$112,008.71 in damages, including \$5,000 statutory damages for copyright infringement, interest, defendant's profits on "Promise" and \$34,855.00 for attorney's fees before the District Court.

I. *Statutory Damages for Copyright Infringement.* Damages were computed, pursuant to 17 U.S.C. 101 at \$1.00 for each copy of the infringing label made, sold or found in the possession of the infringer, with a limit of \$5,000. There were many more than 5,000 labels.

II. *Accounting for profits.* The award of defendant's profits was had in connection with the judgment for plaintiff on its cause of action for trademark infringement. In computing the profits by deducting expenses from sales, deductions for promotion costs were disallowed be-

cause defendant's president had testified that the company spent nothing for advertising "Promise."

III. The award for attorney's fees was the full amount plaintiff's attorneys had billed it for services before the District Court, but did not include services for the Appeal and in connection with defendant's Petition to the Supreme Court for a Writ of Certiorari.

176. *Flick-Reedy Corp. v. Hydro-Line Manufacturing Co.*, 144 U.S.P.Q. 566 (N.D. Ill., May 14, 1964; as amended July 1, 1964) (Perry, J.)

Action for patent infringement and copyright infringement. Plaintiff alleged that certain pages in defendant's catalog for hydraulic and pneumatic cylinders and related products (which pages contained mathematical and technical data, charts and formulas) infringed plaintiff's copyright in its catalog.

Held, judgment for defendant on the issue of copyright infringement.

The court held that plaintiff's copyright registration, insofar as it covered the pages in question, was "invalid and unenforceable" because it included material not original with plaintiff, because the pages had appeared in an earlier catalog and nothing in the registration of the later catalog indicated that the work was not wholly new, and because the same material was used in an article which appeared in a magazine with plaintiff's permission and without copyright notice.

The court also held that there was no copying in any event, but that the defendant had produced its pages by independent effort; the court attributed the similarities to the necessity of treating the same technical material in a similar way and to the use by both plaintiff and defendant of public domain material.

2. State Court Decisions

177. *University of Notre Dame du Lac v. 20th Century-Fox Film Corp.*, 144 U.S.P.Q. 454 (App. Div., 1st Dept., Feb. 9, 1965) (Botein, J.), reversing 144 U.S.P.Q. 107 (Sup., N.Y.Co., Dec. 17, 1964) (Greenberg, J.). Affirmed per curiam without opinion except for dissenting opinion by Judge Burke, 145 U.S.P.Q. 99 (N.Y.Ct.App., March 18, 1965).

Action against book publishers and film distributors to enjoin release and distribution of a motion picture entitled "John Goldfarb, Please Come Home" and further distribution of the published novel on which the picture is based. The book and novel "fall in the category

of broad farce" and depict the images by which a mythical Arab ruler engineers and then wins a football game between "Fawz U" and Notre Dame. A preliminary injunction was granted in the trial court, from which defendants appeal.

Held, reversed.

The trial court had accepted the plaintiffs' contention that the defendants' use of the name of the University of Notre Dame was "commercial piracy" in that the name had great commercial value and was being used for the commercial benefit of the defendants. The trial court had also held that the mention by name of Father Theodore M. Hesburgh, President of the University, in the book, was an invasion of privacy. The Appellate Division, however, held that neither unfair competition nor invasion of privacy had been established.

I. The court held that the references to Father Hesburgh (which, in any event, appeared in the book only and not in the motion picture at all) were merely of a "fleeting and incidental nature" and therefore did not constitute an invasion of privacy under Sections 51 and 52 of the New York Civil Rights Law. The court said:

I shall first discuss the individual plaintiff's claim of violation of his right of privacy under sections 50 and 51 of the Civil Rights Law. Father Hesburgh is named in connection with two brief passages in the book, but not named at all in the film. In the book, a volume of 143 pages in the paperback edition, he is referred to by name at page 108 and again at pages 115-116 as the University official with whom the State Department is in communication. In our opinion these isolated references are of that fleeting and incidental nature which the Civil Rights Law does not find offensive (*Stillman v. Paramount Pictures Corp.*, 5 N Y 2d 994; *Damron v. Doubleday, Doran & Co., Inc.*, 133 Misc. 302, affd. 226 App. Div. 796; *Noglen v. Varsity Pajamas, Inc.*, 13 A D 2d 114). To the extent that Father Hesburgh's cause of action is based on the film, it fails for the additional reason that the film does not use his "name, portrait or picture", the statutory test of identification (*Toscani v. Hersey*, 271 App. Div. 445, 448). We do not think this test is satisfied by the conjunction of the fact that the book names him and the fact that the cover pages of the paperback edition, which in no way refer to him or his co-plaintiff, laud the film.

II. The University relied on Section 397 of the General Business Law, which provides that a non-profit corporation may restrain the use

of its name for advertising purposes or for purposes of trade. The court held, however, that this section was designed to operate mainly in connection with the sale of goods and services, and did not apply to references to a non-profit corporation in a work of fiction. The court said:

Sections 50 and 51 of the Civil Rights Law protect only a "living person" (Hofstadter and Horowitz, *The Right of Privacy*, § 51; Prosser on Torts, 3d ed., p. 843), and the University, an incorporated institution, does not rely on them. Under section 397 of the General Business Law, added by L. 1961, c. 438, a nonprofit corporation such as the University may restrain the use of its name for advertising purposes or for purposes of trade. We are offered no convincing rebuttal of defendants' contention that this legislation was mainly designed to operate in connection with the sale of goods and services, and in our view a situation like the present was remote from the Legislature's contemplation.

III. The court held that the use of the name of Notre Dame, although both clear and many times repeated, did not constitute unfair competition because it was obvious that the Notre Dame in "John Goldfarb, Please Come Home" was fictional and no actual connection with or endorsement by the University could be inferred. It said:

We have read the book, which is incorporated as an exhibit to the complaint, and at the request of the parties viewed a special showing of the moving picture. The name of Notre Dame, unlike that of Father Hesburgh, is employed frequently in both book and film; and there is not the slightest question that the references are to the plaintiff University. And there is no point whatsoever in disclosing our views as to the artistic merit, good taste or essential decency of the treatment accorded Notre Dame in the book and moving picture versions. As will be developed further on, cases of this nature may not be determined on such criteria.

The only critique we are permitted to make is a threshold one shaped by a consistent line of cases. It is this: Is there any basis for any inference on the part of rational readers or viewers that the antics engaging their attention are anything more than fiction or that the real Notre Dame is in some way associated with its fabrication or presentation? In our judgment there is none whatever. They know they are not seeing or reading about real Notre Dame happenings or actual Notre Dame characters; and there is nothing in text or film from which they could reasonably infer "connection or benefit to the institution" (*Cornell University v.*

Messing Bakeries, Inc., 285 App. Div. 490, 492; affd. 309 N.Y. 722). "Nobody is deceived. Nobody is confused." (*Germanow v. Standard Unbreakable W. Crystals*, 283 N.Y. 1, 18), and plainly nobody was intended to be.

As will be seen, this conclusion imposes a heavy burden upon the University, which it must overcome in order to sustain its complaint. . . .

Plaintiffs expressly state that the action is in no sense a libel action and that any libel involved is immaterial and beside the point. It is the doctrine of unfair competition on which the University principally relies; specifically, that defendants have illegally appropriated "the name, symbols, high prestige, reputation and good will of Notre Dame." As "palming off"—deception—is not an element here, the University finds no support in such authorities as *Cornell University v. Messing Bakeries, Inc.*, *supra*, or *Trustees of Columbia University v. Axenfeld*, 136 Misc. 831. In the latter case there was a finding that "defendants in adopting the name 'Columbia Educational Institute' did so with the deliberate design of conveying to the public the impression that they were identical or associated with the plaintiff." Accordingly, plaintiff University invokes cases of the type exemplified by *Madison Square Garden Corp. v. Universal Pictures Co.* (255 App. Div. 459), in which defendant wove actual news photographs of plaintiff's hockey team in action into a moving picture with a fictional plot. Those cases, however, are distinguishable for the reason succinctly expressed in *Miller v. Universal Pictures Co.* (11 A D 2d 47, 49; 13 A D 2d 473; affd. 10 N Y 2d 972), where defendant made recordings simulating the style and manner of playing of an orchestra conducted by plaintiff's deceased husband—"in those cases the offending parties did not provide their own performances."

IV. The defendants also argued that an injunction would violate their rights under the First Amendment. The court said that it was not necessary to reach this issue, but indicated that such an injunction would "outlaw large areas heretofore deemed permissible subject matter for literature and the arts". The court said:

It is permissible to express praise or derision of a college's athletic activities in a journal of news or opinion. If such a journal, a novel and a photoplay are on a parity in law as media of expression, extension of the doctrine of unfair competition to interdict praise or derision by means of the novel or the photoplay would seem without justification. Social cost may properly be con-

sidered in these matters (Developments in the Law—Competitive Torts, 74 Harv. L. Rev. 888, 941); and the granting of an injunction in this case would outlaw large areas heretofore deemed permissible subject matter for literature and the arts. To mention but one, there is the school or college novel, numerous examples of which are cited in the briefs. Use of fictitious names is no answer. Offended institutions would argue that they were readily identifiable, with the inhibiting effect on freedom of expression resulting from the apprehension of criminal or civil sanctions that would understandably be entertained by cautious souls in the chain of distribution to the public. This contingency has been deplored more than once in contexts not overly remote from the situation presented here (*New York Times Co. v. Sullivan*, 376 U.S. 254, 277; *Smith v. California*, 361 U.S. 147, 153, 154; *Farmers Union v. WDAY*, 360 U.S. 525, 530).

“What seems to one to be trash may have for others fleeting or even enduring values” (*Hannegan v. Esquire, Inc.*, 327 U.S. 146, 158). “Everyone is familiar with instances of propaganda through fiction. What is one man’s amusement, teaches another’s doctrine” (*Winters v. New York*, 333 U.S. 507, 510). Accordingly, as intimated at the outset, we may not import the role of literary or dramatic critic into our functioning as judges in this case; and so for purposes of the law we may not reach a conclusion that the works of fiction involved in this litigation are not artistic or literary works. Whether they are creations of merit, whether they have value only as entertainment and no value whatever as opinion, information or education, pose questions which would require us to stake out those elusive lines that we have been warned not to attempt in the cases above cited (see also *Molony v. Boy Comics Publishers*, 277 App. Div. 166, 171, Van Voorhis, J.). Whether “John Goldfarb, Please Come Home” is good burlesque or bad, penetrating satire or blundering buffoonery, is not for us to decide. It is fundamental that courts may not muffle expression by passing judgment on its skill or clumsiness, its sensitivity or coarseness; nor on whether it pains or pleases. It is enough that the work is a form of expression “deserving of substantial freedom—both as entertainment and as a form of social and literary criticism” (*Berlin v. E. C. Publications, Inc.*, 329 F. 2d 541, cert. den.); and we are not prepared to hold that exercise of the freedom in the instant circumstances infringes on rights which equity should protect.

At bottom, it seems to us, the University’s grievance, notwithstanding its disclaimer, sounds in defamation and its remedy, if it

can prove libel, is at law (*Marlin Fire Arms Co. v. Shields*, 171 N.Y. 384).

We conclude that the order appealed from should be reversed, on the law, the injunction vacated and the complaint dismissed, with costs.

178. *Shanahan v. Macco Construction Co., Inc.*, 36 Calif. Rptr. 584, 144 U.S.P.Q. 154 (Cal. Dist. Ct. App., 2d Dist., Jan. 27, 1964) (Fox, J.)

Appeal from judgment dismissing amended complaint in action for infringement of common law copyright and unfair competition. Plaintiff developed plans and specifications for tract houses and built approximately 1,435 of them. Plaintiff charges that defendant thereafter copied the plans and specifications and built houses therefrom identical to plaintiff's houses and in competition with plaintiff. The parties stipulated to go to trial first on the issue of whether the plans had been published, thus depriving plaintiff of his common law copyright, and that if the court determined as a matter of law that plaintiffs' rights had been lost by publication, judgment for defendants would be entered, subject only to a motion for a new trial and appeal. The trial court did find that plaintiff's rights had been lost by publication.

Held, affirmed.

The trial court had found that there had been publication by reason of a number of acts of plaintiffs, to wit: they had issued thousands of brochures containing the floor plans and many of the elevations involved; a number of model homes were built, which the public was invited to inspect and of which visitors were permitted to take measurements; the plans were submitted in a magazine contest and were published in the magazine; detailed floor plans and elevations were available at the office of each of plaintiff's tracts for free inspection by the public; the homes themselves were built. The District Court of Appeals held that the evidence supported the trial court's finding that there had been such publication as to deprive plaintiff of his rights in the plans, and went on to discuss publication by means of erecting the houses themselves holding that building the houses did constitute publication. The court said:

In fact there is no real challenge to the main acts of publication that were found by the trial court. We shall only refer to one of such acts here: the construction by plaintiffs of 1,435 houses and the sale to the public of practically all of these houses built substantially in accordance with plaintiffs' plans, which houses con-

stituted an expression or representation of the subject plans. Plaintiff's only challenge to this finding is to argue that a home built from plans is not a copy of such plans. . . .

A general publication is a communication, disclosure or circulation of a work to members of the public without restrictions as to the persons or use of such publication. *White v. Kimmell*, 193 F.2d 744, 92 USPQ 400.

The statutory provisions relative to general publication are sections 980, subdivision (b) and 983, subdivision (b), Civil Code. These sections provide: 980, subdivision (b): "The inventor or proprietor of any invention or design, with or without delineation, or other graphical representation, has an exclusive ownership therein, and in the representation or expression thereof, which continues so long as the invention or design and the representations or expressions thereof made by him remain in his possession." 983, subdivision (b): "If the owner of any invention or design intentionally makes it public, a copy or reproduction may be made by any person, without responsibility to the owner, so far as the law of this state is concerned."

The principle that a common-law exclusive right is lost by "general publication" has been applied in a variety of areas. . . .

House plans and designs are closely analogous to dress designs. It has been uniformly held that placing a dress design on the public market constituted a general publication of the design. *Fashion Originators Guild of America, Inc. v. Federal Trade Com.*, 114 F.2d 80, aff'd. 312 U.S. 457, 48 USPQ 483; *Société Comptoir de L'Industrie etc. Boussac v. Alexander's Dept. Stores*, 190 F. Supp. 594, 128 USPQ 242, aff'd. 299 F. 2d 33, 132 USPQ 475. . . .

This same principle should apply with equal force to an architect's plans where such plans have found expression or exemplification in the construction of "model homes" and hundreds of tract houses which the public have been invited to inspect and purchase, to which invitation they have responded by the thousands and which resulted in the purchase of practically all of said houses. The application of the principle is best illustrated in *Kurfiss v. Cowherd*, 233 Mo. App. 397. There a house was constructed in accordance with an architect's plans and was open for public inspection. Thousands of people inspected the house. Two similar residences were built without the architect's permission. He brought action for infringement of his common-law copyright. The trial court rendered judgment against plaintiff because it found that the

architect's common-law copyright had been lost by general publication. On this point, the court pointed out (p. 288):

"it is universally held that where the work is made available to the public, or any considerable portion thereof, without restriction, there has been a publication.

"In the case at bar plaintiff concedes that a house [the first one] was built in accordance with his plans, and with his consent; and that said house itself was thereafter open to public inspection. We think this unrestricted exhibition of the house was a publication". . . .

But, argue plaintiffs, there was no general publication here because they did not intend to place their plans in the public domain. . . . Certainly the question of the intention of one who publishes his work cannot be left to a *subjective* test.

Here there can be no question that plaintiffs intended to build 1,435 houses or that they intended to invite the public to visit and inspect these houses and their model homes. They intended to distribute to the public some 30,000 brochures depicting the rooms and their arrangements and the elevations of their houses. They intended to publish the advertisements containing representations of their plans in the newspapers. They intended to do the other acts noted herein and found by the trial court to constitute a general publication. . . .

Thus, despite any subjective intent on the part of plaintiffs not to abandon their plans, they have clearly and intentionally made public such plans. This is all that is required under the California statute to deprive plaintiff of their alleged causes of action against defendants.

179. *Greater Recording Company, Inc. v. Stambler*, 144 U.S.P.Q. 547 (Sup., N.Y. County, Feb. 5, 1965) (Gold, J.)

In action for unfair competition, defendants moved to dismiss the complaint.

Held, motion denied.

It was held that a charge of "record piracy," dubbing of phonograph records from plaintiffs' product, was sufficient to sustain a cause of action for unfair competition. The court said:

The court has jurisdiction. Plaintiffs do not seek to perpetuate a non-existent common law copyright. On the contrary, they seek

protection against unlawful misappropriation of property. *Metropolitan Opera Association v. Wagner-Nichols Recorder Corporation*, 199 Misc. 786, 87 USPQ 173, aff'd 279 App. Div. 632; *Capitol Records, Inc. v. Mercury Records Corporation*, 221 F. 2d 657, 105 USPQ 163. Involved is "record piracy", the production and distribution of records taken and made directly from recordings made and owned by plaintiffs. *Capitol Records, Inc. v. Mercury Records Corporation*, supra; *Radio Corporation of America v. Premier Albums, Inc.*, 19 App. Div. 2d 62, 138 USPQ 404; *Fonotipia, Ltd. v. Bradley*, 171 F. 951; *Flamingo Telefilm Sales, Inc. v. United Artists Corporation*, 141 USPQ 461, revd. for defect in complaint, 22 App. Div. 2d 778, 144 USPQ 168. However, the Appellate Division, in *Flamingo*, did state: "if the particular motion picture film was in the public domain, and the contrary does not appear, and the defendants would be entitled to duplicate and use all or portions of the picture film for telecast or other legitimate purposes, and if their acts were not such as to deceive the public or defraud the plaintiff, they would not incur any liability to plaintiff. See *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348, 142 USPQ 249; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225; *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (emphasis supplied). The motion is denied in all respects.

ALSO OF INTEREST

180. *West v. Lind*, 144 U.S.P.Q. 160 (Cal. Super., L.A. County, Nov. 27, 1964) (Gitelson, J.)

Action for unfair competition Actress Mae West, author and star of the 1928 stage play "Diamond Lil", alleging that she had performed in the play many times over the years and had long been identified with the name "Diamond Lil," challenged the use by defendant, a singer, of "Diamond Lil" as her professional name. The court held that plaintiff is entitled to sole use of the name "Diamond Lil" and granted a permanent injunction. The earlier denial of a preliminary injunction in a prior similar action between the same parties was held not to be *res judicata* as to the merits. See *West v. Lind*, 186 Cal. App.2d 563, 128 U.S.P.Q. 204 (1960).

B. DECISIONS OF FOREIGN COURTS

1. England

181. *Twentieth Century-Fox Film Corp. v. Anglo Amalgamated Film Distributors Ltd.*, *The Times*, Jan. 20, 1965, p. 23; Jan. 21, 1965, p. 17 (England, Chancery, Jan. 20, 21, 1965) (Plowman, J.)

Action for copyright infringement. Plaintiff moved for interim injunction restraining reproduction and display of a parody version of the painting of Elizabeth Taylor, Richard Burton and Rex Harrison which was used in the advertising and promotion of the film, "Cleopatra." This motion picture had been shown for about 18 months in the Dominion Theatre, London, but had not yet been generally released in England, when "Carry on Cleo", a parody of plaintiff's film, opened at the Warner Theatre, London. Plaintiff sought to enjoin display of the posters for "Carry on Cleo."

Held, interim injunction granted.

Defendants argued that a parody, such as their poster, is an independent art form and not an infringement of the copyright in the work parodied. The court held, however, that there had been a substantial copying and that a prima facie case of copyright infringement had been established. The following is an extract from the report in the *Times*:

His Lordship said that this was a trial of the motion and not a trial of the action. Therefore any views expressed by his Lordship on the question of breach of copyright would be provisional only.

The question really was whether the plaintiffs had made a prima facie case of infringement. For the purposes of this motion it was not disputed that copyright subsisted in the picture in question and that it was vested in the plaintiffs.

A point of importance to be borne in mind was that the general release of the defendants' film, "Carry on Cleo" would precede the general release of the plaintiffs' film "Cleopatra."

The plaintiffs' case was that for the purposes of advertising their film "Carry on Cleo" the defendants were using the plaintiffs' picture. The only difference was that the defendants showed their own actors on the picture instead of the plaintiffs'. The plaintiffs said that that was flagrant breach of copyright and was likely to destroy the impact of the plaintiffs' picture.

It was common ground that the plaintiffs' posters were used by the defendants as a basis of the defendants' posters. But the defendants said that their poster was not a copy but a parody of the plaintiffs' poster.

It followed from the provisions of the Copyright Act, 1956, that the question which his Lordship had to consider was whether the defendants had reproduced a whole or a part of the picture in a substantial form.

The question had to be judged from the point of view of the ordinary man in the street. . . . It had to be judged from a quick look rather than a meticulous study. The matter was really one of first impression.

Here, in spite of the differences between the two posters, on the evidence of his Lordship's own eyes, it seems that the defendants' poster came so near as to suggest the plaintiffs' poster to every person seeing it.

Mr. Hogg said that the defendants' poster was a parody of the plaintiffs' poster and suggested that the test was laid down by Mr. Justice McNair in *Joy Music Ltd. v. Sunday Pictorial Newspapers (1920) Ltd.* ((1962) 2 Q.B. 60), namely that in considering whether a parody of a literary work constituted an infringement of the copyright in that work the main test was whether the writer had bestowed such mental labour upon the material he had taken and subjected it to such revision and alteration as to produce an original work.

It was of some importance to bear in mind that that test was suggested to be a test in a literary copyright and not artistic copyright. Even applying that test it did not displace the view one would form on a visual comparison, namely, that the defendants' poster did reproduce a material part of the plaintiffs' poster.

The plaintiffs had, accordingly, made out a prima facie case of infringement.

It seemed clear on the evidence that unless the plaintiffs were granted an interlocutory injunction by the time their film was generally released the damage would have already been done. As the defendants' general release came first the impact of the plaintiffs' publicity was in danger of being ruined in advance. If no injunction was granted now it would be impossible to compensate them by way of damages because they would never be able to show what damage had been suffered. On the other hand any injury done to the defendants would be capable of being compensated. . . .

This was not a case where the defendants could be said to have been taken by surprise. They were doing what they did with open eyes and were taking a calculated risk. If they were not ready for what had happened and if they were not ready with alternative publicity, it was entirely their fault. . . .

In these circumstances his Lordship granted the injunction asked for.

PART V.

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1. United States Publications

182. HATTERY, LOWELL H. and GEORGE P. BUSH, *editors*. Reprography and copyright law. Washington, American Institute of Biological Sciences [1964]. 204 p.

This book (a "must" for lawyers studying the problem of copying as it relates to copyright) is derived from presentations at a symposium in 1963 sponsored by The American University, which explored the reprography-copyright problem, its varied interests, viewpoints, proposed solutions, and outlook. The book also includes a summary, three appendices, and a selected bibliography.

2. Foreign Publications

183. COHN, ERNST, J. Die angrenzenden Rechte im englischen Recht. Berlin, F. Vahlen [©1963]. 89 p. Internationale Gesellschaft für Urheberrecht. Schriftenreihe, Bd. 28.

A study of neighboring rights under the British law, which is found wanting in many respects, particularly because of the absence of a basic principle governing such rights. It is pointed out that, regardless of Article 6bis of the Berne Convention (Rome Revision), the English law does not even recognize the moral rights of an author. The concluding chapter is devoted to a discussion of neighboring rights under the Rome Convention.

184. HODEIGE, FRITZ, *ed*. Das Recht am Geistesgut: Studien zum Urheber-, Verlags- und Presserecht. Eine Festschrift für Walter Bappert. [1. Aufl.] Freiburg im Breisgau, Rombach [1964]. 322 p.

"Mit Beiträgen von Josef Knecht, Kurt Bussmann, Ludwig Delp, Ekkehard Gerstenberg, Ludwig Gieseke, Hellmut Georg Isele, Heinz Kleine, Martin Löffler, Philipp Möhring, Michael

Müller-Blattau, H. L. Pinner, Wilken von Ramdohr, Georg Roeber, Kurt Runge, Fritz Schönherr, Alois Troller, Eugen Ulmer [und] Egon Wagner."

A *Festschrift* for Dr. Walter Bappert, a prominent German copyright jurist, upon the occasion of his 70th birthday, with contributions by eminent legal scholars on topics in the area of copyright, publishers' rights and the law of the press. A chronological list of Dr. Bappert's writings is appended.

B. LAW REVIEW ARTICLES

1. United States

185. ANDREW, JOHN H. Domestic protection of commercial designs: the federal-state conflict. (39 *St. John's Law Review* 23-48, no. 1, Dec. 1964.)

A discussion of the effect of the *Sears* and *Compco* decisions and subsequent state and federal court decisions.

186. Copyrights—subjects—filing of architectural plans with municipal building commission does not constitute publication sufficient to prevent recognition of state common law copyright. (78 *Harvard Law Review* 670-673, no. 3, Jan. 1965.)

A case note on *Edgar H. Wood Associates v. Skene*, 197 N.E.2d 886, 11 BULL. CR. SOC. 439, Item 298 (Mass. Sup. Ct. 1964).

187. DORR, WILLIAM LENT. Unfair competition: simulation of unpatented goods. (50 *Cornell Law Quarterly* 118-127, no. 1, Fall 1964.)

A case note on the *Sears* and *Compco* decisions.

188. FARMAKIDES, JOHN B., and MAXWELL C. FREUDENBERG. Copyright matters affecting the Government. (25 *Federal Bar Journal* 86-105, no. 1, Winter, 1965.)

A contribution to a "Symposium on Patents, Copyrights, and Trademarks," which is concerned with the problem of Government involvement in copyrights, and proposes "to point out some of the recognized rules and new trends in this area."

189. JACOBS, MORTON C. Patent protection of computer programs. (47 *Journal of the Patent Office Society* 6-14, no. 1, Jan. 1965.)

A case is made for the patentability of computer programs.

190. KIDD, JOHN E. Patent, copyright and trademark suits against the Federal Government. (25 *Federal Bar Journal* 125-130, no. 1, Winter 1965.)

191. KLARMAN, BARBARA FRIEDMAN. Copyright and folk music: a perplexing problem. (10 *Wayne Law Review* 702-714, no. 4, 1964.)

This paper, winner of Special Mention in the 1964 Nathan Burkan Memorial Competition, presents a discussion of the various problems arising out of the uncertainty in the law with regard to folk music and suggests possible solutions which may best serve the multiple competing interests.

192. KRASNOW, ERWIN K. Copyrights, performers' rights and the march on civil rights: reflections on *Martin Luther King, Jr. v. Mister Maestro*. (53 *Georgetown Law Journal* 403-429, no. 2, Winter 1965.)

"Employing the *King* decision [224 F.Supp. 101, 11 BULL. CR. SOC. 183, Item 83 (S.D.N.Y. 1963)] as a case in point, the author analyzes the problems involved in attempting to apply antiquated common-law and statutory copyright theories in our modern era of mass communication. He then reviews various performers' rights theories which he contends can be rationally applied in cases such as *King*, and examines the conflict of laws problems involved therein, particularly between state and federal courts. Recognizing that the ultimate solution lies in legislation, Mr. Krasnow concludes with a commentary on recent proposals for amendment of the copyright laws."

193. PARISH, JAMES ROBERT. Statutory copyright protection of fictional characters. (8 *Idea, The Patent, Trademark, and Copyright Journal of Research and Education* 455-470, no. 3, Fall 1964.)

This note, which is based on a paper entered in the 1964 Nathan Burkan Memorial Competition at the University of Pennsylvania Law School, is concerned with the extent to which our legal system currently protects writers for the various facets composing their fictional characters, with a suggestion that the "judi-

cial protection now achieved nominally through the remedy of unfair competition actions, should be removed to the specific area of the actual theory of relief—statutory copyright law.”

194. ROBINSON, EDWIN T. Product imitation—design patents invalid—unfair competition relief denied. (33 *University of Cincinnati Law Review* 537-542, no. 4, Fall 1964.)

A case note on *Sears, Roebuck & Co. v. Stiffel Co.*, and *Compco Corp. v. Day-Brite Lighting, Inc.*

195. SIMON, MICHAEL S. Common law copyright of architectural plans. (24 *Maryland Law Review* 431-442, no. 4, Fall 1964.)

This article, which was entered in the Nathan Burkan Memorial Competition at the University of Maryland School of Law, is a case note on *Edgar H. Wood Associates, Inc. v. Skene*, 197 N.E.2d 886, 11 BULL. CR. SOC. 439, Item 298 (Mass. Sup. Ct. 1964).

196. STRASSER, ALBERT E. Protection against foreign competition: a many splendored thing. Basic considerations. (39 *St. John's Law Review* 11-22, no. 1, Dec. 1964.)

A brief discussion of remedies afforded by the patent, trademark and copyright laws against the copying of successful American products by foreign competitors.

197. TURCHIN, MARTIN F. Copyright as collateral in a secured transaction. (39 *St. John's Law Review* 90-111, no. 1, Dec. 1964.)

An analysis of the problems that would be encountered by a creditor who accepted a copyright as part of the security for a loan. First prize winner in the 1964 Nathan Burkan Memorial Competition at St. John's University.

198. WALDHEIM, FRANKLIN. Mickey Mouse: trademark or copyright? (54 *The Trademark Reporter* 865-882, no. 11, Nov. 1964.)

A discussion of the legal protection of characters, with special reference to their use on merchandise.

199. WEHRINGER, CAMERON K. Copyright & the general practitioner. (10 *The Practical Lawyer* 33-40, no. 8, Dec. 1964.)

Elementary principles for securing copyright protection.

2. Foreign

1. English

200. HESSER, TORWALD. Letter from Sweden. (1 *Copyright* 18-23, no. 1, Jan. 1965.)

A survey of current problems in the field of Swedish copyright.

201. HUGUET, ANDRE. The moral right of the music composer during final preparation of the film (with respect to French law). (1 *Copyright* 9-17, no. 1, Jan. 1965.)

A study of the limitations imposed by the French copyright law of 1957 upon the moral rights of an individual co-author of a collaborative work with special reference to the film music composer.

202. ROTH, ERNST. The availability of musical scores: Dr. Roth speaks for the music publishers. (*EBU Review* 46-47, no. 89B, Jan. 1965.)

A refutation, by a music publisher, of arguments propounded by Mr. Denis Vaughan in an article which appeared under the same title in *EBU Review*, no. 86B (July 1964), pp. 40-45. In his article, Mr. Vaughan had deplored the scarcity of certain operatic scores and the textual inaccuracy of the available scores. See also 8 BULL. CR. SOC. 81, Item 71 (1960).

203. TIPSAREVIC, PAVLE. Some aspects of the protection of performers' rights in Yugoslavia. (*EBU Review* 42-45, no. 89B, Jan. 1965.)

An attempt to "give an answer to the question of how far the legal extension of present-day protection of Yugoslav performers is justified, and whether conditions for the eventual ratification of the Rome Convention on 'neighbouring' rights exist or when these conditions will be created in Yugoslavia."

204. VAUGHAN, DENIS. Mr. Vaughan replies to Dr. Roth's letter. (*EBU Review* 48-50, no. 89B, Jan. 1965.)

A rebuttal. See Item 202, *supra*.

2. In French

205. HEPP, FRANÇOIS. L'exercice des droits de propriété littéraire et artistique dans la Communauté Economique Européenne. (77 *Le Droit d'Auteur* 301-311, no. 12, Dec. 1964.)

A discussion of the extent to which the Treaty of Rome, establishing the European Common Market, has affected the exercise of literary and artistic property rights among the member countries.

3. In German

206. CARY, GEORGE D. Copyright-Eintragung und Rechenprogramme. (*Gewerblicher Rechtsschutz und Urheberrecht*, Auslands- und Internationaler Teil 623-626, no. 12, Dec. 1964.)

A German translation of an article which first appeared in 11 *BULL. CR. SOC.* 362, Item 271 (1964) under the title "Copyright registration and computer programs."

207. DEUTSCH, VOLKER. Die Verbindung von Musik und Text in urheberrechtlicher Sicht. (67 *Gewerblicher Rechtsschutz und Urheberrecht* 7-10, no. 1, Jan. 1965.)

A discussion of the question whether, under the West German copyright law, a work consisting of music and text represents a unit or whether the musical and textual components are independent and separately exploitable contributions.

208. FLUME, WERNER. Die private Tonbandaufnahme: Rechtsvergleichung und Urheberrechtsabkommen. (19 *Juristenzeitung* 314-317, no. 10, May 15, 1964.)

A contribution to the controversy concerning royalty-free tape recording for personal use, with the conclusion that, outside the German Federal Republic, such use has not been opposed on legal grounds either in Europe or in the United States. Includes a comparative survey of the legal situation in various countries, and an interpretation of the pertinent provisions of the Berne Copyright Convention (Brussels and Rome revisions).

209. HANDL, JOSEF. Das Rom-Abkommen und Osterreich. Urheberrechtsreform: Filmwirtschaftlich bedeutsame Tatbestände. (8 *Film und Recht* 2-5, no. 12, Dec. 1964.)

A discussion of recent draft legislation for amending the Austrian copyright law to implement Austria's adherence to the

Rome Convention on Neighboring Rights, with special reference to the film industry.

210. LEINVEBER, GERHARD. Persönlichkeitsrecht und Verlagsrechtsreform. (66 *Gewerblicher Rechtsschutz und Urheberrecht* 645-650, no. 12, Dec. 1964.)

A discussion of the moral rights (personality rights) aspects of the West German law on contracts of publication, with special reference to the preparatory work on the new draft law which is now in the drafting stage at the Federal Ministry of Justice.

211. LORENZ, THOMAS. Zum Vorentwurf eines Abkommens über den Schutz von typographischen Schriftzeichen. (*Gewerblicher Rechtsschutz und Urheberrecht*, Auslands- und Internationaler Teil 618-623, no. 12, Dec. 1964.)

An analysis of the draft convention as modified by the Committee of Experts on the International Protection of Type Faces at its fourth meeting on October 7-10, 1963, in Geneva. A German translation of the Draft Convention and its implementing instrument appears on pp. 630-633.

212. ULMER, EUGEN. Originalwerk und Bearbeitung im internationalen Urheberrecht. (*Gewerblicher Rechtsschutz und Urheberrecht*, Auslands- und Internationaler Teil 613-618, no. 12, Dec. 1964.)

This article, which first appeared as a contribution to *Das Recht am Geistesgut*, a *Festschrift* in honor of Dr. Walter Bappert, edited by Fritz Hodeige (see Item 184, *supra*), is a discussion of the concept of an original work and an adaptation under the Berne and Universal Copyright Conventions, with special reference to the situation in the German Federal Republic.

4. In Italian

213. GUGLIELMETTI, GIANNANTONIO. Gli slogans e la loro tutela. (85 *Diritto di Autore* 289-315, no. 3, July-Sept. 1964.)

A comparative analysis of the legal protection of commercial slogans, with special reference to the question whether they are protectible in Italy under the copyright, trademark or unfair competition law.

214. NAWROCKI, BOLESŁAW. Plagio e diritto d'autore. (13 *Rassegna di Diritto Cinematografico, Teatrale e della Radiotelevisione* 135-144, no. 5, Sept.-Oct. 1964.)

An Italian translation of an article which first appeared in French in 76 *Le Droit d'Auteur* 304-317, no. 12 (Dec. 1963). See 11 BULL. CR. SOC. 290, Item 179 (1964).

NEWS BRIEFS

215. *Postponement of House Hearings on H.R. 4347.*

Hearings on the Copyright Law Revision Bill, H.R. 4347, originally scheduled to commence on April 28, 1965, have been postponed for two weeks, i.e., to May 12, 1965, at 10 a.m. before the House Judiciary Committee, Subcommittee No. 3, 345 Cannon Office Building, Washington, D.C.

216. *1964 Nathan Burkan Memorial Competition Awards.*

The National First Prize in the 1964 Nathan Burkan Memorial Competition was awarded to Mrs. Marion Lozier Woltmann, a graduate of Columbia University School of Law, for her essay, "The Author and the State: An Analysis of Soviet Copyright Law." Second prize was awarded to Mr. S. Paul Posner, a graduate of Harvard Law School, for his paper on "State and Federal Power in Patent and Copyright." Tied for Third Prize were Mr. Monroe E. Price, a graduate of Yale Law School, and Mr. John F. Banzhaf, III, of Columbia University School of Law, who has written several papers on computers and copyright, one of which was mentioned recently in these pages, cf. "Copyright Protection for Computer Programs," 64 Colum. L. Rev. 1274-1300 (Nov. 1964), which was his entry in the Competition.

This year, in addition to Honorable Mention papers which will be published, several outstanding essays were awarded "Special Mention," including a paper by Barbara F. Klarman of Wayne University Law School on folk music and copyright, mentioned *supra*, at Item 191.

217. *Montana Performing Rights Bill Vetoed by Governor.*

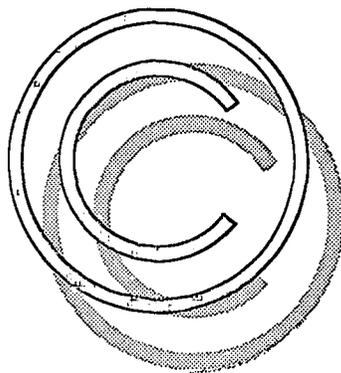
A bill, No. 290, recently introduced in the Montana Legislative Assembly and vetoed by the Governor (March 27, 1965,

Billboard), aimed at curbing the operations of performing rights societies in Montana. The bill declared that creation, reproduction, licensing and commercial use of music, its rendition and reception by means of radio and television communication, is a business "clothed and affected with a public interest," which, under the guise of federal protection, became plagued with various abuses, and should therefore be controlled by the state police power. It was declared that, in order to curb monopolistic practices and, particularly, the price fixing of performing rights, the music business requires "reasonable regulation" by the state government. The bill proposed the establishment of a Copyright Commission, which would be endowed with regulatory and investigative powers, and which, upon request, would also be empowered to determine "reasonable" licensing fees for the right of public performance of musical compositions, in case the parties concerned are unable to agree between themselves. Under the proposed law, music licensing agencies would be required, *inter alia*, to file annually with the Copyright Commission a list of copyrighted musical compositions the performing rights to which are owned or licensed by the agency. The law would also compel licensing agencies to issue, upon request, to any recording company whose recordings are sold or otherwise used in the state, licenses of the right to authorize the radio and television broadcasting of a recordation of musical composition in the repertory of the agency, "without requiring separate licenses for such enumerated stations for such performances."

218. *The New Berne Bureau "Copyright" Publication in English.*

As from January 1965, the English language insert of *Le Droit d'Auteur*, published since January 1962, has been discontinued and in its place an English monthly review under the title *Copyright*, is now available. The contents of *Copyright* are identical with the French edition of *Le Droit d'Auteur*, and represent the official monthly review of the International (Berne) Convention for the Protection of Literary and Artistic Works, including state of ratifications, texts of laws, case law, studies, book reviews and news items. Subscription is ten dollars a year (or 40 Swiss francs); orders should be sent to BIRPI, 37, Chemin des Colombettes, 1211 Geneva 20, Switzerland.

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Robert Jay Burton

September 21, 1914 — March 29, 1965

At the annual meeting of the Board of Trustees of The Copyright Society of the U.S.A. held on May 19, 1965.

Upon motion duly made, seconded and unanimously carried, be it:

RESOLVED, that The Copyright Society of the U.S.A. pays the following memorial tribute to our late friend and trustee, Robert J. Burton:

The untimely death of Mr. Burton has resulted in a great loss to the Copyright Bar.

Since his initial affiliation with Broadcast Music, Inc. in 1940, Mr. Burton has made many significant contributions to the cause of copyright protection and has been a devoted friend of the Copyright Bar. During the past 24 years he has served on, and has been chairman of, copyright committees of the American Bar Association, the Federal Bar Association of New York, New Jersey and Connecticut, and the American Patent Law Association. In addition, he has made numerous speeches and lectures over the years to many and diverse groups in which he has effectively urged the importance of appropriate protection for the creators of artistic works.

Our Society wishes particularly to express its gratitude for Robert J. Burton's services to the Society directly as a friend and trustee, and extends its sincere sympathy to his widow and children; and be it further

RESOLVED, that the secretary of our Society shall transmit a copy of this resolution to his widow.



DR. JUR. H.C. ERICH SCHULZE

President and General Manager, GEMA, Berlin, Germany, who delivered the Third Jean Geiringer Memorial Lecture on International Copyright, April 14, 1965, at New York City.

PART I.

ARTICLES

219. THE THIRD ANNUAL JEAN GEIRINGER MEMORIAL LECTURE ON INTERNATIONAL COPYRIGHT*

Guest Speaker: DR. ERICH HANS RICHARD SCHULZE

Introduction by: EDWARD A. SARGOY

President, The Copyright Society of the U.S.A.

The copyright world is in a ferment. This is especially so in the United States. Our Copyright Act of 1909 is now in its 56th year. Clearly, its term is expiring, although Congress may extend its life another year or so.

The accelerating momentum of our electronic era—with its orbiting “Telstar” satellites, information storage and retrieval by computer symbols, automatic audio-visual recordings on film, tape, disc, wire and computer symbols, and their almost instantaneous playback—are casting into limbo the 18th and 19th century concepts embalmed in our present 1909 copyright system.

The hour of decision in the United States approaches. As the Hon. Abraham L. Kaminstein, U.S. Register of Copyrights prophetically said, in concluding an address before The American Patent Law Association last January 28th: “The bell for the American copyright system has been tinkling for a long time, and right now the tinkling is loud and very insistent. All of us in the intellectual property field have a duty to do something to keep the bell from starting to toll.”

This coming May 12th, the U.S. Congress will be commencing long committee hearings on legislation drafted by our Copyright Office for a major general revision of our basic copyright system.

Many of us here this evening have participated in the gestation of this legislation over the past ten years. Present and former officers and trustees of The Copyright Society of the U.S.A. have been in the forefront of this activity, with service on the Panel of Experts advising the Copyright Office, as panelists in many bar association symposia, in chairing and working on bar association copyright committees, and in writing innumerable articles and commentaries on copyright developments.

* The Theatre, Gallery of Modern Art, New York City, April 14, 1965.

Our bi-monthly publication, The BULLETIN of The Copyright Society of the U.S.A., has served as the Rapporteur General for all of these activities. In addition to its many articles on various aspects of domestic copyright, it has published in full the papers delivered at various copyright symposia over the years. It has kept us abreast of worldwide copyright developments, publishing articles by the most distinguished of foreign copyright authorities.

This brings us to the special occasion of this evening—the annual Jean Geiringer Memorial Lecture on International Copyright, under the joint sponsorship of the New York University Law Center and The Copyright Society of the U.S.A. This lecture has come to be one of the especially fruitful highlights of each year—an opportunity to obtain an intimate and learned insight into the copyright problems and thinking of our European friends and colleagues.

In 1963, we were favored by Guy Aldous, Queen's Counsel, of London, on "The Philosophy of the English Copyright Law." Last year, Jean-Loup Tournier, of the French bar, and General Manager of S.A.C.E.M., the authors' and composers' society of France, enlightened us with his "Appraisal of the First Five Years of the French Copyright Law of 1957." The Society's BULLETIN was delighted to print and pass along the benefit of these addresses to the copyright public generally.

This year for our Jean Geiringer Memorial Lecture, we turn to Germany. The subject this evening is "Copyright Reforms in Germany and Elsewhere."

One of the especially useful media for spreading new ideas in copyright, we have found in the United States, is the copyright symposium. This evening, we propose to hold a special sort of symposium, but in a somewhat different and unique style.

For this purpose, I shall introduce to you a most distinguished legal scholar and lawyer who holds a Doctor of Jurisprudence degree from the University of Cologne.

I shall also introduce to you a major executive and administrator in the copyright field, who is the President and General Manager of GEMA, the German Authors' Society for Musical Performing and Mechanical Reproduction Rights.

For an international and comparative point of view, I shall bring before you the man who, in 1955, was elected President of the International Society for Authors Rights (headquartered in Berlin), and who since 1956 has held membership in CISAC, the International Confederation of Authors and Composers Societies (headquartered in Paris), participating actively in various of CISAC's divisions, such as its Con-

federated Council, its Legislative Commission, and its Third Federation for Mechanical Rights.

What better qualification can we ask than membership on the Commission of Copyright Experts of the Ministry of Justice at Bonn, Germany—and I shall present such a panelist.

No symposium of this kind would be complete without a distinguished author on copyrights. I shall introduce a man who has written major texts, innumerable articles and commentaries on such subjects, among many others, as "Authors Rights in Music, and the German Authors Rights Society"; "Music and the Law—the Remuneration of the Composers"; "The Council of Europe and the Law of Authors Rights";—a man who has written an outstanding *Commentary* on all aspects of German copyright regulations in the field of literature, music and the fine arts, and who, as co-editor with three most distinguished German professors, Dr. Möhring, Dr. Eugen Ulmer, and Dr. Konrad Zweigert, has made a compilation of the copyright laws of all countries.

Finally, I shall introduce a member of the public who, by his cultural contributions, has achieved special distinction through his work on the Administrative Council of the International Richard Strauss Society, and been awarded the Komturkreuz of the Order of St. Silvester by the Holy See for bringing to Radio Vaticana the foundation of an international collection of recordings of sacred music.

It is now my great pleasure and privilege, to introduce to you *all* of these panelists in the person of our distinguished guest, Dr. Erich Hans Richard Schulze.

220.

COPYRIGHT REFORMS*Third Jean Geiringer Memorial Lecture on International Copyright**By ERICH SCHULZE**

Jean Geiringer and I were acquainted for almost twenty years. He was a man of many talents and international copyright was one of his particular interests. The subject of my lecture would certainly meet with his approval. His attention had always been directed to international legal development and his efforts toward promoting and maintaining international contacts were almost unique. This has been of inestimable value to us in Europe. His friends in Europe will always hold his memory in great esteem.

INTRODUCTION*Article 27.(2) of the Universal Declaration of Human Rights*

Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

Many obsolete legal concepts originating from old systems of patronage and privilege have not yet been fully overcome in all parts of the world. Prevailing conditions can still be improved by national copyright reform. Frequently, international legal evolution influences the development of national law. Undue delay in the reform of copyright law occasionally has caused courts to resolve matters not covered by legislation.

A decision as to which of the known copyright theories is to be preferred, is beyond the scope of this lecture. Cogent reasons can be advanced for each. We will limit our discussion to a consideration of the practical reform proposals from a moral and sociological point of view.

Generalizations should be avoided, as the boundary between law and politics cannot be clearly defined. Nonetheless, while national development in different countries must necessarily follow different trends, three basic principles can be laid down:

1. Rules for protection of industrial property cannot be applied to copyright in the same way.

* Dr. jur.h.c., Germany.

2. Limitations upon copyright must not be greater than those imposed upon other property under prevailing local rules.
3. The author must be entitled to an equitable remuneration for every exploitation of his work.

The first principle requires that the protection of works of literature and art must not depend on the commercial exploitability of a work, and that copyright must provide for artistic as well as material interests of the author.

The second principle simply requires that copyright property bear no greater burden than that placed by public interest upon other properties.

The third principle is only a matter of justice and equity. As authors usually work spontaneously, and not on commission, remuneration for all uses of their works is an absolute must for their subsistence.

One other matter is worth mentioning. In literature, copyright frequently is called "the labor law of the intellectual creator". Copyright, however, is not a part of labor law nor has it reached the level of sophistication of labor law well known to all of us. Authors have no paid vacations and holidays, job security, guaranteed working conditions, rules concerning working hours, collective bargaining, employment agencies, nor unemployment and sickness benefits.

The copyright law, on the other hand, often tailors a strait-jacket for authors through mandatory contracts, considerations of public interest and compulsory licenses. Be that as it may, whoever feels art to be his calling will still choose the career of an artist without hesitation. This drive, however, should not encourage legislators to enact laws which take advantage of authors.

THE REFORM PROPOSALS

Let us now turn to the proposals usually advanced on the occasion of each attempt at reform.

1. *The Author*

Copyright should vest exclusively in the author of a work. There is absolutely no justification for granting copyright in a cinematographic work to film producers. Only the individual intellectual creators can be considered authors. The producer can acquire the various rights by assignment and, for practical purposes, such contractual arrangements have always sufficed. Contractual arrangements are usually made covering motion picture production, scenario, motion picture music, col-

lective agreements for motion picture staff, distribution conditions, foreign licenses and world-wide distribution.

2. *The Moral Right of the Author*

The author has artistic and material interests in his work. These are inseparable. Whenever the author is not named or the author's work is distorted in reproduction, this is a violation of both artistic and material interests.

Both must be protected for the full term of copyright.

3. *Term of Protection*

Authors oppose the limited duration of copyright protection saying that no other tangible property knows any such limitation. The economic functions of the two protected subjects, however, differ so substantially that this comparison cannot be justified. Many arguments can be advanced in favor of unlimited copyright protection, in particular the fact that works in the public domain can be adapted and distorted at will. On the other hand, the problems that might arise if copyright protection was of unlimited duration can not be ignored.

If the term were unlimited, arrangements would have to be made to ensure that the rights can be exercised even though a great number of heirs might be involved. If, at some later date, all of the heirs should have died, the copyright would have to pass to the state.

Such arguments have led to the suggestion of introducing a paying public domain with its object giving current authors, the intellectual heirs of the past, benefit from the exploitation of works in the public domain. Though this suggestion is tempting, governmental administration and distribution of the funds might well lead, under the guise of social welfare, to a cultural discipline.

Though a limited term of protection appears unavoidable, it must not be of too short a duration. The term must be of sufficient length to ensure that the proceeds from the work will benefit the author until his death, and his surviving kin.

In the majority of countries, the term of protection is the life of the author plus 50 years. This period, however, is no longer adequate when it is remembered that life expectancy has risen considerably. In Germany, at the turn of the century, the mean life expectancy of each new-born male was 44.82 years while that of each new-born female was 48.33 years. In 1962, the life expectancy of each new-born male was 67.08 years and that of each new-born female 72.62 years.

Conditions in the United States are very similar. At the turn of the

century, 48.23 years for new-born males and 51.01 years for new-born females; in 1960, 67.4 years for new-born males and 74.1 years for new-born females.

In view of this increase in life expectancy, the term of protection should be extended to the life of the author plus 80 years.

4. *The Exclusive Right*

The author and his successors must possess an exclusive right in the work for all now known and later developed modes of exploitation for the full term of protection. The changeable classifications of rights in many copyright laws, will continue to result unavoidably in financial loss to authors and their successors as new possibilities of exploitation arise. This is particularly true in this day of rapidly progressing technique. Time is bound to elapse before new rights are acknowledged and law reform is a protracted process. This lag can be favorably reduced by the courts.

Such has been the experience in Germany. The first official draft for reforming the copyright law was prepared in 1932. Many other drafts have followed, none of which, however, has been enacted. In view of the many other bills that have to be considered, it is unlikely that the German legislature will, in the few months before the general elections, find time for passing a copyright reform.

The courts, on the other hand, have in the meantime shown the way by extending the author's rights to new modes of exploitation for very cogent reasons: Under the principle of protection governing copyright, the author must enjoy the benefits of the new possibilities of exploitation resulting from technical development.

The economic significance of these decisions is demonstrated by some figures which are available to me in my capacity as President of the German authors' society, GEMA:

In 1964, more than half of GEMA's receipts were derived from new possibilities of exploitation recognized by court decisions, i.e.

- 3.4% from motion picture theaters,
- 18% from sound broadcasting,
- 19% from television,
- 10% from juke-boxes and transmissions by loudspeaker,
- 1.3% from public reception of TV broadcasts.

As you can see, great amounts would have been lost if authors in Germany would have had to wait for copyright reform.

Case law was not able to give rights to authors, in areas of exploitation where, though known, they had been denied by the legislature. Here, legislation is required. The grant of new rights is of particular interest to the authors of works of literature and fine art who urge an early enactment of the copyright reform.

The authors of works of literature are particularly interested in performing rights and in the segregation of royalties to authors out of payments to rental libraries. The public libraries, however, are to be exempt from the payment of such royalties. Under the proposed revision, creators of fine art are also to be given a performing right, or a right of exhibition.

In addition a "droit de suite" is suggested for these artists. Thus, if the original of a work of fine art is resold, and the buyer, seller or agent in such transaction is either an art dealer or auctioneer, the seller is to be bound to pay to the author a percentage of the proceeds of such sale. (Between 1 and 3 percent has been suggested.) Such payment need not be made if the proceeds do not exceed a certain amount, the suggested minimum being 300 or 500 German Marks.

In Germany it is intended, and this is important to all authors, to require the payment of royalties for uses by churches, and educational institutions.

5. *Limitations on Copyright*

This brings us to the problem of limitations imposed on copyright. Such restrictions are permissible only in so far as they are compatible with principles of general law. With regard to social and public interest, copyright and other rights should stand on equal footing, as otherwise authors are subject to restrictions not imposed on others in similar positions.

In the case of uses by churches, and educational institutions, it would be inequitable to withhold remuneration from authors when payment is made to editors, the publishers and the distributors.

Mention should also be made of a number of other limitations frequently imposed in copyright laws.

a) *Protection of the Private Sphere*

The private sphere, in general, is exempted from copyright claims. The decisions of the German Federal Court granting authors the right to claim royalties in respect of tape recordings of protected works by private persons have therefore been quite a sensation. Tape recordings in fact do eliminate the need to buy records. In buying records on the

one hand, an individual pays a royalty to the author of the recorded work as part of the price of the record. If, on the other hand, an individual buys a tape recorder and uses it for the recording of radio and TV broadcasts, or for copying borrowed records, he can benefit from the recording of the work without paying any royalty to the author.

Lately, manufacturers of tape recorders have also been held liable by the courts. The question of the possible liability of tape manufacturers has not yet been resolved.

The depressing effect of the increased use of tape recorders on the sale of records has been proven by a test made by a well-known German market research institute. More than two-thirds of the questioned owners of tape recorders replied that they used their instruments for copying records and for recording radio and TV broadcasts. The others use the instrument for recording family events, domestic music, recitals etc. All of the owners, therefore, use the instrument to a greater or lesser extent for the recording of protected works. This is bound to affect the sale of records as no one would think of buying the record of a work he has already recorded on tape.

There are also pre-recorded tapes for sale. These naturally, are more expensive than blank tapes. Royalties are paid only on sales of the pre-recorded tapes. As the inviolability of the private home does not permit controls, the German legislature plans to impose the liability for a single royalty payment to the authors' societies on the manufacturers and importers of sound and video recorders.

b) *Public Performance For Profit*

Another limitation common to many copyright laws is the requirement that a use not only be public but also for commercial purposes if a license is to be required. The performing right, for instance, requires the performance not only to be public but also for profit if it is to operate.

This restriction imposes a particular hardship on composers of culturally valuable works. With the state, churches, schools and institutions for general and adult education, a commercial purpose is normally not found so that the composers cannot claim any remuneration for such performances of their works.

Let us take churches for example. Here the composers are treated less favorably than architects, sculptors, painters, organ-builders, or vesture makers, whom no one would expect to furnish their works or services without payment.

In Germany, where copyright law protects only public commercial uses, the Roman Catholic and the Protestant Church have freely agreed

to the payment of a remuneration to the composers of religious music, and, in connection with copyright reform, have given assurance that they would no longer claim exemption under the new law, if the State did not.

The attitude of the churches is no coincidence. It was, after all, no less a man than Joseph Haas whose "Speyrer Domfestmesse" has found its way, in many languages, to all parts of the world, who claimed emphatically: "The actual denial, though unintentional, of the socially well-founded claims to remuneration by composers is one of the reasons why today so few known composers specialize in the creation of religious music . . . Ways and means must be found, however, to encourage composers estranged from the Musica Sacra to be active again in the shunned field of the composition of religious music. One of the means belonging, however, to a more realistic field is the legal approval of a claim to remuneration of church composers from the church authorities."¹

c) *Compulsory Licenses*

One of the other common limitations on free enjoyment of copyright is the compulsory license.

Under present law, compulsory licenses only exist with regard to phonograph recordings. The compulsory license was introduced for the "protection of the domestic industry". Even though such unilateral protection of the domestic industry may have been justified at the time of the enactment, such justification cannot be made under present conditions since

- aa) in view of the international interdependence of the domestic industry, the protection no longer only benefits the domestic industry,
- bb) German authors, on the other hand, are not protected, by any provision, from the distribution of foreign music by the domestic industry, and
- cc) all considerations of this nature are incompatible with principles of liberalization.

In the new law, not only is there no intention of abolishing existing compulsory licenses, as would be justified by changed conditions, but it is intended to continue existing compulsory licenses and extend their applicability to broadcasting.

1. GEMA-Festschrift MUSIK UND DICHTUNG, p. 81.

Once an author has granted the right of reproduction and distribution of his work to a record manufacturer, or the broadcasting right to a broadcasting organization, all other record manufacturers and broadcasting organizations will be entitled, under the German government's draft copyright law, to reproduce, distribute or broadcast the work on payment of adequate remuneration.

What would be the reaction of the record industry and of broadcasting if legislation were to impose an obligation upon them to exploit *any* and *all* works of authors? The absurdity of such an obligation would be obvious to all reasonable men. There can, similarly, be no justification for the detrimental curtailment of the author's right of free contract by a system of compulsory licenses. It must be remembered that, as against the users, authors are in a much weaker bargaining position. If, in addition, they are to be deprived of their right of free contract and are to be restricted to a claim to remuneration, their position will be further weakened.

There is, among interested parties, a frequent trend of confusing "public interest" with the interests of certain economic groups.

d) *Fair Dealing (Musical Quotation and Protection of Melodies)*

The last of the limitations on copyright, the permissibility of free use of the work of another, must also be treated with caution. A right to use melodies and quote music without the approval of the author will let piracy abound.

6. *Statutory Copyright Contract Provisions*

Even though the majority of restrictions might disappear, authors will not benefit from even the most perfect copyright law unless under statutory law governing contracts respecting copyright, authors are positively granted an adequate share in the proceeds from the exploitation of their works.

Legislation might, as has been the case in part in the labor law, render assistance for the negotiation of standard contracts. Experience has shown that the authors' and the users' associations frequently cannot agree on standard contracts. As a result, both the authors and users establish separate forms of contracts and the result, in practice, is that only those prepared by the users are in force. But even in those instances where an agreement can be reached between the associations, their influence is frequently not sufficient to persuade their individual members to base private contracts on the stipulated conditions. Whatever the arrangement might be, the applicability will not extend to non-members of the associations.

Thus, it would be desirable for the legislature to vest bargaining powers in the associations so that the associations would be able to lay down minimum standard contract conditions for all copyright agreements between their members. The minimum conditions, however, should not cover the amount of remuneration, which, after all, must reflect the different inherent value of works and be the subject of individual agreement. In addition, it should be possible, as in labor law, to provide for a general binding effect of the standard contracts for both organized and non-organized authors and users.

Finally, it would be desirable to establish arbitration proceedings for those areas where the associations cannot agree on terms and conditions for standard contracts. The arbitrators should be vested with final authority to establish the terms and conditions of standard contracts.²

7. *Neighboring Rights*

Thus, it has been shown that the copyright law still leaves much to be desired. The reform desires of authors in different parts of the world are more or less varied, depending on the state of the particular national legislation. Authors are also concerned with the development of so-called rights of performing artists, manufacturers of phonographic records and broadcasters. They are afraid that these new developments will detrimentally affect the realization of their own desires.

This concern is not without justification. Vesting the so-called neighboring rights with pecuniary claims will inevitably be unfavorable to authors. Copyright and neighboring rights are of absolutely different character and should not be regulated by one and the same enactment. If both were included in the same law the so-called neighboring rights might well be given primarily copyright characteristics.

An example of this can be found in Germany. The incorporation of copyright and the so-called neighboring rights in one and the same enactment has resulted in decisions of the German Federal Court holding that both the performing artists and the authors are vested with a performing right in a phonographic record. The performing right is vested, for example, not only in the person of the conductor and the soloist but also in every member of the participating orchestra and chorus.³

2. INTERGU: STELLUNGNAHME ZUR URHEBERRECHTSREFORM IN DER BUNDESREPUBLIK DEUTSCHLAND, Akademischer Verlag Bonn (1964), p. 22.

3. Schulze, "Rechtsprechung zum Urheberrecht" BGHZ No. 79 and annotation.

The German recording companies, which had procured the assignment of the performing rights from the performing artists, together with the performing artists, founded a special society for the exploitation of neighboring rights under the name of "Gesellschaft für Verwertung von Leistungsschutzrechten mbH. (GVL)". Drawn out license rate negotiations between this society and the users' associations resulted in a license in the form of a supplement to the prevailing GEMA rates, the collection of which has been undertaken by GEMA while its distribution is the responsibility of the GVL. During the past calendar year GEMA has collected 2.5 million German Marks for the GVL, 20 percent of which was retained by GEMA as a commission.

A virtue has thus been made out of necessity but authors will never be really satisfied with this solution.

There is an international trend toward the separation of the two subject matters. The scope of the Berne Convention and of the Universal Copyright Convention is limited to copyright. A special convention has been established for the protection of the so-called neighboring rights.⁴

8. *International Law*

As we have said, international legal evolution frequently influences the development of national law. Of the two international conventions, the Berne Convention and the Universal Copyright Convention, a further revision meeting of the Berne Convention is scheduled for 1967 in Stockholm.

Not all of the reform proposals which have so far been submitted can be considered progressive. It is suggested to establish a joint administration for the Berne Convention for the Protection of Literary and Artistic Works and the Paris Union for the Protection of Industrial Property. The functions of the Government of the Swiss Confederation are to be taken over by the World Intellectual Property Organization.

If this is to be only a matter of administrative simplification resulting in a reduction in costs and expenses (which would yet have to be shown) general approval of the proposed change would be inevitable. Reticence must be exercised, however, for quite other reasons: Two so extremely different fields of law as the protection of intellectual property on the one hand and the protection of industrial property on the other are to be placed under a joint administration. Whenever the protection of authors' rights and of industrial rights are coupled, experience has shown it will inevitably be to the disadvantage of the

4. INTERGU, *op. cit.* note 2, p. 22.

authors' rights. The protection of authors' rights can and must hold its own ground, as art is governed by principles quite different from those relating to industrial property!

I have already dealt critically with the proposed revisions in my comments published, in English as well as French and German, in the Copyright Series of the International Copyright Society under the title "The Forthcoming Stockholm Revision Conference 1967", where I add my own proposals, so that in order to avoid repetition, reference is made to that publication.⁵ It can only be hoped that the authors' expectations for the forthcoming revision conference will be fulfilled.

And now I would like to show a documentary film⁶ made at the Munich memorial exhibition on the occasion of the centenary of the birth of Richard Strauss (born in Munich on June 11th, 1864, and deceased at Garmisch on September 8th, 1949). This motion picture not only pays tribute to the great services of the famous composer in the evolution of copyright law but should also be considered an indirect challenge to authors all over the world for greater activity in the defense of their intellectual property.

In "Sharing of the Earth"⁷ copyright undoubtedly came off badly by comparison with life's material aspect. But let us not resign ourselves to these verses of Schiller:

*All too late, when the sharing was over,
Comes the Poet—He came from afar—
Nothing left can the laggard discover,
Not an inch but its owners there are . . .
"Alas", said the God—"Earth is given!
Field, forest, and market and all!—
What say you to quarters in Heaven
We'll admit you whenever you call!" . . .*

5. Vol. 36, Edition Franz Vahlen, Berlin and Frankfurt (1964).

6. The film was produced during the summer of 1964. In its introduction it conveys a general impression of the exhibition in Munich's municipal museum entitled "Richard Strauss and His Time". The film then shows particulars of an exhibition hall specially dedicated to Richard Strauss as the patron of authors: original letters, press cuttings, music notation forms from six decades, copyright literature, documentary photographs, and portraits of some of the bearers of the Richard-Strauss-Medal awarded for services rendered for the sake of copyright. At the end of the film, a series of large pictures with significant legends are shown which illustrate once again the historical development of copyright.

7. English translation by Edward, Lord Lytton.

221. COPYRIGHT AND FOLK MUSIC—*A Perplexing Problem**

By BARBARA FRIEDMAN KLARMAN†

Almost unnoticed, the jungle is closing in. The amusement industry, which formerly ignored traditional music, begins to feel that money is to be made from the folk song revival. . . . The incorporation of folk music into the world of show business raises a number of problems, notably that of copyright.¹

Prior to the recent development of public interest in folk music, the commercial possibilities in that area were rarely matters of discussion or concern. However, with the advent of the folk song renaissance during the fifties, enterprising individuals began to appreciate the potential for economic gain inherent in the increasing demand for such music. It was at this time that copyright law first began to be widely employed as a device to secure economic advantage from the distribution and performance of folk music.² The result of this relatively new development is widespread confusion and often frustration and resentment. Today, the problems of copyright and folk music are becoming increasingly acute.³ The purpose of this paper is to present a discussion of the various problems arising out of the uncertainty in the law with regard to folk music and to suggest possible solutions which will best serve the multiple competing interests.

In order to understand the problems raised in the application of the copyright law to folk music, it is imperative to have some knowledge of the kind of music involved; however, folk music almost defies defini-

* This paper received Special Mention in the 1964 Nathan Burkan Memorial Competition, and was first published at 10 *Wayne Law Review* 702 (1964).

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1. Lloyd, *Who Owns What in Folk Song*, 12 *Sing Out*, No. 1, at 41 (1962).
2. As Pete Seeger cogently recognizes:

Face it: the reason so many arguments come now about the pros and cons of copyrighting folksongs is that money is being made from them. "If he gets all that money, why shouldn't I?" Back in the thirties, when no one was making money out of folk music, this argument never came up. Seeger, Pete, *The Copyright Hassle*, 13 *Sing Out*, No. 5, at 41 (1964).

3. It should be noted that confusion and unpredictability with regard to the copyright law are not limited to problems concerning folk music, but apparently involve almost all areas of the law's applicability. See Umbreit, *A Consideration of Copyright*, 87 *U. Pa. L. Rev.* 932 (1939).

tion.⁴ The provisional definition adopted by the International Folk Music Council is as follows:

Folk music is music that has been submitted to the process of oral transmission. It is the product of evolution and is dependent on the circumstances of continuity, variation and selection.⁵

One interesting aspect of this definition is that it omits reference to the origin or authorship of the music. Thus it is conceivable that a folk song may owe its origin to the inventiveness of a single author, but it does not acquire its characteristic as folk music until it submits to the reworkings and reformulations of the community.

The term (folk music) can therefore be applied to music that has been evolved from rudimentary beginnings by a community uninfluenced by art music; and it can also be applied to music which has originated with an individual composer and has subsequently been absorbed into the unwritten, living tradition of a community. But the term does not cover a song, dance or tune that has been taken over ready-made and remains unchanged. *It is the fashioning and re-fashioning of the music by the community that gives it its folk character.*⁶

A further factor in defining folk music is the time element, which differentiates a popular song from one that in fact has been absorbed into the folk tradition.⁷ Although this element would vary considerably depending upon many factors, such as the strength of the folk tradition in the given community, for the purposes of discussing folk music and copyright law in this paper, the time element may be presumed to be sufficiently long so as to avoid the possibility of any legitimate claims of original authorship to a given piece of music. Thus, the folk music which is the subject of this paper is music, the origin of which is unknown or irrelevant, that has been successfully absorbed into the folk tradition of a community, and has been reworked and refashioned over a significant period of time.

On the basis of such a definition, it is easy to see how claims of individual, personal ownership of that music would provoke serious and

4. See Karpeles, Definition of Folk Music, 7 Journal of the International Folk Music Council 6-7 (1955) for a discussion of the difficulties encountered at the Annual Conference of the International Folk Music Council in their attempts to define folk music in such a way as to satisfy all members.

5. Id. at 6.

6. Ibid. (Emphasis supplied.)

7. See Karpeles, supra note 4, at 7.

vociferous objections. Such objections are raised not only by those who assert competing claims to ownership, but also by those, comprising a rather sizeable group, who are disposed to believe that folk music should belong to everyone for free use and enjoyment.

Some would advance the view that the collector doesn't create the stuff, he merely transmits material that should already be considered as belonging to the public domain, so he cannot in honesty claim it as his own property.⁸

This position is often further substantiated by pointing to governmental and university grants which actually financed the work of collecting and compiling.

Of course, no one wants to prevent, or would try to prevent the folk from singing their own songs privately. . . . But heaven help anybody that tries to sing a printed song . . . for money. The money to be made out of folklore (and we are now learning to our surprise just how much money there seems to be) belongs to the owners of folklore. And the owners of folklore—God bless us all—now turn out to be the folklorists who collect and print it, generally on government and university money; but who did not create it, who are, as a matter of fact, forbidden by the rules of the game even to try to create it, and who—one ventures to say—bloody well cannot create it.⁹

The various parties asserting claims to this music include primarily arrangers and collectors, sometimes more than one of each, asserting competing priorities to a given piece. These parties, along with their publishers, are usually the ones immediately involved in copyright conflict, but as previously pointed out, the conflict is often complicated by those who maintain that this music is strictly in the public domain and that no private property rights exist therein.

Considering the wide variety and latitude of the conflicting interests, all of which are often accompanied by intense economic and personal involvement, it is not surprising that this situation should result in general confusion. The misinformation can nowhere be better demonstrated than by a recently published discussion between two highly reputable folklorists, G. Legman and Charles Seeger.¹⁰ Legman related

8. Lloyd, *supra* note 1, at 41.

9. Legman, *Who Owns Folklore?*, 21 *Western Folklore* 1, at 11-12 (1962).

10. This discussion was published in 21 *Western Folklore* in the following articles: Legman, *supra* note 9; and Seeger, Charles, *Who Owns Folklore?—A Rejoinder*, 21 *Western Folklore* 93 (1962).

the history of the song, "Frankie and Albert." According to Legman's account, Frankie Baker, the actual murderess, was also the presumed composer of the song. She taught this song to Palmer Jones, a Negro pianist and singer. In the early part of the twentieth century, Jones wrote the song down in a pencil manuscript for the father of Hilaire Hiler, who subsequently gave it to Robert Carlton Brown, who later gave it to Legman himself. The song was then printed with credit given to Legman in a book entitled, *The Folk Songs of North America*, (London 1960), edited and compiled by Alan Lomax; the entire book was copyrighted.¹¹ After recounting this history, Legman asserted that legal ownership of the song is exclusively in Alan Lomax through the fact of its publication in the copyrighted book. This assertion was challenged by Seeger who claimed only that such copyrights are never enforced by the courts and in fact are never even litigated. He avoided the underlying question as to whether in fact a legally enforceable copyright does exist. Seeger, however, did suggest that such claim of copyright may have an intimidating and even blackmail effect upon future users by coercing them to pay otherwise uncollectible royalties.¹²

The amazing feature of this discussion is that neither party's statement is accurate. Both writers are professionals in the folk music field itself and yet they have relatively little understanding of what their legal positions are. Their discussions of this problem abound in vague theories and general conclusions and rarely refer to any legal source of authority.¹³ Thus, based on rumor, conjecture, and hearsay, these discussions continue in folk music circles, but they do not contribute any significant enlightenment on this troublesome area. This apparent ignorance on the part of the professionals is not truly blameworthy.

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11. Such a historical accounting demonstrates how circuitous a route this music may traverse.
 12. Seeger also pointed out that the fear of copyright infringement litigation leads some publishers to get "permission" from someone who claims ownership of a piece of music to use that music, and to pay that party a stipulated fee so that any subsequent litigation would be directed against the party fictitiously claiming ownership and not against the publisher or editor using the song with permission.
 13. An article written by Irwin Silber, an editor of *Sing Out*, does indicate a substantial attempt to consider the implications of the law as it stands on the statute books and in practice. See Silber, *Folk Songs and Copyrights*, 9 *Sing Out*, No. 4, at 31 (1960). Silber's failures in his results can be excused not only on the basis of his probable unfamiliarity with the jurisprudential method, but also because of the unavailability of significantly helpful material. This latter matter presents a very serious deficiency and will be discussed *infra*.

It is the intention of this author to demonstrate the practical inevitability of such confused and uncertain discussions in this field, not only insofar as folklorists themselves are concerned, but also as far as lawyers are involved. The consequence of this unresolved confusion includes not only frequent blackmail payoffs to undeserving claimants, but also bitterness and frustration in the face of a law which does not seem to offer sufficient guidance, protection, or control in an area in which the need therefor is intensely felt.

At this point, one might well query as to what the law actually is and what legal rights are in fact involved in the copyrighting of folk music. One could begin by looking at the applicable sections of the copyright statute itself.¹⁴

§7. COPYRIGHT ON COMPILATIONS OF WORKS IN PUBLIC DOMAIN OR OF COPYRIGHTED WORKS; SUBSISTING COPYRIGHTS NOT AFFECTED.

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.¹⁵

§8. COPYRIGHT NOT TO SUBSIST IN WORKS IN PUBLIC DOMAIN, OR PUBLISHED PRIOR TO JULY 1, 1909, AND NOT ALREADY COPYRIGHTED. . . .

No copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to July 1, 1909, and has not been already copyrighted in the United States. . . .¹⁶

First, it is apparent from even a cursory reading of the above-quoted sections that the statute offers no practical guidance whatsoever.

14. 17 U.S.C. (1947), as amended, 17 U.S.C. (Supp. V 1964).

15. 17 U.S.C. §7 (1947).

16. 17 U.S.C. §8 (Supp. V 1964).

ever.¹⁷ It might be noted that the principal significant terms are never defined in the statute; thus would one seek in vain therein for any guidance in determining the legal standard for such fundamental terms as "public domain," "original," and "infringement." Second, for purposes of the present discussion, it should be noted that no specific reference is made in the copyright statute to folk music or folk art of any kind. Such art is only covered by implication to the extent that it falls within the generic category of works in the "public domain." As a result of this omission, one might conclude that the law takes no special account of the considerations unique to folk music,¹⁸ but merely treats it in the same manner as all other music.¹⁹

If the statute has proven to be of little assistance, the regulations and bulletins of the Copyright Office are not more helpful.²⁰ Its informational circular concerning new versions of public domain and/or previously copyrighted works appears to speak directly to the issues involved in folk music problems.²¹ In fact, it offers little more definition and guidance than does the statute, itself.

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17. The conclusion that the copyright statute lacks any abstract unifying theory or fundamental conception led one writer to comment as follows:

The [Copyright] statute, it is true, does not contemplate any such fundamental conception, but the statute is about as useful to a lawyer confronted with these questions as a copy of *Quia Emptores* is to a modern conveyancer. Umbreit, *supra* note 3, at 951.

18. A discussion of these unique considerations follows in the text, *infra*.
19. This conclusion seems warranted not only by the fact that research has failed to uncover any instance of special treatment of folk music, but also by a consideration of the basic copyright law which is set down in such general terms that it would not lend itself to a construction making an operative distinction between folk music and any other kind of music in the public domain.
20. 17 U.S.C. §201 (Supp. V 1964) designates the Copyright Office of the Library of Congress as the agency to administer the copyright law.
21. Copyright Office, Circular 35B.

1. New Versions

Under the copyright law (Title 17 of the United States Code) a new version of a work in the public domain, or a new version of a copyrighted work which has been produced by the copyright owner or with his consent, shall be copyrightable as a "new work." Copyrightable "new works" include compilations, abridgements, adaptations, arrangements, dramatizations, translations, and works republished with new matter.

The copyright in a new version covers only the additions, changes, or other new material appearing for the first time in the work. There

Since legislative and administrative direction is either totally absent or extremely negligible at best the task of developing the law in this area has devolved almost exclusively upon the federal judiciary.²² Aside from the inordinately difficult problems in understanding and applying the copyright statute, such extensive reliance upon the federal judiciary raises all the additional problems of the federal court system itself, *i.e.*, variance of interpretation between the circuits, the lack of sufficient definitive Supreme Court rulings, and the variety and multiplicity engendered merely by the large number of courts dealing with these questions which are all derived from the same statute. The result is a mass of confused, tangled, obscure and vague judge-made rules, a

is no way to restore copyright protection for a work in the public domain, such as including it in a new version. Likewise, protection for a copyrighted work cannot be lengthened by republishing the work with new matter.

2. Reprints

The Copyright Office has no authority to register claims to copyright in mere reprints. In order to be copyrightable, a new version must either be so different in substance from the original as to be regarded as a "new work," or it must contain an appreciable amount of a new material. This new material must also be original and copyrightable in itself. When only a few slight variations or minor additions of no substance have been made, or when the revisions or added material consist solely of uncopyrightable elements, registration is not possible. The Copyright Office considers the information contained on the application form in determining registrability, and makes no attempt to compare the version submitted with any earlier version of the work.

3. Compilations and Abridgements

Any work, to be copyrightable, must be the "writing of an author." Thus, compilations and abridgements, may be copyrighted only if authorship is involved in their preparation. When the assembling of a "compilation" is a purely mechanical task without any element of editorial selection or when the preparation of an "abridgement" involves only a few minor changes or deletions, registration would not be authorized.

One might also notice that, as stated above in Section 2, the Copyright Office merely uses the information contained on the application form in determining the registrability of the work. It makes no independent investigation and exercises no judgment other than that manifestly required by the application itself. As such, it offers relatively little guidance or directive support.

22. 28 U.S.C. §1338(a) (1958) grants original and exclusive jurisdiction to the federal district courts to entertain civil actions in copyright cases.

comprehensive statement of which goes far beyond the scope of this paper.²³

One of the most significant factors contributing to this chaotic situation seems to be invariably overlooked.²⁴ In almost every other branch of the law, reported cases not only cite the rule of law decisive of the issues, but they also present a statement of the factual matters upon which the judgment of law is made. It is the account of the facts giving rise to the conflict that helps to elucidate the applicability and impact of the ruling of law made thereon and thus provides a meaningful standard applicable to other related sets of facts. It is this stated factual foundation which is so significantly lacking in reported musical copyright litigation. A ruling that the song, "L'Annee Pensee" was sufficiently original to be entitled to copyright and that it was infringed by the publication of the song, "Rum and Coca-Cola"²⁵ is entirely inconsequential to someone who is not familiar with the actual music involved. Only few questions in musical copyright matters can be adequately handled by words alone.²⁶ The vast majority of these cases require some greater familiarity in depth with the *facts* of the case, *i.e.*, the music itself, in order to set forth any intelligible standards.

One outstanding exception to the general run of inadequate opinions was written by District Judge Yankwich, a jurist widely noted for his interest in and excellent contributions to the field of copyright law.²⁷ The opinion sets forth in words not only the conflicting claims of the parties involved, but also presents a most clear, cogent statement of the law and its applicability to the facts at issue. Finally, appended to the decision is a set of musical examples which illustrate the factual setting

23. Discussions attempting to consolidate and organize into some reasonably intelligible form the rulings regarding musical copyright questions of originality, copyrightability, infringement, and so on can be found in Shafter, *Musical Copyright* (2d ed. 1939); Henderson, *The Law of Copyright, Especially Musical*, 1 *Copyright Law Symposium* 125 (1939); Schaeffer, M. and L.G., *Infringement of Musical Copyright*, 4 *John Marshall L.Q.* 511 (1939); Dworkin, *Originality in the Law of Copyright*, 11 *Copyright Law Symposium* 60, at 78-80 (1962); Propper, "Popular" Music—Copyright Law, 3 *Copyright Law Symposium* 164 (1940).

24. Research by the present writer has failed to uncover any recognition of this particular aspect of the problem.

25. *Baron v. Leo Feist, Inc.*, 173 F.2d 288 (2d Cir. 1949).

26. See *Smith v. George E. Muehlebach Brewing Co.*, 140 F. Supp. 729 (W.D. Mo. 1956), a case which decided that the addition to an existent piece of music of the sound "tic toc" and setting it to the sound and tempo of a ticking clock contributed nothing of sufficient originality to make the work the subject of copyright.

27. *Hirsch v. Paramount Pictures, Inc.*, 17 F. Supp. 816 (S.D. Cal. 1937).

for the opinion itself. These examples were introduced by the following appropriate comment:

Note: It is difficult to describe by words similarities or differences in musical compositions. They can be best illustrated by the music itself. There is, therefore, attached here, by way of illustration, one of the exhibits demonstrating the similarity between the eight bars in the plaintiff's song and the others referred to in the opinion.²⁸

This excellent opinion demonstrates that it is feasible to write adequate, intelligible and meaningful musical copyright opinions, a matter which is so particularly pressing in the area of law which, as discussed above, depends almost exclusively upon judicial direction.

The next question is to consider how the copyright law applies to folk music which by definition owes its authorship to the community at large. As noted above, the law provides no specific treatment of folk music. However, the commercial use of such music either in arrangements or in compilations does raise some specific problems with regard to the law. The work of the compiler of folk music is very different in quality from that of the arranger, even though the two types of efforts may at times coincide. Involved in this distinction is the more general differentiation between "fact" work and "art" work. The compiler gathers and collates objective data into some intelligible, useful order, thus being involved in a mechanical process which does not especially reflect the personality of the author. On the other hand, the arranger is more involved in the artistic process of originating ideas, patterning them, and providing their ultimate expression, albeit using pre-existing materials as a basis, but nevertheless embodying reflections of his own individuality in the product itself.²⁹

Although the copyright law protects both kinds of efforts, there may be a significant difference in the law's application to the two types of product. The amount of innovation beyond the pre-existing material that is necessary to secure a copyright may be significantly smaller with regard to artistic arrangements than with regard to compilations.³⁰

28. *Id.* at 818-19. The impossibility of objectively measuring degree of similarity between musical compositions is a problem relevant not only to copyright considerations, but also to many areas of musicological inquiry.

29. For an excellent discussion of this general distinction with reference to the copyright law, see Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 *Harv. L. Rev.* 1569 (1963).

30. See *id.* at 1573-76 for a discussion of the problem of the comparative degree of originality required to obtain initial copyright protection on fact and art works.

There may also be some difference in the amount of innovation necessary to avoid infringement with regard to the two different kinds of works.³¹ In addition, the doctrine of fair use which was developed to protect the legitimate public interest in the dissemination and utilization of materials covered by copyright protection³² might well be applied differently to arrangements and compilations.³³

Viewing these problems from the hypothetical vantage point one might draw the following general conclusions: Copyright protection for the "arranger" is probably in the same chaotic situation as is music copyright in general; thus, if a court is satisfied that the arrangement has added something original or novel to the pre-existing folk song the court will grant copyright protection against an infringer, *i.e.*, one who actually copies not the underlying public domain song, but a substantial part of the arranger's personal additions. Copyright protection for the compiler is even more uncertain. In viewing analogous situations one can only conclude that the extent of protection will depend upon the court's evaluation of the social interest to be served by the free appropriation and dissemination of folk music as opposed to the personal interest of the compiler in harvesting and protecting the fruits of his own labor.³⁴ As vague and indefinite as those statements might be, the problems become infinitely more complicated when reduced from the pinnacles of hypothesis to the plains of actuality. Thus, while in theory a collector could not restrict the use of admittedly public domain material by asserting a copyright on the entire collection, in practice a collector would claim copyright not simply on the compilation itself but also on each individual piece by alleging to be either

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31. Generally, the amount of originality necessary to procure a copyright is far less than the amount necessary to avoid infringement. See Gorman, *supra* note 29, at 1573.
 32. For an excellent historical and analytical discussion of the doctrine of fair use, see Yankwich, *What Is Fair Use?*, 22 U. Chi. L. Rev. 203 (1955).
 33. It was suggested by Gorman, *supra* note 29, that the courts attempt in practice to protect the free dissemination of materials which are considered vital to society by refusing to uphold any asserted copyright, by defining quite narrowly the standard of infringements, or by extending the doctrine of fair use. Gorman maintains that the latter two methods are preferable to the first in that an author thereby can at least protect his efforts from the most extreme, pirating.
 34. See Gorman, *supra* note 29, for a discussion of several analogous "fact" work situations. Gorman points out that the courts have been very reluctant to uphold claims of copyright infringement of matter such as news stories and historical scholarship, whereas they have extended generous protection to copyrights of catalogues and directories, containing information of only minimal interest to society as a whole.

the composer or the arranger. Thus, the real problem is to determine to what degree of alteration can one subject folk music and thereby gain copyright protection. Examples of exorbitant authorship claims to well-known folk songs have been cited by irate writers in this area.³⁵ The Weavers, a well-known folk song group, are said to claim authorship of such well-known songs as "Michael Row the Boat Ashore," "Go Tell It On the Mountain," "Drill Ye Tarriers Drill," and others; the authorship of "Michael Row the Boat Ashore" was also claimed by another group, The Skiffers; and a folk song as famous as "Swing Low, Sweet Chariot" was claimed as being written by another group, The Tarriers.³⁶

Most of these copyrights stand only because they are never challenged by litigation in the courts. However, when such a case does arise, the results are often overwhelmingly confusing. In *Wihtol v. Wells*,³⁷ the plaintiff brought an action for infringement of his copyrighted song. Plaintiff had admitted that the copyrighted song was based on a Russian folk melody he had heard thirty years before. The district court had denied the claim of infringement by holding that plaintiff's song was not original and hence not subject to copyright. On appeal, the decision was reversed. The holding of the court of appeals indicated that merely *notating* a folk melody is sufficient originality of endeavor so as to gain copyright protection thereon:

. . . [I]t was original work on plaintiff's part when, some thirty years later, he devised a calculated melody score thus putting it in shape for all to read. It was quite natural that plaintiff employed similar successions of sound in his writing of the melodic element of his "My God and I." . . . We hold plaintiff's writing of the exact and complete melodic element of "My God and I" was an original work subject to copyright.³⁸

The opinion indicated that the Copyright Act makes the certificate of registration *prima facie* evidence of copyright validity; therefore, in infringement cases the burden is upon the defendant to overcome the presumption and to prove that plaintiff's work is not sufficiently original so as to qualify for copyright protection. This kind of a decision raises severe restrictions on the use and dissemination of folk music. Once a claim of copyright is asserted, others can only use that material without paying royalties at their peril; they expose themselves to expensive

35. See Silber, *supra* note 13, at 34, 36.

36. *Ibid.*

37. 231 F.2d 550 (7th Cir. 1956).

38. *Id.* at 554.

litigation requiring the employment of expert witnesses³⁹ to prove that the source of plaintiff's material is in the public domain and hence not original in the copyright sense. It is understandable that very few individuals in the folk music field would be willing or able to undertake such a dangerous course fraught with the risks and uncertainties of the legal process merely in order to assert their right to material in the public domain.⁴⁰

Suggested solutions to these knotty problems have been proposed by several writers in the folk music field. One suggestion was in the nature of a plea to the professionals in the folk music business itself to recognize their own personal responsibility and integrity by refusing to assert false or misleading copyright claims.⁴¹ However, it may be too naive to believe that such a direct appeal to morals, ethics, and self-restraint in this competitive, commercial world will have a very significant effect.

Irwin Silber, an editor of a leading folk music journal, *Sing Out*, has suggested setting up a Folk Song Foundation which would collect royalties on traditional folk music and would use this money for grants in promoting research and dissemination of this essential and important part of our national heritage.⁴² This solution might serve to vindicate the public interest in attempting to keep its own folk culture from stultification and commercialization, but it does not begin to resolve the underlying problems, such as whether a given song is in fact a folk song or whether it has been sufficiently varied so as to qualify for copyright protection as a legitimate arrangement. Furthermore, to require payment for any and all uses of folk music would serve as a far greater deterrent to its availability than even the present confusing system. Many advocates of freely available folk music would make an exception to such principle when outright commercial advantage is being extracted from its use. However, the administration of such a plan as Silber's would retain so many problems and create so many new ones that it hardly appears to offer an improvement over the present system.

39. For an excellent article regarding the problems of litigation, see Orth, *Use of Expert Witnesses in Musical Infringement Cases*, 16 U. Pitt. L. Rev. 232 (1955).

40. In a case similar to *Wihtol*, supra note 37, the defendant successfully defended himself against a claim of infringement by asserting not only that plaintiff's work was based upon a pre-existing public domain song, but also by presenting and proving to the court the original common source and by demonstrating the insubstantiality of plaintiff's alleged changes and adaptation. *Norden v. Oliver Ditson Co., Inc.*, 13 F. Supp. 415 (D. Mass. 1936).

41. Eitman, *Copyrights and Collectors*, 10 *Sing Out*, No. 3, at 20 (1960).

42. Silber, supra note 13, at 36.

Pete Seeger presented a tentative solution similar to Silber's, but it was advanced in somewhat more detail.⁴³ He suggested that a law should be passed requiring recording companies to pay into a PD fund (presumably meaning "public domain" fund) two cents per song per record for any PD song on the record. The funds collected therefrom could then be used to finance new folk song collecting. The Fund would be empowered to sue people who "unjustly claim copyright control over folksongs."⁴⁴ In addition, Seeger recommended that copyright protection in legitimate arrangements of folk songs should extend only for five years rather than the present fifty-six years. This latter proposal seems somewhat attractive except that it ignores the difficult problems which are involved with determining which folk music is subject to copyright protection in the first instance.

An even more novel suggestion was made by Charles Seeger: "What we need is a law penalizing deliberate intent to claim copyright in an item known to be in the public domain."⁴⁵ He felt that this matter should be incorporated into a section of the criminal code dealing with fraudulent communications. A provision in the present Copyright Code provides for the punishment by a fine or imprisonment or both for the misdemeanor of willful infringement for profit of any copyright secured under the Code.⁴⁶ The present statutory crime has only a limited and defined applicability. However, the proposed crime could have such a far-reaching, indefinite applicability that the mere threat of its potential invocation might serve to restrict too severely the statutorily approved use of public domain material.⁴⁷

Finally, it should be noted that the International Folk Music Council has adopted the position that the collector of folk music should be regarded as the "first owner" of his particular written copy of the song, and that he should be granted the same copyright protection for his work as would be granted for an original composition.⁴⁸ This copyright would only protect the collector against actual copying of his work and would not prohibit any other person from collecting by his own efforts the same material that is still current in the tradition. This proposal is based on the recognition of the difficulty inherent in the collector's work and of the collector's need to preserve the fruits of his labor. It might

43. Seeger, Pete, *supra* note 2.

44. *Id.* at 45.

45. Seeger, Charles, *supra* note 10, at 96.

46. 17 U.S.C. §104 (1947).

47. See 17 U.S.C. §7 in text accompanying note 15, *supra*.

48. See 22 *Western Folklore* 187-89 (1963) for the "Statement on Copyright in Folk Music" adopted by the General Assembly of the International Folk Music Council, August 26, 1957.

be noted that the views of the Council are at variance with those of most professional folklorists in the United States.⁴⁹ In addition, whether Congress would have the constitutional power to grant collectors copyright protection as if they were "authors" is questionable.⁵⁰ Also, if the purpose of copyright is not to benefit the individual authors, but is primarily aimed at stimulating artistic creative production for the benefit of the whole public, it is difficult to see how a law providing special protection for the collector's efforts rather than the creator's could serve to further the underlying policy of the statute.⁵¹ Finally, no valid reason has been advanced to single out folk music collectors from all other compilers for special legal protection. Thus, to create special copyright protection for folk song collectors is not in keeping with our national policy and not warranted by the situation even as it presently exists.

One further possible solution might be to set up a Copyright Office which would function in a manner similar to the Patent Office; it would pass upon the registrability of the material submitted to it prior to issuing a copyright and in the process would make determinations as to the originality of the material. However, as there is a difference in quality of endeavor between mechanical invention and aesthetic or intellectual creativity, so the patent law itself differs from the copyright law. The former grants protection only to novel ideas whereas the latter protects original work regardless of whether it is novel or not.⁵² In the face of this distinction, it would seem to be virtually impossible for any agency to determine whether an author claiming to have written an original work has in fact created it out of his own imagination or whether he merely copied it from some source unknown to the investigating authorities. It is this infinity of possibility which makes strict adminis-

49. *Id.* at 187.

50. U.S. Const., art. I, §8(8) provides that Congress shall have the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

51. "The Constitution does not establish copyrights, but provides that Congress shall have the power to grant such rights if it thinks fit. Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given. Not that any particular class of citizens, however worthy, may benefit, but because the policy is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention to give some bonus to authors and inventors."

From Report No. 2222, 60th Cong., 2d Sess., February 22, 1909, accompanying the bill embodying the present Copyright Act approved March 4, 1909, effective July 1, 1909. This material appeared in Howell, *THE COPYRIGHT LAW* xi (3d ed. 1952).

52. See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

trative control of the copyright law impossible as the law now stands. An alternative procedure which would grant protection to the first copyright registration over any other later asserted claims could work obvious injustice upon authors whose commercial spirit did not lead them to dash madly for the Copyright Office upon first writing down a fleeting and perhaps as yet undeveloped idea. The obvious difference between real property and artistic ideas would lead one to conclude that the title registration system appropriate to one may not be appropriate to the other.

CONCLUSION

This paper has been concerned with the presentation of the problems currently existing in the field of folk music and the applicability of the copyright law thereto. As was pointed out, the problems exist because the nature of the underlying subject-matter—folk music—is such as to avoid discrete classification into any of the traditional property definitions. The types and diversity of interests competing for recognition in this area make the situation with folk music somewhat unique as compared to other subjects of property interests, or even more specifically as compared to other matters which fall under copyright application. That the problem is significant is apparent from the sizeable literature devoted to a discussion of it in current journals. However, as noted above, the solutions which have been proffered have been, in the opinion of this writer, seriously deficient, failing to account sufficiently for one or more aspects of a legitimate interest.

The final inquiry then must be concerned with evaluating the present system and recommending any changes which would improve the existing unpleasant chaotic situation. Starting from the underlying evaluative judgment that folk music is a great national resource and should be available for widespread dissemination and free utilization, the following conclusions ensue. The present system does not appear to be adequate in defining and protecting the limits of both free use and private ownership. However, no basic alterations have been suggested which would, in this writer's opinion, serve to improve effectively the existing situation without destroying the balance among the various legitimate competing interests.

One could propose, nevertheless, some minor suggestions which might better effectuate the administration of the present system. As discussed previously, the greatest responsibility in this area of the law falls upon the federal judiciary. If any substantial improvement is to be made, it must originate in this area. Opinions should be written to afford the most guidance possible to others. These opinions should be

clear and well-formulated as to the rules of law, and most importantly, should present enough of the actual music so as to be intelligible to the musical community. Whatever law and authority with regard to these special problems that is now available or becomes available in the future should be as widely publicized as possible. This publicity should be undertaken by journals and private organizations which have a special interest in these matters. In addition, when new cases arise involving the use of allegedly public domain folk music, private organizations should be allowed to intervene in the action as *amicus curiae* to present their views to the court and to draw upon their resources of expertise to inform the court as to the true nature of the music in question. If intervention is not possible or desirable, private organizations could still offer their assistance to individual litigants and thus promote the development of the law in the manner which these organizations desire.⁵³ Thus, in summary, the most efficacious solution to these complex problems seems to call upon the combined efforts of the courts and the interested organizations to strive toward a clearer statement of the law and a more widespread publicity thereto in order to promote satisfaction and stability in this difficult area of law.

53. In the usual copyright litigation, the individual defendant is not necessarily in a position where he is able to overcome the presumption that plaintiff's composition is original and hence copyrightable. An organization could assist by locating the underlying public domain source of plaintiff's piece and thus dispose of the plaintiff's copyright claim thereon.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. UNITED STATES OF AMERICA AND TERRITORIES

222. U. S. BUREAU OF CUSTOMS.

Title 19—Customs duties. Chapter I—Bureau of Customs, Department of the Treasury [T.D. 56393] Part 11—Packing and stamping; marking; trademarks and trade names; copyrights. Part 19—Customs warehouses and control of merchandise therein. Part 24—Customs financial and accounting procedure. Increases in certain customs fees. [F.R. Doc. 65-4074]. (30 *Federal Register* 5580, no. 75, Apr. 20, 1965.)

Amendments providing for increases in certain customs fees, effective 30 days after the date of publication in the Federal Register. Included are increases from \$90 to \$100 for recording a trademark, trade name, or copyright.

223. U. S. CONGRESS. HOUSE.

H.J. Res. 431. Joint resolution extending the duration of copyright protection in certain cases. Introduced by Mr. Willis, April 27, 1965, and referred to the Committee on the Judiciary. 1 p. (89th Cong., 1st Sess.)

A resolution to extend the renewal term of copyright in any work on the date of approval of the resolution until December 31, 1967, if such term would expire before that date. A similar resolution providing for an extension until December 31, 1965 was approved on September 19, 1962 as Pub. L. No. 87-668.

224. U. S. CONGRESS. SENATE.

S. 1870. A bill to amend title 17 of the United States Code, "Copyright", to bar actions for infringement of copyright in certain instances, and for other purposes. Introduced by Mr. Carlson, May 3, 1965, and referred to the Committee on the Judiciary. 2 p. (89th Cong., 1st Sess.)

A companion bill to H.R. 94, introduced by Mr. Lindsay on January 4, 1965. See 12 BULL. CR. SOC. 161, Item 44 (1965).

225. U. S. CONGRESS. SENATE.

S.J. Res. 82. Joint resolution extending the duration of copyright protection in certain cases. Introduced by Mr. McClellan, May 14, 1965, and referred to the Committee on the Judiciary. 1 p. (89th Cong., 1st Sess.)

A companion resolution to H.J. Res. 431. See Item 233, *supra*.

226. U. S. COPYRIGHT OFFICE.

Sixty-seventh annual report of the Register of Copyrights for the fiscal year ending June 30, 1964. Washington, 1965. 25 p.

"Preprinted from the Annual report of the Librarian of Congress for the fiscal year ending June 30, 1964."

Includes legislative and judicial developments of the fiscal year relating to copyright.

2. FOREIGN NATIONS

227. FRANCE. *Laws, statutes, etc.*

Gesetz Nr. 64-689 über die Anwendung des Grundgesetzes der Gegenseitigkeit auf dem Gebiet des Urheberrechtsschutzes, vom 8. Juli 1964. (67 *Blatt für Patent-, Muster- und Zeichenwesen* 75, no. 2, Feb. 1965.)

A German translation of an amendment to the French copyright statute, which predicates copyright protection of works of foreign nationals on the basis of reciprocity. See 12 BULL. CR. SOC. 128, Item 22 (1964).

228. GREAT BRITAIN. *Laws, statutes, etc.*

Gesetz vom 1963 zum Schutze der ausübenden Künstler. Vom 31. Juli 1963. Gesetz zur Änderung des Gesetzes zum Schutze der ausübenden Künstler, um der in Rom am 26. Oktober 1961 abgeschlossenen Konvention Wirksamkeit zu verleihen. (67 *Blatt für Patent-, Muster- und Zeichenwesen* 75-76, no. 2, Feb. 1965.)

A German translation of the British law of July 31, 1963, implementing the Rome Convention on Neighboring Rights of 1961. See 11 BULL. CR. SOC. 413, Item 281 (1964).

229. NORWAY. *Laws, statutes, etc.*

Königliche Entschliessung vom 10. April 1964. (*67 Blatt für Patent-, Muster- und Zeichenwesen* 76-77, no. 2, Feb. 1965.)

A German translation of a decree extending the provisions of the Norwegian copyright laws to nationals of member states of the Berne and Universal Copyright Conventions. See 12 BULL. CR. Soc. 163, Item 49 (1965).

PART III.**CONVENTIONS, TREATIES AND PROCLAMATIONS****230. COUNCIL OF EUROPE.**

Protocol to the European Agreement on the Protection of Television Broadcasts. (1 *Copyright* 55-56, no. 3, Mar. 1965.)

The Protocol, which amends the Agreement, "was signed at Strasbourg on January 22, 1965, by the Delegates of the Governments of the following countries: Denmark, France, Germany (Fed. Rep.), Luxembourg, Sweden. It was then signed by Belgium on February 2, 1965, and by the United Kingdom on February 23, 1965.

"Denmark, France, Sweden and United Kingdom, which had previously ratified the Agreement, signed the Protocol without reservation in respect of ratification.

"In accordance with its Article 4, paragraph 2, the Protocol will enter into force on March 24, 1965."

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

231. *Nom Music, Inc. v. Kaslin*, 343 F.2d 198, 145 U.S.P.Q. 237 (2d Cir., Apr. 2, 1965) (Lumbard, J.) *For decision below, see* 227 F. Supp. 922, 141 U.S.P.Q. 22, 11 BULL. CR. SOC. 339, Item No. 213 (S.D.N.Y. 1964).

Appeal from judgment for plaintiff in action for copyright infringement. Defendant's musical composition, "Daddy's Home", was held by the trial court to have infringed plaintiff's copyright in "A Thousand Miles Away."

Held, affirmed.

Defendant argued that plaintiff had forfeited its copyright by replacing the name of the original copyright proprietor in the copyright notice with its own name when it published "A Thousand Miles Away," such publication having occurred after the original Section 12 copyright registration of the song and after it was assigned to plaintiff, but before the assignment to plaintiff was recorded in the Copyright Office. The court held, however, that plaintiff's published piano arrangement was a "new version" entitled to copyright as a new work and that there is no requirement that the copyright notice on a new version of an existing work show the same copyright proprietor as the notice on the original version. The court said:

To secure copyright protection in a published work, a notice of copyright must appear on each copy, 17 U.S.C. §10, and, in the case of a printed work, the notice must give the name of the copyright proprietor. 17 U.S.C. §29. The dispositive question on this appeal is whether the plaintiff was the "proprietor" of the published version of "A Thousand Miles Away" during the weeks between December 27, 1956 and January 16, 1957.

Section 32 of the Copyright Act provides that:

"When an assignment of the copyright in a specified book or other work has been recorded the assignee may substitute

his name for that of the assignor in the statutory notice of copyright prescribed by this title.”

The effect of §32 is that, where the copyright in a published work is assigned, the assignee becomes the proprietor of the assigned work for purposes of the copyright notice only after the assignment is recorded. Much of the argument on this appeal has been directed at the question whether §32 also applied where the statutory copyright in an unpublished work—a §12 copyright—is assigned, that is, where the work is published for the first time after the assignment.

The district court held that §32 does not apply in the latter case. Whether this is a proper view of the section's scope we do not decide, for we conclude that §32 was inapplicable here on another ground: Even if we assume for purposes of §29 that, prior to recording the assignment the plaintiff was not the proprietor of the copyright received from Keel—a copyright in the lyrics and melody line—it was the proprietor of the copyright in the work which it published—a copyright in the music as arranged for piano.

The legal significance of the addition of the piano arrangement stems largely from §7 of the Act, which provides that musical arrangements, abridgements,

“or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works . . . shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.”

The effect of the latter, qualifying portion of §7 is to preserve the copyright, if any, in the original work as a separate legal entity with its own life span. In the instant case, for example, the copyright in the lyrics and melody line of “A Thousand Miles Away” will, if not renewed, expire 28 years from May 9, 1956—the date on which they were copyrighted under §12. The copyright in the arrangement, on the other hand, will not expire until 28 years from December 27, 1956—the date when that copyright was secured by publication with a proper copyright notice.

Since the published version of “A Thousand Miles Away” is in part protected by two different copyrights, which could have two

different owners and do have two different expiration dates, it might appear that the copyright notice should give the date and proprietor of each. But such has not been the interpretation adopted by this and other courts. In part because of the statutory equation of a derivative work with a "new work," it has been held that the notice need give only the date and owner of the copyright in the derivative work, leaving the reader to his own devices in ferreting out this information as to the original. See *National Comics Pubs. v. Fawcett Pubs.*, 191 F.2d 594, 598 (2d Cir. 1951) (L. Hand, J.), approving the opinion of the district court on this point, 93 F. Supp. 349, 352-53 (S.D.N.Y. 1950) (date of copyright); *West Pub. Co. v. Edward Thompson Co.*, 176 Fed. 833, 837 (2d Cir. 1910) (date of copyright); *Wrench v. Universal Pictures Co.*, 104 F. Supp. 374, 378 (S.D.N.Y. 1952) (owner of copyright).

The plaintiff did base the claim which it filed in the Copyright Office on the addition of the arrangement: It indicated that a claim of copyright in part of the work had previously been registered—although by whom does not appear in its application—and that it was now claiming a copyright in "revised music." There is some ambiguity in the district court's consideration of this claim of copyright. The defendant apparently contended that the claim was made in bad faith since the arrangement was insufficiently original to constitute a new work . . . and that the plaintiff's suit should therefore be dismissed on the ground of unclean hands. Judge Cooper quite properly rejected this contention. And, though it is not quite so clear, we think that he did not merely hold that the claim of copyright was made in good faith but that he also sustained the claim.

Since the record amply supports Judge Cooper's conclusion, the plaintiff must be regarded as having a separate and valid copyright in the arrangement of "A Thousand Miles Away." As to this copyright, the plaintiff was the original proprietor; the only relevance of the assignment was that it amounted to consent from Keel to the plaintiff's use of the lyrics and melody line. Accordingly, §32 does not apply and the notice of copyright was proper.

232. *Uneeda Doll Co., Inc. v. P & M Doll Co., Inc.*, 145 U.S.P.Q. 326 (S.D.N.Y., Apr. 30, 1965) (Cashin, J.)

Action for infringement of copyright in a doll posed upon a red and white barber pole. Plaintiff moved for a preliminary injunction.

Held, motion denied.

The court held that only the abstract idea of "a doll on a pole in a display box" was copied, rather than the expression of the idea. The court said:

An abstract idea is not a proper subject for copyright protection. Only the tangible expression of that idea is copyrightable. . . . The idea of a doll on a pole in a display box may be appropriated by any manufacturer. What he may not appropriate is Uneeda's tangible expression of that idea—the "Baby Trix" display. It may be that "Rosie Posie" competes in the very market in which "Baby Trix" has been selling, and buyers may choose "Rosie Posie" in place of "Baby Trix", but that does not necessarily mean that there has been an infringement of protected rights. I hold that the access necessary to a finding of copying is present, but I also hold that any copying here was limited to the abstract idea of a doll on a pole in a display box and did not extend to Uneeda's tangible expression of that idea.

233. *Breffort v. The I Had a Ball Company*, 144 U.S.P.Q. 708 (S.D.N.Y., Mar. 8, 1965) (Wyatt, J.)

Motion for inspection and copying in action for copyright infringement. Plaintiffs, who alleged that the musical, "I Had a Ball", infringed the copyright in the French work "Impasse de la Fidelite", asked to inspect and copy "any and all scripts, work sheets, notes, drafts, translations, memoranda, screen play, scenario and other writings or documents . . . which deal with, treat or in any way pertain to the planning, translation, preparation, execution or recordation of the dramatico-musical composition entitled 'I Had a Ball' . . . or the dramatico-musical composition entitled 'Impasse de la Fidelite,' or any adaptation, translation or portion thereof."

Held, motion granted in part.

The court held that the discovery asked for was too broad, stating that the relevant papers were those used in the preparation of the allegedly infringing script, and granted the motion to that extent, excluding such items as "planning", "execution" and "recordation".

234. *International Biotical Corp. v. Associated Mills, Inc.*, 239 F. Supp. 511, 144 U.S.P.Q. 577 (N.D. Ill., Aug. 28, 1964) (Perry, J.)

Action for infringement of a design patent for a combined massager and infrared heat lamp and for infringement of copyright in three descriptive brochures. Defendant counterclaimed for declaratory judgment of patent and copyright invalidity and noninfringement.

Held, judgment for defendant. Plaintiff's complaint was dismissed and defendant was awarded declaratory judgment that it had not infringed plaintiff's patent and copyrights.

I. *The design patent.* Plaintiff had been granted a design patent on the appearance of its massaging device, which it claimed had been infringed by defendant's product, also a combined massager and infrared lamp. The court pointed out that certain similarities in functional features of the designs could be expected because both devices were intended to be used in the same way, and held that there was no infringement because defendant's massager was substantially different in appearance from plaintiff's, particularly with respect to its inventive and nonfunctional, and therefore patentable, features. The court held that plaintiff's design patent was valid, but stressed the limitations of the protection afforded. The court said:

The Court further finds that there is no prior design in evidence which includes all of the design features of Plaintiff's Design Patent No. 190,009. When Plaintiff's Design Patent No. 190,009 is properly limited to its specific combination of design features it is valid. However, if Plaintiff broadens the limited scope of its design by ignoring the shape of the circular head, the shape of the handle and the decorative lines and fluting, then the patent is invalid for lack of design invention over . . . prior device(s) . . .

II. *The copyrights.* Plaintiff had alleged that defendant had infringed the copyrights in its three descriptive brochures by using three photographs showing the massager in use in which the poses were the same as those shown in plaintiff's brochures, by using a list of ailments for which the device was alleged to be helpful, and by using a photograph of a switch on which the designations "Hi" and "Lo" appeared. The court held that there had been no copying and that the portions allegedly copied were minor and insubstantial. The court said:

The Court finds that there has been no copyright infringement for the reason that the alleged copying, at best, represents only isolated portions, and not any substantial portion of Plaintiff's copyrighted material, which must be considered as a whole.

Plaintiff does not claim that any of Defendant's photographs are reproductions of any photograph included in Plaintiff's copyrighted material. The evidence clearly shows that each of Defendant's photographs were independently made by Defendant who utilized a different subject and its own Pollenex unit. Plaintiff's copyrights cannot monopolize the various poses used in these photo-

graphs since its copyrights can protect only Plaintiff's particular photographic expression of these poses and not the underlying ideas therefor. Further, the use of the head, leg and back poses for a combined infrared heat and massage device was old long prior to its use by either party hereto. . . .

The Court further finds no copyright infringement in Defendant's use on its carton of a catalog of various ailments and the words "Hi" and "Lo" in connection with its switch. The use of a catalog of ailments is a common expedient in the advertisement of health and medical aids. . . . In addition, the use of the words "Hi" and "Lo" in connection with switch positions also is an old expedient.

III. "*Unclean Hands.*" The court also held that both the design patent and the copyrights were unenforceable against this defendant because of plaintiff's "unclean hands and inequitable conduct in connection therewith," with respect to plaintiff's failure to disclose prior publications of portions of its material in applications for copyright registration for the catalogs, and with respect to misstatements of fact in the catalogs themselves. The court said:

The Court finds that as to this defendant in connection with defendant's manufacture, sale and marketing of its device, the plaintiff's design patent and copyright registrations are unenforceable due to plaintiff's unclean hands and inequitable conduct in connection therewith.

A substantial portion of plaintiff's copyrighted material incorporates text and photographs that were previously published and copyrighted by Plaintiff in 1954 and 1955 in connection with its earlier Infra-Massage device . . . Plaintiff did not inform the Copyright Office of its earlier publications in its applications to register the copyrights here in suit. That part of the copyright application, Item 7, which requires a listing of the "New Matter In This Version" of the material sought to be copyrighted was left blank by Plaintiff in each of the copyright certificates in suit.

The Court further finds that Plaintiff's copyrighted brochure entitled "When Muscular, Rheumatic or Arthritic-Like Pains Strike" . . . is inaccurate, misleading and deceptive. This describes a combined infrared heat and massage unit of the type covered by the design patent in suit and states "Nearly 250,000 in Use—Let Us Send You One to Try!" and further contains numerous testimonial letters as to the efficacy of this unit. At the trial, Plaintiff admitted that neither the above-quoted statement nor the testimonials correctly refer to the unit shown in the brochure, but rather they

refer to an earlier unit of a different design sold by Plaintiff several years prior to the copyright date.

235. *Neal v. Thomas Organ Co.*, 145 U.S.P.Q. 315 (S.D. Calif., Apr. 16, 1965) (Taylor, J.) For prior decision, see 325 F.2d 978, 140 U.S.P.Q. 103, 11 BULL. CR. SOC. 197, Item No. 88 (9th Cir., 1963).

Proceeding on issue of damages in action for copyright infringement. The Ninth Circuit held that defendant's instruction manual for playing the organ, which was published in a combination package with phonograph records with which the manual was designed to be used, infringed plaintiffs' copyright in a similar manual previously prepared for defendant by plaintiffs.

Held, judgment for plaintiffs for damages of \$24,511.80, attorneys' fees of \$8,000 and an accounting for defendant's manufacturing and sales subsequent to the time of trial.

I. Defendant argued that plaintiffs should be awarded only that portion of its profits which were allocable to the manual itself without the phonograph records. The court held, however, that the combination package had value only as a whole, and that no such allocation was possible. The court awarded damages in the amount of defendant's profits on the entire package, allowing, however, a deduction for indirect costs of doing business. The court said:

Defendant urges that the award of damages to plaintiffs should be reduced by apportioning profits to the copyrighted material. While it is true that the copyright protection does not extend to the phonograph records, which comprise a part of the course, this court found . . . that the records had no purpose when separated from the instruction manual and that only the course as a whole had any substantial value. This uncontroverted finding was also approved by the Appellate Court. Defendant's profits must be attributed to the sale of the course as a whole and the profits can not be apportioned since none were, and could not have been, derived from the sale of the records alone. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390 (1940). . . .

Defendant contends, and there is evidence to support this contention, that its indirect costs of doing business amounted to 14.7 per cent. Plaintiffs argue that the evidence of indirect costs should not be considered because it was not shown that said per cent applied to the cost of selling and distributing the infringed (sic) courses. After reviewing the evidence, and particularly the testimony of Mr. Silliman, the court believes it is fair and reasonable to find

that said per cent for indirect costs should be deducted from the gross receipts. It is common knowledge that any business has indirect costs and this per cent should apply in the selling and handling of the courses by defendant the same as it would apply in the handling of any other items.

II. The Ninth Circuit had held that the trial court's original decision on the issue of unfair competition was erroneous because the court had applied California law instead of the substantive federal law of unfair competition. In now applying federal law to the use of plaintiff's performances of public domain music on defendant's records, the court held that since palming off and secondary meaning were absent, there was no unfair competition. The court said:

This court originally recognized that defendant's conduct in regard to its appropriation of plaintiff Duffy's organ performance on a part of the records, might be actionable under state law. The court's independent research has failed to reveal any federal law on this point. The only case referred to by plaintiffs is *International News Service v. Associated Press*, 248 U.S. 215 (1918), but that case has been limited to its own particular set of facts. See *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348 (9th Cir., 1964). Plaintiffs here desire to claim unfair competition for the reason that defendant deleted Duffy's name from its records. Since the Court of Appeals recognized this deletion by its remarks . . . to the effect that the deletion revealed an intent on the part of defendant not to engage in the recognized areas of unfair competition under federal law, i.e., "palming off" and "secondary meaning", this court is of the opinion that the deletion of Duffy's name from the records did not constitute unfair competition. This court has not found any federal law and none has been cited by plaintiffs to the effect that the appropriation of Duffy's performance on part of defendant's records constitutes unfair competition and since it is clear from the record that no case of "palming off" or "secondary meaning" exists, this court finds and holds that plaintiffs have failed to establish their claim of unfair competition.

2. State Court Decisions

236. *Fitzgerald v. Hopkins*, 144 U.S.P.Q. 771 (Wash. Super. Ct., Jan. 12, 1965) (Henry, J.)

Action for copyright infringement; counterclaim for slander. Plaintiff, "one of the outstanding professional sculptors of the Northwest,"

charged that his copyrighted sculpture, "Rock Totem," which had been exhibited at the Seattle World's Fair, was copied by defendant, a graduate student of sculpture at the University of Washington. Defendant alleged in his counterclaim that plaintiff's accusation of copying was defamatory.

Held, judgment for defendant.

I. *Copyright infringement*. The court held that the similarities between the two works, in the absence of other evidence of copying, were not sufficient to show that defendant's "Transcending" was copied from "Rock Totem," particularly in view of the fact that both sculptors had undoubtedly been exposed to Cubism and other schools and trends in modern art which might have similarly influenced their work. The court said:

The use of the vertical form in sculpture, which is one of the issues here, is ancient, possibly dating as far back as 20,000 years ago as asserted by Mr. Fitzgerald. . . . We of the Northwest are familiar with the art and sculpture of the Northwest Indians, the most remarkable and distinctive of which is the totem pole. . . .

This is, true, not the type of sculpture we are involved with here but the testimony does reveal that coincident with this development of modern sculpture there has developed a school of art. . . . which, it is claimed was originated by . . . Picasso . . . when he, together with his friend Braque, sought to illustrate Cezanne's theory that everything in nature can be reduced to the cube, the cone, and the cylinder. . . .

As a result of the development of this school of abstract painting, apparently the sculptor also experimented with geometric forms. . . .

So it is in the context of this history of the development of abstract art that we approach the issues of this case, bearing in mind the work of the mature sculptor Fitzgerald and the work of the graduate student Hopkins must have been influenced by this development in painting and sculpture.

One of the questions before the Court is whether or not the defendant Hopkins copied the work of the plaintiff Fitzgerald.

In determining this question it is necessary to consider whether there was frankly an attempt to copy consciously or whether there was an unconscious copying. . . . *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1. . . .

The question is whether or not this was an innocent reproduction or was it a copy. I believe it was Professor Steinbrueck who

pointed out that to copy there must be a conscious intent to copy. In this context the question then is: Was there a conscious attempt to copy? and the burden is on the plaintiff to prove this.

I believe we can take judicial notice that the World's Fair ended in October, 1962. The defendant Hopkins received his commission [to do "Transcending" for a bank] in November, 1962, about a month after the end of the World's Fair. This point is important because at the time the World's Fair ended and the time of the display of "Rock Totem" ceased, the defendant was not aware of the commission he was to receive in November.

So if there was a copying of "Rock Totem" at the World's Fair it must have been done for some purpose other than this commission, unless it might be said that the defendant at the time he received the commission used a photograph of "Rock Totem" that appeared in some publication. . . .

No witness for the plaintiff has come forward and testified that he saw the defendant in a position where he was copying "Rock Totem." Necessarily the testimony must come from expert witnesses who testify with respect to their opinions after having observed the two pieces of sculpture. . . .

The question is whether or not of these two sculptures, "Transcending" is a copy of "Rock Totem", bearing in mind that the evidence is not sufficient unless there is no possibility of coincidence and that there is evidence of an intention to copy.

Consider the graduate student in sculpture . . . in the context of the modern trend in art and the use of the cubic or geometric form in sculpture . . . [I]s it not reasonable to assume that a sculpture student . . . would experiment with geometric forms in his art? . . .

There is a similarity, no question about it.

But is the similarity between "Transcending" and "Rock Totem" obtained because of the conscious desire of the defendant to copy or is it obtained as a result of years and centuries of traditions in art and sculpture by which both Mr. Fitzgerald and Mr. Hopkins have been influenced as a result of their training and their studies and their experience.

The Court must be careful not to disturb or to impinge or to influence or to inhibit in any way in a free society the right of an artist to express himself as the spirit moves him.

The Court can only be used to prevent the conscious use of another's product of art for his own use.

It is the opinion of the Court that the plaintiff has failed to sustain the burden of proving that there was any copying done by the defendant in this case.

II. *Slander.* The court held that plaintiff had slandered defendant by accusing him of copying "Rock Totem" and that plaintiff's eminence as a sculptor added to the damages sustained by defendant. The court said:

The Court is impressed with the stature of the plaintiff Fitzgerald in the community as one of the distinguished artists and one of the outstanding sculptors of this period in the Northwest and understands the emotion he has when he believes someone is copying and making use of his art.

On the other hand, defendant Hopkins is a young man who has had the drive and desire and energy and skill to obtain not only a bachelor's degree at the University of Washington but also his master's degree and we cannot look upon this with contempt. . . .

We find then that when defendant Hopkins gets his master's degree in fine arts and sculpture at the University of Washington he is confronted with a future where he is condemned in the art community by the foremost sculptor in the Northwest as being a plagiarist. The architects know it, the art community knows it, the entire community knows it, everybody knows it. To a young graduate student could there be greater damage than this? The Court thinks not.

It is one thing for a layman to say "Transcending" is a copy. It is another thing for the Northwest's foremost sculptor to go to the party who commissioned the sculpture and say, "This is a copy."

The Court finds the defendant has been damaged and should be entitled to recover his costs.

True, the monetary awards to the sculptor are not great. I suppose seldom in the lifetime of most artists is the monetary award great. But the acclaim, the admiration of the community, the right to express one's artistic self, is probably more important to an artist than the compensation one receives in a monetary way. And if one is prevented from doing this, it is difficult to appraise the damage in dollars and cents.

The Court is of the opinion that in the light of the testimony the defendant has been damaged in the sum of \$15,000.

237. *Herald Publishing Company v. Florida Antennavision, Inc.*, 145 U.S.P.Q. 437 (Fla. Dist. Ct. App., 1st Dist., Apr. 1, 1965) (Wigginton, J.)

Appeal from judgment for defendant in action for unfair competition. Defendant operates a community antenna system in Panama City, Florida. Plaintiff owns a television station in Panama City, and alleges that it has exclusive rights, partly by contract and partly by industry custom and usage, to first broadcast certain NBC network programs and syndicated programs in its broadcast area. Many of these programs are broadcast, simultaneously with or prior to plaintiff's broadcasts, over stations within 100 miles of Panama City which are either, like plaintiff's station, NBC affiliates, or which have purchased the same syndicated shows. Defendant's antenna system picks up the signals of these other stations and brings the shows, by cable, to subscribers in Panama City.

Held, affirmed.

Plaintiff argued that defendant was wrongfully depriving it of part of its listening and viewing audience by supplying to subscribers the same program material to which plaintiff had exclusive rights. It also charged that defendant was unfairly competing by operating without making any payments for the program material, whereas plaintiff obtained such material only at substantial cost. The court held, however, that absent any claim of copyright infringement, plaintiff had no protectible property right in the program material. The court said:

It appears to be appellant's basic position that even though it owns no copyrights of the programs it telecasts over its facilities, that under the circumstances alleged it nevertheless possesses a special property right in the subject matter of its telecasts which the law will protect against unfair competition and interference with favorable contractual relations between it and those from whom it purchases the right to broadcast its material. In support of this position appellant cites and relies upon the case of *International News Service v. Associated Press*, 248 U.S. 215. In this case Associated Press brought suit to enjoin International News Service from activities alleged to constitute unfair competition. The facts established that Associated Press, at great expense to itself, gathered and furnished to its subscribers news items which appeared in the Associated Press bulletin and in early editions of newspapers published by its subscribers. INS, a competing news gathering and distribution organization, copied the Associated Press dispatches and transmitted them by cable across the country for almost simultaneous release with the dispatches of Associated

Press, palming off the news dispatches as its own and for which it collected revenue from its subscribers. . . .

There are basic distinctions between the facts in the INS case and those alleged in the complaint sub judice. INS and AP were competitors in the same field of activity and furnished identical services to their respective subscribers. In our case appellant is a television broadcasting company deriving its revenues from sponsors who pay for advertising exhibited by appellant before, during and after its regularly scheduled telecasts. Appellee has no facilities for, nor is it engaged in the business of, telecasting programs or other material. It does not compete with appellant for sponsors interested in advertising over television facilities, but derives its revenues solely from services rendered its subscribers. In the INS case . . . it not only pirated the work product of AP which had been produced at great expense to the latter, but it palmed off such work product to its subscribers with the implied misrepresentation that it was the work product of INS. In the case sub judice appellee is not charged with any such reprehensible conduct as was condemned in the INS case, but merely passes on to its subscribers the television programs it receives on its antenna from the air waves which are in the public domain and available for anyone with a sufficiently equipped antenna to receive and enjoy. . . .

The only case factually in point in all material respects with the one now before us for consideration is that of *Cable Vision, Inc. v. KUTV, Inc.*, 211 F. Supp. 47, 135 USPQ 2. In this case television station KLIX of Twin Falls, Idaho, contracted with certain television broadcasting stations in Salt Lake City, by the terms of which it received by wire the programs telecast by the Salt Lake City stations and rebroadcast those programs in the Twin Falls area. KLIX facilities permitted simultaneous broadcast of only one station at a time. The programs from the other Salt Lake City television stations being released at the same time were either ignored by KLIX or were filmed and released at a later time in the Twin Falls area. The television programs emanating in Salt Lake City television stations could not be received in the Twin Falls area by the use of conventional rooftop television antennae. Cable Vision, Inc. of Twin Falls erected a community antenna and engaged in the same business as the appellee in the case sub judice. It received the television programs being telecast by the stations in Salt Lake City and transmitted them to its subscribers in Twin Falls simultaneously with the original broadcast. This activity deprived KLIX of a part of its viewing audience

as well as the advantageous opportunity of releasing at a later time television programs originating in the Salt Lake City television stations. KLIX sought and was awarded an injunction by the Federal District Court restraining Cable Vision's activities in the Twin Falls area on the ground of unfair competition and interference with favorable contractual relations. . . .

The decision of the District Court . . . was appealed to and reversed by the United States Circuit Court of Appeals for the Ninth Circuit, 335 F.2d 348, 142 USPQ 249. The decision of reversal is grounded upon the proposition that unless protected by the copyright laws of the United States, all programs and program material telecast by television stations lie in the public domain and may be received and enjoyed with impunity by the general public, so long as there is no attempt to appropriate good will of the broadcaster, or to deceive. The fact that one receives and utilizes the telecast for commercial purposes by receiving, amplifying and transmitting it to others for a compensation does not make such activity subject to the condemnation of unfair competition or interference with favorable contractual relations enjoyed by the television broadcasting company. In its decision of reversal the Circuit Court of Appeals said:

“. . . Save for the limited protection accorded the creator of literary and intellectual works under the Copyright Act or its exceptions—and here appellees concede they are not asserting a claim for copyright infringement—anyone may freely and with impunity avail himself of such works to any extent he may desire and for any purpose whatever subject only to the qualification that he does not steal good will, or perhaps more accurately stated, deceive others in thinking the creations represent his own work.

“Here the District Court enjoined activity that lacked the element of palming off. . . . To the extent, then, that the District Court holding extended a new protectible interest beyond what the copyright laws confer, it . . . interfere[d] with the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain, *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237. This same principle likewise applies to appellees' claim of contract interference. Parties by the mere expedient of an exclusive contract can not 'bootstrap' into existence rights from subject matter which at their source lie in the public domain. . . .”

... While it is readily conceded that decisions of federal courts are not binding on state courts as regards questions of law which are exclusively within state court jurisdiction, it is our view that the force of the logic and reason expressed in the *Cable Vision* decision is inescapable. We therefore adopt the reasoning and conclusions reached by the Ninth Circuit Court of Appeals in the *Cable Vision* case as applicable to the case sub judice, and on the basis of such application we affirm the decree appealed.

238. *Tobias v. Joy Music, Inc.*, 153 N.Y.L.J. 78, Apr. 23, 1965, p. 15 (App. Term, 1st Dept.) (memorandum opinion), reversing Civil Court, New York County, July 23, 1964 (Baer, J.). See also *Tobias v. Joy Music, Inc.*, 204 F. Supp. 556, 133 U.S.P.Q. 181, 9 BULL. CR. SOC. 398, Item No. 264 (S.D.N.Y. 1962).

Appeal from judgment for plaintiff in action for composers' royalties withheld by the publisher of "Miss You." The composers had sued the publisher (also defendant here) in the Southern District of New York for a declaratory judgment that they and their new assignee, and not the defendant, owned the renewal copyright in the song. The court found for defendant and awarded it counsel fees of \$1,500. Relying on a provision in the original contract by which the composers conveyed the song to defendant's predecessor in interest, defendant withheld from plaintiffs' royalties on "Miss You" the balance of its \$4,763.47 in legal fees and costs incurred in the federal action. The plaintiffs sued in Civil Court, New York County, for the royalties so withheld, and the court held that the contract provision in question, which authorized the publisher, inter alia, to employ attorneys and institute and defend any action or proceeding to protect the interest of the publisher in "Miss You", all at composers' sole expense, did not apply to expenses incurred in controversies between the composers and their own publisher. The Civil Court did not make any finding on the argument there introduced by plaintiffs that the amount of the counsel fees which could be charged against them was res judicata by reason of the \$1,500 award in the District Court.

Held, reversed.

It was held that the award of counsel fees in the District Court was not relevant to, and was not res judicata with respect to, the amount of legal fees which defendant was entitled to withhold pursuant to contract. The memorandum opinion of the court is here reprinted in full:

Judgment and order unanimously reversed with \$10 costs, and motion denied. The award by the United States District Court for the Southern District of New York, in the prior action, of reasonable attorney's fees to defendant, apparently pursuant to section 116 of the Copyright Law (Title 17, U.S.C.) is not res judicata as to the extent of plaintiffs' liability. That award was based upon a statute providing for the award of "a reasonable attorney's fee", not, as in the instant case, upon a contract between the parties which provided for payment of "all of the expenses so incurred". (*J. & K. Cohen Furniture Co., Inc. v. Consol. Edison of N. Y.*, 160 Misc. 941). The prior award was based upon an exercise of judicial discretion under the Copyright Law, and was not concerned with the agreement which forms the basis of this action.

Also of Interest:

239. *United States v. American Society of Composers, Authors & Publishers, Application of Metromedia, Inc.*, not yet reported (2d Cir., Mar. 8, 1965) (Smith, J.)

On an appeal from denial of a motion by Metromedia, Inc. to punish ASCAP for contempt under the ASCAP consent decree as amended because of ASCAP's refusal to grant Metromedia, Inc. a type of license which the latter had requested, the Second Circuit affirmed the denial of the motion, holding that Metromedia, Inc., which was not a party to the antitrust suit which led to the consent decree, had no standing to bring the contempt action. The court also held that under the consent decree ASCAP is not required to accept new licensing formulas proposed by licensees.

240. *Scott v. WKJG, Inc.*, 145 U.S.P.Q. 32 (N.D. Ind., Mar. 4, 1965) (Eschbach, J.)

Motion by codefendant National Broadcasting Company, Inc. to quash service of summons upon it in Indiana in action for copyright infringement.

Held, motion denied.

The court held that NBC is doing business in Indiana because it has affiliates in that state with whom it has contracts and to whom it regularly supplies programs, thus performing the contracts in Indiana.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

241. HOGAN, JOHN C., and SAUL COHEN. An author's guide to scholarly publishing. Englewood Cliffs, N. J., Prentice-Hall [1965]. 167 p.

A handbook, designed for authors of scholarly works, which discusses both legal and non-legal questions on copyright, patent, and related matters. Appendices include the texts of the U.S. Copyright Law and the Regulations of the Copyright Office, a sample copyright registration form, a specimen book-publication contract, a contract for a magazine article, and a brief bibliography.

242. KLOOSTER, JOHN W. The granting of inventive rights. Minneapolis, Intel-Lex Inc. [1965]. 152 p.

"One purpose of this book is to provide a brief, comparative, objective, and fair study of the separate American systems for granting patents, trademarks, and copyrights so that twentieth century Americans can understand and better judge whether these systems are meeting contemporary U. S. needs."

2. Foreign Publications

243. HIRSCH BALLIN, ERNST D. Zum Rom-Abkommen vom 26. Oktober 1961, zugleich ein Beitrag zur Urheberrechtsreform. Berlin, F. Vahlen [1964]. 28 p. (Internationale Gesellschaft für Urheberrecht. Schriftenreihe, Bd. 35.)

A critical analysis of the Rome Convention on Neighboring Rights of 1961, offered as a contribution to West German copyright law reform.

244. TROLLER, ALOIS. Die mehrseitigen völkerrechtlichen Verträge im internationalen gewerblichen Rechtsschutz und Urheberrecht.

Basel, Verlag für Recht und Gesellschaft, 1965. 226 p. (Studien zum Immaterialgüterrecht, v. 6.)

This study, which in essence is a revision and an enlargement of Professor Troller's earlier work published in 1952 under the title *Das internationale Privat- und Zivilprozessrecht im gewerblichen Rechtsschutz und Urheberrecht*, attempts "to tell which international treaties [in the field of industrial property and copyright law] are in existence and which countries adhere to them, presenting the contents and organizational forms of the treaties in a systematic arrangement."

B. LAW REVIEW ARTICLES

1. United States

245. BISHOP, ARTHUR N., JR. Fair use of copyrighted books. (2 *Houston Law Review* 206-221, no. 2, Fall 1964.)

"Mr. Bishop explores the interesting doctrine of fair use of copyrighted books. It is the dividing-line between reasonable utilization of the copyrighted literary works of another and outright plagiarism. The article deals only with books, and consideration is not given to musical compositions, drawings, and other copyrightable products. Common-law copyright is more properly includable in another discourse. The basic doctrine is that fair use is a question of fact, to be determined on the merits of the individual case."

246. COLINO, RICHARD R. Copyright protection abroad for United States cultural exports. (4 *PEAL, Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 465-498, no. 4, Mar. 1965.)

A reprint of an article which originally appeared in 1962 *Duke Law Journal* 219-248, no. 2 (Spring 1962). See 10 *BULL. CR. SOC.* 67, Item 51 (1962).

247. Copyright; damages: construction of Section 101 (b) of the Copyright Act. (12 *UCLA Law Review* 620-628, no. 2, Jan. 1965.)

A case note on *Peter Pan Fabrics, Inc. v. Jobela Fabrics, Inc.*, 329 F.2d 194, 11 *BULL. CR. SOC.* 337, Item 212 (2d Cir. 1964).

248. Copyrights—loudspeaker broadcasts of records by merchandise mart considered public performance for profit. (25 *Maryland Law Review* 78-79, no. 1, Winter 1965.)

A brief note on *Chappell & Co. v. Middletown Farmers Market & Auction Co.*, 334 F.2d 303, 11 BULL. CR. SOC. 421, Item 287 (3d Cir. 1964).

249. FURGASON, DAVID W. Does Stiffel stifle the law of unfair competition? (37 *University of Colorado Law Review* 86-94, no. 1, Fall 1964.)

A note on the *Sears* case.

250. HAYES, JAMES H. Fair use: a controversial topic in the latest revision of our copyright law. (34 *University of Cincinnati Law Review* 73-90, no. 1, Winter 1965.)

This study, which received first prize in the Nathan Burkan Memorial Competition at the University of Cincinnati in 1964, concludes with a proposal that "the legislature maintain the present statutory silence on the question [of fair use] and continue to leave the problem to the courts on a case by case basis."

251. KAPLAN, BENJAMIN. [A review of] Nimmer on copyright, by Melville B. Nimmer. (78 *Harvard Law Review* 1094-1098, no. 5, Mar. 1965.)

An analytical and critical evaluation.

252. LEEDS, DAPHNE ROBERT. The impact of *Sears and Compco*. (55 *The Trademark Reporter* 188-194, no. 3, Mar. 1965.)

The author agrees with the conclusions but not the reasoning of the opinions. To insure that the opinions are not construed too broadly, she attempts to make a case for the enactment, as a federal law, of the draft Uniform Deceptive Trade Practices Act, with suggested modifications.

253. NATTER, SETH. Patent law—copyright law—preemption by federal statutes of state product-simulation restrictions. (31 *Brooklyn Law Review* 186-191, no. 1, Dec. 1964.)

A note on the *Sears* case.

254. Patents and trademarks—registrability—principal register—a bottle configuration may simultaneously be the subject of a design patent and a trademark registration; use of the subject matter of a design patent during the life of the patent may properly be considered as trademark use. (53 *Georgetown Law Journal* 520-524, no. 2, Winter 1965.)

A critical note on the *Mogen David* decision, 51 C.C.P.A. (Patents) 1260, 328 F.2d 925 (1964).

255. RUBENSTEIN, JEROME S. [Reviews of] Financing a theatrical production; a symposium of the Committee on the Law of the Theatre of the Federal Bar Association of New York, New Jersey and Connecticut, ed. by Joseph Taubman [and] This business of music, by Sidney Shemel and M. William Krasilovsky. (33 *Fordham Law Review* 536-538, no. 3, Mar. 1965.)

A critical evaluation.

256. STUBBS, S. A. Unfair competition: abrogation of the doctrine of functionality. (17 *University of Florida Law Review* 492-495, no. 3, Winter 1964.)

A note on the *Compco* case.

257. Trademarks—the Lanham Act—existing design patent does not preclude trademark protection on shape of wine bottle. (78 *Harvard Law Review* 1269-1273, no. 6, Apr. 1965.)

A critical note on the decision in *In re Mogen David Wine Corp.*, 51 C.C.P.A. (Patents) 1260, 328 F.2d 925 (1964).

258. Unfair competition—extent to which state law of unfair competition may prohibit imitation of commercial product designs. (17 *Vanderbilt Law Review* 1561-1564, no. 4, Oct. 1964.)

A note on the *Sears* and *Compco* decisions.

259. VANATTA, DEAN R. Indivisibility of copyright: an obsolete doctrine. (37 *University of Colorado Law Review* 95-104, no. 1, Fall 1964.)

This comment, which was entered in the Nathan Burkan Memorial Competition at the University of Colorado Law School, purposes "to explore the development of the indivisibility theory

and the problems it raises, and to propose a solution for these problems.”

260. WARREN, JOHN H. Copyrights: publication: architectural plans and drawings. (50 *Cornell Law Quarterly* 293-302, no. 2, Winter 1965.)

A case note on *Edgar H. Wood Associates, Inc. v. Skene*, 197 N.E.2d 886, 11 BULL. CR. SOC. 439, Item 298 (Mass. 1964).

2. Foreign

1. English

261. Committee of African Experts to Study a Draft Model Copyright Law (Geneva, November 30-December 4, 1964.) General report, presented by Issa Ben Yacine Diallo (Guinea), rapporteur. (1 *Copyright* 31-39, no. 2, Feb. 1965.)

The general report adopted by the Committee, together with the annexed list of participants, and the texts of a draft African model copyright law and a resolution.

262. GERBRANDY, S. Letter from the Netherlands. (1 *Copyright* 41-46, no. 2, Feb. 1965.)

A survey of legislative and judicial developments in the Netherlands in the field of copyright and related subjects.

263. MENTHA, BENIGNE. The right of reproduction and the exclusive rights in the Berne Convention. (*EBU Review* 53-56, no. 90B, Mar. 1965.)

A discussion of the relative merits of expressly recognizing, in the forthcoming revision of the Berne Copyright Convention, an exclusive right of reproduction. Special reference is made to a draft prepared by a joint study of Swedish experts and BIRPI officials, in which a proposal was made to give to Article 9 of the Convention (Brussels revision) a broader text that would no longer refer to newspaper and magazine articles “but would confine itself to stating, in an opening paragraph, the principle of an exclusive right of reproduction and in a second paragraph empowering contracting countries to place exactly defined limitations on the principle for specific purposes.”

264. NAMUROIS, ALBERT. The prevention of the activities of "pirate" broadcasting stations: a European Agreement (Strasbourg, December 1964). (*EBU Review* 36-46, no. 90B, Mar. 1965.)

A study of legal problems involved in preventing the operations of the so-called "pirate" broadcasting stations which are set up outside the sovereign jurisdiction of any given country, with a survey of legal means available for conducting an effective campaign against such stations. Includes a summary and analysis of a proposed "European Agreement for the prevention of the activities of pirate stations" drawn up under the auspices of the Council of Europe.

265. RADOJKOVIC, ZIVAN. Copyright: a general structural survey. (*Copyright* 57-64, no. 3, Mar. 1965.)

A philosophical discussion covering the following topics: (1) The characteristics of copyright; (2) The juridical nature of copyright; and (3) The place of copyright in the legal system.

267. REMES, KAREL. Prevention of broadcasts transmitted from artificial islands: Dutch legislation on installations on the high seas. (*EBU Review* 47-52, no. 90B, Mar. 1965.)

A discussion of the problem of preventive measures against television broadcasting transmitted from ships outside territorial waters, with "a review of the events concerned, a broad outline of the legal aspect of the problem, and an account of the legislation enacted by the Dutch Government in the matter."

268. Union of National Radio and Television Organizations of Africa (URTNA). Session of administrative and legal studies. (*EBU Review* 57-58, no. 90B, Mar. 1965.)

The text of the resolutions and recommendations adopted by the Union, after examining the problems posed by copyright in all African countries, at a session of administrative and legal studies held in Tunis from December 16 to 20, 1964. The subjects covered by the resolutions include international conventions regulating copyright, protection of African "folklore," the draft model copyright law, and national copyright societies.

2. German

269. DEUTSCH, VOLKER. Zulässigkeit heimlicher Fotos: was haben Fotografen und Kameramänner zu beachten? (9 *Film und Recht* 51-54, no. 3, Mar. 1965.)

An examination of the legal aspects of photographing nude persons on public beaches in the Federal Republic of Germany, with special reference to the question whether or not such persons have legal means to prevent publication of the pictures not only when pictures were taken clandestinely but also when pictures were taken with their knowledge. The problem is examined in the light of Article 5 of the Constitution, Section 22 of the Law on Copyright in the Works of Art (KUG), the Penal and the Civil Codes, as well as the current jurisprudence.

270. MESSERER, WALTER. Geschmacksmusterschutz in Argentinien. (*Gewerblicher Rechtsschutz und Urheberrecht*, Auslands- und Internationaler Teil 12-13, no. 1, Jan. 1965.)

A brief summary of the Argentinian law on the protection of ornamental designs, no. 6673, of August 9, 1963.

271. Rechtsvergleichung als ein Weg zur Zusammenarbeit auf den Gebieten des kulturellen Schaffens. Ergebnisse eines Münchener Vortrags von Dr. Karel Knap, Prag. (9 *Film und Recht* 35-37, no. 2, Feb. 1965.)

A summary of a lecture delivered by Dr. Karel Knap, a Czechoslovak copyright jurist, before a meeting of copyright lawyers in Munich, at which the speaker observed, *inter alia*, that while the Soviet Union apparently had dropped any intention of joining the Universal Copyright Convention, the other countries of the Eastern bloc consider themselves bound by their adherence to the international copyright conventions, especially the Berne Convention (Rome and Brussels revisions).

272. ROEBER, GEORG. Das Verfilmungsrecht in der Urheberrechtsreform: ein Mahnruf in letzter Stunde. (9 *Film und Recht* 46-51, no. 3, Mar. 1965.)

A criticism of section 15 of the present West German official draft copyright law in that it fails to specify the right of an author to make a motion picture of his work (Verfilmungsrecht) as a separate, exclusive right, with a recommendation to incorporate

the language of section 12 of the earlier draft of the Federal Ministry of Justice which expressly recognizes such a right.

273. *Stand der Arbeiten zur Urheberrechtsreform.* (9 *Film und Recht* 31-35, no. 2, Feb. 1965.)

A summary of a lecture delivered by Dr. Gerhard Reischl, Chairman of the Subcommittee on Copyright of the Bundestag, before a Seminar of the University of Frankfurt on January 22, 1965, in which the speaker expressed the belief that the new West German copyright law would be passed during 1965.

3. Hungarian

274. BOYTHA, GYORGY. Magyar művek szerzői jogi védelme az Amerikai Egyesült Államokban. (20 *Jogtudományi Közöny* 85-94, no. 3, Mar. 1965.)

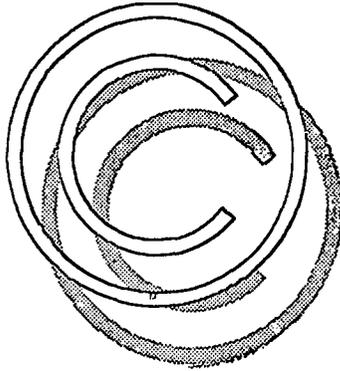
A brief, comparative study of the present United States Copyright Law and the 1964 general revision bill, with special reference to the requirements for obtaining protection of Hungarian works in the United States.

NEWS BRIEFS

275. *The First Decade of the Universal Copyright Convention, 1955-1965.*

A special exhibit entitled "The First Decade of the Universal Copyright Convention, 1955-1965" is being held in the Copyright Office in the Library of Congress from May 20 to November 30, 1965. The exhibit features official documents, photographs, and other material relating to the development and scope of the Universal Copyright Convention and will be open from 9 A.M. to 5 P.M., Monday through Friday (except holidays). Further information may be obtained upon request from the Copyright Office, Library of Congress, Washington, D. C. 20540.

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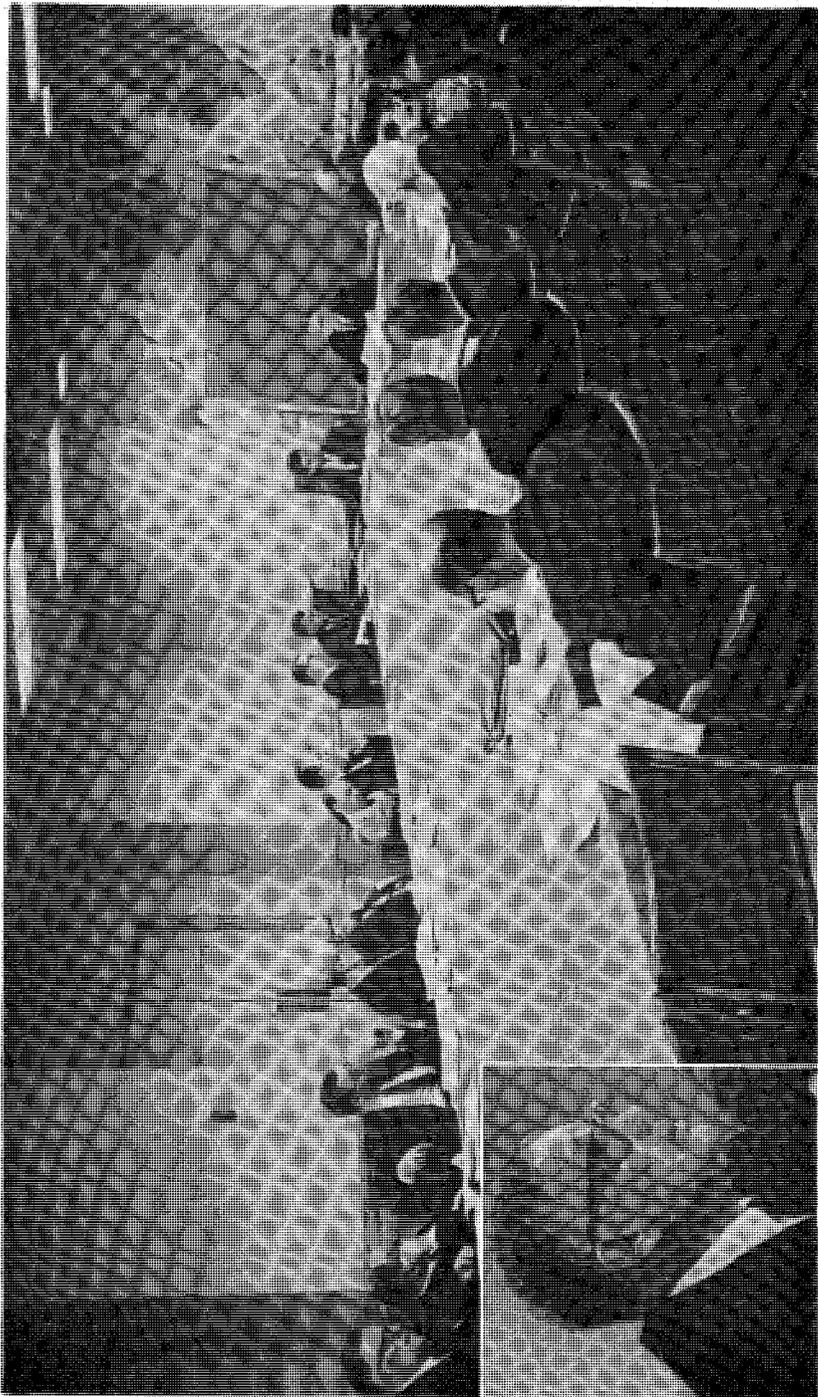
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12TH ANNUAL MEETING, OFFICERS AND BOARD OF TRUSTEES, THE COPYRIGHT SOCIETY OF THE U.S.A., at New York University Law Center, May 19, 1965.

Edward A. Sargoy, president, presiding (*inset*) and (*clockwise*) Leon Kellman, Edward M. Cramer, treasurer, Morton D. Goldberg, Lawrence H. Reed, Fred B. Rothman, publisher, Franklin Waldheim, Daniel Hutterbrauck, Bernard Korman, Charles B. Seton, vice president, Alan Latman, secretary, Mr. Sargoy, Walter J. Dereberg, executive director, Sidney A. Diamond, vice president, Harold Oren-

PART I.

ARTICLES

276. DESIGN PROTECTION: *Walking the Pirate Plank?***

By JACQUES M. DULIN**

Part I

Almost exactly fifty years from the date the first design protection bill based on copyright principles was introduced into Congress,¹ last minute opposition was filed to the recent design protection bill S. 776.² Beyond introductory background, this paper does not attempt to review either the need for design protection or the long history of attempts to gain it. This has been done with exceptional adequacy by others.³ This

* © 1965 by Jacques M. Dulin. This paper is a revised and updated version of a paper which was submitted in the Nathan Burkan Memorial Competition as first prize winner from The George Washington University Law School, 1964, and is printed by permission of the American Society of Composers, Authors and Publishers. The paper received Special Mention in the National Nathan Burkan Competition.

** Mr. Dulin is Law Clerk to The Hon. I. Jack Martin, Associate Judge, U. S. Court of Customs and Patent Appeals.

1. H.R. 11321, 63d Congress, 2d Session (1914), by Mr. Oldfield, introduced January 12, 1914.
2. S. 776, 88th Congress, 1st Session (1963), Mr. Hart and Mr. Talmadge. Opposition filed January 14, 1964.
3. (a) Gotshal, *Today's Fight for Design Protection*, New York. Aaron Fuchs & Co. (1957); reproduced in Hearings on S. 1884 before the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, 87th Congress, 1st Session (1961), (hereinafter referred to as Hearings on S. 1884) at 171-202.
- (b) Weikart, *Design Piracy*, 19 Ind. L.J. 235 (1944).
- (c) Young, *Freebooters in Fashions: The Need for Copyright in Textile and Garment Designs*, ASCAP Copyright Law Symposium, Number Nine 76, 100 (1958).
- (d) Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 BULL. CR. SOC. 25 (1959).
- (e) Derenberg, *Copyright No-Man's Land: Fringe Rights in Literary and Artistic Property*, I, II, and III, 35 J. Pat. Off. Soc'y. 627, 690, 770 (1953).
- (f) National Committee for Effective Design Legislation, *Protection for Designs*. New York (1959).

(Continued)

is a review of the present objections, an attempt to answer the underlying economic arguments, and a look to the future in the event the bill does not pass.

I. INTRODUCTION

A. *The Piracy*

Design protection is about this situation:

A manufacturer who has undertaken the expense of commissioning a designer and producing and marketing a new style, and whose revenue from successful designs must cover his losses from unsuccessful ones, may find that a competitor has copied his prized modes and saturated the market before he, the originator, can dispose of his stock.⁴

Few if any industries in which design is a merchandising factor are immune from piracy. Where competing product characteristics are essentially equal, the value of a design with consumer appeal is indisputable. In textile printing, design "knock-offs" can be sold at lower prices by the pirate, who thereby captures the market, because:

. . . he had no design cost. He doesn't have to pay for stylists, for designers; he doesn't have to invest in a tremendous number of yards of gray goods. Because he knows the design he is copying is a good item and because it is a good item, he can buy his goods, copy the design and sell it.⁵

They spend no time in the development or promotion of their fabric or design because the success of the pattern and the acceptability of the pattern have already been established by the originator of the pattern.

* * * * *

The designs themselves are not expensive. . . . The major expense that we [the originators] undergo is in the promotion of this design, the stocking of the inventory. . . .⁶

(g) Latman, *The New Design Protection Proposals Before Congress*, 8 BULL. CR. SOC. 356 (1961).

4. Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 Harv. L. Rev. 1520 (1959). The copying competitor is said to have "knocked-off" the originator's design.

5. Hearings on S. 1884 at 93-94.

6. *Id.* at 88.

B. Prevention—Theories of Protection

Legal theories under which protection might be possible are common law rights based on either personal property or the business tort of unfair competition, and statutory rights under patents or copyrights. Clearly, personal property rights must be rejected since the right does not extend beyond the original property itself. Unfair competition has been a slowly developing doctrine that clashes with the philosophy reflected by our antitrust laws that society receives its greatest benefits in an atmosphere of free competition. Generally, relief has been available only after an act of piracy, and only on a showing of palming-off or secondary meaning. Until recent cases⁷ this area of the law indicated promising growth for protection against piracy.

The natural tendency has been to turn to statutory remedies since only in that way can the existence of protection before-the-fact of piracy be assured. In the garment trade the major market value lies in the design of the apparel. Existence of a right, carrying with it a rapidly obtainable injunction on a prima facie showing of infringement, is essential, since apparel designs are often seasonal or at best short lived. Such *type* of right is conferred through a patent grant or copyright. Both have experienced some expansion in the types of works coverable under them.

The first American patent statutes did not include designs,⁸ but protection for designs was included within the patent statutes in 1842.⁹ Design patents have proven notoriously ineffective as a means of protection for two reasons. First, the examination procedure in the Patent Office usually takes longer than the critically short design lifetime. Second, courts require the presence of "invention" as in the case of a utility patent.¹⁰ Applying the utility patent test of invention,¹¹ or more properly, non-obviousness, subjects design patents "to tests foreign, in a practical sense, to the nature of appearance."¹² As a result, it is estimated that only one in three design patents prove valid in litigation.¹³

7. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). Both are discussed *infra*.

8. 1 Stat. 318 (April 10, 1790).

9. 5 Stat. 543 (1842).

10. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893); Hearings on S. 1884, testimony of Judge Giles S. Rich at 34.

11. Derenberg, *supra* note 3(e), at 705 states: "It was probably only the result of an historical accident that invention standards were ever applied to such works [design patents]."

12. Pogue, *Borderland, Where Copyright and Design Patent Meet*, ASCAP, Copyright Law Symposium, Number Six 3, 36 (1955).

13. Ringer, *supra* note 3 (d) at 26; Derenberg, *supra* note 3 (e) at 694.

Thus design patents are an insufficient means of protection against design piracy. A manufacturer may not safely predicate capital outlay for product development on the basis of a design patent. Judge Learned Hand summarized the situation in this way:

The plaintiff, a corporation, is a manufacturer of silks, which puts out each season many new patterns, designed to attract purchasers by their novelty and beauty. Most of these fail in that purpose, so that not much more than a fifth catch the public fancy. Moreover, they have only a short life, for the most part no more than a single season of eight or nine months. It is in practice impossible, and it would be very onerous if it were not, to secure design patents upon all of these; it would also be impossible to know in advance which would sell well, and patent only those. Besides, it is probable that for the most part they have no such originality as would support a design patent.¹⁴

Due principally to legislative and administrative expansion of works covered, design protection based on statutory copyright has become more successful than that provided by design patents.¹⁵ Before 1909, copyrightable works consisted of "designs *intended* to be perfected as works of the *fine arts*."¹⁶ A 1909 legislative change eliminated both the "intent" requirement¹⁷ and "fine arts" distinction, leaving the statute to read as it does today: "works of art; models or designs for works of art."¹⁸ However, the distinction that the registrable work must be of the "fine arts" continued as a matter of practice in the Rules and Regulations of the Copyright Office. By a 1926 rule change,¹⁹ the fact that the work was "useful" lost some force as an invalidating factor.²⁰

14. *Cheney Bros. v. Doris Silk Corp.*, 35 F. 2d 279 (2d Cir. 1929), *cert. denied* 281 U.S. 728 (1930).

15. See Gotshal, *supra* note 3(a); Pogue, *supra* note 12 at 14; Young, *supra* note 3(c) at 81-83.

16. 16 Stat. 86 (1870). (Emphasis added.)

17. Today the Regulations of the Copyright Office state "the registrability of a work of art is not affected by the intention of the author as to the use of the work . . .". 37 C.F.R. § 202.10(b) (1959).

18. 17 U.S.C. § 5(g) (1952)

19. Regulation 12(g) (1926) provided: "The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture." (Emphasis added.)

20. Young, *supra* note 3(c) at 82.

The spirit of the 1909 Act gained full effect with the 1948 amendment to the Regulations, which states:

§ 202.10 Works of art (Class G).

(a) *General.* This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.²¹

In *Mazer v. Stein*,²² the Supreme Court implemented the expansion of copyright protection by holding that where a statuette had been copyrighted under 17 U.S.C. § 5 (g) as a "work of art," its copyright protection was not lost or diminished because it was intended to be used, and was used, as a lamp base. Although subsequent decisions have upheld copyright in jewelry, chinaware and textiles, copyright protection is of unsure validity and limited in the scope of articles covered.²³ For these reasons, adequate design protection has continued to be sought.

C. *A Brief History and the Current Status of the Design Protection Bill.*

In the fifty years since 1914, 55 design protection bills have been introduced into Congress.²⁴ The history of the fruitless results has been recounted by others,²⁵ and an extensive bibliography on all aspects of design protection has been compiled by experts in the field.²⁶ Relatively recent work of a drafting committee²⁷ has culminated in a design bill,

21. 37 C.F.R. § 202.10(a) (1959). (Emphasis added.)

22. *Mazer v. Stein*, 347 U.S. 201, 100 U.S.P.Q. 325 (1954).

23. Hearings on S. 1884 at pp. 167-168, 209.

24. Bills through 1959 are listed and briefly described in Ringer, *Bibliography on Design Protection* 27-49 (1955) (Copyright Office, Library of Congress); *Bibliography on Design Protection, Supplement 1959*, 44-71 (Strauss and Ringer ed. 1959) (Copyright Office, Library of Congress).

Bills following S. 2075, 86th Congress, 1st Session (1959), Mr. O'Mahoney, have been: S. 2852, 86th Congress, 1st Session (1959); S. 1884, 87th Congress, 1st Session (1961), Mr. Talmadge, Mr. Wiley, and Mr. Hart; S. 776, *supra* note 2, H.R. 323, Mr. Flynt, H.R. 769, Mr. Ford, H.R. 5523, Mr. Libonati, 88th Congress, 1st Session (1963). The three bills in the 89th Congress, 1st Sess. (H.R. 450 Ford, H.R. 3366 Flynt, and S. 1237 Talmadge and Hart), identical to S. 776, bring the total to 58.

25. See authorities cited note 3, *supra*.

26. Ringer, and Strauss and Ringer, *supra* note 24.

27. National Committee for Effective Design Legislation, organized May 1, 1958, discussed in 5 BULL. CR. SOC. 326-27 (1958); Hearings on S. 1884, testimony of Judge Giles S. Rich at 33. NCEDL, *supra* note 3(f).

S. 776, which carries none of the fatal defects in the form of interest group exceptions contained in earlier legislation.²⁸

S. 776 passed the Senate on Dec. 6, 1963. The purpose of that bill was "to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying."²⁹ Subsequent to Senate passage, one day of hearings was held on House versions of that bill.³⁰ As with S. 1884, the immediate predecessor of S. 776, opposition was not presented at either the Senate or House hearing.³¹ However, the passage of the House versions of S. 776 was successfully forestalled by interest groups in the ready-to-wear garment trade, represented primarily by the National Retail Merchants Association. The record of the House hearings was held open until Jan. 14, 1964 for the NRMA to file a statement in opposition. Extensive coverage in trade papers stimulated additional pressure from NRMA members. On August 12, 1964, the bill was reported from House Subcommittee No. 3 with an exception for the garment industry.³² Due to subsequent adjournment of Congress, the bill died in the House Judiciary Committee.* In the following discussion, only those provisions of S. 776 to which opposition has been filed are analyzed, since other provisions have been covered in the parent bill, S. 1884.³³

28. Ringer, *supra* note 3(d) at 26. See Mayer, 7 BULL. CR. SOC. 32 (1960); Waldheim, 8 BULL. CR. SOC. 359 (1961). This statement refers only to S. 776, as introduced.

29. S. 776, 88th Congress, 1st Session, (1963), Preamble. See Appendix A for pertinent provisions.

30. Held Dec. 12, 1963 on H.R. 323, H.R. 769, H.R. 5523, *supra* note 24.

31. Hearings on S. 1884 at 216, concluded with these remarks by Sen. Hart:

"May I inquire at this time whether there are any present who oppose the legislation and who want to express opposition? I am asking if there are any who oppose? I hear none."

In truth, there was an opposer, an independent auto parts manufacturer, who wanted to copy and sell replacement hubcaps.

32. The exception was added to § 2 of H.R. 5523 (identical to § 2 of S. 776, see Appendix A) as a new Subsection (e) which reads: "Sec. 2. Protection under this act shall not be available for a design that is— . . . (e) Composed of three-dimensional features of shape and surface with respect to men's, women's, and children's undergarments and outerwear."

* Subsequent to the preparation of this paper, bills identical to S. 776 (without the interest group exception) have been introduced into the 89th Congress, 1st Sess.: H.R. 450 (Ford), H.R. 3366 (Flynt), and S. 1237 (Talmadge and Hart). The discussion herein pertains equally to those bills as to S. 776.

33. Hearings on S. 1884, testimony of Mumford at 9-11, Giles at 12-13, Arnall at 21-25, Kaminstein, Federico, and Cary at 138-169, Gotshal at 206.

II. THE OPPOSERS OF S. 776

The three³⁴ opposers of the current design protection bills are the National Retail Merchants Association, R. H. Macy & Co., Inc.,³⁵ and the Apparel Industries of New England.³⁶ As revealed by press reports,³⁷ the reasons for the position of Macy's and the New England apparel makers coincide with those given by NRMA. Although NRMA represents other than just apparel makers, its objections are confined to the garment industry. No substantial difference between the positions of the three opposers is seen, and therefore the statement submitted by the NRMA³⁸ is taken as representative of their positions.

III. THE OBJECTIONS

From a reading of the appended NRMA statement, it will be noted that all the objections are tied to a charge of monopoly; the bill would result in monopoly of ideas, monopoly of style, and strangling suits. Prices would be higher, distribution curtailed, and competition stifled. Those charges are so closely intertwined that a discussion of any one necessarily will touch on aspects of the others.

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34. Actually four. The fourth is the Department of Justice. It is opposed in general to exceptions to the antitrust laws, and is of the opinion that the bill would add a third category (to patents and copyrights) of "monopoly" of doubtful constitutionality "which would serve only unduly to burden commerce without concomitant benefits to the public." Hearings on S. 1884 at 11. The objection of monopoly is discussed herein; experts in the field indicate that the patent and copyright clause of the Constitution, article I, § 8 would support design copyright, Hearings on S. 1884 at 26-29, 86. See: Lutz, *Can Ornamental Designs for Useful Articles be Protected by Copyright? Constitutional Bases of the Willis Bill*, 2 Pat., T.M. & Cr. J. of Research & Ed. 289 (1958), also appearing in Hearings on S. 1884 at 140-49. Basing protection on the commerce clause has been rejected as creating so many problems as to be unworkable. Hearings on S. 1884 at 26-29, 86. But see *contra*, Dienner, *Protection of Industrial Designs*, 45 J. Pat. Off. Soc'y. 673 (1963). The possible impact of the *Sears and Compco* cases, *supra* note 7, on the constitutionality of S. 776 is touched on *infra*.
35. *Woman's Wear Daily*, Dec. 20, 1963, Focus, p. 1.
36. *Id.*, Feb. 3, 1964, p. 2.
37. *Ibid.* notes 35 and 36; WWD Jan. 3, 1964, pp. 1 and 111; WWD Jan. 6, 1964, p. 2; WWD Jan. 17, 1964, p. 11; WWD Jan. 29, 1964, p. 2. See also *New York Times* Jan. 4, 1964, p. 27; *NYT* March 23, 1964, p. C35; *New York Herald Tribune* March 11, 1964, p. 40; *Daily News Rec.* Jan. 14, 1964, p. 1.
38. The statement by Mr. Wm. Burston, Manager, Merchandising Division, NRMA is appended since not generally available. It was submitted to Sub-Committee #3, House Committee on the Judiciary, Jan. 14, 1964.

A. *"Monopoly in Ideas"—Confusion Between Patents and Copyrights.*

A fundamental misconception, that the bill will create monopoly in "ideas," is the major theme of the NRMA statement.³⁹ Typical objections embodying that misconception are:

- (7) But some ideas are not sufficiently original to assure a patent. Some may not qualify for a copyright. To protect these kinds of ideas S. 776 is proposed.
- (20) S. 776 . . . would give one person the right to clear all competitors from the market place. It would make monopoly legal
- (22) . . . Owning *menas* [sic: means] having the right to stop everybody else in his industry from bringing out the same idea.
- (45) . . . under this bill "ownership" of an idea would freeze out all competition, hence prices to the customer would be higher

The misconception, that the bill will create a monopoly in "ideas," is a result of a misunderstanding of the nature of monopoly, and of the differences between copyrights and patents.

A distinction must be drawn between an odious monopoly and a justifiable monopoly.⁴⁰ A monopoly in the early sense of the common law was created, usually by royal grant, by *withdrawing from the public rights which it had previously enjoyed*, and, as a matter of special grace, these rights were granted to some favored individual.

Such a monopoly was, of course, obnoxious and in a broad sense is analogous to the kind of monopoly against which our anti-trust laws are directed. It is a monopoly which lessens competition and takes from the public that which it previously freely enjoyed.⁴¹

In contrast to that "odious" monopoly, a copyright or patent grant does not deprive the public of anything which it enjoyed before the writing or discovery, "*but gives something of value to the community by adding to the sum of human knowledge.*"⁴² Because of the value gained by the public, the "monopoly" grant of patent or copyright, since limited in

39. NRMA statement, paragraphs 7-9, 19-22, 26, 28, 29, 45. See Appendix B.

40. I Smith, *Patent Law—Cases Comments and Materials* §§ 32, 33-40 (1954).

41. Barnett, *Patent Property and the Anti-Monopoly Laws* 55 (1943). The objection of the Justice Dept. (*supra*, note 34) seems to overlook this distinction. The very object of the constitutional provision (article I, § 8) is monopoly, but hardly in the odious sense.

42. *U.S. v. Dubilier Condenser Corp.*, 289 U.S. 178 at 186, 17 USPQ 154 at 157 (1933). (Emphasis added.)

time, is justifiable. In the case of patents, the grant is a reward and stimulus to further invention. Similarly, the copyright is termed “. . . a legal recognition of an equitable natural right belonging to the creator of an original work to prevent others from benefiting unjustly from his creative act.”⁴³ Thus, accurately speaking, if patents and copyrights are to be termed “monopolies,” they must be distinguished from the “odious” monopolies of common law.

A further distinction, which involves a second meaning of the term monopoly, must be made between patents and copyrights. They are fundamentally different in the scope of protection they provide. *A patent does give protection for an “idea”* in that the invention may be embodied in any one of a number of physical forms, equivalent in *function* to the examples disclosed. A *mechanical* or *utility* patent could provide protection for the idea of, for example, a roller skate: the combination of a small sole-plate, with a set of wheels mounted on it, and including some means to attach the plate to the foot of the user. Within the scope of this “idea,” or combination of mechanical elements, the patentee is protected against the making, using or selling of any copies by others.⁴⁴ The patentee has a “monopoly.” After the patent is granted, someone else may not make, use or sell the patented article unless licensed by the patentee. This is the case even if he *independently* invented the patented roller skate. The patentee also maintains protection over obvious variations. Whether the sole-plate conforms to the shape of the foot, whether the wheels are inset below the plate, or are set out, are larger, and extend above the plate, is immaterial to the function of the skate. Such variations, if they fall within the scope of the claims drawn to the combination which we may call the “idea,” would constitute infringements thereof. Even further, the patentee’s absolute right allows him to deprive the public of the entire use of the invention if he so desires, by refusing to make, use, or sell it himself or permit its use by others.

In contrast to the “monopoly” scope of a patent is the scope of

43. Jackson, *Unfair Competition by Product Simulation v. Copyright Protection for Designs*, 45 J. Pat. Off. Soc’y. (No. 5, 1963) 422, 425.

44. It is important to note that the patent grant confers the right to *exclude* others from making, using, or selling the patented subject matter. A patent is *not* a guarantee of the right to make, use, or sell the invention. If you obtain a patent it does not mean you may practice it, since, for example, your patent may be an improvement on a basic invention patented by another. While you may prevent the other from practicing your improvement, you may be prevented from practicing the improvement yourself since in so doing the basic patent may be infringed. Such a situation calls for cross-licensing to unblock the patents.

protection available under a copyright. Its sanction is only against the act of copying; anyone else may produce an identical work so long as it is original. The difference was clearly pointed out in *Mazer v. Stein*:

Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.⁴⁵

Only in this second sense, that of the scope of the protection, is a patent a “monopoly,” but justifiably one since something is given to the public which it did not have before, while a copyright, certainly justly giving the author protection against unauthorized copying, in no sense can be termed a “monopoly.”^{45a}

Designs in being non-functional expressions⁴⁶ are copyright in nature, and for this reason copyright-type protection is the purpose of S. 776. Since only a patent-type grant is a “monopoly” grant on the “idea,” the proposed “design-right,” in the nature of a design “copyright,”⁴⁷ will not be a monopoly in an “idea” as claimed by NRMA. The bill protects specific designs, not design “ideas” or styles.⁴⁸ To paraphrase the *Mazer v. Stein* quote supra: *Unlike a design patent, a design-right gives no exclusive right to the style idea disclosed; protection is given only to the expression of the style, not the style itself.*

45. *Supra* note 22, 347 U.S. at 217.

45a. Contrast Jackson, *supra* note 43 at 425, who says: “No monopoly is involved for the sanction is only against the act of copying . . .”, with the dissent of Justice Douglas in *Mazer v. Stein*, 347 U.S. at 219: “But may statuettes be granted the monopoly of the copyright?” Clearly Jackson’s statement refers to “monopoly” in the second sense while Justice Douglas is referring to the justifiable monopoly termed the copyright, which is granted on writings.

46. Hearings on S. 1884 at 80. See also *In re Mogen David Wine Corp.*, 328 F. 2d 925, 140 USPQ 575 (CCPA 1964) at 580, Rich concurring at 581, *passim*, rejecting functionality in ornamentation.

47. The term “design-right” is suggested, to distinguish between copyright as to subject matter, and between a design patent as to scope of protection.

48. This point can be illustrated by reference to the tiger theme in advertisements. Humble Oil’s (Esso) is perhaps most easily called to mind, “Put a tiger in *your* tank.” Concurrently that theme is used by U.S. Royal in ads for tires, Revlon for hair dressing, Faberge for lipstick, nail polish and perfume, and Rootes Motors for a sports car. *Burning Bright*, Time, Sept. 25, 1964, p. 88. Assuming ads were proper subjects for protection under S. 776, the tiger *theme*, the *idea* of a tiger as a symbol, would not be protectible, but each *embodiment*, the *particular* tiger as expressed, would be.

B. *The Fear of Suits—Will Third Party Retailers Be Liable?*

NRMA objects that S. 776 "would bury the courts under the burden of countless suits."⁴⁹ In the absence of S. 776, further exploratory attempts by litigant victims to extend copyright and unfair competition law will equally "bury" the courts. In the eyes of Congress, whether to pass laws goes off on broader principles than the shopworn horrible of a burden on the courts.

A more serious objection is that third party retailers would be liable under the act: "Our retailers would be involved, for there is not a category of merchandise in our stores which is not open to possible suit. . . ." ⁵⁰ But the bill has been expressly worded so that retailers are not liable except for repeated copying or inducement to copy after notice.

NRMA states:

- (30) Small manufacturers depend in substantial part on store buyers for designer ideas. Buyers scour the consumer magazines and trade press for ideas. They want exclusives in order to profitably compete. They describe their ideas to the small manufacturer. He makes up the garments.
- (31) Under S. 776 the store may be sued if a so-called "owner" of the registration believes his design has been copied. The store is involved because the proponents of the bill have inserted the "inducement" clause. The store "induced" the violation, hence is culpable.

Those paragraphs pose the following question: Will the non-manufacturing retail store be sued under the inducement clause of S. 776?

An answer is difficult because the fact situation presented does not definitely indicate collusion or inducement by the seller or distributor such as would result in infringement. The several sections of Section 8 are intended to reach only the deliberate infringer.⁵¹ An innocent

49. NRMA statement, paragraph 20.

50. *Ibid.* See also paragraph 9, ". . . we believe that S. 776 will release a plague of lawsuits on business, which will involve retailers. . . ."

51. S. 776, "Infringement", Sec. 8, provides in part:

(a) It shall be infringement of a design protected under this Act for any person, without the consent of the proprietor of the design, within the United States or its territories or possessions and during the term of such protection, to—

(1) make, have made, or import, for sale or for use in trade, any infringing article as defined in subsection (d) hereof: . . .

(d) An "infringing article" as used herein is any article, the design of

distributor, *i.e.*, one without knowledge of the infringement, is not subject to liability as an involuntary infringer under Section 8 (a) (2) (i) unless he induced or acted in collusion with the manufacturer of an infringing article:

Sec. 8: (a) It shall be infringement of a design protected under this Act for any person, without the consent of the proprietor of the design,⁵² . . . to—

(2) sell or distribute for sale or for use in trade any . . . infringing article: *Provided, however*, that a seller or distributor . . . shall be deemed to be an infringer only if

(i) he induced or acted in collusion with a manufacturer to make . . . such article (merely purchasing or giving an order to purchase in the ordinary course of business shall not of itself constitute such inducement or collusion);

The exception in parentheses will cover the ordinary business situation. Only a seller who reorders an article after notice that design of the article is protected *and* who refuses to divulge his source, is an infringer under Section 8 (a) (2) (ii).⁵³ Thus, original innocence will not protect a continuing act.⁵⁴ The transfer of the infringing articles by the maker, after notice to the transferee-retailer, will not erect a

which has been copied from the protected design, without the consent of the proprietor: *Provided, however*, That an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium shall not be deemed to be an infringing article. An article is not an infringing article if it embodies, in common with the protected design, only elements described in subsections (a) through (d) of section 2.

52. A further clause states "within the United States", thus not solving the problem of Canadian knock-offs. See testimony of Dwight H. Owen, Cranston Print Works, Hearings on S. 1884 at p. 95. He proposes that after the U.S. problem is settled, a basis can be found for reciprocity.
53. S. 776, Sec. 8. (a)

(2) . . . a seller or distributor of any such article who did not make or import the same shall be deemed to be an infringer only if—

(ii) he refuses or fails upon the request of the proprietor of the design to make a prompt and full disclosure of his source of such article, and he orders or reorders such article after having received notice by registered or certified mail of the protection subsisting in the design.

54. See also Sec. 8 (c) exempting from infringement the incorporation as part of his own product or the product made for another, an infringing article acquired in the ordinary course of business. Continued incorporation after notice would again be infringement.

defense in favor of the retailer. The purpose of this section is to uncover the source, so that the proprietor of a "design-right" registration may proceed against the actual act of copying.⁵⁵

It is not clear, however, what burden of affirmative inquiry will be placed on a manufacturer, such as a commission printer, to determine from the ordering fabric "converter"⁵⁶ whether the design supplied him was copied from a protected design. On its face the bill appears to impose no affirmative duty of inquiry. This problem is felt minor, however, since contractual provisions to the effect that the converter warrants the designs to be non-infringing within the meaning of Section 8 (d),⁵⁷ while not giving absolute freedom from liability if evidence of knowledge is adduced, will solve most of the problems.

C. "Monopoly" and Registration—

Will the Scope of Protection Lead to Monopoly of Style?

NRMA states:

- (8) Under this bill the mere declaration⁵⁸ that an idea is original would apparently secure its protection. "Original" is defined as being not a copy of another's idea,⁵⁹ also that the idea is not found in the public domain. Registrants would thereby be able to sue alleged violators. *If successful* not only could they collect damages but *they could prevent all other creators of similar ideas*⁶⁰ from bringing them to the market and thereby enjoy the fruit of their work. [Emphasis added.]

55. Annual meeting, American Patent Law Association, Design Legislation Committee, Oct. 15, 1964, Washington, D.C., Albert C. Johnston, retiring Chairman, in reply to a question about the bill.

56. A fabric "converter" is not to be confused with one guilty of common law conversion. A converter is the owner of yardgoods who has them printed to order by a commission printer and then manufactures apparel to his or a retailer's pattern.

57. Sec. 8(d), *supra* note 51.

58. Regarding "mere declaration", note that: 1) the application for design protection must be under oath, Sec. 9(c), and 2) there is liability for knowingly bringing an infringement suit on a fraudulently obtained registration (Sec. 24), for false marking (Sec. 25), and for false representation in obtaining registration (Sec. 26). See NRMA statement, paragraph 28.

59. Compare Sec. 1(b) (4), Appendix A.

60. The term "idea" is used loosely in the NRMA statement, and in several places appears to mean "design" rather than the "patentable" kind of "idea". See the discussion *supra* regarding the second meaning of monopoly referring to an "idea" as distinct from the *expression* of an "idea".

The objection, that litigants, *if* successful, "could prevent all other creators of similar ideas from bringing them to the market," is a facet of the monopoly argument which raises the question: will the scope of protection afforded a registered design preclude registration of designs in the same style family, thus leading to a style monopoly?

The test of scope is found in Sections 2 and 3 of the bill.⁶¹ As a preliminary to consideration of comparative similarity between a registered design and one for which registration is sought, the latter design would be denied registration under the provisions of Sections 2 (a) and (d) if it was not original or was functional. Likewise a staple or commonplace design, which is defined in § 2 (b) by example, "such as a standard geometric figure, familiar symbol, emblem, or motif, or other shape, pattern or configuration which has become common, prevalent, or ordinary," per se would not be registrable. Section 2 (c) also would prevent registration of a design differing from staple or commonplace design only in insignificant details or common trade variants. The purpose of Sections 2(a)-(d) is to prevent protection of designs and design elements which are presently in the public domain, or which are merely insignificant or colorable variations thereof. The effect of those provisions will be directly contrary to that of a monopoly, particularly one of the "odious" sort discussed above in topic III A.

However, if the design sought to be registered is a substantial revision, adaptation, or rearrangement of a protected design, then registration would be granted and valid since coming within Section 3 of the bill. Regarding that "substantial revision" test as relating to the registrability of a second-comer's design, the NRMA statement refers to *Trifari v. Charel*:⁶²

- (27) This bill is aimed at the "knock-off-artist." Let's assume a "knock-off" is made. The "knock-off" is identical in most respects to the original it copied. But the copy has a better quality of fabric.⁶³ It has more costly trimming. It is cut fuller. It is [sic: Is it] a copy if it adds that "degree of individuality" which the late U. S. District Court Judge Alexander Bicks, in deciding the case of *Trifari v. Charel*, considered the measuring stick for newness?

* * * * *

61. Sec. 2 and Sec. 3, Appendix A.

62. *Trifari, Krussman, & Fishel Inc. v. Charel Co.*, 134 F. Supp. 551 (1955).

63. *Contra*, Hearings on S. 1884, 88, 95, 106, *passim*.

- (29) Styles, "periods," recur. Assume the Empire style returns. It is in the public domain. No one may register it for his own. But several add "some degree of individuality" to the design. Presumably this makes it registrable. Should the first one to get his certificate be able to stop all the others who may impart notable "degree of individuality"?⁶⁴

The objection answers itself. If one design satisfies the "substantial revision" test, then others having the notable "degree of individuality" equally will satisfy the standard and be registrable. While NRMA recognizes that what is in the public domain must be free to all, they desire similar designs differing only by degree to be registrable. Clearly from the words of Section 3, the bill does not foreclose registration of designs differing only by degree from registered designs. No inconsistency between the *Trifari* test and that of the bill is seen.

If, by "They (buyers) want exclusives in order to profitably compete,"⁶⁵ NRMA means buyers want designs owned by others and they ordered such, then a clear case of infringement would result so long as the designs of the exclusives were registered under the bill. If, however, by "Buyers scour the consumer magazines and trade press for ideas. . . . They describe their ideas to the small manufacturer. He makes up the garments,"⁶⁶ NRMA means the design arising from the buyer's ideas is an adaptation or modification of a protected design, then there may or may not be an infringement. If the modified design differs only by insignificant details, or by variants which are commonly used in the trade, or are in the public domain, then the modified design would not be a "substantial revision" under Section 3, and would infringe under Section 8 (d).⁶⁷ On the other hand, the modified design may be sufficiently different to be non-infringing, and assuming it satisfies the tests of Section 2, would be registrable and protected under the bill. It should be noted that Section 8 (d) also provides that an article is *not infringing if all it has in common* with the protected design are features in the public domain.⁶⁸ Correspondingly, the inclusion of features in the public domain, among others, in a design would *not* prevent its registration.

Necessary elements of any infringement under the act would be that

64. Referring to the *Trifari* Case, *supra* note 62.

65. NRMA statement, paragraph 30.

66. *Ibid.* See also, *The 'Rag' Business*, *Forbes*, July 1, 1964, 24-29.

67. Sec. 8(d), *supra* note 51.

68. Hearings on S. 1884, testimony of Cary at 158, in accord discussing §§ 2 and 3.

copying was done from a protected design, and that the copier knew the design was protected. Thus Section 8(b) provides:

It shall *not be infringement*, to make, have made, import, sell, or distribute, any article embodying a design created *without knowledge of, and copying from, a protected design*. [Emphasis added.]

All the defenses associated with faulty notice will be available to any defendant, at least until notified that the design had been registered.⁶⁹ Further, "copying from a protected design" must be proven.⁷⁰ Where direct proof is not available, a showing of *access and close similarity of the infringing and copied designs* would likely be the test, *as borrowed from copyright law*.

A further problem in connection with style is suggested by paragraph 23 of the statement:

(23) The "couture" manufacturers favor this bill. On what basis could they register their designs as against one another when trends in fashion are much the same for all, and all lines tend pretty much to look alike?

Clearly the cut of a dress would be subject to registration under Section 1(b)(2) since that section defines design as including "two-dimensional or three-dimensional features of *shape* and surface." [Emphasis added.] Since styles recur in cycles, the question becomes: will not the new derived *design* be denied registration under Sections 2(a)-(c) and 3?⁷¹ Will not the new design be insufficiently different from, or not a substantial revision of,⁷² a configuration which has become common, prevalent, or ordinary⁷³ as *embodied* in an earlier or protected *design*?

As discussed above in connection with monopoly, neither copyright, nor design protection under this bill, gives an exclusive right to an *idea*. *Protection would be given only to the expression of the style, not the style itself*. Thus the question posed just above would be answered by how stringently the courts were to apply requirements of Section 2.⁷⁴ Since the purpose of the act is to afford protection for de-

69. See Sec. 7, S. 776, Appendix A.

70. Accord, Johnston, *supra* note 55.

71. §§ 2(a)-(c) and 3, Appendix A.

72. The test of Sec. 2(c) and Sec. 3.

73. The standard of Sec. 2(b).

74. Sec. 2, Appendix A. Of course, prior to court determinations, some administrative determinations under Sec. 2 may be made in applications for registration under Sec. 12(a) and (b), or cancellation proceedings under Sec. 12(c).

signs, and that particularly in the apparel field denial of protection to derivative variations would defeat that purpose, the courts would probably retain a fairly narrow construction of "insignificant details" and common trade variants of Section 2(c), and a liberal construction of "substantial revision[s]" of Section 3. The appeal to the eye of the ordinary observer,⁷⁵ as measured in part by the economic success of the variant, will remain the test most likely to give a valid scope to the terms "insignificant details" and "substantial revision." What is a common variant in the trade is of course a matter of fact for the trial court to consider.

Thus no monopoly of style could occur within the scope of the bill if the courts apply the tests of Sections 2(a)-(d) and 3 in a manner consistent with their presently applied tests.⁷⁶ The comment of Gotshal is additional authority on the point:

For design protection is not at all an attempt to curb the development of styles or to control the market in fashion. Many, many original designs can be created within a style trend; yet each of them ought to be recognized as being the property of its creator.⁷⁷

D. "Monopoly" and Economics

The economic effect of design protection is of concern to all interested parties. As indicated in the introduction, it is documented in the Hearings on S. 1884, the predecessor bill to S. 776, that pirates save themselves significant development costs by appropriating the design creations of originators. For very apparent reasons NRMA does not justify opposition to the bill on the basis that design protection would cost pirates money, a direct economic effect, but on the ground that the economic benefits to the consuming public stemming from piracy far outweigh the economic loss to the originator or the unjustness of the enrichment of the pirate. The economic argument presents several inter-related facets discussed below.

75. The test in *Peter Pan Fabrics, Inc. v. Acadia Co., Inc.*, 173 F. Supp. 292, 121 USPQ 81 (1959); *aff'd sub nom. Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F. 2d 487, 124 USPQ 154 (1960). See *Condotti, Inc. v. Slifka*, 223 F. Supp. 412, 139 USPQ 373 (1963).

76. One could not "brainstorm" an entire design field at the drawing board since § 4 requires there be an "existing useful article embodying the design" which is made public. Accord, *Johnston*, *supra* note 55.

77. Gotshal, Hearings on S. 1884 at 199; see also Hearings on S. 1884 at 119, testimony of Mr. Frost.

1. *Control of Style Obsolescence*

The problem of style obsolescence may be stated in these words:

While . . . manufacturers and their designers might . . . welcome some form of statutory protection such protection might, by compelling greater diversity of design, retard the process of stylistic obsolescence upon which the market for continually changing styles depends.⁷⁸

Any greater diversity between style lines which would occur would stem from the requirements of Section 2 of the bill. But it does not follow necessarily that obsolescence will be retarded by an increase in the diversity in available styles. Obsolescence would be retarded primarily from the fact that *protection* would be available. Protection would prevent the rapid loss of popularity which occurs when a market becomes saturated by a flood of copies. The retardation of obsolescence is secondarily and indirectly effected by the *length* of time the protection lasts. In the case of fashions, ten years' protection (two 5-year periods), as provided for by the bill, is clearly longer than their present lifetime. In other fields such as furnishings, jewelry, ceramics, glassware, and automotive design, the period does not appear inappropriate.

The dynamics of consumer preference is little understood and the operative forces vary in different fields.⁷⁹ But whether the consumer obtains the latest style out of desire to emulate his betters or whether it is to identify with a "new look," a certain amount of style change is due to the promotional nature of the industry. When items are substantially identical in function and quality, the market share is largely dependent on promotion. Further, a certain part of the market for apparel must be "created" by way of new styles and their concomitant promotion. Any greater diversity in styles or their design expressions would not change those factors. The more that investment is needed and put into promotion, the more protection is necessary.

At present, piracy operates to accelerate style obsolescence.⁸⁰ As a *caveat* it must be noted that the terms acceleration and deceleration are

78. Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 Harv. L. Rev. 1520 at 1533.

79. *Id.* at 1534.

80. Hearings on S. 1884, at pp. 88, 98, and 106. Gendler, at 98 states: "It has been proved that the obsolescence of apparel designs has been due to piracy and not to any swift change in consumer taste and preference."

relative and may have little meaning beyond describing what has happened. The bill will shift the equilibrium back to a more truly competitive balance on the merits of designs, quality, and price.

The important result is that whatever "deceleration" of style obsolescence might occur from the bill, this obsolescence can be *controlled*. There are probably three major ways in which this can be done: 1) by licensing of designs to other manufacturers,⁸¹ 2) by the design owner extending his operations to all quality and price lines, and 3) by limiting production of a particular design. Control does not mean that competition is removed. Quite to the contrary, in common situations of functional equality among competing products there will be true competition between the merits of the designs. *Design will be a new dimension of competition.*

The greatest effect of control is that prices in relation to cost rather than in relation to the risk of piracy will be the rule. At present, beyond normal risks of the design catching on, lies the risk that if it does, pirates are sure to follow. This is of major significance since prices of goods in industries of high risks, *e.g.*, the drug industry,⁸² bear little if any relation to on-stream production costs. Protection should operate to bring price more in line with cost and thereby benefit the consumer.

In sum, the benefits to be derived from the protection of designs appear to far outweigh any harmful retardation of obsolescence, should that result from the grant of protection. It would appear that significant differences between designs, leading to diversity in style lines, are really a benefit to the public for two reasons. First, because of the greater diversity among which consumers may exercise choice, and second, because there will be true competition in design leading to better designs and functional innovation.

D. "Monopoly" and Economics

2. Percolation Down vs. Competition in Design

The "percolation down" concept of design in fashion styles is the key to the economic argument. NRMA states it this way:

81. Compulsory licensing has not been suggested, and is outside the bounds of this paper. The following comment is of interest: "Needless to say, the constitutionality, the fairness and the effectiveness of the existing compulsory licensing schemes are much debated issues," Riesenfeld, *Compulsory Licenses and U.S. Industrial and Artistic Property Law*, 47 Calif. L. Rev. 51 at 63 (1959).

82. There the risks appear due to the natural phenomena that few chemicals are useful drugs, and are expensive to discover and develop.

- (36) How does fashion operate in this country? It starts at the top—at the highest level of price—and percolates down in one season or two. Because of this the American woman is the best dressed in the world. Because of this the American woman pays less for her apparel. And this method of operation has made the women's apparel business the multibillion business it is.⁸³

In its most lurid form NRMA pictures the ordinary American woman in sack-cloth and ashes since no designs would "filter down" to lower price line garments. A variant of the argument is that our standard of living would suffer. But there is no price tag on style; designs are made for every price line. "[O]rigination is not limited to higher priced goods exclusively. At present there are houses in all price classes that create their own designs."⁸⁴ At best "percolation-down" can only be taken as partly true of a given industry, and not true of all. Offsetting the loss of whatever "percolation" does occur will be the encouragement of competition in design⁸⁵ and "evolutionary progress in design."⁸⁶ Protection operates as an inducement to design,⁸⁷ and thus more designing⁸⁸ at a higher level of creativity will occur.⁸⁹

But even more important—*where a protected design becomes extremely successful, the pressure of competition will lead to fundamental functional innovation,*⁹⁰ or production efficiencies. How will the manufacturer compete with a Stein coffee pot, if his designer is no artist? A lower cost will offset the design advantage. In achieving the lower cost, innovations in manufacturing techniques, leading to new machines and processes, will be made. A more important result will be the development of products with new, improved, or additional functions. Both the innovations in techniques and functions are of clear benefit to the public.

83. For a report of 7th Avenue's concept of "percolation down" in the garment industry, see *The 'Rag' Business*, *supra* note 66.

84. Hearings on S. 1884; statement of Judge Leonard W. Gendler at 99.

85. *Id.*, Frost at 118-119.

86. *Id.*, Pile at 45.

87. *Id.*, Rich at 84.

88. *Id.*, Abelson at 104.

89. *Id.*, Waldheim at 62.

90. *Id.*, Blitzer at 108. That imitators are not innovators is recognized by Borden, *Advertising in our Economy* 223 (1945): "... the private branders cannot be credited with bringing product innovation and progress in merchandise. With relatively few exceptions they have been imitators and have entered with a price appeal when demand has been built."

D. "*Monopoly*" and Economics

3. *Possible Consumer Benefits—Retail Prices and Mass Distribution*

It is argued that a major result of the bill is that it will lead to higher prices:

- (43) Under S. 776 the "owner" would maintain his prices. His quality would not be improved. The item would not get the wide distribution which active competition accomplishes.
- (45) We have pointed out . . . that under this bill "ownership" of an idea would freeze out all competition, hence prices to the customer would be higher. . . .⁹¹

With design protection available the price of an item does not have to be pegged so high that costs plus profit must be recovered in the short time *before* the pirate moves in. The pirate has no design, development, or promotion costs. He rides on a sure winner. Even if his quality is as good as the original, his start-up costs are less and the item will inevitably sell for less. At present, time is the crucial factor for the originating manufacturer. He must predict how much time, and how many items he can expect to sell within that time, in order to determine the markup necessary to recover costs and reasonable profit. With the security of a presumably valid "design-right" in his pocket, the originating manufacturer would be able to price lower in the knowledge that development and production costs will be safely amortized over a longer period. There will be no gamble with time hoping the first sales will carry him past outlay to reasonable profits before the pirate moves in. The greatest value of the "design-right" lies in the protection afforded during the early critical period before costs are recovered. After this period the right would be used defensively. If pirates do move in somewhat later, it may still be sufficiently costly to prosecute a suit that settlement by licensing would be advantageous to both parties.

The idea that the bill will reduce competition, which in turn is responsible for the amount of distribution, is merely the converse of the monopoly argument. It ignores all competitive factors other than price, particularly that of design. Precisely because one of the present costs of doing business is piracy,⁹² the cost of original items is pushed out of reach of some buyers and the potential market is thereby smaller. Were

91. *Contra*, Hearings on S. 1884, testimony of Mr. Owen at 96.

92. Hearings on S. 1884 at 100.

the cost of piracy removed, prices *could* be lower and the items would have a larger potential in the mass market.

Further, the manufacturer's wholesale price is not usually the major percentage of the retail cost. What the NRMA statement overlooks is the fact that *retailers take losses when designs are pirated*. Retailers are left with merchandise of a cost to them equal to the retail price of the copy.⁹³ Even where the quality of the copy is considerably lower, the original merchandise does not move. If the item is a "style" item, it *must* move soon or be outdated. Such losses must be regained by overall higher prices on other merchandise. Piracy's effect sends many ripples throughout the fabric of our economic community. Considering the entire economic equilibrium, it is seriously questioned whether pirates benefit anyone but themselves.

PART II

IV. RECENT DEVELOPMENTS—THE EFFECT OF THE SEARS AND COMPCO CASES ON DESIGN PROTECTION

Of course, S. 776 did not become law; it died with the adjournment of the 88th Congress. More accurately, S. 776 did pass the Senate but modified House versions containing an exception for the garment industry⁹⁴ died in committee. The successful insertion of an exception into the House versions is, however, no guarantee that the exception would have survived the House Judiciary Committee, or a vote on the House floor, or in conference with S. 776. It seems highly probable that S. 776, free of exceptions, will be re-introduced in the 89th Congress.* There, NRMA and the like will have an opportunity to factually support their position. Certainly, proponents of the bill will oppose any exceptions on principle, since death by way of exceptions has been the fate of prior bills.⁹⁵ With the future bills in mind, the final task here is to discuss the effect of recent cases as they impinge on design protection, and to indicate possible approaches to better design protection.

93. In *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F. 2d 115, 136 U.S.P.Q. 292 (1963), *reversed* 376 U.S. 225 (1964), the Sears retail price was lower than the retailer's wholesale cost. See also Hearings on S. 1884, at 210 for a list of Dansk originals and the copies selling at 25-50% the Dansk retail price.

94. Appendix A.

* As noted above, since the preparation of this paper, bills identical to S. 776 (without the interest-group exception in § 2(e)) have been introduced in the 89th Congress, 1st Sess.: H.R. 450 (Ford), H.R. 3366 (Flynt), and S. 1237 (Talmadge and Hart).

95. *Supra* note 28.

Two recent cases, *Sears v. Stiffel*⁹⁶ and *Compco v. Day-Brite*,⁹⁷ have affected unfair competition law in the growing protection it afforded designs. These cases are not seen, however, to affect the growth of protection under copyright law as typified in the post-*Mazer* case law. A brief review of the growth and scope of unfair competition law prior to these two cases will aid in an appreciation of the "pruning" effect they have had.

A. Background—Unfair Competition Law.

Centuries ago, guild regulations required products to be marked with guild and artisan marks to fix liability for defective goods, and also to identify shipwreck goods.⁹⁸ Unfair competition law grew out of such roots in trademark and trade name law as a recognition that the reputation and good will of a business could be tortiously misrepresented. At an early stage, unfair competition law was confined to protection of trade names and later to marks, but it soon extended to products themselves as what is called product simulation law.

An analysis of cases shows that there are two general theories under which protection is granted in unfair competition cases—misrepresentation and misappropriation.⁹⁹ These two theories are best understood by considering the law, not as having two separate shelters, but as being a spectrum, pure examples of the two theories representing the opposite ends. Unfortunately, most cases lie somewhere in the middle, with a resultant degree of confusion in the law.¹⁰⁰

The primary interest protected under the misrepresentation theory is that of the public. The classic case of misrepresentation in product simulation is that called "palming-off," that is, the fraudulent repre-

96. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 140 U.S.P.Q. 524 (1964).

97. *Compco Corp. v. Day-Brite Lighting Inc.*, 376 U.S. 234, 140 U.S.P.Q. 528 (1964). The *Sears* and *Compco* cases, and cases following them, are the subject of a special issue of the *Columbia Law Review*, 64 *Colum. L. Rev.*, No. 7 (Nov. 1964).

98. Halliday, *Protection of Trademarks and Trade Names*, 46 *J. Pat. Off. Soc'y.* 485.

99. Note, *Developments in the Law—Competitive Torts*, 77 *Harv. L. Rev.* 888.

100. In the following discussion see generally 77 *Harv. L. Rev. supra*, note 99; Stern & Hoffman, *Public Injury and the Public Interest: Secondary Meaning in the Law of Unfair Competition*, 110 *U. Pa. L. Rev.* 935; 1 Callmann, *Unfair Competition and Trade Marks*, 2d Ed. (1950) at 69, 70, 80. As an example of a case in the middle of the spectrum, see *Flexitized, Inc. v. National Flexitized Corp.*, 335 F. 2d 774, 142 U.S.P.Q. 334 (2d Cir. 1964), noted 33 *Geo. Wash. L. Rev.* 992.

resentation of the usually inferior goods of the seller as those of another. The "injury" to the public is thought to be paramount since the deceit and fraud arising from the palming-off is not only a direct economic one, the receipt of inferior goods, but also a consequent loss of faith and confidence in the manufacturer of the particular goods, and the market in general. Of course there is some degree of personal loss to the merchant whose product and business good will was misrepresented by the seller. Such a loss is usually described in terms of a diversion of trade or a dilution of the business reputation.

If the public does not know the reputation of the business whose name or product is misrepresented by the fraudulent seller, then it logically and legally follows that that merchant can complain of no harm. Thus there has arisen a legal test which serves to control the relief granted in such cases. That test is called "secondary meaning," and has been defined as "a likelihood that purchasers of defendant's products would believe that they came from the same source as plaintiff's."¹⁰¹ If there were no consumer confusion as to the source of the product, relief would be denied. In *Chas. D. Briddell, Inc. v. Alglobe Trading Co.*,¹⁰² where no copyright or patent protection was relied on, Judge Frank said that even assuming plaintiff's steak knife design to be "unique and the result of genius,"¹⁰³ defendant was privileged to imitate it *unless* the plaintiff had "a monopoly based upon (1) a patent on the design or (2) a so-called secondary meaning."¹⁰⁴ While relief was denied, there being insufficient evidence of consumer confusion, Judge Frank did apply secondary meaning as a valid principle of product simulation law. The test of secondary meaning was a "likelihood" of consumer confusion as to the source of the goods.

Secondary meaning as an element in an action of unfair competition has been applied to a case involving dress design. In *Sandy v. Junior City*,¹⁰⁵ plaintiffs brought an action for "infringement" of their "Zip-around" dress which was neither copyrighted nor patented. The court, after holding that there was no cause of action on common law copyright in dress designs, did find a cause of action under unfair competi-

101. *Chas. D. Briddell, Inc. v. Alglobe Trading Co.*, 194 F. 2d 416, 419, 92 U.S.P.Q. 100, 102 (1952).

102. *Ibid.*

103. *Id.* at 418, 92 U.S.P.Q. at 102.

104. *Ibid.* (Emphasis added.)

105. *A.J. Sandy, Inc. v. Junior City, Inc.*, 234 N.Y.S. 2d 508, 136 U.S.P.Q. 144 (1962).

tion since secondary meaning, confusion in the minds of the public, and damages were sufficiently alleged.

It should be noted that the public need not know the precise or actual source of the goods, i.e., the source may be anonymous. The requirement is merely that the goods, or in trademark or tradename law, the mark or name, be associated with a source which to the public is recognizable as such for quality. In an early case, *Crescent Tool v. Kilbourn & Bishop Co.*,¹⁰⁶ Judge Learned Hand, who was no liberal on the subject, recognized the requirement of secondary meaning and distinguished two types thereunder, both of which he required for relief. Not only did Judge Hand require "source association," defined and discussed above, but also "source motivation," which may be described as a requirement that the source be of such repute that it motivate the public to buy the item.¹⁰⁷ The more stringent source motivation test generally has not been required by the courts.¹⁰⁸

In order that there be no overlap between the protection available for utilitarian articles under the patent laws the so-called test of "functionality" arose. The configuration of an article could be copied whether the configuration was functional or non-functional *if* no secondary meaning had attached to the configuration. Where secondary meaning had attached, then only functional aspects could be copied. Conversely, where a court found the copied features to be functional and otherwise unprotected, any inquiry into secondary meaning was precluded and copying at will was permitted.

Typical of cases illustrating this principle is *Smith, Kline & French Laboratories v. Waldman*.¹⁰⁹ In the *Smith* case defendant made "Chinese" copies of plaintiff's pharmaceutical tablets ("Benzedrine" and "Dexedrine") the configuration of which, being round, white tablets, cross-scored and having a beveled top edge and concave bottom, the court found to be functional and therefore in the public domain. The court noted the weight of authority to be that "one may freely copy the non-functional features of the article if they have not become associated with the original manufacturer or source and the article is bought because of its utility and neat appearance."¹¹⁰

The court in *Smith* stated the test for functionality as: "The definition of a functional or an essential feature is one which 'serves a

106. 247 Fed. 299 (2d Cir. 1917).

107. *Id.* at 301.

108. 77 Harv. L. Rev. *supra* note 99 at 911.

109. 69 F. Supp. 646 (E.D. Pa. 1946).

110. *Id.* at 648.

substantial and desirable use, which prevents it from being a mere matter of dress.' *Warner & Co. v. Eli Lilly & Co.*, (265 U.S. 526, 44 S.Ct. 615, 617, 68 L. Ed. 1161)." ¹¹¹ In *In re The Deister Concentrator Co., Inc.*,¹¹² the applicant sought to obtain trademark protection by registering a specific rhomboidal outline for ore concentrating tables. Apparatus patents had issued to applicant showing the tables of that outline. The Court of Customs and Patent Appeals denied the registration "because the shape is *in essence* utilitarian."¹¹³

At the opposite end of the spectrum is the misappropriation rationale. The interests involved there are in an opposite balance as compared to those involved in misrepresentation type cases. Under the misrepresentation rationale, unless there is a public interest in freedom of confusion to be vindicated, the courts will leave the parties in the market place as they are found. In contrast, under the misappropriation rationale, the courts deem protection of an individual's creation to outweigh a lack of confusion of the public.

The headwaters of the misappropriation rationale is *International News Service v. Associated Press*.¹¹⁴ In that case, plaintiffs had gone to considerable expense of time and money to collect news items and sold

111. *Ibid.*

112. 48 CCPA 952, 289 F. 2d 496, 129 U.S.P.Q. 314.

113. *Id.*, 48 CCPA at 968. There are many a slip in the application of the test of functionality. Consider *Pagliari v. Wallace China Co., Ltd.*, 198 F. 2d 339 (9th Cir. 1952), where the court found designs on hotel china, which were the essential selling feature of the china leading to its commercial success, to be functional since they satisfied "a demand for the aesthetic" (p. 343). The court in the previous breath indicated that where the

feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product, imitation may be forbidden where the requisite showing of secondary meaning is made. Under such circumstances, since effective competition may be undertaken without imitation the law grants protection. (p. 343)

The court in *Pagliari* then decided the case on the basis that the ornamentation was functional. It would appear, however, that effective competition could have been undertaken without imitation, by adopting an equally "aesthetic" but different design, and thus the patterns fell within that court's own test of a non-functional design, contrary to its decision. The court in *Pagliari* in effect held that success is evidence of functionality and that a good design may be copied but a mediocre one not.

114. 248 U.S. 215 (1918).

them as a service to subscribing newspapers on the east coast. Defendant Associated Press systematically gathered items from early editions of East Coast papers and sold them to their own subscribers on the West Coast. The problem for plaintiffs was that news, particularly after publication, was not personal property and was free to be used by anyone. The Supreme Court, however, found news so gathered to be "quasi-property," and granted an injunction which delayed defendant's use of the INS news until it was of relatively no value as news. The court broadly defined misappropriation amounting to unfair competition to be any "unauthorized interference with the normal operation of . . . legitimate business precisely at the point where the profit is to be reaped."¹¹⁵

The *INS* case represented a considerable extension of unfair competition law beyond palming-off to cases of misappropriation of what equitably belonged to a competitor.¹¹⁶ In a recent misappropriation case of the type called "inverse palming-off," defendant used one of plaintiff's bongo drums in preparing photographs to be used in the promotion of his own drums.¹¹⁷ The problem for plaintiffs lies in convincing courts that they have a business value or property right which has been misappropriated. That is particularly difficult in the area of intangible intellectual creations such as the shape or configuration of goods, a trademark or trade name, or a dress design, since "property" is a conclusory term.¹¹⁸ The court, as in the *INS* case, *creates* a property right if it can be persuaded to grant protection.¹¹⁹ The more tangible the business value, the better shape plaintiff will be in to obtain protection. Plaintiff is more likely to recover if he can also rely on a contract which has been breached, or show fraud, a breach of confidence or fiduciary duty. Such factors give the court alternative grounds for relief, and are evidentiary of the existence of a business value which is to be protected.

While the *INS* case has had varied success in the circuits,¹²⁰ an extremely pertinent New York State case, *Dior v. Milton*,¹²¹ extended the misappropriation doctrine. In that case the defendants,

115. *Id.* at 240.

116. *Dior et al. v. Milton et al.*, 155 N.Y.S. 2d 443, 452 (Sup. Ct.), 110 U.S.P.Q. 563, 566, *aff'd mem.*, 156 N.Y.S. 2d 996 (1st Dept. 1956).

117. *Mastro Plastics Corp. v. Emenee Ind., Inc.*, 141 U.S.P.Q. 311 (Sup. Ct. 1964); 1 *Callmann, supra* note 100 at 76-77.

118. 77 *Harv. L. Rev. supra* note 99 at 935.

119. *Ibid.*

120. *Id.* at 934.

121. *Supra* note 116.

publishers of a fashion "sketch service," by fraudulent misrepresentations, concealments and promises, obtained entry to the showing rooms of the plaintiffs who were well known fashion designers. The defendants prematurely distributed unauthorized reproductions of plaintiffs' original designs and sketches thereby causing a loss in their value. Significantly, the court found property rights in dress designs, sketches and models.¹²² In holding that the fashion houses had a valid cause of action the court in effect ruled that *per se* such "piratical conduct and practices . . . constitute unfair competition."¹²³

The above, then, is a brief review of the state of unfair competition law, as it related to designs and product simulation, prior to *Sears and Compco*.

B. *The Sears and Compco Cases.*

In *Sears v. Stiffel*,¹²⁴ defendant Sears was charged with infringement of plaintiff Stiffel's design and mechanical patents on pole lamps. A second count claimed unfair competition by the sale of "Chinese" copies of the pole lamps. The District Court held the patents invalid for want of invention, but held Sears guilty of unfair competition and enjoined further selling of identical or confusingly similar pole lamps. The Court of Appeals affirmed, holding that under Illinois law it was unnecessary to show palming-off in cases of design simulation. A case of unfair competition would succeed on proof of only a likelihood of confusion as to the source of the products.

The Supreme Court reversed,¹²⁵ holding that when an article is unprotected by patent or copyright, state law may not forbid others to copy that article, since to do so would interfere with federal policy which allows free access to copy whatever the federal patent and copyright laws leave in the public domain.

The Supreme Court saw the question as a conflict between federal patent and copyright laws and state law proscribing unfair competition. The Court found the holding of the lower court in effect to be an indirect encroachment on the federal patent law by giving Stiffel "the equivalent of a patent monopoly on its unpatented lamp,"¹²⁶ although

122. *Id.* at 456, 110 U.S.P.Q. at 568.

123. *Ibid.*

124. *Supra* note 96.

125. No review of the lower court holding that the patents were invalid was sought.

126. 376 U.S. at 233, 140 U.S.P.Q. at 528.

Sears had been doing "no more than copying and marketing an unpatented article."¹²⁷

Compco v. Day-Brite,¹²⁸ involved the same question. The holdings of the lower courts as to the invalidity of patents and existence of unfair competition were the same as in *Sears*. The court reluctantly accepted evidence which showed actual confusion as to the source of the fixtures. Nevertheless it reversed, citing *Sears*, holding that the Day-Brite light fixture, not being entitled to a design or mechanical patent was, therefore, "in the public domain and can be copied in every detail by whoever pleases."¹²⁹

In both cases the court is stating that *it is not the law that something less than a showing of palming-off will sustain an action for unfair competition*. But the *Compco* case goes further than *Sears*, since it, of the two cases, involved a question of secondary meaning. In *Compco* the court stated:

It is true that the trial court found that the configuration of Day-Brite's fixture identified Day-Brite to the trade because the arrangement of the ribbing had, like a trademark, acquired a "secondary meaning" by which that particular design was associated with Day-Brite. But if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will.¹³⁰

Construing the decisions no farther than the facts on which they rest, the holding of the two cases taken together could be phrased as follows: Once the features of a product have been disclosed, that is, put into the public domain, whether by express or implied dedication, i.e., by termination of a valid patent, or declaration of invalidity of an existing patent, then it cannot be removed therefrom by resort to principles of state unfair competition law, regardless of what features, functional or non-functional, are disclosed, and regardless of whether secondary meaning is capable of attaching to those features. The only exception appears to be palming-off:

. . . the federal patent laws . . . do not stand in the way of state law, *statutory or decisional*, which requires those who make and sell copies to take precautions to *identify* their products as their own. A state of course has power to impose liability upon those who,

127. 376 U.S. at 227, 140 U.S.P.Q. at 526.

128. *Supra*, note 97.

129. 376 U.S. at 238, 140 U.S.P.Q. at 530.

130. *Ibid.*

knowing that the public is relying upon an original manufacturer's reputation for quality and integrity deceive the public by *palming-off* their copies as the original.¹³¹

However, it will be extremely easy for a pirate to shift from a situation of palming-off to one of mere "copying." In a situation such as that in the *Bridgell* case *supra*, the only factor that prevented the case from being one of pure palming-off was the labeling. The name and decal on the packing-box and knife blade were different but the goods themselves were the same in design. In reality, labeling may be no effective difference, since the box cover carrying the name and decal may be folded back or removed when on display, and the decal on the blade may be too small or faint to be noticed. What would constitute adequate labeling in situations where it is the configuration of the goods which is in effect the product being sold?

In striking down the lower court holding in *Compco*, which was based on what was considered to be entirely too "thin" evidence of secondary meaning,¹³² the Supreme Court indicated that it is necessary to show more than a *likelihood* of confusion to maintain an action in a product simulation case of unfair competition.

The tendency of unfair competition was toward a self-sufficient cause of action which could be based solely on a showing of secondary meaning having attached to the non-functional configuration of a product. That direction of growth in the law clearly has been stopped since the roles of secondary meaning, apart from functioning as an element in palming-off, and non-functionality of design are now merely evidence pertaining to a remedy for mislabeling under state law:

. . . that the design is "nonfunctional" and . . . that the configuration of the article copied may have a "*secondary meaning*" . . . *may be relevant evidence in applying a State's law requiring such precautions as labeling; however, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling, regardless of the copier's motives.*¹³³

What apparently concerned the Court was the idea that something that could not be patented yet could, through secondary meaning, be

131. *Ibid.* (Emphasis added.)

132. 376 U.S. at 237, 140 U.S.P.Q. at 530.

133. 376 U.S. at 239, 140 U.S.P.Q. at 531. (Emphasis added.)

perpetually protected.¹³⁴ This concern seems to mistake the nature of secondary meaning. In general, it is established only quite slowly, thus giving second-comers an opportunity to enter the field before it is closed to all but the originating manufacturer. Further, the association of the product with the source must be *maintained* through continual efforts of the producing or selling source. Further, in a pioneer field the configuration could, like a trade name or a trademark, become generic and thus be dedicated to the public. Certainly, federal law does not frown on a type of "perpetual" protection which arises through perpetual or continued use, since establishment and continuance of rights through secondary meaning are part of the federal trademark law, the 1946 Lanham Act.¹³⁵

Further, the idea that patent and copyright law *by being silent*, on the copying of unpatented or uncopyrighted works (which have acquired a secondary meaning) *permits copying in a positive sense*,¹³⁶ is an *extreme* expression of a federal statutory policy which preempts the field to the exclusion of state action.¹³⁷

134. The Court in *Sears* stated, 376 U.S. at 231, 140 U.S.P.Q. at 528:

To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public *something which federal law has said belongs to the public*. The result would be that while federal law grants only 14 or 17 years' protection to genuine inventions, see 35 U.S.C. §§ 154, 173, *States could allow perpetual protection* to articles too lacking in novelty to merit any patent at all under federal constitutional standards. This would be too great an encroachment on the federal patent system to be tolerated. (Emphasis added.)

135. 15 U.S.C. §§ 1051-1072, 1091-1096, 1111-1121, 1123-1127, 60 Stat. 427 (1946).

136. The Court in *Sears* stated, 376 U.S. at 232, 140 U.S.P.Q. at 528:

Of course there could be "confusion" as to who had manufactured these nearly identical articles. But mere inability of the public to tell two identical articles apart is not enough to support an injunction against copying or an award of damages for copying that which the federal patent laws *permit* to be copied. (Emphasis added.)

Similarly in *Compco* the Court noted, 376 U.S. at 237, 140 U.S.P.Q. at 530, ". . . the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

137. That preemption has been stated by one commentator to be directly contrary to *Gibbons v. Ogden*, 22 U.S. 1, 9 Wheat. 1, 6 L. Ed. 23 (1824), *Arnold, A Philosophy on the Protections Afforded by Patent, Trademark, Copyright and Unfair Competition Law: The Sources and Nature of Product Simulation Law*, 54 T.M.R. 413 (1964). *Contra*, *Brown, Product Simulation: A Right or A Wrong?*, 64 Colum. L. Rev. 1216 (1964), who

The implications for design protection are mixed. The survival of the business tort of palming-off will be of no more avail than it was formerly since copying is not palming-off. The *Sears* and *Compco* cases have, by extrapolation of the holdings in view of the frequent references to the public interest therein, apparently chosen the policies of the misrepresentation rationale over that of the misappropriation doctrine.¹³⁸ The *INS* case seems sub-silentio overruled, and to the extent that the *Dior* case held that there are property rights in uncopyrighted dress designs, it is no longer valid.¹³⁹ While the Court did not specifically discuss the misappropriation doctrine, a broad interpretation of the two cases indicates the Court would not recognize a protectible business value in a design even if secondary meaning had actually attached.

On the other hand, the two cases indicate several reasons why the federal statutory protection is not only not foreclosed but also is preferable. The Court limits the state to mislabeling laws, but does not so limit the federal power. Secondly, a *national* policy is clearly indicated to be preferable to the many variations evolving under state unfair competition law. Third, the Court's overriding concern that protection be limited in time, by a definite term the expiration of which is a full and irretrievable dedication, in preference to a potentially perpetual protection through secondary meaning, points to a statutory solution.

at p. 1218 notes that *Gibbons v. Ogden* did not solve the point of state ability or disability to create a patent right. Brown notes that there are occasional assertions that a state can create patent rights, directing attention to, *e.g.*, 1 Robinson, *Law of Patents*, 68 (1890), and *cf.*, Whicher, *The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers over the Law of Literary Property in The United States*, 9 BULL. CR. SOC. 102 (1961), *id.* at 194 (1962).

138. Note, *Flexitized Inc.*, *supra* note 100.

139. The *Dior* case could be easily distinguished since there was present in that case a showing of fraud. *Dior* could also be distinguished on its holding that a cause of action was stated for unjustifiable interference with the contractual rights of plaintiffs. There is an aspect of the *Dior* case which is not clearly developed in the opinion, that designs before publication are trade secrets. Whether this is an approach for counsel to take is doubtful since it is questionably applicable to situations not involving parties privy to the subject matter, *e.g.*, former employees. In any event the *Sears* and *Compco* cases should have little effect since distinguishable on the ground that nothing has been dedicated to or withdrawn from the public domain in the case of trade secrets, *Servo Corporation of America v. General Electric Company*, 337 F. 2d 716, 143 U.S.P.Q. 85 (4th Cir. 1964).

It must be emphasized that neither *Sears* nor *Compco* will halt growth of protection in unfair competition product simulation law. Beyond the fact that the cases did *not* deal with articles which had not been previously but invalidly patented (and therefore dedicated to the public), or to which a strong secondary meaning had attached, they will be distinguished by courts on whatever grounds suit the purpose.¹⁴⁰

Just as flora adapts under adverse conditions, so the law will blossom with fictions and distinctions. Unfair competition, particularly under the misappropriation rationale, has tended to go too far in the relief granted, permitting both injunctions and damages.¹⁴¹ What is more pertinent to the problems and nature of designs is copyright-type protection, of limited, primarily injunctive relief, quickly available, but of short term.

C. Borderland of Future Growth—Trademarks.

Trademarks can be three-dimensional.¹⁴² The federal trademark law calls for no more than that such a mark be "capable" of distinguishing the goods, i.e., pointing to the source, in order that registration be permitted. That requirement is no more stringent than the likelihood of confusion test, and something less than secondary meaning, struck down by the Supreme Court in *Sears*. While the delineation of the amount of growth possible in this area is not within the bounds of this paper, it will be apparent from the consideration of three cases, *In re Mogen David Wine Corp.*,¹⁴³ *In re Minnesota Mining and Mfg. Co.*,¹⁴⁴ and *In re Shenango Ceramics, Inc.*,¹⁴⁵ that *Sears* and *Compco* do not foreclose the area.

In the *Mogen David* case¹⁴⁶ the question was whether, as a matter of law, an unexpired design patent to the ornamental features of a decanter bottle precluded registration on the Principal Register of the configuration of the same bottle as a trademark for wine. Distinctiveness called for by § 2 (f) of the 1946 Act,¹⁴⁷ i.e., secondary meaning, was

140. See *supra* notes 117 and 138.

141. *Supra* note 138.

142. *In re Minnesota Mining and Mfg. Co.*, 51 CCPA 1546, 335 F. 2d 836, 143 U.S.P.Q. 366.

143. 51 CCPA 1260, 328 F. 2d 925, 140 U.S.P.Q. 575, on remand, 145 U.S.P.Q. 85 (PO TM TAppBd 1965).

144. *Supra* note 142.

145. 143 U.S.P.Q. 48 (PO TM TAppBd 1964).

146. Decided three days after *Sears* and *Compco* without reference thereto, and rehearing denied with full knowledge of the two cases.

147. 15 U.S.C. § 1152 (f).

alleged. The Trademark Trial and Appeal Board had concluded that the registration under § 2 (f) could be considered only after the expiration of the patent. The Court of Customs and Patent Appeals reversed and remanded for consideration of whether the evidence submitted was sufficient to establish distinctiveness under § 2 (f) of the Act. The Court observed that property rights under design patents as compared to trademarks are of a different nature, exist for different periods, are granted on a different basis on different evidence, are for different purposes, and the two rights are separate and distinct.¹⁴⁸ The court held that trademark registration plainly would not extend the patent monopoly after its expiration. Since the subject matter of the *Mogen David* case was the packaging or container for the product, rather than the actual product itself, the case is not inconsistent with *Sears* or *Compco*, falling within the labeling and distinctive dress in the packaging of goods which *Sears* and *Compco* indicated state unfair competition law may protect,¹⁴⁹ as well as being directed to federal protection.

In the *Minnesota Mining* case, applicant sought to register on the Supplemental Register, a triangular prism-shaped block of a chemical under the configuration of goods provision of the 1946 Lanham Act.¹⁵⁰ The administrative tribunals refused registration on the grounds that the *over-all* configuration of goods was not a proper subject of registration under that provision. The court in reversing indicated that the test was not whether the configuration applied to only a part of the goods and was thereby registrable, or to the entire goods and thus unregistrable, but was whether the configuration was *intended* primarily to indicate origin and was *capable* of indicating origin. The court noted, relying on the *Deister* case,¹⁵¹ that where the shape or feature was entirely arbitrary it may become a legally recognizable trademark because there is no public interest to be protected.

The *Shenango* case involved a situation similar to that of *Mogen David* insofar as the applicant was attempting to register the *shape* of china dishware on the Principal Register, the same dishware having been the subject of an expired patent. The Trademark Trial and Appeal Board refused registration, pointing out that here, as distinct from *In re Mogen David*, the configuration of the *goods themselves* was

148. *Supra* note 143, 140 U.S.P.Q. at 577-79.

149. Derenberg, *The Seventeenth Year of Administration of The Lanham Trademark Act of 1946*, 142 U.S.P.Q. No. 6, Part II, at 3 (August 10, 1964).

150. Section 23, 15 U.S.C. § 1091, the provision establishing a supplemental register.

151. *Supra*, note 112 and accompanying text.

the subject of attempted registration, and was functional and not arbitrary, as shown in part by the expired patent. The Board followed the *Deister* case. The concurring board member was of the opinion that as a matter of law *Sears* and *Compco* precluded a consideration of functionality and secondary meaning since the design of plates is not proper subject matter for registration as a trademark on the Principal Register.¹⁵² His position apparently derives from an extension of the *Sears* and *Compco* cases, that what is not a label or distinctive dress is not susceptible of protection; as a matter of law if it is not a label or packaging then it cannot be considered. That position, however, is a misconstruction of *Sears* and *Compco*, since those cases did not cover the problem of proper subject matter for federal trademark registration. Further, the dictum in *Compco* discussed only the element of non-functionality in state unfair competition law, rather than federal trademark law, leaving valid the rule that where the configuration is "functional" it may not be protected except by a patent.

The over-all configuration of goods may obtain federal protection by registration on the Supplemental Register if it is an arbitrary configuration intended primarily to indicate origin and capable of doing so, i.e., capable of functioning as a trademark, as seen from the result in the *Minnesota Mining* case.¹⁵³ Certain configurations, as packages, if they have already become distinctive, may obtain federal trademark protection on the Principal Register, as seen by the *Mogen David* case. The Principal Register protection would be insufficient for the vast majority of design situations because distinctiveness is slow to develop and thus cannot give prospective protection, while a one year in commerce requirement for the Supplemental Register protection would be a too harsh prerequisite for most designs. As in unfair competition law, the protection available through registration under the Lanham Trademark Act would be as perpetual as the continuing attachment of secondary meaning through continuous use permits. Once obtained, such protection could be far more extensive in time than the ten years provided for by S. 776.

152. 143 U.S.P.Q. at 52.

153. As a caveat it should be noted that Derenberg is of the view that federal unfair competition law is limited to § 43a, 15 U.S.C. § 1125(a), and that the entire ornamental configuration of goods as a matter of law should be incapable of trademark significance and thereby unregistrable, 64 Colum. L. Rev. 1202.

D. *A Glance at Constitutionality after Sears-Compco.*

Would S. 776 be constitutional in view of *Sears* and *Compco*? The question arises since it is not clear whether the federal preemption derives from the patent and copyright (and trademark?)¹⁵⁴ statutes, or from the Constitution itself. If the decisions in *Sears* and *Compco* were primarily constitutional rather than questions of conflict of laws, then S. 776 might be invalid as not within the constitutional framework of "preserving free competition."¹⁵⁵ However, those two decisions seem more clearly to involve a conflict question since there was great emphasis on the preemption by federal law. *Foreclosure* of other statutes is not so readily apparent in the decisions as is the call for a *federal statutory* scheme limiting the *scope* and *period* of protection.

The Constitution would appear to afford accommodation of protection for designs merely by considering a design to be a "writing" within the meaning of Article I, Section 8. There is presently some overlap with copyrights. To hold designs not within the Constitution would be to hold many categories of copyrights unconstitutional. While trademarks are founded on the commerce clause, there is also some overlap between designs and three-dimensional trademarks. Further, designs *are* patentable under the Constitution although that hardly suits their nature.

154. 15 U.S.C. § 1125(a), § 43(a) of the Lanham Act, may provide basis for preemption should the issue arise. See 64 Colum. L. Rev. 1212. That issue may be settled in *PIC Design Corp. v. Sterling Precision Corp.*, 231 F. Supp. 106, 142 U.S.P.Q. 431 (S.D.N.Y. 1964), noted 33 Geo. Wash. L. Rev. 816.

155. *Sears*, *supra* note 96, 376 U.S. at 231, n. 7, 140 U.S.P.Q. at 527, n. 7. A clue to the feelings of Justice Black may be found in his dissent in *Aro Mfg. Co., Inc., et al. v. Convertible Top Replacement Co., Inc.*, 377 U.S. 476 at 522, wherein he states:

The granting of patent monopolies under this *constitutional* authority (Article I, § 8) represents a very *minor* exception to the Nation's traditional policy of a competitive business economy, such as is safeguarded by the antitrust laws. *When articles are not patentable and therefore are in the public domain*, as these fabric covers were, to grant them a legally protected monopoly offends the *constitutional plan* of a *competitive economy* free from patent monopolies except where there are patentable "Discoveries". (Emphasis added.)

Quaere: Is the commerce power such an implied negative as to limit article I, Section 8 to patents and copyrights? It would not seem to preclude designs since they are in part covered by both patents and copyrights.

The imagined conflict with the antitrust laws as preserving "free competition" is merely the hypnosis of the magic word "monopoly." Since a "design-right" under the bill would not be a monopoly, the antitrust objection is untenable. Copying is not preservative of "free competition," that elusive state which courts are particularly unsuited to define, but is more an unfair method of competition.¹⁵⁶ Article I, Section 8 of the Constitution affords adequate basis for copyright-type design protection whether a design is considered as a "writing" or as one of the "useful arts."

E. *Amending Design Patent Law—An Unsatisfactory Alternative.*

An alternative approach to design protection might lie in the revision of 35 U.S.C. 171,¹⁵⁷ which is the current statutory basis for the stringent utility patent test of "invention" as applied to designs. The utility patent tests have been applied by the Patent Office and the courts to *design* patents with devastating results.¹⁵⁸ Not only are the courts generally unaware that since the 1952 Patent Act¹⁵⁹ the test of "invention" has been replaced by a test of "obviousness,"¹⁶⁰ but also that the patentability tests for utility patents (useful, novel, and unobvious) are different from the tests for design patents (novel, original, and ornamental). Applying the proper tests as they are now in the statute would help, and even more helpful would be a statutory change, to the effect that "the conditions and requirements of this title . . . relating to patents for inventions shall apply to patents for designs,"¹⁶¹ apply not to the test for patentability but to *procedural* aspects. Even with such changes,

156. Indeed it is commonly taught in law schools as part of a course on unfair trade. See Oppenheim, *Unfair Trade Practices, Cases, Comments and Materials*, (1950), Ch. 4, *Appropriation of Values Created by Another*, § 2, *Appropriation of Styles and Designs*, pp. 498-512.

157. 35 U.S.C. § 171. Patents for designs.

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

158. Ringer, 7 BULL. CR. SOC. 25 (1959).

159. Act July 19, 1952, c. 950, 66 Stat. 792, Title 35 U.S. Code.

160. Rich, Kettering Award Address, *The Vague Concept of "Invention" as Replaced by § 103 of The 1952 Patent Act*, 8 Patent, Trademark, and Copyright J. of Research and Education 136 (1964), reprinted in 46 J. Pat. Off. Soc'y. 855.

161. *Supra* note 157.

however, the present lag in obtaining protection and its harmful effects would not be overcome.¹⁶²

V. CONCLUSION

Piracy is good business—for the pirates. It is virtually without risk; pirates ride on sure winners, and need little capital outlay. Because society has long felt “free competition” beneficial,¹⁶³ and has carried an historical misconception toward justifiable monopolies, piracy has been permitted to flourish.

In the absence of design protection, the coverage available under copyrights has expanded. As stated in *Dan Kassoff v. Novelty Jewelry*,¹⁶⁴ it is “now settled beyond question that practically anything novel can be copyrighted. . . . No matter how poor artistically the ‘author’s’ addition, it is enough if it is his own.”¹⁶⁵ This illustrates the judicial acceptance of the administrative enlargement of the category of “works of art” to include those intended for application to useful articles. *Sears and Compco* should provide additional reason for designers to attempt to enlarge the scope of the types of designs of useful articles for which copyrights could be obtained.¹⁶⁶

But under copyrights, 56 years is far too long protection; S. 776 would provide a total of only ten years. Further, as Ringer has pointed out, protection under copyrights is inappropriate since it is too broad in scope, “a presumably innocent non-manufacturing retail vendor was held liable for copyright infringement.”¹⁶⁷ S. 776 is not so broad as the *Vera* case as to third party retailers since knowledge is an element of infringement under Sec. 8 (d) of the bill. In this respect NRMA is better off under S. 776, and may be walking a copyright plank.

162. *Supra*, p. 323.

163. This is Adam Smithian dogma, as noted by Judge Frank in his concurring opinion in the V-8 case, *Standard Brands, Inc. v. Smidler*, 151 F. 2d 34 (2d Cir. 1945).

164. 309 F. 2d 745, 135 U.S.P.Q. 234 (1962).

165. *Id.* at 746.

166. The proposed Copyright Revision Bills, H.R. 11947 (Mr. Celler) and S. 3008 (Mr. McClellan) 88th Congress, 2nd Session, would not change this since § 9 therein would serve to codify the cases as to design protection under copyright law. Recall that § 32 of S. 776 would terminate protection under copyright law upon receipt of design registration, and conversely, § 28 terminates design-right registration upon issuance of a design patent. See the subsequent bills, H.R. 4347 and S. 1006, 89th Cong., 1st Sess.

167. 7 BULL. CR. SOC. 25, at 30, citing *Scarves by Vera, Inc. v. United Merchants & Mfrs., Inc.*, 173 F. Supp. 625, 121 U.S.P.Q. 578 at 581 (1959).

Until recently, expansion occurred in unfair competition, particularly under the misappropriation doctrine, but with *Sears* and *Compco* the Supreme Court has pruned unfair competition in product simulation back to the basic root of palming-off. Only injunctive remedy would be available under appropriate state law, be there any, and that for mislabeling, not for copying. However, that a policy against copying must be a *national* policy with consideration of economic factors is consistent with *Sears* and *Compco*. The two cases indicate that perpetual protection for designs through growth in unfair competition law is undesirable. It is evident from the decisions that *federal statutory* protection of limited *scope* and *term* is preferable.

As seen from more recent cases, that area of trademark law which borders on configuration of goods or packages appears to be intact after the *Sears* and *Compco* cases. Some expansion in this area of the law is expected. Another approach has been suggested, that of bringing home to the courts, in suits on design patents, that the utility patent tests for patentability are inappropriate to design patents. Revision of § 5 U.S.C. 171 to emphasize the differences between the utility and design patent tests would be in order. This would be at best a half-measure since the benefits of prospective protection at the time of first use are available only through copyright-type protection.

It is not inappropriate that a change in the law to afford greater protection to designs must come from Congress. The Court in the *Sears* case ascribes to the ideal of promoting invention "while at the same time preserving free competition."¹⁶⁸ But whether we now have "free competition," or whether piracy necessarily must be let flourish to preserve "free competition," are questions the Court is unsuited to answer. Congress, in the framework of its investigatory powers, is peculiarly suited to gather and to weigh the factors in order to determine the necessary legislative action. To borrow a phrase from Auerbach, ". . . government intervention to make our competitive system work is not a novelty."¹⁶⁹

Congress has sufficient evidence to determine that piracy is unfair competition, and the proposed "design-right" protection is no more "monopoly" than is copyright. Nothing NRMA states contradicts that evidence; their arguments are factually unfounded, inflammatory, belated, and restricted to part of a single industry. After ignoring the opportunity to present facts and alternatives at the hearings, NRMA

168. *Sears*, *supra* note 155.

169. Auerbach, *Quality Standards, Informative Labeling and Grade Labeling as Guides to Consumer Buying*, 14 L. & Contemp. Prob. 362, 383 (1949).

obtained enough time with the magic words "monopoly" and "competition" to apply pressure for, and obtain, an interest group exception. NRMA will have an opportunity to present the 89th Congress with facts to support their charges. Copyright-type design protection remains the best solution, and promises competition with respect to designs without excessive protection, both as to scope and period, as might occur under growing areas of the law.

APPENDIX A

S. 776, 88th Cong., 1st Sess., provides in part as follows (the interest group exception is set out separately at the end; the provisions of the bill reproduced here are identical to the provisions in H.R. 450 (Ford), H.R. 3366 (Flynt), and S. 1237 (Talmadge and Hart) introduced into the 89th Cong., 1st Sess.):

S. 776 A BILL To encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying.

§ 1. DESIGNS PROTECTED. (a) The author or other proprietor of an original ornamental design of a useful article may secure . . . protection . . .

(b) For the purposes of this Act—

(1) A “useful article” is an article which in normal use has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article which normally is a part of a useful article shall be deemed to be a useful article.

(2) The “design of a useful article”, hereinafter referred to as a “design”, consists of those aspects or elements of the article, including its two-dimensional or three-dimensional features of shape and surface, which make up the appearance of the article.

(3) A design is “ornamental” if it is intended to make the article attractive or distinctive in appearance.

(4) A design is “original” if it is the independent creation of an author who did not copy it from another source.

§ 2. DESIGNS NOT SUBJECT TO PROTECTION. Protection . . . shall not be available for a design that is—

(a) Not original;

(b) staple or commonplace, such as a standard geometric figure, familiar symbol, emblem, or motif, or other shape, pattern, or configuration which has become common, prevalent, or ordinary;

(c) different from a design excluded by subparagraph (b) above only in insignificant details or in elements which are variants commonly used in the relevant trades; or

(d) dictated solely by a utilitarian function of the article that embodies it.

§ 3. REVISIONS, ADAPTATIONS, AND REARRANGEMENTS. Protection . . . shall be available notwithstanding the employment in the design of subject matter excluded from protection under section 2, if the design is a substantial revision, adaptation, or rearrangement of said subject matter: *Provided*, . . . [any copyrighted or patented material is employed only with consent of proprietor] . . .

§ 4. COMMENCEMENT OF PROTECTION. (a) The protection . . . shall commence upon the date when the design is first made public.

(b) A design is made public when, by the proprietor of the design or with his consent, an existing useful article embodying the design is anywhere publicly exhibited, publicly distributed, or offered for sale or sold to the public.

§ 5. TERM OF PROTECTION. (a) . . . [provides for two five year periods.]

(b) . . . [in cases of predating, the period runs from that date as in copyrights.]

(c) . . . [provides for single registration in cases of use on multiple articles.]

§ 6. THE DESIGN NOTICE. (a) Whenever any design . . . is made public as provided in section 4 (b), the proprietor shall . . . mark it . . . legibly with a design notice consisting of . . .

(1) The words "Protected Design", the abbreviation "Prot'd Des." or the letter "D" within a circle . . .

(2) The year of the date on which the design was first made public; and

(3) The name of the proprietor . . .

(b) The notice shall be so located and applied as to give reasonable notice . . . in the case of sheetlike . . . materials bearing repetitive . . . designs, by application of the notice to each repetition, or to the margin, selvage, or reverse side of the material at reasonably frequent intervals, or to tags or labels affixed to the material at such intervals.

(c) . . . protection . . . shall not be affected by the removal, destruction, or obliteration by others of the design notice on an article.

§ 8. INFRINGEMENT, see *infra* pp. 331 ff.

§ 21. INJUNCTION. . . . courts having jurisdiction . . . may grant injunctions in accordance with the principles of equity to prevent infringement, including in their discretion, prompt relief by temporary restraining orders and preliminary injunction.

§ 22. RECOVERY FOR INFRINGEMENT. . . . (a) . . . the court shall award . . . damages adequate to compensate for the infringement, but in no event less than the reasonable value of the use made of the design by the infringer, and the costs of the action. When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages . . . not exceeding \$5,000 or \$1 per copy, whichever is greater. . . . The damages awarded . . . shall constitute compensation and not a penalty. The court may receive expert testimony . . . [to determine] . . . damages.

(b) . . . [provides a three year statute of limitations.]

(d) The court may order that all infringing articles, and any plates, molds, patterns, models, or other means specifically adapted for making the same be delivered up for destruction or other disposition as the court may direct.

§ 24. LIABILITY FOR ACTION ON REGISTRATION FRAUDULENTLY OBTAINED. . . .

§ 25. PENALTY FOR FALSE MARKING. . . .

§ 26. PENALTY FOR FALSE REPRESENTATION. . . . [to obtain registration] . . .

§ 27. RELATION TO COPYRIGHT LAW. (a) Nothing in this Act shall affect any right or remedy now or hereafter held by any person under title 17 of the United States Code.

(b) When a pictorial, graphic, or sculptural work in which copyright subsists under title 17 of the United States Code is utilized in an original ornamental design of a useful article, by the copyright proprietor or under an express license from him, the design shall be eligible for protection under the provisions of this Act.

§ 28. RELATION TO PATENT LAW. (a) Nothing in this Act shall affect any right or remedy available to or held by any person under title 35 of the United States Code.

(b) The issuance of a design patent for an ornamental design for an article of manufacture under said title 35 shall terminate any protection of the design under this Act.

§ 29. COMMON LAW AND OTHER RIGHTS UNAFFECTED. Nothing in this Act shall annul or limit (1) common law or other rights or remedies, if any, available to or held by any person with respect to a design which has not been made public as provided in section 4 (b), or (2) any trademark right or right to be protected against unfair competition.

§ 32. AMENDMENT OF COPYRIGHT LAW. Chapter I of title 17, United States Code, is amended by adding the following:

“§ 33. Ornamental design of useful article not subject to deposit; effect of utilization of copyrighted work in design of useful article . . .

(c) . . . [copyright protection] . . . shall terminate with respect to its utilization in useful articles whenever the copyright proprietor has obtained registration of an ornamental design of a useful article embodying said work under the provisions of . . . [S. 776] . . .”

§ 35. NO RETROACTIVE EFFECT. . . .

In the 88th Congress, House bills identical to S. 776 were H.R. 323, H.R. 769, and H.R. 5523. To the latter bill, H.R. 5523, the garment industry exception was proposed as a new subsection (e) to Section 2:

Sec. 2. Protection under this act shall not be available for a design that is— . . .

(e) Composed of three-dimensional features of shape and surface with respect to men's, women's, and children's undergarments and outerwear.

APPENDIX B

STATEMENT OF THE NATIONAL RETAIL
MERCHANTS ASSOCIATION
ON THE SUBJECT OF S. 776
NOW BEFORE THE SUB-COMMITTEE
OF THE HOUSE JUDICIARY COMMITTEE
JANUARY 14, 1964*

- 1 My name is William Burston. I am manager of the merchandising division of the National Retail Merchants Association and authorized by the President of the Association to speak in its behalf.
- 2 The National Retail Merchants Association is a non-profit trade association organized under the Membership Corporations Law of the State of New York with executive offices at 100 West 31st Street, New York 1, New York. NRMA, as we usually are called, has a membership of approximately 1,800 corporations, partnerships and individual proprietors, located in every state in the Union and in over 40 countries abroad. These members operate approximately 11,000 stores accounting for \$19 billion in sales annually and providing employment for over 800,000 of our citizens.
- 3 It goes without saying that all men and women are entitled to the fruit of their work. This is the rule of our free society and we would debase that rule and ourselves if we imposed any restriction upon it.
- 4 Daily, in every stratum of our economic and cultural life, "ideas" occur to millions of men and women. They are not world-shaking like an Einstein's. They don't change our manner of living like Edison's invention of the electric light. They don't add beauty and distinction as did Chippendale's "line" in furniture design. They haven't the classic air of a Chanel suit.
- 5 Yet they are *ideas*. Imaginative adaption, a new angle, a different type of handling, an inspired addition bring forth things of value that never existed before.
- 6 They *are* creations and their creators are entitled to the fruits of their minds. There are laws now on the books to protect these rights.

* Paragraph numbering supplied for ready reference.

- 7 But some ideas are not sufficiently original to assure a patent. Some may not qualify for copyright. To protect these kinds of ideas S 776 is proposed.
- 8 Under this bill the mere declaration that an idea is original would apparently secure its protection. "Original" is defined as being not a copy of another's idea; also that the idea is not found in the public domain. Registrants would thereby be able to sue alleged violators. If successful not only could they collect damages but they could prevent all other creators of similar ideas from bringing them to market and thereby enjoying the fruit of their work.
- 9 Because we believe that present laws offer sufficient asylum against predators of other men's ideas; because we believe that S 776 will release a plague of lawsuits on business, which will involve retailers; because we believe that unworthy but well-financed registrants will stop others from profiting from *their* enterprise; because we believe that our standard of living would be seriously lowered and multi-billion industries shrunk to fractions of their size with consequent disastrous effect on our economy; and finally, because in the field of ideas most ideas are derivative, the National Retail Merchants Association urges that S 776 not pass.
- 10 First may we address ourselves to the subject of ideas and their creation. Charles Darwin is credited with being the father of the idea of natural evolution of life on earth. Yet a year before Darwin was to publish his inquiry, clear around the globe, on an island thousands of miles away, the same idea occurred to Alfred Russell Wallace.
- 11 Picasso is acknowledged the father of Cubism. Yet Braque at almost the same time was painting thoroughly cubistic pictures.
- 12 Galileo in Italy and Kepler in Germany independently arrived at the same theory of the motion of the stars.
- 13 The history of civilization can furnish additional examples of what seem like the simultaneous and spontaneous generation of the same idea to two people working independently of each other.
- 14 Still further reading of civilization's story will show, however, that ideas don't spring full-grown into men's minds. They have "fathers", precursors. The ideas are the result of responses to "influences". The minds see gaps and seek to fill them. A book, a man, a thing,

- a voyage, a social or economic condition, strikes a spark and the idea is born.
- 15 Darwin didn't invent his theory of the origin of species. It had been foreshadowed to a large degree by naturalists before him.
 - 16 Cezanne, and Picasso's trip to Africa, were Picasso's "fathers".
 - 17 Copernicus was Galileo's and Kepler's "father", and Copernicus' father might be Aristotle.
 - 18 Similarly, the millions of ideas generated daily by men and women the world over have the same kind of birth. (sic) Their knowledge of the past, their interaction with their colleagues, a competitive threat, a magazine article—whatever it might be—lights up a spark in their minds and a new idea is born. This process is especially true in art as in textiles, in literature as in women's ready to wear, in music as in housewares.
 - 19 Should not these ideators profit from their creations? They should if they are patentable or copy-rightable. They should if they can have the freedom of the market place in which to establish that right. They have that freedom now.
 - 20 S 776 would restrict that freedom. It would give one person the right to clear all competitors from the market place. It would make monopoly legal. It would bury the courts under the burden of countless suits. Our retailers would be involved, for there is not a category of merchandise in our stores which is not open to possible suit because of the ideational process by which practically every item we carry is evolved.
 - 21 S 776 will have drastic consequences in women's apparel. Here fashion ideas are in constant development. Fashion cycles regularly recur. Industry adapts them to current wants. Fashion museums are favorite sources for fresh ideas.
 - 22 How would the courts decide the originator of a "look" when the "look" is itself recurrent? In fashion if you live long enough the modes of your youth overtake your age. Is that manufacturer, the owner who first gets to the registry office? (sic) Owning menas (sic) having the right to stop everybody else in his industry from bringing out the same idea.
 23. The "couture" manufacturers favor this bill. On what basis could they register their designs as against one another when trends in

- fashion are much the same for all, and all lines tend pretty much to look alike?
- 24 How would the courts decide whose was the original and whose the copy, when all designers great and not great—and we have designers equal to the best of France—are nevertheless subject to the same “influences”?
 - 25 The bill proscribes “copying”. Suppose one manufacturer saw another’s garment and it “gave him an idea”. The idea resulted in a garment made of a different fabric, of a different texture, the collar line changed, decoration added, and the cost, two rungs over or under the “original”. Suppose suit were brought. How could the courts decide which was the original and which the copy?
 - 26 This type of creativity occurs over and over again in the ready to wear industry. The ideational process is much the same in other industries. Should we suppress it once S 776 is passed?
 - 27 This bill is aimed at the “knock-off artist”. Let’s assume a “knock-off” is made. The “knock off” is identical in most respects to the original it copied. But the copy has a better quality of fabric. It has more costly trimming. It is cut fuller. It is (sic) a copy if it adds that “degree of individuality” which the late U.S. District Court Judge Alexander Bicks, in deciding the case of Trifari vs. Charel, considered the measuring stick for newness?
 - 28 S 776 grants registration to the person who can declare he did not copy his idea. Suppose a closely similar idea occurred at the same time to another (Darwin-Wallace, Picasso-Braque)? It is (sic) equitable that the first to register should have the power to make the second drop his idea or face suit?
 - 29 Styles, “periods”, recur. Assume the Empire style returns. It is in the public domain. No one may register it for his own. But several add “some degree of individuality” to the design. Presumably this makes it registrable. Should the first one to get his certificate be able to stop all the others who may impart notable “degree of individuality”?
 - 30 Small manufacturers depend in substantial part on store buyers for designer ideas. Buyers scour the consumer magazines and trade press for ideas. They want exclusives in order to profitably compete. They describe their ideas to the small manufacturer. He makes up the garments.

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- 31 Under S 776 the store may be sued if a so-called "owner" of the registration believes his design has been copied. The store is involved because the proponents of the bill have inserted the "inducement" clause. The store "induced" the violation, hence is culpable.
- 32 Such suits would tie our stores into knots. Giant firms, by constant litigation, could harry smaller firms out of business.
- 33 The argument is made that it takes too long under the patent law to determine the originality of an idea. The "originators" of these "new" ideas want faster action. Hence S 776.
- 34 Why shouldn't the convinced "originators" seek protection under the copyright law? Right now a number of items of apparel are protected under this law—items popularized on TV and by a film star. Attempts to "knock" these off were met by suits. Genuine ideas are protectable. S 776 would make the doubtful, protectable.
- 35 We say again: there are sufficient present protections for the true innovator. S 776 is wholly unnecessary.
- 36 How does fashion operate in this country? It starts at the top—at the highest level of price—and percolates down in one season or two. Because of this the American woman is the best dressed in the world. Because of this the American woman pays less for her apparel. And this method of operation has made the women's apparel business the multi-billion business it is.
- 37 Were the so-called originators, under S 776, able to keep for themselves the ideas which are themselves derivative, the mass popularization of women's styles would virtually cease. Especially would this be felt in low and popular priced merchandise.
- 38 There would be two classes of women: the small band, affluent enough to afford the high prices the "owners" impose, and the rest of our women, unable to afford them. We'd have "haves" and "have nots". We'd have women in current styles and women in dated clothes. We'd have first class and second class citizens.
- 39 To avoid this the "owners", we're told, would downgrade their own styles in the course of the season, as many do now. They would bring out lower-priced versions. This is what the present unfettered market now does and quickly.
- 40 The "owners" would be less swift because they'd wish to "milk" their designs as long as possible, and only at the tail end of the

season would they arrange their own "knock offs". Also, if they did so earlier they might offend their higher-paying customers who wouldn't wish to meet themselves on the street.

- 41 Is a business man a "pirate" who follows a trend? This holds for all business, not only ready to wear. The first one out with a wanted product gets the fruits of his enterprise. It is common practice in all businesses not to let a competitor beat you to an idea.
- 42 Frequently your version is an improvement on the first. Not to be able to do this is to run the risk of being out of business. Frequently the versions are at a lower price because of technological breakthroughs. The customer gets the "break".
- 43 Under S 776 the "owner" would maintain his prices. His quality would not be improved. The item would not get the wide distribution which active competition accomplishes.
- 44 The proponents of the bill declare that under it prices would be lower. Monopoly has never resulted in lower prices and monopoly has been last to introudce (sic) technological innovations that result in lower prices. S 776 would create unjustifiable monopolies.
- 45 We have pointed out that ideas are derivative; that genuine breakthroughs are either patentable or copyrightable; that S 776 would give unearned property rights to undeserving people; that this would result in thousands of law suits involving items in practically every category department and specialty stores buy in: that under this bill "ownership" of an idea would freeze out all competition, hence prices to the customer would be higher; that the bill is contrary to the accustomed practice in all businesses. For these reasons we urge that S 776 not pass.

William Burston
Manager
Merchandising Division
NRMA

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. UNITED STATES OF AMERICA AND TERRITORIES

277. U. S. CONGRESS. HOUSE.

H.R. 8664. A bill to implement the Agreement on the Importation of Educational, Scientific, and Cultural Materials, opened for signature at Lake Success on November 22, 1950, and for other purposes. Introduced by Mr. Mills, June 1, 1965, and referred to the Committee on Ways and Means. 14 p. (89th Cong., 1st Sess.)

A bill to implement the so-called "Florence Agreement." Somewhat similar to H.R. 2537 and H.R. 12821, introduced during the 87th Congress. See 10 BULL. CR. SOC. 42, Item 8 (1962).

278. U. S. CONGRESS. HOUSE.

Cleveland, James C. New Hampshire General Court urges U. S. copyright law changes; extension of remarks. (111 *Congressional Record* no. 137, p. A4176, daily ed., July 28, 1965.)

An insertion in the *Record*, by Congressman Cleveland of New Hampshire, of a copy of a concurrent resolution adopted by his State legislative body calling upon Congress for a revision of the copyright laws to provide better protection for creators. In addition, under unanimous consent, is included "a versification of the problem authored by the Honorable Margaret DeLude . . . one of the principal sponsors of the resolution in the New Hampshire House of Representatives."

279. U. S. CONGRESS. SENATE.

S. 2068. A bill to provide injunctive relief from activities which dilute the distinctive quality of a trademark or trade name or which otherwise constitute unfair commercial activities. Introduced by Mr. Javits, June 2, 1965, and referred to the Committee on the Judiciary. 5 p. (89th Cong., 1st Sess.)

A companion bill to H.R. 5514, introduced by Mr. Lindsay earlier in the same session. See 12 BULL. CR. SOC. 231, Item 164 (1965).

2. FOREIGN NATIONS

280. DENMARK. *Laws, statutes, etc.*

Ordinance amending the Decree on the application of the Law on Copyright in Literary and Artistic Works and the Law on Rights in Photographic Pictures with respect to foreign countries, of November 18, 1963. (1 *Copyright* 78-79, no. 4, Apr. 1965.)

An ordinance implementing Section 60 of the Danish Law on Copyright in Literary and Artistic Works of May 31, 1961, and Section 20 of the Danish Law on Rights in Photographic Pictures of May 31, 1961, as regards the application of these acts in relation to member countries of the Berne and the Universal Copyright Conventions, and of the European Agreement on the Protection of Television Broadcasts.

281. RUSSIA (1917- R.S.F.S.R.). *Laws, statutes, etc.*

Bürgerliches Gesetzbuch der Russischen Sozialistischen Föderativen Sowjetrepublik vom 11. Juni 1964. Abschnitt IV: Urheberrecht. (43 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 122-133, no. 1/2/3/4, Dec. 15, 1964.)

A German translation, by Karel Knap, of the new copyright law of the Russian Socialist Federated Soviet Republic (R.S.F.S.R.), which entered into force on October 1, 1964 as part IV of the Civil Code of June 11, 1964.

282. UGANDA. *Laws, statutes, etc.*

Loi sur le droit d'auteur (du 22 juin 1964). (45 *Revue Internationale du Droit d'Auteur* 214-224, Jan. 1965.)

The French text of the Uganda copyright statute of June 22, 1964.

283. ZAMBIA. *Laws, statutes, etc.*

The Copyright Act, 1965 (No. 14 of 1965). (1 *Copyright* 107-111, no. 5, May 1965.)

The text of the new Zambian copyright law which came into force on March 1, 1965.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

284. INTERNATIONAL COPYRIGHT RELATIONS OF THE U.S.A.

Listed below are the countries with which the United States has international copyright relations as of January 1, 1965. The first column lists the countries that have ratified or acceded to the Universal Copyright Convention of 1952 (the U. C. C.). The countries in the second column are parties to the Buenos Aires Convention of 1910, which is one of the Pan-American Copyright Conventions. In the third column are countries with which the United States has bilateral copyright relations by virtue of a proclamation or treaty.

1. <i>U. C. C.</i>	2. <i>Buenos Aires Convention</i>	3. <i>Bilateral Relations</i>
Andorra		
Argentina	Argentina	Argentina Australia Austria Belgium
Austria		
Belgium		
	Bolivia	
Brazil	Brazil	Brazil
Cambodia		
Canada		Canada
Chile	Chile	Chile China
	Colombia	
Costa Rica	Costa Rica	Costa Rica
Cuba		Cuba
Czechoslovakia		Czechoslovakia
Denmark		Denmark
	Dominican Republic	
Ecuador	Ecuador	
		El Salvador*
Finland		Finland

* By virtue of Mexico City Convention, 1902.

1. <i>U. C. C.</i>	2. <i>Buenos Aires Convention</i>	3. <i>Bilateral Relations</i>
France		France
Germany (Federal Republic)		Germany
Ghana		
Greece		Greece
Guatemala	Guatemala	
Haiti	Haiti	
Holy See		
	Honduras	
		Hungary
Iceland		
India		India
Ireland		Ireland
Israel		Israel
Italy		Italy
Japan		
Laos		
Lebanon		
Liberia		
Liechtenstein		
Luxembourg		Luxembourg
Mexico	Mexico	Mexico
Monaco		Monaco
		Netherlands
New Zealand		New Zealand
Nicaragua	Nicaragua	
Nigeria		
Norway		Norway
Pakistan		
Panama	Panama	
Paraguay	Paraguay	
Peru	Peru	
Philippines**		Philippines

** UNESCO has advised the U. S. Government that on November 14, 1955, a letter was received from the Philippine Minister in Paris stating that the Philippine President had directed the withdrawal of the instrument of accession prior to November 19, 1955, the date on which the Convention would become effective in respect of the Philippines. No determination has been made as to the legal effect of this communication.

1. *U. C. C.*

Portugal

Spain

Sweden

Switzerland

United Kingdom

United States
of America

Zambia

2. *Buenos Aires
Convention*

United States
of America

Uruguay

3. *Bilateral
Relations*

Poland

Portugal

Rumania

South Africa

Spain

Sweden

Switzerland

Thailand

United Kingdom

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

285. *Kurlan v. Commissioner*, 343 F.2d 625, 145 U.S.P.Q. 106 (2d Cir., Mar. 26, 1965) (Friendly, J.)

Petition for review of a decision of the Tax Court, T.C. Memo 1963-282, in which it was held that the proceeds of the settlement of a lawsuit against Columbia Broadcasting System for misappropriation of ideas was income from "a copyright, a literary, musical, or artistic composition, or similar property, held by—(A) a taxpayer whose personal effort created such property . . ." and, thus, was ordinary income rather than a capital gain. The taxpayer alleged that the C.B.S. television show, "My Friend Irma," incorporated or was copied from much of the material contained in a demonstration recording, submitted by him to C.B.S., of a proposed radio show to be based on "My Sister Eileen." The Supreme Court of California held (*Kurlan v. Columbia Broadcasting System*, 40 Cal.2d 799, 256 P.2d 962, 97 U.S.P.Q. 556 (1953)) that Ruth McKenney's rights in the literary property ("My Sister Eileen") as recognized by §980 of the California Civil Code had been lost by publication, and that Kurlan's contributions by way of literary expression and development of minor characters had not been copied, but that the demurrer in the case could not be sustained because there was a possibility of some recovery for violation of Kurlan's rights to his allegedly original methods of presentation and format. The case was then settled, and Kurlan and McKenney released all claims, whether for violations of literary property infringement of copyright, or in contract, from Columbia Broadcasting System's past or future production of "My Friend Irma."

Held, affirmed on other grounds.

The court held that while the Tax Court had correctly regarded the decision of the California Court as determinative of the issues there decided, and that Kurlan's format or method of presentation falls within §1221 (3) (A), the Court had not taken into account claims, included

in the settlement, which were not pleaded in the action and that such additional claims might involve literary property which did not derive from taxpayer's personal efforts. The court said:

. . . . But the California decision, made on a demurrer, was an authoritative determination only as to those claims which Kurlan had pleaded in the California action, not as to what he had but did not plead.

What Kurlan may well have had in addition were infringement claims to vindicate the radio and television rights secured by McKenney's federal copyright. It is immaterial whether Kurlan's attorney omitted these claims in the California complaint because he lacked faith in them or because he feared that they were outside state court jurisdiction Although the federal copyright did not confer a monopoly of the pretty-but-dumb and plain-but-bright combination, which was in the public domain, CBS' presentation may have approached the McKenney characters and their development so closely as to have infringed. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 7 USPQ 84 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931). CBS evidently thought so; its lawyers insisted on a broad release of all claims for infringement, in which McKenney joined. Kurlan's partial interest in McKenney's copyright was not itself created by his "personal efforts" within §1221 (3) (A) Section 1221 (3) (A) thus would not bar capital gain treatment for so much of the settlement as related to this interest.

The court went on to hold, however, that despite the foregoing, the settlement did not qualify for capital gains treatment because it was, in effect, a royalty payment, rather than the proceeds of a sale or transfer. The court said:

. . . . Kurlan failed to make out another element essential to capital gain treatment, namely, that the gain was on a "sale or exchange" or "from the compulsory or involuntary conversion" of "property used in a trade or business." Internal Revenue Code of 1954, §1231 (a). In *C.I.R. v. Ferrer*, 304 F.2d 125, 130-133 (2d Cir. 1962), after reviewing the cases on "sale or exchange," we approved decisions which refused to deny such recognition to what amounted to a conveyance of a lesser estate simply because this was to the holder of a larger one who wanted to get rid of the lesser interest rather than to a stranger who wished to use it, the fact that the transfer was thus couched in language of surrender or cancellation rather than of sale thus not being fatal. But that does not go far

enough to cover the transaction here. The settlement did not convey to CBS any interest in the copyright; Kurlan and McKenney simply released claims for past infringement and allowed similar future radio or television use of CBS, retaining their rights against all others. The collapsing of claims to past and future royalties into a lump sum payment does not render the transaction a sale . . . Although the Commissioner has been driven back in his battle against capital gain treatment for transfer of anything less than the whole copyright, and the grant of exclusive licenses in one geographic area or in one entertainment medium may give rise to capital gain . . . the tide has not gone so far as to include within "sale or exchange" the transfer of a non-exclusive right to copy, even though this be valuable and for the entire life of the copyright and in return for a lump sum . . .

286. *Davis v. E.I. duPont de Nemours & Co.*, 145 U.S.P.Q. 258 (S.D. N.Y, Apr. 16, 1965) (Feinberg, J.)

Action for copyright infringement. Plaintiff, Donald Davis, charged that defendants' television production, "Ethan Frome," infringed copyright in a play also based on Edith Wharton's novel, written by plaintiff's father, Owen Davis, and himself. With the permission of Wharton, Lowell Barrington wrote a play based on the novel. Wharton was dissatisfied with this play, which was never produced, and in December, 1934, Wharton and Barrington entered into an agreement with the Davises whereby the Davises acquired the exclusive right to dramatize the work and the right to use such portions of the Barrington play as they wished, and whereby the resulting Davis play became an "entity" owned in stated shares by the Davises, Wharton and Barrington and was copyrighted in the name of the Davises. Wharton died in 1937 and her executors renewed the copyright in the novel in 1939. In 1942, Wharton's literary heir, Elisina Tyler, the Davises, Barrington and others entered into an agreement with Warner Bros. Pictures, Inc. whereby Warner Bros. obtained the right to make a motion picture based on the novel, the Barrington play and the Davis play. Warner Bros. Pictures, Inc. acquired the right to show the motion picture on television, but did not obtain any other television rights. Helen Deutsch wrote a screenplay for Warner Bros. but no motion picture was produced. In 1958, Warner Bros.' rights were conveyed to Columbia Pictures Corporation. Owen Davis died in 1956, and plaintiff Donald Davis became his father's executor. David Susskind and Talent Associates, Ltd., having failed to obtain television rights to the Davis play from Donald Davis, proceeded to produce a television version of "Ethan

Frome" on the basis of rights obtained from Elisina Taylor and Columbia whereby it obtained, respectively, permission to use the novel and the Deutsch screenplay. Plaintiff charged that the television version incorporated material from the Davis play, and brought this action against the sponsor, the sponsor's advertising agency, the authors of the teleplay and the network.

Held, judgment for plaintiff.

I. Plaintiff contended that the teleplay was based on the Deutsch screenplay, which was in turn based on the Davis play, and that as a result, the teleplay included much of the original copyrighted material in the Davis play. Plaintiff conceded that a teleplay based entirely on the novel would have been proper. Defendants argued that to the extent that their teleplay incorporated, through the Deutsch screenplay, material from the Davis play, such material was derived in turn from the Barrington play, in which Davis did not have exclusive rights. The court held, however, that, working from the screenplay, the authors of the teleplay incorporated considerable portions of the Davis play, which portions had been original with the Davises. The court said:

Proof of copying here is complicated by two factors: four different media of expression are involved (the novel, the theater, moving pictures and television), and the claimed copying is primarily secondhand, not direct. Plaintiff seeks to prove that the allegedly infringing television script was copied from the Deutsch screenplay which, in turn, was copied from the Davis play.

Examining the first step, it is virtually uncontroverted that defendants' teleplay was copied from the Deutsch screenplay. Babin and Gellen testified that they proceeded with the adaptation by writing on the face of the copy of the Deutsch screenplay obtained by Susskind. . . .

That Talent copied from the Deutsch screenplay is of only academic interest unless Miss Deutsch copied from the Davis play. . . . The 1942 contract which gave Warner Bros. permission to make "Ethan Frome" into a movie acknowledges receipt by Warner Bros. of the Barrington play and the Davis play. . . . I find that Miss Deutsch had access to the Davis play.

A comparison of the Davis play with the Deutsch screenplay clearly supports a finding of copying. Limitations of space preclude a listing of all of the many similarities between the two works. . . . It is true that the screenplay does differ from the Davis play by the addition of several scenes and emphasis on the

romantic side of Mrs. Wharton's novel. Other changes can be traced to the difference in media. However, but for these differences, the works are quite similar. The similarities, along with the evidence of access, justify a finding that Deutsch copied from the Davis play and incorporated substantial portions of it in her work. . . .

As indicated above, the bulk of the Deutsch screenplay found its way into the telecast, and this included the significant portions of the Davis play used by Deutsch. . . . Accordingly, I find that the 1960 telecast was copied from the Davis play.

II. The court also held that the efforts of defendants to "un-Davis" the television script by introducing changes before the television show was broadcast were insufficient to disturb the finding of copying, since the changes amounted, in most cases, to no more than paraphrasing the original script, and paraphrasing is still copying. The court said:

" . . . The labors of Misses Babbitt and Gellen to take Davis out of the television show . . . were too little, too late and too transparent. In almost every instance, their "changes" amounted to mere paraphrasing, inversion of dialogue, or substitution of one significant object for another. But paraphrasing is tantamount to copying in copyright law.

III. The Davis play was registered as an unpublished work in December, 1934, and was published in 1936. The copyright notice read as follows:

Copyright, 1911, 1922, 1936 by

CHARLES SCRIBNER'S SONS

—————
Copyright, 1935, By

Owen and Donald Davis

Defendants argued that because the copyright date erroneously read "1935" instead of the proper date, 1934, the copyright in the play was forfeited. The court held, however, that under the modern liberal judicial attitude toward errors in copyright notices, and since there had been no prejudicial reliance by defendants on the erroneous notice, the defect was not fatal. The court said:

The error here was one of twenty-seven days, since the registration of the unpublished work fell short of occurring in 1935 only by the small period. . . .

Strict construction of the requirement that the year of publication be stated has been commonly regarded as stemming from an 1848 case, *Baker v. Taylor*. . . . In recent times, the rule illustrated by *Baker v. Taylor*—that the copyright notice must accurately reflect all required information—has been the basis of many lower court rulings invalidating copyrights in which the notice insufficiently identified the copyright proprietor. Moreover, opinions have continued to indicate that the law is that a notice containing a year later than the actual date of copyright invalidates the copyright, although such statements do not appear to be holdings. On the other hand, there are a number of decisions holding harmless the error of using in the notice a year earlier than the actual copyright date. The basis for disregarding this discrepancy is that the error is in favor of the public; since the period of duration of the copyright is deemed to commence with the notice date, the copyright period is diminished by the error.

A liberal attitude has been evident in recent cases dealing with dating errors in the application for a certificate of copyright . . . *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F.2d 706 (6th Cir. 1956), cert. denied, 353 U.S. 949 (1957)

Recent decisions in this circuit have generally reflected the view that "the purpose of a copyright notice is to prevent innocent persons who are unaware of the existence of the copyright from incurring the penalties of infringers by making use of the copyrighted work." *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406, 409 (2d Cir. 1946), cert. denied, 331 U.S. 820 (1947); see *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594, 602 (2d Cir. 1951), opinion clarified, 198 F.2d 927 (2d Cir. 1952); *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (2d Cir. 1934), cert. denied, 294 U.S. 717 (1935). Under this guideline, the courts have been liberal in overlooking defects in the copyright notice when it is obvious that the proprietor has substantially, and in good faith, complied with the statutory requirements, and this defendant has not relied to his prejudice on the notice as it appears on the copyrighted work. *B. & B. Auto Supply, Inc. v. Plessner*, 205 F.Supp. 36 (S.D.N.Y. 1962); *Trifari, Krussman & Fishel, Inc. v. B. Steinberg-Kaslo Co.*, 144 F.Supp. 577 (S.D.N.Y. 1956) In addition, the Copyright Office regulations have reflected a similar relaxing of requirements. Reversing an earlier position that a variance in the notice date was fatal, the Office has recently expressed the opinion that "if the copyright was actually secured not more than one year earlier than the year date

in the notice, registration may be considered as a doubtful case." 37 C.F.R. 202.2 (b) (1960).

Consistent with the liberal philosophy in recent cases in this circuit and in others, I hold that on the facts of this case, in the absence of any suggestion of prejudicial reliance, the variance of twenty-seven days between the copyright date (December 5, 1935) and the notice date (1935) does not invalidate plaintiff's copyright. There is no indication that plaintiff or his publisher used the later date to attempt to extend unlawfully the initial period of copyright. . . . Plaintiff has advanced an alternative ground for sustaining the copyright despite the error in the notice, based on the decisions in *Wrench v. Universal Pictures Co.*, 104 F.Supp. 374 (S.D.N.Y. 1952) and *Harris v. Miller*, 50 U.S.P.Q. 306 (S.D.N.Y. 1941). Briefly, he argues that since the differences in the 1934 unpublished and the 1936 published versions of the play qualify the latter as a "new work", the inclusion of 1935 in the copyright notice was mere surplusage and has no legal effect. . . . However, in view of the previous discussion upholding the copyright notwithstanding the inclusion of 1935 in the notice, it is not necessary to deal with this argument.

IV. The court also held that sponsors and advertising agencies who have some power of supervision with respect to an infringing television show, as the court found duPont and Batten, Barton, Durstine & Osborn, Inc. to have in this case, can be held liable, along with the producers, for infringements. The court quoted *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304 (2d Cir. 1963), as follows:

"When the right and ability to supervise coalesce with an obvious and direct financial interest in the exploitation of copyrighted materials—even in the absence of actual knowledge that the copyright monopoly is being impaired . . . —the purposes of copyright law may be best effectuated by the imposition of liability upon the beneficiary of that exploitation."

287. *H.M. Kolbe Co., Inc. v. Shaff*, 145 U.S.P.Q. 77 (E.D.N.Y., Mar. 22, 1965) (Levet, J.)

Action for copyright infringement. Plaintiff, who had recovered a judgment against Happy Cottons, Inc. for infringement in a textile design, *H.M. Kolbe v. Armigus Textile Co., Inc.*, 135 U.S.P.Q. 188, 10 BULL. CR. SOC. 119, Item No. 91 (S.D.N.Y. 1962), affirmed 315 F.2d 70, 137 U.S.P.Q. 9, 10 BULL. CR. SOC. 261, Item No. 287 (2d Cir. 1963), was

unable to obtain satisfaction of the judgment. Plaintiff then brought the present action against Gustave Shaff and Armand Indelicati, officers of Happy Cottons, Inc., for the same infringement. Plaintiff moved for summary judgment.

Held, judgment for plaintiff.

The court held that all those who participate in a copyright infringement, including those officers of a corporate infringer who personally participate in the acts of infringement, are jointly and severally liable. The court also held that a judgment against one or more of the joint tortfeasors did not preclude bringing action for the same infringement against the others if the first judgment had not been satisfied. The court said:

Copyright infringement is a tort. *Turton v. United States*, 212 F.2d 354, 101 USPQ 164 (6th Cir. 1954). All those who participate in an infringement are jointly and severally liable. *Ted Browne Music Co. v. Fowler*, 290 F. 751 (2d Cir. 1923); *Reeve Music Co., Inc. v. Crest Records, Inc.*, 190 F.Supp. 272, 128 USPQ 37 (E.D.N.Y. 1959), modified on other grounds 285 F.2d 546, 128 USPQ 24 (2d Cir. 1960).

Officers or directors of a corporation found guilty of infringement are individually liable if they personally participated in the acts constituting infringement. *Hagemeyer v. Insect-O-Lite Co., Inc.*, 291 F.2d 696, 699, 130 USPQ 186, 189 (6th Cir. 1961); *General Electric Co. v. Wabash Appliance Corp.*, 93 F.2d 671, 674, 36 USPQ 214, 217 (2d Cir. 1938).

The rule that a corporate official is liable personally only where he exceeds his corporate authority was noted in *Claude Neon Lights, Inc. v. American Neon Light Corp.*, 39 F.2d 546, 551, 5 USPQ 347, 350 (2d Cir. 1930). The court, however, limited its application: "A director and officer of a corporation who by a vote or otherwise, specifically commands subordinate agents of a corporation to engage in the manufacture and sale of an infringing article, is liable individually in an action for damages brought for such infringement." An express disavowal of the rule limiting the personal liability of corporate officials to acts outside their authority came in *FTC v. Standard Education Soc.*, 86 F.2d 692 (2d Cir. 1936), mod. on other grounds, 302 U.S. 112 (1937), a decision by Judge Learned Hand.

Another archaic rule limits the personal liability of corporate officers to injunction where they act only within the normal scope of their authority. . . . This rule appears to have been abandoned,

at least where there is personal involvement in the acts of infringement. *Hagemeyer v. Insect-O-Lite Co., Inc.*, supra. . . .

The papers submitted to the court clearly indicate that the defendant Shaff was personally involved in arranging and directing the production of the infringing design. I find that there is no genuine issue as to this fact. Therefore, Shaff was a joint tortfeasor with Cottons.

The fact that one joint tortfeasor has been sued and a judgment rendered does not bar the suit against the remaining joint tortfeasors where the judgment is unsatisfied. E.g., *United States v. Silliman*, 167 F.2d 607 (3d Cir. 1948).

288. *Bourne v. Fouche*, 145 U.S.P.Q. 340 (E.D. S.Car., Mar. 5, 1965) (Wyche, J.)

Action for copyright infringement. Plaintiffs alleged that their copyrights in "San Antonio Rose" and "Mr. Sandman" were infringed by the unauthorized performance of the two songs at the Skyline Club, "a place of business for public entertainment . . ."

Held, judgment for plaintiffs.

Defendants argued that they were not responsible for the infringing performances because the musicians employed by them had played the two compositions without defendants' knowledge or consent, and contrary to instructions not to play ASCAP music, and because the musicians were independent contractors. The court held, however, that one who employs musicians to give a public performance for profit is liable for any infringements resulting from such performance, whether or not the employer had any knowledge of what musical selections would be played, and regardless of the fact that the musicians were independent contractors. The court said:

The United States Supreme Court has held that one who hires an orchestra is liable even if he does not know or select the particular compositions played. In *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191 (1931), the Court said [at page 198]: "And knowledge of the particular selection to be played or received is immaterial. One who hires an orchestra for a public performance for profit is not relieved from a charge of infringement merely because he does not select the particular program to be played."

Judge Ernest F. Cochran held in *M. Witmark & Sons v. Pastime Amusement Co.* (E.D.S.C. 1924), (affirmed, 2 F.2d 1020 (CA 4,

1924)) that it is no defense that a musician is an independent contractor . . .

* * *

Plaintiffs are, therefore, entitled to injunction and statutory minimum damages of Two Hundred Fifty Dollars each . . . and the costs of this action; together with attorney's fees in the sum of One Hundred Fifty Dollars, on each count of this complaint.

ALSO OF INTEREST:

289. *Triangle Publications, Inc. v. Standard Plastic Products, Inc.*, 145 U.S.P.Q. 332 (E.D. Pa., Mar. 31, 1965) (Van Dusen, J.)

Action for unfair competition. Plaintiff, publisher of "Seventeen" Magazine, charged that defendant's use of the name "Miss Seventeen", for plastic luggage and stationery items directed toward the juvenile and teen-age feminine market, constituted unfair competition. Plaintiff sought an injunction restraining defendant from infringing the "Seventeen" trademark.

Held, preliminary injunction granted.

The court held that defendant's "Miss Seventeen" trademark infringed plaintiff's trademark in view of the fact that defendant had not only used the word "Seventeen" (which the court described as a "weak" mark) but had also copied the distinctive lower-case script in which the "Seventeen" name has always appeared, and had copied photographs from the magazine.

290. *In re Mogen David Wine Corp.*, 145 U.S.P.Q. 85 (Patent Office Trial & Appeal Board, Feb. 4, 1965) (Lefkowitz, Member.)

The Board upheld a refusal to register the appearance of the Mogen David wine decanter, as a trademark, on the Principal Register, on the ground that it was "a nondistinctive container for the goods" which had not acquired a secondary meaning.

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