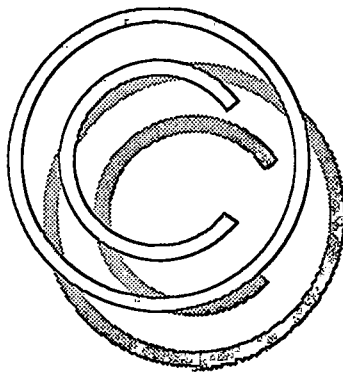


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## PART I.

## ARTICLES

## 1. LA CAISSE NATIONALE DES LETTRES

*The French National Literary Fund*

By JULES MARC BAUDEL\*

Almost all states now have copyright laws in order to enable authors to profit from their writings. But some go even further. France, for instance, has adopted a system of direct subsidies to literature administered by the "Caisse Nationale des Lettres," a national literary fund. The Caisse reflects an historic tradition in France. During the Ancien Regime, a Royal Literary Fund was established to provide salaries for the authors writing about the reign of the King; Corneille, Racine and Boileau were on the list of beneficiaries, as well as many others who are now forgotten. The Revolutionaries of 1789 abolished the Fund, but the idea survived. Fouché, the powerful minister of Napoleon's police, tried to reestablish the fund. Romantics Lamartine and Victor Hugo considered the idea, proposing to finance a Fund by collecting royalties on works in the public domain. With such a fund, a solidarity between the literary quick and dead would be created.<sup>1</sup> During the Second World War a plan to create two parallel organizations was born in the Resistance: the first organization would be for supporting scientists, the Centre National de la Recherche Scientifique; the second one would support and encourage literary activity, the Caisse Nationale des Lettres. After the war the Caisse was formally created by a law of October 11th 1946<sup>2</sup> voted unanimously by the Second Assemblée Constituante. The

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\* M.Comp.L., The University of Chicago; License, University of Paris.

*Ed. Note:* The Society is pleased to publish this study on a subject of which very little is known and which is frequently misunderstood in the United States. Attention of the reader is called to the excellent recent article by Monroe E. Price, entitled "Government Policy and Economic Security for Artists: The Case of the *droit de suite*," 77 Yale L.J. 1333-1366 (June 1968), 15 BULL. CR. Soc. 422 (August 1968).

1. See generally, Vaunois, *Le Domain Public Payant*, 61 *Le Droit d'Auteur* 111 (1948).
2. Loi No. 46-2196, *Journal Officiel*, Oct. 12, 1946. The bill was introduced before the Second Constitutional Assembly by Mr. Deveze and reported upon by Mr. Deixonne on behalf of the Commission for National Educa-

objectives of the law were to help authors writing in French and publishers of significant literary works. Furthermore, the Fund was given the power to protect literary works of any period and any national origin by the extension to it of the moral right of authors.

But the law did not solve the crucial problem: how to finance the Fund. The financing of the organization was to be met by a tax of 5 per cent on the turnover of the publishing companies and on the author's royalties. But the law was not carried out by the executive because of the opposition of those subject to the tax, the very persons who were its intended beneficiaries. Because of this strong opposition the Executive, extremely weak in 1946<sup>3</sup> due to internal discord, failed to act to implement the law. Laws in France are promulgated in very general terms and require executive action in the form of executive orders to give them practical effect. The Executive did not issue the executive order necessary for the implementation of the law.

But as early as February 1947, Mrs. Rachel Lempereur, a deputy of the Socialist party, and Mr. Deixonne, who reported the law creating the Caisse, introduced a bill to amend this law to provide for a new method of financing the Caisse, namely a paying public domain, the idea suggested by the Romantics.

On February 13, 1948, the Assemblée Nationale discussed the matter and unanimously passed the amendment.<sup>4</sup> The Fund was to be financed by a tax of 6 per cent on the selling price of books in the public domain with the exception of school books, scholarly books and devotional books. The bill came in front of the Conseil de la République and was defeated unanimously.<sup>5</sup> It was defeated because the Conseil de la République thought that this amendment was not financially efficient with its exemption. The Conseil felt that because the public domain generally begins fifty years after the death of the author, very few books will be profitable; secondly, when a book is published such a long time after the author's death, it is very often a scholarly or school book. Furthermore, the paying domain is not desirable because the authors in

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tion. The text of the proposed law adopted the conclusions of a special commission which had been established in 1945 by the Minister of National Education.

3. The volume of statutes enacted in 1946 was extraordinarily high and the Executive was short of time. Moreover the opposition of the taxpayer-beneficiaries was so strong that enforcement of the tax would have been difficult. Opposition to the measure from the Communists within the government coalition also served to weaken it.
4. Loi No. 48-122.
5. Discussion on the bill published in the *Journal Officiel, Debats Parlementaire, Conseil de la République*, May 14, 1948.

the public domain are often the best ones; the public domain would be a tax paid by the reader of good literature and would be unfair, if not unjust. The Conseil de la Republique then proposed a tax of 2 per cent on the turnover of publishers. The Assemblée Nationale refused to pass this modification and proposed another system.<sup>6</sup> Then for eight years the revision bill came before the two houses without compromise or passage. At last, a definitive text dealing with the problem of financing was adopted on the eighth of February 1956<sup>7</sup> by the Conseil de la Republique. The text amends the law of 1946 by providing for mixed financing: there was an extension of the copyright period for an additional 15 years with all revenues to be used for the benefit of the Fund, authors' and publishers' assessments, and a subsidy by the State. Other resources could be authorized by the executive power such as the acceptance of donations. This text was promulgated and became law on February 25, 1956.

The law was implemented by two "decrets" establishing the fund on the 19th of November, 1956<sup>8</sup> and the 30th of March, 1957,<sup>9</sup> so that the Fund could commence in 1957. The Fund is now 10 years old; and it is possible to study the way it has worked.

*A purpose of the Fund: to help publication.*

It is unfortunately obvious that works which are financially the most rewarding are often not the most intellectually distinguished. Publishers hesitate to publish a cultural work that only a few initiate readers can buy and understand. Furthermore the French language market for books is small in comparison with the English market which includes the United States, England and the Commonwealth. So, in the nineteen fifties, there was concern because the number of publications of French classic authors, particularly in an edition of their complete works, was thought to be in decline. The reason was that a publisher could not

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6. In 1948, according to the Constitution of the Fourth Republic, a bill voted by the Assemblée Nationale in order to become law had simply to be examined by the second House, the Conseil de la Republique. Upon rejection by the Conseil de la Republique of the paying public domain bill, the Assemblée Nationale adopted another system of financing and the bill had again to be presented to the Conseil de la Republique. Meanwhile, a new interpretation of the Constitution made it necessary not only for the Conseil de la Republique to examine the bill but for the Conseil to vote on and pass the new text in the identical terms in which it was presented to it. And for this reason it took eight years for the text to be adopted.

7. Loi No. 56-202, Journal Officiel, Feb. 26, 1956.

8. Decree No. 56-1215, Journal Officiel, Nov. 30, 1956.

9. Decree No. 57-409, Journal Officiel, March 31, 1957.

recover the cost of such editions because there was insufficient demand. To republish editions of many books which were no longer available in bookstores and libraries was necessary to preserve and perpetuate the tradition of French letters. The lack of such books concerned not only scholars but also students of high schools and colleges. For instance when the writer of this article prepared his "baccalaureat,"<sup>10</sup> he studied the philosophers of the XVIII<sup>o</sup> Century and the importance of their ideas for European political movements. For such a study, the correspondence of Voltaire was necessary since he corresponded with many writers and politicians all over Europe. This correspondence was not available in the library of any school. There were only short and incomplete editions which were insufficient.

One of the aims of the Caisse Nationale des Lettres is to make the publication of such works commercially feasible. Several examples of the difficulties of publishing such works in 1947 and 1948 were discussed by the Conseil de la Republique in May 1948 and illustrate the types of works involved. The "Association Guillaume Bude" is an association of scholars. It publishes at an inexpensive price Greek and Latin classics with French translation and critiques. It could hardly collect enough money for their publication in spite of the important market composed of teachers, professors and students. Another example: the College de France, a France high level college, wanted to publish a lexicon of low grecism, written by Du Cange. This lexicon was essential to scholars in Greek civilization and could be found only in a few libraries in Europe because the latest edition, published in the XIX<sup>o</sup> Century, was out of print. A publisher was finally found, but it would have been easier if, at that time, the Fund had been able to help. A "Corpus General" of the French philosophers was published only after a great delay because of lack of money to invest in it. A great many works, very important in French literature, could not be published because the time to sell out an edition would be too long to recover the initial investment. Some critical editions, and scholarly works such as the correspondence of Sainte-Beuve, were not published for the same reason.

The "Caisse Nationale des Lettres" makes the publication of such works feasible by granting loans without interest to publishers. These loans are granted for a period which cannot exceed ten years. Payments are correlated with the sales of the book published with Fund help. If sales are good, the loan is repaid rapidly. If sales are poor, the publisher has ten years to repay the loan without interest. The time is long

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10. The "baccalaureat" is the French examination which permits a student to enter university. Its level is about the same as the level of the end of the second year of an American college.



enough to enable the publisher to repay the loan. And because the speed of repayment is related to sales, the risk of a slump in sales of the edition is taken almost entirely by the Fund.

This system of loans means that the Fund can support more editions with its resources than it could under a system of outright grants. The publisher is almost always able to repay the loan from sales of the edition because although the market for such books is small, it is steady and the publisher can be fairly certain that it will be sold out during the ten year period.

To get a loan, a publisher must at first submit an estimate of the cost of the work to be published. This estimate is submitted with the manuscript and the request is presented to a referee who is a member of the Committee of Direction of the Fund who examines the merits and the conditions of publication. This committee makes the decision to accept or to refuse a loan, considering above all the cultural interest of the work. At the beginning about one out of three applications for a loan was granted. Now, because of the increase in applications, the proportion is less, and selection is more rigorous.

Only a French publishing firm can receive a loan from the Fund. In theory the work may be in a foreign language. Some loans were given for the edition of translated French books in Arabic such as *Le Petit Prince* by Saint-Exupery and *Les Justes* by Camus. Bilingual editions with the original text and its French translation are also eligible. For example, *Faust* by Goethe, *Don Carlos* by Schiller or *Knight Harold* by Byron, or *Experience of Truth*, the autobiography of Ghandi, have been published with a Fund loan.

The Fund has now granted six hundred and thirty six loans.<sup>11</sup> The loans were granted for works so varied as the complete works of Gerard de Nerval, a romantic poet, Renan, a XIX<sup>e</sup> Century philosopher, Blaise Cendrars, a contemporary novelist, and Emile Zola, the well known naturalist novelist. Collections of correspondence have also been published: for instance Voltaire and Mme. de Stael. Critical editions, for instance "Delie" by Maurice Sceve, a Renaissance poet, "*Voyage en Amerique*" by Chateaubriand or the *Salons de 1759, 1761, 1763* by Diderot, have been published. In addition reference works, historical works, artistic works (but no scientific works — they are published with the help of the "Centre National de la Recherche Scientifique"), and critical essays, have been published. For instance the *Nouveau Dictionnaire de la Langue Francaise* published by Robert was supported by a Fund loan.

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11. As of July 1, 1967.

In summary, every literary work which would improve knowledge of art or literature is eligible for a loan from the Caisse Nationale des Lettres. New works, fiction or poetry, are not eligible. The fund uses its loans to assist publication of works or critiques of works already recognized as classic. It stimulates new literary creation in other ways. The Fund gives fellowships to authors — about 130 a year — sometimes grants subsidies to literary magazines, and each year subsidizes the publication of about twenty poetry manuscripts.

The loans made in 1967 will assist publication of works which comprise two thirds of the French editions of scholarly books. Those loans reached in 1967 a total of 3,510,000 francs<sup>12</sup> (about 720,000 dollars), 72.5% of the expenditures of the Fund. The amount of loans planned in 1968 will be about 3,699,403 francs. The 1968 loans will be used for the publication of collections of correspondences: the correspondence of Fenelon, a moralist of the XVII<sup>e</sup> Century, of Balzac and of George Sand, a romantic writer. In addition, for the first time, the loans will be used to support cultural paperback editions with large sales (over 40,000 copies) and a low selling price (under 4 or 5 francs).

The loans of the Fund are now an established institution and almost all French publishing firms consider the possibility of obtaining loans from the Fund before undertaking to publish a scholarly work.

*Another Aim of the Fund: To help authors.*

The Fund provides two kinds of grants: the first go to young writers and the second to older writers in need. Furthermore, a part of the expenditures of the Fund goes to the management of a special system of social security for writers based on the general system with some minor changes.

*The subsidies to the authors:*

Subsidies granted to authors are for the purpose, as it is written in the original law of October 11, 1946, "to support and to encourage the literary activity of French writers or of authors writing in French by fellowships. . . ."

When they begin to write and are unknown, the young writers often have barely enough money to live. A money earning occupation endangers their literary vocation. It is to avoid such situations that the Fund grants fellowships to young writers. These are granted according

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12. These figures are taken from a report of the Caisse to the Cultural Committee of the Senate issued in October 1967.

to permissive legal criteria: to be French is not necessary, the writer need only to write in French. The fellowship is a monthly stipend of 750 francs (about 150 dollars). Its duration varies according to the individual case, each different from the other. Familial position and material needs as well as the quality of works written before are the most important criteria for obtaining a fellowship.

The Committee of Direction decides to allocate or not allocate the Fellowship after a study of the applicants' dossiers. About thirty fellowships are granted every year.

The grantees have a great deal of freedom; but they have to write a book. The fund never asks for a synopsis. Writing is not like technical work. Often it cannot be done regularly. For example, this year, one of the grantees asked for a fellowship and lived on a Greek island. The objective is to enable the author to write, not to make of him a kind of civil servant.

The results are hopeful. Three hundred and nine fellowships have been granted in ten years. There were only six or seven failures. All the other grantees wrote at least a book, usually a novel, but sometimes poetry or an essay. For instance, the Fund gave a fellowship to a then unknown writer Anna Langfuss.<sup>13</sup> The book she wrote won the Prix Goncourt, the prestigious French literary award. Some others were also highly successful and obtained awards such as the "Prix Interallie," the "Prix Femina," the "Prix Max Jacob," etc.<sup>14</sup> When young authors have received such a consecration they are able to continue their work alone.

In addition to these fellowships, subsidies are granted to old writers who are too poor to live decently. Credit has existed for them since the XVII<sup>e</sup> century at the Central Office of the Ministry of Finance.<sup>15</sup> But it is not sufficient and the Fund must help too. The Fund now provides twelve elderly authors with regular allowances of 812 francs a month.

In 1967, the total subsidies, including the subsidies for literary magazines and poetic works, came to 468,000 francs (about 93,600 dollars), 9.6% of the budget of the Fund. In 1968 an increase of 22% is scheduled in order to raise the number of fellowships and to support more publication of poetic creations.

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13. She won the Prix Goncourt in 1962 with her novel, *Le Sel et le Souffre*. Unfortunately she died some months later.

14. Unless it is not a secret, the Fund prefers not to disclose the name of the authors who are granted a fellowship.

15. Since the time of Colbert, the Treasurer of Louis XIV, limited funds for authors in need have been available at the Ministry of Finance.

*The part of the "Caisse Nationale des Lettres"  
in the Writers' social security system:*

The present system of social security in France dates from the liberation in 1945. The structure of taxes and benefits was revised in August 1967.<sup>16</sup>

In the case of wage earners, who comprise 75% of the French working population, the system is financed partly by a percentage of their wages and partly by the employers. Each employee must be a member of the system and must pay for it. Because of his assessment, each employee, working in France, without regard to nationality, has 80% of his medical expenses refunded and in special cases all his medical expenses. All charges are paid, if due to motherhood. If because of sickness, pregnancy, or an injury due to an accident while working, a wage earner is unable to work, he receives a stipend in place of his wages. For those over 65 years of age, the Social Security System provides a pension in proportion to wages earned at the time of retirement. But for stipends for those unable to work due to sickness, pregnancy or injury, there is a ceiling of 3420 francs a quarter (about 684 dollars).<sup>17</sup>

Payments from the State or from the beneficiaries cover many of the workers who are not employees and they have the same coverage. Almost all the people working in France and their families are protected by this national compulsory system.

Owing to the Caisse Nationale des Lettres, writers can now obtain the benefit of social security. In 1950 an executive order treated writers as employees and publishers as employers. The amount of the contribution of employers and employees should have been calculated on the basis of the royalties paid by publishers to the authors. That executive order was misconceived because of the analogy it made of royalties from a copyright to wages paid by an employer. In French law a copyright royalty is the product of a property which is temporary but which has all the legal attributes of property. Publishers and authors unanimately refused to cooperate with this system of financing and the executive order was never applied because the validity of the executive order was brought before the administrative courts. In 1956, when the law organizing the new system of financing the Caisse was passed, the Court had not yet made its decision. The executive order implementing the new law canceled the earlier order; during this period writers could not benefit from the social security system.

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16. Ordonnances No. 67-706, No. 67-707, 67-708 Journal Officiel, Aug. 22, 1967.

17. The new regulation of August 1967 fixed the charge upon the employers at 17% of the wages and the charge upon the employees at 6.5% of the wage.

In the law of February 25, 1956, which organizes the financing of the Caisse Nationale des Lettres, the legislature decided that the Fund would manage the writers' Social Security. The Fund pays to the social security fund the allowance that would normally be paid by employers. Because royalties fluctuate greatly, it is difficult to fix an appropriate annual contribution. The legislature decided on a lump sum. All writers with more than 50% of their income coming from their literary activity must be registered at the social security system of the Fund. The contribution of the Fund made in place of the employer's contribution and the authors' is computed on the assumption that the authors' income is equal to three quarters of the ceiling income on stipends (3420 francs per quarter). The benefits are computed on the same basis. In 1967 the Fund paid 521,949 francs which represents 11% of its budget to the social security system and has handled for the social security system 145,800 francs received from 339 authors subject to this system.<sup>18</sup> Besides the system of "social insurance" the Securite Sociale administers a system of familial allowances with a similar method of financing. Its purpose is to give assistance to every family composed of more than two children and an allowance to every woman when she has a child. But the Caisse is not concerned with this system and writers must pay their shares as "independent workers."

### *The Third Aim of the Fund: to Protect the Integrity of Literature*

The purpose of the Caisse Nationale des Lettres is not merely to give financial aid to French letters but also to ensure respect for the artistic heritage of France and of humanity in general. This legislative object is expressed in paragraph 4 of article 2 of the Law on the Caisse Nationale des Lettres. The text declares that the Caisse is meant "to ensure respect for literary works whatever their country of origin after the death of the author and even after their arrival in the public domain."

The Caisse is given the power to assume the responsibility of imposing standards for the use of literary works. This can be done by the institution of court actions against the purveyors of works which constitute abuses. Nevertheless, the Caisse used this power only once, in a suit against the publisher of a mutilated edition of *Les Miserables* by Victor Hugo.

The remedy available is the prohibition of the misuse of the original work or an order to disclose a work. The Fund acquires standing to sue

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18. These figures are taken from a report of the Caisse to the Cultural Committee of the Senate issued in October 1967.

upon the death of the author. Although the copyright expires fifty years after the death of the author, the Fund retains its standing in perpetuity, so that it may sue in respect of ancient literary works as well as the work of authors recently deceased.

This right to sue was affirmed in article 65 paragraph 2 of the law of 11th of March 1957<sup>19</sup> which codified the law of literary and artistic property in France. It provides: "The lawfully constituted professional bodies (one of which is the Caisse) have the right to sue to defend the interests granted them by their individual charters."

The right of the Fund in this regard bears a close resemblance to the moral right of the author. In effect, in French law as in the law of all nations party to the Berne Convention on copyright, the "droit d'auteur" is twofold. First it is equivalent to the American copyright which is a temporary monopoly lasting for a maximum of 56 years after publication, during which time the author or his heirs may exploit the work financially. Second, it is an inalienable right, certain attributes of which are unlimited in time. These are rights with respect to the integrity of the work, to the name of the author, and to the condition of disclosure.

The text appears to provide that rights in respect of the integrity of the work devolve differently from rights in respect of disclosure. The former according to article 6 of the law of 11th of March 1957 are granted to the heirs-at-law only, and not to their successors. The latter according to article 19 of the same law may devolve upon certain designated classes of beneficiaries, under a will as well as heirs-at-law and may further devolve upon the successors of such beneficiaries so that the right is perpetual so long as there are persons entitled to benefit under article 19.

After the death of the author a conflict may arise between the Caisse and the heirs of the author who have inherited rights under article 6 or article 19. Clearly, in the vast majority of cases this problem will not occur since there will be no heirs, as for example in the case of ancient authors.

Although article 6 gives rights regarding the integrity of the work solely to the heirs-at-law of the author, under the law of 1946-1956 concerning the Caisse, a similar right was granted to that body. It would thus appear that those entitled to exercise rights under either law may act separately or together at their option.

The Caisse is affected also by the right of disclosure. Article 19 gives rights in respect of disclosure to certain designated classes of heirs, but the cause of action which accrues to the Caisse is defined in article 20

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19. Journal Officiel, March 11, 1957.

which states: "In a case of notorious abuse in the exercise or non-exercise of the right of disclosure on the part of the representative of the deceased author . . . the Civil Tribunal may order any appropriate measure. This is so even where there is a conflict between such representatives, where there are no known heirs or in the case of heirs not within the designated classes." The result is that the Caisse has standing to sue only when there are no heirs in the classes designated under article 19 or when the heirs refuse or fail to disclose a work in a manner constituting an abuse, as for example when they accept payment for a disclosure. To summarize, rights of the Caisse regarding the integrity of the work are concurrent with those of the heirs-at-law under article 6; but article 19 gives primary rights to the designated heirs in respect of disclosure, to which the powers of the Caisse are subordinated, in the sense that it cannot act until such primary rights have been exhausted. This interpretation was rejected by Professor Desbois of the University of Paris, the leading authority on the law of literary and artistic property in France. His view is that article 6 does not apply to events occurring after the death of the author. In so far as these are dealt with in the article, it is ineffective, having been displaced by articles 19 and 20 covering the same subject matter and passed by the legislature at a later date. The latter two articles provide fully for rights in relation to events occurring after the death of the author, both as to the integrity of the work and to disclosure. Indeed, Professor Desbois discards this dual classification as creating an unwarranted dichotomy within the moral right of authors. A moral right cannot be divided.

The only judgment on this matter, given by the Tribunal de Grande Instance de la Seine, the trial court of Paris, on April 15th 1964,<sup>20</sup> supported this interpretation. It dealt with Victor Hugo's novel *Les Misérables* which was unfaithful to the original. The works of Victor Hugo are in the public domain, but he still has two living great grandchildren: Jean and Marguerite Hugo. They are not his heirs-in-law under article 6 but rather they fall within the designated classes of heirs under article 19. The court decided that there had not been an open abuse of the moral right by the Hugo family and therefore the Fund had no cause of action. It was held that article 20 affirms all aspects of the moral right including the right in the integrity of the work. In these circumstances the Caisse has a general but only subsidiary right to exercise the moral right in its entirety, that is to say, the Caisse has a cause

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20. Tribunal de Grande Instance de la Seine, April 15, 1964, 1964-II Gazette du Palais Jur. 23 (with brief by Mr. Gulphe); 1964 Recueil Dalloz Jur. 746 (with note by Prof. Desbois).

of action only in the case of abuse of the moral right by the designated heirs or when there are no heirs of that class.

This case is the only one concerning this issue which has been brought to trial, and the judgment is presently under appeal. It now remains for the Court of Appeal, or perhaps the Cour de Cassation to pronounce the definitive interpretation of the articles in question.

### *The Management of the Caisse Nationale des Lettres*

Above we discussed the programs and powers of the Fund. We must now study its financing and its staff organization.

#### *The Resources:*

The budget of the Fund is increasing at a rapid rate. The income of the Fund was 440,000 francs (about 88,000 dollars) during the first year. Ten years later, in 1967 it has reached 4,825,000 francs (about 965,160 dollars). In 1968 an income of 5,250,000 francs (about 1,050,000 dollars) is scheduled and around 1972 about 8,000,000 francs (about 1,600,000 dollars).

A part of the income comes from a tax of 0.2% collected on the turnover of the French publishing firms. Books for exportation, school and scientific books are exempted. In 1967, this tax is expected to constitute 24% of the Fund's income (1,160,000 francs).

Another tax of 0.2% on authors' royalties paid by publishers yields almost 3% of the budget. Accessory royalties, such as royalties from a cinematographic adaptation of a book, are not taxed and royalties paid for the first 5000 copies of a book published for the first time are exempted.

An additional source of revenue, 3% of the budget, comes from the taxes paid by writers for social security.

An increasingly important source of income derives from the fifteen years extension of the literary property. After the termination of the author's rights to royalties, the right passes to the Fund for a period of fifteen years before the literary work becomes public property. Prior to the law of 1956, the literary work passed immediately into the public domain when the author's rights expired. When the law of 1956 was passed, this source of income was to be the Fund's only permanent income; the other taxes were to be only temporary. However a law of 1959<sup>21</sup> made these two taxes permanent. Therefore, as soon as the protection of a literary work ends, a new copyright begins, with the Fund

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21. Loi de Finance No. 59-1454, § 66, Journal Officiel, Dec. 27, 1959.



as beneficiary and including together the right of representation and of reproduction but also the accessory rights in respect with adaptation and translation. The Fund may, as it prefers, continue the existing contract with respect with the exploitation of the work or bargain new contracts.

Normally a copyright continues for fifty years after the author's death, although an extension of about 14 or 15 years has been granted to compensate for the two world wars. Thus all the works of an author are granted to the Fund at the same time. At present the Fund receives royalties for the works of Taine, Alphonse Daudet, Emile Zola, Guy de Maupassant, Mallarme, Renan and Verlaine. In 1971 it will acquire the rights to the works of Jules Verne. In 1967 the income from royalties will reach 330,000 francs, or 7% of the budget.

Each year the Fund acquires the rights of the works of authors dead for fifty years. The Fund retains the right to exploit these works for fifteen years. Therefore, during the first fifteen years, the Fund will gain the rights of works by new writers without losing any works. In 1972, that is after fifteen years, the Fund will each year lose the rights of the authors whose works it has exploited for fifteen years, but will continue to acquire the works of new writers. As a result, we can assume that until 1972 the Fund's resources, because of more and more works to exploit, will increase and then will become stable.

During the years to come, the resources of the Fund will also be augmented by the taxes paid by publishers receiving financial advantages from works published for the first time in a country which does not protect French works, such as the USSR. According to a 1964 law,<sup>22</sup> authors publishing their works for the first time in one of these countries will no longer be eligible for a copyright in France, a system of compulsory license will be established, the beneficiaries of which will be an association of public interest like the Caisse Nationale des Lettres. That law has not yet been applied, because to do it a publisher must begin proceedings before a court which must establish the absence of reciprocity and, before handing down a decision, the court will need an official advisement of the Ministry of Foreign Affairs. No publisher has yet taken the steps leading to such judgment.

A final source of income, constituting 18% of the budget, comes from repayment of loans granted to publishers which represents a sum of 850,000 francs. The State also provides 300,000 francs or 6% of the budget in direct grants.

In addition, 39% comes from funds on hand which have been committed to publishers by way of loans but are not yet due to be paid

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22. Loi No. 64-589, Journal Officiel, July 9, 1964.

out to them. There is a delay of approximately one year between the granting of such loans and the actual transfer of funds granted which occurs upon publication, during which time the Caisse uses them to finance other operations. These assets amount to 1,910,000 francs (about 382,000 dollars) in 1967.

*The Organization of the Caisse Nationale des Lettres*

The Caisse Nationale des Lettres enjoys great liberty of action in managing this quite substantial budget.

Although the Fund is a public service, it is incorporated and consequently has all the legal attributes of personality. It has the intrinsic authority and power that only an administrative agency can have in putting into motion the machinery of the State in order to achieve its purposes. Furthermore, the taxes raised for the Fund have the same characteristics as other public taxes and are collected by the Treasury of the State.

The Fund is financially and administratively autonomous, it fixes its own budget and expenditures and makes the decisions concerning its management and its policies.

While the Fund is officially under the authority of the Minister of Cultural Affairs, the supervision is not very rigorous. The Minister cannot make policy decisions for the Fund, but can act only after the fact to veto a decision with which the Minister disagrees. The reports of the Board of Directors' meetings must be sent to the Minister within ten days. Within twenty days, the Minister can ask for new debates on one or more issues. If the new deliberations confirm the first decision, the Minister can nullify the decision by executive order but he must do so within ten days. Supervision with such strict limitations is nothing more than a minimal control and is of little consequence.

The management of the Fund is conducted by a Board of Directors which is very independent from the State. It is composed of 13 statutory members: 5 civil servants, 5 members of the French university system (such as the Dean of the Faculte de Lettres of Paris and the Manager of the Centre National de la Recherche Scientifique), the perpetual secretary of the Academie Francaise, the Chairman of the Societe des Gens de lettres, and the Chairman of the Publishers' Union. Thirteen added members are elected for four years by different academies or professional institutions.

The eight other members, qualified personalities of the literary world such as famous writers, are appointed by the Minister.

Therefore only a minority of the Board's 34 members — the 5 civil service and the 8 members appointed by the Minister — could be consid-

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ered to be "representatives" of the State. So the Fund's policy is substantially out of range or interference from the State.

### *Conclusion*

After ten years, the Caisse Nationale des Lettres is working as it was hoped it would.

In fact, its activities appear to be an important catalyst for the growth of the tradition of French letters. The size of the budget of the Fund is not very important when compared with the gross revenues of the French publishing industry, but the money and the moral support given by the Fund are an incentive for publishers to publish books of good quality. Numerous works have been published which would not have been published under a system of free enterprise.

Although the loans granted to writers are few in number, if compared with the number of new books published each year, they do enable younger authors to become known and to create and to be remunerated according to the success of their works.

It is interesting to note that the activities of the Caisse Nationale des Lettres are widely supported in the actual context of the French Government. The Minister who oversees the Fund is Mr. Malraux. He is himself an author, so the problems concerning authors are very close to him and to his department. He is wise enough to give to the Fund a great deal of liberty. Furthermore, the Fund is part of the general French cultural policy which, for instance, has also led to the establishment of the Maisons de la Culture. Their purpose is to popularize any kind of art and literature and thereby extend culture in France. It is a deeply French attitude to think that it is by encouraging the spirit of creativity that the radiance of a civilization extends over the world.

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TABLE 1  
 FIGURES OF THE BUDGET OF THE  
 CAISSE NATIONALE DES LETTRES<sup>23</sup>

1967			
Resources	%	Francs	Equivalent in Dollars <sup>24</sup>
Income from the paying public domain	7	330,000	\$ 66,000
Tax of 0.2% collected on the turnover of publishing firms .....	24	1,160,000	232,000.
Tax of 0.2% collected on authors' royalties (except on the first 5,000 copies published for the first time) .....	3	130,000	26,000
Subsidies from the State .....	6	300,000	60,000
Income paid by writers for Social Security .....	3	145,000	29,000
Income from the refundings of loans granted to the publishing firms .....	18	850,000	130,000
Funds from credits granted to publishers not due before the publication of the financed work .....	39	1,910,000	382,000
Expenditures	%	Francs	Equivalent in Dollars
Management of the Caisse Nationale des Lettres .....	6	297,750	\$ 59,550
Fellowships to writers .....	9	468,000	93,600
Payments to Social Security .....	11	521,949	104,389
Loans to publishers .....	72.5	3,510,000	720,000
Other Expenses (taxes, refundings, etc.)	0.5	28,101	5,620

23. Figures taken from the Report of the Caisse, *supra* note 18.

24. On the assumption that one dollar is equivalent to five francs.

2. PROPERTY OR OTHER RIGHTS IN THE NAMES,  
LIKENESSES OR PERSONALITIES OF DECEASED  
PERSONS\*

By ALICE G. DONENFELD\*\*

I. *Any Similarity to Actual Persons, Living or Dead,  
Is Purely Intentional*

In the entertainment industry, one of the most common questions posed by a client is the extent and limits of the right of privacy. This can come up in many ways: how much protection does an entertainer have from the constant intrusion of the press into his or her private life? can a song be written about an actual person or a true incident? can a biography be written without the subject's consent? when does an author cross the line between fair comment on a person of public interest and invasion of privacy?

The concern in this area has manifested itself in most warranty clauses for the sale of a literary property since the author, in order to sell his work, must warrant that the work does not infringe upon or violate the civil rights or right of privacy of any person, firm or corporation. Since an author cannot always be sure the name of the murderess in his new mystery is wholly original with him, he may unwittingly be infringing upon the right of privacy of someone's Aunt Minnie in Chicago who also, in company with his murderess, bears the name Minnefred Horowitz. This paper will not, however, deal with the question of the right of privacy of a living person since that topic has been the subject of many law review articles and Supreme Court cases.

A different question arises, however, in regard to the protection of the name, reputation, personality and/or biography of a deceased person. Is there any way the heirs or personal representatives can prevent the exploitation of their decedent's fame without their consent?

According to the New York Civil Rights Law, Sec. 50, "A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any *living* person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor" (emphasis supplied).

This statute has been construed by the case law in New York as being a personal right and subject to enforcement only by the one whose

\* © Alice G. Donenfeld 1968.

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privacy is being invaded, and, because of the emphasis on the "personal" aspects of the right of privacy the right has been held to die with the person whose privacy has been invaded. *Schumann v. Loew's, Inc.*, 135 N.Y.S.2d 361 (1954); *Rome Sentinel Co. v. Boustedt*, 43 Misc.2d 598, 252 N.Y.S.2d 10 (1964); *Russell v. Marboro Books*, 18 Misc.2d 166, 183 N.Y.S. 2d 8 (1959).

This would seem to foreclose the possibility of any right of action to the survivors or personal representatives of a deceased person for the commercial use of a deceased person's name or picture. However, there are still areas where care must be taken in order to be free of law suits.

First, a client must be advised that while a deceased person may not have a right of privacy, all the living relations of such person do have such a right, and care must be taken not to use their names or likenesses or they would have an action for invasion of their right of privacy.

Second, there is a growing tendency toward the theory that there is a property right attached to one's name, likeness, reputation and personality, and this property right might be construed in the future as surviving the death of the person it is attached to, thereby becoming a vested and protectible property right in the personal representatives or heirs of the decedent.

## II. "What's in a Name" — *Plenty at the Going Rate of Public Relations and Commercial Endorsements*

The concept of a right of privacy was created in 1890 by an article in the *Harvard Law Review* by Justice Samuel Warren and Louis D. Brandeis:

We must therefore conclude that the rights, so protected, whatever their exact nature, are not rights arising from contract or from special trust, but are rights as against the world; and, as above stated, the principle which has been applied to protect these rights is in reality not the principle of private property, unless that word be used in an extended and unusual sense. The principle which protects personal writings and any other productions of the intellect or of the emotions, is the right to privacy, and the law has no new principle to formulate when it extends this protection to the personal appearance, sayings, acts, and to personal relations, domestic or otherwise.<sup>1</sup>

The idea of a property right in privacy was difficult to conceive at that time since the basis for the theory of privacy was not the existence

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1. 4 Harv. L. Rev. 193, 213 (1890).

of a positive or "property" right, but the existence of a negative right such as the right to be left alone, not to have one's secrets disclosed, not to have one's letters made public, and generally to be free from public interference.

The right of privacy was accepted in 1895 when a nephew tried to enjoin the erection, without permission, of a statue honoring his deceased aunt. The court refused to allow the nephew the injunction but recognized that the aunt, during her lifetime, would have been able to protect her right of privacy by an injunction. The basis for the court's decision was the negative aspect of privacy:

A woman like Mrs. Schuyler may very well in her lifetime have been most strongly averse to any public notice, even if it were of a most flattering nature, regarding her own works or position. She may have been (and the evidence tends most strongly to show that she was) of so modest and retiring a nature that any publicity, during her life, would have been to her most extremely disagreeable and obnoxious.<sup>2</sup>

The corollary of the negative theory was expressed in 1902 when the New York Court of Appeals recognized the positive value of one's name, face or reputation, and attached the term "property" to the right of privacy.

The right to grant the injunction does not depend upon the existence of property which one has in some contractual form. It depends upon the existence of property in any right which belongs to a person.<sup>3</sup>

In 1905 the Georgia courts decided that the right of privacy derived from the natural rights of man and the doctrine of property rights.<sup>4</sup>

Once the theory of "property" is attached to the right of privacy, the next step is to develop a value for the right.

Names have always been assumed to have a value for without such assumption there could be no rationale for the laws of libel and slander. In recent years the values of certain famous names have become inestimable. This needs no illustration when consideration is given to the prices paid by companies for the use of a celebrity's name in conjunction with a product. Licensing corporations have been established which do nothing but promote the financial value of the name of a celebrity by

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2. Schuyler v. Curtis, 147 N.Y.Rep. 434 (1895).

3. Roberson v. Rochester Folding Box Co., 171 N.Y. 538 (1902).

4. Pavesich v. New England Life Insurance Co., 122 Ga. 190, 193; 50 S.E. 68, 70 (1905).

granting licenses for the use of such name on a myriad of products. The whole entertainment industry is based on the idea of having a "name" actor or actress appear in a production in any media, and the salary scale of performers, or athletes, is based on their "draw" or "box office appeal."

Not only is the financial value of a name a marketable commodity today, but the promotion of the name is a separate industry upon which millions of dollars are spent annually. Public relations firms are hired by individual personalities to keep their names in the limelight of the press and the public. Great concern is given to the type of publicity which can be gained and its possible financial impact on the "draw" or "appeal" of the name. Not only do personalities spend huge sums on the promotion of their names, but their lawyers and agents haggle endlessly over contractual billing and credit clauses in contracts ranging from a letter for a one-night stand in Skokie, Illinois, to an Actor's Equity Run-of-the-Play contract for a Broadway show, or a forty-page contract for a multi-million dollar motion picture. All this is what makes up the value of a name today, and the name can be that of an actor, author, artist, politician, model, athlete, musician, industrialist, executive, playboy or any other of a hundred types who wish to be in the public eye for any of a hundred reasons.

The New York courts have come to recognize, apart from the right of not having one's privacy invaded, the right to exploit, for its commercial value, one's own name and personality.

The right of privacy — the right in the "inviolable personality" — inheres in each individual. Of particular significance to a public figure is that facet of the right of privacy which, as the obverse of the right of withdrawal from the glare of public scrutiny, embraces the "right of publicity," the exclusive property interest in one's name, portraiture and picture (*Haelan Laboratories v. Topps Chewing Gum*, 2 Cir., 202 F.2d 866, 868, cert. den. 346 U.S. 816, 74 S. Ct. 26, 98 L.Ed. 343). The law has long recognized that "(a) man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property" (*Brown Chemical Co. v. Meyer*, 139 U.S. 540, 544, 11 S. Ct. 625, 627, 35 L.Ed. 247).

Indeed, the very purpose of sections 50 and 51 is the prevention of "the use of an individual's name (portraiture or picture) for commercial purposes without his consent" (*Orsini v. Eastern Wine Corp.*, 190 Misc. 235, 236, 73 N.Y.S.2d 426, 427). "The right protected is the right to be protected against the commercial exploitation of one's personality" (*Hill v. Hayes*, 18 A.D.2d 485, 488, 240 N.Y.S.2d



286, 290; *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 358, 107 N.E. 2d 485, 487).<sup>5</sup>

In the field of unfair competition the primary concern is generally one of public interest, i.e. is the public misled into relying on a fraudulent representation that the goods or services of one person are actually those of another? The second concern is that of protecting the commercial value of a name.

The modern view as to the law of unfair competition does not rest solely on the ground of direct competitive injury, but on the broader principle that property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality, and a court of equity will penetrate and restrain every guise resorted to by the wrongdoer . . . The New York courts have applied the rule in the *International News Service* case in such a wide variety of circumstances as to leave no doubt of their recognition that the effort to profit from the labor, skill, expenditure, name and reputation of others which appear in this case constitutes unfair competition which will be enjoined (see, e.g. *Fisher v. Star Co.*, 231 N.Y. 414, 428; *Lehrenkrauss v. Universal Tours*, 262 N.Y. 332, 337; *Madison Square Garden Corp. v. Universal Pictures Co.*, 255 App. Div. 459, 464-465, *supra*; *Federal Waste Paper Corp. v. Garment Center Capital*, 268 App. Div. 230, 234, *affd.* 294 N.Y. 714).<sup>6</sup>

Where a name has acquired a secondary meaning, or where one has expended time, effort and money to give a name or title a secondary meaning, the courts will resolve all doubts in favor of those who have put forth such labors.<sup>7</sup>

Other courts have given recognition to the premise that a man's name, personality and characteristics have a value that is protectible under the theory of unfair competition.<sup>8</sup>

While not all courts agree that there is a property right attached to a right of privacy, there is a growing acceptance of the fact that a

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5. *Spahn v. Julian Messner, Inc.*, 250 N.Y.S.2d 529, 536, 537 (1966), *affd.* 260 N.Y.S.2d 451, *vacated and remanded* 18 L. Ed. 2d 744 (1967).
  6. *Metropolitan Opera Co. v. Wagner Nichols Recorder Corp.*, 199 Misc. 786, 796 (1950).
  7. *Hemingway v. Film Alliance of the U.S.*, 46 U.S.P.Q. 568 (1940); cf. *Cornell University v. Messing Bakeries*, 285 App.Div. 490, 138 N.Y.S.2d 280 (1955); *Armour & Co. v. Master Tires & Rubber Co.*, 34 F.2d 201 (1925).
  8. *Charles Chaplin v. Amador*, 93 Cal. App. 358 (1928); *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1962); see also *RISKS & RIGHTS* by Samuel Spring, W. W. Norton & Co. (1952).

value can be given a name, or a personality. It seems to be an inequitable result to have this property right extinguished with the demise of the corporeal entity to which it is attached. A corporation which has a trade name can exploit that name forever. An actor, or author or comedian can spend thousands of dollars publicizing his name during his lifetime, and upon his death his relatives are left with no way of protecting or exploiting that valued name.

III. *"The Evil that Men Do Lives After Them; the Good Is Oft Interred with Their Bones:" and Relatives Have Been Held to Have Some Property Rights in a Corpse.*

At common law the only property right in his person a decedent left to his survivors was "a limited interest which is to be considered in the nature of a property right for burial purposes and for allowing recovery for outrages committed against the body."<sup>9</sup>

The courts have uniformly held that a right of privacy is a personal right which does not survive the death of the person on whose behalf enforcement is sought.<sup>10</sup>

The only type of case that allowed any relief to survivors was in the unauthorized publication of the photograph of a deceased child. The rationale was as follows:

The suit is not based on injury to the deceased child. According to the allegations, the wrongs done by defendants were committed after the death of the child. Therefore in this case there is no survival of a right of action. The right, if it ever existed or now exists, began after the death of the child and is a right of action on the part of the plaintiffs.<sup>11</sup>

It is interesting to note that the court disregarded the defense that this was an invasion of privacy action and thereby died with the child. "In this case the child was dead when the unauthorized acts were committed, and the right of action would not be in the child, but in the parents."<sup>12</sup>

The court, while not discussing the theory of a descendible property right, realized that the injury was not to the decedent, but to the parents, and also accepted the fact that since the cause of action arose after the child's death the wrong was committed against the parents. However, generally, where survivors brought actions for defamation or

9. *Ravellette v. Smith*, 300 F.2d 854, 858 (1962).

10. *Maritote v. Desilu Productions*, 230 F.Supp. 721 (1964); *Rome Sentinel Co. v. Boustedt*, 43 Misc.2d 598, 152 N.Y.S.2d 10 (1964).

11. *Bazemore v. Savannah Hospital*, 171 Ga. 257, 155 S.E. 194, 196 (1930).

12. 155 S.E. 194, 197.

invasion of privacy of a decedent the court found that there was no legal damage to the survivors.

The court held as follows:

The authorities appear to be uniform that the right of privacy cannot be asserted by anyone other than him whose privacy is invaded. The publication did not invade plaintiff's privacy in any respect. There was nothing in it which brought plaintiff into unjustifiable or any publicity . . .

. . . Defamation of a deceased person does not give rise to a civil right of action at common law in favor of the surviving spouse, family, or relatives, who are not themselves defamed. A libel on the memory of a deceased person is not deemed to inflict on the surviving relatives of the deceased any such legal damage as will sustain a civil action for the defamation.<sup>13</sup>

When suitors realized that the area of right of privacy was a dead end, attempts were made to show a property right in a deceased's name, fame or personality which was descendible. One of the most interesting of these cases is *James v. Screen Gems*, where the widow of Jesse James, Jr. brought an action for alleged wrongful portrayal of her deceased husband. The widow asserted the claim that she had used the name "Mrs. Jesse James, Jr." for 58 years and that "the names Mrs. Jesse James, Jr. and Jesse James, Jr. belong solely to plaintiff and her deceased husband jointly 'by reason of the living of the marriage vows for a period of 51 years,' and as such plaintiff maintains a certain interest of monetary value by her designation and title of Mrs. Jesse James, Jr. . . ." <sup>14</sup> The court completely disregarded the widow's claim of a property right in her name and the name of her deceased husband, and disallowed her claim by finding that the portrayal of decedent was directed towards him and not towards his widow and she could therefore not recover damages for the wrongful invasion of her privacy.

Another interesting aspect of the theory of a property right in the name and personality of a deceased has come up through the tax courts. In *Runyon v. U.S.*<sup>15</sup> the son of Damon Runyon claimed the right to treat money received by him from a motion picture company for the right to make a motion picture based on the life of his father as a gain from the sale of a capital asset. The Government disallowed the claim on the ground that no New York case had been cited to indicate

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13. *Kelly v. Johnson Publishing Co.*, 160 Cal. App.2d 718, 325 P.2d 659, 662 (1958).

14. 344 P.2d 799, 800 (1959).

15. 281 F.2d 590 (1960).

that a right of privacy exists on behalf of the son or personal representative of a deceased person. The court upheld the Government but in the dicta assumed that there was a property right.

We think the government's position is also sound in asserting that even though the taxpayer had a property right in the name and story of his father's life, there was nevertheless no sale of it . . . There was, therefore, no conveyance of every substantial right owned by the taxpayer, if, in fact, he owned anything.<sup>16</sup>

In *Starrels v. Commissioner of Internal Revenue*,<sup>17</sup> Mrs. Starrels contended that payments made to her in return for her consent to the portrayal of herself, her father and other members of her family in a motion picture were exempt since they were damages for invasion of privacy. This was disallowed on the ground that the compensation was not for an invasion of Mrs. Starrels' privacy but the privacy of her father.

The closest decision to the establishment of a descendible property right in a name and reputation has been in *Maritote v. Desilu Productions, Inc.*<sup>18</sup> This was a civil action brought by the administratrix of the estate of Alphonse Capone, and the son and widow of deceased against defendants for an alleged "appropriation of the 'name, likeness and personality' of Al Capone, without the consent of the widow, son or administratrix, for use in a television broadcast . . ." <sup>19</sup> The court defined the question at bar as follows:

1) The court having recognized the fact that there exists no right of privacy in a dead man under Illinois law, may the estate of a deceased person recover in quasi-contract for an alleged appropriation of a property right in the name, likeness and personality of said deceased person? <sup>20</sup>

The court found that under Illinois law the above question must be answered in the negative, as an action for the appropriation of the name, likeness and personality of a person is categorized in law as an action for right of privacy and the use of a new name, such as appropriation of a property right, does not change the import of the law. The dicta, however, contain a plea for a change in the law and point up the need for reform.

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16. 281 F.2d 590, 592.

17. 304 F.2d 574 (1962).

18. 230 F.Supp. 721 (1964).

19. 230 F.Supp. 721, 722.

20. *Ibid.* at 725.

The court, however, must agree with plaintiff that a wrong has been committed. And, indeed, there should be a remedy. The volume of pages contained in the briefs before us testify to the fact that this is an area of the law that has been unsatisfactorily developed, and there is much need for reform. We are much impressed with plaintiff's arguments relating to the distasteful type of profiteering that has followed the death of our late beloved President, John F. Kennedy, and the unfortunate lack of legal machinery available to curtail it. Yet, if the courts are to overcome the imperfections in the law, we must do it within the framework of our established legal system.<sup>21</sup>

IV. *"Live and Let Live" — Die and Let Others Live Off You.*

In summary, the law as it now stands does not afford any right of action for the use of the name, likeness or personality of a deceased person. The personal representatives and heirs of a personality are without recourse to the courts unless their own right of privacy has been infringed.

The reluctance of the courts to grant relief to such representatives or heirs has been premised on the theory that such relief would be based on an action for invasion of a right of privacy which does not survive the death of one whose privacy has been invaded. Until the courts accept the premise that a name, likeness and personality have a commercial value, akin to personal property, that can be passed on to one's heirs or personal representatives, there can be no change in the law. This premise is not unacceptable when it is considered that the cause of action arises after the death of the personality, and the damage caused by the unauthorized exploitation is done to the heirs and personal representatives on whose behalf any right of action should lie. Also to be considered is the copyright law which benefits the heirs of a deceased author or creator, and the natural next step would be to benefit the heirs of a deceased personality who could also be considered the "author" or "creator" of his or her own commercial and marketable, though less tangible, image.

On the practical side of this question, most authors and producers of properties which exploit deceased persons obtain releases rather than lawsuits. It is usually far easier to go to a widow or child or personal representative and pay them for the use of the deceased's name, likeness and personality and the use of and access to any letters, papers, pictures and anecdotes or stories about the deceased than to go ahead without such consent and incur their wrath.

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21. *Ibid.* at 726.

While the law would seem to make any chance of recovery for the appropriation of a deceased's name, likeness and personality highly unlikely at present, the momentum towards the protection of heirs and survivors seems to be gaining in direct relation to the escalating cost of achieving notoriety.

Therefore, when advising a client embarking on the exploitation of a deceased personality, all possibilities for obtaining releases and permissions should be explored before going ahead without them.

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## PART II.

LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS

## 1. United States of America and Territories

3. U.S. *Laws, statutes, etc.*

Public Law 90-396, 90th Congress, H.R. 6279, July 11, 1968. An act to provide for the collection, compilation, critical evaluation, publication, and sale of standard reference data. [Washington, GPO, 1968] 2 p. (82 Stat. 339, 340). See 14 BULL. CR. SOC. 316, *Item* 215 (1967).

4. U.S. *Laws, statutes, etc.*

Public Law 90-416, 90th Congress, S.J. Res. 172, July 23, 1968. Joint resolution extending the duration of copyright protection in certain cases. 1 p. (82 Stat. 397). See 15 BULL. CR. SOC. 396 (1968).

*Notice from the Copyright Office:*

By this law, all subsisting copyrights in their *second* term that would expire before December 31, 1969 have been extended, so that they will continue in force through December 31, 1969. The extension is automatic and does not require any action in the Copyright Office.

Please note that this extension does *not* apply to copyrights in their first term. It therefore has no effect on the time limits for renewal registration, which must be made during the last year of the original 28-year term. Also, this law does not revive any copyrights that have already expired.

This extension applies only to copyrights that have already been renewed, for which the period of protection would otherwise expire.

5. CALIFORNIA. *Assembly Bill No. 83.*

Penal Code. Section 653h. Sound Recordings: Pirating.

The California statute has added criminal remedies against record piracy. New Section 653h of the California Penal Code (Assembly Bill No. 83 of January 11, 1968) makes it clear that while its provisions do not apply to persons engaged in radio and television broadcasting who transfer sound, this exception is limited to the

transfer of sounds other than from the sound track of a motion picture. The new section reads as follows:

653h. (a) Every person is guilty of a misdemeanor who:

(1) Knowingly and willfully transfers or causes to be transferred any sounds recorded on a phonograph record, disc, wire, tape, film or other article on which sounds are recorded, with intent to sell or cause to be sold, or to use or cause to be used for profit through public performance, such article on which such sounds are so transferred, without the consent of the owner.

(2) Sells any such article with the knowledge that the sounds thereon have been so transferred without the consent of the owner.

(b) As used in this section, "person" means any individual, partnership, corporation or association; and "owner" means the person who owns the master phonograph record, master disc, master tape, master film or other device used for reproducing recorded sounds on phonograph records, discs, tapes, films or other articles on which sound is recorded, and from which the transferred recorded sounds are directly or indirectly derived.

(c) This section shall neither enlarge nor diminish the right of parties in private litigation.

(d) This section does not apply to any person engaged in radio or television broadcasting who transfers, or causes to be transferred, any such sounds (other than from the sound track of a motion picture) intended for, or in connection with, broadcast transmission or related uses, or for archival purposes.

SEC. 2. If any provision of this act or the application thereof to any person or circumstances is held invalid as being unconstitutional or preempted by federal law, such invalidity shall not affect other provisions or applications of the act which can be given effect without the invalid provision or application, and to this end the provisions of this act are severable.

HISTORY: A.B. 83, approved and filed July 16, 1968.

## 6. NEW YORK STATE.

General Business — Works of Art — Express Warranties. Chapter 454. Article 12-D.

New York State has repealed Article 12-D of the General Business Law, which dealt with representations and warranties of works



of art (printed in full in 14 BULL. CR. SOC. 86, *item* 16 (October 1966)), and has enacted a new law which includes certain important changes. The new law now to be found in General Business Law Chapter 454, Article 12-D, "Creation and Negation of Express Warranties in the Sale of Works of Fine Arts," became effective September 1, 1968. As amended, the statute now reads as follows:

§221. Definitions

As used in this article:

(a) The term "person" means an individual, partnership, corporation, association or other group however organized.

(b) The term "fine art" means a painting, sculpture, drawing or work of graphic art.<sup>1</sup>

(c) The term "art merchant" means a person who deals in works of fine art or by his occupation holds himself out as having knowledge or skill peculiar to works of fine art or to whom such knowledge or skill may be attributed by his employment of an agent or broker or other intermediary who by his occupation holds himself out as having such knowledge or skill. The term "art merchant" includes an auctioneer who sells works of fine art at public auction as well as such auctioneer's consignor or principal.

(d) The term "written instrument" means a written or printed agreement, bill of sale, or any other written or printed note or memorandum of the sale or exchange of a work of fine art by an art merchant. The term "written instrument" also includes a written or printed catalogue or other prospectus of a forthcoming sale as well as any written or printed corrections or amendments thereof.

(e) The term "author" or "authorship" refers to the creator of a work of fine art or to the period, culture, source or origin, as the case may be, with which the creation of such work is identified in the description of the work.

(f) The term "counterfeit" means a work of fine art made or altered, with intent to deceive, in such manner that it appears to have an authorship which it does not in fact possess. The term "counterfeit" shall also be deemed to include any work of fine art made, altered or copied in such manner that it ap-

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1. So in enrolled bill.

pears to have an authorship which it does not in fact possess even though such work may not have been made with intent to deceive.

#### §222. Express warranties

Any provision in any other law to the contrary notwithstanding: 1. Whenever an art merchant, in selling or exchanging a work of fine art, furnishes to a buyer of such work who is not an art merchant, a written instrument which, in describing the work, identifies it with any author or authorship, such description (i) shall be presumed to be part of the basis of the bargain and (ii) shall create an express warranty of the authenticity of such authorship as of the date of such sale or exchange. Such warranty shall not be negated or limited because the seller in the written instrument did not use formal words such as "warrant" or "guarantee" or because he did not have a specific intention or authorization to make a warranty or because any statement relevant to authorship is, or purports to be, or is capable of being merely the seller's opinion.

2. In construing the degree of authenticity of authorship warranted as aforesaid, due regard shall be given to the terminology used in describing such authorship and the meaning accorded to such terminology by the customs and usage of the trade at the time and in the locality where the sale or exchange took place. A written instrument delivered pursuant to a sale which took place in the state of New York which, in describing the work, states, for example,

(i) that the work is by a named author or has a named authorship, without any other limiting words, means, unequivocally, that the work is by such named author or has such named authorship;

(ii) that the work is "attributed to a named author" means a work of the period of the author, attributed to him, but not with certainty by him;

(iii) that the work is of the "school of a named author" means a work of the period of the author, by a pupil or close follower of the author, but not by the author.

#### §222-a. Disclaimers

Words relevant to the creation of an express warranty of authenticity of authorship of a work of fine art and words tend-

ing to negate or limit warranty shall be construed wherever reasonable as consistent with each other; but subject to the provisions of section 2-202 of the uniform commercial code on parol or extrinsic evidence, negation or limitation is inoperative to the extent that such construction is unreasonable. Subject to the limitations hereinafter set forth, such construction shall be deemed unreasonable if:

1. The language tending to negate or limit such warranty is not conspicuous, written and contained in a provision, separate and apart from any language relevant to the creation of the warranty, in words which would clearly and specifically apprise the buyer that the seller assumes no risk, liability or responsibility for the authenticity of the authorship of such work of fine art. Words of general disclaimer like "all warranties, express or implied, are excluded" are not sufficient to negate or limit an express warranty of authenticity of the authorship of a work of fine art, created under section two hundred twenty-two of this article, or otherwise; or

2. The work of fine art is proved to be a "counterfeit," as that term is defined in this article, and this was not clearly indicated in the description of the work; or

3. The work of fine art is unqualifiedly stated to be the work of a named author or authorship and it is proved that, as of the date of sale or exchange, such statement was false, mistaken or erroneous.

#### §222-b. Construction

1. The rights and liabilities created by this article shall be construed to be in addition to and not in substitution, exclusion or displacement of other rights and liabilities provided by law, including the law of principal and agent, except where such construction would, as a matter of law, be unreasonable.

2. No art merchant who, as buyer, is excluded from obtaining the benefits of an express warranty under this article shall thereby be deprived of the benefits of any other provision of law.

§2. This act shall take effect September first, nineteen hundred sixty-eight.

## LEGISLATIVE MEMORANDUM.

In an accompanying *Legislative Memorandum*, the changes in new Article 12-D were explained as follows:

*I—Clarificatory Changes*

1. Under the U.C.C. (2-313) a description of goods which is made part of the basis of the bargain creates an express warranty that the goods will conform to the description. Under this bill the identification of a work of fine art with any authorship creates a presumption that such description of the work is part of the basis of the bargain. No formal words are required to prove that, to a buyer, authenticity of authorship is "of the essence of the contract." This bill recognizes what is axiomatic in the art market — buyers pay higher prices for "names."

2. Under the U.C.C. (2-313.2) warranty is negated with respect to any statement which purports to be "merely the seller's opinion." No express disclaimer is needed to exclude warranty. It constitutes a "built-in disclaimer." The rule of caveat emptor is especially applicable, by common law and the U.C.C. alike, to seller's "opinions." This is a sound rule which prevents sellers from being held for warranties for mere "puffing." But when a presumably reputable and honest art merchant says "This is a painting by Renoir" this cannot and should not be dismissed as mere "puffing." It is intended by the seller to be and usually is accepted by the buyer as an affirmation of a *fact*. However, works of fine art are unique in many ways, not the least of which is that the only person capable of attesting to the authenticity of authorship of the work as a *fact* is the author himself (or an eyewitness). By the very nature of things, everyone else's statements relative to authorship becomes a matter of educated judgment or opinion and the more remote the creator is from the present the more remote is the possibility that anyone can make an attribution of authorship as a *fact*.

This peculiarity inherent in works of fine art, as distinguished from other "goods," enables the art merchant to enjoy the best of two possible worlds. He can, without making any preliminary investigation, make a firm and positive attribution (justifying a higher price) and, if it is later proved to be false, fall back upon his "built-in disclaimer" — that his attribution of authorship was, after all, only his judgment — a matter of "mere" opinion. This bill holds a merchant-seller responsible to a non-merchant buyer for any statement relevant to the

authorship of a work of fine art notwithstanding that such statement is or purports to be or is capable of being merely his "opinion." In this particular area the distinction between "fact" and "mere opinion" based upon a merchant's presumable experience or skill or expertise becomes too finely drawn to permit a merchant-seller to avoid legal responsibility while reaping the benefits of branding his merchandise with well known names. If "labels" are needed or useful for mere "housekeeping" purposes, a merchant may still use them and absolve himself from responsibility, without injury to the purchaser, by using the "express disclaimer" method which art auctioneers have used for centuries. Without such express disclaimers, the private art-merchant-seller lulls the buyer into a false sense of security, and, when the occasion requires, may invoke his "built-in" secret disclaimer under the explicit sanction of the letter, if not the spirit, of the U.C.C. (2-313.2).

Article 12-D was intended to be distinguishable from U.C.C. § 2-313 by omitting all negative conditions. This revision clarifies these distinctions by explicitly ruling out all "built-in-disclaimers" which exclude warranty under the U.C.C. This should better apprise art-merchant-sellers to refrain from making reckless attributions of authorship or to at least expressly apprise the non-merchant-buyers of their intention not to warrant the authenticity thereof by including in the bill of sale a clear and conspicuous disclaimer.

## *II — Basic Changes*

A. Although the U.C.C. abounds with provisions designed to promote higher standards of good faith, honesty and fairness in commercial practices of merchant-sellers and provisions designed to protect buyers from unconscionable clauses and unreasonable results, none of these fully accomplish the aims sought to be attained by this bill respecting the requirements and construction of disclaimer provisions. This bill seeks to accomplish the following:

1. To negate an express warranty of authenticity of authorship of a work of fine art a disclaimer must be clear, conspicuous, in writing and specifically addressed to the express warranty. Notwithstanding a disclaimer which meets these formal requirements this bill, which tracks the language of U.C.C. § 2-316(1), further provides that such disclaimer shall be deemed inoperative to negate the warranty if the work of art is proved to be

a "counterfeit". The term "counterfeit" is defined as a work created with intent to deceive as well as a mere "copy" which is sometimes capable of deceiving a casual (non-merchant) buyer. Although the latter is not an art forgery in the criminal sense, it is treated as an equivalent in the context of this statute in order to avoid unnecessary verbiage and fine distinctions between fakes, forgeries, imitations, pastiches or just plain copies of works by masters which might not fool an expert but might fool a casual buyer. The important objective is to insure that a buyer does not pay a "genuine" price for a pseudo-work of art.

2. But fakes, frauds and forgeries are not the only pitfalls which lurk in the path of the unwary art collector. By far the greatest pitfall is what art merchants euphemistically describe as "mere misattributions". Art merchants have over the centuries invented an infinite myriad of variegated "attributions" no full glossary of which has ever been published, which may mean one thing in ordinary conversation and, by usage of the trade, something else when used in a bill of sale or a catalogue, each designed to make use of well established names of artists, periods, cultures, sources or origins, as the case may be, in describing works of sometimes dubious origin.

The one and only attribution in art merchant's terminology which can and should leave no room to doubt authenticity of authorship is when the bill of sale or catalogue reads "painting by a named author". Supposing this painting, although not a forgery, turns out to be the work of a minor contemporary of the named author and should properly have been labelled "*Attributed* to the named author", (which might betray its doubtful authorship) should the buyer be permitted to rescind the sale notwithstanding that the seller attempted to protect himself from legal responsibility by a specific disclaimer?

Equity would seem to require, and the bill so provides, that in such case the warranty should govern the disclaimer and not vice versa.

B. As enacted, Article 12-D applied to all sellers and all buyers irrespective of whether they were merchants or non-merchants. The departures from traditional norms under this bill rest on a firmer foundation against the background of a transaction restricted to a merchant-seller and a non-merchant-buyer. The definition of an "art merchant" tracks the U.C.C. definition of "merchant [2-104(1)] and the Code rationale for dealing with transactions between professionals and non-pro-

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professionals in a given field (See Practice Commentary and Official Comment under U.C.C. § 2-104) reflects the rationale for this basic change in Article 12-D of the General Business Law.

## 2. Foreign Nations

### 7. AUSTRALIA. *Laws, statutes, etc.*

Copyright Act 1968. No. 63 of 1968. Assented to 27 June 1968. [Canberra, A. J. Arthur, Commonwealth Govt. Printer, 1968] 105 p.

A new copyright law which "shall come into operation on a date to be fixed by Proclamation." It is designed to enable Australia to become a party to the Universal Copyright Convention and to the Brussels revision of the Berne Convention.

### 8. AUSTRALIA. *Laws, statutes, etc.*

Designs Act 1906-1967. [Canberra, A. J. Arthur, Commonwealth Govt. Printer, 1967] 11 p.

The Designs Act 1906 as amended.

### 9. AUSTRALIA. *Laws, statutes, etc.*

Designs Act 1968. No. 64 of 1968. Assented to 27 June 1968. [Canberra, A. J. Arthur, Commonwealth Govt. Printer, 1968] 4 p.

Amendments to the Designs Act 1906-1967 (see Item 8, *supra*) which make adjustments chiefly to provide conformity with the new Copyright Act 1968.

### 10. CZECHOSLOVAK REPUBLIC. *Laws, statutes, etc.*

Authorsky zakon a predpisy souvisici; texty pravnich predpisu usporadel a poznamkami opatrel Karel Knap. Praha, Orbis, 1968. 425 p.

An annotated text of the Czechoslovak copyright law of 1965, texts in Czech of international conventions to which the Republic adheres, and pertinent decrees and regulations covering, *inter alia*, free use, royalties, and taxation.

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## PART III.

**CONVENTIONS, TREATIES AND PROCLAMATIONS**

## 11. INTERNATIONAL COPYRIGHT UNION.

State of the International Union on July 1, 1968. (4 *Copyright* 156-157, no. 7, July 1968.)

The semiannual 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 July 1, 1968.

12. State of ratifications and accessions to the conventions and agreements affecting copyright on July 1, 1968. (4 *Copyright* 171-172, no. 7, July 1968.)

Covers the Rome Convention on Neighboring Rights, the Universal Copyright Convention, the European Agreement concerning Programme Exchanges by Means of Television Films, and the European Agreement for the Prevention of Broadcasts Transmitted from Stations Outside National Territories.

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## PART IV.

**JUDICIAL, DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## 1. United States Supreme Court

*On certiorari:*

13. *Hoffenberg v. Kaminstein*, 37 U.S.L. Week 3151 (U.S. Sup. Ct., October 21, 1968).

Petition for certiorari to review 157 U.S.P.Q. 358 (D.C. Cir., 1968), 15 BULL. CR. SOC. 330, *Item* 329 (1968).

*Held*, cert. denied.

14. *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 37 U.S.L. Week 3133 (U.S. Sup. Ct., October 14, 1968).

Petition for certiorari to review 391 F.2d 150, 157 U.S.P.Q. 65 (2d Cir., 1968), 15 BULL. CR. SOC. 334, *Item* 331 (1968).

*Held*, cert. denied.

## 2. Federal Court Decisions

15. *Smith v. Little, Brown & Company*, 396 F.2d 150, 158 U.S.P.Q. 177 (2nd Cir., June 6, 1968) (Hays, J.). *For decision below, see* 273 F. Supp. 870, 154 U.S.P.Q. 473 (S.D.N.Y., 1967), 15 BULL. CR. SOC. 181, *Item* 119 1968); *for earlier related decisions, see* 245 F. Supp. 451, 146 U.S.P.Q. 540 (S.D.N.Y., 1965), 13 BULL. CR. SOC. 138, *Item* 162 (1965), *affirmed*, 360 F.2d 928, 149 U.S.P.Q. 799 (2nd Cir., 1966), 13 BULL. CR. SOC. 415, *Item* 435 (1966).

Plaintiff's appeal from lower court's determination of damages and profits in action for infringement of common law copyright. A book published by defendant was previously held to have infringed plaintiff's literary property in her unpublished manuscript.

*Held*, affirmed.

I. The district court had refused to allow punitive damages on the grounds that (i) it was doubtful whether an employee of defendant who

gave the infringing author an account of plaintiff's work was acting within the scope of her employment, (ii) in ordering second and third printings of the infringing work after receiving notice of plaintiff's claim, the conduct of one of defendant's officers was perhaps negligent but not sufficiently "reckless", and (iii) the courts have been reluctant to grant punitive damages "especially in copyright cases". The appellate court held the lower court's determination not to be "clearly erroneous".

II. Although plaintiff objected to the lower court's holding that defendant might deduct its royalty payments to the infringing author in determining its profits, the appellate court held that the "district court was plainly correct in permitting defendant to treat the royalties paid to the author of the infringing book as an element of its cost [*cit. om.*]. Of course it is open for plaintiff to bring suit against the author for such royalties, and we understand that she has done so."

16. *Yameta Co. Ltd. v. Capitol Records, Inc.*, 393 F.2d 91, 157 U.S.P.Q. 465 (2nd Cir., April 15, 1968) (Per curiam). *For decision below, see* Item 28, *infra*.

Judge Metzner's award of a preliminary injunction under Section 43(a) was reversed without opinion. Because "exceptional and meritorious" reasons existed for trial as soon as possible, the case was remanded to the Chief Judge of the Southern District for preference.

17. *Landry, d.b.a. Curtis School of Aeronautics v. American Institute for Research*, 393 F.2d 48 (5th Cir., March 18, 1968) (Per curiam).

Appeal from an order in action for copyright infringement.

*Held*, order modified in accordance with agreement of the parties in open court. The order as modified provided, *inter alia*, that plaintiff's copyrights were valid and had been infringed by defendant, that defendant be enjoined from "reproducing or using the plaintiff's copyrighted materials or words agreed to be proprietary with plaintiff", and fixed damages at \$650.

18. *Time Incorporated v. Bernard Geis Associates, et al.*, 159 U.S.P.Q. 663 (S.D.N.Y., Sept. 24, 1968) (Wyatt, J.)

Action for copyright infringement and unfair competition. Plaintiff, publisher of Life Magazine, had purchased from Abraham Zapruder "home movies" (and all rights therein) which the latter had taken of the assassination of President Kennedy, had secured copyright thereon and published various frames of the film in several issues of Life Magazine (with its permission, a copy of the film was deposited in the National

Archives and numerous frames had been reprinted in the Warren Report). Defendants published and distributed a book on the assassination written by Josiah Thompson which contained charcoal renderings of several of the film's frames. Thompson had been employed by Life Magazine in the preparation of a series of articles dealing with the assassination and had taken photographs of the film, from which the charcoal sketches were prepared.<sup>1</sup>

*Held*, summary judgment for defendants.

I. *Copyright.*

(a) The court found that Life Magazine had not consented to the challenged use of the film and that a Life associate editor whose "permission" was allegedly relied upon by defendants had, in any event, no authority to bind the plaintiff corporation and that this was known to defendants.

(b) Defendants contended that the Zapruder film [frames] were not susceptible of copyright because (i) as mere records of historical events, they lacked originality, (ii) "news" cannot be copyrighted, and (iii) protection was inappropriate under the "doctrine" of the recent decision in *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir., 1967), 15 BULL. CR. SOC. 43, Item 24 (1967) (copyright protection denied to a game rule because of the limited number of ways in which the substance of the rule could be expressed). The court, however, found the film to be a proper subject of copyright, stating, *inter alia*:

A news event may not be copyrighted. . . . [But] Life claims no copyright in the news elements of the event but only in the particular form of record made by Zapruder. . . . Any photograph reflects "the personal influence of the author and no two will be absolutely alike", to use the words of Judge Learned Hand. The Zapruder pictures in fact have many elements of creativity. Among other things, Zapruder selected the kind of camera (movies, not snapshots), the kind of film (color), the kind of lens (telephoto), the area in which the pictures were to be taken, and (after testing several sites) the spot on which the camera would be operated. The *Morrissey* decision . . . can have no possible application here. Life claims no copyright in the events at Dallas. They can be freely set forth in speech, in pictures, in books, in music, and in every other form of expression. All that Life claims is a copyright in the particular form of expression. . . . If this be "oligopoly", it is specifically

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1. The opinion contains an exhaustive review of the facts, including those regarding a "consent" defense, and comprehensive discussions of the copyrightability of photographs and the doctrine of fair use.

conferred by the Copyright Act and for any relief address must be to the Congress and not to this court.

(c) Observing that “copyright in a work protects against unauthorized copying not only in the original medium in which the work was produced, but also in any other medium as well [Nimmer, COPYRIGHT, 98]”, the court found the fact that the copies were “done in charcoal by an ‘artist’ ” to be immaterial.

(d) Overcoming an “initial reluctance to find any fair use . . . because of the conduct of Thompson in making his copies and because of the deliberate appropriation . . . in defiance of the copyright owner”, the court held defendants’ copying to be privileged. The court said:

. . . it was not the nighttime activities of Thompson which enabled defendants to reproduce [the] copies. . . . They could have secured [the] frames from the National Archives, or they could have used the reproductions in the Warren Report or the issues of Life itself. Moreover, while [defendant’s] hope for commercial gain is not a significant factor in this Circuit, there is a strong point for defendants in their offer . . . to Life [of] all profit of Associates from the Book as a royalty payment. . . . There is a public interest in having the fullest information available on the murder of President Kennedy. Thompson did serious work on the subject and has a theory entitled to public consideration. While doubtless the theory could be explained with sketches of the type [conceded to be “fair sketches”], the explanation actually made . . . with copies is easier to understand. The Book is not bought because it contained the Zapruder pictures; the Book is bought because of the theory of Thompson and its explanation, supported by the Zapruder pictures. There seems little, if any, injury to plaintiff. . . . There is no competition between plaintiff and defendants. Plaintiff does not sell the Zapruder pictures as such and no market for the copyrighted work appears to be affected. Defendants do not publish a magazine. There are projects for use by plaintiff of the film in the future as a motion picture or in books, but the effect of the use of certain frames in the Book on such projects is speculative. It seems more reasonable to speculate that the Book would, if anything, enhance the value of the copyrighted work; it is difficult to see any decrease in its value.

II. *Unfair Competition.* The court held that plaintiff had no cause of action for unfair competition in the copying of a copyrighted work found not to violate the federal Copyright Act because (i) it “is doubtful” whether the New York cases accord protection in such a situation

and, at any rate (ii) under *Sears and Compco* New York could not constitutionally convert "fair use" copying into an actionable form of unfair competition.

19. *Rytvoc, Inc. v. Robbins Music Corporation*, 289 F. Supp. 136, 157 U.S.P.Q. 612 (S.D.N.Y., Nov. 27, 1967) (Bryan, J.)

Plaintiff's motion for summary judgment in action for copyright infringement and declaration that plaintiff is the owner of renewal rights in several musical compositions composed or arranged by one James R. Munday. In 1936 and 1937, under assignments from Munday (allegedly including renewal rights) which were not recorded until 1963 and 1964, defendant secured certificates of registration for original term copyright in the works; in 1958 plaintiff obtained and recorded an assignment from Munday, his wife and child, of renewal rights in all his works.

*Held*, motion denied.

I. Defendant claimed the right to renewal in two of the works for itself on the grounds they were composed by Munday in the course of his employment by Benny Goodman, from whom defendant had obtained an assignment. Observing that the proprietor of copyright in works made for hire is entitled to renewal, the court held that whether the compositions in question were of such nature required a factual determination at trial.

II. With regard to other of the works, defendant having introduced a purported assignment to it from Munday of his interest as "co-writer" therein, the court held that plaintiff's mere allegation of sole and exclusive renewal rights was insufficient to carry the motion.

III. Although plaintiff claimed that its prior recorded assignment took precedent over defendant's 1936 and 1937 assignments by virtue of section 30 of the Copyright Act, defendant alleged that in 1958 plaintiff had actual notice of the earlier assignments. Noting that if this assertion were supported at trial it might prove a complete defense, the court held that Munday's warranty of his right to assign the renewals in the 1958 assignment was "plainly not dispositive of this issue".

20. *United Merchants and Manufacturers, Inc. v. Sarne Company, Inc.*, 278 F. Supp. 162, 157 U.S.P.Q. 331 (S.D.N.Y., Dec. 8, 1967) (Mansfield, J.)

Motion for preliminary injunction in action for copyright infringement. Plaintiff alleged that its copyrighted fabric design was copied by defendant on fabric luggage.

*Held*, motion granted.

The court held that the "average observer" test of similarity disclosed a prima facie case of infringement; variations between the designs were deemed such that the ordinary observer, unless he set out to detect them, "would be disposed to overlook them and regard the aesthetic appeal as the same".

The court also held that, absent a showing that copyright notice could have been embodied in the design itself without impairing its market value, the inscription of notice on the selvage of plaintiff's fabric at every 27-inch repeat of the design complied with Section 10 of the Copyright Act, and that the omission of notice on a small portion of plaintiff's over-all production was excusable under Section 21. The court added that the latter section does not bar injunctive relief against even innocent infringers.

21. *Alart Associates, Inc. v. Aptaker*, 157 U.S.P.Q. 494 (S.D.N.Y., April 16, 1968) (Mansfield, J.). *For prior decision, see* 279 F. Supp. 268, 156 U.S.P.Q. 559 (S.D.N.Y., 1968), 15 BULL. CR. Soc. 337, Item 333 (1968).

Motion for reconsideration of an order (i) denying summary judgment to defendant on the grounds that an inadvertent error, subsequently corrected, in plaintiff's corporate name on its registration application was not fraudulent or misleading; and (ii) awarding plaintiff \$300 costs, including attorney's fees, incurred on the motion because defendant had raised the same "frivolous and dilatory" contention twice before. Defendant moved for reconsideration on the basis of a letter subsequently received from the Copyright Office concerning corrections of registration and argued further that plaintiff had made misrepresentations to the court concerning its registration.

*Held*, motion denied.

The court pointed out that the instant motion could not be considered one for reargument because it was not brought within the time limits of S.D.N.Y. Rule 9(m). Nor, held the court, was defendant entitled to relief under F.R.C.P. 60(b)(3) because the letter could have been "discovered" with reasonable diligence before the hearing of the prior motion and, in raising alleged misrepresentations, defendant was merely attempting to reargue plaintiff's earlier assertion that its certificate had been adequately corrected (a position actually supported by the proffered letter). The court also found nothing to indicate that the award of expenses was unjustified "even if reconsideration were appropriate at this late stage. . . ."

22. *Chappell & Co., Inc. v. Frankel*, 285 F. Supp. 798, 157 U.S.P.Q. 693 (S.D.N.Y., April 22, 1968) (MacMahon, J.)

Action for infringement of copyright in four musical compositions by several music publishers against the president of two corporations which had produced and distributed an album containing the works in question (plaintiffs had also filed as yet unsatisfied claims in bankruptcy against the two corporations).

*Held*, judgment for plaintiff; determination of damages referred to a special master.

I. After reviewing the license recording systems of the plaintiffs, the court found that a search of their records and those of the Harry Fox Office showed that no mechanical license for reproduction of the compositions was ever issued to the corporations; further, the Fox Office, as collection agent, never received royalty payments for the compositions and, in fact, lacked authority to issue licenses for these plaintiffs.

II. Defendant was a major shareholder in, and a director and president of, the two corporations. He knew that licenses were usually negotiated by his vice-president but had no knowledge whether the works in question were licensed. He did, however, negotiate the acquisition of the masters and the reproduction thereof. He was also responsible for the arrangement of the songs on the recordings which were sold under the banner "J. Jay Frankel presents . . ." "In a word", said the court, "he caused the whole process of infringement" and was thus personally, jointly and severally liable notwithstanding his alleged lack of knowledge of infringement.

23. *Morser v. Bengor Products Co., Inc.*, 283 F. Supp. 926, 159 U.S.P.Q. 267 (S.D.N.Y., May 1, 1968) (MacMahon, J.)

Action for infringement of copyright in a novelty coin designed by plaintiff. In granting partial summary judgment, Judge Byran had previously held the copyright valid, determined that the corporate defendant, in purchasing and selling infringing coins, was an infringer, and set down for trial the issues of damages and the personal liability of a corporate employee who admitted that he supervised the purchase of the infringing coins and the filling of orders therefor but denied any knowledge of infringement and asserted that, after receiving notice of plaintiff's claim, he instructed that no further orders be filled; however, an order was in fact filled five months later.

*Held*, judgment for plaintiff against the corporation and one of its employees in the amount of \$250 plus costs, not including counsel fees.

I. The court held the employee to be personally liable as a participatory infringer, "an intent to infringe or knowledge of infringement" not constituting elements of liability. The sale after notice was found to be due to an innocent mistake on the part of another employee and thus to be an insufficient predicate for *punitive* damages.

II. Plaintiff was unable to prove actual damages and although defendant's total sales were established (\$32.50 at \$5.00 per hundred), defendant did not demonstrate its costs. On this basis, the court held an award of statutory damages to be appropriate but "in view of the inexpensive product involved", assessed the award at the statutory minimum of \$250 rather than the maximum of \$5,000 sought by plaintiff. Counsel fees were denied because defendant's decision to resist the claim although infringement was quite clear was deemed understandable in light of the sizeable damages sought by plaintiff.

24. *United States v. Slapo*, 285 F. Supp. 513 (S.D.N.Y., May 31, 1968) (Weinfeld, J.)

Prosecution for alleged assembly and sale of books containing copyrighted musical compositions reprinted and published without the copyright owners' consent.

*Held:* Defendants' motion to dismiss was denied.

The court observed that even "assuming, as defendants allege, that 'fake books' have been accepted by the music industry without opposition, we have not yet reached the point . . . where an industry custom and practice serves to repeal criminal laws." The court added that the absence of infringement actions by the copyright owners would not bar a criminal prosecution. Defendants' motion to suppress evidence obtained pursuant to search warrants was also denied.

25. *First Financial Marketing Services Group, Inc. v. Field Promotions, Inc.*, 286 F. Supp. 295 (S.D.N.Y., July 5, 1968) (Pollack, J.)

Motion to dismiss complaint seeking declaratory judgment that plaintiff is not infringing defendant's copyright. Plaintiff alleged that it had acquired "ownership and the exclusive right to sell" a combined self-scoring credit test and bank loan application form ("Loan Alone") "throughout the United States, except in the State of Ohio" from the Winters National Bank ("Winters") which had created and copyrighted such form and that defendant had threatened to sue plaintiff for infringement of copyright in its similar "Zip" forms.



*Held*, motion granted to the extent that unless plaintiff within 60 days amends its complaint to allege copyright ownership or amends its summons and complaint to join Winters as a voluntary or involuntary plaintiff, the action will be dismissed.

The court found that the validity of copyright in the "Loan Alone" form would be in issue and that, under the "indivisibility" doctrine and in view of the geographic division alleged in the complaint, Winters must be deemed the proprietor thereof and hence an indispensable party. The court said:

. . . a transfer to be effective as a transfer of ownership must convey all ownership rights. . . . When the rights are split up and partially assigned as to time, place, or particular rights or privileges, the limited grant of exclusive rights operates merely as a license. . . . plaintiff appears to be Winters' exclusive licensee within a limited territory. No facts have been pleaded to support the other possibility — that Winters is plaintiff's licensee, on a "lease-back" arrangement, for the State of Ohio. . . .

26. *Cone Mills, Inc. v. Levine & Company, Inc.*, 286 F. Supp. 323 (S.D. N.Y., July 2, 1968) (Pollack, J.)

Proceeding for an order holding defendants in contempt for admitted violations of an order temporarily restraining them from infringing plaintiff's copyrighted design.

*Held*: The court held that a lack of willfulness on the part of defendants in selling textiles bearing an infringing design does not constitute a defense to a charge of civil contempt.

27. *United Merchants and Manufacturers, Inc. v. Sutton*, 282 F. Supp. 588, 157 U.S.P.Q. 487 (S.D.N.Y., August 14, 1967) (Tenney, J.)

Motion for preliminary injunction in action for copyright infringement and unfair competition. The complaint alleged that defendant duplicated plaintiff's copyrighted and uncopyrighted floral designs on fabric "tote" bags manufactured in Japan. It was undisputed that defendant had visited plaintiff's "trade only" fabric showroom and purchased samples bearing the designs in question.

*Held*, motion granted with respect to the copyrighted designs only.

I. The court held that the designs for which plaintiff claimed copyright protection were sufficiently "original": "Copyrighted matter

need not be strikingly unique or novel. All that is required is that the 'author' do something on his own which is more than a trivial variation." Although defendant submitted numerous floral designs allegedly substantially similar to plaintiff's, the court questioned the probative force of such showing because the exhibits themselves might constitute infringements; at any rate, the court found none of the proffered designs to be so similar to plaintiff's as to justify a finding of copying therefrom.

The court also held that plaintiff had complied with the notice requirements by "adequate markings" on the selvage of each yard of its goods.

Access being uncontroverted, sufficient similarity between the parties' designs was found, as to one of plaintiff's patterns, because "although there might be some points of difference . . . the overall aesthetic appeal of the two designs is so similar as to warrant a finding that an observer possessing ordinary qualities of discernment who was not attempting to discover disparities would be taken in". Defendant conceded the identity between plaintiff's other copyrighted design and its own.

Defendant asserted that preliminary relief was unwarranted because it had discontinued production of one of its allegedly infringing designs and because of the sufficiency of money damages. But the court found that defendant had not carried its "heavy burden of demonstrating that they have no reasonable expectation of committing the wrong anew" and, stating that where copyright validity is established a preliminary injunction will issue without a detailed showing of irreparable harm, held plaintiff's allegation that the presence on the market of infringing goods destroyed the "saleability and value of original goods" to be sufficient.

II. No copyright protection was claimed for other of plaintiff's designs because the selvage notice had been blurred. Plaintiff, however, alleged a "custom of the trade" against the purchasing of samples for copying and, further, that upon buying the samples defendant had signed an agreement providing that the buyer would not copy the designs appearing on purchased fabric. The court refused to grant temporary relief on the grounds that "a more detailed showing of irreparable harm" was required than in the case of the copyrighted designs and had not been demonstrated.

III. Plaintiff also claimed a right to relief under Section 43(a) of the Lanham Act because defendant allegedly attached labels to their bags bearing the notations "original import", "made in Japan" and "copyright". The court held, however, that the mere unsupported allegation of likelihood of damage due to misdescription was insufficient to warrant extraordinary relief and, moreover, that it did not appear

likely that the tags would mislead the consuming public and that money damages, if any, would be sufficient.

28. *Yameta Co., Ltd. v. Capitol Records, Inc.*, 279 F. Supp. 582, 157 U.S.P.Q. 491 (S.D.N.Y., Feb. 3, 1968) (Metzner, J.)

Preliminary injunction granted in action for unfair competition. The court held that singer-guitarist Jimi Hendrix was entitled to restrain defendant, pursuant to §43(a) of the Lanham Act, 15 U.S.C. §1125(a), from falsely representing that Hendrix was the principal performer on a record album when in fact he was merely an accompanist. The offending record jacket said "Jimi Hendrix plays and Curtis Knight sings" but Hendrix' name appeared in considerably larger letters than Knight's, and the words "plays" and "sings" were in much smaller type. In addition, the album cover carried a picture of Hendrix alone looking as though he were singing, and at least one advertisement for the album referred to Hendrix alone in its text.

### 3. State Court Decisions

29. *Turner v. Century House Publishing Co., Inc.*, 290 N.Y.S.2d 637 (Sup. Ct., June 5, 1968) (Bryant, J.)

Action for infringement of common law copyright in plaintiff's unpublished manuscript. Plaintiff had agreed with the corporate defendant to write a book about flatware of the Victorian period. After the submission of initial manuscripts the agreement was terminated over a dispute on deadlines. The corporate defendant subsequently published an allegedly infringing book dealing with the same subject matter and written by its co-defendant president.

*Held*: dismissed; exemplary damages awarded to plaintiff for defendants' violation of an order entered in previous litigation between the parties.

I. Noting the individual defendant's own experience in the field and use of source materials to which both parties had ready access, and finding that errors common to both works were "repeated in other publications and easily traceable to common sources used by both parties", the court found that an examination of the works under the "ordinary observer" test disclosed similarities which were at most "insubstantial" and hence insufficient to sustain the cause of action. The court enunciated, *inter alia*, the following criteria of decision:

The property right in an unpublished manuscript . . . is limited to the particular statement or compilation and does not extend to

the plan adopted for imparting information [nor] prevent another person from making an independent collection of the same facts or information and using it as his own. . . . Copying consists in the exact or substantial reproduction of an original, using such original as a model as distinguished from an independent production of the same thing. . . . Plaintiff could not acquire a monopoly in the narration of historical events.

II. However, one chapter of defendants' book was found to be a rewritten copy of matter written by plaintiff and previously published by the individual defendant under his own pen name, for which plaintiff had already secured injunctive relief. Although finding that "the material in this chapter, as it now appears, [is not] such a substantial part of the defendants' book as to affect the decision in this case", the court held "that this chapter has been re-used in violation . . . of the order issued in the prior action" and awarded plaintiff \$400 exemplary damages.

30. *Spahn v. Julian Messner, Inc.*, 286 N.Y.S.2d 832 (Ct. App., Dec. 28, 1967) (Keating, J.), *prob. juris. noted*, 37 U.S.L.W. 3118 (U.S. Sup. Ct., Oct. 15, 1968). *For earlier decision, see* 274 N.Y.S.2d 877 (1966), 14 BULL. CR. SOC. 333, Item 229 (1966).

On remand from the U.S. Supreme Court, reconsideration of appeal from an order of the Appellate Division affirming judgment for plaintiff in an action for invasion of privacy under N.Y. Civil Rights Law §51.<sup>1</sup> Plaintiff, a famous baseball player, complained of defendant's unauthorized and fictionalized purported biography of plaintiff directed at juvenile readers.

*Held, affirmed.*

I. Holding that before a public figure may recover for an "unauthorized presentation of his life" he must demonstrate that the work is "infected with material and substantial falsification and that [it] was published with knowledge of such falsification or with a reckless disregard for the truth", the court found that defendant had failed to

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1. In 250 N.Y.S.2d 529 (Sup. Ct., 1964) the trial court entered judgment for plaintiff which was affirmed by the Appellate Division at 260 N.Y.S.2d 451 (1965), in turn affirmed by the Court of Appeals at 274 N.Y.S.2d 877 (1966). At 387 U.S. 236 (1967) the Supreme Court reversed and remanded the case to the Court of Appeals for reconsideration in light of *Time, Inc. v. Hill*, 385 U.S. 374 (1967). The Court of Appeals then vacated its prior order of affirmance, at 20 N.Y.2d 752 (1967), and set the case down for reargument from which ensued this opinion.

explain how an "all-pervasive use of imaginary incidents . . . invented dialogue . . . and attributed thoughts and feelings . . . which were . . . the [conscious] figment of the author's imagination can be said not to constitute knowing falsity". Although acknowledging the possibility of, but not recognizing, a defense based on literary technique allegedly customary in writing children's books, the court found that such a defense could not succeed where the author of the purported biography engaged in a minimal degree of research, amounting to little more than the use of newspaper clippings the authenticity of which was "rarely, if ever, checked out". The court said that to "hold that this research effort entitles the defendants to publish the kind of knowing fictionalization presented here would amount to granting a literary license which is not only unnecessary to the protection of free speech but destructive of an individual's right — albeit a limited one in the case of a public figure — to be free of the commercial exploitation of his name and personality."

II. In a dissenting opinion Judge Bergan, with whom concurred Chief Judge Fuld, observed that it was "difficult to apply precisely the criteria of" the relevant Supreme Court cases for "All fiction is false in the literal sense that it is imagined rather than actual [and] it is . . . 'calculated' because the author knows he is writing fiction . . . ; and it is more than a 'reckless' disregard for truth [because] fiction is the conscious antithesis of truth". Finding that the term "calculated falsehood" as used by the Supreme Court has "some of the traditional common law overtones of meaning in the sense of wrongful injury", the dissenters concluded that the New York privacy statute should not be held to protect against the fictionalization of the life of a voluntary public figure "not shown to hurt him and not shown designed to hurt him."

31. *State's Attorney for Prince George's County v. Sekuler*, 158 U.S.P.Q. 231 (Md. Ct. App., April 9, 1968) (McWilliams, J.)

State's appeal from decision holding Art. 31, Sec. 232(A) of the Maryland Code invalid. This apparently unique statute made it a misdemeanor for anyone other than specified State agencies to reproduce for profit certain maps produced and sold by the Maryland Department of Taxation and Assessments.

*Held*, affirmed.

Observing that the provision in question was "not aimed at the prohibition of any use which would mislead the public as to the source of the maps; it simply prohibits absolutely their reproduction . . . for the purpose of . . . profit thereby creating a monopoly in the State",

the court held the statute to be in conflict with the Federal Copyright Act and, by virtue of the Supremacy Clause of the Constitution, invalid under the doctrine of *Sears and Compco*. The court added, however, that "the State is free to seek relief against the 'unfair competition' of Sekuler in the equity courts".<sup>1</sup>

*Also of interest:*

32. *Sigma Productions, Inc. v. Dunaway*, N.Y.L.J., Feb. 19, 1968 at 18, col. 3 (Sup. Ct. N.Y. Co., 1968) (Hecht, J.)

Motion for preliminary injunction restraining defendant actress from rendering performing services for anyone but plaintiff until her contractual obligations are fulfilled and directing defendant to render services to plaintiff in accordance with such obligations. Plaintiff motion picture producer alleged that it had exercised its option to future services of defendant by notice that she appear for a specially written role in a photoplay scheduled for production and that defendant had failed to comply.

*Held*, motion denied.

I. The request for affirmative relief was refused because equity will not direct performance of a contract for personal services.

II. The request for a negative injunction was denied due to the presence of material factual disputes, such as the fairness and conscionability of defendant's contract with plaintiff and the latter's compliance with the notice provisions of the option, which could not be resolved on motion. Also, there was serious question as to the "uniqueness" of defendant's services. The court said:

Absent a clear showing of the uniqueness of a performer in the entertainment industry, or that the performer cannot be replaced, a preliminary injunction will not be granted. . . . While plaintiff's president asserts that a role had been especially created for defendant, he concedes that he has interviewed [for replacements] and that the principal difficulties in finding a replacement are . . . production schedule commitments and . . . salary. While finding a replacement may be "difficult", this does not substantiate the claim that replacement is "impossible". Plaintiff's president advises that the specially written role is that of "a sophisticated, attractive woman of about 25, who has what is commonly referred to as 'sex appeal' but also has intelligence and sensitivity." [But] this court is reluctant

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1. But note that petitioner's uncontroverted testimony below was to the effect that he did no more than reproduce and sell the maps; he did not remove the State's legend nor indicate that they were the product of his own efforts.

to grant the drastic relief requested simply on the basis of Mr. Preminger's apparent suggestion that in the entire entertainment industry only Miss Dunaway has the "particular and unique talent . . . to convey all of these disparate qualities at one time."

The court added that a clause in her contract with plaintiff by which defendant affirmed the unique nature of her services could not supplant the required showing of fact because private parties may not determine whether a court of equity will act.

III. The court, however, recognized that plaintiff had already incurred substantial expenses for the photoplay and that production commitments made it likely that any delay in a decision on the merits would result in monetary damages of such magnitude as to be uncollectible even should plaintiff prevail. Further, added the court, the significance of defendant's challenge to the enforceability of allegedly "standard" motion picture option provisions rendered the issues deserving of a most thorough evidentiary investigation. For these reasons the decision was qualified in that the motion was denied without prejudice to renewal in the event defendant failed to consent to immediate trial upon ten days' notice.

33. *Rosemont Enterprises, Inc. v. Random House, Inc.*, N.Y.L.J., April 3, 1968 at 2, col. 2 (Sup. Ct. N.Y. Co., 1968) (Frank, J.). *For earlier related decisions, see* 256 F. Supp. 55, 150 U.S.P.Q. 367 (S.D.N.Y., 1966), 14 BULL. CR. SOC. 323, Item 225 (1967), *reversed*, 366 F.2d 303, 150 U.S.P.Q. 715 (2d Cir., 1966), 13 BULL. CR. SOC. 411, Item 434 (1966), *cert. denied*, 385 U.S. 1009 (1967).

Action for violations of the rights of privacy and publicity. Defendants, the author and publisher of an unauthorized but apparently truthful biography of Howard Hughes, moved for summary judgment in an action commenced by a corporation organized by close associates of Hughes for the ostensible purpose of preparing an authorized version of his life story.

*Held*, motion granted.

The court held that, as a "public figure", albeit a hesitant one, Hughes had no right to suppress a truthful account of his life notwithstanding that it may have been prepared and published for profit. Plaintiff's argument that it was objecting, not to the *contents* of the book, but to the *conduct* of defendants in its preparation (*e.g.*, to defendants' alleged plagiarism, lack of research, and other activity at odds with normal publishing customs) was deemed "wholly irrelevant" in the

absence of demonstrated "material and substantial falsification" in the work. Only if such a showing had been made, said the court, would plaintiff's allegations assume relevance with regard to proving defendants' knowledge of falsity or reckless disregard for the truth. At any rate, added the court, Hughes' right of privacy under the New York statute was purely personal and could not be enforced by the corporation. Plaintiff's attempt to sustain the case as the assignee of Hughes' right of publicity was equally unavailing because "just as a public figure's 'right of privacy' must yield to the public interest, so too must the 'right of publicity' bow where such conflicts with the free dissemination of . . . matters of public interest."

34. *Sound of Music Co. v. Rogers*, N.Y.L.J., April 17, 1968 at 2, col. 5 (Sup. Ct. N.Y. Co., 1968) (Murtagh, J.)

Petition for order confirming arbitrator's award; cross-application to vacate the award on the grounds the arbitrator exceeded his authority in granting an award to petitioner without finding, as required by the arbitration agreement, that respondents had committed "fraud or wilful misconduct".

*Held*, award confirmed; cross-application denied.

Petitioner Sound of Music Co. was the assignee of the rights of the producers of the stage play "Sound of Music" under a 1959 production agreement with the respondent authors of the music and lyrics for the play. The production contract provided that the proceeds derived from the authors' disposition of "motion picture rights" were to be shared in specified proportion with the producers and provided for arbitration of disputes qualified to the extent that the producers might not recover unless the below-described misconduct had been demonstrated. Contending that respondents had deprived them of their rightful share of proceeds from the disposition of motion picture sound track recording rights, petitioners commenced arbitration. Although respondents asserted that the term "motion picture rights" in the production contract did not include the motion picture sound track rights, the arbitrator noted that "the importance of sound-track album rights was not as widely recognized in 1959 as in more recent years; in fact the development of these rights has moved so rapidly that analogies to contracts of recent date have no persuasive bearing. . . ." Although, in order to avoid the "tarbrush of fraud, intentional fraud, [being] put on anyone", the arbitrator several times declined to deal expressly in terms of "fraud or wilful misconduct", the court found that a sufficient determination had been made that "by retaining the benefits derived from the wrongful acts of their representatives, respondents were, themselves, guilty of



willful misconduct." The "wrongful acts" consisted of arrangements made for the control, manufacture and sale of the motion picture sound track albums without the knowledge of petitioners—i.e., (i) with the knowledge of petitioners, respondents had entered into an agreement with a film company for the sale of motion picture rights, the authors' share of the gross receipts of the film to include the gross from the distribution of the picture "and all other rights"; but, (ii) without the knowledge of petitioners, respondents' representatives negotiated a side deal with the motion picture company by which respondents obtained the exclusive right to manufacture and sell the motion picture sound track albums; as a result of which (iii) respondents received the sound track, made arrangements for the manufacture and sale of albums therefrom, and profited immensely without any accounting being made for the rights of the petitioners.

35. *Elliot v. Roulette Records, Inc.*, N.Y.L.J., May 9, 1968 at 16, col. 1 (Sup. Ct. N.Y. Co., 1968) (*Quinn, J.*)

Motion for temporary injunction in action to restrain defendant record company from using the designation "Mama Cass" in marketing records made for defendant's predecessor by the singer Cass Elliot. Defendant's right to market the records and use the name "Cass Elliot" in connection therewith was not challenged; however, plaintiff record company alleged that the sobriquet "Mama Cass" was adopted by Elliot and promoted and made vastly more popular through its own efforts after Elliot had terminated her relationship with defendant's predecessor and had, together with a group collectively having become known as "The Mamas and the Papas", become associated with plaintiff.

*Held*, motion denied for failure to demonstrate a clear right to relief.

The court observed that Elliot's grant to defendant's predecessor of the "right to use the artist's name and all biographical material concerning the artist" did not limit defendant to keeping her biographical data static; nor did it prohibit defendant "from publishing and advertising such up-to-date information, including adaptations of name, as may identify Cass Elliot with any after-acquired, revived, or increased popularity even though gained under the auspices or through the public promotional efforts of others. . . ."

36. *Rand v. Hearst Corporation*, N.Y.L.J., August 13, 1968 at 9, col. 1 (Sup. Ct. N.Y. Co., 1968)

Action for invasion of privacy under N.Y. Civil Rights Law §51.

*Held:*

Holding that "a famous public figure has a cause of action under the Civil Rights Law if his name . . . is used . . . without his consent for purposes of advertising or trade, whether the statement is true or false, or whether it is done without malice or is a custom of the trade", and indicating that "purely commercial" uses of another's name or likeness are subject to more stringent limitations than other appropriations of personality, the court sustained the sufficiency of a complaint alleging that defendant published a paperback book on the front cover of which appeared an excerpt from a book review containing plaintiff's name and that plaintiff, a well-known author and lecturer, never consented to such use. Apparently, the book reviewer's use of plaintiff's name was deemed "privileged" as contrasted with defendant's "commercial" use of the extract.

37. *Universal City Studios, Inc. v. Arete Productions, Inc.*, N.Y.L.J., August 22, 1968 at 9, col. 2 (Sup. Ct. N.Y. Co., 1968) (Gellinoff, J.)

Motion for temporary injunction restraining defendant from televising commercials for "Muriel" Cigars in which the song "Big Spender" is performed dramatically with a parody of the lyric. Plaintiff, the producer of a motion picture version of the musical play "Sweet Charity" which included the song in question, claimed that it acquired exclusive motion picture rights to the play and all its constituent parts, that the first big production number in its lavish and expensive motion picture is to feature "Big Spender," and that the use of the commercials in a planned saturation campaign prior to the opening of the picture "will debase plaintiff's motion picture with commercial association" and impede plaintiff's advertising and sales efforts. Defendant denied plaintiff's allegations, controverted any inconsistency between the divergent uses of the song, and asserted that plaintiff's motion picture rights did not include television commercial rights.

*Held*, motion denied as "not warranted at this time, especially where plaintiff can get all the relief to which it can show it is entitled through a quick trial."

38. *Smith v. Waite*, 158 U.S.P.Q. 111 (Texas Ct. Civ. App., Jan. 11, 1968) (McDonald, J.)

Appeal from summary judgment for defendant in action for breach of franchise agreement.

*Held*, reversed: "The franchise agreement does not violate the Texas Anti-Trust Laws. The owner of a patent, copyright or trademark

may franchise out by contract the right to use such patent, copyright or trademark.”

39. *Cowles Magazines and Broadcasting, Inc. v. Elysium, Inc.*, 63 Cal. Rptr. 507 (Ct. App., Nov. 7, 1967 as modified Dec. 4, 1967).

Appeal from order granting the publisher of “Look” magazine a preliminary injunction against defendant’s use of the magazine title “Nude Look”.

*Held*, reversed. The evidence was insufficient as a matter of law to sustain a finding of likelihood of public confusion of source.

The court held that because of differences in the price, frequency of publication, subject matter, typography and cover format of the parties’ publications, the lack of any other evidence concerning deception, and the fact that the titles were not identical, confusion could be inferred only if the titles were found “colorably similar” upon comparison. “Colorable similarity”, said the court, “is not established by the fact that both tradenames have in common a single word. If Elysium’s tradename fixed attention . . . on the word ‘Look’ to the virtual exclusion of any other word . . . in its title, confusing similarity might result. . . . Attention may thus be focused upon ‘Look’ by the artful use of typography, design, or other device . . . or by the use of an accompanying word that is colorless. . . . [However] the words ‘Nude’ and ‘Look’ are given equal prominence on Elysium’s covers; it cannot be said that the word ‘Nude’ is colorless.”

#### 4. Opinion of the Comptroller General

40. *Opinion of the Comptroller General of the United States*, No. B-163867, 158 U.S.P.Q. 172 (May 21, 1968).

On March 20, 1968 Senator John J. Williams wrote the Comptroller General concerning the publication by the New York *Times* and Bantam Books, with the *Times*’s copyright notice, of the recent Report of the National Advisory Commission on Civil Disorders. Senator Williams observed that the Times-Bantam edition came out the day following the release of the Report while the official U.S. Government Printing Office version did not appear until sometime later. The Senator also stated that because the Times-Bantam edition was brought out under copyright other private interests could not reprint the Report until the Government Printing Office edition was released, “thereby placing the report content in the public domain”. Thus, Senator William asserted, Times-Bantam was in an exclusive position for a period during which funds

which would have gone to the U.S. Treasury had the GPO published earlier were diverted to private interests occupying a monopolistic position. The Senator requested a report as to the propriety of the conduct of the Commission and GPO. The Comptroller General's response made the following points:

I. Contrary to the Senator's assumption predicated on the copyright of the Times-Bantam edition, the "report itself was in the public domain from the first and could have been safely reprinted by any publisher at any time. . . ." Although the Bantam edition did contain new matter (pictures and an introduction) the Comptroller General did "not believe it reasonable to conclude that those in the publishing business are not sufficiently sophisticated to have appreciated their right to publish the report itself as opposed to the pictures and introduction." It was found, however, that as a practical matter "publication by another firm after Bantam's edition appeared was probably not feasible".

II. The Comptroller General's inquiry disclosed that GPO did in fact print an advance version of the Report prior to release of the Bantam edition but that, upon instructions from GSA (the requisitioning agency), distribution thereof was limited to the President, his Cabinet, members of Congress and the press. It was further indicated that the requirements of publication rendered it "doubtful" if GPO could have accelerated publication of its final mass-distributed version. However, Times-Bantam was apparently given a preferential position in printing a pre-GPO commercial edition and it was deemed "inappropriate that a single private publisher should be given the economic advantage of making public the contents of a Federally financed document of wide public interest". "It seems", continued the Opinion, "that despite the absence of applicable statute, fundamental standards of fairness and propriety require that no single publisher [be] given a pecuniary advantage without offering the same opportunity to others." Concerning the asserted loss of funds to the Treasury, the Comptroller General added that GPO was not intended to profit from the sale of documents and that it was therefore reasonable to consider any loss of sales offset by the elimination of production costs.

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## PART V.

## BIBLIOGRAPHY

## A. BOOKS AND TREATISES

## 1. United States Publications

41. ALLERTON PARK INSTITUTE, *14th, 1967*. Trends in American publishing; papers presented at an Institute conducted by the University of Illinois Graduate School of Library Science, November 5-8, 1967. Edited by Kathryn Luther Henderson. Champaign, University of Illinois Graduate School of Library Science [1968]. 105 p.

Contents: Major trends in American book publishing, by Dan Lacy; Current trends in American publishing, by Charles Madison; The economics of publishing, by Robert W. Frase; The prospective new copyright law, by Abe A. Goldman; The role of computers, by Daniel Melcher; Current trends in educational publishing, a personal view, by Robert J. R. Follett; A librarian looks at American publishing, by Edwin Castagna; Bookstores: a main distribution agency for books, by Louis Epstein; The American university press, by Emily Schlossberger.

The papers "describe some of the current trends in American publishing and . . . assess their implications for the future."

42. AMERICAN BAR ASSOCIATION. *Section of Patent, Trademark and Copyright Law*. 1968 Committee reports to be presented at the annual meeting to be held August 3-8, 1968, Philadelphia, Pennsylvania. Editor: Edward C. Vandenburg. Chicago, American Bar Center [1968]. 197 p.

Includes reports of Copyright Division committees dealing with copyright legislation, international copyright treaties and laws, Copyright Office affairs, program for revision of the copyright law, program for protection of industrial designs, neighboring rights, authors, and Government relations to copyrights.

43. CLAPP, VERNER W. Copyright—a librarian's view. Prepared for the National Advisory Commission on Libraries. Washington, Copyright Committee, Association of Research Libraries, Aug. 1968. 40 p.

An expression of the librarian's point of view that the copyright law should be revised so as to permit a library, under certain

conditions, to provide photocopies, particularly a single photocopy, of copyrighted materials in its collections to any applicant, without the payment of royalties.

44. **LAWLOR, REED C.** Copyright and patent protection for computer programs. [New York] Diebold Group, Inc., ©1968. 7 p. The Diebold research program professional paper series. Document No. PP 24.

An argument is made for strengthening the patent and copyright laws "in order to encourage the creation of new programs."

## 2. Foreign Publications

45. **KUMMER, MAX.** Das urheberrechtlich schützbare Werk. Bern, Stämpfli, 1968. 229 p. Abhandlungen zum schweizerischen Recht, n. F., Bd. 384.

A treatise on the subject matter of copyright, containing an analysis of the notion of "work" (Das Werk) followed by a discussion of the protectibility of various kinds of works, including those produced with the use of electronic and mechanical devices.

46. **JARACH, GIORGIO.** Manuale del diritto d'autore. 1. ed. Milano, U. Mursia [1968]. 461 p. Il Bivio; guide e manuali: Serie libri completi.

A handbook on the Italian copyright law, couched in non-technical language. The appendices include texts of pertinent laws, decrees, regulations, and texts in Italian, of the Brussels and Stockholm revisions of the Berne Convention, and of the Universal Copyright Convention.

47. **RUSSELL-CLARKE, ALAN DAUBENY.** Copyright in industrial designs. 4th ed. London, Sweet & Maxwell, 1968. 237 p.

An updating of a comprehensive text on copyright in industrial designs in the United Kingdom. Appendices include texts of pertinent laws and regulations.

---

## B. LAW REVIEW ARTICLES

### 1. United States

48. BENWAY, RICHARD F. Patents, copyrights and trademarks compared and distinguished. (3 *Portia Law Journal* 17-29, no. 1, Fall 1967.)

An examination of "each [form of intangible personal property] in terms of definition, historical development, administrative prerequisites to issuance, and social utility."

49. CARSON, E. JANE, and WILLIAM J. DOWELL. Copyright—CATV copyright liability. (36 *The George Washington Law Review* 672-678, no. 3, Mar. 1968.)

A critical note on the appellate decision in *United Artists Television, Inc. v. Fortnightly Corp.*, 377 F.2d 872, 15 BULL. CR. SOC. 46, Item 25 (2d Cir. 1967).

50. Copyright pre-emption and character values: the *Paladin* case as an extension of *Sears and Compco*. (66 *Michigan Law Review* 1018-1039, no. 5, Mar. 1968.)

A comment on *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315, 15 BULL. CR. SOC. 37 Item 23 (1st Cir. 1967).

51. GROSSLAND, HUGH J. The rise and fall of fair use: the protection of literary materials against copyright infringement by new and developing media. (20 *South Carolina Law Review* 153-242, no. 2, 1968.)

Among the conclusions reached are "that a provision be added to the Copyright Act establishing a statutory licensing system with a private clearinghouse," and that a moral right doctrine be recognized and incorporated in the American legal system.

52. FLETCHER, RICHARD L., JR., and STEPHEN P. SMITH, III. Computers, the copyright law and its revision. (20 *University of Florida Law Review* 386-410, no. 3, Winter 1968.)

A note, recipient of the Gertrude Brick Law Review Apprentice Prize for the best student note submitted in the Fall 1967 term at the University of Florida College of Law, which deals with the following questions, "primarily as the proposed revision applies to them, but also with reference to the existing copyright law":

1. Does a computer program fit within the present statutory scheme for legal protection?

2. How will the proposed revision change the present status of the program?

3. Does the use of copyrighted materials in a computer infringe the author's copyright?

4. If the proposed revision changes existing law on these questions, are these changes desirable?

53. GOLDSTEIN, PAUL. Copyrighting the new music. (17 *Buffalo Law Review* 355-373, no. 2, Winter 1968.)

A paper, awarded National First Prize in the Nathan Burkan Memorial Competition, which attempts to answer the questions "whether, and how, the law is to accord copyright protection to the new music." "New music" is characterized as being "usually spontaneous in origin because of the absence of a notated score . . . catholic in its embrace, including not only musical and non-musical sounds, but theatrics, monologues, pantomime and choreography as well . . . [and] intractible; its infinitely varied emissions of sounds, and the equally varied antics of its participants, render it difficult of any notation subsequent to performance."

54. MYERS, GARY R. Section 113 of the proposed copyright law revision—a proposed amendment to protect the utilitarian aspects of useful articles. (72 *Dickinson Law Review* 307-324, no. 2, Winter 1968.)

"This Comment [which has been submitted to the Nathan Burkan Memorial Competition at Dickinson School of Law, 1968] will analyze the copyright protection granted pursuant to . . . [the proposed] revision and will also investigate utility and design patent protection for useful articles. The deficiencies of current patent and copyright protection will be noted and an amendment to section 113 will be suggested to overcome these deficiencies by providing a hybrid patent-copyright protection for useful articles."

55. UCLA LAW REVIEW. Project: New technology and the law of copyright: reprography and computers. Foreword: Two copyright crises, by Melville B. Nimmer. (15 *UCLA Law Review* 931-1030, no. 3, Apr. 1968.)

A study, by the editors of the *UCLA Law Review*, funded by the National Endowment of the Arts, and "conducted largely through interview with congressmen, attorneys, members of governmental agencies, librarians, and manufacturers and users of reprographic devices and computers." The study explores the nature and



significance of new machine copying technology and computer developments, suggests "particular avenues for reconciling the competing interests of the public and of the author," and in general, purposes to aid those who must ultimately devise "solutions to the perplexing copyright problems raised by the new technology."

## 2. Foreign

### 1. English

56. GRASSI, ALEXANDRO. Possible actions to put down parasitic television advertising in stadia on the occasion of televised football matches. (*EBU Review* 49-52, no. 110B, July 1968.)

A brief outline of possible remedies offered by Italian laws against the siting of posters, placards and advertising devices so that they come into the picture taken by television cameras, with the author's preference being in favor of an action for unfair competition.

57. HENNEBERG, IVAN. The scope of protection according to the Stockholm Act of the Berne Convention. (4 *Copyright* 167-170, no. 7, July 1968.)

After a comparison of the pertinent provisions of the Stockholm revision with those of the Brussels text, a conclusion is reached that "there is no difference of substance between the Brussels Act and the Stockholm Act. The latter merely improved the drafting of the Brussels Act by avoiding the words 'the rights granted by this convention' which had given rise to different interpretations as to the scope of protection under the Convention."

58. LARRUE, MADELEINE. Sports programmes and international television: the legal aspect. (*EBU Review* 52-58, no. 110B, July 1968.)

"At the beginning of this rapid review . . . [the author] described a discouraging situation in which broadcasters had to bring the sports promoters round to the view that the television of a sporting event was in no way prejudicial to their interests but would, on the contrary, provide them with a still larger audience. And having ended with a discussion of the international television contracts regarding such events as the Olympic Games . . . [he] leave[s] the reader the judge of the progress made in reconciling the two points of view."

59. MASOUYE, CLAUDE. Copyright and television exchanges. (*EBU Review* 59-64, no. 110B, July 1968.)

A discussion of "the question whether the European Agreement concerning Programme Exchanges by means of Television Films . . . contains provisions contrary to those adopted in Stockholm during the revision of the Berne Convention."

## 2. French

60. ULMER, EUGEN. Droit comparé et recherche fondamentale en matière de droit d'auteur et de droit de la propriété industrielle. (*39 II Diritto di Autore* 68-87, no. 1, Jan.-Mar. 1968.)

An address delivered on Oct. 17, 1967 by the director of the Max Planck Institute for Foreign and International Patent, Copyright and Unfair Competition Law, on the occasion of its inaugural meeting in Munich. The theme of the address was "Comparative law and basic research in the matter of copyright and industrial property law."

## 3. German

61. KLAVER, FRANCA. Die Drahtübertragung von Fernsehsendungen; Probleme des Urheberrechts und des Leistungsschutzes. (*Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil 215-227, no. 7, July 1968.)

A comparative study, under European, United States, and international laws, of copyright and neighboring rights problems posed by cable television.

62. ROEBER, GEORG. Das Recht der öffentlichen Wiedergabe und die Tantiemestellung der Verwertungsgesellschaften; Begriffs- und Abgrenzungsfragen für die Bereiche von Film und Fernsehen. (*12 Film und Recht* 148-154, no. 6, June 15, 1968.)

A discussion of conceptual and definitional problems of motion pictures and television with respect to the right of public presentation and royalty payments to performing rights societies under the copyright laws of the German Federal Republic.

63. ULMER, EUGEN. Die Stockholmer Konferenz für geistiges Eigentum. (21 *Neue Juristische Wochenschrift* 1009-1017, no. 22, May 30, 1968.)

An article on the Intellectual Property Conference of Stockholm and its accomplishments.

### C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

#### 1. United States

64. LINDUSKY, EUGENE M. Copyright violation: a moral issue. (2 *ASCAP Today* 32, no. 2, July 1968.)

A brief article, reprinted from *Musart*, official publication of the National Catholic Music Educators Association, which points out the immorality of unlicensed copying of copyrighted musical works in Catholic schools and churches.

65. LOWENS, IRVING. The copyright mess: showdown at the Circle C Ranch. (*The Sunday Star*, Washington, D. C., Sept. 1, 1968, pp. B7, B13.)

The music critic of the *Washington Star* points out some of the inadequacies of the present copyright law, comments on the failure of revision efforts, and concludes by quoting the phrase, "The time is now."

#### 2. England

66. GUASTAVINO, GUILLERMO. The problem of legal deposit, its advantages, possible courses of action. (22 *Unesco Bulletin for Libraries* 2-8, no. 1, Jan.-Feb. 1968.)

A brief consideration of the problems of establishment, regulations, compliance and use of a legal deposit system is concluded with a statement of the need for finding and applying "uniform, internationally valid solutions."

### NEWS BRIEFS

67. UNESCO Meeting on Copyright Protection for Translators.

An international meeting, sponsored by UNESCO, was held in Paris during the week of September 22, 1968, with regard to copyright protection for translators of literary, scientific and tech-

nical works. UNESCO had invited a Committee of Experts from all parts of the world to this meeting. The Department of State, upon the suggestion of the Register of Copyrights, invited Professor Walter J. Derenberg to serve as United States representative at the conference.

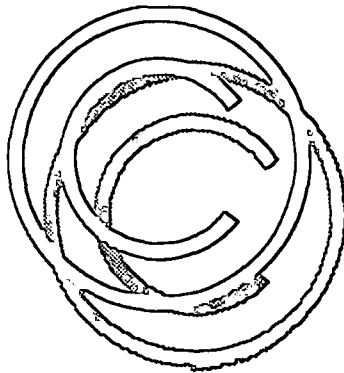
Other countries from which an expert was present included Great Britain, France, Italy, Denmark, Yugoslavia, Czechoslovakia, Iran, India, Ghana, Senegal, Ceylon, Japan, Mexico and Brazil. In addition there were numerous observers representing both translators' and publishers' interests, including the International Federation of Translators, the International Federation of Publishers, ALAI (Association Littéraire et Artistique Internationale), which was represented by Professor Henri Desbois, CISAC (the Confédération Internationale des Sociétés d'Auteurs et Compositeurs) and several other similar associations.

At the end of the meeting a comprehensive report, with recommendations for more effective protection of translators' rights both in developed and underdeveloped countries, was adopted and will soon become available from UNESCO.

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## PART I.

## ARTICLES

## 68. THE ROLE OF THE REGISTER OF COPYRIGHTS IN THE REGISTRATION PROCESS: A CRITICAL APPRAISAL OF CERTAIN EXCLUSIONARY REGULATIONS.\*

Under the Copyright Act,<sup>1</sup> the only action required in order to obtain a valid statutory copyright in a published work is publication with the prescribed notice.<sup>2</sup> In order to perfect the rights accruing under his copyright, however, the claimant must also "promptly" deposit two copies of the best edition of the copyrighted work, together with a claim of copyright, in the Copyright Office.<sup>3</sup> Fulfillment of this

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\* This scholarly and timely essay was written by Thomas A. Reed while a third-year law student at the University of Pennsylvania, and was awarded the 1968 First Prize in the Nathan Burkan Memorial Copyright Essay Competition by the Dean of that Law School. It was first published at 116 U. of Pa. L. Rev. 1380 (June 1968), and is reprinted here with the permission of the author, The American Society of Composers, Authors and Publishers, sponsors of the Burkan Competition, and the Editors of the University of Pennsylvania Law Review. Mr. Reed is now a member of the New York Bar.

1. 17 U.S.C. §§ 1-215 (1964).

2. *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939); *United States v. Backer*, 134 F.2d 533 (2d Cir. 1943). 17 U.S.C. § 10 (1964), provides: Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.

17 U.S.C. § 9 (1964) defines a "person entitled as "[t]he author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns . . . ." (subject to certain conditions set forth therein).

Statutory copyright is not available in unpublished works, except in certain classes of works not reproduced for sale, as to which copyright is obtained by depositing with the Copyright Office one copy of the work (or other identifying reproduction as specified by the statute), together with a claim of copyright. 17 U.S.C. § 12 (1964).

3. 17 U.S.C. § 13 (1964). In certain specified cases a single copy or other identifying reproduction will suffice.

requirement of registration and deposit is a condition precedent to any action for copyright infringement, but the copyright itself ordinarily remains valid pending fulfillment.<sup>4</sup> Thus, although most claimants register their works as a matter of course, registration may be deferred, without loss of any rights, until the eve of suit.

Unfortunately for some copyright claimants, however, the requirement of registration cannot be satisfied by the claimant's acts alone: recent cases also require that the Register of Copyrights actually issue a certificate of registration before infringement proceedings can be brought.<sup>5</sup> To the extent that the Register has any discretion to determine the validity of copyright claims and to withhold the certificate if he decides a claim is invalid, he can vitally affect a claimant's right to enforce his copyright. It is the purpose of this Comment to focus attention on the extent of the Register's discretion to refuse registration, examining the theoretical and legal bases for its existence, how it has in fact been exercised through Copyright Office regulations, and what remedies should be made available to those who may be adversely affected by the Register's decision.

## I. REGISTRATION

Unlike the Commissioner of Patents, whose statutory function is to grant or deny applications for patents after conducting a thorough search of his files and examining the inventions submitted to ascertain whether or not they meet certain statutory standards,<sup>6</sup> the Register of Copyrights is not charged with the function of granting copyright protection. With respect to copyright in published works, section 10 of the Copyright Act provides:

Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title . . . .<sup>7</sup>

With respect to certain classes of works not reproduced for sale, section 12 provides that copyright "may . . . be had" by making the appropri-

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4. *Id.*

5. *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958); *G. P. Putnam's Sons v. Lancer Books, Inc.*, 251 F.Supp. 210 (S.D.N.Y. 1966).

6. 35 U.S.C. §§100-04, 131 (1964).

7. 17 U.S.C. §10 (1964). The requirements regarding the proper form and placement of the copyright notice are specified in 17 U.S.C. §19 (1964).

ate deposit, accompanied by claim of copyright.<sup>8</sup> Thus, the steps required to secure copyright lie wholly within the control of the copyright claimant.

Notwithstanding the fact that copyright inheres in a work before the Register has taken any action, registration is not optional. Section 13 requires registration of all claims to copyright, together with prompt deposit of copies of all works, published and unpublished, in which copyright is claimed.<sup>9</sup> This requirement of deposit and registration is of vital importance to the functioning of the copyright system. Were it not for the central depository and file provided by the Copyright Office, it might be an exceedingly difficult task for a person desiring to make legal copies of copyrighted matter to discover the identity and whereabouts of the copyright proprietor, especially if the copyright had been assigned,<sup>10</sup> or renewed in the name of someone other than the author.<sup>11</sup> The records made up from registrations thus assist both pro-

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8. 17 U.S.C. §12 (1964). Works covered by this section include lectures and similar productions; dramatic, musical and dramatico-musical compositions; motion picture photoplays; photographs; motion pictures other than photoplays; and works of art, plastic works, and drawings.
  9. 17 U.S.C. §13 (1964).
  10. The Copyright Act provides that "Copyright secured under this title or previous copyright laws of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will." 17 U.S.C. §28 (1964). The Act facilitates tracing of assignments by requiring that "[e]very assignment of copyright shall be recorded in the copyright office within three months after its execution" (or six months, if executed outside the United States). If this is not done, the assignment becomes "void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded." *Id.* §30. These records are an indispensable aid to one who wishes to trace title to a copyright.
  11. The Copyright Act provides that a copyright, once secured, shall run for a term of 28 years from the date of first publication of the work (17 U.S.C. §24 (1964)), or from the date of prior deposit (if any) as an unpublished work. *Marx v. United States*, 96 F.2d 204 (9th Cir. 1938); see *Rose v. Bourne, Inc.*, 176 F.Supp. 605, 608 (S.D.N.Y. 1959), *aff'd*, 279 F.2d 79 (2d Cir. 1960). The initial term of copyright may be extended for a renewal period of 28 years, provided a renewal copyright has been obtained in accordance with the requirements of the statute. 17 U.S.C. §24 (1964). In most cases, the renewal may be obtained only by the original author or by one of his statutorily designated successors. *Id.* In certain enumerated types of works, however, the renewal copyright vests not in the author, but in the person who is the proprietor of the work at the time the renewal vests. *Id.* The problem of determining who is entitled to the renewal, and the manner in which it is to be obtained, has generated much

prietors and users by making public and easily accessible much valuable information which would otherwise remain unknown or difficult to locate.<sup>12</sup>

Despite the importance of registration, however, the drafters of the Copyright Act of 1909 chose not to invoke the drastic sanction of forfeiture of copyright for failure to register, as had been done in earlier acts.<sup>13</sup> Instead, they relied chiefly<sup>14</sup> on the expedient of making registration and deposit conditions precedent to any right of action for copyright infringement:

No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with.<sup>15</sup>

Although the statute makes registration a prerequisite to any action for infringement, it was at first not thought necessary that the Register actually issue a certificate of registration. The statute nowhere defines compliance for the purpose of section 13, and the early decisions apparently assumed that compliance only by the claimant and not by the Register was all that was required. In other words, they assumed that a claimant would be entitled to bring suit for infringement once he had mailed his copy or copies to the Register of Copyrights, accompanied by the appropriate registration forms and statutory fees. This was the reasoning in *White-Smith Music Publishing Co. v. Goff*,<sup>16</sup> in which plaintiff sought to enjoin defendant from infringing its copyrighted mu-

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litigation. *See, e.g.*, *DeSylva v. Ballentine*, 351 U.S. 570 (1956); *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943). *See generally* M. NIMMER, COPYRIGHT §§112-18 (1967).

12. For an appraisal of the values of the present registration system see Kaplan, *The Registration of Copyright*, in 1 STUDIES ON COPYRIGHT 325, 366-71 (1963).
13. *See, e.g.*, Rev. Stat. §4956 (1873).
14. Also available but rarely used are the sanctions provided in 17 U.S.C. §14 (1964): if the copies called for by §13 are not promptly deposited, the Register may at any time after the publication of the work, upon actual notice, require the proprietor of the copyright to deposit them. If the copies are not deposited within a specified time after the making of the demand, the proprietor of the copyright is liable for a fine of \$100 as well as twice the amount of the retail price of the best edition of the work, and the copyright becomes void.
15. 17 U.S.C. §13 (1964).
16. 187 F. 247 (1st Cir. 1911). *See also* *New York Times Co. v. Star Co.*, 195 F. 110, 112 (S.D.N.Y. 1912) (dictum).

sical composition, basing its claim to copyright on an assignment of the author's renewal rights. The Copyright Office had refused to register the claim, apparently on the ground that plaintiff was not entitled to the renewal. Nevertheless, the court noted that plaintiff had "offered registration under the statute," saying that "although registration was refused, yet [the plaintiff] fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension."<sup>17</sup>

The first contrary reading of the statute came in 1921, in *Lumière v. Pathé Exchange, Inc.*<sup>18</sup> *Lumière* involved a photographer who, at the time of filing a bill for an injunction to restrain infringements of his copyright in three photographs, had made the required deposit but had not yet obtained the certificate of registration. The court held that actual possession of the certificate was a prerequisite to bringing suit and dismissed the complaint. But by far the most significant and devastating decision to copyright claimants was that of the Court of Appeals for the Second Circuit in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*<sup>19</sup> Plaintiff had claimed copyright as a work of art in its elaborately designed, jewel-studded watch and applied for registration (Class G).<sup>20</sup> The Register declined to issue a certificate of registration on the ground that the watch was not a work of art, but an article whose sole intrinsic function was its utility.<sup>21</sup> The district court agreed with the Register that the watch was uncopyrightable and dismissed the complaint on the copyright count.<sup>22</sup> Judge Learned Hand, writing for the majority of the Court of Appeals, assumed that the watch was copyrightable but affirmed the lower court's disposition of the copyright count on the ground that no action for infringement could be brought until

17. 187 F. at 247.

18. 275 F. 428 (2d Cir. 1921), followed in *Rosedale v. News Syndicate Co.*, 39 F.Supp. 357 (S.D.N.Y. 1941).

19. 260 F.2d 637 (2d Cir. 1958), *affir'g in part on other grounds and rev'g in part* 155 F. Supp. 932 (S.D.N.Y. 1957).

20. 17 U.S.C. §5(g) (1964).

21. See 155 F.Supp. at 934. The Register probably based his determination on §202.10(c) of the Copyright Regulations, 37 C.F.R. §202.10(c) (Supp. 1956): "If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art. However, where the object is clearly a work of art in itself, the fact that it is also a useful article will not preclude registration." Compare the current version of this regulation, quoted and discussed in text at note 135 *infra*.

22. The court also dismissed a count based on a charge of unfair competition but granted plaintiff a permanent injunction against infringement of a design patent which it had obtained upon the watch. 155 F.Supp. at 937.

the work had actually been registered and a certificate of registration issued.<sup>23</sup> He characterized the contrary position espoused in the *White-Smith* case<sup>24</sup> as dictum, resting the immediate decision chiefly on his reading of the statute.<sup>25</sup>

Under this holding, the only recourse open to a copyright claimant denied registration who desires to sue for infringement is to bring a separate action for mandamus to compel the issuance of a certificate.<sup>26</sup> The requirement imposed by *Vacheron* on the unsuccessful applicant for copyright registration is formidable. Not only must he undergo the expense of two successive actions in order to vindicate his claim, but he must also risk the possibility that, if the infringement is a continuing one, his injury will be aggravated while he proceeds against the Register. The extra time involved in bringing the latter action might even cause the statute of limitations to run on his infringement action.<sup>27</sup>

These burdens are sufficiently serious to have caused the Register himself to characterize the plight of the unsuccessful registrant as "unfortunate" and to advocate legislative overruling of the *Vacheron* case in the Copyright Revision Bill.<sup>28</sup> However, even if *Lumière* and *Vacheron* had not established the necessity of obtaining a certificate of registration (as opposed to merely applying for one) before bringing an infringement action, the Register's initial refusal to register could adversely affect the claimant in several ways. For instance, section 209 of the Copyright Act provides that the certificate, when completed, "shall be admitted in any court as prima facie evidence of the facts stated therein."<sup>29</sup> Assuming for the purposes of discussion that the rule of the *White-Smith* case were still good law and that an infringement action could be brought despite the Register's refusal to issue a certificate, such refusal would nevertheless deprive the claimant of the procedural advantage of this presumption. This advantage is not inconsiderable, for the

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23. 260 F.2d at 639. The court reversed and remanded the judgment granting a permanent injunction upon the design patent count for a trial on the issue of originality. *Id.* at 641-42.

24. See text accompanying notes 16-17 *supra*.

25. See 260 F.2d at 640-41. *But see* dissenting opinion of Clark, J., *id.* at 645-46.

26. *Id.* at 640-41 (by implication). The court refused to continue the action pending the outcome of such a mandamus action.

27. See the suggestion of Clark, J., in his dissenting opinion in *id.* at 645. Any civil action under title 17 must be commenced no more than 3 years after the claim accrued. 17 U.S.C. §115(b) (1964).

28. 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 75 (Comm. Print 1961).

29. 17 U.S.C. §209 (1964).

facts stated in the certificate will, if not controverted, supply the basis for establishing the subject matter, ownership and existence of the copyright.<sup>30</sup> Without the benefit of the presumption, the claimant would have to prove each of these items separately. Even more significant than the procedural advantage expressly granted by the statute, however, is the widely-held judicial view that the certificate of registration raises a prima facie presumption of the validity of the copyright,<sup>31</sup> and the likelihood that courts would apply the converse of this view to create a reverse presumption of invalidity in the event that the Register had refused to issue a certificate.<sup>32</sup> Finally, denial of the certificate will nec-

30. Specifically, §209 requires the certificate of registration to contain the name and address of the claimant, the country of the author's citizenship, his name (when shown by the Copyright Office records), the title of the work, the date of deposit of copies, the date of publication (if any), the class designation and entry number, and (in the case of a book) the statement of receipt of affidavit of manufacture and date of completion of printing or publication date as stated in the affidavit.
31. Courts generally give effect to the language of 17 U.S.C. §209 (1964) by holding that prima facie effect must be given to the statements in the certificate, whether or not within the Register's "personal knowledge." See, e.g., *Jerry Vogel Music Co. v. Forster Music Publisher, Inc.*, 147 F.2d 614 (2d Cir. 1945). In some cases, however, courts have gone even farther and have spoken broadly of the certificate as presumptive evidence of the validity of the copyright, or of the plaintiff's title. See, e.g., *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); *Magnus Organ Corp. v. Magnus*, 269 F.Supp. 981, 984 (D.N.J. 1967); *Freudenthal v. Hebrew Publishing Co.*, 44 F.Supp. 754, 755 (S.D.N.Y. 1942).
32. The probability that a court will defer to the Register's decision that a given work is uncopyrightable and therefore ineligible for registration is directly related to the court's view of the extent of discretion accorded by the Copyright Act to him in deciding this kind of question. The greater the Register's scope of discretion, the less willing the court may be to disturb his decision.

There is considerable evidence pointing to the existence of only a limited degree of discretion on the part of the Register. No case has been found in which a court rested its affirmance of the Register's denial of a certificate on judicial deference to his decision; on the contrary, in all the mandamus actions brought against him in which his decision was affirmed, the court has agreed with him on the merits of the case.

There are but two cases in which the Register's refusal of registration was later overturned by a court: *United States ex rel. Twentieth Century-Fox Film Corp. v. Bouvé*, 33 F. Supp. 463 (D.D.C. 1940), *aff'd*, 122 F.2d 51 (D.C. Cir. 1941), and *King Features Syndicate, Inc. v. Bouvé*, 48 U.S.P.Q. 237 (D.D.C. 1940). Since the two cases are similar in all essential respects, only the first, whose opinion more completely discusses the issues, will be examined. In that case, plaintiff had sought registration of a book, in Class A, 17 U.S.C. §5(a) (1964), for page proofs of contributions to periodicals bound

essarily deprive the applicant of the various advantages of registration apart from those relating to infringement actions,<sup>33</sup> perhaps the fore-

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together in book form, and had tendered a single registration fee. The Register denied the application on the ground that the submitted material was not a book but rather separate page proofs of 20 contributions to periodicals, and that a separate registration and fee was required for each one. (In so deciding, he relied, *inter alia*, on the following language in 17 U.S.C. §13 (1964): "After copyright has been secured by publication of the work with the notice of copyright as provided in section 10 of this title, there shall be promptly deposited in the Copyright Office or in the mail addressed to the Register of Copyrights, . . . two complete copies of the best edition thereof then published, . . . or if such work be a contribution to a periodical, for which contribution special registration is requested, one copy of the issue or issues containing such contribution . . . .") Plaintiff then petitioned for a writ of mandamus against the Register to compel him to accept the application for registration as a book, which writ was granted by the district court. 33 F.Supp. 463 (D.D.C. 1940).

In affirming the grant of mandamus, the court of appeals said of the Register that "[i]t does not follow that he has power to exercise uncontrolled discretion in refusing registration of material which is subject to copyright, merely because he disagrees with the author as to how it should be classified." 122 F.2d at 54. It also held that "assuming that he has full power to classify deposited material, still, this gives him no power to refuse registration of a claim to copyright, which has been already secured by publication and notice; if the claim is based upon material which is actually the subject of copyright." *Id.* at 54-55. The court held that it had power to review the Register's determination, and found it clearly erroneous as a matter of law.

Despite limits on the Register's discretion when it comes to denying registration of material that is "actually the subject of copyright," however, and apart from the standard of review that may be applied (*see id.* at 54), the court also made it clear that it did regard the statute as giving the Register some discretion to refuse registration. It rested this determination partly on its construction of the statute, now 17 U.S.C. §207 (1964), which provides: "Subject to the approval of the Librarian of Congress, the Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this title." The court reasoned that this language "must contemplate the exercise of some discretion, not only in the making, but in the administration of such rules." 122 F.2d at 53. Another reason for holding the Register empowered to refuse applications could be found in practical considerations:

In light of recent trends and the divergent philosophies of different schools of thought as to what constitutes *art*, to say nothing of the large possibilities inherent in *plastic works of a scientific or technical character*, it seems obvious that, unless the Register has some power to control deposits for copyright, it may soon become necessary to build a new library annex. It seems obvious, also, that the Act establishes a wide range of



most among these being the readiness with which a certificate is accepted as evidence of copyright ownership for the purposes of transfer of title.<sup>34</sup>

From a first reading of the statute, the procedure for obtaining a certificate of registration appears virtually automatic; that is, the Register is given no express discretion to decline to issue a certificate of registration. Section 11 provides:

Such person may obtain registration of his claim to copyright by complying with the provisions of this title, including the deposit of copies, and upon such compliance the Register of Copyrights

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selection within which discretion must be exercised by the Register in determining what he has no power to accept.

*Id.* (Emphasis in original). Finally, the court found there was no doubt "that the Register may refuse to issue a certificate of registration until the required fee is paid, and until other formal requisites of the Act have been satisfied." *Id.* at 53-54.

In other words, although the functions of the Register in regard to registration of claims may be regarded as ministerial inasmuch as he has a duty to register claims which are submitted in accord with the statutory requirements and whose subject matter is clearly copyrightable, it is nevertheless clear that he does have "discretion" to the extent that copyrightability is doubtful, that is, to the extent that he must exercise judgment in construing the statute and in applying it to determine the eligibility of a particular claim. See Berger, *Authority of the Register of Copyrights to Reject Applications for Registration*, in 1 STUDIES ON COPYRIGHT 404 (1963).

Given that the Register's discretion is limited, it is clear that some discretion does exist, especially in ascertaining whether a submitted work constitutes copyrightable subject matter under the statute. While any exercise of this discretion will be reviewable, there is clearly a danger, from the applicant's point of view, that the reviewing court will defer to the Register's decision unless it is found to be patently erroneous. This danger exists all the more because no statutory provision for judicial review of the Register's decisions has been made. The applicant must therefore resort to the extraordinary writ of mandamus as a substitute for review; but he will probably find that mandamus can give him only limited relief. See the discussion of the limitations of mandamus at notes 166-68 *infra* and accompanying text.

33. See text at note 12 *supra*.

34. For a list of the advantages of registration to copyright proprietors and others, see Kaplan, *supra* note 12, at 368-69. Among the other advantages of registration to the author of copyright proprietor is that Copyright Office records aid in protecting registered works against unauthorized use by informing would-be users of the material of the copyright's existence and of the name of the copyright proprietor where these facts are not evident from the notice itself, as where the copyright has been assigned or renewed in the name of someone other than the author.

*shall* issue to him the certificates provided for in section 209 of this title.<sup>35</sup>

Some have concluded from this that the Register's function is wholly ministerial, involving no power to decline to issue a certificate, at least so long as there has been compliance with the formal requisites of the statute.<sup>36</sup> Other parts of the statute, however, indicate that the drafters must have intended to give the Register, at minimum, sufficient discretion to turn down claims he finds to be wholly without merit.<sup>37</sup> Reference has already been made to the prima-facie presumption of validity accorded by section 209 to the facts stated in the certificate.<sup>38</sup> It has been argued with good reason that this provision would be rendered meaningless if the Register were bound to issue a certificate automatically to every claimant upon receipt of the claim and accompanying deposit. If such were the case, the certificate could hardly be of greater evidentiary weight than the unsupported assertions of the copyright claimant; it is therefore difficult to see on what basis the presumption of validity might be justified.<sup>39</sup> Also, section 207 gives the Register authority to

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35. 17 U.S.C. §11 (1964) (emphasis added).

36. See authorities cited by Kaplan, *supra* note 12, at 367.

37. In *Bouvé v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 53 (D.C. Cir. 1941), the court stated:

[T]he Register may properly refuse to accept for deposit and registration "objects not entitled to protection under the law." . . . It seems obvious, also, that the Act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept.

See also *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958).

38. 17 U.S.C. §209 (1964). See text accompanying note 29 *supra*. The facts required to be contained in the certificate are enumerated in note 30 *supra*.

39. See 30 OP. ATT'Y GEN. 422, 424-25 (1915):

The suggestion that the determination of the validity of the registration should be left to the courts, and the necessary inference involved that the duty of the register is purely automatic, and consists wholly (with the single exception of books) in determining whether the subject presented is . . . within the general class of articles which may be copyrighted, can not be reconciled with the power vested in the register to issue rules and regulations under which he will permit registration under the law. That section of the law plainly indicates that he has at least some measure of discretion in the administration of the act. Manifestly, in the exercise of that discretion he may make such investigation and require such showing of compliance with the law as may be necessary to

make "rules and regulations for the registration of claims to copyright as provided by this title."<sup>40</sup> If these provisions are to be given any effect, it seems clear that the Register must have at least the power to refuse registration to a work if the applicant is not a person entitled to copyright protection, or if the claim falls wholly outside the scope of copyrightable subject matter or fails on its face to comply with one or more of the statutory requisites of copyright protection, such as proper placement of notice.<sup>41</sup>

Several cases have upheld the Register's action in declining to make registration and to issue a certificate in specific instances, thereby giving weight to the view that he has the power to do so.<sup>42</sup> The United States Attorney General has added the weight of his authority to

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enable him to determine whether the prerequisites imposed have been met.

Cf. *Bouvé v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 52-54 (D.C. Cir. 1941); 41 OP. ATT'Y GEN. 395, 396-98 (1958). See also Fisher, *The Copyright Office and the Examination of Claims to Copyright*, in 1953 COPYRIGHT PROBLEMS ANALYZED 11, 15-17 (T. Kupferman ed. 1953).

40. 17 U.S.C. §207 (1964).

41. [I]f the Copyright Office were to register claims and issue certificates without regard to the copyrightability of the material, the result would be to mislead the applicant and the public. What materials are copyrightable is a rather esoteric question on which the general public is not well informed. Many applications are received in the Copyright Office for the registration of uncopyrightable material such as titles, names, ideas, mechanical devices, tools, toys, and almost anything imaginable, usually under a misapprehension by the applicant of the copyright law. In some instances, protection may be available under the trademark or patent laws. Registration of a copyright claim in such material would lull the applicant into a false sense of security in believing he had copyright protection, instead of seeking advice and other means of protecting his interests; and the public would often be given the false impression that the material is copyrighted. Further consequences would also seem evident: the registration records would be cluttered with unfounded claims; registration records and certificates would be unreliable and would lose much of their probative value for copyright claimants, for other persons dealing with them, and for the courts; and many unfounded claims would probably become the source of litigation.

Berger, *Authority of the Register of Copyrights to Reject Applications for Registration*, in 1 STUDIES ON COPYRIGHT 393, 405 (1963).

42. *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958); *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir. 1947); *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.* 155 F.Supp. 932 (S.D.N.Y. 1957), *aff'd in part and rev'd in part, on other grounds*, 260 F.2d 637 (2d Cir. 1958).

this view of the statute in an official opinion.<sup>43</sup> But owing to the indefiniteness of the statute and the dearth of case law on the point, the outer limits of the Register's discretion have never been defined.

Perhaps the principal reason that the point has not been extensively litigated is that the Register has shown relatively little inclination to probe the limits of his discretion.<sup>44</sup> Notwithstanding his powers, he would no doubt acknowledge that his office is ill-equipped and ill-suited to undertake a complete assessment of the validity of each copyright claim received: there are too many factors affecting copyrightability whose impact cannot be ascertained simply by examining the deposited work or the accompanying application.<sup>45</sup> For example, since the Copyright Office makes no attempt to conduct a search of its files before making registration, there is no way in which it is possible to determine by inspection whether or not a given work constitutes an original work of authorship, except in the rare instance when the examiner might recognize a plagiarism of a work with which he was already familiar.<sup>46</sup>

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43. 30 OP. ATT'Y GEN. 422 (1915). This view was confirmed in a more recent opinion dealing specifically with the Register's power to decline registration of a work on the ground that it is obscene or otherwise illegal, 41 OP. ATT'Y GEN. 395 (1958).

44. It is the announced policy of the Copyright Office to make registration of claims in doubtful cases. This policy is discussed more fully in the text accompanying note 48 *infra*.

45. In addition to the impossibility of assessing all the factors which enter into a determination of copyrightability on the sole basis of an applicant's submissions, a former Register of Copyrights has pointed out that there is a severe restriction on the amount of time that can be devoted to any given application. Of the more than 1,000 applications for registration received every day (each primary examiner must process about forty of these to keep the workload current), approximately 850, or 85%, appear to be in proper form and to meet all the statutory requirements. A brief examination of the remaining 15% reveals that they depart in some way from the statutory formalities. Fisher, *supra* note 39, at 15. See also Kaplan, *supra* note 12, at 361-62. More recent figures indicate that the number of applications has increased. In fiscal 1966, for example, 286,866 registrations were made in all categories (no figures were published regarding the total number of applications received). 69 REGISTER OF COPYRIGHTS ANN. REP. 33 (1967). Unofficial figures for 1967 disclose that 323,415 applications were received, resulting in approximately 294,000 registrations. Interview with Richard E. Glasgow, Esq., Chief of Examining Division, United States Copyright Office, in Washington, D.C., Jan. 15, 1968. Assuming a working year of 250 days, this means that in 1967 the Copyright Office processed an average of nearly 1300 applications per day.

46. See Berger, *supra* note 41, at 403 n. 38.

About the most that can ordinarily be done is to ascertain whether the work fits under one of the statutory classifications of copyrightable subject matter; whether the required notice is adequate; whether there is agreement in dates, names, etc., between the application and the deposited copies; and possibly to determine some other matters, such as whether the author is a person entitled to copyright.<sup>47</sup> Even within the narrow confines to which practical limitations restrict the Register's range of inquiry, however, close questions calling for nice judgments can arise. This is especially true in the area of copyrightable subject matter, as will be seen below.

## II. COPYRIGHT OFFICE REGISTRATION PRACTICE AS CODIFIED IN EXCLUSIONARY REGULATIONS

### A. *The Register's Own Conception of His Role: The "Rule of Doubt"*

Realizing the consequences that refusal to issue a certificate can entail and knowing that the Copyright Office has not been endowed with the primary function of adjudicating the validity of copyright claims submitted to it, the Register has traditionally followed a policy of making registration in doubtful cases. Known variously as the "rule of doubt" or the "rule of doubtful validity," this policy has been stated as follows:

Instead of requiring an applicant to prove his case, the examiners are prepared to prove a case for rejecting before they make such a recommendation. We will register material which we feel a court *might* reasonably hold to be copyrightable, even though, personally, we feel that it is not subject to copyright.<sup>48</sup>

Under this policy it would seem that the Register should refuse to issue a certificate only in the event that the claim submitted has virtually no chance of withstanding an eventual challenge in the courts. In practice, however, certain categories of would-be registrants find it more difficult to obtain a certificate than the above statement implies.

47. See Kaplan, *supra* note 12, at 361-62.

48. Library of Congress, Department & Divisional Manuals, No. 7, "Copyright Office" 38 (1950). See also Fisher, *supra* note 39, at 16.

B. *The Mechanics of Processing Copyright Claims and the Need for Standards of Exclusion*<sup>49</sup>

Upon receipt of an application for registration, the application form and accompanying deposit are sent to an examiner whose function is to ascertain whether or not a certificate should issue. If the submitted material is clearly copyrightable and if there has been compliance with the other statutory requisites, the certificate will normally be issued as a matter of course. Should a question arise, the examiner will write to the applicant and attempt to secure whatever further information or clarification is needed. If, after examining the deposit and all the pertinent information regarding it, the examiner decides that the material is not copyrightable or that the applicant is not entitled to copyright, the applicant will be notified of the rejection and of the reasons therefor. The applicant may then request reconsideration, in which case the initial decision is reviewed *de novo* by the head examiner of the appropriate section of the Examining Division,<sup>50</sup> who takes into account whatever arguments the applicant advances in favor of acceptance. If the decision is confirmed, further appeals lie to the Assistant Chief and, ultimately, to the Chief of the Examining Division. In rare cases presenting questions of particular importance it may be possible to appeal to the Register, but ordinarily, if the Chief of the Examining Division affirms the initial examiner's denial, the applicant's only recourse lies in bringing an action of mandamus against the Register. As mentioned above, the statute makes no provision for further administrative review or for direct review of such denials by a court. In fact, even the informal procedure just described is not required by statute; it has evolved solely on the initiative of the Register in the interest of fairness to copyright applicants.

Given the lack of statutory guideposts for the exercise of his discretion in passing upon applications for registration, yet faced with the necessity of establishing minimal administrative standards of exclusion which will enable his staff to process the flood of applications

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49. The following explanation is based on the writer's interview with Messrs. Richard E. Glasgow and Arthur J. Levine, respectively Chief and Assistant Chief of the Examining Division, United States Copyright Office, in Washington, D.C., January 15, 1968. For a brief summary of the procedure followed in the Examining Division, see Kaplan, *supra* note 12, at 361-62.

50. In order to facilitate the process of examination, the Examining Division is subdivided into four sections entitled "Arts," "Music," "Books," and "Renewals and Assignments," respectively. Each of these sections is supervised by a head examiner.

with reasonable dispatch,<sup>51</sup> the Register has had to formulate various policy statements defining specific categories of material that he regards as clearly ineligible for copyright under the statute and its judicial interpretations. While some of the statements are intended only for the internal use of the Copyright Office and hence are not generally available, the Register has traditionally published other regulations dealing with registration of claims to copyright for the guidance of the public.<sup>52</sup> Some of these deal with purely administrative and procedural matters, such as the proper procedure to be followed in submitting applications for copyright<sup>53</sup> or the conditions under which photographs of the copyrighted work may be deposited in lieu of copies required by section 13.<sup>54</sup> Most of the published regulations, however, attempt to define the scope of the statutory classifications of copyrightable subject matter.

In addition to providing general definitions, many of the regulations offer specific examples of the types of works which will or will not be accepted for registration.<sup>55</sup> Some of the regulations in this latter category are designed to forestall certain obvious misunderstandings as to the scope of copyrightable subject matter. For example, under Class I (drawings or plastic works of a scientific or technical nature), a regulation makes it clear that the term "plastic work" refers to a three-dimensional work giving the effect of that which is molded or sculpted, and not to every object made of one of the synthetic chemical derivatives, plastics.<sup>56</sup>

### C. Regulations That Define the Register's Discretion Too Broadly or Too Narrowly

Unfortunately, not all the questions that the regulations undertake to resolve are inherently capable of such clear-cut answers, and not all the regulations are so easily justified. In certain cases, disputed

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51. For statistics on the number of applications that must be processed daily, see note 45, *supra*.

52. The Register of Copyrights is authorized to make rules and regulations for the registration of claims to copyright by 17 U.S.C. §207 (1964). The current regulations are codified in 37 C.F.R. ch. 2 (1967). For a compendium of past regulations, see United States Library of Congress, Copyright Office, *A Compilation of the Regulations Concerning Copyright, 1874-1956* (1956) (microfilm).

53. 37 C.F.R. §202.3 (1967).

54. *Id.* §202.16.

55. These regulations elaborate on the classes enumerated in 17 U.S.C. §5 (1964).

56. 37 C.F.R. §202.12(b) (1967).

questions of copyrightability have been arbitrarily settled by regulations that leave insufficient scope for the application of the rule of doubt. In others, the arbitrariness lies not in the regulations themselves, but in the nature of the judgment that they require the Register to exercise. Careful consideration of these regulations is necessary in order to understand fully the problems they create and the reforms in the law that these problems suggest.

### 1. *Regulations Categorically Excluding a Class of Works*

The Register has promulgated relatively few regulations categorically stating that broad classes of works are not copyrightable, since most determinations of copyrightability involve questions of judgment and hence must be made on a case-by-case basis. There are, however, two hard and fast rules involving the copyrightability of a work with respect to which a patent has been obtained, and both are open to challenge.

The first of these rules is found among the regulations pertaining to works of art (Class G). The regulation provides:

The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.<sup>57</sup>

The second rule relates to drawings or plastic works of a scientific or technical character (Class I):

A claim to copyright in a scientific or technical drawing, otherwise registrable in Class I, will not be refused registration solely by reason of the fact that it is known to form a part of a pending patent ap-

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57. *Id.* §202.10(b). One might wonder how the Copyright Office could know officially whether or not a patent had already been issued. The answer probably lies in 35 U.S.C. §287 (1964), which provides:

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.," together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement.



plication. Where the patent has been issued, however, the claim to copyright in the drawing will be denied copyright registration.<sup>58</sup>

The first rule forecloses the possibility of obtaining copyright registration for a patented design; the second prohibits the registration of a scientific or technical drawing which forms part of an issued patent. In both cases, the reason for the denial is obscure. Nowhere does the statute require any such result, and the possibility of dual protection has not been foreclosed by the courts.

In the field of works of art, the landmark case is *Mazer v. Stein*,<sup>59</sup> in which the Supreme Court held that an independently copyrightable work of art is not rendered uncopyrightable by virtue of its subsequent inclusion in a useful article. It expressly declined to decide whether the allowance of either a copyright or a design patent on a given work bars the grant of the other.<sup>60</sup> The Court has never resolved this issue, and no lower court has squarely held that such dual protection is necessarily unobtainable. The one case cited informally<sup>61</sup> by the Copyright Office as a basis for this regulation, *Louis De Jonge & Co. v. Breuker & Kessler Co.*,<sup>62</sup> affords it very little support. In *De Jonge*, which arose under the Copyright Act of 1874,<sup>63</sup> plaintiff brought an action for infringement of his copyrighted painting which he used as the basis of a design on gift-wrapping paper. Defendant contended that plaintiff should have obtained a design patent for his painting, and thus copyright protection had to be barred, arguing that the areas covered by the patent and copyright statutes were mutually exclusive. After deciding that the painting was within the scope of the copyright law, the court rejected the defendant's argument, saying that there was some area of overlap between copyright and patent, and that if a given work appears eligible for both forms of protection, either one could be chosen.<sup>64</sup> The court did add its opinion that as soon as one of these monopolies was granted, the other became unavailable.<sup>65</sup> This

58. 37 C.F.R. §202.12(c) (1967).

59. 347 U.S. 201 (1954). This case is analyzed in the text accompanying notes 120-23 *infra*.

60. *Id.* at 217.

61. Interview with Messrs. Richard E. Glasgow and Arthur J. Levine, respectively Chief and Assistant Chief of Examining Division, United States Copyright Office, in Washington, D.C., Jan. 15, 1968.

62. 182 F. 150 (C.C.E.D. Pa. 1910), *aff'd on other grounds*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914).

63. Act of June 18, 1874, ch. 301, 18 Stat. 957.

64. 182 F. 150 *passim*.

65. *Id.* at 152.

last statement was clearly dictum, since the plaintiff had made no application for a patent, and the only issue that had to be decided was whether the mere availability of a patent barred the validity of the copyright. This dictum may perhaps be attributable to the court's fear of unduly extending one of these two statutory monopolies by superimposing the protection of the other.

In the case of scientific or technical drawings, the regulation in question apparently stems from the decision of the Court of Appeals for the Second Circuit in *Korzybski v. Underwood & Underwood, Inc.*,<sup>66</sup> in which a second theory was advanced as requiring the denial of dual patent and copyright protection to the same work. The court held that the drawings or diagrams forming part of a patented invention are dedicated to the public in what amounts to a compulsory divestive publication, and therefore may not be copyrighted.<sup>67</sup> The court observed that the patent dedicates both the invention and the drawings, subject only to the inventor's monopoly to make, use, and vend the invention during the term of the patent.

This argument does not purport to rest on broad policy grounds, but rather on a narrow legal technicality.<sup>68</sup> Even assuming its validity, however, it does not justify the broad exclusion of the regulations in question. Consistently with the holding in *Korzybski*, a person could preserve his claim to both monopolies simply by placing a copyright notice on his design or drawing before submitting it to the Patent Office,<sup>69</sup> since publication with notice is sufficient to invest statutory copyright.<sup>70</sup> Although filing a work not bearing the statutory notice in the Patent Office might well constitute a publication sufficient to divest common-law rights in the submitted work,<sup>71</sup> and hence render copyright

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66. 36 F.2d 727 (2d Cir. 1929).

67. *Id.* at 729.

68. See Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 50-51 (1953).

69. This is because the *Korzybski* court rested its conclusion on the premise that filing the drawings of a patented invention in the Patent Office constitutes a divestive publication placing them in the public domain, so that they could not subsequently be copyrighted without violating the statutory prohibition against copyrighting anything in the public domain, 17 U.S.C. §8 (1964). If the drawings were copyrighted prior to filing, there would be no contravention of this provision, and the rule of the case would not apply.

70. See note 2 *supra*.

71. Holding that filing in a governmental office constitutes such a divestive publication are *Callaghan v. Myers*, 128 U.S. 617 (1888); *DeSilva Constr. Corp. v. Herralld*, 213 F.Supp. 184 (M.D. Fla. 1962); *Wright v. Eisle*, 86 App. Div. 356, 83 N.Y.S. 887 (2d Dept. 1903); *Tumey v. Little*, 186 N.Y.S.2d 94 (Sup.

unobtainable,<sup>72</sup> the rationale of *Korzybski* affords no basis for refusing to register a validly copyrighted work which is subsequently patented.<sup>73</sup> Thus, the availability of dual protection would depend only upon which monopoly was obtained first.

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- Ct. 1959). *Contra*, *United States v. Certain Parcels of Land*, 15 F.R.D. 224 (S.D. Cal. 1954); *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546 (1959); *Edgar H. Wood Associates v. Skene*, 347 Mass. 351, 197 N.E.2d 886 (1964).
72. Publication without notice of copyright will inject a work into the public domain, at least if published by authority of the copyright proprietor. *Atlantic Monthly Co. v. Post Publishing Co.*, 27 F.2d 556 (D. Mass. 1928); *cf. McDaniel v. Friedman*, 98 F.2d 745 (7th Cir. 1938).
73. The whole concept of "publication" in copyright law is imprecise, owing largely to the fact that the term is nowhere defined in the Copyright Act. One source of confusion is the distinction that has been drawn between "investive" and "divestive" publication. As noted in the two preceding footnotes, publication is necessary in order to invest an author with federal copyright protection (except in the case of works enumerated in 17 U.S.C. §12 (1964), as to which copyright may be obtained upon deposit before publication); but publication of a work without the statutory notice will serve to divest common-law copyright and render statutory copyright unobtainable. In *American Visuals Corp. v. Holland*, 239 F.2d 740, 744 (2d Cir. 1956), Judge Frank concluded that

the courts apply different tests of publication depending on whether plaintiff is claiming protection because he did not publish and hence has a common law claim of infringement — in which case the distribution must be quite large to constitute "publication" — or whether he is claiming under the copyright statute — in which case the requirements for publication are quite narrow. In each case the court appear so to treat the concept of "publication" as to prevent piracy.

Thus formulated, Judge Frank's doctrine may not be a particularly useful generalization, since it is stated in terms incapable of precise application. How large is "quite large," and how narrow is "quite narrow"? Nevertheless, other cases have approved or even extended the doctrine, albeit as dicta. See *Public Affairs Associates v. Rickover*, 284 F.2d 262 (D.C. Cir. 1960), *vacated for insufficient record*, 369 U.S. 111 (1962); *Continental Cas. Co. v. Beardsley*, 253 F.2d 702 (2d Cir. 1958); *Hirshon v. United Artists Corp.*, 243 F.2d 640 (D.C. Cir. 1957); *Burnett v. Lambino*, 204 F.Supp. 327 (S.D.N.Y. 1962); *Edgar H. Wood Associates v. Skene*, 347 Mass. 351, 197 N.E.2d 886 (1964). Whatever may be the limits of the doctrine, however, it does indicate that a publication sufficient to divest common-law rights would also be sufficient to invest statutory copyright. Applied to the *Korzybski* situation, this means that even if filing in the Patent Office should be held a sufficient publication of the work to divest common-law rights, as indicated by the cases cited in note 71 *supra*, then a fortiori such filing of the work with notice of copyright would constitute sufficient publication to invest statutory copyright.

The inconsistent results flowing from the narrow *Korzybski* theory have led at least one commentator to speculate that the regulations in question are based not on the holding in *Korzybski*, but rather on the "fundamentally sound view that the creator might have an election between the two forms of protection<sup>[74]</sup> . . . but that the federal protective scheme never intended double protection."<sup>75</sup> Such a view, however, is a flimsy base on which to ground an exclusionary regulation. Apparently recognizing the uncertainty of the "federal scheme" in this area, the same writer went on to observe that while such a restrictive approach to double protection might be most consistent with overall governmental policy toward monopolies, "it does not square easily with the ruling in *Mazer v. Stein* that there is an overlap between patentable and copyrightable subjects."<sup>76</sup>

The argument that a work qualifying for either copyright or patent might be allowed to obtain both forms of protection certainly does not seem untenable. Although courts have generally been hostile to attempts to extend the length or scope of a statutory monopoly,<sup>77</sup> it does not necessarily follow that the simultaneous grant of patent and copyright would bring about an undue extension of either monopoly. To a large extent, the interests protected by patent and copyright are different. Basically, the Patent Act grants a broad monopoly for a relatively short period (up to seventeen years),<sup>78</sup> whereas the Copyright Act grants a considerably more restricted monopoly for a much longer period (up to fifty-six years).<sup>79</sup> The holder of a patent may "exclude others from

74. See, e.g., *Jones Bros. v. Underkoffler*, 16 F.Supp. 729, 731 (M.D. Pa. 1936); *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150, 152 (C.C.E.D. Pa. 1910).

75. Nimetz, *Design Protection*, in 15 ASCAP, COPYRIGHT LAW SYMPOSIUM 79, 85 n. 23 (1967).

76. *Id.* at 86 n. 23.

77. See, e.g., *Brulotte v. Thys Co.*, 379 U.S. 29 (1964).

78. 35 U.S.C. §154 (1964) provides:

Every patent shall contain . . . a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof.

In the case of design patents; the applicant may elect a term of 3 years and 6 months, 7 years, or 14 years, depending upon the amount of fee paid. *Id.* §§171, 41(a)(3)(b).

79. The Copyright Act provides for an original term of 28 years, renewable under certain conditions for a further term of 28 years. 17 U.S.C. §24 (1964).

making, using, or selling the invention throughout the United States.”<sup>80</sup> He is thus given a monopoly of the art disclosed by his patent application, that is, of the idea behind his invention.<sup>81</sup> He may prevent the exploitation of the invention not only by copiers, but also by another person who later “discovered” the same invention in perfect ignorance of the prior discovery.<sup>82</sup> By contrast, the copyright holder is given only the right to multiply and sell copies of his *own* work.<sup>83</sup> The quality protected by copyright is originality, not novelty or invention.<sup>84</sup> In keep-

80. 35 U.S.C. §154 (1964).

81. See, e.g., *Flowers v. Austin-Western Co.*, 149 F.2d 955, 958 (7th Cir. 1945):

[O]ne device is an infringement of another if it performs substantially the same function in substantially the same way to obtain the same result, so that if two devices do the same work, in substantially the same way and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. . . .

As another judge put it, “[A] ‘monopoly’ [*i.e.*, the patent monopoly] means the exclusion of others from doing the same or a similar thing . . . .” *Hoffman v. Berger*, 18 F.Supp. 632, 634 (S.D.N.Y. 1937).

82. The later inventor would not be able to obtain a patent for his invention, if substantially similar to the prior one, because of the requirement of novelty imposed by 35 U.S.C. §102 (1964). “The patentee must not only have originated the idea, but he must have been the first to have done so.” *Julius Kayser & Co. v. Rosedale Knitting Co.*, 18 F.Supp. 836, 840 (E.D. Pa. 1937), *aff’d*, 98 F.2d 839 (3d Cir.), *cert. denied*, 305 U.S. 649 (1938). Put another way, “[G]enerally speaking, [the right of the first inventor of a patentable device or process to a patent therefor] may not be defeated by a subsequent inventor, or by the public, unless an abandonment of the right on the part of such first inventor be shown.” *Stresau v. Ipsen*, 77 F.2d 937 (C.C.P.A. 1935).

83. 17 U.S.C. §1 (1964) provides in part that:

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;

....

The remainder of the section enumerates other rights of the copyright-holder, none of which are applicable to works of art or scientific or technical drawings.

84. Originality is both a constitutional and a statutory prerequisite to copyrightability. The copyright clause of the Constitution restricts the power of Congress in granting copyright protection to “authors.” U.S. CONST. art. 1, §8. The Supreme Court has defined “author” in the constitutional sense to be “[H]e to whom anything owes its origin; originator; maker.” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). Thus, a person who has merely copied from others may not be deemed an author. Although the Copyright Act makes no express requirement of originality, courts have uniformly implied the requirement. See, e.g., *Du Puy v. Post*

ing with the more limited nature of the copyright monopoly, numerous cases have held that there can be no infringement unless the copyrighted work is actually copied.<sup>85</sup> Thus, if two persons should independently create identical works of art, each could obtain the exclusive right to make copies of his own work without infringing the other's copyright.<sup>86</sup>

Because of the different interests protected by patent and copyright, there are relatively few works that conceivably could qualify for both forms of protection. The two types of works that most readily come to mind are those covered by the regulations criticized above: scientific or technical drawings which form part of a patent application, and works of art embodying sufficient novelty and invention to make them patentable.<sup>87</sup>

The consequences of allowing dual protection to the first of these types may best be illustrated by an example. Suppose that the inventor of a radical new type of can opener wishes to copyright the technical drawings disclosing the invention. Before submitting them to the Patent Office, he places on them the statutory notice of copyright. Assume that the drawings will be sufficiently published when filed to invest the copyright under section 10 of the Copyright Act.<sup>88</sup> Then if a patent subsequently issues on the invention disclosed by the drawings, during the patent term the copyright will add little to the exclusive rights

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Telegram Co., 210 F. 883 (3d Cir. 1914); *Edward Thompson Co. v. American Law Book Co.*, 122 F. 922 (2d Cir. 1903). This implication can be based on the limitation in 17 U.S.C. §9 (1964) that copyright protection may only be claimed by "authors," or their successors in interest. See *Gladys Music Inc. v. Arch Music Co.*, 150 U.S.P.Q. 26 (S.D.N.Y. 1966).

85. *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951); *Christie v. Cohan*, 154 F.2d 827 (2d Cir. 1946); *Arnstein v. Porter*, 154 F.2d 464, 468-69 (2d Cir. 1946); *Ansehl v. Puritan Pharmaceutical Co.*, 61 F.2d 131 (8th Cir. 1932).
86. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390 (1940); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D. N.Y. 1924). See *Reed v. Carusi*, 20 F. Cas. 431 (No. 11,642) (C.C.D. Md. 1845).
87. Another type of work which would conceivably qualify for both types of protection is a print or label, which might either be registered under 17 U.S.C. §5(k) (1964), or submitted for a design patent under 35 U.S.C. §171 (1964). See *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927) (dual protection denied).
88. See note 73 *supra*.

granted by the patent, for by the terms of the patent no one may make, use, or sell the invention without first obtaining a license from the patentee.<sup>89</sup> The only right conferred by the copyright that is not granted under the patent is the exclusive right to copy the drawings. The added coverage would mean that, for example, a person who wished to publish a treatise on the art of making can openers, illustrating his text with the copyrighted drawings, would have to pay royalties to the copyright holder. This slight additional burden would not seem sufficient reason to deny copyright protection.

As part of the consideration for the grant of the patent monopoly, however, when the patent expires the invention disclosed therein is supposed to become freely exploitable by the public.<sup>90</sup> If the copyright in the drawings were to interfere with free exploitation, it would have the difficult-to-justify effect of prolonging the patent monopoly. It is unlikely, however, that the continuing existence of the copyright would in fact create such interference. Control of the right to publish the drawings would in no way prevent anyone from using them as an aid in manufacturing the can opener, since the Copyright Act confers no monopoly of use. Nor, by the weight of authority, would the manufactured article constitute an infringing "copy" of the drawings.<sup>91</sup>

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89. 35 U.S.C. §154 (1964).

90. *Brulotte v. Thys Co.*, 379 U.S. 29, 31 (1964); *Kellogg & Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896). As stated by the Court in *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 255-56 (1945):

By the patent laws Congress has given to the inventor opportunity to secure the material rewards for his invention for a limited time, on condition that he make full disclosure for the benefit of the public of the manner of making and using the invention, and that upon the expiration of the patent the public be left free to use the invention. . . . [T]he means adopted by Congress of promoting the progress of science and the arts is the limited grant of the patent monopoly in return for full disclosure of the patented invention and its dedication to the public on the expiration of the patent. . . .

. . . [A]ny attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal device employed, runs counter to the policy and purpose of the patent laws.

91. The subject of the drawings, a can opener, is by hypothesis not copyrightable, being neither a work of art (Class G) nor a plastic work (Class I). Copyright in the drawings will therefore protect only against reproduction of the drawings, not against copying of the can opener per se, as distinguished from the original elements (angle, perspective, etc.) contained in

With respect to the second category of works potentially eligible for dual protection, works of art, there would seem to be no greater reason to prohibit the coexistence of the two monopolies. Assume that an extraordinarily talented craftsman has created a new design for a saltcellar. The design is sufficiently novel and inventive to qualify for a design patent, yet the finished product looks so much like a modern sculpture that it is unquestionably a work of art and copyrightable as such.<sup>92</sup> Copyright would protect the artistic features of the work as expressed in the particular form of the finished product; design patent would protect whatever new principle or idea had been embodied in the design.<sup>93</sup> Once the design patent had expired, others would be free to use this idea or principle with impunity in whatever way they might wish, so long as they did not copy the particular form of artistically expressing that principle embodied in the copyrighted saltcellar. Thus, for the balance of the copyright term, the designer would have no greater rights than he would have had if the design patent had never issued; he could not use the copyright to monopolize his new principle of saltcellar design, since others would be free to use that principle so long as their saltcellars did not resemble his so closely as to warrant an inference of actual copying.

Responding to the above or similar arguments, a court might not unreasonably find it consistent with Congress's overall statutory scheme to allow both patent and copyright in different aspects of the same work, and thus uphold a copyright claim in drawings forming part

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the drawings *qua* drawings. *Cf.* *Modern Aids, Inc. v. R. H. Macy & Co.*, 264 F.2d 93 (2d Cir. 1959).

It should be noted, however, that if the subject of the drawings were itself copyrightable (*e.g.*, a toy registrable as a work of art), then the protectible elements in the drawings or illustrations would include not only the manner of depicting the toy in two-dimensional form, but also the form and appearance of the toy itself. If these protectible elements should in turn be incorporated into a three-dimensional toy copied from the drawings, the latter would be an infringing copy. *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (2d Cir. 1934); *King Features Syndicate v. Fleischer*, 299 F. 533 (2d Cir. 1924). *See also* *Hene v. Samstag*, 198 F. 359 (S.D.N.Y. 1912). *But cf.* *E. I. Horsman & Aetna Doll Co. v. Kaufman*, 286 F. 372 (2d Cir.), *cert. denied*, 261 U.S. 615 (1922).

92. In Class G. 17 U.S.C. §5(g) (1964).

93. This dichotomy of protection would hold true so long as form was not so bound up with function as to make the two inseparable. But if form were dictated solely by function, it is unlikely that the Register would accept the article for registration. *See* Copyright Office Regulations, 37 C.F.R. §§202.10(a), (c) (1967); discussion in text accompanying notes 123-136 *infra*.



of an issued patent or in a work of art on which a design patent had already been obtained. Such a finding seems all the more likely in the light of the Supreme Court's refusal to rule out the possibility of dual protection in *Mazer v. Stein*.<sup>94</sup> Given the absence of an authoritative judicial opinion or statute clearly holding dual protection unavailable, the regulations denying registration to such copyright claims are clearly not formulated with due regard to the rule of doubt or to the policies which prompt that rule: they foreclose copyright in works in which copyright might well be upheld by the courts.<sup>95</sup>

## 2. *Regulations Unduly Limiting the Registrability of a Class of Works*

The Correctness of the Register's decision not to issue certificates of registration in the circumstances just discussed is clearly open to question. Some regulations, however, are more ambiguous, as for example, those concerning choreographic works. The policies governing the registrability of such works are of uncertain scope, as well as of doubtful validity.

The copyright statute makes no explicit mention of choreographic works as such; yet, in order to receive copyright protection, they must be classified under one of the statutory rubrics of section 5.<sup>96</sup> The

94. 347 U.S. 201 (1954).

95. No decision expressly granting such double protection has been found, but it was at least countenanced in *Wilson v. Haber Bros.*, 275 F. 346 (2d Cir. 1921). The court allowed recovery for infringement of both a copyright and a design patent on a kewpie doll, although it did not pass on the question of the validity of double protection since the defendant had estopped himself from contesting this issue by a prior consent decree. *But see In re Blood*, 23 F.2d 772 (D.C. Cir. 1927) (application for design patent denied on hosiery ticket which had obtained copyright registration as a label); *Ex parte Guild*, 98 U.S.P.Q. 464 (Pat. Off. B. A. 1952), *aff'd on other grounds*, 204 F.2d 700 (C.C.P.A. 1953) (application for design patent denied on roof design which had obtained copyright registration as a work of art).

96. Despite the fact that §4 of the 1909 Act states that "[t]he works for which copyright may be secured under this title shall include all the writings of an author," and §5 provides that "[t]he above specifications [*i.e.*, the enumerated classes of copyrightable works] shall not be held to limit the subject matter of copyright as defined in §4 of this title . . .," no case has been found to uphold a copyright in an item that could not be fitted into one of the classes mentioned in §5. In *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955), the court construed the Copyright Act so as to restrict "writings" protected by §4 of the Act to a more limited class of items than all works which are capable of protection under the Constitution.

most appropriate of these is Class D (dramatic or dramatico-musical compositions). Although the notation for a choreographic work might be registered in another class,<sup>97</sup> only Class D affords the copyright holder protection against unauthorized public performance of the work,<sup>98</sup> which in the case of choreographic works is at once the most likely and, potentially, the most damaging type of infringement.<sup>99</sup> The current regulation governing Class D permits the registration of choreographic works in this class if they are "of a dramatic character, whether the story or theme be expressed by music and action combined or by actions alone."<sup>100</sup> The same regulation goes on to exclude from Class D registration, however, "descriptions of dance steps and other physical gestures, including ballroom and social dances or choreographic works which do not tell a story, develop a character or emotion, or otherwise convey a dramatic concept or idea."<sup>101</sup>

This regulation obviously attempts to draw a distinction between those choreographic works that are "dramatic" and those that are not. Such a distinction is admittedly necessary under the statute, for if a ballet is to qualify as a "dramatic work," by definition it must have some dramatic quality. The problem lies in defining that quality, and this is a question of import to choreographers. Most traditional ballets depict a story or narrative through the actions of the dancers and therefore clearly fall within the category of "dramatic works" both under the regulations and under the cases.<sup>102</sup> Many modern dances,

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97. *E.g.*, Class A (books); Classes L-M (motion pictures). 17 U.S.C. §§5(a), (l), (m) (1964).

98. Section 1(d) of the 1909 Act grants the copyright proprietor the exclusive right "[t]o perform or represent the copyrighted work publicly if it be a drama . . . and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever." 17 U.S.C. §1(d) (1964).

99. *See* letter from Agnes George DeMille, reprinted in B. VARMER, *COPYRIGHT IN CHOREOGRAPHIC WORKS*, Study No. 28, 86th Cong., 2d Sess. 110 (Comm. Print 1961). *But see* letter from Lincoln Kirstein, *id.* at 113, suggesting that the expense of reducing a ballet to legible notation (roughly \$1200 for 20 minutes), together with the difficulty of reproducing the work from the notation alone, cause the benefits to be reaped from obtaining copyright protection for choreographic works to be outweighed by the trouble and expense involved.

100. 37 C.F.R. §202.7 (1967).

101. *Id.*

102. Several cases are generally cited for the proposition that in order for a composition to be considered a dramatic composition under the Copyright Act, it must tell a story. The authority most widely relied on is *Fuller v. Bemis*, 50 F. 926 (C.C.S.D.N.Y. 1892), which involved a claim of copyright in a description of the movements of a stage dance. As the court char-

however, are to dance as abstract expressionism is to painting: they explore movement and form, tell no story, and may convey no identifiable character or emotion. If an emotion is conveyed to the audience, it is likely to be wholly subjective, incapable of a generalized definition or description.<sup>103</sup>

The registrability of such a work is left in doubt by the regulation quoted above, and there is little available precedent to elucidate the standard therein set forth. Yet a reasonable case can be made for the proposition that any choreographic work designed to evoke a reaction in its audience through the actions of one or more dancers—whether the reaction be emotional or purely intellectual—should be considered “dramatic,” and hence entitled to copyright. It may be that the phrase “otherwise convey a dramatic concept or idea”<sup>104</sup> is broad enough to

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acterized the dance, it “convey[ed] to the spectator, no other idea than that comely woman is illustrating the poetry of motion in a singularly graceful fashion.” *Id.* at 929. In denying a preliminary injunction to the plaintiff, the court stated, “It is essential to such a composition that it should tell some story. The plot may be simple. . . . The merely mechanical movements by which effects are produced on the stage are not subjects of copyright where they convey no ideas whose arrangement makes up a dramatic composition.” *Id.* There is some ground for supposing, however, that the real basis for decision was that the court felt the dance to be risqué or even immoral. See the description of the dance set out at 50 F. 926-27. See also Mirell, *Legal Protection for Choreography*, 27 N.Y.U. L. REV. 792, 807-09 (1952). Two other cases also deny copyright protection as a dramatic work on similar grounds: *Martinetti v. Maguire*, 16 F. Cas. 920 (No. 9173) (C.C.Cal. 1867), and *Barnes v. Miner*, 122 F. 480 (C.C.S.D.N.Y. 1903). Both cases, however, seem even more clearly to rest on the unspoken ground of immorality. See Mirell, *supra*, at 807-09. But see *Daly v. Palmer*, 6 F. Cas. 1132, 1135-36 (No. 3552) (C.C.S.D.N.Y. 1868), in which a stage presentation involving a single incident of rescue was held copyrightable as a “dramatic composition.” See also *Hendersen v. Tompkins*, 60 F. 758 (C.C.D. Mass. 1894) (public performance using idea and lyrics of plaintiff’s song held a copyrightable dramatic composition); *Green v. Luby*, 177 F. 287 (C.C.S.D.N.Y. 1909) (sketch consisting of recitations and songs, with very little dialogue and action, held a dramatico-musical composition within the Copyright Act).

103. Cf. Letter from Lincoln Kirstein reprinted in B. VARMER, *COPYRIGHT IN CHOREOGRAPHIC WORKS*, Study No. 28, 86th Cong., 2d Sess. 113 (Comm. Print 1961):

Increasingly, ballets fail to tell stories. They are about the dance itself, just as symphonic music is about sound. Some critics attach programs of the ‘March of Fate’ or the ‘Triumph of Love’ to a piece but this is merely a point of departure to their prose-poems and has little to do with the ballet, itself.

104. 37 C.F.R. §202.7 (1967).

encompass even the most abstract of choreographic works, but it seems doubtful that the Copyright Office does in fact give the phrase such an interpretation, especially in view of the Office's announced requirement that in order to be eligible for registration as an unpublished work, a copy of the choreographic work which is "merely diagrammatic of dance movement and actions (for example, if it is in Labanotation), . . . be accompanied by a verbal description of the production as a whole, explaining the plot, characters, themes, or emotions expressed by the choreography."<sup>105</sup> Under this rule, a work that is so abstract that it expresses no theme or emotion, let alone plot or character, is thus excluded from registration even though it could legitimately be considered "dramatic." One can only conclude that the rule of doubt has not been given sufficient scope with respect to this type of work.<sup>106</sup>

3. *Regulations Permitting the Register to Exercise  
Too Great a Degree of Subjective Judgment in  
Deciding What Is Copyrightable*

The regulations just discussed embody the Register's advance decision to deny registration to certain fairly well-delineated categories of works, despite the fact that their copyrightability might conceivably be

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105. Copyright Office Circular No. 51 "Choreographic Works." This requirement could, of course, be quite easily circumvented, since it would be a simple matter for the author of the work to make up a verbal description of the production that would be sufficient on its face to gain approval by the examiners. This does not mean that the rule is harmless, however, since it may force the author to lie about his work on pain of being denied registration.
106. There is some uncertainty as to how rigidly the Copyright Office intends to enforce the requirement mentioned in the preceding footnote. Mirell, *supra* note 102, at 810-811, relates that registration in Class D was obtained for the choreographic score (in Labanotation) of the musical "Kiss Me, Kate," although the dances were "mood and idea pieces, devoid of plot or story in the usual sense." *Id.* at 810. The score itself revealed no plot or story line, nor did any of the material accompanying the score. But the concession may have been more apparent than real, for an interoffice memorandum regarding this registration stated that the applicant had "purported to fulfill the . . . conditions for registration of a work as a dramatic composition; that is, the indicated dance movements spelled out, to a person familiar with the system, a story told in action, marked by the prescribed boundaries of a particular stage or setting." United States Copyright Office interoffice memorandum regarding the registration of Miss Hanya Holm's dances for "Kiss Me, Kate," March 1952, *quoted in* Mirell, *supra* note 102, at 811 n.86.

upheld by the courts. There is another series of regulations under Class G (works of art), however, which calls for the exercise of so great a degree of subjective judgment on the part of the Register in deciding what works are copyrightable that the claimant runs at least an equal risk of an unjustified denial of registration. This judgment is brought to bear in two successive determinations: first, whether the work in question is sufficiently creative to meet the minimum standard for copyrightability; and second, whether any mechanical or utilitarian aspect the article may possess bars it from being considered a work of art.

All works listed in section 5 must possess a certain minimal amount of creativity in order to be copyrightable,<sup>107</sup> in addition to the requirement that they represent an independent effort ("originality") on the part of their authors.<sup>108</sup> This requirement applies to works of art in a qualitatively different manner, however, than it does to the other enumerated classes of works. As Professor Nimmer has pointed out:

[A] photograph even if completely lacking in creativity is still undeniably a photograph if in its form it is the product of the photo-process. Similarly a book, a map, a musical composition or any of the other types of works enumerated in Sec. 5 of the Copyright Act are identifiable and definable by the nature of their respective forms regardless of whether such forms evidence any creativity . . . . With respect to works of art, however, the requirement of minimal creativity is applied . . . as a matter of definition. That is, unless a work evidences "some creative authorship in its delineation or form" it cannot by definition be regarded as a work of art.<sup>109</sup>

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107. Illustrative of this requirement are cases denying copyright protection to fragmentary words or phrases, *see, e.g.*, *Smith v. George E. Muehlebach Brewing Co.*, 140 F.Supp. 729 (W.D. Mo. 1956); *Kanover v. Marks*, 91 U.S.P.Q. 370 (S.D.N.Y. 1951); to non-creative variations of musical compositions, *see, e.g.*, *Norden v. Oliver Ditson Co.*, 13 F. Supp. 415 (D. Mass. 1936); and to forms of expression dictated solely by functional considerations, *see, e.g.*, *Caddy-Imler Creations, Inc. v. Caddy*, 299 F.2d 79 (9th Cir. 1962); *Consumer Union of United States, Inc. v. Hobart Mfg. Co.*, 199 F.Supp. 860 (S.D.N.Y. 1961) (compilation of factual material); *E. H. Tate Co. v. Jiffy Enterprises, Inc.*, 16 F.R.D. 571 (E.D. Pa. 1954) (instructions for use of hanger); *cf. Dietrich v. Standard Brands, Inc.*, 32 F.R.D. 325 (E.D. Pa. 1963); 37 C.F.R. §202.1(d) (1967). *See generally* M. NIMMER, COPYRIGHT §10.2 (1967).

108. *See* note 84 *supra*.

109. M. NIMMER, *supra* note 107, §19.1, at 85 (quoting 37 C.F.R. §202.10(b) (1967) (footnote omitted)).

In other words, if someone properly submits a photograph for registration, all the Register need do is determine that the submitted item is in fact a photograph, and therefore registrable in Class J, a matter which ordinarily requires no exercise of discretion. Any question whether the photograph is sufficiently creative to be copyrightable need not be decided by the Register, but can be left for a court to settle in future litigation. On the other hand, when an item is submitted to the Register for registration as a work of art, he must exercise discretion in deciding whether or not to accept it as such.

It is in this context that the Register must appraise the creativity of the work. A very low level of creativity will suffice,<sup>110</sup> but it is clear that there are broad limits beyond which the courts will not accord recognition as a work of art; these limits also define the outer boundaries of his discretion. One test of creativity was presented in *Bailie v. Fisher*,<sup>111</sup> where the claimant sought to compel the Register to issue a certificate of registration for a five-pointed cardboard star with a circular center, designed to receive a photograph of a movie star. The court agreed with the Register that this device did not constitute a work of art.<sup>112</sup>

To illustrate this problem further, consider the case of an artist who wishes to register as a work of art a perfectly round, smooth and

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110. The still-prevailing rule was stated by Mr. Justice Holmes in the landmark case of *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239 (1903):

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change.

*Id.* at 251-52.

111. 258 F.2d 425 (D.C. Cir. 1958).

112. The court adopted the test proposed by the Ninth Circuit, leaving the Register broad discretion: "A thing is a work of art . . . if it appears to be within the historical and ordinary conception of the term art." *Id.* at 426, quoting *Rosenthal v. Stein*, 205 F.2d 633, 635 (9th Cir. 1953).

unornamental metal sphere which he has formed by melting lead and pouring it into a mold. It is difficult to see how this could embody sufficient creativity to qualify even under the most generous standard a court might apply, so the Register would be justified in refusing to issue a certificate. But suppose that the artist remelts his ball of lead, this time flattening it a bit to make it slightly pear-shaped. How is the Register to decide whether or not the form of the lead now embodies sufficient creativity to have been transformed from a public-domain sphere into a work of art? Similarly, a simple drawing of a square clearly would not embody sufficient creativity—but let the square be transferred to canvas, appropriately placed and set off by a contrasting background, and an arguably copyrightable work of art has been created.

Even when the submitted article possesses sufficient creativity, however, it still must surmount a second hurdle, namely a determination by the Register that its “sole intrinsic function” is not its “utility.”<sup>113</sup> This requirement stems from the fear, reflected by the Supreme Court’s decision in the early case of *Baker v. Selden*,<sup>114</sup> that if copyright were permitted in works whose primary function is their utility, a monopoly would thereby be indirectly granted “not only of the use of the copyrighted work itself, but also of the system, function, process or art (i.e. the ‘idea’) upon which the work is based or for which it is fitted.”<sup>115</sup> While the indirect monopoly of use of the copyrighted article would not of itself necessarily be contrary to the statutory scheme,<sup>116</sup> if this indirect monopoly were to extend to the science underlying the work, then copyright could be used to circumvent the stricter requirements of patent law by granting protection to ideas, which are specifically excluded from copyright protection.<sup>117</sup> The resultant rule,<sup>118</sup> as reflected in the regulations, leaves an ill-defined line between works of art and works of utility. To the former, the Register must issue a certificate; to the latter, he must deny it. But since there is little case law on

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113. 37 C.F.R. §202.10(c) (1967).

114. 101 U.S. 99 (1880).

115. M. NIMMER, *supra* note 107, §37.1, at 148.

116. *See id.*

117. *See text* accompanying notes 77-95 *supra*.

118. Professor Nimmer doubts the need for such a rule, since a copyright only empowers the author to prevent direct copying of his work, not the application or restating of any functional system contained therein. *See* M. NIMMER, *supra* note 107, at §37.4.

the distinction between the two,<sup>119</sup> the Register's discretion is virtually unbridled.

The Register's task has been further confused by the holding of the Supreme Court in *Mazer v. Stein*<sup>120</sup> that there is an overlap between the fields of patent and copyright, and that certain articles may qualify for either type of protection, if not both.<sup>121</sup> The *Mazer* case, an action for infringement of copyright, raised the issue whether plaintiff's copyright in a statuette—considered a work of art by itself—was invalidated by the subsequent utilization of or intention to utilize copies of the statuette as a base for lamps manufactured by plaintiff, defendant having made highly accurate copies of the lamps, including the statuettes. The Court held the statuettes to be validly copyrightable with or without the lamp fixtures, saying: "We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration."<sup>122</sup> In so holding, the Court expressly approved the Copyright Office regulation which includes under section 5(g) "works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned."<sup>123</sup>

It has thus been established that the use to which a separately identifiable work of art is put will not affect its copyrightability. In many objects, however, artistic or ornamental features are found combined with functional features in such a way that the two are not readily separable. This is true, for example, of an enameled ashtray, a jeweled pin or an engraved glass vase. How is the Register to decide whether a work has artistic form apart from what its mechanical or utilitarian aspects demand? For example, jewelry can be copyrighted,<sup>124</sup> while an ordinary watch clearly cannot, since the form of a watch is dictated by its function, rather than by artistic expression. But what of a highly bejeweled watch? In the *Vacheron* case,<sup>125</sup> plaintiff sued for the infringement of its copyright in such a watch, having obtained a

119. See text accompanying notes 59-65 *supra*.

120. 347 U.S. 201 (1954).

121. See text accompanying notes 66-95 *supra*, where the possibility of simultaneously obtaining copyright and patent protection is discussed.

122. 347 U.S. at 218.

123. 37 C.F.R. §202.10(a) (1967).

124. *Id.* The copyrightability of ornamental jewelry was upheld in *Boucher v. Du Boyes, Inc.*, 253 F.2d 948 (2d Cir. 1958).

125. *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 155 F.Supp. 932 (S.D.N.Y. 1957), *aff'd in part and rev'd in part, on other grounds*, 260 F.2d 637 (2d Cir. 1958).



design patent, but having been refused registration for a copyright as a "work of art." The distinctive feature of the watch was the jeweled appearance of its face, which differed from most men's watch faces in two respects: it bore twelve oblong jewels in place of numerals, and instead of hands it had two transparent rotating disks, each bearing a jewel mounted on its periphery. Resting its decision primarily on the ground that the sole function of the watch was its utility, the district court upheld the Register's refusal to issue a certificate.<sup>126</sup> The court reached its decision notwithstanding its observation that the watch in some ways resembled jewelry: "[T]he effect of plaintiff's grouping of the elements of the design did create a watch with the appearance of a piece of jewelry as distinguished from a watch embellished with jewels."<sup>127</sup>

The watch in *Vacheron* is representative of the objects with regard to which the Register must attempt to formulate and apply regulations that will define the line between a copyrightable work of art and an uncopyrightable article of utility. Although he denied registration to the watch, he has allowed it, with subsequent judicial approval, for such items as designs printed upon dress fabrics,<sup>128</sup> dinnerware patterns,<sup>129</sup> dolls,<sup>130</sup> Christmas decorations,<sup>131</sup> banks in the shape of dogs,<sup>132</sup> and artistic jewelry boxes.<sup>133</sup> Other items accepted for registration but not as yet tested in the courts include "book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays."<sup>134</sup>

126. 155 F.Supp. at 934.

127. *Id.* at 935.

128. *See* Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc., 169 F.Supp. 142 (S.D.N.Y. 1959).

129. *See* Syracuse China Corp. v. Stanley Roberts, Inc., 180 F.Supp. 527 (S.D. N.Y. 1960).

130. *See* Rushton v. Vitale, 218 F.2d 434 (2d Cir. 1955); *cf.* Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc., 73 F.2d 276 (2d Cir. 1934).

131. *See* Doran v. Sunset House Distrib. Corp., 197 F.Supp. 940, 945 (S.D. Cal. 1961).

132. *See* Royalty Designs, Inc. v. Thrifticheck Serv. Corp., 204 F.Supp. 702 (S.D.N.Y. 1962).

133. *See* Dan Kasoff, Inc. v. Gresco Jewelry Co., 204 F.Supp. 694 (S.D.N.Y. 1962).

134. Mazer v. Stein, 347 U.S. 201, 221 (1954) (separate opinion of Douglas, J.). *See* Staff Members of New York University Law Review, *The Meaning of "Writings" in the Copyright Clause of the Constitution* in 1 STUDIES ON COPYRIGHT (1963).

Whether all of these would now be accepted for registration is somewhat doubtful, however, since in 1954 a new section was added to the Copyright Office Regulations, providing:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.<sup>135</sup>

While this regulation does clarify the criteria for acceptance as a work of art, it leaves in doubt the standard which will be applied in determining when an article has no other "intrinsic function" than "its utility." Could the creator of a casserole dish establish that it had an artistic function by producing half a dozen bishops to testify that they customarily displayed his creation in their living rooms? How is the Register to determine whether a feature can be "identified separately" and "exist independently as a work of art"? To the extent that the Register's determinations regarding status as a work of art involve primarily matter of opinion, rather than factual or legal determinations, they are necessarily subjective. When one recalls the function of the registration certificate,<sup>136</sup> whose issuance or denial is thus made to depend upon such subjective judgments, one can see how great is the importance of providing some form of review of the Register's discretion.

*D. Undue Restrictions on Registrability Owing to Failure of Regulations to Respond Quickly to Changed Conditions*

In addition to the fact that some of the regulations define the field of available copyright either too narrowly or too broadly, leaving much to the unguided discretion of the Register, there is a second factor exemplifying the need for easily obtainable review of the Register's decisions. This factor is the tendency of the Copyright Office to delay amending its regulations to correspond to changed needs and conditions, and even to new laws. Such a tendency is observable especially with regard to choreographic works and works of applied art.

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135. 37 C.F.R. §202.10(c) (1967).

136. *I.e.*, that it is a prerequisite to bringing an action for infringement and also has certain other advantages. See notes 29-34 *supra* and accompanying text.

If Diaghilev had sought copyright registration for one of his ballets in 1910,<sup>137</sup> when the first regulations under the 1909 Act were promulgated, he would have been disappointed, for the regulations then provided that “[t]he designation ‘dramatic composition’ does not include the following: Dances, ballets, or other choreographic works.”<sup>138</sup> By 1917 his chances might have improved somewhat, for although the regulations made no positive mention of ballets or choreographic works, only “dances” were retained as a specific exclusion from “dramatic compositions.”<sup>139</sup> In the 1939 regulations, there was still no positive mention of choreographic works or ballets, but “dances” continued to be excluded together with, *inter alia*, “animal shows, sleight-of-hand performances, and acrobatic or circus tricks of any kind.”<sup>140</sup> It was not until 1948 that pantomimes and ballets were specially included in the regulations under Class D.<sup>141</sup>

The copyrightability of works of applied art has had a similar development. Before 1909, copyright in works of art was limited to specific branches of the fine arts and models or designs intended to be perfected as works of the fine arts.<sup>142</sup> By the Act of March 4, 1909, this category became simply “works of art; models or designs for works of art,” as it remains to this day.<sup>143</sup> For some time, however, the regulations under the 1909 Act preserved the distinction which had seemingly been abandoned by the statute, stating under “works of art”:

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137. Conceivably he might have done so. Although the system of dance notation known as Labanotation, now the only universally recognized system, was not invented until 1928, other systems (albeit somewhat crude) did exist in 1910. One of these, perhaps coupled with a verbal description of the ballet, might well have supplied a sufficient written record of the work to qualify it for copyright.

138. Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, at 7 (1910).

139. Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, at 8 (1917).

140. 37 C.F.R. §201.4(c)(4) (1939).

141. 13 Fed. Reg. 8650 (1948). Unofficially, the Copyright Office has expressed the opinion that “[d]ramatic ‘pantomimes’ and ‘ballets’ were probably registrable ever since that Act [the Act of August 18, 1856, ch. 169, 11 Stat. 138, which was the first act to make dramatic compositions copyrightable] became the law . . . .” Letter from the Copyright Office to Leon Mirell, Dec. 13, 1951, in Mirell, *Legal Protection for Choreography*, 27 N.Y.U. L. Rev. 792, 803 n.52 (1952).

142. In 1873, copyright protection was granted, *inter alia*, to any “painting, drawing, chromo, statue, statuary, and . . . models or designs intended to be perfected as works of the fine arts . . . .” Rev. Stat. §4952 (1873).

143. 17 U.S.C. §5(g) (1964).

This term includes all works belonging to the so-called fine arts. (Paintings, drawings and sculpture.)

Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.<sup>144</sup>

The 1917 regulations retained intact the first paragraph of this definition but timidly observed that although

protection for productions of the industrial arts utilitarian in purpose and character even if artistically made or ornamented depends upon the patent law, . . . registration in the Copyright office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.<sup>145</sup>

Noting the discrepancy between the regulations and the statute, one commentator has observed that "[a]lthough these regulations were open to the criticism that they ignored the spirit of the changes made by the Act of 1909, the Copyright Office operated on the premise that design patent and copyright should and could be separated."<sup>146</sup> Whatever the reasons for the Copyright Office's adherence to the policy that "works of art" meant "works of the fine arts,"<sup>147</sup> it was not until 1948, nearly forty years after the passage of the 1909 Act, that the regulations were changed to permit copyrighting of works of art that contemporaneously possessed utilitarian features.<sup>148</sup>

Despite these reluctant adjustments to changing conditions, in recent years the Register has shown himself to be progressive in other

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144. Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, §12(g) at 8 (1910).

145. Rules and Regulations for the Registration of Claims to Copyright, Copyright Office Bull. No. 15, §12(g), at 8-9 (1917).

146. Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 44 (1953).

147. The case of *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), discussed in note 110 *supra*, did not necessarily dictate a contrary policy. That case merely held that a lithographed circus poster, admittedly in the category of works belonging to the fine arts, could not be denied copyright either on the ground that it was of poor artistic quality or that it constituted "commercial" art.

148. In 1948 the first paragraph of the regulation under Class G (works of art) was amended (13 Fed. Reg. 8650 (1948)) to read substantially as it does today, 37 C.F.R. §202.10(a) (1967).

matters of registration. He has accepted registrations of video tapes<sup>149</sup> and computer programs,<sup>150</sup> both of these being works whose copyrightability under the present statute is quite dubious.<sup>151</sup> Nevertheless, there is ever present the possibility that the Register will fail to respond to a new need for copyright registration even though the statute can be interpreted to give him power to do so. Furthermore, there is no guarantee that the present relatively liberal attitude toward registration will not one day regress to a much more restrictive interpretation of the statute, thereby seriously impairing the protection available to persons creating works on the fringes of copyrightability.

### III. A PROPOSED REMEDY: DIRECT JUDICIAL REVIEW OF THE REGISTER'S REFUSAL TO REGISTER

The foregoing demonstrates that the "rule of doubt" policy<sup>152</sup> as applied by the Register has not been sufficient to ensure that only claims which are clearly without merit will be denied registration. It is perhaps to be expected that he would tend to undershoot rather than overshoot the mark, despite his announced policy of giving the applicant the benefit of the doubt,<sup>153</sup> and generally allow registration in doubtful instances only when the case for registration is quite sub-

149. The first registration of a video tape recording was made on April 19, 1961, in Class L (motion-picture photoplays). Letter from Richard Colby to Professor Walter J. Derenberg, April 28, 1961, in 8 BULL. CR. SOC. 205 (1961).

150. The Copyright Office has expressed the conditions under which registration for computer programs will be considered in Copyright Office Cir. 31D (1965). The Office first announced that it would accept applications for registration of computer programs as such in April, 1964. 67 REGISTER OF COPYRIGHTS ANN. REP. 4 (1965). In that year, 3 registrations were made. *Id.* The number is growing, however; in fiscal 1965, 16 claims covering computer programs were registered, 68 REGISTER OF COPYRIGHTS ANN. REP. 4 (1966), and 36 in fiscal 1966. 69 REGISTER OF COPYRIGHTS ANN. REP. (1967).

151. With respect to registration of both video tapes and computer programs, the principal doubts are (1) whether or not the work is a "writing" within the meaning of the copyright clause, U.S. CONST. art. 1, §8; (2) if so, whether it is encompassed by §§4 and 5 of the Copyright Act, 17 U.S.C. §§4, 5 (1964); and (3) if so, in what class it should be registered.

Regarding video tapes, see Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U. L. REV. 1081 (1955); Needham, *Tape Recording, Photocopying, and Fair Use*, in 10 ASCAP COPYRIGHT LAW SYMPOSIUM 75, 102 (1959).

152. See text accompanying note 48 *supra*.

153. See *id.*

stantial. Given this situation, some form of review for rejected applications short of bringing an action of mandamus against the Register is clearly warranted. The question is what form of relief can be provided to fill this need without unduly disrupting the existing system. Little purpose would be served by stripping the Register of his discretion to decline to issue a certificate, as has sometimes been proposed.<sup>154</sup> Such a solution would deprive the registration system of its useful function of weeding out wholly worthless claims, as well as rendering virtually worthless the evidentiary presumption of validity accorded the certificate by section 209 of the Copyright Act.<sup>155</sup> A better approach would be to work out a means of allowing the Register to sift out worthless claims, while at the same time permitting the victim of an unwarranted rejection to obtain prompt redress. The present system adequately achieves the first goal, but it leaves the applicant for registration without sufficient recourse if his claim happens to be among those rejected.

The chief difficulty with the present system is that in most situations the Register is, for all intents and purposes, the final arbiter of copyrightability. This is so because courts give substantial weight to his issuance of a certificate in assessing copyrightability,<sup>156</sup> and because of the inherent difficulty in the only recourse against an adverse decision, namely, an action for mandamus.<sup>157</sup> He is well-suited to make that determination in the first instance, because of his day-to-day administration of the copyright statute. But he is also subject to the inherent limitations of an administrator when it comes to deciding difficult questions of copyrightability. Faced with a huge daily volume of applications,<sup>158</sup> the Register, as an administrator, must minimize the number of exceptional cases. Therefore, having once settled upon a given regulation as defining the outer limits of copyrightability, he is likely to adhere to that position at least until a sufficient number of doubtful cases have arisen to warrant reevaluation. Meanwhile, a number of potentially worthy claims might have been denied registration.

Partial relief from the burdens of the present awkward and unsatisfactory procedure for review is provided in the now-pending Copy-

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154. See Kaplan, *supra* note 12, at 367, for some of these proposals.

155. See text accompanying note 38 *supra*.

156. See note 29 *supra* and accompanying text; note 31 *supra*.

157. See discussion of the difficulties attending a mandamus action in text accompanying notes 166-68 *infra*.

158. See note 45 *supra*.

right Revision Bill,<sup>159</sup> which makes a number of basic changes in the system of copyright registration. In the new bill, the Register's duties are made explicit: he is *expressly* required to register the claim and to issue a certificate of registration

[w]hen, after examination . . . [he] determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met . . . .<sup>160</sup>

For the first time he is specifically directed to refuse registration and to notify the applicant in writing of the reasons for his action

[i]n any case in which [he] determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason . . . .<sup>161</sup>

Reading these two sections together, it is clear that the drafters intended to lay an explicit statutory foundation for the Register's exercise of discretion to reject claims which he finds are not entitled to copyright under the statute.<sup>162</sup> Section 410 of the bill carries over the requirement of section 13 of the current law that no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made. Section 410 goes on to provide, however, that

[i]n any case . . . where the deposit, application and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.<sup>163</sup>

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159. H.R. 2512, 90th Cong., 1st Sess. (1967). Failure to agree on some of the new bill's provisions has led to a 4th consecutive one-year extension of the present law. N.Y. Times, May 26, 1968, at 84, col. 1.

160. H.R. 2512, 90th Cong., 1st Sess. §409(a) (1967).

161. *Id.* §409(b).

162. The existing statute is silent on this point, but the courts have recognized an implied power to reject claims in a number of cases upholding the Register's refusal to issue a certificate. See the discussion at note 32 *supra*.

163. H.R. 2512, 90th Cong., 1st Sess. §410 (1967).

As a result of this change, an applicant who has unsuccessfully attempted to obtain registration can nevertheless sue an infringer, subject only to the obligation of notifying the Register.<sup>164</sup> Thus, the Register's unreviewed refusal to register no longer would create a barrier to bringing an infringement action.<sup>165</sup>

Despite this welcome overruling of the result in *Vacheron*, the new bill fails to correct two problems in the present law. First, the machinery proposed in section 410 makes no attempt to afford relief to an applicant whose application has been denied registration and whose work is not currently being infringed. Presumably, the rejected applicant would be relegated to a mandamus action against the Register, as under existing law. Mandamus, however, is hardly an adequate substitute for judicial review provided by statute, since it will not be granted to reverse discretionary decisions, at least in the absence of abuse of discretion or arbitrary and capricious action.<sup>166</sup> This qualification, of course, tends to break down in practice, because courts experience a considerable amount of confusion in attempting to distinguish ministerial from discretionary action,<sup>167</sup> particularly in matters involving the proper construction of a statute. The availability of mandamus in this situation is rendered still more uncertain by the existence in the Revision Bill of the partial remedy just discussed, for courts might well impute to Congress the intention of making that remedy exclusive.<sup>168</sup> Thus the new bill would bring about the anomalous result

164. If he so chooses, the Register may then join the action. The Revision Bill provides:

The Register may, at his option, become a party to the action with respect to the issue of registrability of the copyright claim by entering his appearance within sixty days after such service, but his failure to do so shall not deprive the court of jurisdiction to determine that issue.

H.R. 2512, at §410.

165. Section 410 was expressly designed to alter the rule of *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958). H.R. REP. NO. 83, 90th Cong., 1st Sess. 125 (1967).

166. K. DAVIS, *HANDBOOK ON ADMINISTRATIVE LAW* §222, at 764 (1951).

167. *Id.* at 764-66.

168. According to Professor Davis, the modern practice regarding the availability of mandamus where another remedy exists is that "[o]rdinarily mandamus may not be resorted to as a mode of review where a statutory method of appeal has been prescribed or to review an appealable decision of record." *Id.* at 763-64 (quoting *Roche v. Evaporated Milk Ass'n*, 319 U.S. 21, 27-28 (1943); see *United States ex rel. Girard Trust Co. v. Helvering*, 301 U.S. 540 (1937), in which the Court relied on what it termed "the settled rule that the writ of mandamus may not be employed to secure the adjudication of a disputed right for which an ordinary suit



that unsuccessful copyright claimant A would be afforded a better opportunity to vindicate his interests than unsuccessful copyright claimant B, simply because A's copyright had been infringed and B's had not. Yet B has important interests at stake, equally deserving of protection, even though his copyright is not currently being infringed. Registration would make it easier for B to protect his work against unauthorized use because of the procedural advantage gained from establishing presumptive copyrightability before any infringement takes place. If B wishes to dispose of his work, he will find a readier market for it if it has been registered; it might be quite difficult to dispose of an unregistered work, because the assignees or licensees would have little confidence in the validity of the copyright or in B's title.<sup>169</sup> Indeed, so important is registration, regardless of present infringement, that some claimants have been willing to bring suit to compel registration before any infringement has taken place, despite the obstacles and uncertainties of such actions.<sup>170</sup>

A second defect remaining under the Revision Bill is that, although it provides (substantially as under present law) that a certificate of registration issued within five years of the date of first publication shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate,<sup>171</sup> no provision is made for any presumption of validity to attach to the facts which would have been stated in a certificate of registration had the Register not declined to issue one.

In order to correct the first of these defects, the Revision Bill should make special provision for a civil action against the Register in the United States District Court for the District of Columbia in the event that registration should be finally denied after the informal

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affords a remedy equally adequate, and complete." *Id.* at 544 (citations omitted). It is conceivable that a court could be persuaded by the argument that the partial remedy afforded by the Revision Bill is sufficient to foreclose recourse to mandamus by a rejected applicant, even if that remedy were not yet available because his copyright had not yet been infringed.

169. Kaplan, *The Registration of Copyright*, in 1 *STUDIES ON COPYRIGHT* 325, 368-69 (1963).
170. *See, e.g., King Features Syndicate, Inc. v. Bouvé*, 48 U.S.P.Q. 237 (D.D.C. 1940).
171. H.R. 2512, 90th Cong., 1st Sess. §409(c) (1967). This section adds that the evidentiary weight to be accorded the certificate of registration if registration is made later than 5 years from the date of first publication "shall be within the discretion of the court."

appeal procedure with the Copyright Office has been exhausted.<sup>172</sup> Such a provision would afford the unsuccessful claimant a means of trying the validity of his claim without having to wait for an infringement to take place.<sup>173</sup> All decisions and actions of the Register taken in the course of denying registration should be reviewable de novo<sup>174</sup> by the district court, allowing both the applicant and the Register to introduce new evidence. Should the claimant succeed in persuading the court that his claim was valid, the court would uphold his copyright and direct the Register to issue a certificate of registration. The court could also direct the Register to amend or withdraw any regulation which conflicted with the court's decision.

Precedent for such a system of de novo judicial review exists under the Patent Act.<sup>175</sup> That system, somewhat more elaborate, provides first for internal appeal to the Patent Office Board of Appeals by an applicant whose claim has been twice rejected by the Patent Office.<sup>176</sup> If the applicant is dissatisfied with the Board's decision, he then may elect either to appeal to the Court of Customs and Patent Appeals on the record made in the Patent Office,<sup>177</sup> or to bring an action de novo against the Commissioner of Patents in the District Court for the District of Columbia.<sup>178</sup> While the structure created for patent appeals is more complex than is necessary or desirable in the case of copyrights, reflecting the far greater complexity of patent legislation,<sup>179</sup> there is no reason why copyright law cannot adopt part of the structure with-

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172. Such a procedure has been suggested by a former Register of Copyrights. See Letter from Clement L. Bouvé to the Librarian of Congress, Sept. 17, 1938. A modified version of the Bouvé proposal was suggested in Beran, *Refusal to Register—A Roadblock to Copyright Owners*, 10 BULL. CR. SOC. 147, 159-64 (1963). This writer's recommendation represents a further modification of Beran's proposal.

173. The machinery provided in the Revision Bill to expedite the suit of a claimant whose copyright is presently being infringed would be retained as an alternative remedy under this proposal.

174. Such an appeal should not be confined to the record made in the Copyright Office, since a determination of copyrightability should be made on the basis of all available evidence. This is especially true considering the lack of any formalized internal appeal system in the Office, and hence of any adequate record-making procedures.

175. 35 U.S.C. §§1-293 (1964).

176. *Id.* §134.

177. *Id.* §141.

178. *Id.* §145. The two remedies are mutually exclusive.

179. Patent applications, unlike copyright registrations, entail a search of the prior art as well as an assessment of novelty and inventiveness. For the conditions under which patents are granted, see *id.* §§100-04.

out appropriating the whole. There is no need to include the Patent Office internal appeal procedure, with its separate Board of Appeals, but the provision for de novo judicial review does furnish a desirable model. The court would not be confined by the narrow strictures on a remedy in the nature of mandamus,<sup>180</sup> but would be free to weigh all the relevant arguments of law and policy advanced by the parties in order to decide whether the Register's refusal was proper in the light of all the circumstances.

To remedy the second failing of the Revision Bill, that is, to facilitate a challenge to the Register's decision not to issue a certificate, the new Copyright Act should provide that if the Register's refusal is based on the ground of uncopyrightability of the subject matter (the claimant having complied with all the formal requirements of the law as proposed in the Bill—that is, if the deposit, application, and fee required for registration have all been delivered to the Copyright Office in proper form<sup>181</sup>), then the Register should be required to issue, upon request, a special document to be called a Certificate of Administrative Compliance.<sup>182</sup> This document would state (1) that the Register had examined the application and found it to have satisfied all the administrative requirements for copyright registration; and (2) that a certificate of registration had been denied, setting forth the reasons for the denial. The Certificate of Administrative Compliance would be deemed prima facie evidence of the same facts as the present certificate of registration;<sup>183</sup> unlike the certificate of registration, however, it would create no presumption regarding copyrightability.

The experience of nearly sixty years under the 1909 Act has shown that the discretion of the Register to refuse registration to claims he considers unwarranted or ill-founded serves a useful function. Yet the extremely wide range of his discretion calls for an effective counterweight in the form of readily available recourse to remedial machinery, in order to prevent disadvantage to claimants in case the Register's denial of registration is improper. Presently available methods of review are, however, clumsy and unwieldy.

Under the new bill, correcting a misjudgment of the Register would be made easy for one whose copyright has been infringed. Re-

180. See text accompanying notes 166-68 *supra*.

181. These requirements are covered in §§406, 408, and 708 respectively, of the Revision Bill, H.R. 2512, 90th Cong., 1st Sess. (1967).

182. The issuance of a Certificate of Administrative Compliance under slightly different conditions is proposed in Beran, *supra* note 172, at 162-63.

183. See note 30 *supra*.

jected applicants whose claimed copyright is not presently being infringed, however, should have a similarly available remedy so that they will not unjustly be deprived of the advantages of registration apart from the right to sue. The proposed additions to the Revision Bill would go further toward alleviating the present imbalance between the power of the Register and the rights of rejected applicants, by making the remedies for all such applicants essentially identical, regardless of whether infringement had taken place. Yet these proposals do not significantly limit the theoretical power of the Register; on the contrary, they would preserve his administrative role, while relieving him of the burden of making what amount to rulings of law. These changes should be incorporated into the new law in the best interests of an equitable system.

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## PART II.

**LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS**

## 1. United States of America and Territories

69. UNITED STATES. *Copyright Law Revision*. Copyright Office. December 16, 1968. Alternative Draft Provisions on Secondary Transmissions. 36 p.

Only the "explanatory note", comparative table and schematic outlines are printed below:

## EXPLANATORY NOTE

The attached preliminary and rather rough drafts represent an attempt to bring together the various proposals for copyright legislation on CATV and other secondary transmissions, and to lay them out in the form of statutory language for discussion. The drafts are based on the proposals set forth in various replies received on or before November 1, 1968, to Senator McClellan's request for comments, and on reports of ideas considered during various discussions of the problem before that date. The recent Notice of Proposed Rule Making and Notice of Inquiry released by the Federal Communications Commission on December 13, 1968, was not taken into consideration in the drafting.

Three alternative drafts have been prepared, and there has been an effort to include in one or another most of the detailed proposals that have been the subject of recent discussion. In general, Alternative A is oriented toward the copyright owner interests, Alternative C is oriented toward the interests of CATV operators, and Alternative B represents a middle ground. This scheme has not been followed in every detail, however, and the drafts are by no means mutually exclusive. Their purpose is to elicit comments and clarify thinking rather than to push any particular viewpoint. The drafts were prepared by attorneys in the Copyright Office, but the Office expresses no preference for any approach or provision, and it realizes that complete redrafting will be necessary before Committee action can be expected.

The drafts are accompanied by a comparative table which, while oversimplified, may help in the analysis of this complex subject matter. An underlying assumption of the drafts is that the definitions of "perform," "transmit," "publicly," "transmission program," and "fixed" will remain substantially as they appear in Section 101 of S.597.

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ALTERNATIVE DRAFT PROVISIONS ON SECONDARY TRANSMISSIONS

COMPARATIVE TABLES

	ALTERNATIVE A	ALTERNATIVE B	ALTERNATIVE C
EXEMPTIONS (Subsection (a))			
Hotel relays ITV retransmissions Common carrier relays	Exempt except for pick-ups of transmissions to a controlled group (e.g. Muzak, closed circuit)	Same	Same
Nonprofit or governmental systems	Exempt unless subject to full liability under subsection (b)	Same as above	Same as above
Small systems	No exemption	Exempt if system has 500 subscribers or less	Exempt if system has 1,000 subscribers or less
Local signals	No exemption	No exemption	Transmission of local signals to local subscribers exempt unless system alters content, originates programming beyond certain limits, or engages in Pay-TV operations

	ALTERNATIVE A	ALTERNATIVE B	ALTERNATIVE C
<b>FULL LIABILITY</b> (Subsection (b))			
Pick-up and retransmission to controlled groups	Full liability	Full liability	Full liability
Failure to record in Copyright Office	Full liability, except where exempt under subsection (a)	Same	Same, except applies only where CATV is importing distant signals
Importation of distant signals into major markets	Full liability (except where exempt under subsection (a)) in specified number of major markets	Full liability (except where exempt under subsection (a)) in specified number of major markets, plus full liability after CATV has been in operation for a certain number of years in a specified additional number of markets	No full liability
Exclusivity	Full liability (except where exempt under subsection (a)) where CATV imports first or second network run, or local run before anyone in area, after receiving notice of exclusive rights	No exclusive rights	No exclusive rights



	ALTERNATIVE A	ALTERNATIVE B	ALTERNATIVE C
Professional team sports	Full liability (except where exempt under subsection (a)) where distant signals are imported into area where no one has authority to carry the game	Same as Alternative A, except that full liability also requires notice to CATV operator	Full liability (except where exempt under subsection (a)) for CATV carriage in area actually blacked out under 15 USC 1592, and then only when CATV receives notice
<b>COMPULSORY LICENSING</b> (Subsection (c))			
Coverage	Everything not exempted by subsection (a) or subject to full liability under subsection (b) is subject to compulsory licensing under subsection (c).	Same	Same
Amount of royalty	Reasonable license fee, which can be tripled or reduced if either party refuses to bargain	Percentage of gross from subscribers	Percentage of gross from subscribers, which can be administratively changed under limited conditions
Method of distribution	Direct inter-party negotiations	Register of Copyrights collects fees and court distributes them under interpleader procedure	"Royalty Fee Administration for Secondary Transmissions" established in Copyright Office and it collects and distributes fees
<b>DEFINITIONS</b> (Subsection (d))			

	ALTERNATIVE A	ALTERNATIVE B	ALTERNATIVE C
"Area normally encom- passed"	Defined as a fixed mileage radius, different for radio and television. Problem of metropolitan overlap dealt with here	Same	Same
"Leading broadcast markets"	To be listed in Copyright Office regulations	Same	Not applicable

ALTERNATIVE A  
SCHEMATIC OUTLINE

1. *Exemptions* (subsection (a)):

(a) The following are completely exempt except for pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit):

- Hotel relays
- ITV retransmissions
- Common carrier relays

(b) The following are exempt unless the retransmission is subject to full liability under subsection (b):

- Nonprofit or government systems

2. *Full liability* (subsection (b)):

(a) The following are fully liable in all cases:

- Pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit)

(b) The following are fully liable unless they are hotel relays, ITV retransmissions, or common carrier relays:

- Retransmissions when the operator has not recorded his identity in the Copyright Office
- Importation of distant signals into one of a specified number of major markets
- Retransmission of first or second network, or first non-network, showing in the area, when exclusive rights have been sold to a local station and notice of exclusivity has been given
- Importation of professional team sports into area where rights to game have not been sold

3. *Compulsory license* (subsection (c)):

(a) Anything not exempt under subsection (a) or fully liable under subsection (b) can be retransmitted without permis-

sion by complying with the compulsory licensing conditions of subsection (c).

- (b) Compulsory license requires recording notice in Copyright Office and paying a "reasonable license fee." Copyright owner's remedies do not include injunctions, profits, or statutory damages, but court can triple or reduce "reasonable license fee" if there has been a refusal to bargain.

4. *Definitions* (subsection (d)):

- (a) "Area normally encompassed" is defined as a fixed mileage radius, different for radio and television. Problem of metropolitan overlap is dealt with here.
- (b) "Leading broadcast markets" are to be listed in Copyright Office regulations.

ALTERNATIVE B  
SCHEMATIC OUTLINE

1. *Exemptions* (subsection (a)):

The following are completely exempt for pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit):

- Hotel relays
- ITV retransmissions
- Common carrier relays
- Nonprofit or government systems
- Systems with 500 subscribers or less

2. *Full liability* (subsection (b)):

(a) The following are fully liable in all cases:

- Pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit)

(b) The following are fully liable unless they are hotel relays, ITV retransmissions, or common carrier relays:

- Retransmissions when the operator has not recorded his identity in the Copyright Office
- Importation of distant signals into a specified number of major markets. In the top group there is full liability from the outset, but in the second category there is compulsory licensing until the CATV system has been in operation for a specified period of time.
- Importation of professional team sports into area where rights to game have not been sold and CATV has been given notice.

3. *Compulsory license* (subsection (c)):

(a) Anything not exempt under subsection (a) or fully liable under subsection (b) can be retransmitted without permission by complying with the compulsory licensing conditions of subsection (c).

(b) Compulsory license requires recording notice and depositing annual statement of account and fees in Copyright Office.

Fee is specified percentage of gross subscription fees. Register of Copyrights acts as passive trustee and files annual interpleader proceeding with court which thereafter makes pro rata distribution.

4. *Definitions* (subsection (d)):

- (a) "Area normally encompassed" is defined as a fixed mileage radius, different for radio and television. Problem of metropolitan overlap is dealt with here.
- (b) "Leading broadcast markets" are to be listed in Copyright Office regulations.

ALTERNATIVE C  
SCHEMATIC OUTLINE

1. *Exemptions* (subsection (a)):

The following are completely exempt except for pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit):

- Hotel relays
- ITV retransmissions
- Common carrier relays
- Nonprofit or government systems
- Systems with 1,000 subscribers or less
- Systems carrying local signals to local subscribers only are exempt if they do not alter content, originate programming beyond specified limits, or operate as a Pay-TV system

2. *Full liability* (subsection (b)):

(a) The following are fully liable in all cases:

- Pick-ups of transmissions to a controlled group (e.g., Muzak, closed circuit)

(b) The following are fully liable unless they are hotel relays, ITV retransmissions, or common carrier relays:

- Importation of distant signals when the operator has not recorded his identity in the Copyright Office
- Importation of professional team sports into area where game blacked out under 15 USC 1592 and CATV has been given notice

3. *Compulsory license* (subsection (c)):

(a) Anything not exempt under subsection (a) or fully liable under subsection (b) can be retransmitted without permission by complying with the compulsory licensing conditions of subsection (c).

(b) A Royalty Fee Administration for Secondary Transmissions is established in the Copyright Office. Compulsory licensing

requires recording notice and depositing annual statement of account and fee with Administrator. Fee is specified percentage of gross, which Administrator can change at stated intervals under limited conditions. Administrator distributes fees annually, with limited provision for judicial review of his determinations.

4. *Definitions* (subsection (d)):

“Area normally encompassed” is defined as a fixed mileage radius, different for radio and television. Problem of metropolitan overlap is dealt with here.

2. Foreign Nations

70. GERMANY (*Federal Republic, 1949-* ).

Exchange of notes between the Government of the Federal Republic of Germany and the Government of Norway concerning the extension of the term of copyright protection. (4 *Copyright* 213-214, no. 10, Oct. 1968.)

In the exchange of notes the Government of Norway agrees with the German interpretation that the provisions of the Norwegian Law of December 2, 1955, as amended, “on the provisional extension of the term of protection of intellectual works shall apply to German nationals as well as to works considered to be of German origin, in so far as such works had not fallen into the public domain before September 17, 1965.” See 14 BULL. CR. SOC. 179, Item 89 (1966).

71. NEPAL. *Laws, statutes, etc.*

Legge, n. 2022, destinata a disciplinare le questioni relative al diritto d'autore. (39 *Il Diritto di Autore* 222-230, no. 2, Apr.-June 1968.)

An Italian translation of the Nepali copyright law of 1966.

72. PAKISTAN. *Laws, statutes, etc.*

Orders concerning the application of sections 53 and 54 of the Copyright Ordinance, 1962 (of March 13, 1968) (S.R.O. 709(K)/68, 710(K)/68). (4 *Copyright* 201-202, no. 9, Sept. 1968.)



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Orders extending the Pakistan copyright law to members of the Berne Union and of the Universal Copyright Convention, and to the United Nations Organization and its specialized agencies.

73. NORWAY. *Laws, statutes, etc.*

Royal decree concerning the free use of works for educational purposes in some specific cases. (4 *Copyright* 214, no. 10, Oct. 1968.)

In general, permits, for use only as a teaching aid in certain approved schools, the making of sound recordings of published school broadcasting programs or other broadcast programs having mainly an educational nature. Excepted are the making of recordings direct from phonograph records or tape recordings produced for commercial purposes.

74. SIERRA LEONE. *Laws, statutes, etc.*

The Copyright Act, 1965. (No. 28, of May 5, 1965). (4 *Copyright* 127-131, no. 6, June 1968; 158-166, no. 7, July 1968; 179-187, no. 8, Aug. 1968.)

"Published in *Supplement to the Sierra Leone Gazette*, vol. XCVI, No. 62, dated August 12, 1965. The Act took effect on May 28, 1966 (retrospectively) by Public Notice No. 27 of 1966, published in the *Gazette* dated June 9, 1966.

"An act to make new provisions in respect of copyright and related matters in substitution for the provisions of the Copyright Act, 1911 and other provisions relating thereto."

75. SOUTH AFRICA. *Laws, statutes, etc.*

Act to consolidate and amend the law relating to designs. (No. 57, 1967). (Assented to 1st May, 1967). (7 *Industrial Property* 256-264, no. 8, Aug. 1968.)

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## PART III.

## CONVENTIONS, TREATIES AND PROCLAMATIONS

76. INTERNATIONAL COPYRIGHT UNION. Stockholm Revision of July 14, 1967. Protocol Regarding Developing Countries. *Great Britain*.

The following appeared in *THE BOOKSELLER* (London), December 7, 1968, at p. 1915:

The Government repeated its assurances about international copyright in the House of Commons last week. Mr. Carter-Jones asked the President of the Board of Trade what steps he was taking, in cooperation with other governments, with a view to safeguarding international copyright, and whether he would make a statement. In a written answer, Mr. Dell, replying for the Minister, said:

"We have no present intention of accepting the Protocol to the Berne Convention as revised in Stockholm last year. This Protocol allows such developing countries as are members of the Convention to grant a much lower standard of copyright protection than is demanded by the Convention itself.

"We are taking part in international discussions aimed at clarifying the position as it now stands. This position is somewhat confused partly because of this Protocol and partly because there are now two separate international Conventions, the Berne and Universal Conventions. These have different but overlapping membership, different secretariats and widely different standards."

77. UNIVERSAL COPYRIGHT CONVENTION. *Malta*.

The United States Department of State has been informed by the Director-General of UNESCO that the instrument of accession by Malta to the Universal Copyright Convention was deposited on August 19, 1968. In accordance with Article IX, paragraph 2, of the Convention, the latter came into force with respect to Malta on November 19, 1968, three months after the deposit of the instrument of accession.

Malta is the 56th country to become a party to the Universal Copyright Convention.

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## PART IV.

**JUDICIAL, DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## 1. Federal Court Decisions

78. *Geisel v. Poynter Products, Inc.*, 158 U.S.P.Q. 450 (S.D.N.Y., April 9, 1968) (Herlands, J.). *For decision after trial, see Item No. 79, immediately below.*

Motion for preliminary injunction for violation of Section 43(a) of the Lanham Act. Plaintiff, Theodore Seuss Geisel, is a well-known artist-author who has written and illustrated numerous books and articles featuring "imaginative and whimsical creatures created by plaintiff and drawn in his unique, readily recognizable style [which] are the foundation of the success of plaintiff's works and strike a responsive chord in the hearts and imaginations of children everywhere." In 1932, prior to plaintiff's success in the children's book field, he prepared a series of illustrated essays ("cartoons") including his characteristic creatures, which were published, in connection with the name "Dr. Seuss," in Liberty Magazine under blanket copyright notice. Subsequently, defendant Liberty Library, successor in interest to Liberty Magazine, granted defendant Poynter Products the right to manufacture and sell toys based on the cartoon illustrations and to use the name "Dr. Seuss" in connection therewith. Defendant Poynter commenced to produce and sell dolls derived from the illustrated creatures in association with the "Dr. Seuss" name (in plaintiff's established stylistic printing), the use of which had never been authorized by plaintiff. Plaintiff sought a preliminary injunction restraining defendants from representing plaintiff as the designer, producer or sponsor of defendants' dolls.

*Held*, injunction granted.

The court found that the "trade name" "Dr. Seuss", as used in connection with plaintiff's books, records, etc. and the promotional material relating thereto, had developed great commercial value and "is a substantial aid in the sale of any product for children" and that defendant's sales of the dolls in prominent association with the stylized Dr. Seuss name (e.g., "Dr. Seuss"; "From the Wonderful World of Dr. Seuss"; "This

is my —— from Dr. Seuss Merry Menagerie”) was “deliberately intended to and do[es] give the impression and constitute express and implied representations that plaintiff created, designed, manufactured, produced, authorized or approved the design of these dolls and the dolls themselves, [which] impression and representations are false and misleading. . . .”

Observing that Section 43(a) is not limited to the proscription of false designations of *geographical* origin, but rather encompasses false representations of personal authorization or approval as well, the court held that defendant’s use of the “Dr. Seuss” name was therefore within the prohibition of that section.

79. *Geisel v. Poynter Products, Inc.*, not yet reported (S.D.N.Y., Dec. 10, 1968) (Herlands, J.). *For decision on motion for preliminary injunction, see Item No. 78, immediately above.*

Action for unfair competition, defamation and prima facie tort. The basic facts underlying this controversy are set forth in the digest of the decision on plaintiff’s motion for a preliminary injunction in Item No. 78, *supra*. Subsequent to the issuance of the temporary relief, defendant Poynter Products changed its references to the name “Dr. Seuss” by discontinuing the use of plaintiff’s characteristic style of printing and by modifying all references to the name with terminology indicating the dolls were “based on Liberty Magazine Illustrations by Dr. Seuss.” After full trial, Judge Herlands issued a seventy-two page opinion including footnotes).

*Held*, for defendants, except to the extent of the preliminary injunction herein made permanent.

I. *Liberty’s Rights Under the 1932 Agreement*: The court held that plaintiff’s oral 1932 agreement with Liberty Magazine transferred the entire bundle of rights in the cartoons to the magazine without any reservation of rights, legal or equitable, in plaintiff.

Plaintiff asserted that although his agreement with Liberty did pass legal title in the copyrights to the latter (an admission required to avoid the cartoons being held in the public domain under the indivisibility doctrine, no separate copyright having been claimed for the individual cartoons), such rights were understood to be held in trust for plaintiff. Absent proof of any express agreement concerning such trust relationship, plaintiff offered considerable expert testimony concerning the customs and usages in the magazine industry at the time in question which, “if believed in its entirety,” would have imposed a condition in the agreement that Liberty could use each essay “only in a single

insertion" in its magazine and thereafter held the copyright in trust for plaintiff, and would have implied a transfer of "all" or "complete" rights only in such a sense. Defendant offered similarly comprehensive expert testimony controverting plaintiff's position and the court, finding defendant's evidence more convincing and credible than plaintiff's, held that "the custom and usage in 1932 in the magazine trade implied in fact in the Geisel-Liberty agreement a provision whereby all rights or complete rights were assigned to Liberty." Further, the court continued, "in ordinary acceptance the expressions 'all rights' or 'complete rights' have a mechanical and literary meaning [and] plaintiff has failed to sustain the burden of proof which is upon him when he seeks to impart to these words a connotation that is diametrically opposed to their plain colloquial sense [-i.e.] a totality of rights . . . without qualification [or restriction] as to the uses to which the cartoons might be put."

II. *Defendant's Right to Manufacture and Sell Dolls Derived from the 1932 Illustrations:* The court held that, as the owner of copyright on the two-dimensional illustrations, Liberty had "the right to make three-dimensional figures or dolls therefrom or to license another to do so." The court categorized its holding as "a corollary" of the rule that copyright in a work expressed in one medium might be infringed by a work set forth in another medium (citing cases dealing with, *inter alia*, the infringement of cartoon copyrights by doll manufacturers). The "manifest logic" of its holding, added the court, "is demonstrated by assuming *arguendo* that [plaintiff's cartoons] are in the public domain. In that suppositious situation, clearly defendants could copy the cartoons at will. In the present case, defendants, as owners of the copyrighted cartoons, cannot be in a less advantageous position."

III. *Defendant's Right to Use Plaintiff's Name in Connection with Such Manufacture and Sale:* Prefatory to its specific holdings on each of plaintiff's various theories of suit under the instant heading, the court discussed a number of trademark/unfair competition cases establishing the doctrine that one might make reference to another's trademark "as long as there is full and meticulously truthful disclosure" of the exact relationship involved. This general principle, influencing the entire course of the opinion, prompted the court to observe that, in like sense, plaintiff herein "has, to the extent that defendant Liberty Library owns all rights in the cartoons which appeared with the name 'Dr. Seuss', no absolute monopoly in [such name]."

*A. Section 43(a) of the Lanham Act:* The court reaffirmed, on the merits, its holding on the motion for preliminary relief that defendant doll manufacturer's references to the name "Dr. Seuss" during the period of time prior to the issuance of a temporary restraining order, preceding the preliminary injunction, violated Section 43(a) and ordered that the injunction be made permanent.

However, the court further held that defendant's use of the name "Dr. Seuss" after the issuance of the preliminary injunction was not within the prohibition of that section as such references created no false impression that plaintiff designed, manufactured or authorized the dolls. The court said:

No actual deception or confusion of, or tendency to deceive, the public is possible [from the post-injunction use of the name]. Defendants have, in fact satisfied the criteria of full and meticulously truthful disclosure. The phrase "based on" or the word "based" as used by defendants . . . , like the phrases "derived from," "suggested by," or "inspired by" accurately characterize the genetic link between the cartoons and the dolls. . . . The dolls are not exact reproductions or replicas of the cartoons. But these morphological differences are within the accepted limits in the licensed toy trade. . . . Section 43(a) cannot be read as permitting an inference [that "based on" is a misrepresentation because it implies plaintiff's approval] without deleting the word "false" from that statute.

*B. Common Law False Attribution of Sponsorship:* "Indubitably," said the court, "one cannot attribute to an artist or author a work which the artist or author did not create or which substantially departs from his original work." Adding, however, that defendant's ownership of all rights in the 1932 cartoons "must include some right to use the name 'Dr. Seuss'" because that name appeared on each of the cartoons, the court reiterated (see §43(a), above) its finding as to the absence of any false attribution subsequent to the issuance of the preliminary injunction in holding against plaintiff on this theory also.

*C. Misappropriation:* The court held that "plaintiff cannot recover for the 'appropriation' of the cartoons themselves because defendant Liberty Library owns the copyright and plaintiff has no rights in them."

*D. N.Y. Gen. Bus. Law §368-d (Anti-dilution/Injury to Business Reputation):* In dismissing plaintiff's claim under this statute the court held that (i) there was no showing of a likelihood of injury to [plaintiff's] business reputation"; and (ii), as to dilution:

That statute requires a showing of some measure of customer confusion. . . . [which] has not been made herein with respect to defendants' [post-preliminary injunction] conduct. In the ordinary case of "dilution" of a trade name, the parties are not in any contractual relationship involving the subject matter of the claim of dilution. . . . In this case, however, the applicability of the concept of dilution is precluded by the contractual relationship between the parties. Plaintiff's rights in the trade name "Dr. Seuss" are monopolistic as to all the world *except* as to defendant Liberty Library, who acquired all rights in the cartoons from plaintiff in 1932. Consequently, defendants cannot be considered to be diluting plaintiff's trade name.

*E. N.Y. Civil Rights Law §51 (Right of Privacy):* The court held that plaintiff could not succeed under this statute because (i) as an assumed name or pseudonym, rather than plaintiff's actual surname, the designation "Dr. Seuss" lies without the scope of Section 51; and (ii) the self-contained exception in Section 51\* was applicable. Although, in the latter connection plaintiff asserted the inapplicability of the exception because plaintiff "sold or disposed of" the *cartoons*, and not the *dolls*, with his name appended, the court held that "the dolls are substantially related to the cartoons [and] the evident statutory purpose of the exception encompasses the circumstances of this case."

*F. Defamation:* Plaintiff alleged that the dolls were "tasteless, unattractive and of an inferior quality" and that the sales of such in connection with a name associated with plaintiff was defamatory. The court found for defendant, however, holding that (i) the dolls were not of such defamatory character; and (ii) after the issuance of the preliminary injunction, there was no association of plaintiff with the dolls upon which to predicate the asserted connection.

*G. Prima Facie Tort:* The court held that plaintiff had failed to establish that defendants had conspired to injure plaintiff, indeed, "far from there being an intent to injure, the Court finds that defendants . . . conducted themselves carefully and conservatively. There was no malice or intention to inflict injury on plaintiff." Further, added the

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\* "But nothing contained in this act shall prevent any person . . . from using the name . . . of any author, composer or artist in connection with his literary, musical or artistic productions which he has sold or disposed of with such name . . . used in connection therewith."

court, plaintiff had failed to plead and prove the special damages required of a prima facie tort claim.

80. *Pickwick Music Corporation v. Record Productions, Inc.*, 292 F. Supp. 39, 159 U.S.P.Q. 228 (S.D.N.Y., June 19, 1968) (MacMahon, J.).

Action for copyright infringement by the publishers of eight musical compositions against a number of defendants connected in various capacities with the production and sale of an infringing record album.

*Held*, judgment for plaintiffs in part.

I. One group of defendants consisted of individuals associated with a dissolved corporation which had engaged in the initial manufacture and sale of the album. The court found that all but two of this group personally participated in the acts of infringement and were each jointly and severally liable. The court observed that the parties found liable had all participated in the arrangements made for pressing the album and in the distribution of profits and losses upon dissolution; each also played an active part in the formation or financing of the corporation or the recording, editing or sale of the album. One of the exonerated defendants performed "merely ministerial office functions" and engaged in the sale of the album only by virtue of having taken telephone orders; the other merely did art work for the corporation—neither was shown to be connected with the process of manufacture and, though both had served as (non-executive) officers of the firm, "this in itself does not make them participants in the infringement."

II. A second group of defendants was comprised of the corporation which pressed the album, under arrangement with the aforementioned dissolved firm, and its president. The court held both the corporation and the individual liable, observing that the corporation engaged in manufacture without filing a notice of intent to use, that non-payment for its efforts was no defense, and that the officer, though presumably acting in his corporate capacity in negotiating for and personally doing the pressing, was not shielded from liability thereby.

III. A third group of defendants consisted of a record-producing corporation which succeeded to the aforementioned dissolved corporation's properties, corporate members of its sales organization, and individual officers and shareholders of these firms. The court found that the corporations had contributed to the manufacture or sale of the infringing albums. Although the producing corporation filed notices of intent followed by the unaccepted tender of alleged statutory royal-



ties, the notices were held to have "come too late . . . they should have been filed by the [dissolved corporation or the pressing corporation] before the works were actually reproduced" and the tendered checks, based upon albums "manufactured and sold," while the statute speaks of the number of units manufactured, were deemed properly rejected. The court concluded that "the belated notices of intent and specious tenders of payment are a rather transitory attempt to build a defense. They will not limit the amount of recovery of compensatory or punitive damages, nor will they bar an award of attorney's fees." The individuals were found to have personally participated in the acts of infringement committed by their respective corporations.

IV. Several of the defendants in each group cross-claimed against those in the other groups on the basis of alleged assurances that all license requirements had been met. All but two of these claims were dismissed for failure to produce evidence in support thereof.

81. *Dolch v. Garrard Publishing Company*, 159 U.S.P.Q. 480 (S.D.N.Y., Aug. 2, 1968) (Graven, J.).

Action and counterclaim for declaratory judgment. Plaintiffs are the holders of all the rights of two well-known authors in the field of children's education under the authors' contracts with defendant publisher, each of which granted defendant an "exclusive right of publication." Plaintiff sought a declaration that defendant was restricted to publishing hard-cover editions and acquired no rights to publication in paper-back form (which latter rights plaintiffs were desirous of selling to another publisher). Alternatively, plaintiffs requested a declaration that insofar as the agreements did grant paper-back rights, plaintiffs were entitled to rescission for defendant's failure to exploit such rights. Defendant, in addition to controverting the above, based on the unrestricted nature of the grant of rights, sought a declaration that it was entitled to include these authors' works in catalogs dealing with the books of other authors.

*Held*, judgment for plaintiff in part and defendant in part.

I. The court held that subsequent provisions of the contracts did not modify the grant of "the exclusive right of publication of the books" so as to limit the publication rights to hard cover editions and that defendants were entitled to publish the books in paper-back form.

A. Plaintiffs asserted that a provision in each of the contracts, providing that the "design, quality of materials used . . . the general format

... and distribution policies shall be consistent with the educational purposes for which the material is intended and the professional reputations of the authors," negated a grant of paper-back publication rights. Observing, however, that plaintiffs had themselves been negotiating for the paper-back publication of the works and had requested rescission for failure to exploit the paper-back rights—thus indicating their own view that paper-back publication was not inconsistent with the educational purposes of the books and the authors' reputations—and noting "other evidence" (including the development of a substantial paper-back educational market) of the lack of any such inconsistency, the court held that "the provisions referred to cannot reasonably be construed as withholding the right of paper-back publication."

*B.* Plaintiffs also relied upon minimum royalty provisions in the contracts (expressed in flat cent amounts compared to the regular percentage royalties) which, allegedly, were inconsistent with a grant of paper-back publication rights because of the prices at which paper-back versions would have to be sold to accommodate same. The court, however, noted that plaintiffs' alternative request for rescission indicated their own view that exploitation of paper-back rights under the royalty provisions was economically feasible. The court added that if the selling prices of the paper-back editions were in the upper range of those contemplated by plaintiffs' desired publisher and if the maximum (percentage) royalty provisions of the contract were applicable, as they would be should distribution approach that contemplated by that publisher, the resultant payments would approximate the minimum flat royalties. The court therefore held that the minimum royalty provisions could not "be reasonably construed as limiting 'the exclusive right of publication' to the publication of books with hard covers."

*C.* The evidence also showed that during the negotiations of the contracts in question the matter of paper-back publication was not discussed although the parties were familiar with the publication in paper-back of numerous works of various forms. Plaintiffs asserted that this manifested the parties' intent to exclude paper-back publication rights from the grant, but the court held such assertion to be an attempt to add or supply words of limitation to the grant clause which was barred by the parole evidence rule.

*II.* The court also held that, because there was no substantial market for paper-back versions of the type of work here concerned until some time subsequent to the execution of the contract and due to

the fact that for the past four years the defendant's right to paper-back publication had been the subject of the instant litigation, plaintiffs' were not entitled to partial rescission for defendant's failure to exploit paper-back rights.

III. The court further held that, under the long-standing interpretation by the parties of another agreement between the authors and defendant, defendant was not entitled to publish catalogs which included both books written by the authors in question and those authored by others. Although the specific provisions of the agreement in question were not entirely clear on the matter, "in this case the rule relating to the practical construction and interpretation of a contract by the parties prior to controversy is applicable."

82. *Blumcraft of Pittsburgh v. Newman Bros., Inc.*, 159 U.S.P.Q. 166 (D. Ohio, June 25, 1968) (Hogan, J.). For earlier decision, see 373 F.2d 905, 153 U.S.P.Q. 91, 14 BULL. CR. SOC. 375, Item No. 288 (6th Cir. 1967).

On remand from the court of appeals' reversal of summary judgment for defendant in action for copyright infringement. Both plaintiff and defendant are long-established and well-reputed firms engaged in the creation of ornamental metal designs for architectural use. Plaintiff alleged that it had created a new handrail system, illustrations of which were published in its various copyrighted catalogs, and that defendant copied such illustrations in its own catalog.

*Held*, for plaintiff; judgment withheld pending determination of damages.

Stating that "we deal with the ultimate and conglomerate expression—conceding that many [elements] in isolation may be in the public domain, or may be so easy or obvious that anyone would be likely to so express," the court held that plaintiff's illustration was a copyrightable "original" work. Although defendant attempted to attack the validity of plaintiff's copyright by severing the various elements of plaintiff's illustration and categorizing each as "old hat," and the court observed that there "is not a musical note, nor a musical chord, nor an English word that has not been in the public domain for a long time. Any song or book, or article, or speech attacked word by word would therefore fail. All of which demonstrates that it is the ensemble that makes the difference." The court also noted that "original" in copyright means only that a particular work originated with the author—"no large measure of novelty is required"—and that there was no

evidence that plaintiff *did*, aside from having the *opportunity* to, utilize other sources in producing its illustration.

Although defendant "relies on abandonment arising from [the drawings in plaintiff's] patent application publication," the court held that only "the beginning" of plaintiff's expression had been so abandoned, if any.

Defendant also asserted that its illustrations were merely representations of its own product, to which the court repeated the holding in the court of appeals that "one cannot copy the copyrighted illustration of another's product, even though it may precisely illustrate one's own product"; and added that at the time in question defendant had only "ideas" and no such goods to illustrate.

Finally, noting a "revolutionary number of changes, all in the direction of plaintiff's copyright" in defendant's catalog illustrations, the court held that under the "ordinary observer" test of substantial similarity and in light of defendant's undisputed access to plaintiff's catalogs, "the accused illustration was in fact substantially copied from the plaintiff's copyrighted and original expression." The long-standing excellent reputation of defendant, however, impelled the court to add that "we do not pin the badge of any moral wrongdoing on [defendant], or its president, or any other officer or employee, or its artist. . . . As psychiatry teaches, the subconscious mind is a forceful directing agent—unknown to the conscious."

83. *Tennessee Fabricating Co. v. Moultrie Manufacturing Co.*, 159 U.S.P.Q. 363 (M.D. Ga., Aug. 16, 1968) (Elliott, J.)

Action for copyright infringement. Plaintiff held a registration of claim to copyright for an architectural casting. Defendant obtained such a casting which bore no discernible notice (subsequent to the institution of suit the designation "TFC Co. ©" was found beneath a surface covering of paint) and commenced to produce copies for sale therefrom.

*Held*, judgment for defendant.

The court held that plaintiff had forfeited copyright protection by failing to produce any evidence of initial publication with notice, adding that the registration certificate is not *prima facie* evidence thereof "since publication is not a fact stated in the certificate". Further, plaintiff "having produced no evidence that all copies of the work manufactured by it had borne copyright notice cannot benefit from

presumption that the copyright notice was obscured by some intervening third party." The unit from which defendant manufactured its copies was therefore deemed to represent an insufficient publication with indiscernible notice. Although plaintiff did make of record one of its units bearing the legend "TFC Co. ©", this was found inadequate "since TFC Co. is not the Plaintiff's name nor the name by which it is known in the industry and Plaintiff's full name does not appear elsewhere on the work."

The court also held that plaintiff's casting did not possess the "minimal degree of creativity required of a work of art" to sustain registration.

84. *Florence Art Company, Inc. v. Quartite Creative Corporation, et al.*, 158 U.S.P.Q. 382 (N.D. Ill., June 13, 1968) (Napoli, J.)

Action for copyright infringement. Plaintiff manufactures and sells lamps; defendant Top Value Enterprises sells premium stamps to businesses and redeems same in merchandise and defendant Quartite is a lamp supplier to Top Value. Plaintiff marketed a certain table lamp with sculptured base for which it held a Class G registration. Due to the manufacturing process, the copyright notices thereon were "always noticeable, although in some cases partially unclear." Plaintiff offered to supply Top Value with such lamps and at a meeting between these parties, Top Value was informed that the lamps were copyrighted and was given a sample bearing a partially readable notice. Top Value subsequently requested that Quartite modify one of its own lamps in certain respects to correspond to features of plaintiff's. Quartite made the requested modifications and its lamp was then catalogued and sold by Top Value.

*Held*, judgment for plaintiff.

The court found that (i) plaintiff's lamp was "created by the exercise of skill, labor, judgment, and ability of plaintiff's employee" and was wholly original therewith; (ii) plaintiff consistently maintained reasonable efforts to comply with the notice requirements of the Copyright Act; and (iii) defendant's lamp, as modified, "embodies all the new and original design features of plaintiff's copyrighted lamp and is a copy thereof." The court concluded that "both defendants had access to plaintiff's lamp . . . willfully and deliberately copied for profit the essential design and coloring features [thereof] . . . and had actual notice of plaintiff's claimed copyright. . . ."

## 2. State Court Decisions

85. *Van Valkenburgh, Nooger & Neville, Inc. v. John F. Rider Publisher, Inc., not yet reported* (Sup. Ct. N.Y. Co., Dec. 9, 1968) (Conclusions of Law) (Saypol, J.)

Action for unfair competition. Defendant was the publisher of plaintiff's two sets of multi-volume treatises on electricity. Plaintiff alleged that defendant (a) misappropriated the form and substance of the mode of presentation characterizing plaintiff's works in publishing other works dealing with similar subject matter; and (b) took steps to market the latter works at the expense of plaintiff's.

*Held*, for plaintiff.

The court held that defendant owed plaintiff a fiduciary duty which originated in the publishing contract between the parties and arose specifically from defendant's exclusive control of the right to publish and sell plaintiff's works, defendant's express undertaking to use its best efforts to promote the sales thereof, and the fact that any benefit to plaintiff under the contract depended solely on defendant's sales.

The court also found that the publishing agreement contained an implied covenant that defendant would "deal honestly, fairly, and in good faith with Plaintiff and would not take any action that would frustrate or impair Plaintiff's rights in relation to that agreement."

The court held that defendant had both violated its fiduciary duty and breached the implied covenant by (i) engaging in the preparation and publishing of the challenged works "which were closely comparable in form and substance to plaintiff's books,\* and were conceived and designed by defendants to be sold in place of plaintiff's books"; (ii) failing to inform plaintiff, before publication of the challenged books, that they had arranged for the preparation thereof and intended to publish same; and (iii) concealing the plans with regard to the challenged works from plaintiff and deceiving plaintiff with regard thereto.

The court also held that defendant had violated its express "best efforts" undertaking, in addition to the fiduciary duty and implied covenant, by (i) using, in connection with the marketing of the chal-

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\* In his oral decision, as reported in the Transcript of Minutes of the Official Reporter dated Sept. 17, 1968, Judge Saypol said, in part: ". . . defendant's product is an expanded and updated version not identical [to nor literally copied from] but sufficiently patterned after the plaintiff's to arouse judicial interest and concern of impropriety by misappropriation. Bedfellows have done questionably what strangers might get away with, with impunity."

lenged books, the customer lists, knowledge, selling techniques and advertising experience acquired in connection with the marketing of plaintiff's books; (ii) suspending activities connected with the sale of plaintiff's books while "launching an extensive campaign" to promote the challenged works; and (iii) attempting to sell the challenged books to purchasers and former purchasers of the plaintiff's books.

Plaintiff was held entitled to (i) judgment in the amount of royalties that would have been payable to plaintiff had sales of the challenged books and the rights therein been sales of the plaintiff's; (ii) judgment in the amount of loss in value of plaintiff's works sustained as a result of defendant's breaches and the creation, publication and sale of the challenged works; (iii) an order directing the destruction of all unsold copies of the challenged books and the materials used in reproducing same and enjoining defendants from printing, publishing or selling the works; and (iv) the maximum additional allowance of \$3,000 under N.Y.C.P.L.R. §8303(a)(2).\*\*

Although the court found defendant to have been guilty of "deliberate and wanton wrongdoing," punitive damages were denied "since a public right does not appear to be involved. . . ."

*Also of interest:*

86. *Remco Industries, Inc. v. Toyomenka*, 158 U.S.P.Q. 455 (S.D.N.Y., April 26, 1968) (Bryan, J.)

Motion for preliminary injunction in action for unfair competition between marketers of competing toy vehicles. Plaintiff alleged that defendant's product simulated the allegedly unique and non-functional design features of its toy and that defendant had palmed off its toy as plaintiff's.

*Held*, motion denied.

On the product simulation count, the court held that plaintiff had not demonstrated a degree of success on the issue of secondary meaning sufficient to warrant preliminary relief, pointing out that advertising expenditures "measure plaintiff's efforts to establish secondary meaning but do not determine its success." The court's holding rendered it unnecessary to deal with the admitted problem of the effect of *Sears* and *Compco* on the doctrine of secondary meaning. On the palming off count, the court found the evidence insufficient to sustain the

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\*\* An Interlocutory Judgment detailing plaintiff's remedies was signed Dec. 9, 1968, and filed in the New York County Clerk's Office on Dec. 10, 1968.

allegation and, with particular reference to *Sears and Compco*, added that defendant had in no way simulated the plaintiff's labels or packaging.

87. *Black Hills Video Corporation v. F.C.C.*, 399 F.2d 65 (8th Cir., Aug. 7, 1968) (van Oosterhout, J.)

Consolidated petitions to review and set aside rules promulgated by the F.C.C. relating to the regulation of CATV systems. Petitioners' assertion that the "carriage rule" (generally requiring CATV systems to carry the programs of local stations on request) was invalid in view of the provisions of the Copyright Act was rejected because the recent Supreme Court decision in the *Fortnightly* case was deemed to insulate CATV operators carrying copyrighted programs under the rule from liability for infringement. A challenge to the "non-duplication rule" (generally prohibiting the duplication of programs on the same day they are presented by local stations) as invalid under the rationale of *Sears and Compco*, because of alleged inconsistency with the Copyright Act was also unavailing, because:

Here the conflict if any is between two federal laws [rather than state and federal law under the supremacy clause] and at most the issue is whether the Commission's power to regulate non-duplication under the powers granted it by the Federal Communications Act is inconsistent with federal policy underlying the Copyright Act. Petitioners have not shown that the rule, which the Commission found was needed to further the public interest in the broadcasting field, is inconsistent with the policy underlying the Copyright Act.

The court also refused to sustain petitioners' contentions that the above rules, and others, were without the Commission's jurisdiction, were promulgated in violation of the APA, and were in violation of the First and Fifth Amendments.

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## PART V.

## BIBLIOGRAPHY

## A. BOOKS AND TREATISES

## 1. United States Publications

88. Copyright Law Symposium, no. 16. New York, Columbia University Press, 1968. 236 p. (Nathan Burkan Memorial Competition, sponsored by the American Society of Composers, Authors and Publishers, 1966).

The prize essays are analyzed separately, *infra*.

89. George Washington University, *Washington, D.C. National Law Center. Computers-In-Law Institute*. The law of software; 1968 proceedings. Washington, D.C., 1968, 1 v. (various pagings).

*Partial contents.*—The copyright outlook: Impact of new technology on the economy of specialized publications, by Curtis G. Benjamin. Registrability of computer programs, by George D. Cary. Copyright protection for computer programs, by John F. Banzhaf III. Also includes a section on patent protection of computer programs.

90. PATTERSON, LYMAN RAY. Copyright in historical perspective. Nashville, Vanderbilt University Press, 1968. 264 p.

"Professor Patterson traces the development of copyright from the sixteenth century to the present in the United States. He shows that copyright was in fact originally a publisher's right, not really an author's right at all, which helps explain much about the unsatisfactory nature of present-day copyright law and the absence of a satisfactory law of literary property—the root of the current attempt by Congress to revise provisions of the existing copyright law."—Dust jacket.

91. WITTENBERG, PHILIP. The protection of literary property. Boston, The Writer, Inc. [1968] 267 p.

"A portion of this book originally appeared under the title, *The Law of Literary Property*" (Cleveland, World Pub. Co., 1957).

A reference work for authors, lawyers, literary agents, publishers and editors, written as an aid to the understanding of legal problems involved in the protection of literary property. Includes a brief history of the concept of literary property and covers such subjects as the proposed general revision of the copyright law, international copyright, plagiarism, piracy, infringement, permissions, protection of ideas, names and titles, the right of privacy, libel, censorship, publishing contracts and subsidiary rights.

## 2. Foreign Publications

92. FOX, HAROLD G. *The Canadian Law on Copyright and Industrial Designs*. 2nd Edition. Toronto, The Carswell Company, 1967. 691 p., appendices. (Announced 15 BULL. CR. SOC. 191, Item 130 (1968)).

The following is an excerpt from a review of Dr. Fox's new edition of his work, written by Christopher Robinson, Q.C., of Ottawa:

With a modification of the Churchillian phrase, it might be said of the author of this book that in no country in any field of law in our times have so many owed so much for so long to one man. Harold Fox has been publishing works on the Canadian law in all branches of the field of industrial and intellectual property for over forty years and during that time his books have, with the exception of one small volume dealing with patents, been the only ones published on the Canadian law in these important fields. He has published three editions of his work on Patents, two editions of his work on Trade Marks, and now, after an interval of over twenty years since the first edition, this second edition of his works on Copyright and Industrial Designs. Besides all this he has, since 1940, published Fox's Patent Cases with a complete annotated collection of all cases in these fields.

This second edition of Fox on Copyright, the only Canadian work there has ever been on the subject, is useful not only in providing an up-to-date statement of the law on the subject resulting from Canadian jurisprudence but also in providing an up-to-date selection of United Kingdom jurisprudence on the subject relevant to Canada, this latter aspect being of particular importance because of the far reaching changes in the United Kingdom Copyright statute made in 1956, which substantially reduced the pre-

vious quite close similarity of the United Kingdom and Canadian statutes and hence reduced the direct usefulness in Canada of United Kingdom text books on the subject.

Not only does one find that the author has brought his work up to date, one also finds that in many instances there has been substantial reconsideration of earlier materials and substantial revisions and additions in connection with such earlier material . . .

As the title of the work indicates it deals not only with Copyright but also with Industrial Designs, which were last dealt with by the author in the first edition of his work on Trade Marks in 1940. The inclusion of Industrial Designs in a work on Copyright is logical since they are more closely related to this subject than to the subject of Trade Marks and Unfair Competition. There has been an appreciable amount of Canadian jurisprudence in this field in the past quarter century and specially important recent decisions on the basic question of the subject matter of Industrial Designs. All of these are fully treated by the author.

The Canadian Copyright Act contains a section (Section 46 discussed by the author at pp. 159 to 169) corresponding to a section which first appeared in The Imperial Copyright Act of 1911 dealing with overlap between copyright and design protection. A different approach to dealing with this question was taken in the United Kingdom Copyright Act of 1956 in Section 10. The Canadian Royal Commission in its report on Copyright in 1957 discussed the question (pp. 71 to 75) and recommended the adoption essentially of the United Kingdom 1956 approach. It is interesting that, since that time, New Zealand, which had had a provision essentially identical with the present Canadian provision, simply omitted any provision at all on the subject in the new Copyright Act of 1962, the view having been reached in New Zealand that there was no need for any such special provision, which indeed is essentially peculiar to the Commonwealth copyright statutes inspired by the Imperial Act of 1911. It was the objection alone of the English delegation at the Berlin Conference in 1908 for revision of the International Copyright Convention that prevented that Convention from extending to works of applied art and brought about instead Article 2(4) which provides for the protection of such works so far as the domestic legislation of each country allows. Before Canada finally enacts a new Copyright Act, a re-examination of this whole question could usefully be undertaken.

93. GERSTENBERG, EKKEHARD. Die Urheberrechte an Werken der Kunst, der Architektur und der Photographie. Erläutert für Urheber und Juristen. München, C. H. Beck, 1968. 323 p.

A section by section commentary, intended for authors and lawyers, on the new copyright law of the German Federal Republic, with special emphasis on works of art, architecture and photography. Extensive appendices include comparative tables, citations to leading cases, and texts of various pertinent laws and regulations and of international conventions.

## B. LAW REVIEW ARTICLES

### 1. United States

94. Adequate legal protection for computer programs. (1968 *Utah Law Review* 369-394, no. 3, Sept. 1968.)

"This article was awarded first prize in the Nathan Burkan Memorial Competition at the University of Utah College of Law." Among the conclusions reached are that copyright protection is desirable for the bulk of commercially distributed computer programs not meeting the patent requirements of novelty and non-obviousness, and that the section in the Patent Reform Bill prohibiting software patents should be changed to extend such protection.

95. BERTELSMAN, WILLIAM O. The first amendment and protection of reputation and privacy—*New York Times Co. v. Sullivan* and how it grew. (56 *Kentucky Law Journal* 718-756, no. 4, Summer, 1967-68.)

An article which purposes "to discuss in some detail the development of the *New York Times* doctrine, its logic and policy, its place in first amendment theory, its shortcomings, and finally some possibilities for channels of future growth."

96. DERENBERG, WALTER J. The twenty-first year of administration of the Lanham Trademark Act of 1946. (158 *Patent, Trademark and Copyright Weekly Reports* 1-50, no. 9, part II, Sept. 16, 1968.)

An annual progress report submitted to the Section of Patent, Trademark and Copyright Law of the American Bar Association. Of interest to the copyright bar are Professor Derenberg's introductory remarks concerning the fate of the copyright revision

bill in the 90th Congress, and sections dealing with the registrability of background design, packages and configurations; section 43(a) of the Lanham Act; and, the impact of the *Sears and Compco* decisions.

97. GOLD, STEPHEN A. Television broadcasting and copyright law: the community antenna television controversy. *Copyright Law Symposium*, no. 16 (1968), pp. 170-192.

An essay, awarded National Fifth Prize in the 1966 Nathan Burkan Memorial Competition, which was first published anonymously in *St. John's Law Review*, vol. 41, n. 2 (Oct. 1966), pp. 225-239. See 14 BULL. CR. SOC. 250, Item 135 (1967).

98. GOLDSTEIN, PAUL. Copyrighting the new music. *Copyright Law Symposium*, no. 16 (1968), pp. 1-29.

This essay, which was awarded National First Prize in the 1966 Nathan Burkan Memorial Competition, was first published in 15 *Buffalo Law Review* 355-373, no. 2 (Winter 1968).

99. LIBOTT, ROBERT YALE. Round the prickly pear: the idea-expression fallacy in a mass communications world. *Copyright Law Symposium*, no. 16 (1968), pp. 30-80.

This essay, awarded National Second Prize in the 1966 Nathan Burkan Memorial Competition, was first published in the *UCLA Law Review*, vol. 14, no. 3 (Mar. 1967), pp. 735-772. See 15 BULL. CR. SOC. 74, Item 54 (1967).

100. LLOYD, BOARDMAN. "Disk television": recurring problems in the performance of motion pictures. *Copyright Law Symposium*, no. 16 (1968), pp. 143-169.

An essay, awarded Fourth National Prize in the 1966 Nathan Burkan Memorial Competition, which was first published in *University of Chicago Law Review*, vol. 34, no. 3 (Spring 1967), pp. 686-703. See 15 BULL. CR. SOC. 74, Item 55 (1967).

101. NIMMER, MELVILLE B. The right to speak from Times to Time: first amendment theory applied to libel and misapplied to privacy. (56 *California Law Review* 935-967, no. 4, Aug. 1968.)

Professor Nimmer examines the rationale behind the opinions in the libel case of *New York Times Co. v. Sullivan*, 376 U.S.

255 (1964) and the privacy case of *Time, Inc. v. Hill*, 385 U.S. 374 (1967). He concludes that the Court was correct in the "definitional balance of interests" approach to the libel case in which it held in effect that defamatory speech directed against a public official, unless it is knowingly or recklessly false, is protected by the first amendment, but erred when it applied the same doctrine to the privacy case.

102. PUCKETT, ALLEN W. The limits of copyright and patent protection for computer programs. *Copyright Law Symposium*, no. 16 (1968), pp. 81-142.

A paper, awarded National Third Prize in the 1966 Nathan Burkan Memorial Competition, which purposes to determine if computer programs "are clearly entitled to copyright or patent protection, and if so, what the limits of that protection shall be." In the conclusion, public policy considerations are presented as "arguments against the extension of patent 'protection' to computer programs."

103. RINGER, BARBARA A. The role of the United States in international copyright — past, present, and future. (56 *The Georgetown Law Journal* 1050-1079, no. 6, June 1968.)

"Criticizing the inadequate early reactions of American foreign policy planners to the development of international copyright, Professor Ringer points out the need to redefine an international copyright law which will be responsive to the interests of the developing nations but will also preserve the basic purposes of copyright law. Such an effort, she concludes, requires energetic American involvement."

## 2. Foreign

### 1. Danish

104. KOKTVEGAARD, MOGENS. Elektronisk databehandling: immaterialretlige aspekter. Referat till XIII nordiska mötet för industriellt rattsskydd den 26-28 aug. 1968 i Stockholm. (*NIR* 139-151, no. 2, 1968.)

A report in Danish, with English summary, to the 13th Nordic Conference on the Protection of Industrial Property, held in Stockholm from Aug. 26 to 28, 1968. The report deals with computers

and intellectual property law, in which distinctions are made "between the *hardware* of electronics, the *software*, the *input*, and the *output*."

## 2. English

105. BOYTHA, GYORGY. Reciprocity in international copyright law. *Questions of International Law*, 1968, published by the Hungarian Branch of the International Law Association, pp. 37-63.

A study of the problems of reciprocity in international copyright law which are rooted in the territorial character of copyright laws so that "the assertion of copyrights beyond the state boundaries is subject to special conditions: international conventions or, in certain cases, actually concurrent reciprocal practice."

106. Committee of Experts on the Photographic Reproduction of Protected works. *Paris, July 1 to 5, 1968*.

General report. (4 *Copyright* 195-201, no. 9, Sept. 1968.)

"The purpose of the meeting was to examine copyright problems raised by the reproduction of protected works by photography or by processes analogous to photography and to formulate recommendations for possible solutions." The report is followed by annexes which include the list of working documents, the recommendations, and the list of participants.

107. CORINTH, BERNHARD. Gewerblicher Rechtsschutz und Urheberrecht in der britischen Kronkolonie Hongkong. (*Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil 286-287, no. 8/9, Aug./Sept. 1968.)

A brief survey of the legal protection of intellectual property in the British Crown Colony of Hong Kong.

108. DESJEUX, XAVIER. The scope of application of the Berne Convention as revised at Stockholm on July 14, 1967 (eligibility criteria and country of origin). (4 *Copyright* 203-204, no. 9, Sept. 1968.)

"This study was prepared as a report to the General Assembly of the International Literary and Artistic Association (ALAI), on April 23, 1968."

109. EUROPEAN BROADCASTING UNION. *Legal Committee*. The Stockholm version of the Berne Convention; views of the European Broadcasting Union. (*EBU Review* 33-47, no. 111B, Sept. 1968.)

In essence, an analysis and interpretation of the Stockholm Act.

110. EVANS, ROBERT V. *Fortnightly Corporation v. United Artists Television, Inc.* (*EBU Review* 54, no. 111B, Sept. 1968.)

After a brief comment on the decisions in the *Fortnightly* case, the deputy general counsel of CBS indicates that "the pending case of *Columbia Broadcasting System, Inc. v. Teleprompter Corp.* in which CBS claims infringement of its copyrighted television programmes by cable television systems, presents two factual aspects not present in the *Fortnightly* case." And that CBS now intends to take its case forward with the hope "that the factual distinctions will provide a basis for reversal, modification, or limitation of the *Fortnightly* case.

111. GAUDEL-GRUYER, DENISE. The assimilation of televisual works to cinematographic works and the regime of cinematographic works in the Stockholm Act of the Berne Convention. (*4 Copyright* 205-206, no. 9, Sept. 1968.)

"This study was submitted to the General Assembly of the International Literary and Artistic Association (ALAI), held on April 23, 1968." The study concludes that "it has been found that Articles 14 and 14 *bis* of the Stockholm Act still ensure to co-authors of cinematographic and televisual works a certain protection, but that they provide the basis of a system which is definitely unfavorable to authors, by facilitating for makers the exploitation of audiovisual works."

112. International Confederation of Societies of Authors and Composers (CISAC) (26th Congress, Vienna, June 23 to 29, 1968). (*4 Copyright* 189-191, no. 8, Aug. 1968.)

A brief account of the agenda and proceedings of the meeting, followed by the texts of the adopted resolutions. Among the topics covered by the resolutions were the Stockholm Protocol, and the collection of public performance royalties on film music and for jukeboxes in the United States.



113. International Publishers Association (IPA) (18th Congress, Amsterdam, June 9 to 15, 1968). (4 *Copyright* 188-189, no. 8, Aug. 1968.)

A brief account of the agenda and proceedings of the meeting, followed by the texts of the adopted resolutions. "A large part of the discussion was devoted to the problem of the Stockholm Protocol of the Berne Convention and that of assistance to developing countries."

114. LEIFS, JON. Can an extension of the copyright term be enforced? (*GEMA News* 21-22, no. 8, Aug. 1968.)

The president of the Icelandic performing rights society, STEF, using as an example the fact that Wagner's *Parsifal* had fallen into the public domain even though the composer had intended that it be performed only at the Bayreuth Festivals, urges authors, as well as their heirs, to preserve their works "in manuscript form, unprinted, and in no way reproduced," so as to retain unlimited control over their works for all times.

115. RINGER, BARBARA A. The role of the United States in international copyright. (4 *Copyright* 215-226, no. 10, Oct. 1968.)

Reprinted from 56 *Georgetown Law Journal* 1050-1079, no. 6, June 1968.) See Item 103 *supra*.

116. SANCTIS, VALERIO DE. Letter from Italy. (4 *Copyright* 138-145, no. 6, June 1968.)

A survey of recent legislative and judicial copyright activities in Italy, followed by a brief report on two meetings of lawyers that took place in Rome recently, the first of which "concerned copyright in relation to commissioned intellectual works, the second was . . . on questions of unification and harmonization of legislation, and it may also be of interest in regard to copyright, particularly as regards relations between countries having different economic and legal systems."

### 3. English, French and Spanish

117. SCHULZE, ERICH. First experiences with the new German copyright legislation. (*GEMA News* 3-21, no. 8, Aug. 1968.)

English, French and Spanish in parallel columns. The article, which is confined to the legislation of the German Federal Republic,

lic, was first published in German in 49 *UFITA* 17 (1967). See 15 *BULL. CR. SOC.* 205, Item 201 (1968).

#### 4. French

118. H'SSAINE, A. *Le droit d'auteur au Maroc.* (39 *Il Diritto di Autore* 210-215, no. 2, Apr.-June 1968.)

A brief survey of copyright protection in Morocco, by the director of the Moroccan Copyright Office.

#### 5. German

119. BODEN, RUDOLF. *Über die Unzulänglichkeit des Leistungsschutzes der ausübenden Künstler.* (70 *Gewerblicher Rechtsschutz und Urheberrecht* 537-540, no. 9, Sept. 1968.)

"Beiträge aus dem Gewerblichen Rechtsschutz und Urheberrecht zu Ehren von Robert Ellscheid."

A case is made for the thesis that the protection afforded to performances of performing artists by the Law on Copyright and Neighboring Rights of the German Federal Republic is inadequate.

120. Gamm, Otto Friedrich *Frhr.* von.

*Verlust der Einheit des Rechts durch Gesetzesperfektionismus und Verlagerung des Interessenausgleichs.* (70 *Gewerblicher Rechtsschutz und Urheberrecht* 401-403, no. 8, Aug. 1968.)

Some of the provisions of the new copyright law and of the law against unfair competition are given as illustrations of the thesis that the unity of the law is being eroded in the German Federal Republic by the incorporation in special laws of provisions to cover situations which could better be dealt with by general legal principles as interpreted by the courts.

121. GAWRILOW, E. P., and CH. CH. KOITEL. *Einige Fragen des Geschmacksmusterschutzes in der UdSSR.* (*Der Neuerer*, Ausg. B 151-154, July 1968.)

A discussion of some problems of design protection in Soviet Russia.

122. HEYDT, LUDWIG. Geschmacksmuster und Werke der angewandten Kunst. (70 *Gewerblicher Rechtsschutz und Urheberrecht* 530-537, no. 9, Sept. 1968.)

“Beiträge aus dem Gewerblichen Rechtsschutz und Urheberrecht zu Ehren von Robert Ellscheid.”

A survey of efforts in the German Federal Republic to obtain effective domestic and international protection of designs and works of applied art, with special attention to definitional problems.

123. KRÜGER-NIELAND, GERDA. Persönlichkeitsschutz Verstorbener als Schranke der Freiheit der Kunst; zum Mephisto-Urteil des I. Zivilsenats des Bundesgerichtshofs vom 20. März 1968—I ZR 44/66. (70 *Gewerblicher Rechtsschutz und Urheberrecht* 523-527, no. 9, Sept. 1968.)

“Beiträge aus dem Gewerblichen Rechtsschutz und Urheberrecht zu Ehren von Robert Ellscheid.”

A critical comment on a recent West German Supreme Court decision in the *Mephisto* case, involving the question whether the Court had placed undue limitations on freedom of expression. See also Item 125, *infra*.

124. Die Neue Verwertungsgesellschaft “BILD-KUNST”; kritische Ausserungen zum Folgerecht und zu den Möglichkeiten seiner Wahrnehmung. (12 *Film und Recht* 233-236, no. 8, Aug. 15, 1968.)

An account of a new author society established in the German Federal Republic for the purpose of collecting and distributing proceeds from the resale of a work of fine art (*droit de suite*), in which critical observations are made as to the feasibility of its administration.

125. Peter, Franz Wilhelm. Zur Dauer des allgemeinen Persönlichkeitsrechts; Betrachtungen im Anschluss an das Urteil des Bundesgerichtshofs in Sachen “MEPHISTO.” (12 *Film und Recht* 215-223, no. 8, Aug. 15, 1968.)

A critical comment on a decision of the Supreme Court of the German Federal Republic banning the reissue of the novel, *Mephisto*, written by Klaus Mann and published outside of Germany while he was an emigrant. The action was brought by the

adopted son of the deceased actor, stage manager and director, Gustaf Gründgens, on the ground of the violation of his late father's general right of personality arising out of allegedly distorted and defamatory statements about a character in the novel appearing under the name Hendrik Höfgen, but allegedly identifiable with the plaintiff's adopted father. The principal criticism is directed against the court's ruling that an individual's general right of personality survives his death.

126. ULMER, EUGEN. Der urheberrechtliche Werkbegriff und die Moderne Kunst; Rezensionabhandlung. (70 *Gewerblicher Rechtsschutz und Urheberrecht* 527-530, no. 9, Sept. 1968.)

A critical review of *Das urheberrechtlich schützbares Werk* by Max Kummer (Bern, Stämpfli, 1968) on the subject matter of copyright protection.

#### 6. Italian

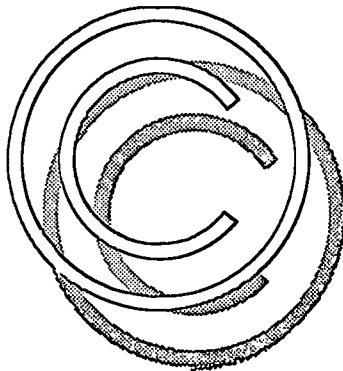
127. FABIANI, MARIO. Disconoscimento di paternità intellettuale e tutela della personalità. (39 *Il Diritto di Autore* 131-142, no. 2, Apr.-June 1968.)

An article dealing with the problem of securing disavowal of authorship under Italian laws, in a situation in which the paternity of a work is imputed to one who is not its author. The conclusion is reached that laws other than the copyright law may provide the requisite relief.

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## PART I.

## ARTICLES

## 128. THE SHAPES OF THE LAW OF IDEAS\*

By SHIRLEY M. HUFSTEDLER\*\*

When I accepted the invitation to address you, I did so upon the assumption that I could perform a role to which appellate judges have become accustomed, if not inured: to speak as a generalist to a group of specialists about statements made by people I have never heard and whose demeanor I have never observed and to render an opinion, after the fact, about how the whole matter should come out. But as judges we usually have the benefit of a record and of that amount of learning to which the lawyers think it safe to expose us.

I have not had the pleasure of hearing the distinguished experts who have participated in this program, and I have found that their records will not be filed until after my opinion is due.

So I abandon any pretense of speaking as a judge and, instead, I am going to talk to you as a lawyer, a sometime student, and a court watcher about the factors which affect the shape of the law of ideas, and I am going to suggest some trends reshaping the law, which I can see through the glass darkly.

When I use the phrase "law of ideas" I do so not in any narrow sense, but as encompassing the products of the human mind from the conception of the thought through fruition of the idea.

Let us now dissolve the close-up and move to the long shots.

We can arrange all humanity into a creativity curve, a great rainbow statistical curve. At one end of the curve will be a small group of geniuses who are intensely creative. At the opposite end of the curve will be a larger group of people who will metabolize their lives away without a single original thought. And there will be a huge bulge of people in the middle whose creativity potential ranges from the slight to the near great.

There is little reason to believe that either the social or the legal environment has very much effect on the extremes found in that curve.

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\* Speech delivered January 22, 1969, Practising Law Institute program, "Intangible Property — Rights and Liabilities," San Francisco, California.

\*\* Circuit Judge, United States Court of Appeals for the Ninth Circuit.

Why, for example, did the Athenian Golden Age produce a burst of geniuses — Aeschylus, Sophocles, Hippocrates, Euripides, Thucydides, Phidias, Pericles, Socrates, Protagoras, Plato, to name a few — in the course of a hundred years in a town smaller than Washington, D.C.? Why did Leonardo da Vinci, Raphael, Michelangelo appear simultaneously in Renaissance Italy? Why did Elizabethan England produce a panoply of literary giants? No one knows. We do know that the societies in which those brilliant showers fell had little in common with one another and their systems of law even less. It is perhaps fair to say that genius of this order is a kind of accident of nature to be classed with less benign natural phenomena, like the paths swept by comets and the upheavals in the earth's crust, and, like them, the laws of men do nothing to alter their course.

It is, of course, patent that no legal philosophy can affect the obverse of genius. No matter how assiduously we cultivate the capacities of the Kallikaks and the Jukes, the yield is barren.

Every society, consciously or not, encourages or discourages the creative potential of its people in the middle of the humanity curve. What kinds of creativity are encouraged and in whom have varied widely from time to time and from society to society. For instance, in Western Europe during the Middle Ages, creativity not dedicated to the service of the throne was devoted to the Church. An artist who had something to express which was relevant to neither was silent. How many societies have conducted talent searches among the peasantry?

What kinds of creations are stimulated and what kinds are not, who is encouraged to create and who is not, have depended and still depend upon the total components of a culture. Those components consist of the articulated rules of the society — that is laws — and the unarticulated rules of the society — the conduits of culture, the accepted forms of courting, fighting and living, together with the value systems and power systems that turn an undifferentiated mass of people into a culture.

No system of laws, no philosophy of law exists in a cultural vacuum. The evolution of the law of ideas in the United States is inexplicable without an awareness of the cultural changes which have impelled changes in the law.

The articulated premise of the founding of our Republic was that we should be a free people in a free society. One of the postulates of that freedom is that all of the creative potentials of all of our people will be cultivated and another is that the harvest of their creations shall be available to all. Perhaps it would be more accurate to describe these ideas as philosophic ideals, because from the instant of the birth of the Nation to today, not all of our people have been free, the creative

potentials of all of our people have not been cultivated, and the creations have not been available to all. For example, it is obvious that our society has made no effort whatever, until very recently, to cultivate the creative potential of black people, or American Indians, or thousands of other citizens — not excluding women of any color. Or that we have been equally enthusiastic about stimulating the creations of artists, scientists, and industrialists. It is equally obvious that the reasons for these differentiations are not the state of the law, legislatively or judicially composed, but the rules of the total culture of which the law is a pale reflection.

If we should accept, at least as a philosophical ideal, the stimulation of all creations, of all people, for distribution to all, we immediately confront pragmatic difficulties. Even the most devout adherent to the ideal must concede that not all ideas are of equal value either to the individual or to the society, that not all creators have equal potential, that the resources available either to exploit ideas or to cultivate people are not unlimited. It follows that some system of values must be adopted and some system of priorities must be developed and some compromises must be reached. We have never had a consensus about what the value system should be or how priorities should be scaled or what compromises are appropriate. But values, priorities, and compromises have nonetheless always existed. They have never been static. As they have changed so also has changed the philosophy of law.

Eighteenth century America cradled a precarious civilization. We were an agrarian people, thinly scattered in an undeveloped land, clustered into townlets, nourishing industries barely conceived. We were not a cohesive people. We were a clutch of city-states, tenuously united against common enemies. The Federal Constitution as originally adopted mirrors not only the lofty and noble philosophic ideal of a free society, but also the value systems, priorities, and compromises existing at that time. The Bill of Rights was accepted, but accepted with the built-in qualification that those rights did not extend to all Americans. Under the eighteenth century value system, slaves were not people, but chattels, and women were not figured in one way or the other.

The First Amendment guarantees that Congress shall pass no law abridging freedom of expression, which, as a corollary, might be assumed to include free dissemination of expression. Yet in Article I, section 8, at least some lock-up of freedom of dissemination of ideas is sanctioned because Congress is given 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." There you have in one sentence not only the source of our patent and copy-

right laws, but also an expression of the constitutional framers' value judgments about which creators were to be stimulated, what kind of creations were to be fostered, and how both ends were to be accomplished.

The choice of who (authors and inventors) and what (science and useful arts) was dictated by the needs of the newborn country as the draftsmen saw them. The choice of methods was primarily culturally indicated. In our society, then and now, conduct is molded by some adaptation of the pleasure-pain training principle. We have also adopted a refinement: socially desirable conduct is inculcated by using the pleasure phase of the principle, and socially undesirable conduct is theoretically altered by applying the pain or punishment principle. We have assimilated these notions so thoroughly that we spend very little of our time worrying about whether either idea works, or, if it does, how well. The draftsmen assumed, without thinking about it much one way or another, that the way to stimulate the potential authors and inventors in the middle of the creativity curve was to reward them. The reward could have been symbolic, like medals, ribbons, titles, statuettes. But no one then or now has figured out a reward which is as touching as money. And the way to get rich was to obtain exclusive possession and rights to something other people wanted, hence the limited monopolies of patents and copyrights.

It is not surprising that in the eighteenth and nineteenth centuries Congress was liberal with inventors and artists of the accepted kind and that courts read patents and copyrights with a charitable eye toward the creators, particularly if those creations had wended their way into the hands of industry which had grown both rich and powerful. Nor is it surprising that the ideas favored were those which contributed to the industrial might of the Nation. This was the era of the sanctity of the private contract, the virtue of unrestricted competition in the market place, and the supremacy of the property concept as the ultimate public good and a moral value in and of itself.

Judged by the values and priorities which were admired by the majority, or, more accurately, the majority of those who had speaking parts in formulating the policy and the law of the United States, the system was a whopping success. America changed from a puny colonial infant into a world industrial power with a steadily escalating gross national product.

But there were doubts. Doubts even sometimes expressed in the courts. A few second thoughts could not possibly have challenged the law as it existed in the nineteenth century. What happened was the twentieth century — and with it convulsive change. Two World Wars

and assorted smaller ones, one Great Depression and some minor recessions, and a revolution in technology shifted us from our stereopticons to movies, radio, and television, and from our buggies to spaceships.

The pace of the law is always more ponderous than the step of the times. But in an era of cataclysmic change even the law moves with seeming agility. During this century we have witnessed the development of the whole spectrum of entertainment law, the expansion of the law of trademarks and trade names, the unfolding of that coat of many colors known as trade secret law, the creation of constellations of federal agencies charged with regulating creators, transmitters, broadcasters, and manufacturers, and we have heard a chromatic scale of unfair competition theories.

From this banquet of legal dishes, I am going to sample only a few and those few are in the area of unfair competition. I sweep into one untidy heap all of the cases in this area anteceding *International News Service v. Associated Press*<sup>1</sup> and I dismiss them with the observations: the law was the law of the market place in an atmosphere of *laissez faire*, tempered by the Chancellor's conscience, and his conscience was not easily pricked. His conscience quivered only when the public was deceived or when the conduct of the competitors toward one another went beyond gentlemanly deception and became outright fraud.

Then the *INS* case came along stating the apothegm: "Thou shalt not reap what thou hast not sown," Brandeis dissenting. And with that case a new era of unfair competition law opened.

The sowers-and-reapers figure is a beguiling one and, if the setting were simply one wheat field among the multitude, one diligent farmer and a pirate with a scythe, the concept would be compelling. The trouble is that news services are not farmers and their crop is not wheat, even though between themselves the product was treated as if it were.

Whether or not the Court really intended to instigate a major shift in focus in the law of ideas is problematical. The explanation for the decision may be simply a visceral reaction against the bad guys. It is possible that the majority of the Court did not think very deeply about the impact on the public of the decision of the private quarrel between the news services, even though it is obvious that fencing in the product of a news service's wires to prevent poaching by its competitor prevents access to news not only by the poacher but by the general public served by the poacher.

The popularity of *INS* depends upon the degree to which one accepts or rejects the ordering of priorities implicit in the opinion. Is protection

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1. 248 U.S. 215 (1918).

of private investment of greater, lesser, or the same value as the interest of the public in the broadest dissemination of news? Notice that in the setting of *INS* the protected interest of the parties *inter sese* was not creativity in the sense of idea production. It was investment in a kind of manufacturing operation. It just happens that what was manufactured was news.

*INS* was followed by a series of decisions from lesser courts granting relief on the theory of unfair competition to a wide assortment of aggrieved competitors and noncompetitors to vindicate the private interests that *INS* protected and, again, like *INS* the public stake in the controversies was mostly ignored, Learned Hand and sometimes the Second Circuit to the contrary. I do not linger over these cases because whatever may have been their value, they have been eclipsed by *Compco*<sup>2</sup> and *Sears*.<sup>3</sup>

It was initially easy to underestimate the importance of *Compco* and *Sears*. The setting was as pedestrian as *Fumed Oak* and the precise holdings were hardly earth rattling. As is true with so many other Supreme Court decisions, however, the significant parts of the opinions were not so much in the holdings as in the choice of legal theory woven into them and the calculated omissions from the opinions.

Critical reading of Supreme Court opinions is something like critical examination of Oriental paintings: the message appears not alone from the brushwork but from the untouched space.

In *INS* the blanks contained public interest and the copyright laws. In *Compco* and *Sears*, the omission is *INS*.

In *Compco* and *Sears* the artist was Hugo Black, and his brushwork is of a very different stuff from that exhibited in *INS*. Justice Black could have written two neat, constricted opinions on the grounds that the lower courts had expanded unfair competition beyond settled territory, or more broadly, but still in narrower compass, that federal law preempted state law in the field, thereby leaving intact federal substantive unfair competition law and merely scissoring developed state law. Instead, Justice Black placed the decisions smack on the ground of federal constitutional policy, expressed in Article I, section 8. In doing so the theme coursing through his opinions, particularly in *Sears*, was the interest of the public in free access to ideas. Justice Black had no occasion in discussing the limits of protecting unpatented designs to expound about First Amendment guarantees, but we know how Justice Black feels about freedom of expression and we must read *Sears* and *Compco* with the author's value judgments clearly in mind.

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2. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

3. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

Soon after *Compco* and *Sears* were handed down, a number of lower federal and state courts were required to interpret those decisions. By and large, the lower courts exhibited little talent for Oriental art. But in the five years following *Compco-Sears*, courts with more time, if not more artistic training, have posted signs and those signs do not say "INS is alive and well in our Circuit."

The First Circuit sign is *CBS v. De Costa*.<sup>4</sup> For those of you overcome by amnesia during the last few days, here is a quick sketch. In the forties and fifties Mr. De Costa cast himself into a role of his own creation. He dressed up in a distinctive black costume, distributed "Have Gun, Will Travel" cards, dubbed himself "Paladin," and, for fun, performed in rodeos, horse shows, and parades. Some years after De Costa turned Paladin, Richard Boone hung up his smock and scalpel and appeared on CBS Television sporting the name Paladin and all the trimmings. "What an amazing coincidence," said CBS. "Too amazing," said a jury, awarding \$150,000 damages for misappropriation to Mr. De Costa. "Too bad," said the First Circuit, relieving Mr. De Costa of every sou from his CBS hope chest, relying primarily on *Compco* and *Sears*.

I point, in passing to the Ninth Circuit signs posted in *Cable Vision, Inc. v. KUTV, Inc.*<sup>5</sup> and *Smith v. Chanel, Inc.*<sup>6</sup> with the comment that the Ninth Circuit signs do not indicate that the direction is different from that of the First Circuit.

Now I am going to move briefly into chancier territory: Where is the law of ideas heading?

I think the trend is to stimulate the free circulation of ideas and thus to constrict the protection of private interests, particularly when the conflicts between private and public interest occur in a First Amendment atmosphere. This means a growing strictness in interpretation of copyright and patent law and a shriveling to pre-INS dimensions of unfair competition concepts in cases affected with a competing public interest. At the same time I see growth in the protection of the individual artist as a creative personality, that is to say, a growth in the law which started out as a right of privacy and has since been refined into a host of protectible personality components, including elements of personality which have commercial exploitability. In short, I think whatever may be left of the philosophy of INS may be poured into protection of the individual artist, not the corporate purveyor of the artist's products, except to the extent necessary to protect the artist himself. I also foresee, albeit dimly, a trend toward more favorable treatment of

4. 377 F.2d 314 (1st Cir. 1967).

5. 335 F.2d 348 (9th Cir. 1964).

6. (No. 21522, Oct. 21, 1968).

artists whose product is copyrightable as compared with inventors of things patentable.

These broadly stated forecasts are not based alone upon *Sears* and *Compco*, or upon some guess about the future composition of the United States Supreme Court. Rather they are based on changes in the climate of our culture. From that complicated tapestry, I select for example but a few threads.

We are robbed with affluence, despite the holes in some of our pockets. Our young people are rebelling, passively and violently, to a system of priorities in which property and investment values are scaled above their "people values." Activist youth have dealt us the cruelest cut by telling us, not just that our values are wrong, but that they are irrelevant.

The value system of our youth has already had an impact on our social institutions. The young are getting older every day and so are we. These youngsters are already moving into the first niches of policy making, and within a decade they will be sitting in legislatures and warming the benches of many of our courts.

Unless the social consciousness of these young people atrophies quickly, or their values shift in the harsh realities of competition, or all of us are annihilated by our violence or that of others beyond our shores, the new philosophic ideal will be an open society and a new freedom.

Of those people in the middle of the creativity curve, who will then be the encouraged creators? I suggest that it will be those whose incipient talents are most admired. If the present youthful ideas prevail, those people will be the individual artists and not the industrialists; and of those artists, the performing artists, musicians, poets, writers, painters, sculptors and their kind will be favored more than inventors of all manner of things utilitarian.

That is what I say I see, but whom can you trust over 30?

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129. CATV — THE *FORTNIGHTLY* POSTLUDE

By GEORGE D. CARY\*

It seems reasonable to assume that if we are speaking about a postlude to *Fortnightly*<sup>1</sup> there must have been a prelude, and so I ask that those of you who are familiar with the prelude will bear with me while I refer briefly of some of the events leading up to the *Fortnightly* case in order that we may properly assess the postlude.

When the House of Representatives passed the copyright bill in April of 1967, which did not include any CATV provision, Judge Herlands had already upheld in the *Fortnightly* case in the District Court in New York, the right of the copyright proprietor to claim that the CATV retransmission of these copyrighted programs was a "public performance for profit" within the meaning of the copyright law. About one month after the House passed the bill, the Second Circuit Court in New York unanimously upheld Judge Herland's decision. I think it is also helpful to be reminded that the Senate had been holding hearings only on the CATV issue in March and April of 1967, which also was at a time after Judge Herland's original decision but before the Second Circuit opinion. So in the summer of 1967 after the Second Circuit had upheld Judge Herland's decision, one can visualize that a large cloud must have hung over the CATV industry as a result of these two very strongly worded and well considered opinions, especially with respect to the prospect of huge damage provisions for all past infringements. Thus, it is only natural to find that the CATV industry and the copyright proprietors had entered into some negotiations of a rather private nature, to see if there was any way of resolving in a businesslike way the great difficulties created as a result of these decisions.

These negotiations continued for quite some time and in October of 1967 the NCTA, the trade association of the CATV industry, held a series of regional meetings around the country to which Senator McClellan was invited. He regretted that he could not make the trips but he did prepare a statement which he authorized to be read at each of these meetings and I would like to briefly quote a few excerpts from that simply to give you a flavor of Senator McClellan's thinking with respect to the CATV problem and the copyright issue.

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\* Deputy Register of Copyrights. Based on remarks made to the Copyright Luncheon Circle in New York City on January 31, 1969.

1. *United Artists Television, Inc. v. Fortnightly Corp.*, 392 U.S. 390 (1968). For lower courts' decisions see same case at 255 F.Supp. 177 (S.D.N.Y. 1966) and 377 F.2d 872 (2d Cir. 1967).

It is apparent that CATV systems will be required to pay copyright fees. In my opinion this is just. Such payments, however, must be made without placing an excessive administrative burden on individual operators . . . Although I believe your industry should pay copyright fees, I will oppose any effort to use the copyright statute for the purpose of obstructing the service which you render to millions of our citizens.

If the parties are unable to reach accommodations and agree on a joint recommendation to the Congress, the final result may be legislation not in the best interest of anyone. I earnestly recommend that you exert every effort to reach understandings with both the copyright interests and the broadcasters.<sup>2</sup>

To me the interesting points that he makes in this statement are, first, that he believes that copyright fees are in order. Secondly, he is convinced that these fees must not be excessive. And finally, he strongly hints that unless the parties agree themselves on a provision, they may well wind up with a requirement in the law which neither of them will like.

The negotiations to which I have referred continued on through the fall of 1967, but finally came to a standstill in December of that year when the Supreme Court granted certiorari in the *Fortnightly* case, much to the surprise of everyone, including the CATV lawyers.

Because of this dead center which the whole matter seemed to have reached, the Register of Copyrights attempted early in the following year<sup>3</sup> to persuade Senator McClellan to press for what he called a "bare-bones" or "skeleton" bill which would contain most of the noncontroversial issues that had been agreed upon, but the Senator in a letter to the Register declined this invitation.<sup>4</sup> He did however promise to recommend to his Subcommittee that at the very first of the next session it should continue its efforts to obtain copyright legislation. It is within this context that the Supreme Court in June of 1968 handed down two really momentous decisions. In one week it decided in the *Southwestern*<sup>5</sup> case that the FCC possessed appropriate jurisdiction to regulate CATV. The following week the Court handed down the *Fortnightly*<sup>6</sup> decision in

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2. Statement of Sen. John L. McClellan, Chairman of the Senate Subcommittee on Patents, Trademarks and Copyrights to the Regional Meetings of the National Community Television Association, dated October 6, 1967. (This statement appears in the files of the Senate Subcommittee.)

3. Letter dated March 29, 1968 addressed to Senator McClellan.

4. Letter dated April 17, 1968, addressed to the Register of Copyrights.

5. *U.S. v. Southwestern Cable Co.*, 392 U.S. 157 (1968).

6. *Supra*, note 1.

which it said in effect that the retransmission by CATV of the signals of the broadcast stations was not a "public performance for profit," within the meaning of the copyright law. I doubt if many lawyers would ever have predicted that the Court would have come to the conclusion which it did. At any rate, I don't intend to dwell on the merits or demerits of this decision since that is really not the purpose of this paper.

This concludes the prelude to the *Fortnightly* situation, and the question now is what is the postlude? It is fair to state that the *Fortnightly* case threw everybody into a tailspin, and some weeks or months were spent trying to study and analyze what that case might portend for the future. However, in August of 1968 Tom Brennan, the Counsel of the Senate Subcommittee handling the copyright bill, decided to move in the direction of resolving the problem, so he asked all of the parties involved in this controversy to submit to him by October 1 their comments on the problem as well as statutory language. This time limit was later extended to November 1st.

Since the previously mentioned negotiations between the CATV representatives and the copyright proprietors had been conducted without the glaring eye of publicity being focused upon them, it wasn't really until the letters were received by the McClellan Committee on November 1,<sup>7</sup> that one was able to get some inkling of what really took place in these negotiations. In the letter of Mr. Louis Nizer, who represented the motion picture companies at the bargaining session, one finds that he made essentially the following points:

1. There was general agreement from the outset that copyright proprietors would be protected where the film programs were imported into "adequately served" markets. However, the parties could not agree on the definition of an "adequately served" market.
2. There was also general agreement that the CATV system would be entitled to a compulsory license where they were operating in markets other than those "adequately served."
3. On the question which Mr. Nizer termed "the touchstone of all copyright," namely the problem of exclusivity, he said that the parties failed to reach any agreement.

Mr. Nizer then went on to indicate in a general way the type of permission and rate structures that they had in mind and had talked over but all of which of course came to no avail.

When one reads the letter which was submitted by the President of NCTA, I think the first thing that strikes you is that it sounds as though

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7. These letters are on file in the office of the Senate Subcommittee.

no progress was made at all during these negotiations, because the proposal he makes generally harks back to a proposal he had previously made. However, it is my understanding that the parties during these negotiations actually came considerably closer to agreement than Mr. Ford's letter would indicate. In general, what Mr. Ford stated to be the position of NCTA was that first of all they opposed any ban on CATV originations. They further favored an across-the-board compulsory license of all broadcast signals distributed, which would take the form of a statutory fee, based on a percentage of gross receipts which could be deposited in a single place. His final point was that CATV would of course honor the blackouts of all of the professional sports contests.

Meanwhile, back at the ranch, another development was taking place during the summer and fall of 1968, which, while it may not have any direct bearing on the issue, I think is of interest and should at least be briefly mentioned. This relates to the President's Task Force on Telecommunications which had been appointed earlier and which of course was authorized to consider many different ramifications of the telecommunications problems. However, copyright appears to have become involved in the deliberations of this Task Force according to various trade press reports.<sup>8</sup> According to these, the staff of the Task Force seemed to favor some sort of copyright liability for CATV. As a matter of fact, the most recent report that I saw in this connection said in effect that the Task Force staff considered that the importation of distant signals, and the matter of program origination by CATV should not be permitted until Congress amends the copyright bill to prescribe full copyright liability to CATV.<sup>9</sup> In mid-December, the *New York Times* carried a story that this report of the President's Task Force had been sent to the White House but was not being made public because several of the members were in the process of writing dissenting opinions.<sup>10</sup> The *New York Times*, however, ran quite a lengthy summary of the general areas which the report covered, and copyright was not mentioned therein, so I have no personal knowledge that copyright was actually dealt with by the Task Force. However, for what it may be worth, I have heard by the grapevine that the report recommended in effect that copyright was an important matter but that this was something that should be specifically resolved by the Congress.

Now, whatever may be the result of the effect of the President's Task Force recommendations — and of course this may well be of no real significance, because it was submitted to a President who was just

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8. *Broadcasting*, September 9, 1968.

9. *Television Digest*, September 16, 1968.

10. *N.Y. Times*, December 10, 1968.

about to go out of office, and one cannot say for certain whether a new Administration, especially of the opposite party, would give effect to this recommendation or would do anything at all about it — one cannot deny that a document issued by the FCC in the middle of December, on December 13, 1968,<sup>11</sup> to be specific, is a very hot potato and a current subject of considerable controversy today. I refer of course to the Notice of Inquiry in which the Commission stated that it was going to modify the CATV rules which had been operative under the Second Report and Order for some two years or more.

While the FCC report, of course, does not affect copyright *per se*, it is all part of the same ball of wax and therefore I think a few minutes should be spent upon the general substance of that report. First of all, the Commission suggests that program origination promises to foster beneficial progress in the communication field, primarily by releasing valuable spectrum space so that on balance it believes that program origination by CATV should be encouraged. As a matter of fact, it indicated permission to the carriage of broadcast signals would be conditioned on the requirement that local program origination should be included in the CATV operations. Secondly, the Commission also stated its intention that the present CATV services which are not in violation of the existing regulations are to be “grandfathered,” that is, the proposed new rules will apply only to CATV systems commenced after December 20, 1968. Although as I have indicated; the Commission stated its intention to promote origination, it also stated very specifically that this was going to be permitted on only one single channel — that is, one channel in addition to the channel on which time, weather or other similar type of automatic information has been used over some period of time.

The importation of distant signals is at the heart of the Commission's new proposition, and since this is where the copyright problem really gets into the act, I think we ought to spend a few minutes on just what the Commission had in mind with respect to this matter. First of all, the Commission took the position that the importation of distant signals into a major market could achieve a very highly significant penetration of the major market — up to 50% it said — and this fact the Commission considered to be a form of unfair competition. Thus when a CATV system wishes to import distant signals, the Commission proposes to require that it obtain permission from the stations whose signals it wishes to import. This requirement, according to the Commission, is parallel with Section 325(a) of the Communications Act, which

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11. Docket No. 18397.

which requires broadcast stations to get permission when they use another broadcast station's signals. In requiring this permission, the Commission made it clear that it was aware of the developments in the Congress with respect to the copyright problems. However, the Commission said in effect that the proposal to require the CATV operator to obtain the permission of the imported station was something that stemmed from its responsibilities under the Communications Act, although it admitted that this necessarily embodied copyright implications. It went on to state that if the Congress did enact copyright legislation, it would naturally be governed by it, and in order to give the Congress time to do this, it would wait an appropriate period of time, before it put its rules into effect. Even if it did put its rules into effect and then the Congress subsequently enacted a copyright statute, it could always amend its rules.

This somewhat circuitous language leads one to the conclusion that whatever an "appropriate" time is, the Commission will wait, and if the Congress does nothing then the new rules go into effect subject to modification at a later date. All of which is to say that the Commission believes it has a responsibility under the Communications Act to do something about what it considers an unfair competition problem and it intends to move ahead. As a matter of fact, the first hearings were held early in February 1969, at which many divergent views were expressed.

When the Commission requires the CATV system to get the permission of the imported stations before it can bring these distant signals into a major market, it seems to me that this is a device for indirectly dealing with the copyright question, because as most everybody knows, radio stations do not generally own the proprietary rights in the majority of the material which they broadcast. So, in effect this means that the CATV owner must deal directly with the copyright proprietor. This conclusion is made crystal clear in the clarification of this order which the Commission issued on the 24th day of January 1969,<sup>12</sup> in which it said that a quit-claim type of waiver from stations was not sufficient. The CATV system is going to have to get permission from the station on a program-by-program basis to import these distant signals, which obviously means they have got to get a clearance on the use of the copyright material.

Without attempting to go into the rather complex regulations of the FCC, let me just briefly indicate to you how it proposes to operate. First of all, the Commission proposes to "grandfather" all the present operations so that in effect these new rules are going to apply only to

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12. 34 Fed. Register 1177 (January 24, 1969).

a new CATV system which comes into existence after December 20, 1968. No CATV system which comes into existence after that date may operate in the 100 largest markets within 35 miles of the center city without obtaining permission from the broadcaster of the distant signals. In the earlier regulations under the Second Report and Order, the Commission had adopted the Grade A and B contour principle as a means of identifying the area. Here it flatly came out with a mileage basis which it claims is easier to administer, although undoubtedly some people would disagree with that, especially with the mileage criteria. What the Commission is really bothered about here is the effect that CATV penetration — which I have indicated might be on the order of 50% — will have on the UHF development which is one of the primary considerations of the Commission under the Communications Act.

In those localities other than the top 100, that is from 101 on down, the CATV system which operated within 35 miles of a broadcast station would be permitted, without permission, to transmit only the signals of the closest stations of the three major networks, one independent station and one educational broadcaster. Carriage of other distant signals would require permission. If the CATV system is outside of this limit, it could transmit all the signals it could handle if it picked up those closest to it. In other words, the FCC doesn't want a station in Kentucky to import New York City signals. The idea is that you use the signals that are available in the community or the state where you are located, and no leapfrogging is permitted. I might add at this point that the Commission contemplates the "grandfathering" of CATV services in the smaller markets outside of the specified zones, the same as it does in the case of the major markets.

One interesting reaction to the FCC order that struck me as far as the CATV industry is concerned was that there seemed to be some difference of opinion as to the effect of this order within the CATV industry itself. Mr. Frederick Ford of the NCTA,<sup>13</sup> and Mr. Irving Kahn of Teleprompter,<sup>14</sup> were entirely negative about these regulations. On the other hand, Mr. William Jennings,<sup>15</sup> who is President and Chairman of the H & B American Corporation, which is the nation's largest owner of CATV systems, is reported to have said that he believed the new rules would be beneficial to his company. Mr. Albert Stern, of the Television Communications Corp., while he considered the ruling as a "subtle plea" to Congress for guidelines, did add that he saw no signs in the FCC proposals that their growth or expansion would

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13. Washington Evening Star, December 13, 1968.

14. *Ibid.*

15. *Ibid.*

be substantially affected.<sup>16</sup> Perhaps the most cogent comment about the rules came from the well known New York *Times* columnist, Jack Gould, who prophesied,

If anyone believes the future of electronics is a path to serenity, he can be assured that the coming days hold only legislative, regulatory, and technological bedlam, intensified by the battle of vested interests and by laymen and scientists trying to understand what each is saying to the other.<sup>17</sup>

Mr. Brennan, acting at the behest of Senator McClellan, called a meeting which convened on January 8, 1969, at which most of the interested parties on all sides of the question were in attendance. The participants were asked to comment upon three draft proposals that had been prepared by the Copyright Office at the request of Senator McClellan and mailed to them prior to the meeting.<sup>18</sup> I think it is safe to say that most of the answers and comments were predictable. No one really changed their minds, at least not in public. However, to the careful observer and one who listened for the key words, it seemed to me that there was in some of the statements an indication of what both parties, that is, the opposite sides, could accept without raising too much objection to it. Now, it should be apparent that in delicate negotiations like this it's quite difficult for the opposing parties to say "we will accept this" or "we will accept that." After all, they represent their constituents and they cannot in effect give away their major demands because the other side would obviously take advantage of such action. However, if a solution is imposed upon them by Congress which meets in a reasonable manner what each side feels it requires, one could imagine that this could be a way out of the impasse. So, Mr. Brennan intends to have separate private meetings with a small group of these people in the very near future to try to see if he can get some further idea of what they could accept. He still hopes for some agreement. As a matter of fact, Senator McClellan, when he reintroduced the revision bill on January 22, 1969, said on the floor of the Senate that he had already stated "that the Subcommittee will undertake to report a copyright revision bill at the earliest date in this session"<sup>19</sup> of the Congress. The hint there seems to be pretty plain for all to see.

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16. N.Y. Times, December 14, 1968.

17. N.Y. Times, December 16, 1968.

18. See 16 BULL. CR. SOC. 109-120 (Dec. 1968).

19. Congressional Record, January 22, 1969, p. S-664.



The postlude to *Fortnightly* cannot be concluded without a brief reference to certain correspondence between Senator McClellan and Chairman Hyde of the Federal Communications Commission. On January 30, 1968,<sup>20</sup> the Senator wrote the Chairman indicating his view that there must be a coordinated approach to the CATV problem by the Congress, the FCC and other appropriate government agencies, and stating that “. . . it is obvious that in reaching a judgment concerning one of those issues, consideration must also be given to what action has been taken, or may be taken in the future, concerning the other aspect.” He then went on in the following vein:

In order for the Subcommittee to proceed with the drafting of a copyright CATV provision and to report a copyright revision bill at the earliest feasible date in this session of Congress, it will be necessary for the Subcommittee to receive a statement from the Commission clarifying its anticipated future course of action with respect to the regulation of CATV systems if legislation is enacted providing for the payment of reasonable copyright fees by CATV systems, and including other necessary and appropriate provisions to eliminate those conditions of CATV operations which the Commission regards as “unfair competition”.

The Senator concluded his letter by clearly indicating that if no such clarification was received in a reasonable period of time, “. . . it would appear that the Subcommittee would have no other alternative than to schedule a public hearing to review those aspects of the Commission action which involve matters coming within the jurisdiction of this Subcommittee.”

Chairman Hyde, for the Commission, made a prompt reply to the Senator's letter on February 17, 1969.<sup>21</sup> He pointed out that with respect to the smaller markets, or the “inadequately served market” as it is known in copyright terms, it was not contemplated that the Commission would make any basic changes in the carriage and same-day non-duplication rules, in the event that copyright legislation of the type proposed by the Senator were enacted. With respect to the major markets, or the “adequately served” areas in copyright terms, the Commissioner clearly indicated that the Commission would conform its policies to those of the copyright revision bill “provided of course that the revision represented Congressional action taking into account also the communications aspect of the CATV problem.” By way of emphasis of this latter

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20. A copy of this letter is on file in the office of the Senate Subcommittee.

21. *Ibid.*

proviso, the Commissioner added that “. . . we strongly hope that Congress will enact a law which will be a meld of copyright and communication policies.” He concluded by indicating that it was not possible to state at this time what the Commission would do in the future with respect to such matters as program origination, diversification, multiple ownership, common carrier operations, technical standards, the reporting requirement and certain other general areas of inquiry, until comments and oral presentations had been concluded.

The foregoing exchange speaks pretty plainly for itself and there seems to be no occasion to gild the lily.

The question remains, Where do we go from here? Mr. Brennan has indicated that if no early agreement is reached, the Committee will begin to mark up the bill in the near future, probably around the Easter recess, which is early April. So, should no compromise be reached by that time, one gets the definite impression in Washington that Senator McClellan is going to have a CATV provision in the reported bill, — a provision which he hopes can be acceptable to all parties, even though all parties might not like all aspects of the provision. Then hopefully the bill will move forward from there, pass the Senate and get over to the House and become law at this session of Congress. However, should this be too optimistic an assessment, and no action is taken this year, I venture my own personal opinion that the copyright revision bill as we have been working on it for so many years will probably be dead.

The revision package cannot continue to hold together indefinitely, and I do not believe that it will withstand the stresses and strains of technological and industrial change more than two years at the most. If the process of disintegration does take hold, I do not see how the Copyright Office or anyone else can undertake any all-out effort to reverse it. I am not alone in the conviction that it is make or break for general revision in the 91st Congress, and this means that we had all better change our focus from the trees to the forest.

Thus, if no results come at this session of the Congress, I suppose one could suggest that about all that may be expected in the future as far as the Copyright Office is concerned, is some sort of a “barebones” or “skeleton” bill which might be attempted on a piecemeal basis. Now, I don't like to leave you with such dire predictions, but I would be derelict if I omitted to mention them as possibilities. I am still hopeful that a bill can be produced which can meet the greater part of objections of the parties involved, and I hope sincerely that it will become law at the present session of Congress.

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## PART II.

LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS

## 1. United States of America and Territories

## 130. U.S. CONGRESS. HOUSE.

H.R. 3089. 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 13, 1969, and referred to the Committee on the Judiciary. 27 p. (91st Cong., 1st Sess.)

Identical to H.R. 2886, 90th Cong., 1st Sess. (1967), also introduced by Mr. Ford. See 14 BULL. CR. SOC. 315, Item 209 (1967). See also Item 131, *infra*.

## 131. U.S. CONGRESS. HOUSE.

H.R. 4209. 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. St. Onge, January 23, 1969, and referred to the Committee on the Judiciary. 27 p. (91st Cong., 1st Sess.)

Identical with H.R. 6124, 90th Cong., 1st Sess. (1967), also introduced by Mr. St. Onge. See 14 BULL. CR. SOC. 315, Item 211 (1967). See also Item 130, *supra*.

## 132. U.S. CONGRESS. HOUSE.

H. Con. Res. 87. Concurrent resolution expressing the sense of Congress concerning certain proposed new CATV rules. Introduced by Mr. Barrett (for himself, Mr. Nix, Mr. Byrne of Pennsylvania, Mr. Eilberg, and Mr. Green of Pennsylvania), January 15, 1969, and referred to the Committee on Interstate and Foreign Commerce. 1 p. (91st Cong., 1st Sess.)

Proposes the rescission of the recent F.C.C. notice of proposed rulemaking relating to CATV until such time as full and adequate hearings have been held by appropriate congressional committees and the Commission itself, "and until Congress shall have had an

adequate opportunity to consider possible legislation relating to the regulation and operation of CATV.”

133. U.S. CONGRESS. HOUSE.

H. Res. 84. Resolution to direct the Committee on Interstate and Foreign Commerce to conduct an investigation and study of Federal regulation of community antenna television systems. Introduced by Mr. Van Deelin, January 3, 1969, and referred to the Committee on Rules. 2 p. (91st Cong., 1st Sess.)

Under the terms of the resolution special emphasis is placed on the carriage and origination rules “dealt with in the notice of proposed rulemaking issued by the Federal Communications Commission on December 12, 1968.”

134. U.S. CONGRESS. SENATE.

S. 543. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. McClellan, January 22 (legislative day, January 10), 1969, and referred to the Committee on the Judiciary. 57 p. (91st Cong., 1st Sess.)

The new bill is similar to the bill which was under consideration by the Subcommittee and was the subject of extensive hearings in the 90th Congress. A companion bill was passed, with certain amendments, by the House of Representatives in April 1967.

Made a part of S. 543, as Title II thereof, is a provision to establish in the Library of Congress a National Commission on New Technological Uses of Copyrighted Works. This measure, in the form of a separate bill, was passed by the Senate in October 1967 but was not acted upon by the House.

Senator McClellan stated, in his remarks made at the time of the introduction of the bill, 115 *Cong. Rec.* S664 (daily ed. Jan. 22, 1969), that the same text as the previous bill was introduced in order for the Subcommittee to resume its consideration at the point where it was suspended by the adjournment of the 90th Congress. He noted that the public hearings on this legislation were concluded during the 90th Congress and that any comments or proposed amendments not previously communicated should be submitted at the earliest possible time. In addition Senator McClellan reaffirmed his earlier statement that the Subcommittee would undertake to report a copyright revision bill at the earliest feasible date in this session of the 91st Congress.

135. U.S. *Copyright Office.*

Copyright law revision: Index of hearings before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate. Combined subject and name index. Washington, U.S. Govt. Print. Off., 1968. 151 p.

This index was prepared by Mrs. Harriet L. Oler, an attorney on the staff of the Copyright Office. Mrs. Oler was assisted in the final editing by Mrs. Sandra Turner and Mrs. Susie Nimmons, also of the Copyright Office staff.

Contents. — 89th Cong., 1st Sess., pursuant to S. Res. 48 on S. 1006 (Aug. 18-20, 1965). — 89th Cong., 2d Sess., pursuant to S. Res. 201 on S. 1006 (Aug. 2-25, 1966). — 90th Cong., 1st Sess., pursuant to S. Res. 37 on S. 597 (Mar. 15-Apr. 28, 1967).

## 2. Foreign Nations

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

Design Copyright Act 1968. (Of October 25, 1968). An Act to amend the law relating to the copyright of certain manufactured articles, and for connected purposes. (4 *Copyright* 234, no. 11, Nov. 1968.)

An article on this new amendatory law appears in the same issue of *Copyright*. See Item 172, *infra*.

137. SIERRA LEONE. *Laws, statutes, etc.*

Loi sur le droit d'auteur du 5 mai 1965. (*Revue Internationale du Droit d'Auteur* 264-348, no. 58, Oct. 1968.)

French version of the copyright law of Sierra Leone.

138. YUGOSLAVIA. *Laws, statutes, etc.*

Copyright law. (Of July 20, 1968). (4 *Copyright* 242-252, no. 12, Dec. 1968.)

An article on this new law, which was translated into English by BIRPI, appears in the same issue of *Copyright*. See Item 170, *infra*.

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## PART III.

**CONVENTIONS, TREATIES AND PROCLAMATIONS**

139. UNESCO. Committee of Experts on the Photographic Reproduction of Protected Works. Paris, 1-3, July, 1968. General Report. (II *Copyright Bulletin* 4-14 No. 3, 1968.)

With summary of discussions, working documents, recommendations and list of participants. Professor Melville B. Nimmer represented the United States at the meeting.

140. UNESCO. Comparative Study on Copyright: Translators' Rights. (II *Copyright Bulletin* 15-41 No. 3, 1968.)

The study defines general principles as regards protection of translators' rights; conditions governing protection; nature of protection; restrictions on protection and traditional measures. Included is a table of the pertinent laws now existing in various countries and a list of countries with their basic copyright laws.

A report on the meeting of a committee of experts convened in Paris in 1968 to study this problem will be published in a later issue of this BULLETIN.

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## PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## 1. Federal Court Decisions

141. *Scherr v. Universal Match Corporation*, 160 U.S.P.Q. 216 (S.D. N.Y., Sept. 18, 1967) (McGohey, J.)

Defendants' motion for summary judgment in action for copyright infringement. With the approval of the Army, defendant Universal produced and distributed matchbooks bearing a picture of a statue depicting a charging infantryman, which statue, entitled "The Ultimate Weapon", is prominently displayed at a Fort Dix, N.J. site. Plaintiffs, two ex-servicemen, were primarily responsible for the design and construction of the work during their period of service. The United States intervened.

*Held*, motion granted.

The court held that, although the statue was not a "publication" of the United States Government within the meaning of 17 U.S.C. § 8 and hence was susceptible of copyright, a divestitive publication (by exhibition) with improperly placed notice had occurred, or, alternatively, copyright inured to the Government under the "work made for hire" rule.

A. The court held that the Act's prohibition of copyright to "publication[s] of the United States Government" does not encompass a statue. Although noting that the precise scope of the quoted phrase "has long been a source of conflict and concern", the court found that "the issue presented by this motion does not fall within the ambit of this confusion since in all discussions of the problem there seems to be unanimous, albeit tacit, agreement that [the phrase] refers to printed works, [a conclusion which is] given added weight by the correspondence of language used to circumscribe the prohibitions found in the Copyright Act and in the Printing Law [and] the fundamental purpose underlying [the prohibition] which is based on 'the necessity of wide public dissemination of the contents of materials produced by and relating to issues and problems of national interest. . . .'"

B. The court held that the copyright notice affixed, unbeknownst to the Army, upon the statue in such position as to render it inaccessible to normal view was fatally placed although proper in form. Although the Act is silent as to the proper place of notice on a work of art, the court based its holding on the fact that "the unquestioned purpose of the notice requirement is 'to apprise anyone seeking to copy the article of the existence of the copyright. . . .'"

The finding that the statue had been published was derived from the fact that it "has at all times been, and is today, on view at . . . a site open to the public [with no] restriction, posted or otherwise, on the copying or photographing" thereof.

C. The court further held that, even if the notice were valid, copyright to the statue resided in the Government by virtue of 17 U.S.C. § 26. After reviewing the activities of plaintiffs during their period of service and the supervision of their work on the statue, and upon considering the relevance and effect of various Army duty classification regulations, the court found the statue to have been produced by plaintiffs within the scope of their "employment". In response to plaintiffs' contention that they spent their own time and money in creating the work, the court observed that there was a great disparity between the magnitude of funds expended by the Army on the project and the plaintiffs' minor out-of-pocket expenses and, further, that plaintiffs failed to show that they had requested and were denied reimbursement. ["Under the plaintiffs' interpretation", said the court, "any employee could circumvent the 'works for hire' rule by expending a comparatively small amount of his own time and/or money on a project arising out of and performed within the scope of his employment."]

142. *The American Fabrics Co. v. Lace Art, Inc.*, 291 F. Supp. 589, 160 U.S.P.Q. 366 (S.D.N.Y., Sept. 26, 1968) (Motley, J.)

Motion for preliminary injunction in action for alleged infringement of copyright in plaintiff's floral patterned lace design.

*Held*, motion denied.

The court found that the presence of unresolved factual issues regarding plaintiff's compliance with the notice requirements of the Copyright Act, a lack of demonstrated irreparable harm, and plaintiff's delays in instituting suit and bringing on the motion were each independently adequate reasons for denying preliminary relief.

A. Plaintiff sought to excuse the "insufficiency" (absence?) of copyright notice on its lace by reason of defendant's receipt of a notice of



infringement. The court held, however, that an "insufficient" copyright notice places a work in the public domain and, if this occurs, "the copyright is forfeited and cannot be revived by notice of its former existence".

Plaintiff also unsuccessfully placed reliance on the decision of the Second Circuit in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 124 U.S.P.Q. 154 (1960). The court said:

[Plaintiff] claims notice may not be placed upon its lace without impairment [of its market value]. Plaintiff [also] says his lace has no selvage . . . upon which to place notice. He does state generally in one affidavit that notice "is placed on the goods sold by the plaintiff", but in another affidavit it appears that such notice consisted merely of labels upon the *samples*.

One significant difference between this case and Peter Pan Fabrics appears. Some of the lace of plaintiff is sold directly to department stores for resale by the yard to home sewers. Such lace apparently has no copyright notices, although it would appear that they might be affixed to the board around which the lace is wrapped or by adhesive labels directly on the lace. It must be noted that the Peter Pan Fabrics plaintiff at least made an initial effort to affix notice, and notice affixed to our plaintiff's bolts would not disappear into dresses as in Peter Pan Fabrics, at least insofar as the bolts of lace go directly to department stores. This court might well hold plaintiff's notice . . . insufficient as a matter of law, but such decision need not be made on this motion. . . . Further testimony . . . is needed as to the sufficiency of plaintiff's notice and any impairment of market value of the lace occasioned by alternative methods of notice, such as adhesive labels."

B. Although conceding that a detailed showing of irreparable harm is unnecessary to obtain preliminary relief in a copyright infringement action once a prima facie case is established, the court found that plaintiff had failed to make "even a threshold showing" of such injury. Monetary damages, said the court, would prove an adequate remedy and although plaintiff's moving affidavit claimed a need for immediate relief because of the short selling life of its design, the court observed that plaintiff had itself concurred in multiple delays of the motion and thus "it might appear on plaintiff's own affidavit that the crucial period for protection has passed."

C. Plaintiff's inadequately explained delay of seven months from the time it first notified defendant of the alleged infringement to the filing of the complaint, together with the above-mentioned delays in

bringing on the motion, led the court to find that "drastic provisional relief is not warranted at this late date".

143. *Loomskill Inc. v. Rubin Levine & Co., Inc.*, 159 U.S.P.Q. 676 (S.D. N.Y., Nov. 7, 1968) (MacMahon, J.)

Motion to dismiss the complaint in action for copyright infringement and unfair competition. Plaintiff had deposited five copies of its work with the Copyright Office and apparently complied with the notice requirements of the Copyright Act but had not yet received a certificate of registration.

*Held*, motion granted.

I. *Copyright*. Citing 17 U.S.C. §13, the court said:

In order to complete registration, it is necessary for the plaintiff to obtain a registration certificate from the copyright office . . . Plaintiff has not obtained a registration certificate and therefor has not registered its copyright in the manner required by statute for maintenance of this action.

II. *Unfair Competition*. The court held that "pendant jurisdiction over a claim under state law requiring a plenary trial should not be exercised when a federal claim is dismissed prior to trial."

144. *Marcal Paper Mills, Inc. v. Scott Paper Co.*, 160 U.S.P.Q. 147 (D.N.J. August 7, 1968) (Coolahan, J.)

Motion to dismiss the complaint in action for copyright and trademark infringement and unfair competition. Plaintiff alleged that (i) defendant's use of a certain label on its facial tissue products infringed the copyright in two of plaintiff's registered labels, (ii) defendant's use of the word "Camellia" on such products infringed plaintiff's registered trademark for that term, (iii) defendant's use of a "flore" design similar to plaintiff's constituted common law trademark infringement, unfair competition and a "false designation of origin" under the Lanham Act, and (iv) defendant's use of a particular trade dress similar to plaintiff's constituted unfair competition.

*Held*, motion granted.

I. *Copyright*. The court prefaced its holding on the copyright count by reference to *Arnstein v. Porter*, 154 F.2d 464, 68 U.S.P.Q. 288 (2d. Cir. 1946), where, as "stated by Judge Frank, the two basic facts

that a plaintiff must establish are, first copying and second, that the copying went so far as to constitute 'improper appropriation'."

The court found that plaintiff had failed to establish either element, stating:

There has been no evidence of copying. Firstly, plaintiff has presented no proof of defendant's access to plaintiff's products. If it be maintained, and such a position would not be ludicrous, that the court should take judicial notice of the fact that Scott executives are at least somewhat aware of what the competition is doing, plaintiff's proofs also fail on the second, similarity, question. The court's examination of the plaintiff's copyrighted labels and of the defendant's allegedly infringing facial tissue label<sup>4</sup> convinces it that there is no similarity whatsoever between the two designs. Although certain *elements* of the two products, such as the florets contained on both and the use of an oval design on both, bear some similarity, the two labels, *viewed as a whole* (and this is the only way they should be viewed in the case of this type of copyright claim),<sup>5</sup> bear no similarity whatsoever. . . .

Furthermore, even were the court impressed with the fact that defendant had consciously copied the plaintiff's label, it is entirely convinced that there has been no "improper appropriation" because no ordinary observer would, upon an examination of the plaintiff's and defendant's labels, consider that defendant's label was taken from the copyrighted sources.

II. *Unfair Competition*. With regard to plaintiff's assertion that defendant's use of the floret design on its toilet tissue, and use on its facial tissue of a particular trade dress, constituted unfair competition, the court stated that in its view *Sears* and *Compco* had not "entirely done away with the common law of unfair competition" and had certainly not invalidated state law prohibiting actions "such as to constitute a 'palming off' of plaintiff's [sic] products" despite its effects on decisions "requiring a showing of only 'a likelihood of confusion'".

The court, however, found that plaintiff's design and trade dress had not acquired secondary meaning and, further, that plaintiff had failed to establish a likelihood of confusion.

III. *Trademark Infringement*. The court held that plaintiff had failed to establish a likelihood of confusion resulting from plaintiff's prominent use of its registered "Camellia" trademark and defendant's use of that term "in the context of 'Camellia Pink Prints', an obvious color designation printed in small letters on three sides of a box clearly designated as 'Lady Scott'". The court similarly dismissed the count

predicated on infringement of common law trademark rights in the floret because of a lack of secondary meaning and likelihood of confusion.

IV. *False Designation of Origin*. The court dismissed this count because "plaintiff's floret design . . . has acquired no secondary meaning, and it isn't plaintiff's position that defendant affixed the word 'Marcal' to its products".

145. *Rodgers v. Living Room Lounge, Inc.*, 291 F. Supp. 599, 160 U.S.P.Q. 437 (D. Mass., Nov. 5, 1968) (Caffrey, J.)

Plaintiffs' motion for summary judgment in action for copyright infringement. Plaintiffs submitted the uncontroverted affidavit of an ASCAP employee which established that the affiant, a person familiar with popular music, heard plaintiffs' four copyrighted musical compositions performed on defendant's premises and prior thereto had heard such compositions many times and was able to recognize and identify them any time they were played within his hearing. Defendant admitted that, at the time in question, musical compositions were performed at its establishment which was open to members of the public who were there served food and beverage.

*Held*, motion granted.

The court found that "on the basis of the pleadings, depositions and admissions on file, together with the affidavits, there is no question of issue as to any material fact" and awarded plaintiff the statutory minimum of \$250 per count and reasonable attorneys fees (\$350).

146. *Sinatra v. The Goodyear Tire & Rubber Co.*, 159 U.S.P.Q. 356 (D. Cal., August 20, 1968) (Hall, J.)

Defendants' motion for summary judgment in action for unfair competition. Plaintiff, Nancy Sinatra, alleged that defendants' radio and television commercials, which utilized, under license, an anonymous rendition of the music, arrangement and modified lyrics of the copyrighted musical composition entitled "These Boots Are Made For Walking"; were imitations of her well known recorded performance of that song.

*Held*, motion granted.

The court found that defendants' "did not pass off; that is, they did not mislead the public into thinking their commercials were the product of plaintiff or anyone else", and held that "imitation alone does not give rise to a cause of action".

## 2. State Court Decisions

147. *Paulson v. Personality Posters, Inc.*, N.Y.L.J., Oct. 21, 1968 at 2, col. 3 (Sup. Ct. N.Y. Co., 1968) (Frank, J.)

Motion for preliminary injunction in action for infringement of common law copyright and invasion of plaintiff's rights of privacy and publicity. Plaintiff, Pat Paulson, a well-known television comedian, whose tongue-in-cheek entry in the 1968 presidential campaign, as "Put-On Presidential Candidate of 1968" under the banner of the STAG party, received wide exposure through a popular nationally televised variety program, newspaper coverage, personal appearances and exploitation of an exclusive campaign merchandise license, sought to restrain defendant from marketing a commercial "campaign" poster depicting plaintiff in fanciful garb and pose which was derived from a photograph of plaintiff submitted to defendant by the former's agent.

*Held*, motion denied.

1. *Common Law Copyright*. The parties offered contradictory versions of the basis upon which the photograph, in which plaintiff claimed a common law copyright, had been submitted to defendant, plaintiff alleging that it was submitted only for inspection in connection with a proposed license agreement and defendant asserting that it was offered without restriction for distribution in its discretion. The court found that this dispute precluded the granting of preliminary relief and rendered it unnecessary to decide whether plaintiff in fact possessed a common-law copyright. The court said:

A common-law copyright entitles the proprietor of an intellectual or artistic production to the absolute and exclusive use thereof prior to its publication and the right of first publication of the work . . . Such copyright terminates, however, upon the owner's assent to general publication of the work . . . While submission of the work to a particular person, or select group of persons, for a limited purpose and without right of diffusion, distribution or sale would constitute a "limited publication" which would not result in the loss of common law copyright . . . there is sharp disagreement here as to whether the photograph was sent to defendant for a limited purpose . . . or whether it was a completely unrestricted and unlimited submission for purposes of general publication, which would result in the loss of any common law copyright plaintiff may have had in the work.

II. *Right of Privacy* (N.Y. Civ. R.L. §51). In denying relief under this theory, the court held defendant's poster to be a constitutionally protected comment upon a matter of public interest, the comedic/satiric nature of plaintiff's candidacy notwithstanding. After reviewing limitations engrafted onto the right of privacy in furtherance of "the free dissemination of ideas, thoughts, newsworthy events and matters of public interest", the court said in part:

In the instant case plaintiff is concededly a well-known public personality by professional choice. As such, his affairs would ordinarily engender considerable public interest and, indeed, as an entertainer he actively seeks to promote and stimulate such public attention . . . In pursuit of such attention he projected himself into the national political scene, a sphere which is always "newsworthy" and which propels into such category all, irrespective of prior status, who aspire to participate therein. It is, moreover, an arena whose participants have traditionally been the fairest of all game for unbridled, unrestrained public comment and criticism ranging from the ridiculous to the scurrilous. Limitations upon the permissible in political expression are almost non-existent. It is the strength of our political system that it can flourish in such matrix, where the sensibilities of the participants must bow to the superior public interest in completely unfettered and unabridged free discussion of whatever persuasion, merit or style . . . It is apparently plaintiff's position that since "he is only kidding" and his political activities are really only a "publicity stunt" they fall outside the scope of constitutionally protected matters of public interest. Such premise is wholly untenable. When a well-known entertainer enters the presidential ring, tongue in cheek or otherwise, it is clearly newsworthy and of public interest. A poster which portrays plaintiff in that role, and reflects the spirit in which he approaches said role, is a form of public interest presentation to which protection must be extended. That the format may deviate from traditional patterns of political commentary, or that to some it may appear more entertaining than informing, would not alter its protective status. It is not for this or any court to pass value judgments predicated upon ephemeral subjective considerations which would serve to stifle free expression . . . Thus, whether the poster involved be considered as significant satirical commentary upon the current presidential contest, or merely as a humorous presentation of a well-known entertainer's publicity gambit, or in any other light, be it social criticism or pure entertainment, it is sufficiently relevant to a matter of public interest to be a form of expression which is constitutionally protected . . .

III. *Right of Publicity.* Commenting that "while plaintiff is ostensibly seeking redress for an alleged 'violation of his privacy', it is not his privacy at all that concerns him", the court also denied relief under a "publicity" theory. The court said:

Privacy in its usual sense is hardly the goal of an entertainer or performer. What such a figure really [wants] is a type of relief which will enable him to garner financial benefits from the pecuniary value which attaches to his name and picture. While such concept, which has been termed the "right of publicity" has been accorded limited recognition . . . the courts of this state have evidenced no inclination to adopt or follow such construction within the context of [N.Y. Civ. R.L.] Section 51. On the contrary, it has been made clear that the purpose of the statute is to redress injury for invasion of a person's "right to be left alone", with recovery being grounded on the mental strain, distress, humiliation and disturbance of peace of mind suffered by such person, hardly what plaintiff here seeks, and that the statute was not enacted to fill gaps in the copyright law or to afford substitute relief for breaches of contract or violations of other species of property rights . . .

Moreover, even where the "right of publicity" is recognized, it does not invest a prominent person with the right to exploit financially every public use of name or picture. What is made actionable is the unauthorized use for trade or advertising purposes in connection with the sale of a commodity . . . The "right of publicity", therefore, like that of "privacy", is at best a limited one, and would be held to have no application where the use of name or picture, as is here the case, is in connection with a matter of public interest. That such use is constitutionally protected and must supersede any private pecuniary considerations is conceded even by those who urge more widespread recognition of a distinct property right of publicity.

IV. The court added that, insofar as plaintiff's claim was predicated on Section 51, "injunctive relief could not in any event be granted on the present application since the papers submitted are fatally defective in failing to set forth . . . a wrongful use of the portrait or picture 'within the State' . . . references to 'national sales distribution and marketing' [being] insufficient for such purpose." Further, held the court, under any theory the "entire thrust" of plaintiff's claim is financial injury for which ultimate monetary damages, if awarded, will provide full and adequate compensation.

148. *Estate of Ernest Hemingway v. Random House, Inc.*, 296 N.Y.S.2d 771, (N.Y. Ct. App., Dec. 12, 1968) (Fuld, J.) *For decision below, see* 53 Misc.2d 462, 279 N.Y.S.2d 51, 153 U.S.P.Q. 871 (Sup. Ct. 1967), 14 BULL. CR. SOC. 389, Item No. 294 (1967), affirmed without opinion, 285 N.Y.S.2d 568 (1st Dept. 1967). *For decision on motion for preliminary injunction, see* 49 Misc.2d 726, 268 N.Y.S.2d 531, 148 U.S.P.Q. 618 (Sup. Ct. 1966), 13 BULL. CR. SOC. 253, Item No. 282 (1966), affirmed without opinion, 25 A.D.2d 719, 269 N.Y.S.2d 366 (1st Dept. 1966).

Action for infringement of common law copyright, unfair competition, breach of confidential relationship and invasion of privacy. After the death of Ernest Hemingway, defendant Hotchner wrote a biographical study of the famous author incorporating numerous lengthy quotations drawn by Hotchner from conversations he had had with Hemingway over the years of their close friendship. Plaintiff's request to preliminarily enjoin publication of the book by defendant Random House was denied by Judge Frank and, after publication, Judge Schweitzer granted summary judgment dismissing the complaint. Plaintiffs' action was predicated upon (i) infringement of Hemingway's common law copyright in his conversational discourse, (ii) unfair competition (with Hemingway's own literary creations), (iii) breach of confidential relationship under which Hemingway allegedly imparted his words and thoughts to Hotchner. Mrs. Hemingway alone sought to recover for invasion of her privacy based upon references to her in the book, particularly with regard to her role during her husband's last months.

*Held*, affirmed.

I. *Common Law Copyright*. The court affirmed the dismissal of this count, but "on a ground more narrow than that articulated" by Judge Schweitzer.<sup>1</sup> The court specifically declined to base its affirmance on the proposition, advanced by defendant and given credence in Judge Frank's opinion denying preliminary relief, that literary property may never be claimed in conversational speech which remains unfixed in tangible form. Refusing to pass upon the validity of this argument in the case at bar, the court preferred to "raise . . . questions, leaving them open for future consideration in cases which may present them more sharply. . . ." The court said:

It must be acknowledged — as the defendants point out — that nearly a century ago, our court stated that common law copyright extended to "[e]very new and innocent product of mental labor which has been embodied in writing, or some other material form"

1. See 14 BULL. CR. SOC. 389, Item No. 294 (1967).



(Palmer v. Dewitt, 47 N. Y. 532, 537). (Emphasis supplied.) And, more recently, it has been said that "an author has no property right in his ideas unless \* \* \* given embodiment in a tangible form" (O'Brien v. RKO Pictures, 68 F Supp. 13, 14). However, as a noted scholar in the field has observed, "the underlying rationale for common law copyright (i.e., the recognition that a property status should attach to the fruits of intellectual labor) is applicable regardless of whether such labor assumes tangible form" (Nimmer, Copyright, p. 41). The principle that it is not the tangible embodiment of the author's work but the creation of the work itself which is protected, finds recognition in a number of ways in copyright law.

One example, with some relevance to the problem before us, is the treatment which the law has accorded to personal letters — a kind of half-conversation in written form. Although the paper upon which the letter is written belongs to the recipient, it is the author who has the right to publish them or to prevent their publication (see Baker v. Libbie, 210 Mass. 599, 605, 606). In the words of the Massachusetts court in the Baker case (210 Mass., at pp. 605-606), the author's right "is an interest in the intangible and impalpable thought and the particular verbal garments in which it has been clothed." Nor has speech itself been entirely without protection against reproduction for publication. The public delivery of an address or a lecture or the performance of a play is not deemed a "publication," and, accordingly, it does not deprive the author of his common law copyright in its contents. . . .

Letters, however — like plays and public addresses, written or not — have distinct, identifiable boundaries and they are, in most cases, only occasional products. Whatever difficulties attend the formulation of suitable rules for the enforcement of rights in such works . . . they are relatively manageable. However, conversational speech, the distinctive behavior of man, is quite another matter, and subjecting any part of it to the restraints of common law copyright presents unique problems.

One such problem . . . is that of avoiding undue restraints on the freedoms of speech and press and, in particular, on the writers of history and of biographical works of the genre of Boswell's "Life of Johnson." The safeguarding of essential freedoms in this area is not without its complications. The indispensable right of the press to report on what people have *done*, or on what has *happened* to them or on what they have *said in public* . . . does not necessarily imply an unbounded freedom to publish whatever they may

have *said in private conversation*, any more than it implies a freedom to copy and publish what people may have put down in *private writings*.

Copyright, both common law and statutory, rests on the assumption that there are forms of expression — limited in kind, to be sure — which should not be divulged to the public without the consent of their author. The purpose, far from being restrictive, is to encourage and protect intellectual labor . . . The essential thrust of the First Amendment is to prohibit improper restraints on the *voluntary* public expression of ideas; it shields the man who wants to speak or publish when others wish him to be quiet. There is necessarily, and within suitably defined areas, a concomitant freedom not to speak publicly, one which serves the same ultimate end as freedom of speech in its affirmative aspect.

The rules of common law copyright assure this freedom in the case of written material. However, speech is now easily captured by electronic devices and, consequently, we should be wary about excluding all possibility of protecting a *speaker's* right to decide when his words, uttered in private dialogue, may or may not be published at large. Conceivably, there may be limited and special situations in which an interlocutor brings forth oral statements from another party which both understand to be the unique intellectual product of the principal speaker, a product which would qualify for common law copyright if such statements were in writing.

The court also took cognizance of the issue raised by Judges Frank and Schweitzer regarding “the difficulty of measuring the relative self-sufficiency of any one party’s contributions to a conversation” but, in a footnote, responded that “it may be, in the case of some kinds of dialogue or interview, that the difficulty would not be greater than in deciding other questions of degree, such as plagiarism. . . .”

The court’s “more narrow ground” upon which it affirmed the disposition below was based on the lack of any proof that Hemingway manifested a desire to maintain control over the future publication of his conversations with Hotchner. The court said in part:

Assuming, without deciding, that in a proper case a common law copyright in certain limited kinds of spoken dialogue might be recognized, it would, at the very least, be required that the speaker indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication. In the conventional common law copyright situation,

this indication is afforded by the creation of the manuscript itself. It would have to be evidenced in some other way if protection were ever to be accorded to some forms of conversational dialogue.

Such an indication is, of course, possible in the case of speech. It might, for example, be found in prefatory words or inferred from the circumstances in which the dialogue takes place.<sup>3</sup> Another way of formulating such a rule might be to say that, although, in the case of most intellectual products, the courts are reluctant to find that an author has "published," so as to lose his common law copyright (see Nimmer, Copyright, sec. 58.2, pp. 226-229), in the case of conversational speech — because of its unique nature — there should be a presumption that the speaker has not reserved any common law rights unless the contrary strongly appears. However, we need not carry such speculation further in the present case since the requisite conditions are plainly absent here.

For present purposes, it is enough to observe that Hemingway's words and conduct, far from making any such reservation, left no doubt of his willingness to permit Hotchner to draw freely on their conversation in writing about him and to publish such material.

II. *Unfair Competition.* The court affirmed dismissal of the unfair competition count on the grounds that there was "no competition of any kind, unfair or otherwise" between Hemingway and Hotchner and no demonstrated "palming off or other deceitful practice which must be present before an otherwise lawful use of literary material might be stamped as unfair competition." It was thus unnecessary for the court to pass upon defendants' contention that *Sears* and *Compco* precluded plaintiffs' resort to a state unfair competition remedy.

III. *Breach of Confidential Relationship.* The court held that, although the evidence below may have suggested the existence of a confidential relationship between Hemingway and Hotchner, there was no indication that such relationship encompassed the material included in defendants' book. The court said:

The confidential relationship, if it did exist, extended only to the negotiation and carrying out of projects for the adaptation of Hemingway's published books and stories for motion pictures and television. Neither the allegations of the complaint nor the averments in the affidavits go beyond this. There is no showing of any kind that the adaptations were based on Hemingway's conversations; they were drawn from distinct, and completed works to which Hemingway held the copyright. Thus, there is nothing in the affidavits

from which a restriction on Hotchner's right to quote Hemingway's conversation may be deduced.

IV. *Right of Privacy* (*N.Y. Civ. R.L. §51*). The court affirmed the dismissal of Mrs. Hemingway's privacy claim because (i) she is a newsworthy public figure, (ii) no falsification was established, (iii) the portions of the book dealing with her husband's deterioration were not impermissible, and (iv) the circulation of proofs to book reviewers did not constitute a proscribed "advertising use". The court said:

... in the light of constitutional guarantees of free speech, section 51 may not be applied to afford recovery to a public figure or in matters of public interest — to quote from *Hill* (385 U. S., at p. 388) — "in the absence of proof that the defendant published the [item] with knowledge of its falsity or in reckless disregard of the truth." (See, also, *Spahn*, 21 N. Y. 2d, at p. 127.) That Mrs. Hemingway is a public figure and newsworthy, within the meaning of these cases, may not be disputed. Not only is she the widow of a literary figure of world renown, a Nobel Laureate, but she herself has encouraged public attention to her status by writing articles for the popular magazines dealing with her husband and with events in their lives together. As the court aptly noted in *Goelet v. Confidential, Inc.* (5 A. D. 2d 226, 228), "[o]nce a person has sought publicity he cannot at his whim withdraw the events of his life from public scrutiny."

With respect to the required proof of falsification, under the doctrine of the *Hill* and *Spahn* cases, we need but note that, despite a passing reference to the subject in an affidavit, no serious attempt was made to support such a claim. There was no allegation in the complaint of any misstatement knowingly or recklessly made . . .

Nor is there basis for the plaintiff's further contention that, falsity aside, the description of her feelings and conduct during the time of her husband's mental illness constitutes "so intimate and so unwarranted" a revelation "as to outrage the community's notions of decency" and allow an action for damages. (*Time, Inc., v. Hill*, 385 U. S. 374, 383, n. 7, *supra*.) It is enough to say that Hotchner's sympathetic report of Mrs. Hemingway's role in her husband's anguished last months may not be treated as an impermissible revelation or as otherwise offensive to any notion of decency. The brief disclosures to which the plaintiff points have their proper place in a biographical account of the dissolution and death of a gifted writer.

The plaintiff also urges that section 51 creates a right of action not merely for the invasion of privacy "for the purpose of trade" — the aspect of the statute involved in Hill and Spahn — but also for "advertising purposes," and she goes on to contend that the circulation of galley proofs of the book by Random House to the book reviewers of sixteen journals and newspapers amounted to an advertisement of the book in advance of its publication.<sup>5</sup> The statute does, as we noted in *Flores v. Mosler Safe Co.* (7 N. Y. 2d 276, 284), render a use for "advertising purposes a separate and distinct violation" but it is self-evident, we suggest, that the circulation of proofs of a book to reviewers may not be considered advertisement within the meaning of section 51. The main purpose and function of book reviewing is to introduce the author's work into the stream of public information, the free flow of which is safeguarded by the First, and Fourteenth Amendments. A publisher, in circulating a book for review, risks unfavorable comment as well as praise; he places the work in the arena of debate. The same reasons which support the author's freedom to write and publish books require a similar freedom for their circulation, before publication, for comment by reviewers.<sup>6</sup>

149. *Cinepix, Inc. v. Triple F. Productions*, N.Y.L.J., Feb. 6, 1969, at 16, col. 3 (Sup. Ct. N.Y. Co. 1969) (Markowitz, J.). *For opinion denying cross motions for summary judgment, see* 150 U.S.P.Q. 134 (Sup. Ct. 1966), 13 BULL. CR. SOC. 424, Item No. 439 (1966).

Action for unfair competition (title piracy). Plaintiff claimed rights in a half hour black and white television film series entitled "I Spy" which featured Raymond Massey and was televised with no more than moderate success over a number of independent stations between 1956 and 1959. The series consisted of dramatizations based upon true spy stories. Defendant Triple F. was the producer of an identically titled one hour color television series starring Bill Cosby and Robert Culp which depicted fictional espionage episodes with an emphasis on humor. This highly popular series was televised during the period 1965 through 1968 over the facilities of defendant National Broadcasting Company and is presently in syndication. Defendants admitted that they had known of the prior series when they adopted their title.

*Held*, judgment for defendants.

I. Copyright in the Massey "I Spy" series resided in Reah Productions, Inc., a wholly-owned subsidiary of Guild Films, Inc. A license agreement between these entities granted Guild an exclusive right to

commercially exploit the series and recognized Guild as the exclusive owner of the telefilms themselves. The films were, in fact, in Guild's possession or control when that firm went into bankruptcy. Subsequently, under court order, Guild's trustee in bankruptcy sold plaintiff several "telemovie properties" held by the bankrupt, including the Massey series. Defendants contended that plaintiff acquired at most ownership of the physical films constituting the Massey series but secured no rights in the title thereof. The court, however, concluded that while plaintiff did *not* acquire "any rights to the copyrights which continued to be the property of Reah" (the court refusing to attribute the subsidiary's properties to the parent), plaintiff *did* succeed to rights of commercial exploitation under the license agreement and thus possessed "some property interest in the title 'I Spy'."

The above conclusion was based upon the court's findings that: (A) Guild's trustee succeeded to the bankrupt's rights in the license agreement as well as title to the telefilms because (i) the license agreement did not terminate as a result of the licensee's bankruptcy (there being no provision to that effect in the agreement and no integral personal relationship), (ii) the license was not of such a personal nature as to preclude assignment and, even assuming that a covenant against assignment could be given effect in bankruptcy where a lease is not involved (see Bankruptcy Act §70b), the agreement contained no such provision, and (iii) there was no evidence that the trustee had not assumed the license; and (B) The purchase by plaintiff of the trustee's right, title and interest in the "I Spy/Massey" property similarly embraced the rights under the license agreement as well as title to the films. The court relied upon, *inter alia*, the following language from *Madison Pictures, Inc. v. Pictorial Films, Inc.*, 151 N.Y.S.2d 95, 106 (Sup. Ct. 1956):

The arguments of the defendant that it sold prints, and not rights, and that in the sale of the prints no permission was given to use the prints by way of showing them upon a screen, are unacceptable. The court cannot be so naive as to believe that the sale of prints was without purpose other than to give the defendants valuable considerations which they received. These prints have a highly commercial purpose. They are not used for purposes of art, decoration of the home, or for storage in warehouses.

II. The court further held, however, that the title "I Spy" had not acquired a secondary meaning associated with the Massey series at the time defendant's series premiered on television, and ordered the complaint dismissed. The court said, in part:

. . . even though titles to copyrighted productions may not be covered by the copyright, per se, a title which has become descriptive and closely identified in the public mind with the production of the copyright owner will be protected to the extent necessary to prevent confusion on the part of the public as to the identity of the protection covered by the title. . . . This association is commonly called secondary meaning [and it] must obtain at the time the defendant entered the market.

. . . plaintiff's proof establishes only that the [Massey] series was regularly telecast during the period 1956-1957 and thereafter on a sporadic basis until some time in 1959. It was to some extent advertised during this period but the effectiveness of this activity may be questioned. . . . [Additionally,] the entire thrust of the testimony of an expert witness produced by plaintiff . . . was that the prior series could be "revived". Revival, he testified, means bringing back to life a television property either dead or slumbering. His testimony establishes that the situation in September, 1965 [when defendants' series premiered] was, at least, that the prior series was either dead or in a deep coma. Such endeavors as testified to by plaintiffs cannot be found to have created any secondary meaning even in 1956 and 1957.

The crucial date in this case, however, is September, 1965 and attention will now be directed to the exploitative activity of Cinepix after it acquired the films in 1962. It seems clear that Cinepix effected no domestic license of the series . . . [and] the record establishes the absence of domestic telecasting of the series during the six and three-quarter years prior to September, 1965 . . . . That leaves advertising and promotion as a possible manner of acquiring secondary meaning. Undoubtedly there was some, but, for the most part, it was confined to the 1956-1957 period. . . .

Nor was there any likelihood of confusion shown on the part of the public in differentiating between the two series. . . . It must be assumed that the public will use reasonable intelligence in differentiating between these two dissimilar productions.

The court further suggested, but declined to hold, that even had plaintiff succeeded to some prior preemptive right in the title deriving from the 1956-1957 period, it might be found to have abandoned same. The court concluded that, "because of the long period of non-use, during which the [Massey] series has been characterized as dead or slumbering, and the absence of any secondary meaning in September, 1965, it is abundantly clear that defendant's formulation of the title in question

to suit the format and content of their series was in good faith and in no way an attempt to capitalize on the prior use of the title.”

150. *Minniear v. Tors; Minniear v. Ziv Television Programs, Inc.*, (Cal. Ct. App., Oct. 24, 1968) (Nutter, J.)

Plaintiff's appeals from two judgments of nonsuit in consolidated actions for idea piracy. Plaintiff claimed that defendants' television series "Sea Hunt", and a particular episode therein, were pirated from ideas for a television series conceived of and developed by plaintiff to which defendants had access by reason of a pilot screening and the receipt from plaintiff of a booklet containing outlines for further programs.

Delineating its scope of review as limited to whether there was sufficient evidence to let the case go to a jury, the court reversed the nonsuit insofar as it pertained to a cause of action predicated on contract and affirmed the nonsuit to a "conversion-fraud" theory.

The court said, in part:

Generally, ideas are not the property of anyone and may be used by all absent a contract to pay for them. Plaintiff has no statutory copyright. His claim must rest upon a protectible property right within the meaning of [Cal. Civ. Cd.] section 980a, or an implied contract to pay for his idea. . . . [As stated in *Desney v. Wilder*, 46 Cal. 2d 715] "a so-called 'implied in fact contract' . . . may be found although there has been no meeting of the minds. . . . The person who can and does convey a valuable idea to a producer who commercially solicits the service or who voluntarily accepts it knowing that it is tendered for a price should . . . be entitled to recover. . . ." There is substantial evidence to support an inference that appellant submitted his idea to Tors with the reasonable expectation that he would be paid by Ziv if his idea were used. There is also substantial evidence to support the further inference that Tors acting for Ziv accepted the submission of the idea with full awareness of appellant's expectation of payment in event of use. Tors admitted that pilots are made in the industry for the purpose of showing them to prospective purchasers with a view to selling them commercially to make a series. . . . [And there is ample evidence to support a finding that] appellant's ideas and format were the inspiration for Sea Hunt and [that] respondent, in fact, used appellant's ideas and format.

The [conversion-fraud] cause of action talks of a scheme to defraud plaintiff of property rights. . . . As stated above, in the absence of a protectible property right there can be no conversion of



an idea. . . . Appellant here had only one possible literary composition, i.e., the script of the pilot. . . . This might have been subject to protection as a property right . . . but there was no substantial evidence that this script or composition had been used as such. Appellant makes no allegations of any substantial similarity between the protectible portions of his work and respondents' teleplay other than the fact that respondents' teleplays are similar in format. . . . No claim is made here that respondent did not develop its own script and teleplays. . . . The use of [a] sequence [similar in concept to a plot outline in the booklet furnished defendant] was the appropriation of an idea not a composition. Accordingly, . . . there is no substantial evidence of any conspiracy to convert or fraudulently appropriate any protectible property rights of appellant. . . .

### 3. Tax Court Decision

151. *KIRO, Inc. v. Commissioner*, 51 T.C. No. 16 (Tax Court, Oct. 16, 1968) (Bruce, J.)

Petitioner had entered into several license agreements entitling it to televise certain motion picture films over its Seattle station. Some of the agreements allowed unlimited exposures while others restricted the number of authorized runs. In its 1958 return, KIRO claimed an aggregate depreciation deduction under a sliding scale method for "film rentals and purchases". The Commissioner disallowed part of the deduction, claiming that straight-line depreciation was required under Section 162 of the Internal Revenue Code (rental expenses under a lease).

*Held*, for petitioner in part.

The court held that, as to the films with limited authorized runs, KIRO was entitled to sliding scale depreciation. Section 162 was deemed inapplicable as the contracts provided for an intangible broadcast license rather than the acquisition of a leasehold. Further, as the evidence clearly established that the value of a motion picture film is at its greatest upon its first showing, diminishing with successive exhibitions, the straight-line depreciation method was found not to provide a "reasonable allowance" under section 167(c). Certain of the restricted run films had been licensed under agreements which provided a sliding scale refund schedule for use in making adjustments in price should the licensor withdraw the film before the licensee exhausted the authorized number of showings, and KIRO's calculations for depreciation were

based upon the attribution of percentage of value per run under this arrangement. Sliding scale depreciation for restricted run films which were licensed without such provision was calculated upon the basis of KIRO's experience in the Seattle television market. Both bases of calculation were held permissible. As to the films licensed without exposure restriction, however, the Court held that KIRO had not sufficiently established the calculation of its claimed deduction nor overcome the burden of demonstrating the error of the Commissioner's straight-line method.

*Also of interest:*

152. *Kenney v. American Can Company*, 402 F.2d 478 (9th Cir., Oct. 30, 1968) (Per Curiam)

Plaintiff's appeal from judgment for defendant in action for misappropriation. Plaintiff alleged that he had submitted to defendant an idea concerning "easy open" seals for cans and that defendant, without compensating plaintiff, had made use of the idea in marketing its "easy open" coffee cans.

*Held*, affirmed.

The trial court held that the evidence failed to disclose any reliance by defendant on plaintiff's communications or any relationship of confidence or trust between the parties. The Court of Appeals found the decision below to be amply supported by the evidence and not clearly erroneous.

153. *Khoury v. Bouquet Record Co., Inc.*, N.Y.L.J., Nov. 1, 1968 at 16, col. 1 (Sup. Ct. N.Y. Co., 1968) (Streit, J.)

Motion to preliminarily enjoin defendant from advertising and selling certain records in conjunction with the name "Tiny Tim". Plaintiff had made the recordings in question in 1932 under the name "Darry Dover" and had since attained considerable fame as an entertainer under the sobriquet "Tiny Tim".

In granting temporary relief the court said: "It is not disputed that plaintiff made a recording in 1932 under the name of Darry Dover. What is in dispute is whether defendants may, without right, appropriate for themselves that recording now that plaintiff has attained considerable fame under a different name and style as 'Tiny Tim'. Plaintiff has a protective property right to his creative works and is entitled to restrain the appropriation thereof. Plaintiff has attained some fame

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under the name 'Tiny Tim' with a unique style, appearance and personality. Defendants seek not only to sell such recordings, but to do so by trading upon the name 'Tiny Tim' and upon the unique personality and style without a satisfactory showing of any authority or right." <sup>1</sup>

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1. *Cf. Elliot v. Roulette Records, Inc.*, N.Y.L.J., May 9, 1968 at 16, col. 1 (Sup. Ct. N.Y. Co, 1968), 16 BULL. CR. Soc. 53, Item 35 (1968).

## PART V.

**BIBLIOGRAPHY**

## A. BOOKS AND TREATISES

## 2. Foreign Publications

154. ABREU, EDMAN AYRES DE. O plágio em música . . . São Paulo, Revista dos Tribunais, 1968. 183 p.

Excerpts from numerous writings and court decisions dealing with infringements and plagiarism of musical, dramatic and artistic works, preceded by a listing of pertinent Brazilian legislation and the complete texts, in Portuguese, of the international copyright conventions to which Brazil has adhered.

155. SIDLER, PETER. Der Schutz von Computerprogrammen im Urheber- und Wettbewerbsrecht. Basel, Verlag für Recht und Gesellschaft, 1968. 80 p. (Studien zum Immaterialgüterrecht, 7).

A study of the protection of computer programs under the laws of copyright and unfair competition, with emphasis on pertinent Swiss and German literature and jurisprudence.

## B. LAW REVIEW ARTICLES

## 1. United States

156. American Association of Law Libraries. *61st Annual Meeting, Philadelphia, July 1-3, 1968*. Can copyright law respond to the new technology? Julius J. Marke, chairman. John Schulman, Benjamin Kaplan, Verner Clapp, Abe A. Goldman, and George Frost, panelists. (61 *Law Library Journal* 387-408, no. 4, Nov. 1968.)

A panel discussion of the copyright problems posed by reprography and computer-based systems of information storage and retrieval and how best the problems might be treated under the copyright revision bill.

157. BENWAY, RICHARD F. Patents, copyrights and trademarks compared and distinguished. (3 *Portia Law Journal* 17-29, no. 1, Fall 1967.)

An examination of "each [form of intangible personal property] in terms of definition, historical development, administrative prerequisites to issuance, and social utility."

158. Copyright — interpretation of license agreement — right to make motion picture includes right to televise. (54 *Iowa Law Review* 160-166, no. 1, Aug. 1968.)

A critical comment on the decision in *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 15 BULL. CR. SOC. 337, Item 332 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968).

159. Copyright — protection denied to verbal expression of simple subject matter. (67 *Michigan Law Review* 167-178, no. 1, Nov. 1968.)

A note on *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 15 BULL. CR. SOC. 43, Item 24 (D. Mass. 1967.)

160. Copyright — telecommunication — CATV carriage of copyrighted material does not constitute infringement. (21 *Vanderbilt Law Review* 854-863, no. 5, Oct. 1968.)

A comment on the *Fortnightly* case, 392 U.S. 390, 15 BULL. CR. SOC. 316, Item 327 (1968), with a conclusion that "given the nature of copyright law, it is difficult to envision an adequate judicial solution." The commentator opines, instead, that the F.C.C., "buttressed with clear policy guidelines provided by Congress, would be the logical agency of government to resolve most adequately and amicably the competing economic, private, and public interests involved in CATV transmission of copyrighted works."

161. DAVIDSON, SAMUEL L. [Review of] What the general practitioner should know about trademarks and copyrights. By Arthur H. Seidel . . . 1967. (25 *Washington and Lee Law Review* 345-347, no. 2, Fall 1968.)

The reviewer finds the book valuable as a " 'short form' source book," but feels that the "complexities" of the subjects covered should have followed "a rather simple explanation of the overall general situation." See 15 BULL. CR. SOC. 273, Item 274 (1968).

162. EULENBERG, ALEXANDER. Books and mousetraps. (54 *American Bar Association Journal* 1173-1176, Dec. 1968.)

An answer to the following question in respect to tax treatment: "Do we prefer inventors of our favorite gadgets [*i.e.*, the builders of better mousetraps] to the authors of our favorite books,

or are Congress and the Tax Court arbitrarily giving inventors preference?"

163. KOLLER, HERBERT R., and JACK MOSHMAN. Patent protection for computer software: implications for the industry. (12 *Idea* 1109-1133, no. 4, Winter 1968-1969.)

A representation of "views on what the law and practice are today, as well as on what the law should be" in respect to the patentability of computer software inventions.

164. NOLAN, PETER F. Copyright protection for motion pictures: limited or perpetual? (12 *Idea* 1135-1160, no. 4, Winter 1968-1969.)

A paper, awarded Georgetown University Law Center's first prize in the 1968 Nathan Burkan Memorial Competition, which finds, upon examining existing case law relating to the concept of publication in copyright law, "that the vast majority of motion pictures produced in this country can be granted virtually perpetual copyright protection under state common law. The author concludes that this is contrary to the Patent-Copyright Clause in the United States Constitution, and he suggests that this anomaly be clearly overruled by Congress in the Revision Bill."

165. [Reed, Thomas A.] The role of the Register of Copyrights in the registration process: a critical appraisal of certain exclusionary regulations. (116 *University of Pennsylvania Law Review* 1380-1415, no. 8, June 1968.) *Reprinted* 16 *BULL. CR. SOC.* 65-108 (Dec. 1968).

A comment, First National Prize Winning Essay in the 1968 Nathan Burkan Memorial Competition, which purposes "to focus attention on the extent of the Register's discretion to refuse registration, examining the theoretical and legal bases for its existence, how it has in fact been exercised through Copyright Office regulations, and what remedies should be made available to those who may be adversely affected by the Register's decision." Remedies are suggested for the following two alleged defects in sec. 410 of the general revision bill, H.R. 2512, 90th Cong., 1st Sess. (1967): (1) the failure to afford relief to an applicant whose application has been denied registration and whose work is not currently being infringed; and (2) no provision is made for any presumption of validity to attach to the facts which would have been stated in a certificate of registration had the Register not declined to issue one.

166. SMITH, DELBERT D. Pirate broadcasting. (41 *Southern California Law Review* 769-815, no. 4, Summer 1968.)

An examination of "the legal status of pirate broadcasting in terms of relevant legal principles." The examination includes an analysis of the "intricacies surrounding the assertion of national jurisdiction over pirate broadcasters which are located beyond national boundaries . . . followed by an assessment of the international, regional, and national legislation which may be brought to bear on pirate broadcasting." Special attention is given to the 1967 British Broadcasting Act which is described as emphasizing "the faltering attempts at regulation through international agencies."

167. VAN EPPS, G. DAVID. Constitutional law — New York Court of Appeals expands right of privacy afforded public figures. (19 *Syracuse Law Review* 1035-1037, no. 4, Summer 1968.)

A brief note on *Spahn v. Julian Messner, Inc.*, 21 N.Y.2d 124, 286 N.Y.S.2d 832 (1967).

168. WESLEY, ROGER. Copyright liability for communication satellites: a bridge from CATV. (12 *Idea* 1161-1191, no. 4, Winter 1968-1969.)

A paper, awarded the George Washington University National Law Center's first prize in the 1968 Nathan Burkan Memorial Competition, which purposes "to assess in detail the emergence of satellite systems, available international copyright remedies, conflicting interests and some possible solutions to extending copyright protection."

## 2. Foreign

### 1. English

169. DESJEUX, XAVIER. The right of reproduction in the Berne Convention as revised at Stockholm on July 14, 1967. (4 *Copyright* 236-238, no. 11, Nov. 1968.)

"This study was presented as a report to the General Assembly of the International Literary and Artistic Association (ALAI), on April 23, 1968."

170. MARKOVIC, BOZIDAR. Letter from Yugoslavia: the new Yugoslav copyright law. (4 *Copyright* 253-257, no. 12, Dec. 1968.)

A general comparison of the revised copyright law and its predecessor in order "to bring out the essential differences between

them and the principal reasons which prompted the Yugoslav legislature to make . . . [the] alterations.”

171. United International Bureaux for the Protection of Intellectual Property. *Working Group on Copyright Problems of Satellite Communications (Geneva, October 14-16, 1968)*. Final report. (4 *Copyright* 230-233, no. 11, Nov. 1968.)

The purpose of the Group, convened by the Director of BIRPI, “was to undertake an exchange of views on the copyright and neighboring rights problems that might arise from the transmission of radio and television broadcasts by communications satellites.” The list of participants appears at the end of the report.

172. WALLACE, WILLIAM. The United Kingdom protects “works of applied art.” (4 *Copyright* 235-236, no. 11, Nov. 1968.)

Some background material on U.K. protection of industrial designs, followed by an explanation of the Design Copyright Act 1968 and concluded with a brief analysis of international aspects of the new Act. Under this new law, section 10 of the Copyright Act 1956 is amended, so that the copyright owner who applies his artistic work to articles of commerce and puts those articles on the market, instead of losing all copyright protection, retains his power to sue, for a period of 15 years from the date he himself first marketed goods to which the work had been applied, anyone who copies his work whether or not the design was registered. See also Item 136, *supra*.

## 2. English, French and Spanish

173. RINGER, BARBARA A. Recent judicial developments in the United States. (*Revue Internationale du Droit d'Auteur* 88-161, no. 58, Oct. 1968.)

A discussion of decisions, most of which were handed down in 1966 and 1967, and were selected because of the trends they indicate, the precedents they establish, and “the light they cast on the troubled state of the copyright law in the United States at the present time.”

174. DESBOIS, HENRI. L'obligation de publication et de diffusion des éditeurs de musique. (*Revue Internationale du Droit d'Auteur* 162-234, no. 58, Oct. 1968.)

An analysis of case law, followed by deductions and conclusions drawn therefrom, on the obligations of music publishers to



publish and distribute works under the French copyright statute of March 11, 1967.

175. JOUBERT, CLAUDE. L'applicabilité des actes successifs de la Convention d'Union de Berne. (*Revue Internationale du Droit d'Auteur* 4-79, no. 58, Oct. 1968.)

A study of the applicability of the various texts of the Berne Copyright Convention with reference to relationships that might exist between Berne countries not bound by the same Act.

### 3. English and French

176. AURIC, GEORGES. Les contrats entre auteurs et organismes de radio-diffusion. (*Interauteurs* 256-273, no. 173, 4th quarter 1968.)

A report devoted essentially to an analysis, under French law, of agreements between music composers and radio and television broadcasting organizations, within the framework of such organizations as distributors, producers, or publishers of works.

### 4. French

177. MAULNIER, THIERRY. Le droit de l'auteur sur son oeuvre; transcription de l'exposé oral présenté par Thierry Maulnier. (*Interauteurs* 214-221, no. 172, 3d quarter 1968.)

A philosophic analysis of the author's right in his creation from the point of view of its life history: firstly, as it is created; secondly, as it is used, performed or adapted during the lifetime of its creator; and lastly, when it falls into the public domain.

### 5. German

178. SCHMIEDER, HANS HEINRICH. Wann endet das Schutzrecht der ausübenden Künstler nach dem den neuen Urheberrechtsgesetz? (12 *Film und Recht* 315-317, no. 11, Nov. 15, 1968.)

A brief discussion of problems arising in connection with the duration of the protection of performing artists in motion pictures under the new copyright law of the German Federal Republic.

## NEWS BRIEFS

## 179. ROBERT J. BURTON MEMORIAL FELLOWSHIP OFFERED AT COLUMBIA UNIVERSITY.

The Columbia University School of Law announces the establishment of the Robert J. Burton Memorial Fellowship. Commencing in the Fall of 1969, the Fellowship will be awarded annually to a graduate student of law for study and research on copyright or other laws affecting music, art, literature, or other products of the mind, or on laws affecting communications.

The fellowship provides a stipend of \$5,000. Students who are interested in pursuing graduate study in the area mentioned above are encouraged to contact Assistant Dean, Graduate Legal Studies, Columbia School of Law, 435 West 116th Street, New York, N.Y. 10027.

The Robert J. Burton Memorial Fellowship was established by friends of the late Robert J. Burton, a graduate of Columbia Law School in the Class of 1937. Judge Burton was president of Broadcast Music, Inc. His many activities included service as a judge in New Rochelle, N.Y. For many years he was a leading member of the copyright bar and well-known as a writer and speaker on copyright problems. He was frequently a guest participant in the Columbia Law School's Seminar in Copyright Law. From 1956 to 1959 he served on the Board of Trustees of The Copyright Society of the U.S.A.

## 180. VANDERBILT UNIVERSITY OFFERS SPRING INSTITUTE ON LEGAL PROBLEMS IN THE MUSIC INDUSTRY.

An institute entitled "Legal Problems in the Music Industry" will be held under the direction of Prof. L. Ray Patterson, on Friday April 18, 1969, in Underwood Auditorium at Vanderbilt University in Nashville. The speakers will include Stanley Adams, President of the American Society of Composers, Authors and Publishers; Edward M. Cramer, President of Broadcast Music, Inc.; Harold Orenstein and Allen Arrow, of the firm of Orenstein, Arrow & Silverman, New York City, who will speak on problems in buying and selling copyrighted works, and on avoiding litigation in the sale and acquisition of such works; Leo Strauss, who will speak on foreign rights; and Leonard Feist, Executive Director of the National Music Publishers' Association, who will discuss current developments and the status of the copyright revision bill.

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**181. COPYRIGHT OFFICE MOVES.**

On March 31, 1969, the Copyright Office began operation in its new quarters in Building No. 2 of Crystal City Mall, 1921 Jefferson Davis Highway in Arlington, Virginia. However, it is *important* that all mail continue to be addressed to the Register of Copyrights, The Library of Congress, Washington, D.C. 20540. It is essential that the Virginia address *not* be used in correspondence.

The Copyright Office will occupy the first five floors of a modern high-rise structure forming part of a complex of new buildings located approximately three miles south of downtown Washington and about one mile west of Washington National Airport.

Telephone numbers will be changed. The area code is 703, and the number of the Public Information Office will be 557-8700. Hours of service will be 8:00 a.m. to 4:00 p.m., Mondays through Fridays (except legal holidays). These will also be the hours during which the Copyright Card Catalog and other official records will be open to public use and inspection.

Service may be delayed temporarily by the move, but it is hoped that there will be a minimum of inconvenience. The Office asks the indulgence and cooperation of the public during the transition. Great care is being taken to see that all official records and materials in process are safeguarded throughout the move.

The reason for the move is the urgent need for additional space, both by the Copyright Office and by other departments of the Library of Congress. It is believed that the new facilities offer a number of advantages and opportunities for improved service.

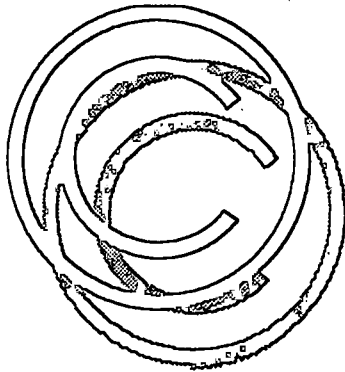
According to current plans, the Copyright Office will return to Capitol Hill and occupy a part of the Madison Memorial Annex to the Library of Congress, the construction of which is contemplated in the future on a site adjacent to the present Library of Congress buildings.

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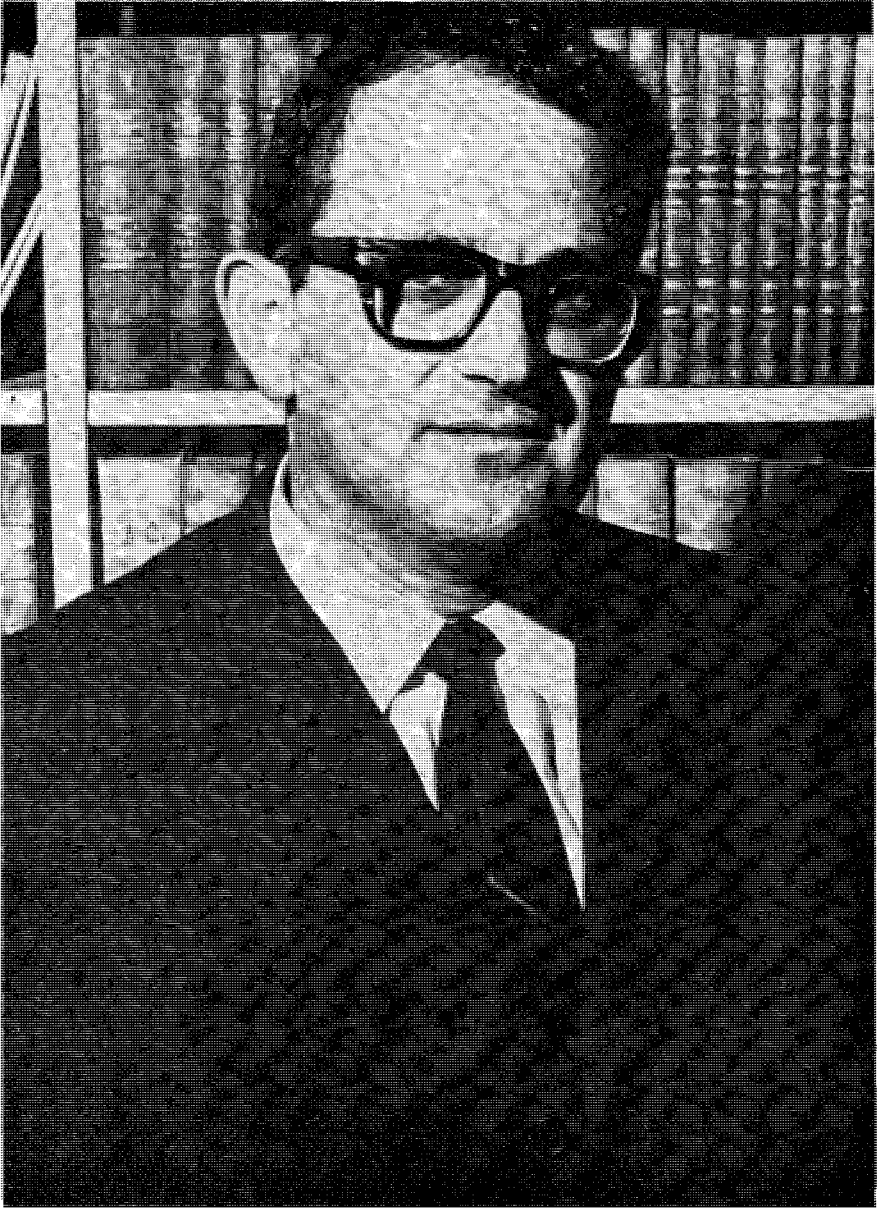
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## AUSTRALIA JOINS THE UNIVERSAL COPYRIGHT CONVENTION

The United States Department of State has been informed by the Director-General of UNESCO that Australia deposited its instrument of ratification of the Universal Copyright Convention on February 1, 1969. Australia is the 57th country to become a party to the Universal Copyright Convention.

In accordance with Article IX, paragraph 2, of the Convention, the latter will come into force with respect to Australia on May 1, 1969, three months after the deposit of the instrument of ratification.



ZE'EV SHER

*The Deputy Attorney General of Israel, who delivered the Seventh Annual Jean Geiringer Memorial Lecture on International Copyright at New York University Law Center on April 16, 1969.*

## PART I.

## ARTICLES

182. REFLECTIONS ON COPYRIGHT IN  
DEVELOPING COUNTRIES

*The Seventh Annual Jean Geiringer Memorial Lecture  
on International Copyright Law*

By ZE'EV SHER\*

## I.

Copyright problems of developing countries have been discussed extensively of late. Great efforts have already been made to find solutions to these problems and more are planned for the future.

Concessions concerning the level of copyright protection which developed countries must grant under international agreements represent some of the most important steps taken by an international body for the benefit of the developing countries. The granting of concessions must be evaluated not only in the light of the assistance which developing countries have derived from such grants, nor in that of the relative weight such concessions bear to the total assistance which these countries receive, but rather because of their unique nature, in the light of each country being ready to donate not from the public chest but from property privately owned.

In Stockholm, the Protocol proposed for the benefit of developing countries, has been the subject of heated discussion. It remains as controversial as it was when originally proposed. Nobody can yet predict which solution will be satisfactory in reconciling two conflicting premises: the sanctity of private rights in copyright and the need to assist a major part of mankind as yet unable to acquire for full consideration what it needs.

## II.

Most of the laws in this field which have come to my attention are somewhat similar, "having seen one, you have seen all". Take the two Model laws prepared by international bodies — one for Africa and one

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\* Deputy Attorney General, Israel. This paper does not represent in any way the position of the Government of Israel, but the author's views only.

for Asia, since the major principles can be drawn from them. One soon discovers that basically contemporary developments have not advanced much beyond principles which have existed for centuries. Let us look briefly at the copyright rules found in Jewish law, developed between the years 1000 B.C. and 600 A.D.

Infringement of copyright was recognized in Jewish law in the time of Jeremiah.<sup>1</sup> "Therefore, behold, I am against the prophets, saith the Lord, that steal my words every one from his neighbour".

To this general prohibition there has been added a positive rule that "he that tells a thing in the name of him who said it, brings deliverance unto the world".<sup>2</sup> And so also it has been said that the words in Proverbs "rob not the poor, because he is poor", refer to copyright infringement.<sup>3</sup>

The legal concept on which the protection of copyright was based is to be found in the basic rule of trespass stated in Deuteronomy:<sup>4</sup> "thou shalt not remove thy neighbour's landmark". Early Jewish legal literature contains many reflections on the sanctity of copyright in general and the moral right in particular. So long as printing was not known, it seems that the "remedy" was only a moral one, since no real pecuniary damage could result. Since the discovery of printing, books in Hebrew usually include a preface by one or more scholars, which in fact constitutes an authorization to print and a prohibition to copy. Thus, by the 15th century, the reproduction right had already been recognized.<sup>5</sup> The basic rules of copyright, the right of reproduction and the moral right, formed the basis of the Jewish law of copyright as it still does with refinements and qualifications.

More challenging and rewarding than the systematic study of copyright laws of the developing countries is an investigation into their needs in relation to the international copyright system and the response of that system to those needs.

### III.

Once again the Bible provides us with a basic principle.

"Ye shall do no unrighteousness in judgment, thou shalt not respect the persons of the poor, nor honour the persons of the mighty; but in righteousness shalt thou judge thy neighbour".<sup>6</sup>

1. XXIII, 31.

2. The Jerusalem Talmud, Sanhedrin, XI, 5.

3. Midrash Tanchum, on the Book of Numbers, para 22; Abot VI, 6.

4. XXII, 22.

5. This "consent", as the Hebrew term has it, is not peculiar to Jewish law, since approbations by various organs of the Church are also evidenced.

6. Lev. XIX, 15.

This same idea is reflected in Article 7 of the Universal Declaration of Human Rights.<sup>7</sup>

“All are equal before the law and are entitled without any discrimination to equal protection of the law. All are entitled to equal protection of the law. All are entitled to equal protection against any discrimination in violation of this Declaration and against any incitement to such discrimination”.

I sometimes wonder whether or not the special concessions concerning the protection of copyright in developing countries are not in violation of Article 7, because of the Art. 29(2) of the Declaration, which states: “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”.

A prima facie case for this can be made by showing that certain special provisions included in the Protocol regarding developing countries, forming part of the Berne Convention as revised at Stockholm in 1967, enable them to derogate from existing rights granted to copyright owners within their jurisdiction.<sup>8</sup>

The question is whether in fact the special needs of developing countries justify the measures already taken, or yet to be taken, and whether there are alternative means, which will avoid the establishment of different standards.

Any study of the special needs of the developing countries and the legal order best fitted to provide for these needs forces us to examine carefully some of the accepted principles of the international copyright system, in order to reconcile these with such special needs, while at the same time trying to legislate in a manner which will afford all authors equal treatment everywhere.

#### IV.

When speaking about developing countries, two questions arise: —  
1) What country should be considered a developing country? 2) What

7. Proclaimed by the General Assembly of the United Nations on December 10, 1948.

8. According to a list prepared by BIRPI — 20 countries (see Document DA/29/2 submitted to the extraordinary session of the Permanent Committee which took place in Paris, February 3-7, 1969) are already entitled to apply special rights.

are the needs of such a country in copyright matters? I do not intend to dwell on the first question, although I recall that possibly more time was spent at Stockholm debating it than in examining whether the special treatment established in the Protocol would really serve its purpose. Any attempt to solve the problem by exact legal criteria is, I think, doomed to fail. Whether a country is to be considered a developing one is, in my opinion, a political question to be decided accordingly. Contrary to others, I find it difficult to perceive how the issue will be settled in a scientific manner.

I would also like at this juncture to express doubt whether the list submitted in February 1969 by the Director of BIRPI to the Paris meeting of the Permanent Committee of the Berne Union is conclusively binding.<sup>9</sup> It is, in my opinion, questionable whether BIRPI should at this stage have taken the initiative to present such a list at all. The diplomatic conference clearly rejected a proposal to prepare a list and deferred the matter.<sup>10</sup> I do not believe that the presentation of the list served any useful purpose. Not all the countries listed will apply the special rights, while others not included therein still maintain that they are developing countries, according to the "established practice of the General Assembly of the United Nations". If a country so contends, no real sanction against it exists, and the International Court of Justice is the only competent court to decide whether any country is in violation of its obligations under the Convention.<sup>11</sup>

I submit that the question should always be who is needy, and whether there is any justification for the grant of aid, rather than the establishment of abstract criteria or the fixing of a charity list in advance.

What I propose here is that the tests are whether or not the justified need of a country cannot be satisfied because of obstacles created by copyright, and whether objectively that country is able to overcome these obstacles. It is easy to argue that certain countries, which have a very low per capita national income and are, as a rule, in the category of "developing countries", are also needy in copyright. Some evidence of this may be found in the final report of UNESCO's meeting of experts on book production and distribution in Asia, which took place in Tokyo, 25-31 May, 1966. There it was stated:<sup>12</sup>

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9. The list is Annex III to Document DA/29/2 submitted to the extraordinary session of the Permanent Committee which took place in Paris, February 3-7, 1969.

10. DA/29/11, para 21.

11. See Art. 33 and 36 of the Berne Convention as revised in Stockholm.

12. UNESCO's Document MC/55, para 18.

“With a population of about 910 million people in 1964, or 28% of the world total, the eighteen countries of the Asian region<sup>13</sup> produced 29,790 book titles<sup>14</sup> – or 7.3% of the estimated world titles. This represented only 32 book titles per million population, as against a world average of 127, or an average for Europe of 418. Of this about 10% were translations, half from English.

In 1964, the Asian region produced an estimated 128 million copies, or only 2.6% of the world total (5 billion copies) or about 4,300 copies per title. This is, of course, a very low figure and resulted in comparatively high book production costs”.<sup>15</sup>

At the same time, 27 to 37 million books were imported to the region annually at a value of approximately 20 million U.S. dollars. The need of the area was not in books alone, but also in the means for producing them. Printing machinery costing 18 million dollars and paper (for all purposes) costing 80 million dollars have also been imported.

Reducing the above figures into another form, we find that the supply of books was about 32 pages per capita, or, about one thirtieth to one sixtieth of that of the major book publishing countries. Concurrently, the need in the Asian countries has been 125 pages per capita in schools alone. This shortage is manifested in part not only by a high illiteracy rate and low purchasing power of the population but also in the high reliance on imports, shortage of foreign currency and difficulties in developing a book industry.

Unless something drastic is done, the shortage will grow. The population of this region by 1980 is estimated to reach 1 billion 370 million, 40% being of school age. Unfortunately, however, schooling will presumably only reach 285 million if the 103 million in 1962 is to be taken as a guide.

During the period 1970-1980, it is also estimated that the supply of school books per capita will be:

	1970	1975	1980
In school education .....	175	203	233
Literacy campaign .....	59	34	11
	<u>234</u>	<u>237</u>	<u>244</u>

13. In fact only Northeast Asia was considered and the countries are: Afghanistan, Burma, Cambodia, Ceylon, Taiwan, India, Indonesia, Iran, Republic of Korea, Laos, Malaysia, Mongolia, Nepal, Pakistan, Philippines, Singapore, Thailand, Republic of Vietnam.

14. Including non-periodical publications of at least five but not more than 48 pages.

15. Figures are not supplied for languages of publications, nor of the subject matters or fields.

At the same time, an expansion of printing capacity is also required, and the demand for paper will increase as well. Economic standards will also probably increase the need for more contemporary copyright material to a higher ratio than in the past.<sup>16</sup> Financing this enormous need is difficult and aid will be necessary.

A more gloomy picture exists in certain regions of Africa.<sup>17, 18</sup> The annual book production in 1964 was about 1,310 titles — or six titles per million inhabitants. In fact, only 20 out of the 34 countries of the region produced any books at all. Out of these, seven countries produced less than seven titles annually, and only five produced more than a hundred titles per year. The average number of copies per title was estimated at approximately 8,200 books; if pamphlets are excluded, this figure would be reduced to 5,600.

This yields a total of 7.3 million copies annually or 34 copies per thousand inhabitants, and of books only thirty copies per thousand, or one-thirtieth of a book per person per year, which may be contrasted with 7.7 books in the United Kingdom, 6.2 in the USSR and 5 in France. World book production in 1964 was estimated at five billion copies; Africa's share was only 1.5% whereas its share of the world's population is 9.4%.

The low level of book production makes this region largely dependent on book imports, and statistics show that about 24 million books are imported annually, three times the number of books produced locally.

The problem of the region is neither limited to shortage of books, nor to means of producing them. It exists also in people who can contribute material. I do not mean writers alone but also translators.

There is an increasing insistence in countries which have recently gained their independence on the use of local language. Research by UNESCO has also shown a lack of good translators. Experts have concluded that a "contact language" for each country is necessary. Once such a language is introduced, reproduction problems come to the fore. As has been indicated above, Africa suffers more than most from book shortage. "Contact languages" would here prove insufficient. UNESCO experts have observed that the simplest — although not always effective —

16. UNESCO's Document COM/CS/3/7.

17. *Ibid.*

18. For this purpose, the African region includes the following 34 countries: Botswana, Burundi, Cameroon, Central African Republic, Chad, Congo (Brazzaville), Democratic Republic of Congo, Dahomey, Ethiopia, Gabon, Ghana, Guinea, Ivory Coast, Kenya, Kesothis, Liberia, Madagascar, Malawi, Mali, Mauritania, Niger, Nigeria, Senegal, Sierra Leone, Somalia, Swaziland, Tanzania, Togo, Uganda, Upper Volta, Zambia.



means of providing books for Africa in local language is by translating already existing texts, with adaptive additions necessary for local use and needs.

Apart from problems of book production, the need for copyright material exists also for other means of communication and expression. It has been stated on many occasions that the need for broadcasting material is the most pressing. This is a matter of major importance. In addition to its use for political and general information purposes, the radio is a vital medium in mass campaigns in agriculture, health, education and the like.

Developing countries not only have a shortage of the equipment and material — newsprint, printing and broadcasting equipment, raw film stock and filming equipment, to build a mass communications system, but also, once again, necessary material the free use of which is precluded by copyright rules.

It has been argued that it is not so much the payment of royalties which constitutes the evils of copyright but the consuming administrative process involved. Suggestions have been made that for the time being publishers in developed countries should simply forego their royalties. It has also been suggested that publishers might consider producing lists of books for which translation rights are sought or could be available. A clearing house could be set up to handle the matter informally. Under international organization a reduction in fees might also be negotiated.

Such a project does not normally form the subject of discussion. Instead we are more concerned with amendment of the existing legal framework and the reduction of financial burdens.

Definitions are unnecessary for those who wish to cooperate. Rather than determining what is a developing country, may I make the following proposals on the far more crucial question of need. The needs of one country may be evaluated by comparing it with other countries, having particularly in mind educational and cultural requirements.

## V.

To ease the difficulties encountered by developing countries in obtaining copyright three main courses are available:

- 1) The actual grant of the necessary rights and in many cases also the physical carrier. The latter may be books supplied under a grant in aid program, television films and radio programs under an exchange program, or the coupon system initiated by UNESCO. More sophisticated programs of this kind require the creation of national or inter-

national funds to compensate copyright owners, the establishment of a clearing house for copyright and the making of grants of material assistance to meet the particular needs of each of the requesting countries.

2) The elimination of existing copyright in certain countries, within a given legal order. By this, of course, is meant the Protocol annexed to the Berne Convention in Stockholm, and possibly also the proposed amendment to the Universal Copyright Convention, which has been forwarded for examination to a sub-committee of the International Committee of the Universal Copyright Convention.<sup>19</sup>

3) The creation of a special international law in copyright for the developing countries. How this will link up with the existing order binding all developed countries (except the U.S. and the U.S.S.R.), is, to say the least, unclear.

Let me now examine the various present arrangements and their impact on the needs of the developing countries.

It seems proper to start with the Protocol to the Berne Convention, clearly the most controversial of the acts for the benefit of the developing countries. Having already some indication of the effects of its adoption, we can to a certain degree predict its future. Briefly, the provisions of the Protocol are as follows:

(a) The term of protection of copyright can be reduced from the life of the author and fifty years after his death to 25 years after death. Where the term is fixed by the Convention itself to fifty years only, it is reduced 25 years. The term of protection of photographic works and works of applied art can be reduced from 25 years to ten years.

(b) The term of translation may be shortened from the whole term of copyright protection under the Convention to ten years, unless the author provides a translation in the language in which protection is claimed. This reduced ten-year term may be further reduced since a compulsory license for translation may be obtained three years after publication.

(c) Three years after publication a compulsory license may be obtained for production of any work for educational and cultural purposes, unless the work has been published in the country where the license is requested "in the original form in which it was created". Copies produced under the compulsory license may be imported into another developing country.

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19. IGC/XR/8, Annex A.

(d) Exclusive right for the authorization to broadcast literary and artistic works is granted only if the broadcast is for profit-making purposes.

(e) Copyright protection may be reserved for teaching, study and research in all fields and education. The owner of the copyright is entitled to compensation which conforms to the standard of payment made to national authors and is subject to national currency regulations, while in other cases (Art. I(c)) the author may be entitled to a just compensation.

Certain questions arise in connection with the Protocol which do not find any solution in the Convention itself. These questions concern the interpretation of the rules of the Convention as such, and the inter-relationship with other international obligations.

## VI.

1) The demand for the special term of protection was originated by the African study meeting on copyright, held in Brazzaville in August 1963.<sup>20</sup> The 1964 study group on the proposals of the Berne Convention revision explained that the then existing compulsory minimum term of protection was too rigid for developing countries<sup>21</sup> and a protocol was submitted to substitute for Art. 7 of the Brussels text the provisions of Art. 7 of the Rome Convention of 1928. The latter contains no compulsory provisions on the terms of protection but provides that unless all countries adopt a uniform term, the term shall be regulated by the law of the country where protection is claimed and must not exceed it. This course was abandoned by the 1965 Study Group and the principle of Art. IV of the U.C.C. was adopted, excluding application to countries which have yet to adopt a term of protection based on the life of the author. In this respect, it must be noted that the only change suggested was in *term* of years after death and not in the general principle of copyright protection.

Does this reduction in time serve any useful purpose, other than making the Berne Convention Protocol conform to the U.C.C.?

2) The second concession to developing countries is to minimize the right of translation. Judging by actual needs, this is the most important concession that could be granted to developing countries. It clearly gives them the right to translate works into their own national

20. See Doc. S/1 – Proposals for Revising the Copyright Provisions, submitted to Stockholm, A. 69.

21. See also BIRPI's Document 871 – Draft African Model Copyright Law, p. 18.

language as a matter of urgency. But is the method adopted most beneficial to these countries and just to the owner? The right of translation is in principle recognized by the developing countries. Under the Protocol, a non-exclusive license to translate is available three years from publication. If the author himself does not publish a translation, his right ceases; if a compulsory license has previously been granted, his right to remuneration also ceases. Thus, unless a translation by or on behalf of the owner is published within ten years, the right of translation is in the public domain.

Altogether apart from the author's moral right, it is my impression that under these conditions both translator and publisher will seek agreement with the author in order to protect themselves. The result is that only at the expense of a developing country's scarce foreign currency resources and with the goodwill of the author can the translation right have any economic meaning for the translator whose services are on many occasions scarce and insufficient. Accordingly, we have to look for an inducement to translate rather than to the right itself, and this is not to be found.

The relationship between the U.C.C. and the Protocol is also relevant here. Art. V of the former provides that compulsory translation may only be effected seven years after publication and certain moral rights are preserved. Apart from the possibility of obtaining an earlier compulsory license to translate, the Protocol takes us back to 1896, and to Art. 5 of the Berne Convention as revised in Paris. Can this right be exercised by countries which are members of the U.C.C.? The answer is, of course, in the affirmative but only as between such of them as are members of the Berne Union, because in their mutual relations the U.C.C. does not apply, as provided for in the Annexed Declaration to the U.C.C. The right, however, does not exist among U.C.C. members as such, nor is it proposed at present.

A further point needs to be made concerning the report of Main Committee II of the Stockholm Conference. Paragraph (b) states:

"Article 5 of the Paris Convention of 1896 merely stipulates that the publication of such a translation must take place in a country of the Union. The translation must be published in the country invoking the resolution concerning the translation license. Publication does not mean printing in the strict sense. This is an essential distinction for countries that do not possess even the technical means needed to publish translations or reproductions under the conditions laid down by the additional protocol".<sup>22</sup>

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22. S/301, para 14.

With due respect I am not sure whether all this reflects the Protocol. Under sub para (i) of paragraph 1(b) which deals with translation, it is necessary, in order to maintain translation rights in any given country, to publish the work in the national language of that country in any one of the countries of the Union. If understood correctly, the publication under the license might not be effected in the country granting the license, but only in any other country, provided that copies of the translation are offered to the public. In other words, there is no necessity that the translation be printed within any one of the countries of the Union.

All agree that translation rights are vital to the developing countries — but does this provision assure their needs? It seems not, because it does not assure translation, the preservation of foreign currency, or the establishment and development of a local printing industry. Furthermore, rather than promoting a uniform system, it introduces a new one.

3) The third concession deals with reproduction rights for educational or cultural purposes within the developing countries.

The provision covers all kinds of literary or artistic works, and calculates the date of the grant of reproduction rights from time of publication. Publication means the manufacture of copies and their offer to the public. But is a license for films, broadcasting material, etc. within the provision? Are these also not necessary for developing countries?

Difficulties also arise from the terms used. What is meant by the words [“that the literary and artistic work] had not been published in the original form in which it had been created”, as a condition precedent for the grant of a compulsory license? Do they include the manuscript, the negative film, or the first recording, or rather the form of first real publication?

In the light of these difficulties of interpretation, it is doubtful whether this provision will ever be invoked. It is also doubtful whether the provision conforms to the U.C.C. and thus whether it does not introduce further points of difference. It is true that the U.C.C. does not include any provision concerning reproduction right. Until the recent version such a general provision did not appear in the Berne Convention either, an omission which did not prevent member countries from recognizing such a right as a fundamental one on which copyright is based. If I may quote from the preparatory document to the Stockholm Conference:<sup>23</sup>

23. S/1, p. 41.

“ . . . the study group reached the conclusion, in its 1964 Report, that a provision on the right of reproduction should be proposed. This prerogative has a fundamental place in the legislation of countries of the Union, the fact that it is not recognized in the Convention would therefore appear to be an anomaly”.

During the 1965 preparatory discussion, doubt had been expressed as to necessity and desirability of incorporating the right in the Convention, and the report continues —

“ . . . One delegation noted in particular that the right of reproduction was already recognized implicitly in the Convention, by reason of the existence of a number of special provisions on the subject . . . ”

Therefore, in explaining the program of the Conference, the report stated —

“The deliberation at the 1965 Committee of Governmental Experts showed, however, that there was a growing interest in widening the scope of the list, in the Convention, of the rights granted to the author, and that it was now considered desirable in many countries that this fundamental right of the author should be recognized *de jure conventionis*. Doubts have frequently been expressed concerning the proposals made in this connection, but they seem to have been due primarily to defining in the Convention the exceptions that would have to be made to the general right of reproduction . . . ”

If the right of reproduction existed from the very beginning of copyright, then of course we have to ask whether or not this right exists implicitly in the U.C.C. It is my contention that it does and therefore the introduction of paragraph 1 (c) of the Protocol, as well as paragraph 1 (e), should be considered as a setback to an international copyright system. Obviously the right cannot be applicable in countries which are members of the U.C.C., unless a special provision is introduced to this effect. This requires some explanation.

The U.C.C., it is to be assumed, includes reproduction rights for the following reasons. According to its preamble members of the U.C.C. “were moved by the desire to assure in all countries copyright protection”, and Article 1 provides:

“Each contracting state undertakes to provide for the adequate and effective protection of the rights of authors and other copyright proprietors in literary, scientific and artistic works . . . ”

Now if this only refers to rights recognized specifically in the Convention, it would hardly be worth mentioning. It must therefore be that in substance the duty to protect fundamental rights is part of the undertakings in the Convention. This interpretation is also supported by the introductory remark by UNESCO's representative at the Geneva Conference, who stated:

"Article I . . . specifies the duty which is incumbent upon the states to protect literary and artistic works effectively . . ."

How can anyone say that effective protection does not include, in the first place, the right of reproduction? Prof. Bodenhausen, then of the Netherlands delegation, also indicated that the text could be improved by the omission of the author's prerogatives.<sup>24</sup> Let us also remember the summing up by the president:<sup>25</sup>

"It was considered that these rights (guaranteed by Article 1) should include those given to authors by civilized countries but that an enumeration was dangerous, *because it might be read limitively*". (italics added).

Thus paragraph 1(c) grants very little to developing countries, first because of its lack of clarity as to the conditions precedent to its operation, and secondly, because it goes far beyond the rights and obligations of the U.C.C. and therefore discriminates against U.C.C. members.

4) Paragraph 1(d) of the Protocol should be commended for its clarity. Generally the rights of copyright owners extend to all uses of works in broadcasts made for profit-making purposes. This provision can also be justified in light of the needs of the developing countries to expand their broadcasting services as one of the main means of education.

5) There is no doubt that the most controversial provision of this very controversial document is paragraph (e) of Article 1. This authorizes a developing country

"to reserve the right, exclusively for teaching, study and research in all fields of education, to restrict the protection of literary and artistic works, provided due provision shall be made by domestic legislation to assure to the author a compensation which conforms to standards of payment made to national authors; the payment and transmittal of such compensation shall be subject to national cur-

24. Records, p. 135, No. 114.

25. Records, p. 14.

rency regulations. Copies of a work published pursuant to reservations under this paragraph may be imported and sold in another country of the Union for purposes as aforesaid, if that country has invoked the said reservations and does not prohibit such importation and sale.

“Where the foregoing conditions do not exist, the importation and sale of such copies in a country of the Union which cannot take advantage of the Protocol are prohibited in the absence of agreement of the author or his successors in title”.

No indication exists as to the nature of the restriction and the point at which it removes the rights of protection. It should be noted, however, that the compensation provision indicates that in fact the right should exist but that the owner is prevented from enforcing it. In other words, the real purpose of this paragraph must be to grant a compulsory license for educational use and no more. If this is the case, what does the provision add to the other concessions granted under the Protocol (the limitation of the term of protection and the right to grant compulsory licenses for reproduction) if not the right only to reproduce, translate and adapt works immediately upon their publication, provided that the material is used for teaching, study and research in one of the fields of education. If this is correct, then despite contrary arguments this concession is indeed justified in light of the special needs of the developing countries.

I have, however, long been puzzled why this special concession had to be concealed or disguised by general terms. The report of the Committee<sup>26</sup> does not clarify the matter in stating that:

“A new possibility for restriction open to domestic legislation has been adopted for uses destined exclusively for teaching, study and research in all fields of education. It should be noted that the reservation does not apply solely to the right of translation and reproduction; it may also be invoked equally for the other uses of literary and artistic works . . . In addition the words ‘in all fields of education’ and the exclusivity of the purposes for which the reservation can be utilized, indicates that industrial or commercial research or research of the same nature is outside the scope of this reservation”.

Unfortunately, this is too vague an explanation of an ambiguous provision. What are the uses and activities in a developing country which cannot be considered of an educational nature?

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26. S/301, para 19.



It seems that this provision will either have a limited use only or be abused, without allowing any compulsory recourse to any forum that can judge the nature of the Act.

6) Apart from the specific problems touching each of the Concessions some general problems exist:

- a) Can the concessions be applied to works which have been protected in the past by any country that will enforce or adopt the protocol?
- b) What is the term of the concessions? It seems that it is either ten years or as long as a State is a developing country, since by extending its choice to more than ten years a developing country will be able to apply the Protocol until it ratifies the next act. Is this really compatible with the idea that this Act meets a special need and does not solve all the problems of developing countries?

## VII.

What is the future of all the concessions described? The Stockholm Act provides two different forms for the adoption of the Protocol: ratification or accession to the Stockholm Act of the Convention in its entirety, or uniquely by way of a declaration that the Protocol is recognized or applied. The latter permits a developing country to declare that it intends to apply the Protocol, and a developed country to admit its application to work in respect of which it is considered under the Berne Convention to be the country of origin. Developing countries which apply the Protocol will be able to grant lower protection to those works originating in countries which have specifically admitted it. There is at present very little official information on this point. Until now only two countries have put life into the Protocol—Senegal, a developing country, and Bulgaria, a developed country. Three developed countries have indicated their intent to adopt the Protocol, Denmark, the Federal Republic of Germany and Sweden. Other countries have not yet come to any decision, notably those countries whose language serves as a “contact language” in the developing countries.

Adherence to the Protocol also presents difficulties. Any developing country which decides to adopt it will at the same time reduce the protection of its own material. This results from two undertakings entered into by every member of the Berne Union: to treat foreigners as it treats nationals; and to grant foreigners certain rights, according to the standard established in the text of the Convention to which it is a party. The Protocol only reduces the standard of obligations established

by the Convention, and does not affect the obligation to accord national treatment.

The first to be affected by any change in the legislation of a developing country will be that country's nationals, since books adapted for local education, language and culture have priority, followed by the need to create, translate or adapt for radio and television programs produced by people who have the required local knowledge and who will in many cases be local residents.

In this regard, the continuing need to establish a modern printing industry in most developing countries is also relevant. If no assurance exists that the industry can achieve economies of scale, what are the prospects of its being established? And because of the Protocol, no such assurance can be given.

The necessary conclusions from the foregoing are that although certain rules cater to the special needs of the developing countries and although the Protocol may be considered a contribution of high value to them, the uncertainty created by some unhappy drafting and the complications engendered by the general rules concerning the applicability of the undertakings under the Convention, make a wide application of the Protocol seem dubious. It is regrettable that doubt should exist whether the Protocol will foreseeably govern the standards of protection of copyright among members of the Berne Union which are developing countries.

As an alternative, it was proposed not many years ago to delete Art. 17(a) of the U.C.C., which states that

“Works which according to the Berne Convention, have as their country of origin a country which has withdrawn from the International Union created by the said Convention, after January 1951, shall not be protected by the U.C.C. in the countries of the Berne Union”.

According to a report submitted to the extraordinary meeting of the intergovernmental committee in Paris in February 1969,<sup>27</sup> opinion is divided on this matter. Finally, it was decided to convene a revision conference, the agenda of which will, inter alia, include the proposal to delete Art. 17, and a sub-committee has been established to study the various problems raised. These include:

- 1) Whether the suspension of the safeguard clause should be limited to developing countries, and, if so, how the latter should be defined;

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27. IGC/XR/2.

- 2) Whether the safeguard clause should be suspended indefinitely or for a specified period;
- 3) Whether a Berne Union member should be entitled to adjust the level of protection to that offered by a developing country under the suspension;
- 4) Whether any link between the Berne Union and the Universal Copyright Convention could or should be substituted for the safeguard clause; and
- 5) The majority necessary at a revision conference to revise the U.C.C., particularly Article XVII and the Annexed Declaration.

The sub-committee is expected to conclude its work soon and its report will constitute background material for the conference.<sup>28</sup>

In order to evaluate the effect of revision, I would like to offer the following remarks.

According to the latest available information, there are now 59 members of the Berne Union, of whom 35 are also members of the Universal Convention. These include four which are, according to BIRPI's opinion,<sup>29</sup> developing countries, out of a total of twenty such countries which are members of the Berne Convention.

On the other hand, the U.C.C. has 56 member states, of which 17 are developing countries, according to the same criteria.

The proposed revision is, in the first place, of interest to the twenty developing countries, which are at the moment members of Berne, because in fact Art. 17 of the U.C.C. and the annexed Declaration deal mainly with the interrelationship of members of the Berne Union themselves, while the U.C.C. excludes from its framework the relationship between Berne members as such. It may be asked therefore whether the annexed Declaration should really be regarded as part of the U.C.C. or whether it is not a special agreement among its Berne members, sanctioned by the U.C.C., and forming together with Art. 17 an agreement between the two Conventions. If the latter is the case, is not a special meeting of Berne members who are also members of the U.C.C. necessary in order to agree to the proposed change?<sup>30</sup>

Apart from the legal difficulties connected with the possible amendments, there are also problems of time. Since the Universal Convention does not include any provisions concerning the procedure of a Revision Conference, and no precedent exists in relation to the coming into force

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28. IGC/XR/8, Annex 8.

29. As indicated above, this opinion has no binding effect.

30. This and similar agreements are brought forward by Doc. DA/29/3.

of the amendments passed, some considerable time may elapse until these come into operation in the countries which accept and ratify them.

Even if ratified and in force among some members of the U.C.C. (who may indeed be members of the U.C.C. alone), what will the effect be as between such members of the U.C.C. and those which are still bound by the original version? The system adopted by the Berne Union regarding the relationship between members not bound by the same text, may not help here. The Berne Union provides norms which may give different levels of protection or permit discrimination, whereas the U.C.C. provides mainly rules as to relationships. To establish relationships at least two parties must agree. Thus, in addition to the opposition which may arise to U.C.C. members regulating the relationship between Berne members, practical difficulties will exist in making the proposed deletion of the Berne safeguard clause really attractive which is the key to the long-awaited solution to the special needs of the developing countries.

The obligation to observe lower standards of protection will obviously ease the burden of the developing countries but it will not relieve them entirely from the burden since also under the U.C.C. the right of translation exists for a longer period than under the Protocol, and even the latter provides a minimum term to cater for the immediate needs of the developing countries.

For all these reasons the course taken is, it is submitted, not one which will settle in short order the copyright problem of the developing countries.

Whenever the Protocol has been criticized for its lack of clarity or the uncertainty of its rules, the reply has been that it must be accepted as a well balanced compromise having regard to the interests of all concerned. This reminds me of the story about the man who gave his wife money to buy a pair of shoes. The wife could not decide whether to buy high-heeled shoes or flat ones. After discussing the matter with her husband, they decided that having been invited to an important reception she should buy high-heeled shoes appropriate to such an occasion. Still not being certain, she again discussed the matter with her husband and they decided that since she took long walks daily, flat shoes would be a better purchase. The wife remained doubtful and finally the husband advised her to buy one of each kind. On returning home after buying the shoes she complained that she was limping. "Well", her husband replied, "every compromise limps".

The fate of the Protocol seems to be decided, and this is presumably also true of the amendment to the U.C.C. Unless some unforeseen power

intervenes the latter will be adopted but apparently never come into general force and effect.

A third course has, however, now been broached and a committee set up by the Berne Union and the U.C.C. together, to seek a way to merge the two. That, however, will take some time.

### VIII.

Because of the pressing needs of the developing countries, direct legal action seems to me to be self-defeating, since the rules to be observed preclude immediate and general application of the concessions or aid which the developed countries are ready to grant under the existing circumstances to the developing countries. Other means must therefore be developed to give immediate relief. Two have been suggested: the direct grant and the establishment of a new international copyright regime which will replace the two existing systems and be acceptable to all parties. The idea of direct grants has been accepted in principle by the Stockholm Conference in adopting Resolution No. II, which recommended to the International Bureau of the Berne Union a study of ways and means for creating financial machinery to ensure fair and just returns to authors whose works are used for the benefit of the developing countries. The same course has now been suggested by American book publishers, who have proposed the following means for its implementation:<sup>31</sup>

- a. grant of translation rights at minimal terms;
- b. grant of reprint rights in developing countries;
- c. offer of low-priced books to the developing countries;
- d. aid in training activities aimed at the development of indigenous publishing houses in the developing countries.

In my opinion not enough has been done to establish international order for the grant of aid, and it would be of more value at this stage to put greater effort into international activity in this direction.

Within the framework of the competent international organizations, I would suggest the setting up of an institute whose duties would include, *inter alia*,

- 1) the assembly of copyright material necessary for developing countries to carry out their educational, scientific and cultural programs of development;

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<sup>31</sup>. Suggested during the Extraordinary Session of the Permanent Bureau in February 1969, see pages 17-17 (Rev.) of Document DA/29/11.

- 2) the transfer of copyright to the needy;
- 3) to compensate — or coordinate the payment of compensation to — authors;
- 4) grant of aid for the purpose of establishing publishing houses and printing establishments;
- 5) coordination of the transfer of the various funds accruing in respect of activities connected with the purposes of the proposed institute;
- 6) establishment of translation services, the training of translators and publication of translations;
- 7) establishment of teams for the adaptation of teaching books, and other material for local use in the developing countries and coordination of publication and sales.

One can envisage the mode of operation of such an institute under the auspices of one or more international organizations:

- 1) A council, representative of the participating states and the international associations of authors, publishers, producers of phonograms and motion pictures, and broadcasters, to lay down standards, define requirements and determine procedures.
- 2) A governing body elected by the council to coordinate activity and establish and maintain necessary connections between users, owners and suppliers.
- 3) The actual work could be carried on by local bodies, either national or regional, approving the requests, ordering translations, adaptations and publications according to the rules set by the council and having in mind the means available for allocation, such as copyright, printing facilities and the service of qualified personnel. The local bodies would work in close cooperation with local education services, broadcasting bodies, cultural establishments and bodies of a similar nature.

How will all these activities be financed? First, it is hoped that some of the needs will be supplied free of charge.

Secondly, the necessary foreign currency to import low-priced books will be provided through the governing body, using either the UNESCO coupon scheme or making the necessary arrangements with the IMF or similar bodies.

Further financing might come from the developed countries either by direct contribution or with the close cooperation of the local pro-

ducers and publishers by collection of participation fees from all income arising out of exploitation of copyright, in the form of stamps affixed to books, records, cinema and theatre tickets, and a percentage of income arising from royalties on public performances, broadcasts, etc. The money so collected need not be transferred abroad but could be used to compensate local owners of the copyright in the works used, translators, publishers exporting low-priced books, or producers of phonograms, slides, etc. reproduced locally.

Who will benefit from the scheme? Of course, every developing country, but the term still requires definition. In my opinion, standards may be established according to:

- a) rate of illiteracy in excess of 25% of the population;
- b) local printing below a fixed number of pages per capita and number of titles;
- c) number of students in primary and secondary schools and institutions of higher learning.

Such standards might be determined triennially according to a survey made by UNESCO.

A program of this kind could be set up within two years and begin to be carried out well before any of the copyright conventions could be of benefit to all developing countries equally, without discrimination, according to their actual needs and in all important respects.

It lies with all concerned to come together and set up the machinery. There are always difficulties in executing such programs and many natural and artificial obstacles will be encountered, but these can be overcome once we all realize that only by aiding the needy, can one aid oneself.

One further observation. If a scheme like the one proposed is established, then of course certain rights, now granted to developing countries, can be transferred to the institute, empowered by its charter to acquire reproduction, translation, adaptation, performance and broadcasting rights. Accession to the institute might ipso facto involve the grant of rights and the undertaking of obligations necessary to implement the program.

Once such an institute is established, we could cease to speak about aid, assistance, granting and reserving, and instead about true cooperation, participation and sharing. Only then can we hope to reach the stage of being a family of nations living together with greater understanding and regard for one another, and with less hatred, suspicion and ignorance.

What I have said will possibly not meet with general approval. The solution proposed attempts to avoid political and legal complications, such as we sometimes like to create. I do not presume that any system that can be devised is perfect and I am quite aware of the defects of what is proposed here. There have been occasions when even the Queen's Judges, who carry justice in their breasts, have admitted their fallibility. When Queen Victoria opened the new Royal Courts of Justice in the Strand, the Judges prepared a draft memorial of greeting which included the words: "We, Your Majesty's Judges, mindful as we are of our imperfections". Lord Jessel rejected this proposal, saying that if he was mindful of his many imperfections, he ought not to be a judge. And admirable compromise was suggested by Lord Justice Bowen, which said "mindful as we are of each other's imperfections". I hope, however, that any criticism I have advanced has been constructive. There is always room for improvement in our institutions.

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183. RECENT DEVELOPMENTS IN INTERNATIONAL  
COPYRIGHT

*The Paris Meetings of February, 1969*

By BARBARA A. RINGER\*

These brief remarks are intended merely as an introduction to the reports and resolutions adopted by the Intergovernmental Copyright Committee of the Universal Copyright Convention and the Permanent Committee of the Berne Union at their extraordinary sessions held in Paris, February 3-7, 1969. However, at least to one who was there, the reports seem more revealing for what they don't say than for what they do. It would be hard to realize from a reading of the reports what an important corner in international copyright was turned at Paris last winter.

Stated in a very broad and oversimplified way, the major results of the Paris meetings can be summed up under four headings:

1. *U.C.C. Revision.* It was apparent before the Paris meetings even started that a decision to prepare for revision of the "Berne safeguard clause" of the Universal Copyright Convention would be taken by the Intergovernmental Copyright Committee. A coalition had been formed before the meetings, consisting of a number of developing countries, who are seeking U.C.C. revision as an alternative to the Stockholm Protocol of the Berne Convention, and of key developed countries, who look on relaxation of the safeguard clause as the best way to kill off the Protocol. Efforts to raise technical objections or to point out the dangers of this approach were entirely futile, and it therefore became very important to insure that the preparations for U.C.C. revision are thorough and are carefully coordinated with other activities in the international copyright field.

2. *Stockholm Protocol.* Someone said toward the end of the Paris meetings that the Stockholm Protocol Regarding Developing Countries died on Monday morning, February 3, 1969, and was buried that afternoon. Glib and superficial as that statement obvi-

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\* Assistant Register of Copyrights. The views expressed here are the author's own, and do not reflect the official position of the Copyright Office or the Department of State.

ously is, the tendency of practically everyone at Paris to regard the Protocol as a dying if not dead duck was too clear to be ignored.

3. *Long-Range Solutions.* The willingness of the United States to make its program for a fundamental restudy of the current international copyright situation complementary rather than alternative to U.C.C. revision greatly increased support for the study program. There was general acceptance of the premise that, with the failure of the Stockholm Protocol and the immediate possibility of U.C.C. revision, a hard over-all look at where international copyright is going is essential. The establishment of an International Copyright Joint Study Group was accomplished without opposition.

4. *Atmosphere and Leadership.* In marked contrast to recent meetings in this field, the Paris sessions were held in an atmosphere of cooperation and good will that was as gratifying as it was unusual. The meetings also marked the reemergence of France and the continued emergence of the United States as leaders in international copyright matters. Without minimizing the difficulties that lie ahead of us during the next few years in this field, one cannot be blamed for hoping that they will be reduced as a result of the clear air of Paris.

The program established at Paris for the rest of 1969 is formidable indeed.

1. *Subcommittee on U.C.C. revision.* In late June a special subcommittee consisting of representatives from six countries, including the United States, will meet in Paris "to examine the issues raised by the proposals for the revision of Article XVII and its Appendix Declaration." Along with issues involving the scope and duration of any suspension of the Berne safeguard clause, the subcommittee was asked to consider "whether any link between the Berne Union and the Universal Copyright Convention could or should be substituted for the safeguard clause." The subcommittee is to report to the next regular meeting of the Intergovernmental Copyright Committee in December, 1969, and is also to provide its report for the information of the Joint Study Group to meet in October. Immediately before the subcommittee meets, the Berne Permanent Committee will hold an extraordinary session to consider these issues.

2. *Joint Study Group.* The Intergovernmental Copyright Committee and the Berne Permanent Committee, acting jointly, estab-

lished "a group for the study of the entire situation of international relations in the field of copyright," which will hold its first meeting in Washington, September 29-October 3, 1969. The terms of reference of the Joint Study Group are very broad, but as a matter of priority it is to consider three matters specifically: (1) the establishment of international clearinghouse arrangements for the benefit of developing countries; (2) the practical copyright problems of developing countries and methods for solving them; and (3) "the problems arising from the existence of two copyright conventions of world-wide scope and possible methods for providing links between them." The Washington meeting will be closed, and will be limited to representatives from 26 specified countries, the secretariats, and four observers. It will report to the regular December sessions of the governing committees of the U.C.C. and the Berne Union.

3. *The Intergovernmental and Berne Committee Meetings.* The regular sessions of the IGCC and the BPC next December will have before them the reports of both the subcommittee on U.C.C. revision and the Joint Study Group. The Paris session specifically decided "that the Intergovernmental Copyright Committee, at its next regular session, shall fix the date for the meeting for revision of Article XVII of the Universal Copyright Convention and of the Appendix Declaration relating thereto and shall proceed with preparations for that conference, taking into consideration the results of the subcommittee established hereunder." The two governing bodies are also called upon to "make the necessary decisions for the continuation of the Joint Study Group."

It is worth noting that both the U.C.C. subcommittee and the Joint Study Group are to study possible new links between the Universal and Berne Conventions and to report their findings and recommendations to the December meetings. New trends seem certain to emerge during 1969, and the gloomy atmosphere that descended after the Stockholm Conference in 1967 may be lifting. If this proves true, the Paris meetings of February, 1969, can be considered an important turning-point in international copyright protection.

#### I. REPORT ON THE MEETINGS OF THE INTERGOVERNMENTAL COMMITTEE ALONE (IGC/XR/10, MARCH 29, 1969)

1. The Intergovernmental Copyright Committee established under Article XI of the Universal Convention met in extraordinary session at Unesco Headquarters in Paris from 3 to 7 February 1969.

2. The twelve Member States of the Intergovernmental Copyright Committee were represented: Brazil, France, Federal Republic of Germany, India, Italy, Japan, Kenya, Mexico, Spain, Switzerland, United Kingdom, United States of America.

3. The following States, parties to the Universal Convention or members of the United Nations or Unesco, were represented by observers: Afghanistan, Algeria, Andorra, Argentina, Austria, Belgium, Canada, Ceylon, Chile, Costa Rica, Czechoslovakia, Denmark, Finland, Guatemala, the Holy See, Ireland, Israel, Laos, Madagascar, Monaco, Morocco, Netherlands, New Zealand, Nicaragua, Nigeria, Peru, Philippines, Portugal, Romania, Senegal, Sweden, Thailand, Tunisia, Turkey, Uruguay, Yugoslavia.

4. Representatives of three intergovernmental organizations, twelve international non-governmental organizations and three national non-governmental organizations took part in the meeting as observers.

5. The list of participants is annexed to the present report (Annex C).

6. Mr. Ribeiro (Brazil), Acting Chairman of the Intergovernmental Copyright Committee, declared the session open and expressed his most cordial wishes for the success of its work.

7. Mr. Saba (Assistant Director-General for International Standards and Legal Affairs, Unesco) extended a warm welcome to all members and observers on behalf of the Director-General, Mr. René Maheu. He noted that the current session of the Intergovernmental Committee was of special importance, since it was the first time that the Committee had been called upon to carry out the responsibilities delegated to it under the Universal Convention in regard to the revision of that instrument.

8. He emphasized the complexity of the present situation of international copyright, pointing out that a major cause was that the use of works of the mind played an essential part in development.

9. In conclusion, Mr. Saba remarked that the results of the meeting would undoubtedly have an influence on the future development of international copyright.

10. Professor Bodenhausen (Director of the United International Bureaux for the Protection of Intellectual Property) (BIRPI) expressed his pleasure at being present in an advisory capacity at the meetings of the Intergovernmental Committee, in accordance with the provisions of the Universal Convention. He thanked the Director-General of Unesco and his staff for their kind welcome.

1. *Composition of the Bureau pending the next regular session of the Intergovernmental Committee*

11. The Committee took note of the resignation of its Chairman, H.E. Mr. Cippico, who had been called upon to take up other duties (document IGC/XR/4).

12. Following statements by the representatives of Argentina, Italy, Mexico, Spain, United Kingdom and United States of America, Mr. Ribeiro, Acting Chairman of the Committee, was elected Chairman.

13. Mr. Ribeiro paid tribute to the masterly skill and efficiency with which H.E. Mr. Cippico had presided over the Committee.

14. H.E. Mr. Charpentier (France) joined in the tribute paid to H.E. Mr. Cippico, and welcomed Mr. Ribeiro as Chairman for the current session.

2. *Adoption of the final agenda*

15. The Intergovernmental Committee adopted the following item for its agenda:

“Communication from the Director-General of Unesco concerning comments from States parties to the Universal Copyright Convention with regard to the revision of Article XVII of the Convention”.

3. *Revision of the Universal Copyright Convention*

16. The Secretariat of the Committee presented the report on this subject (document IGC/XR/2) containing comments by 31 States parties to the Universal Convention, regarding the desirability of revising Article XVII of the Convention in the light of the consultation carried out by the Director-General of Unesco in pursuance of resolution 5.122 adopted by the General Conference at its fourteenth session.

17. Professor Bodenhausen (Director of the United International Bureaux for the Protection of Intellectual Property, BIRPI) raised two interlocutory questions:

- (i) the definition of the respective spheres of competence of the General Conference of Unesco and the Intergovernmental Copyright Committee. He pointed out that the Intergovernmental Committee was not a Unesco body and should proceed independently in its study of the question of revising the Universal Convention;

- (ii) the legal validity of the requests for revision made by at least ten States parties to the Convention. In that connexion he drew the Committee's attention to the provisions of Article XII of the Universal Convention whereby the convening of a conference for revision might be either mandatory, if requested by at least ten States or, failing ten requests, left to the discretion of the Committee.

18. The representative of India observed that there was no set formula for presenting requests for revisions and that the inference undoubtedly was that replies in favour of convening a conference for revision were legally valid requests.

19. The observer from Argentina, while agreeing with the representative of India that there was no set formula for requests for revision of the Universal Copyright Convention, expressed the view that the legal validity of the replies forwarded to the Director-General of Unesco should be examined.

20. The representative of Spain considered that the questions raised by the Director of BIRPI were fundamental. He explained that the Government of Spain, for its part, was in favour of convening a revision conference but was not making a formal request to that effect.

21. The observers from Czechoslovakia, Kenya, Monaco, Nigeria, Peru and Yugoslavia informed the Committee that their governments were formally requesting that a revision conference be convened.

22. The observer from Chile stated that his government not only agreed with the proposed revision of the Universal Convention but was expressly requesting that revision.

23. The representative of France, for his part, thought that the Intergovernmental Committee should take into account the unanimous stand of the General Conference of Unesco in favour of the revision of Article XVII of the Universal Convention. The stand taken by the Conference carried sufficient weight for the Committee to regard the convening of a revision conference as a necessity.

24. The representative of the United States of America endorsed the statement of the Director of BIRPI concerning the respective spheres of competence of the General Conference of Unesco and the Intergovernmental Copyright Committee.

25. He further suggested that a working group be set up to examine the legal validity of the requests for revision of the Universal Convention.

26. The representative of the Federal Republic of Germany seconded the suggestion made by the representative of the United States of America.

27. The representative of Italy said that the Intergovernmental Committee was not competent to interpret the comments made by the States parties to the Convention. He approved of the idea of setting up a working group to examine the replies received by the Director-General of Unesco. He suggested that should any doubt remain as to the legal validity of the replies sent by the governments, the Unesco Secretariat should consult the various governments concerned to ascertain whether or not they requested the convening of a revision conference.

28. The representative of the United Kingdom, while not against the establishment of a working group to examine the replies made by States parties to the Universal Convention, wished to know whether the said group would be in a position to interpret such replies.

29. The observer from Ceylon, after recalling the antecedents of the matter before the Intergovernmental Committee, expressed the view that the comments made by the States parties to the Universal Convention constituted formal requests for revision.

30. The observer from Madagascar endorsed the view of the observer from Ceylon.

31. The observer from the Union of National Radio and Television Organizations of Africa reminded the meeting of the position of the African countries and emphasized that for those countries the revision of Article XVII of the Universal Convention was a matter of urgency.

32. The observer from Tunisia thanked the representative of France for having recalled that resolution 5.122 had been adopted unanimously by the General Conference of Unesco which implied that more than ten States were asking for the convening of a revision conference. He drew the Committee's attention to the difficulties of the developing countries, which might find themselves unable to remain parties to any conventional system for the protection of copyright for want of an appropriate solution.

33. At the close of this exchange of views, the Chairman of the Committee noted that there was almost a consensus in the Intergovernmental Committee that a conference should be convened to revise the Universal Convention. He further concluded that since no one had spoken against it, the Committee wished to convene a revision conference.

34. When the discussion was resumed, the representative of France expressed the view that it was important for developing States to be able to take advantage of the protection guaranteed by the Universal Convention. He recalled that the Committee had decided, at its previous session, to convene a revision conference. He considered that a sub-committee, set up under Rule 16 of the Rules of Procedure of the Intergovernmental Committee, might be entrusted with the preparations for the revision conference, whose terms of reference would be limited to the amendment of Article XVII and the Appendix Declaration relating thereto and would not extend to the clauses of substantive law.

35. The representative of the United States of America expressed satisfaction at the Committee's decision to revise the Universal Convention and mentioned that his delegation was submitting a resolution on the subject with a view to implementing that decision. In the resolution it was proposed, in particular, that a sub-committee be set up in accordance with Rule 16 of the Intergovernmental Committee's Rules of Procedure to examine the following points:

- (1) Whether the suspension of the safeguard clause should be limited to the developing countries and, if so, how that term should be defined;
- (2) Whether the safeguard clause should be suspended indefinitely or for a specified period of time;
- (3) Whether a Berne Union member should be entitled to adjust the level of protection to that offered by a developing country under the suspension;
- (4) Whether any link between the Berne Union and the Universal Copyright Convention could or should be substituted for the safeguard clause;
- (5) The majority necessary at a revision conference to revise the Appendix Declaration.

36. The sub-committee so formed should meet before the Joint Study Group mentioned in resolution 59 (IX) of the Intergovernmental Committee, to which the results of its discussions might be transmitted.

37. The observer from Romania expressed the opinion that Resolution 59 (IX) of the Intergovernmental Copyright Committee should constitute the basis for the work to be done by the Joint Study Group.

38. The observer from Tunisia recalled that at the previous meeting of the Committee, general agreement had been reached on the desirability of convening a conference to revise the Universal Conven-



tion. He drew the Committee's attention to Articles XI and XII of the Convention, laying down the procedure for preparing for revision conferences, and giving the Intergovernmental Committee sole competence in the matter. He also referred to the terms of resolution 5.122 adopted by the General Conference of Unesco at its fifteenth session, authorizing the Director-General to take appropriate steps, firstly to enable the competent bodies to examine the possibility of revising Article XVII of the Universal Copyright Convention and secondly, to set up a joint study group to examine any other changes it might seem necessary to introduce into that instrument.

39. The representative of Kenya submitted a draft resolution proposing the convening of a conference to revise Article XVII of the Universal Convention and the setting up of a sub-committee appointed under Rule 16 of the Rules of Procedure of the Intergovernmental Committee, which would be responsible for preparing for the conference. While acknowledging that it was for the Committee to decide on the membership of the sub-committee, he proposed that it should consist of representatives of the following States: Brazil, France, India, Italy, United States of America.

40. The observer from Morocco referred to the unanimous vote on resolution 5.122 of the General Conference of Unesco and emphasized the importance to be accorded to it, in view of the fact that the Universal Convention had been drawn up and adopted under the auspices of Unesco. He added that as the revision of Article XVII of the Universal Convention would make it possible to prevent developing countries from withdrawing from any system for the protection of copyright, it should be of service to the Berne Union and the Universal Convention alike.

41. The representative of India agreed with what had been said by the representative of Kenya and the observer from Tunisia.

42. The representative of the United Kingdom appreciated the excellent reasons for modifying Article XVII and the Appendix Declaration relating thereto, but considered it necessary to proceed with caution and to examine that question in conjunction with all the other problems raised in connexion with international copyright.

43. The representative of Mexico seconded the remarks of the representative of the United Kingdom.

44. The representative of the United States of America reminded the Committee that the draft resolution prepared by his delegation took the needs of the developing countries into account.

45. The representative of Italy recalled that his government, when consulted by the Director-General of Unesco in compliance with resolution 5.122 of the General Conference, had stated in its reply that it was in favour of a revision limited exclusively to Article XVII and he explained that the reply should be interpreted as a formal request for revision within the meaning of Article XII of the Convention.

46. At the close of its deliberations, the Intergovernmental Committee set up a Drafting Committee comprising the following States: France, Federal Republic of Germany, India, Kenya, Mexico, United Kingdom, United States of America.

47. The Chairman of the Intergovernmental Committee, being a member *ex officio* of the Drafting Committee, was unanimously elected as its Chairman.

48. The Drafting Committee prepared a draft resolution which was adopted by the Intergovernmental Committee and which is annexed to the present report (Annex A).

49. The Committee having been informed that Tunisia's accession to the Universal Convention was imminent, decided on the basis of a proposal initiated by France and supported by Senegal, that should the Convention have come into force for that State by the time of the meeting of the sub-committee appointed under Rule 16 of the Rules of Procedure of the Intergovernmental Committee, Tunisia would be authorized to attend the sub-committee meetings as an observer.

50. The representative of Italy inquired which Member States on the sub-committee had spoken in favour of revising Article XVII of the Universal Convention.

51. The Assistant Director-General for International Standards and Legal Affairs replied that of those States, India and Kenya had asked for the text to be revised.

52. The representative of France stated that his government also was in favour of revision.

53. Resolution 1 (XR) was unanimously adopted.

#### 4. *Other business*

54. The other items on the Agenda of the Intergovernmental Committee were discussed at a joint meeting with the Permanent Committee of the Berne Union.

REPORT ON THE MEETINGS OF THE PERMANENT COMMITTEE ALONE (DA/29/11, FEBRUARY 7, 1969)

1. The Permanent Committee of the International Union for the Protection of Literary and Artistic Works (Berne Union) hereafter referred to as "The Permanent Committee" met in extraordinary session from 3 to 7 February 1969 in Paris, at the Headquarters of Unesco, which had extended its hospitality to the Committee because of the fact that an extraordinary session of the Intergovernmental Copyright Committee was being held there at the same time.

2. The twelve States members of the Permanent Committee were represented: Belgium, Brazil, Denmark, France, Germany (Federal Republic), India, Italy, Portugal, Roumania, Spain, Switzerland, United Kingdom.

3. Representatives of the following States, being members of the Berne Union, parties to the Universal Copyright Convention or Members of Unesco, were present as observers: Afghanistan, Algeria, Andorra, Argentina, Austria, Canada, Ceylon, Chile, Costa Rica, Czechoslovakia, Finland, Guatemala, Holy See, Ireland, Israel, Japan, Kenya, Laos, Madagascar, Mexico, Monaco, Netherlands, New Zealand, Nicaragua, Nigeria, Peru, Philippines, Senegal, Sweden, Thailand, Tunisia, Turkey, United States of America, Uruguay and Yugoslavia.

4. Observers had also been sent by three intergovernmental organizations, twelve international non-governmental organizations and three national organizations.

5. The list of participants is appended to this report (Annex C).

6. In the absence of the Chairman, H.E. Ambassador Tristram Alvise Cippico (Italy), the Vice-Chairman of the Permanent Committee, Mr. Jorge Carlos Ribeiro (Brazil) opened the extraordinary session and, stressing the importance of the matters on the agenda, hoped that the discussions would be fruitful.

7. Professor G.H.C. Bodenhausen, the Director of BIRPI, wished the Permanent Committee every success in carrying out the work to be done during the extraordinary session.

8. Mr. H. Saba, representing the Director-General of Unesco, also expressed his good wishes and welcomed the Permanent Committee on behalf of his Organization. He reminded the meeting that it was not the first time that this Committee and the Intergovernmental Copyright Committee had had occasion to co-operate in studying the problems of international copyright.

9. The Director of BIRPI then informed the Permanent Committee of the Chairman's resignation and pointed out that the Internal Rules (Rule 9) provided a possible basis for a solution in the event of there being no Chairman.

10. On the proposal of the Italian delegation, seconded by the delegation of the Federal Republic of Germany, the Permanent Committee unanimously invited Mr. Jorge Carlos Ribeiro (Brazil), the Vice-Chairman, to act as Chairman.

11. In accordance with Rule 7(3), of the Internal Rules of the Permanent Committee, the International Bureau of the Berne Union (BIRPI) was responsible for the secretariat of the debates.

12. After adopting its agenda, the Permanent Committee proceeded to consider the items on the basis of the working papers prepared and distributed by BIRPI.

13. The Permanent Committee was convened in extraordinary session at the request of the Director of BIRPI, for the special purpose of helping him in formulating the advice which he might be called upon to give to the Intergovernmental Copyright Committee on the revision of the Universal Copyright Convention with respect to matters of concern to the Berne Union (in particular, the amendment of Article XVII of the said Convention and the Appendix Declaration relating thereto).

14. As these matters relate essentially to the protection of copyright in developing countries, the Director of BIRPI first submitted to the Permanent Committee the present results of the inquiry he had carried out, in pursuance of the resolution adopted at the 13th ordinary session (Geneva, December 1967), on the intentions of States members of the Berne Union with regard to the application of the Protocol Regarding Developing Countries, annexed to the Stockholm Act of the Berne Convention.

15. Having considered these replies, the Permanent Committee heard a number of supplementary statements from States which had not yet replied to the above-mentioned inquiry.

16. Mr. de San (Belgium) said that, in his country, the ratification of international instruments was a prerogative of the legislature and that the question would therefore have to be put before the Belgian Parliament. He added that the problem of revision of the Universal Convention seemed to him to be linked with the entry into force of the Protocol and that, in the circumstances, the Belgian Government

would not be able to define its position until the results of the work of the joint study group which was to be set up were available.

17. Mr. Stoenescu (Roumania) said that his country's instruments of ratification of the Convention establishing the World Intellectual Property Organization and of the Stockholm Act of the Paris Convention (industrial property) would shortly be deposited. He added that the Protocol and the Stockholm Act of the Berne Convention were under consideration and that information regarding the situation would be given as soon as possible.

18. Mr. Weincke (Denmark) explained that the Danish Government had not yet come to a decision and it was the Danish Copyright Council which had come out in favour of a declaration of application of the Protocol.

19. The Permanent Committee then studied the report of the Director of BIRPI on the consultations he had had with the United Nations Secretariat concerning the definition of "a developing country in conformity with the established practice of the General Assembly of the United Nations" (Article 1 of the Protocol). It emerged from these consultations that the criterion suggested was based on the idea of assessments of Member States and the relaxation from the obligation to pay them. A list of States benefiting from such exemption had been sent by the Secretariat of the United Nations to the Director of BIRPI. The Director had submitted it to the Permanent Committee as a list of countries which might be considered developing countries within the meaning of Article 1 of the Protocol.

20. Mr. Laurelli (Argentina) noted that his country and certain other Latin American countries were not included in the list; he hoped that the criteria of the United Nations Conference on Trade and Development (UNCTAD) would be adopted in preference to the other system, in view of the relationship which exists between social and cultural problems and economic problems. The Chairman of the Permanent Committee pointed out, however, that such a proposal had been expressly rejected by the Stockholm Conference.

21. After taking note of the report of the Director of BIRPI, the Permanent Committee decided, on the proposal of its Chairman, to keep the question of the definition of developing countries on its agenda and, in particular, to reconsider it at its next ordinary session.

22. Having thus examined the matters directly connected with the Protocol adopted at Stockholm (intentions of Member States concerning its application; criterion for determining which countries were

to benefit from it) the Permanent Committee then studied the report of the Director of BIRPI concerning a possible revision of Article XVII of the Universal Copyright Convention and the Appendix Declaration relating thereto, the problems which it involved and its possible consequences.

23. Mr. Balakrishnan (India) was worried about the delay in the entry into force of the Stockholm Act of the Berne Convention and feared that the revised Act of the Universal Convention would suffer the same fate. The delaying tactics adopted by certain countries in regard to ratification seemed to him regrettable.

24. Mr. Chakroun (Morocco) reminded the meeting that the developing countries were mainly importers of intellectual works; he deplored that the Stockholm revision had not achieved its purpose owing to failure on the part of the advanced countries to ratify it. He hoped that there would be a change in attitude, to avoid the world becoming divided into two opposing groups.

25. Mr. Chaudhuri (India) emphasized the extent of the developing countries' needs, particularly for low-priced educational literature. He thought that the solution lay not in importing books, but in legal measures such as those established at Stockholm. He also drew attention to the problem of regional languages, in connection with the translation of scientific and educational books. He suggested, however, that not only should Article XVII of the Universal Convention be revised, but provisions similar to those of the Stockholm Protocol should be introduced into that Convention. He did not believe that there was any grounds for the fears of the developed countries concerning the Protocol, since its application would not mean that every book would be reproduced; what could be translated and reproduced should be clearly defined and specified. In his opinion, copyright did not have absolute force and should be subjected to certain restrictions for the purpose of aiding the developing countries in their national education and advancement policies. In conclusion, he hoped that the spirit which had reigned during the drawing up of the Stockholm Protocol would be preserved in the future.

26. Mr. Charpentier (France) stated that his delegation felt that revision of Article XVII of the Universal Convention was justified all the more so since the ratification of the Stockholm Protocol was encountering difficulties.

27. Mr. Laurelli (Argentina) recalled that the developing countries still had full freedom to decide what their international relations con-

cerning copyright should be; he felt that a close examination of the general situation was necessary, with particular reference to the relations between the two Conventions and the need to avoid clashes in matters of jurisdiction as well as the vulnerability of copyright. He pointed out that while his country was still in favour of an amendment to the provisions of the Universal Copyright Convention such an amendment should be introduced only after a thorough study had been made of the whole range of problems which were arising at the present time with regard to copyright protection in order to avoid any confrontation between poor and rich countries.

28. Mr. Ulmer (Federal Republic of Germany) stated that his Government had submitted the Stockholm Act of the Berne Convention, in its entirety, to its Parliament for ratification; the Parliament has not yet made its decision. His view was that, if that Act entered into force, revision of Article XVII of the Universal Convention was not necessary, as the Protocol would be sufficient. However, in view of the hesitancy in that respect apparent in certain developed countries, the wish to revise the Universal Copyright Convention was understandable. Mr. Ulmer considered that such a revision might impair the universal scope of the Berne Union. He reminded the meeting that, for the Intergovernmental Copyright Conference in Geneva in 1952, the establishment of the safeguard clause (Article XVII) had been a question of substance and that the preamble to the Universal Convention expressly mentioned the desire of States not to impair the Berne Convention. He suggested that if the link between the two Conventions defined by Article XVII were ended, it would be advisable to replace it by another; the revision should be studied in the general context, having regard to the problems as a whole, with the object of ensuring better development of international copyright.

29. Mr. Archi (Italy) reiterated that the Italian Government was favourable towards a revision, limited solely to Article XVII, of the Universal Copyright Convention. He underlined the fact that the present situation was different from that in 1952 (Geneva Conference), because at that time the idea of developing countries did not exist.

30. Mr. Fernandez de la Mora (Spain) expressed himself along the same lines as the delegate of Italy.

31. The Director of BIRPI stressed the indisputable relationship between the revision of Article XVII of the Universal Convention and acceptance of the Stockholm Protocol. It did not seem to him that there was undue delay between signature and ratification of the latter; in

many countries, the decision was subject to Parliamentary procedure; many interests and problems were, moreover, involved, and one group of countries would delay its decision until it knew what another group was doing, and vice versa. The Director of BIRPI also drew attention to the need for developing countries to enact legislation prior to the implementation of the Protocol. He informed the Permanent Committee that, in order to make the situation more flexible, it was planned to prepare certain models which would show how the Protocol might be applied so as to satisfy the various categories of interests involved.

32. The Director of BIRPI also drew the Permanent Committee's attention to the differences that appeared to exist among the countries in favour of a revision of the Universal Copyright Convention, and to the problems to be solved: To what extent should the Universal Copyright Convention be revised? Which provisions could be amended? What procedure should be followed? What kind of relationship should there be between the two Conventions? He suggested that the Permanent Committee should hold a joint meeting with the Intergovernmental Copyright Committee in order to set up the proposed study group, and that this group should then come to a decision, within the limits of its competence concerning the revision of the Universal Convention.

33. The Chairman noted, in conclusion, that no general opinion of the Permanent Committee had been recorded, but that a number of views had been expressed.

34. Following the meetings of the Intergovernmental Copyright Committee on its own, and the adoption of a resolution establishing a sub-committee to examine the issues raised by the proposals for the revision of Article XVII of the Universal Copyright Convention and its Appendix Declaration, the Director of BIRPI informed the Permanent Committee of his intention to ask the Chairman to call an extraordinary session of the Committee immediately before the meetings of the said sub-committee. The purpose of this extraordinary session would be two-fold: on the one hand to assist the Director of BIRPI in the advice he will be called upon to give to the sub-committee on the issues included in its mandate; and on the other hand to designate the two States members of the Permanent Committee to attend the meetings of the sub-committee as observers.

35. Mr. Ulmer (Federal Republic of Germany) supported the proposal of the Director of BIRPI and emphasized that it would be necessary for the Permanent Committee to formulate its advice on the issues to be considered by the sub-committee which were of direct interest to the Berne Union.



36. The Chairman of the Committee, noting the agreement of the Committee on this proposal, declared that it was so decided.

REPORT ON THE JOINT MEETINGS OF THE PERMANENT COMMITTEE AND OF THE INTERGOVERNMENTAL COPYRIGHT COMMITTEE (IGC/XR/10; DA/29/11)

37. After separately examining such questions as solely concerned their respective terms of reference, the Committee met together to consider what action should be taken in pursuance of resolutions 3 and 59(IX), adopted respectively by the Permanent Committee of the Berne Union and by the Intergovernmental Copyright Committee at their ordinary sessions held in December 1967, concerning the setting up, composition and terms of reference of a joint study group on international copyright.

38. The United States representative stated that suggestions so far made under existing international agreements to meet the needs of developing States had produced nothing definite, and that short-term and long-term solutions must be envisaged. International copyright agreements should not simply protect, but also facilitate the utilization of intellectual property. The joint study group should therefore give priority consideration to the immediate problems and to the needs of the developing countries; its terms of reference should be based on the resolutions 3 and 59(IX), adopted by the two Committees in 1967, and it should report back periodically to the Chairman of the Committees.

On behalf of American publishers, he read out a statement referring to the main problems and the publishers' interest in finding solutions for them. This statement is annexed to this report (Annex B).

He invited the joint study group to hold its first session in Washington from September 29 to October 3, 1969.

39. The representative of France recalled that States were hesitant about ratifying the Stockholm Protocol, which did not seem to have justified the hopes placed in it. The establishment of a joint study group should ensure a coherent approach to current problems in international copyright, provided that its terms of reference were as broad as possible and that a comprehensive examination was made of international copyright relations, for a twofold purpose: to find a legal framework that would take care of the needs of the developing countries and, on the model of the Berne Convention, to ensure a high degree of protection for the products of intellectual creativity. It should fix its own method of work. The qualified representatives of authors should be associated with its deliberations.

40. The representative of Italy supported the United States proposal to set up a joint study group, but recalled that the group should not discuss the revision of Article XVII of the Universal Convention and the Appendix Declaration relating to it.

41. The representatives of Kenya and Mexico agreed with the representative of Italy.

42. The representative of France also agreed. The terms of reference of the joint study group should not concern the revision of Article XVII of the Universal Copyright Convention. France was very much in favour of there being two Conventions.

43. The representative of the Federal Republic of Germany also supported the United States proposal. The two essential questions for examination by the group were the relations between the two existing copyright conventions, and the relations between advanced and developing countries. It seemed to him that the revision of Article XVII of the Universal Convention was also a matter that affected the relations between the two Conventions.

44. The representative of Spain, agreeing with the last speaker, pointed out that there were not only legal and political aspects, but also economic; they should be discussed in the spirit of the Berne Union without prejudice to a right hitherto regarded as universal.

45. The Canadian observer stressed the urgency of solving problems which justified setting up the proposed group, whose terms of reference should be as wide as possible.

46. The United Kingdom representative suggested that one long-term aim of the study group might be to prepare a single Convention affording two different levels of protection, the level as regards the advanced countries being that of the Stockholm Act of the Berne Convention, excluding the Protocol.

47. The representative of India suggested that three points concerning international copyright were at issue: revision of Article XVII of the Universal Convention; matters, other than that revision, which were questions for the joint study group; and Unesco aid in setting up an information centre to provide some immediate way of dealing with the problems of the developing countries. Drawing up a third convention could easily hold up a solution of the existing problems and therefore India would be opposed to it.

48. The representative of Switzerland agreed with previous speakers that the terms of reference should be as wide as possible, but doubted whether the proposed timetable could be respected.

49. The Argentine observer endorsed what had been said by the representatives of the Federal Republic of Germany and the United States and urged that priority be given to examining relations between advanced and developing countries, so as to allow the latter easier access to intellectual property.

50. The representative of Belgium said that the United States proposal offered a promising basis for conciliation and a shared approach.

51. The representative of Denmark and the Swedish observer supported the United States proposal.

52. The observer from Monaco asked whether problems raised by satellite transmission should not also be considered by the group.

53. The Assistant Director-General for International Standards and Legal Affairs of Unesco and the Director of BIRPI informed the Committees of the activities envisaged on this subject by their organizations.

54. After the general exchange of views, the Committees discussed the composition and terms of reference of the joint study group.

55. On the basis of two proposals, regarding its composition submitted by the representatives of India and of Italy, the Committees agreed on the list of twenty-six States named in the resolution relating to the joint study group.

56. The Committees discussed the admission, as observers, of representatives of the interests concerned. The observers from the International Literary and Artistic Association, the International Confederation of Societies of Authors and Composers, the International Writers' Guild and the International Publishers' Association stressed the necessity of having those directly concerned represented at the meetings of the group.

57. Some delegates referred to the desirability of arranging for the representation also of users of property protected by copyright.

58. The Committees finally considered that the question of representation on the group of the interests concerned could be settled at the same time as the group's terms of reference.

59. The Committees set up a working group to draw up precise terms of reference, composed of representatives of France, Federal Republic of Germany, India, Italy, United Kingdom, United States, and

with the Chairman of the Committees as Chairman. The working group submitted to the Committees a draft resolution regarding the joint study group on international copyright.

60. When this resolution was adopted, the Committees were unanimous in specifying, in reply to remarks by the representative of Belgium, that the group was to be consultative in character.

61. During the discussions of paragraph 7(a) of the resolution, it was generally agreed that the studies concerning an international mechanism which would enable the developing countries to have easier access to copyrighted works should not bear for the moment on national or international financing procedures, which might have implications going beyond the specific problems of copyright.

62. The observer of Sweden proposed that under paragraph 7(b) a reference be made to the principles of the Stockholm Protocol. However, after a discussion, this proposal was withdrawn.

63. With regard to paragraph 7(c), the observers from Monaco and Tunisia were afraid that the terms of reference of the joint study group with regard to the methods which might be used in establishing links between the two existing Conventions might affect those of the Subcommittee set up under resolution No. 1(XR) to prepare for the revision of Article XVII of the Universal Convention.

64. The representative of the Federal Republic of Germany pointed out that, besides the question of a possible replacement of the special link of Article XVII of the Universal Convention and the Appendix Declaration by another link, there might be envisaged general links between the two Conventions which the joint study group could examine.

65. The Tunisian observer having raised the question where the joint secretariat of the study group would be located, it was explained that any communications could be sent either to Unesco or to BIRPI, each of these organizations undertaking to transmit immediately to the other any communications so received.

66. The Committees then adopted, each so far as it was concerned, resolutions Nos. 1 and 2 (XR), annexed to this report (Annex A).

67. The representative of France, speaking for all the participants, congratulated the Chairman of the Committees for the patience, competence and flexibility which he had shown in conducting the discussions. He also thanked the Secretariats whose assistance had contributed to the development of the work.

68. The representatives of the United States of America, India and Mexico joined in these remarks.

69. The Chairman thanked the participants for the work they had accomplished. He expressed his gratitude to the Committees for the confidence they had placed in him and observed that the results of the meetings could be considered as the beginning of a constructive period for the future of international copyright.

70. On behalf of the international nongovernmental organizations, the President of the International Literary and Artistic Association joined the congratulations addressed to the Committees and to their Chairman.

71. The Chairman then declared the extraordinary sessions of the Committees closed.

ANNEX A. RESOLUTION No. 1 (XR)

The Intergovernmental Copyright Committee,

*Considering* the request of a number of countries party to the Universal Copyright Convention to convene a conference for revision of the Convention;

*Taking note* of the fact that these requests were prompted by proposals for changes in the provisions of the Universal Copyright Convention with respect to its relationship to the Berne Convention for the Protection of Literary and Artistic Works;

*Recognizing* its duty, under Article XI of the Universal Copyright Convention, to make careful and thorough preparations for any revision conference;

*Decides* to convene a conference for revision of Article XVII of the Universal Copyright Convention and of Appendix Declaration relating thereto;

*Establishes*, in accordance with Rule 16 of its Rules of Procedure, a sub-committee to examine the issues raised by the proposals for the revision of Article XVII and its Appendix Declaration. The sub-committee is composed of the following members: France, Federal Republic of Germany, India, Kenya, Mexico, United States of America; the Chairman of the Intergovernmental Copyright Committee is *ex officio* member of the sub-committee; the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the United International Bureaux for the Protection of Intellectual Property may attend meetings of the sub-committee in an advisory capacity;

Czechoslovakia and two States members of the Permanent Committee of the Berne Union designated by the latter attend the meetings of the sub-committee as observers;

*Expresses the wish* that the following be included among the issues considered by the sub-committee:

- (1) whether the suspension of the safeguard clause should be limited to developing countries and, if so, how that term should be defined;
- (2) whether the safeguard clause should be suspended indefinitely or for a specified period of time;
- (3) whether a Berne Union member should be entitled to adjust the level of protection to that offered by a developing country under the suspension;
- (4) whether any link between the Berne Union and the Universal Copyright Convention could or should be substituted for the safeguard clause; and
- (5) the majority necessary at a revision conference to revise the Universal Copyright Convention and particularly its Article XVII and the Appendix Declaration relating thereto;

*Requests* that the sub-committee submit its report to the Intergovernmental Committee at the time of its next regular session and recommends that it communicate, as a matter of information, its report to the Joint Study Group established under resolution No. 2 (XR);

*Decides* that the International Copyright Committee, at its next regular session, shall fix the date for the meeting of the conference for revision of Article XVII of the Universal Copyright Convention and of the Appendix Declaration relating thereto and shall proceed with preparations for that conference, taking into consideration the results of the sub-committee established hereunder.

The documentation prepared by the Secretariat to be submitted to the next regular session of the Intergovernmental Copyright Committee shall include a report of the work accomplished at that time by the Joint Study Group established under resolution 59 (IX) of the Intergovernmental Copyright Committee;

*Instructs* the Chairman of the Intergovernmental Copyright Committee, in consultation with the Director-General of Unesco, to convene the sub-committee thus constituted.

## RESOLUTION NO. 2 (XR)

The Intergovernmental Copyright Committee sitting with the Permanent Committee of the International Union for the Protection of Literary and Artistic Works (Berne Union),

1. *Considering* the serious present and potential problems of multi-lateral copyright relations, considering the necessity of furthering the betterment of mankind as well as the urgent requirements of developing countries in the educational field and the impact of international copyright arrangements upon them, considering also the economic problems of domestic production and international exchanges of intellectual works;

2. *Recalling* that the Stockholm Conference on Intellectual Property (1967) has adopted the Stockholm Act of the Berne Convention including the Protocol Regarding Developing Countries, and noting that the Protocol has not been adopted by many of the Member States, and recalling resolutions 3 and 59 (IX) adopted by the Committees at their thirteenth and ninth sessions respectively, held in December 1967, as well as resolution No. 1 (XR) adopted by the Intergovernmental Copyright Committee at its present session;

3. *Establishes* a group for the study of the entire situation of international relations in the field of copyright, to be called the International Copyright Joint Study Group;

4. *Accepts* with appreciation the invitation of the representative of the United States of America to hold the first session of the Joint Study Group in Washington;

5. *Adopts* the following decisions concerning the duties and composition of the Joint Study Group, and its procedure during the period preceding the next regular sessions of the Permanent Committee and the Intergovernmental Copyright Committee;

6. The Joint Study Group may examine any questions concerning international copyright relations and their practical implications;

7. The Joint Study Group shall, as a matter of priority, deal with the following matters which will be included in the agenda of its first session:

- (a) the establishment of an international mechanism for permitting developing countries a greater degree of access to protected works while respecting the rights of authors;

- (b) the needs of developing and developed countries in the international copyright field, particularly that of education, the effect of the régime of international copyright relations on the satisfaction of these needs, as well as any improvements that could be made in this respect, taking into account the interests of authors with a view to encouraging the creation of intellectual works;
- (c) the problems arising from the existence of two copyright conventions of world-wide scope and possible methods for providing links between them;

8. The Joint Study Group shall consist of representatives of the following 26 States: Argentina, Australia, Brazil, Canada, Ceylon, Czechoslovakia, France, Germany (Federal Republic), India, Italy, Ivory Coast, Japan, Kenya, Mexico, Netherlands, Nigeria, Peru, Philippines, Romania, Senegal, Spain, Sweden, Tunisia, United Kingdom, United States of America, Yugoslavia.

9. The Joint Study Group shall have a joint secretariat furnished by BIRPI and Unesco;

10. The first session of the Joint Study Group shall be held in Washington from 29 September to 3 October 1969;

11. Governments of the States party to the Berne Convention, the Universal Copyright Convention, or both, and all interested international non-governmental organizations, are invited to communicate to the Joint Secretariat, before 1 May 1969, studies or proposals on any question within the competence of the Joint Study Group, particularly on the matters mentioned in paragraph 7 above;

12. The working documents for the first session of the Joint Study Group shall consist of:

- (a) the studies and proposals referred to in paragraph 11 above, and
- (b) any reports that the Secretariats of BIRPI and Unesco may wish to submit jointly or separately, including, if possible, documentation on the importance of copyright royalties in the economies of different States, particularly the developing countries;

13. The working documents shall be communicated to the members of the Joint Study Group preferably by 1 July 1969;

14. The Joint Secretariat shall convene a one-day information meeting of the interested international non-governmental organizations in



July or August 1969. At that meeting the Joint Secretariat shall invite the organizations represented to appoint a total of four persons, who shall be invited to attend the meetings of the first session of the Joint Study Group and to furnish such information or observations as may be requested by the latter. For this purpose the organizations representing authors shall be invited to appoint two persons, the organizations representing publishers shall be invited to appoint one person, and the organizations representing users of copyrighted works shall be invited to appoint one person;

15. The Joint Study Group shall appoint its officers and establish its Rules of Procedure as its first meeting;

16. The meetings of the first session of the Joint Study Group shall be closed;

17. The Joint Study Group shall report on the results of its first session and on its proposals as to its further work to the Permanent Committee and the Intergovernmental Copyright Committee at their next regular sessions. The two Committees shall, in the light of such report and any other relevant developments, make the necessary decisions for the continuation of the Joint Study Group, its procedures, and the representation of international non-governmental organizations.

## ANNEX B

### *Statement of American Book Publishers*

American publishers realize there are real and sufficient issues with which private enterprise and governments must quickly come to grips in order to implement policies which will balance the interests of copyright proprietors with the interests of users of copyrighted materials and, at the same time, give vigorous impetus to the dissemination of information and knowledge.

It is an historical and universally accepted fact that copyright protection and an international copyright structure have served as an important stimulus to authors and publishers in the creation of educational, scientific, and cultural works. It is also a matter of historical record that many American publishers, with the support of authors, have waived the generally accepted return on their efforts in order to assist developing countries in various ways, including:

(a) The granting of translation rights to thousands of titles at minimal terms.

(b) The granting of original language reprint rights for the publication of low-cost editions by publishers in developing countries.

(c) The publication of many low-cost editions which sell at a fraction of the U.S. list price.

(d) The participation in publishing and distribution seminars aimed at the development of indigenous publishing in developing countries.

That there can be improvements in certain areas is generally accepted.

American publishers recognize that any revision of existing copyright conventions will take time and they agree that, in the interim, greater recognition should be given to the needs of developing countries which are indeed continuing and urgent. The American publishers look forward to extending greater cooperation during the period when concerted and active efforts are also being made at the intergovernmental level to find long-range, coordinated solutions to the problem of international copyright.

American publishers are eager to facilitate clearances and contractual arrangements for both translations and reprints. To this end, they are prepared to encourage the establishment of an international clearing house. As envisaged, such a clearing house would cooperate actively with publishers in developing countries in order to:

(a) Facilitate the processing of simplified agreements in connection with the granting of rights for translations and original language reprints, at appropriate terms and conditions and with due consideration given to the stage of development and the particular needs of developing countries.

(b) Study with publishers in developing countries the various internal conditions inhibiting the development of indigenous publishing with a view towards extending financial and technical cooperation.

American publishers wholeheartedly support placing on the agenda the prompt study of the problems to which cognizance was given in the text of the resolutions adopted unanimously, at Geneva, in December of 1967 by the Intergovernmental Copyright Committee and the Permanent Committee of the Berne Union.

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## PART II.

**LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS**

## 1. United States of America and Territories

## 184. U. S. CONGRESS. HOUSE.

H.Res. 248. Resolution to direct the Committee on Interstate and Foreign Commerce to conduct an investigation and study of Federal regulation of community antenna television systems. Submitted by Mr. Sandman on February 17, 1969, and referred to the Committee on Rules. 2 p. (91st Cong., 1st Sess.)

Identical with H.Res. 84 of the same Congress, submitted by Mr. Van Deerlin on Jan. 3, 1969. See 16 BULL. CR. SOC. 168, Item 138 (February 1969).

## 185. U. S. CONGRESS. HOUSE.

H.Res. 284. Resolution to effect a thorough investigation of the rule-making functions of the Federal Communications Commission with reference to community antenna television. Submitted by Mr. Goodling, February 27, 1969, and referred to the Committee on Rules. 2 p. (91st Cong., 1st Sess.)

Identical with H.Res. 84, submitted by Mr. Van Deerlin on Jan. 3, 1969, and H.Res. 248, submitted by Mr. Sandman on February 17, 1969, in the present session of Congress.

## 186. U. S. CONGRESS. SENATE.

Convention establishing the World Intellectual Property Organization and Paris Convention for the Protection of Industrial Property—removal of injunction of secrecy. (115 *Congressional Record* p. S2730, no. 44, daily ed. Mar. 12, 1969.)

Senator Byrd of West Virginia receives unanimous consent that the "injunction of secrecy", be removed from Executive A, 91st Congress, first session, the convention establishing the World Intellectual Property Organization and the Stockholm revision of the Paris Convention, transmitted to the Senate by the President of the United States on March 12, 1969, that the conventions, together with the President's message be printed in the *Record*. In

his message, the President urges the Senate to give its advice and consent to ratification of the conventions.

187. U. S. CONGRESS. SENATE.

S. 766. A bill to amend the Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes. Introduced by Mr. McClellan (for himself and Mr. Scott), January 29 (legislative day, January 10), 1969, and referred to the Committee on the Judiciary. 6 p. (91st Cong., 1st Sess.)

A bill providing for a Federal law of unfair competition which is similar to a number of bills introduced in previous Congresses.

2. Foreign Nations

188. SINGAPORE. *Laws, statutes, etc.*

Copyright (Gramophone Records and Government Broadcasting) Act, 1968 (No. 47 of 1968); an act to provide penalties for the infringement of copyright in gramophone records and to exempt government broadcasting from infringement of copyright in musical works and in gramophone records. (5 *Copyright* 27-28, no. 2, Feb. 1969.)

This Act came into force on January 1, 1969.

189. TUNISIA. *Laws, statutes, etc.*

Decree regulating the administration of the moral and material interests of the authors and composers of Tunisia. (5 *Copyright* 14, no. 1, Jan. 1969.)

A decree setting up, pursuant to article 31 of the Tunisian copyright law, an author society with the exclusive right to act as an intermediary between the author and his heirs, and users or associations of users, for the granting of licenses and collection of royalties. And, this society "shall be lawfully substituted, as from publication of this Decree, for all other existing societies of authors and composers in the execution of outstanding contracts with users or associations of users in the territory of the Republic of Tunisia."

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PART III.

**CONVENTIONS, TREATIES AND PROCLAMATIONS**

190. INTERNATIONAL COPYRIGHT UNION.

The International Union on the threshold of 1969. (*5 Copyright* 8-11, no. 1, Jan. 1969.)

An annual survey of the events occurring in the preceding year which are of concern to the Berne Union.

191. INTERNATIONAL COPYRIGHT UNION.

State of the International Union on January 1, 1969. (*5 Copyright* 4-7, no. 1, Jan. 1969.)

The annual report of the Berne Bureau listing member countries and showing the revisions of the Berne Convention ratified by each, together with their reservations, as of January 1, 1969.

192. State of ratifications of and accessions to the conventions and agreements affecting copyright on January 1, 1969. (*5 Copyright* 20-21, no. 1, Jan. 1969.)

Covers the Rome Convention on Neighboring Rights, the Universal Copyright Convention, the European Agreement concerning Programme Exchanges by means of Television Films, the European Agreement on the Protection of Television Broadcasts and the Protocol to the said Agreement, and the European Agreement for the Prevention of Broadcasts Transmitted from Stations Outside National Territories.

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## PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## I. Federal Court Decisions

193. *Independent News Co., Inc. v. Williams*, 404 F.2d 758 (3d Cir., Dec. 4, 1968) (Seitz, J.). *For decision below, see* 273 F. Supp. 375 (D. Pa., 1967); *for decision on motion for preliminary injunction, see* 293 F.2d 510 (3d Cir., 1961), 8 BULL. CR. SOC. 372, Item 366 (1961), *affirming* 184 F. Supp. 877 (D. Pa. 1960).

Appeal from dismissal of complaint in action for permanent injunction against alleged conversion of literary property. Plaintiffs Superman, Inc. and National Comics Publications, Inc. are the publishers and copyright proprietor of certain comic books of which plaintiff Independent News Co., Inc. is the sole distributor to wholesalers who, in turn, distribute to retailers. Under plaintiffs' distribution scheme, at the end of the "sales period" of the comics all unsold copies were to be returned by the retailers to the wholesalers for credit. Under their contracts with Independent, the wholesalers were to forward only the covers of the returned publications to Independent, mutilate the remaining portion and dispose of the mutilated pages to purchasers who would agree to use same for waste only and not for resale. In 1960 plaintiffs sought a preliminary injunction against defendant, a seller of secondhand publications found to be selling plaintiffs' coverless comics, on theories of copyright and trademark infringement, conversion of literary property, invasion of privacy and unfair competition. The district court denied the motion upon its finding that defendant obtained the comics principally from wastepaper dealers (rather than plaintiffs' contract wholesalers) and the lack of any evidence that such dealers had in fact been placed under contractual restrictions against use for purposes other than waste or that, if they were so obligated, defendant had any knowledge of the restrictions. The Third Circuit affirmed. Shortly thereafter plaintiffs gave notice of the restrictions to all wastepaper dealers known to be purchasing the coverless comics from wholesalers and commenced stringent policing of the distribution system and obligations thereunder; it was also clear that after the 1960 hearing on the motion for temporary relief, defendant had actual notice of such restrictions. Seven years after

that hearing, the case came on for final disposition on the conversion theory alone and the trial court dismissed the complaint on the grounds that defendant's sources for plaintiffs' comics had "dried up" over the intervening years and the lack of any evidence that "defendant has purchased any of plaintiffs' coverless comics from wastepaper dealers or wholesalers, or solicited such purchases, for several years", thus rendering injunctive relief unnecessary. Jurisdiction was retained, however, in the event of any affirmative action by defendant to encourage others to violate their agreements with plaintiffs.

*Held*, affirmed in part.

The court held that the findings below were not clearly erroneous, adding that "where an injunction is sought against a practice which has already been stopped, the trial court's discretion in granting or denying it is necessarily broad, and it may consider many factors, such as the likelihood of repetition". Although the court below had made no specific findings regarding defendant's future intent, it was held to have acted within its discretion on the grounds that "it is a reasonable inference that the complained of practice cannot be resumed so long as plaintiffs continue policing the contracts". In affirming on this ground, the court assumed without deciding that the contractual restrictions could have been enforced against "a party not in privity but with knowledge thereof". The court concluded, however, that there was no basis for retaining jurisdiction because "the purported reservation goes to a claim which, if pleaded, which we doubt, was not decided by the district court, viz., inducing breach of contract".

194. *Tempo Music, Inc. v. Myers*, 407 F.2d 503, 160 U.S.P.Q. 707 (4th Cir., Feb. 27, 1969) (Craven, J.)

Defendant's appeal from judgment for plaintiff in action for copyright infringement. The trial court had awarded damages against defendant by reason of the unlicensed performance of plaintiffs' musical compositions (all ASCAP selections) at defendant's establishment. Although defendant had been solicited to take an ASCAP license he had declined to do so, instead requesting that ASCAP supply him with a list of the Society's compositions which he would then cause not to be performed. ASCAP did not accede to this request.

*Held*, reversed and remanded with instructions to enter judgment for defendant.

The court held that although the trial court's finding of infringement was amply supported by the evidence, plaintiffs were estopped

because of the failure of ASCAP, as their agent, to inform defendant that he could have requested the Society's advice as to whether specific compositions to be performed at his premises were in the ASCAP repertoire. This duty was derived by the court from the ASCAP anti-trust consent judgment. The court said:

Though . . . a listing [of the ASCAP repertory] was unquestionably requested [by defendant] we do not fault ASCAP<sup>4</sup> as agent of the defendants for its failure to supply it. Counsel advised us that the total listing of ASCAP songs fills three large volumes and, if furnished Myers, would not likely have been useful to him for the desired purpose. But without some help from ASCAP, Myers' position was impossible. Despite his expressed intention to avoid infringement, he could not possibly hope to do so except by the alternatives of (a) playing no music at his club or (b) paying what he regarded — rightly or wrongly — as an exorbitant licensing fee.

Pretrial order or not, we think the court below was presented by the testimony of Myers with a question of controlling importance: whether ASCAP had any duty to respond to Myers' request for a list of copyrighted compositions, and if so, what sort of response was required. We think the answer to this question is found in the Amended Consent Judgment of March 14, 1950, under which, we are advised by counsel, ASCAP now operates. Part of that anti-trust consent judgment provides as follows:

"XIV. Immediately following entry of this Judgment, defendant ASCAP shall upon written request from any prospective user inform such user whether any compositions specified in such request are in the ASCAP repertory, and make available for public inspection such information as to the ASCAP repertory as it has. Defendant ASCAP is furthermore ordered and directed to prepare within two years, and to maintain and keep current and make available for inspection during regular office hours, a list of all musical compositions in the ASCAP repertory, which list will show the title, date of copyright and the author, composer and current publisher of each composition."

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<sup>4</sup> Although ASCAP is not a party its counsel participated in the trial below and the hearing on appeal. The selection of the actual plaintiffs results from the pure accident of what the combo happened to play on the night of February 3, 1967, at the Gold Leaf Supper Club. Presumably on another night there would be different tunes offered the patrons, and a different set of plaintiffs would be selected thereby from the approximately 12,000 members of ASCAP.

ASCAP's conduct is, of course, to be imputed to its principals.



In oral argument, counsel for ASCAP urges what seems to be a reasonable solution to Myers' problem: that he should simply have sent a list of the Showmen Four's tunes to ASCAP, which would gladly compare the list with its own listing and promptly advise Myers which tunes could not be played without infringement. Significantly, ASCAP does not maintain, nor could it, that Myers *knew* this, for there is nothing in the record to support such conjecture, and Myers' testimony suggests the contrary. Without some knowledge that this service, now so cheerfully offered, was available, Myers could scarcely have availed himself of it.

We hold that ASCAP was under a duty to advise of its editing obligation under paragraph XIV of the antitrust consent judgment, and to advise that such service was available upon request, when a communication was made to ASCAP by Myers which could have been fairly interpreted as a request for aid in avoiding infringement. As ASCAP failed to comply with Myers' request for a listing of ASCAP compositions, and also failed to offer the editing service contemplated by the consent decree, we think it would be inequitable to permit these plaintiffs to recover for the infringement which occurred and which was caused and brought about, in part at least, by the dereliction of ASCAP in failing to facilitate Myers' expressed intention of avoiding infringement. Under such circumstances, we think these plaintiffs are estopped to assert infringement and ask for damages and counsel fees. To allow it would enable them to profit from the dereliction of their own agent, ASCAP. So to hold is merely an application of the ancient equitable doctrine of "unclean hands."

In an earlier footnote to its opinion, the court concluded that ASCAP's practice of supplying lists of its affiliated music companies to proprietors of various establishments (including defendant) in conjunction with the Society's system of "explaining" the copyright notice requirements to bandleaders was "ineffective as an explanation of how infringement might be avoided. . . ." The court said:

ASCAP's counsel explained that lists of music companies whose tunes were licensed through ASCAP were sent to *proprietors*; and that one was sent to Myers. Also, ASCAP's representative "went around and explained" to *bandleaders* that copyright law required that sheet music show the name of the company holding the copyright. Therefore, even if a band played by ear, it could go to a music store and find on the sheet music of tunes in their repertoire the names of the companies holding the copyright, compare those

companies with the list of companies sent to the proprietor for whom they were playing, and edit their own list to avoid infringement.

The problem with this method ASCAP employed to enable infringement to be avoided is that all of the critical information is not put into the same hands, and only a seemingly irrelevant part of it—a list of music companies—is put into the hands of the proprietor, who is often, as here, the party really threatened by an infringement suit. As a bandleader such as the leader of the Showmen Four is infrequently the defendant in an infringement suit, his incentive to check his own music, absent a request from the proprietor, is minimal. The proprietor will hardly make the request unless he knows how the checking may be done, and he does *not* know, because that part of the information was given to the bandleader.

Consequently, this dissemination of information by ASCAP does not realistically apprise the proprietor of any method of avoiding infringement.

195. *Twentieth Century-Fox Film Corporation v. National Publishers, Inc.*, 294 F. Supp. 10, 161 U.S.P.Q. 100 (S.D.N.Y., Dec. 9, 1969) (Mansfield, J.)

Plaintiff's motion for preliminary injunction in action for copyright infringement. The parties had entered into a contract under which defendant was licensed to prepare, publish and sell a souvenir booklet for the motion picture "STAR", full copyright therein to be retained by plaintiff. Defendant having defaulted under certain payment and reporting provisions of the agreement, plaintiff initially commenced an action for arrears and an accounting in the New York Supreme Court. Three days later, plaintiff notified defendant of its election to terminate the agreement under a default termination clause therein and warned that any further dispositions of the booklet by defendant would be deemed an infringement of the copyright.

*Held*, motion granted.

Finding that defendant was not justified in relying upon the mere filing of the state action complaint as mandating its continued distribution of the booklet after receipt of the termination notice and, hence, that defendant had not reasonably changed its position in reliance upon the institution of the state action, the court held that the commencement of the former action did not constitute an election of remedies barring a possibly inconsistent federal claim. The court said:

Defendant's major assertion in opposition to the granting of a preliminary injunction is that by bringing suit in the state court. Fox affirmed the contract and thereby waived any right to terminate the rights of National under the contract. Therefore, defendants argue, the license is and continues to be fully valid, and plaintiff may not assert its invalidity in an action based upon copyright infringement. Ordinarily the mere institution of a lawsuit asserting a claim based on one theory, or seeking one type of relief, does not constitute a binding election precluding the assertion of alternative or inconsistent claims or remedies in the same or another action. Inconsistent claims may be asserted under both federal and New York State rules (Rule 8, F.R.C.P. and CPLR § 3002). A binding election occurs only where one party pursues a remedy to a point where, in reliance upon such action, the other changes his position to his detriment. Thereupon the first party is estopped or precluded from pursuing an inconsistent remedy. . . .

National claims that it relied to its detriment on Fox's institution of the state court action as an affirmation of the contract. The argument appears to be that, having been sued on the contract in the state court, defendant felt that it had an obligation to perform under the contract; and that, had it not been for the state court action, it would, upon receiving the November 1 letter, have ceased its distribution activities and turned the booklets over to Fox pursuant to ¶ 13 of the Agreement. It is well settled that reliance, in order to create an estoppel, must be reasonable. *Bealle v. Nyden's Inc.*, 245 F.Supp. 86, 93-95 (D.Conn. 1965). In this case the mere institution of the state court action hardly justified National's assumption that Fox would not demand both payment and injunctive relief, in view of the type of liquidated damages clause found in the contract. Furthermore, within a short time after commencement of the state court suit (so short that defendants' brief (p. 5) describes it as "almost immediately after being served") National was advised unequivocally that further distribution of the booklet would result in Fox's bringing a lawsuit to enforce its copyright. At that point, as is still the case, nothing had happened in the state court beyond the filing of a complaint. Even if Fox should be prohibited from both recovering a judgment for the full amount of all claims asserted in the state court and having the benefit of a preliminary injunction, there has been no recovery or prosecution to judgment in the state court action. In these circumstances National's assertion of reliance is neither justified nor reasonable, and it becomes unnecessary to decide whether there is in fact any incon-

sistency between the relief sought in the state court and that sought here.

196. *Pantone, Inc. v. A. I. Friedman, Inc.*, 294 F. Supp. 545, 160 U.S.P.Q. 530 (S.D.N.Y., Dec. 17, 1969) (Mansfield, J.)

Plaintiff's motion for preliminary injunction in action for copyright infringement and violation of Section 43(a) of the Lanham Act. Plaintiff claimed copyright in a booklet designed for use by artists and printers which embodied plaintiff's color matching system. The booklet consisted of numerous pages, "each bearing a series of bands of carefully selected colors which are arranged in a fashion or plan designed, through variation of certain basic colors, to provide an extensive range of selection. . . ." Plaintiff sought to enjoin defendant, *pendente lite*, from distributing a leaflet featuring a color-matching system published by a non-party (Para-Tone, Inc.) on the grounds that the Para-Tone leaflet infringed plaintiff's copyright and that defendant's distribution of the leaflet constituted unfair competition.

*Held*, motion granted.

The court found the evidence adduced on the motion to reveal "a reasonable probability" of plaintiff prevailing on the merits on both counts.

I. *Copyright*. Although there was evidence that numerous color-selection and color-matching booklets, cards and other such publications existed prior to the creation of plaintiff's booklet, the court held that the validity of plaintiff's copyright in the booklet was sustained by the originality of its manner of expressing plaintiff's system. The court said:

In order to be copyrightable plaintiff's work need not be strikingly unique or novel as long as its contribution is more than a trivial variation. . . .

After careful examination of plaintiff's mode of expression, combination and arrangement of colors in its booklet in the light of the foregoing principles, and comparison with pre-existing color charts and exhibits shown to the Court, plaintiff's booklet appears to possess sufficient originality and uniqueness in its embodiment of its mode of expression to qualify it for copyrightability. Although the mere portrayal of a series of gradations of color shades, standing alone, would present a doubtful case for copyright protection, the arrangement here possessed [a] unique quality which apparently gained ready recognition on the part of artists in a critical profession. . . .

The originality of plaintiff's work lay in the new arrangement employed to facilitate selection and matching of colors, which was accomplished by placing each basic color or mixture in the center of each strip or page of related colors and then placing on each side of it the lighter tints achieved from addition of transparent white and on the other side of it the darker shades achieved by the addition of black. This embodiment or mode of expression had not previously been published and was the plaintiff's original creation.

The court found that the Para-Tone leaflet and plaintiff's booklet were substantially similar in their manner of presentation and that Para-Tone had access to plaintiff's booklet prior to publication of its material. The court added:

Any doubt about Para-Tone's copying of plaintiff's work is dispelled by Para-Tone's publication, for use in connection with its publication, of a typewritten cross-reference sheet entitled "Para Tone New Colors." It lists each of the hues, shades and tints offered by Para-Tone and plaintiff opposite a very similar color, shade or tint offered by Pantone, together with the respective Para-Tone and Pantone serial numbers for each, in such a way as to create the impression that each such correlated color is the same. The inference is inescapable that the publisher's intent was to demonstrate that the two color matching systems were interchangeable and lead customers to believe that there was a Para-Tone color that could be substituted for at least 140 of the colors offered by the plaintiff. This cross-reference sheet has been distributed by the defendant to close to a thousand of its customers.

Further, stated the court, it was clear that defendant had access to plaintiff's booklet at the times it distributed the Para-Tone leaflet to its customers. Such distribution was therefor held to be "an implementation of Para-Tone's unauthorized copying . . . and part and parcel of a selling or vending activity designed to use the infringing materials for the purpose of permitting the sale and use of Para-Tone's system and materials" against which plaintiff might properly be entitled to injunctive relief.

Defendant asserted a number of affirmative defenses, none of which were credited by the court: (a) In 1963 plaintiff's wholly-owned subsidiary obtained a registration of claim to copyright in the booklet, the application stating September 25, 1968 as the date of publication. In 1968 plaintiff obtained a registration for the same work, claiming September 30, 1963 as the date of first publication. The court found this

duplication of registration to "arise out of an oversight: by 1968 the representative of the plaintiff who had executed the 1963 application, and the attorney who handled it, had ceased to be associated with plaintiff, with the result that in 1968 plaintiff's president, overlooking the fact that a copyright had been registered in 1963, filed and obtained registration of a new copyright claim to the same work" and added that plaintiff's copyright notice, "Copyright 1963", complied with the Copyright Act and regulations thereunder.

(b) Apparently referring to the disparity in the dates of first publication stated in the duplicative applications for registration and to the words "Printer's Edition" in the 1968 application, defendant asserted that plaintiff had defrauded the Copyright Office by failing to mention, in 1968, that "material and substantial portions" of the work had been previously published. The court observed, however, that even defendant had conceded that the 1963 and 1968 works were identical except for minor variances (the addition of the words "Printer's Edition" and rearrangement of the order of part of the introductory text) which were "too immaterial and inconsequential to invalidate the registration certificate or render it fatally defective".

(c) The 1968 application for registration was filed in the name of "Pantone Press, Inc. (also known as Pantone, Inc.)". Although plaintiff was incorporated as "Pantone Press, Inc.", it had previously changed its name to "Pantone, Inc." and organized a wholly-owned subsidiary as "Pantone Press, Inc." which was later merged out of existence. The court found the name stated in the application to constitute "an innocent immaterial variance of no legal significance", adding that "Pantone Press, Inc. was in fact identical with the plaintiff" and that "such technical minutiae do not afford a basis for defeating an otherwise valid copyright."

(d) In 1965 plaintiff's wholly-owned subsidiary assigned the 1963 registration to a finance company (Dommerich) as security. The court found that, based upon the contingent nature of the assignment and notwithstanding its recordation under Section 30 of the Copyright Act, plaintiff was entitled to maintain the action. The court said:

It is undisputed that the assignment was to effectuate a transfer of ownership to Dommerich only in event of default [of its loan obligations] which had not occurred, and that Dommerich consents to the plaintiff's enforcement of its copyright in the plaintiff's work. Thus the plaintiff continues as the real party in interest and is entitled, as both the equitable owner and copyright proprietor, to

maintain this suit for infringement. . . . The purpose of recordation of the assignment pursuant to Title 17, U.S.C. § 30 was to put subsequent purchasers or mortgagees on notice. . . . It did not destroy plaintiff's status as "the copyright proprietor" entitled to sue for damages, 17 U.S.C. § 101(b), and its right as a "party aggrieved" to seek injunctive relief, 17 U.S.C. § 112.

II. *Section 43(A)*. Section 43(a) of the United States Trademark Act, 15 U.S.C. § 1125(a), prohibits use of false designations or misrepresentations in connection with goods or services. *Glenn v. Advertising Publications, Inc.*, 251 F.Supp. 889, 902-03, 148 USPQ 645, 654-655 (S.D. N.Y. 1966). Whether one adopts a narrow interpretation of the statute (limiting it to the palming off of trademarked goods, *Chamberlain v. Columbia Pictures Corp.*, 186 F.2d 923, 89 USPQ 7 (9th Cir. 1951)) or a broad view (that it prohibits *any* false representation in connection with goods or services, *L'Aiglone Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649, 102 USPQ 94 (3d Cir. 1954)), defendant's distribution of the offending leaflet and cross-reference sheet entitled "Para Tone New Colors" violated § 43(a), since these materials would lead the ordinary observer to believe that the Para-Tone colors and color system are the same as plaintiff's Pantone colors and system, whereas as defendant concedes, the Para-Tone colors, while closely similar to plaintiff's and arranged in a manner that copied plaintiff's unique arrangement, do differ in shade, tint and quality from the Pantone colors represented to be the same. For instance, the cross-reference sheet "Para Tone New Colors" shows Para-Tone's "Yellow #101", whereas in fact the former has a greener tinge to it than the latter. Similar differences pervade the two color matching systems. However, an artist, designer, ink manufacturer or innocent purchaser of color sheets, could be misled by the defendant's works, including the cross-reference sheet, into the belief that the two color systems were substantially the same and that each of the cross-referenced colors was identical. This, of course, could cause serious and harmful consequences to plaintiff's business, as well as to members of the trade thus misled. The misrepresentation is used to advertise and sell an inferior and less expensive system, which has repeatedly been condemned as a violation of § 43(a).

197. *Bevan v. Columbia Broadcasting System, Inc.*, 293 F. Supp. 1366, 161 U.S.P.Q. 376 (S.D.N.Y., Dec. 18, 1968) (Mansfield, J.)

Motion to serve amended complaint in action for copyright infringement. Plaintiffs claimed that, as authors of the play "Stalag 17", they

held full copyright therein, including specifically the right to adapt the play as a television series, and that defendants' television series, "Hogan's Heroes", constituted an infringement thereof. In addition to denying the material allegations of the complaint, defendants asserted that plaintiffs did not own the "copyright interest" allegedly infringed. This assertion was based upon an agreement between plaintiffs and Paramount Pictures Corporation which granted to Paramount certain rights in the play, "including all motion picture rights, rights to produce and exhibit motion picture photoplays adapted from the play [and] rights to project or exhibit such motion picture plays by television. . . ." In addition to cash payments to be made to plaintiffs for these rights, Paramount was obligated to pay plaintiffs a certain amount for each "sequel" (defined in terms of a character spin-off) of any motion picture adaptation of the play produced by it.

Plaintiffs' amendment proposed to (i) add Paramount as a defendant on the basis of defendant's affirmative defense and the refusal of Paramount to join as plaintiff; (ii) add a pendant jurisdiction claim against Paramount only to recover payments for each installment of "Hogan's Heroes" as "sequels" on the grounds that Paramount had "tacitly" licensed plaintiff to exhibit the series; and (iii) add a second pendant jurisdiction claim against Paramount only for failure to enforce its interest (assumed, "arguendo", to have been granted). No federal claim was asserted against Paramount and diversity between plaintiffs and Paramount was lacking.

*Held*, motion denied.

Stating that "in the absence of a [federal] jurisdictional basis and the assertion of a claim against Paramount arising out of a transaction, occurrence or event forming the basis of the action against existing defendants, this Court may not order Paramount to be joined as a party unless the prerequisites established by [Federal] Rule 19(a) are satisfied", the court found that the conditions of joinder under that section were not met.

A. Although plaintiff contended that absent the joinder of Paramount complete relief could not be accorded among the present parties within the terms of Rule 19(c), the court found this not to be the case. The court said:

If plaintiffs establish in the present action that they are the copyright proprietors as alleged and that "Hogan's Heroes" infringes their copyright, they will be awarded a judgment; whereas if they fail to sustain these essential elements, their complaint must be dismissed. In either event the Court is able to grant complete relief



as between the existing parties without the joinder of Paramount, and it is unnecessary to join Paramount as a party in order to enable plaintiffs to prove their claim. According to the moving papers plaintiffs' rights against the existing defendants are separate and distinct from the rights asserted in speculative and tentative terms ("arguendo") against Paramount. Nothing in the September, 1951 agreement, or in the other papers submitted, obligated Paramount to exploit the rights granted or assigned to it, or to hold or enforce them as a fiduciary or trustee for the plaintiffs. On the contrary, plaintiffs made an outright grant and assignment of partial rights for a fixed sum plus \$16,500 per sequel, paragraph THIRTEENTH of the agreement providing:

"THIRTEENTH: Nothing herein or elsewhere contained shall obligate the Purchaser to produce at any time any motion picture based upon or adapted from said play, nor shall any of the rights herein granted to the Purchaser revert to the Sellers based upon a claim that the Purchaser did not at any time produce motion pictures based upon or adapted from said play."

Thus the situation here differs in an essential and material respect from that where an assignee holding rights as an agent or trustee for the owner refuses to enforce them for the owner's benefit. In the latter case the agent's joinder is essential to enable the owner to obtain relief, see *Manning v. Miller Music Corp.*, 174 F. Supp. 192 (S.D.N.Y. 1959), whereas here it is not.

The most that can be said in support of plaintiffs' application is that they find themselves on the horns of a dilemma arising out of conflicting or differing interpretations of the terms of the 1951 agreement, which might (but *not* necessarily will) lead to multiple litigation with respect to the same issues and the risk of inconsistent determination unless the issues are resolved in one proceeding which will bind all persons having a possible interest. Such a joinder of all interested persons in one proceeding would suit plaintiffs' convenience, since it would minimize the delay, expense and risks involved, and avoid the possibility of having to litigate in two forums against different parties with the risk of inconsistent findings. But it hardly serves the interest of Paramount, which would be dragged unwillingly into a suit that essentially presents claims between others only and would require it to become involved in expense as a litigant in order to suit the plaintiffs' convenience. The standards for determining whether joinder must be ordered are not the relative conveniences of the parties but those prescribed by Rule 19, and it

is abundantly clear that plaintiffs have failed to show that in Paramount's absence complete relief cannot be accorded among those already parties.

B. Plaintiff also asserted that joinder of Paramount was required under Rule 19(a) so as to protect the existing defendants from multiple or inconsistent obligations. In addition to noting plaintiffs' lack of standing to claim the benefits of this provision ("If the defendants . . . are content to risk a possible double liability, that is their concern and it hardly lies in plaintiffs' mouths to urge such solicitous protection upon them,"), the court found lacking any indication that Paramount was likely to attempt enforcement of the "same copyright" against the defendants.

The court further held that the two proposed pendant jurisdiction claims against Paramount must fail for lack of any federal claim against the proposed defendant to which the essentially contractual allegations "could be pendant".

198. *Florabelle Flowers, Inc. v. Joseph Markovits, Inc.*, 296 F.Supp. 304, 160 U.S.P.Q. 611 (S.D.N.Y., Dec. 31, 1968.)

Plaintiff's motion for preliminary injunction in action for copyright infringement. Plaintiff claimed copyright in an artificial flower with simulated facial features, allegedly created by one of its salesmen (Cohen) who arranged for the manufacture thereof by a Hong Kong concern (Dong Fung).

*Held*, motion denied.

The court held that plaintiff's claim of copyright suffered from several "infirmities" which collectively militated against the award of preliminary relief.

A. The court found that the evidence adduced on the motion indicated that the "concrete" expression of the flower was actually created by Dong Fung and added that plaintiff could not accede to copyright therein by virtue of either the work made for hire or work created on commission theory. The court said:

In the facts as they now appear, it seems likely that plaintiff will fail at the threshold of its case because the alleged author was not the one whose "own skill, labor, and judgment" produced the work in question. . . .

Without knowing now the exact measure of the respective contributions, I find it most probable that Cohen had a general idea,

as merchandisers frequently do, that was not a revolutionary leap from things long familiar in the trade; that he discussed it with the people in Hong Kong; and that the Oriental artisans either had or created, for general sale, the concrete object of art which Cohen (or Florabelle) later sought to copyright.<sup>3</sup>

B. The court also found that there had probably been a widespread publication of the flower without adequate copyright notice. Finding that such publication was "effected by plaintiff itself", the court responded to plaintiff's suggestion that those actually responsible for the divestitive publication were "Dong Fung or other Hong Kong manufacturers who 'knocked off' the sculpture" by stating:

Even if this were an entirely accurate account of the facts, contrary to what I have found, plaintiff could not prevail on the present motion. A party is not free to present its allegedly unique work to a manufacturer, impose no legal or otherwise effective restraints upon the manufacturer, permit the work to be copied and sold in quantity on the American market (with no, or no adequate, notice of copyright), and then seek to reverse the flood by a grossly tardy registration of the kind here involved.

C. The court further found that, whoever created the flower, it appeared to lack even the 'faint trace' of originality required for copyright and there was a strong likelihood that "plaintiff cannot show more than an aggregate of well known components to form an unoriginal whole — the result falling short of the easy standard of originality required for a copyright."

199. *United Merchants & Manufacturers, Inc. v. K. Gimbel Accessories, Inc.*, 294 F. Supp. 151 (S.D.N.Y., Dec. 10, 1968) (Mansfield, J.)

Motion for preliminary injunction in action by textile converter against importer of fabric-covered luggage for infringement of copyright

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<sup>3</sup> In a post-hearing letter, plaintiff suggests that "if it should be held that persons in Hong Kong themselves created the work, the work was created at the Plaintiff's instance, and at the Plaintiff's expense, and the work is properly copyrighted by Plaintiff." However, this is not an appropriate case for application of the "Works for hire" doctrine, 17 U.S.C. § 26. The evidence fails to sustain the suggestion that plaintiff "commissioned" the work. There is nothing whatever to indicate that Dong Fung's creative efforts were expended "at the Plaintiff's expense." The only pertinent evidence is to the contrary: it indicates that plaintiff paid Dong Fung nothing except an invoiced price per item for the several dozens it purchased. And there is no faint intimation that plaintiff ever complained to Dong Fung about the latter's apparent willingness to sell the item to all comers.

in plaintiff's textile designs. Defendant had purchased samples of plaintiff's fabric bearing copyright notice on the selvage of the material under a sales agreement containing a covenant that the purchaser would not copy such designs or cause same to be copied.

*Held*, motion granted.

The court held that the copyrightability of plaintiff's designs was "established not only by their apparent originality and uniqueness (which need not be strikingly novel as long as the author's contribution is more than a trivial variation . . .), but by the existence of certificates of registration which constitute *prima facie* evidence of the existence of a valid copyright", that the markings on the selvage constituted adequate notice of copyright, and that the "average observer" test disclosed substantial appropriation of plaintiff's designs.

200. *National Chemsearch Corporation v. Easton Chemical Co., Inc.*, 160 U.S.P.Q. 537 (S.D.N.Y., Jan. 16, 1969) (Frankel, J.)

Plaintiff's motion for preliminary injunction in action for copyright infringement and unfair competition. Plaintiff, a distributor of various household chemical products, alleged that defendant corporation, a competitor formed by a former employee of plaintiff, copied plaintiff's copyrighted promotional materials and simulated its common law trademarks. Defendant did not deny these allegations, but asserted that preliminary relief was unwarranted.

*Held*, motion granted.

Defendant questioned the validity of plaintiff's copyrights on the grounds that the materials lacked creativity, but the court held that they did "pass the rather modest test of the copyright law in this respect." The court further observed that a detailed showing of irreparable harm was unnecessary and that, in any event, plaintiff had demonstrated a sufficient danger of customer confusion and impairment of its good will. Although defendant claimed that, upon advice of counsel, it had ceased distributing the offending materials after commencement of this action, the court stated that the "cessation of the offending materials after suit has begun is not itself decisive ground for denying injunctive relief which is otherwise appropriate" and added that such voluntary action by defendant indicated that any harm inuring thereto by reason of a preliminary injunction "is likely to be bearable".

*Also of interest:*

201. *Davis v. Trans World Airlines*, 160 U.S.P.Q. 767 (D. Cal., Jan. 28, 1969) (Whelan, J.)

Defendants' motion for summary judgment in action for unfair competition. Plaintiffs, members of "The Fifth Dimension" singing group, had recorded a copyrighted musical composition entitled "Up, Up and Away" and this recording had achieved considerable popularity. Defendants subsequently utilized, under license, an anonymous rendition of this composition with modified lyrics in numerous television and radio commercials.

*Held*, motion granted.

Pointing out that the performances in the commercials were anonymous, "that is, there [was] no audio or visual representation, holding out an inference that any of the commercials embod[ied] the voice of any particular individual or individuals", and that plaintiffs were not referred to by name or inference, the court found that there had been (i) no passing off of the commercials as the product of plaintiffs, (ii) no invasion of plaintiffs' privacy, and (iii) no defamation of plaintiffs nor violation of any of their "personal rights". Although defendants admitted, for the purposes of the motion, that the commercial performances were imitative of plaintiffs' recording, the court held that "imitation alone does not give rise to a cause of action [citing, *inter alia*, *Sears and Compco\**]".

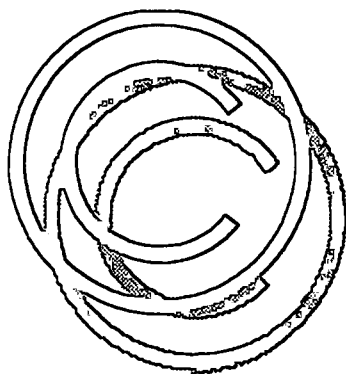
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\* Although not cited by the court, see also *Sinatra v. Goodyear Tire & Rubber Co.*, 159 U.S.P.Q. 356 (D. Cal. Aug. 20, 1968), 16 BULL. CR. SOC. 176, Item 146 (Feb. 1969).



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## PART I.

## ARTICLES

202.

## REVISION REVISITED

*By* ROBERT W. KASTENMEIER\*

My hope today is to give you some idea of the vicissitudes necessarily undergone by legislation intended to revise and bring up-to-date Federal law governing the relations between users and owners of copyrighted materials.

Copyright law is a highly complex specialty. Inherited from the British in time to find its justification in our Constitution, it remains old fashioned and esoteric to most — a mystique for the initiated. Revision has necessarily involved — and continues to involve — a series of confrontations and tedious but essential accommodations and adjustments between those, on the one hand, who seek legitimate compensation for the use of their copyrighted works of authorship and those, on the other hand, whose legitimate need is to use these works without undue complication or cost. In many of these areas of head-on conflict, what is more, the contesting parties can and do articulately muster virtually equally impressive arguments in the name of the public interest.

Some of the idea of the magnitude of the current revision effort can be gleaned from the time and labor that has been devoted to it. The last comprehensive revision of the law occurred 60 years ago, in 1909. The communications climate of those times as contrasted with the present, is highlighted by recalling that the Supreme Court had just held that a piano roll is not a “copy” of the embodied composition.<sup>1</sup> Motion pictures and sound recordings were still novelties. Radio was in an early stage and television not yet perfected. The past 60 years have seen enormous progress in the techniques of communication, and the rate of change is apparently still accelerating, rather than slowing down.

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\* Text of the address by The Honorable Robert W. Kastenmeier, Chairman, House Subcommittee on Patents, Trademarks and Copyrights, before The Copyright Luncheon Circle, New York City on May 9, 1969.

1. *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 1908.

The changes that have taken place and are taking place before our eyes are potentially so revolutionary that it has become fashionable to say that even a theoretically perfect new law, however prompt its adoption, will necessarily have obsolesced in material part by the time of its enactment.

But as you know, revision has not been prompt. Attempts made between 1924 and 1940 having foundered, the present drive for revision legislation was launched in 1955, when Congress appropriated funds for a comprehensive program of research and studies by the Copyright Office as the ground work for general revision.

Now, seven Congresses and four legislative measures later, revision is still under consideration by the Senate, with Senate action expected, or hoped for, in the present session of Congress.

My comments today bear on three major periods. The first began with the 1955 study project and ended with the introduction of a revision bill (H.R. 11947, 88th Cong.) in 1964 by Chairman Celler at the request of the Register of Copyrights. The second period began with the introduction early in 1965 of H.R. 4347, 89th Congress, and ended on April 11, 1967 when the House enacted an amended version of a successor measure, H.R. 2512, 90th Congress. This is the period in which the House Copyright Subcommittee, of which I am now Chairman, studied and reworked H.R. 2512 in detail. It is the period of my own close involvement in the revision effort. The third period began when the House bill went to the Senate, and has not yet ended.

### *Initial Phase: Study and Report*

The first six years of the initial phase of the revision project — the years 1955 to 1961 — were a period of study. In those years the Copyright Office staff and a number of copyright experts outside the office prepared, and the Senate published, a series of 34 monographs on the history and provisions of the present law, the issues involved, and alternative solutions. The publication of these studies was followed by the issuance in 1961 of the Report of the Register on the General Revision, containing detailed recommendations for an omnibus statute. Starting with the research and analysis contained in the studies and the views expressed by members of a general revision panel appointed by the Librarian of Congress, the Report provided tentative conclusions on each issue. This was followed by three years of further discussion, debate, and drafting, leading to the introduction in 1964 of a revision bill for the purpose of further discussion and comment. The achievement and refinement of this legislative measure are recorded in a six-

part publication of the House Committee on the Judiciary, entitled "Copyright Law Revision, Parts 1 through 6."

I shall make repeated reference to the invaluable contributions to the work in progress of the Register of Copyrights and his staff. These contributions, in the initial stage, consisted of patient and continuing study and discussion which helped to create a climate of objective dialogue among experienced members of the copyright bar, some of whom are also representatives of leading interest groups. It is extremely doubtful that the significant progress that has been made on the legislative front would have occurred without this essential work of preparation.

### *Phase 2: Revision in the House of Representatives*

After introduction and discussion of the 1964 bill, Chairman Celler, at the request of the Register of Copyrights early in 1965, introduced H.R. 4347, 89th Cong., containing some further changes. The measure was immediately referred to the Copyright Subcommittee. Under my chairmanship, the Subcommittee devoted 22 days of public hearings in 1965 and more than 50 executive sessions in 1966 to the study and "markup" of the revision measure.

I must again stress the tremendous impact that technological changes have had on the postures of owners and users of copyright. Originally the first function of copyright was the protection of materials in printed form. Today, advanced methods of photocopying have thrown the traditional relationships in bookmaking out of balance. Educators and users are eager to take advantage of new, economical methods of distribution. Publishers fear that broadscale infringement may put an end to book publishing as we know it. This is but one example. Similar technological innovations, notably the computer and aspects of telecasting, create similar problems in other areas.

The entire revision experience has been a memorable one for me and, I dare say, for the entire Subcommittee. No Member of the Subcommittee is a copyright lawyer, nor is our counsel. The task before us was thus doubly challenging. We were confronted with a highly complex set of rules governing the relations between owners and users over a wide spectrum of copyright areas—publishing, music, records, radio, television, and their offshoots, among others. The only point on which we encountered virtual unanimity among the interest groups was that revision is long overdue. A compensating advantage of our lack of expertise was that the Members approached the task with relatively few preconceptions and with the attitude that they would learn what they

needed to know in order to decide. With the commencement of the hearings on May 26, 1965, the legislative phase of revision had its real beginning. The hearings brought before us a highly competent group of experts and advocates. As a whole, the witnesses — and we heard more than 150 — were not only zealous in defense of the interest they represented, but also proved most objective and helpful in their exposition of the problems involved. Indeed, an unusually large proportion of the witnesses saw revision not merely as a forum in which to further their economic interests, but also as a concerted effort in the public interest. As a result, a substantial number of viable compromises became feasible.

My Committee colleagues, I believe, exhibited unusual patience and pertinacity in the pursuit of understanding and in the evaluation of the issues from the point of view of the public. We regarded the task as a technical one and partisanship was wholly absent from our deliberations.

Of necessity, the Committee leaned heavily on the Register of Copyrights and his staff, particularly in the markup sessions that consumed most of 1966, in which, step by step, we took apart and reassembled H.R. 4347. Their cooperative diligence was invaluable and the degree to which they combined high competence and virtually universal acceptance by the private sector of copyright seems in retrospect to have been unique.

Let me turn now to some of the principal provisions of the emergent bill which was approved without amendment by the full Committee on the Judiciary late in 1966 and was brought to the floor of the House in April 1967, as H.R. 2512, 90th Congress.

a. *Fair Use.* The judicial doctrine referred to as the “fair use” doctrine constitutes an important limitation on the exclusive rights of copyright owners by exempting “fair” uses of copyrighted material from the consequences attendant on infringement. Though widely applied in litigation, the doctrine has never been given statutory form. The bill provides statutory guidelines for determining the applicability of the doctrine to particular uses. Publishers and educators, joining in an exhaustive debate, provided the Committee with the necessary insights. Detailed gloss on the proposed statutory provision consumed nine pages of the Committee Report. I believe that substantial accord was achieved in this difficult area and that the result should go far in quieting the legitimate concerns of educators.

b. *The Duration of Copyright.* The Committee accepted vigorous arguments in favor of replacing the present copyright term of 28 years,

renewable for an additional 28 years, with a basic term of life of the author plus 50 years. This will eliminate the increasing incidence of an author outliving his copyright. It will also conform our system to the prevalent European system and will thus facilitate our participation in international copyright conventions.

c. *A Single Federal System.* The present anachronistic dual system of so-called "common law copyright" for unpublished works and statutory copyright for published works seemed undesirable to the Committee. The bill provides a single Federal statutory system.

d. *Government Works.* The bill continues the existing ineligibility of works of the Federal Government for copyright protection. Further, the Committee rejected a number of proposals to prohibit the Federal Government from owning copyright.

e. *Phonograph Records.* Existing law makes provision for a system of compulsory licensing for the manufacture and distribution of phonograph records of copyrighted musical compositions. Early in the revision project there was a substantial sentiment for the elimination of these provisions and the restoration of record licensing to the operation of the market. At the hearings, however, it appeared that the owners and users of musical copyright preferred to continue these provisions, subject only to their disagreement as to the price. The Committee studied voluminous submissions and argument and decided to retain the compulsory license provisions and to increase the license fee per musical work.

f. *Juke Box Music.* On the venerable issue of the so-called juke box exemption, after considering a wide range of alternatives, the Committee concluded that the exemption should be repealed and that juke box performances should be made subject to a compulsory license with automatic clearance conditioned on the payment of a statutory royalty. The Committee bill adopted the royalty payment based on the total number of records made available for performance in a particular juke box within a designated period. Under this provision, however, the parties could withdraw their operations from the impact of the statute by making private licensing agreements and could thus achieve substantial savings of compliance and policing costs.

g. *CATV.* One of the most frustrating dilemmas presented to the Subcommittee involved the status of so-called CATV, the community antenna systems that intercept broadcasts off the air and retransmit them to paying subscribers. Unlike the case of juke box music, the present

statute makes no specific provision for CATV, nor even mentions it. For more than 18 years CATV has operated without paying royalties for retransmission of copyrighted materials. Its justification was that it is little more than an improved antenna and is, as such, exempt. At the time of the Subcommittee's deliberations a Federal district judge in New York had rejected the CATV position, but during the Senate phase of the revision project this decision was reversed by the High Court.

The Committee's bill divided CATV activities into three categories. In the broadcast terms, operations which merely amplified reception would be exempt. With two further exceptions, other CATV operations would be wholly subject to copyright obligations. The exceptions involved CATV operations into areas which do not receive all the networks and as to which notice has not been given that a local station holds an exclusive license to carry the program in the area. To these, a "reasonable" license fee was made applicable.

h. *Performance Right.* In addition to the foregoing issues attempted to be resolved by the Committee's bill, there were two matters whose omission from the bill have given rise to increased controversy in the Senate phase. The first of these involved the request of record manufacturers and recording artists for a performance right in the public performance of sound recordings. The Committee recognized the force of some of the arguments advanced in support of this proposal but concluded that to increase the scope of protection for sound recordings was not practicable.

i. *Computer Uses.* The problem of computer uses of copyrighted material was touched on rather lightly at the hearings before the Subcommittee. The Committee recognized the profound impact that information storage and retrieval devices seemed destined to have on authorship, communications, and human life itself, but determined that it would be premature to attempt detailed legislation in this area.

j. *Floor Debate.* H.R. 2512 was debated by the House of Representatives on April 6 and April 11, 1967 and was passed on the latter date with a number of amendments.

Early in the debate it became apparent that the opposition engendered by the Committee's solution of two important issues might constitute a barrier to the enactment of the bill. These were the issues involving juke box music and CATV. Continuing negotiations and meetings over the weekend falling between April 6 and April 11 resulted in a mutually acceptable resolution of the juke box issue. This compromise contemplated the imposition upon the juke box operators of



a flat performance fee of \$8.00 per juke box, per year of operation. Payment was to be made to the Register of Copyrights as trustee, and entitlement to the funds collected was to be established by the claimants in the proportion in which their copyrighted compositions were performed. The compromise shifted the cost of ascertaining entitlement from the juke box operators to the composers and their performing rights societies.

No comparable substantive accommodation was achieved in the CATV area. The distinguished chairman of the Committee on Interstate and Foreign Commerce objected that in prescribing conditions to the exemption of certain CATV operations from copyright, the bill invaded the jurisdiction of his Committee over communications matters. Undoubtedly the jurisdictional boundaries of the two Committees do overlap. In any event, to save the bill from the possible consequences of acrimonious jurisdictional strife, a proposal was made to strike the CATV provisions from the bill, and this was done by consent of both Committees.

A few additional amendments, primarily relaxing the copyright obligations of educational television, were added on the floor of the House and, as so amended, the bill was passed and sent to the Senate.

### *Phase 3: Revision in the Senate*

From April 1967 to the end of the 90th Congress, H.R. 2512 was pending before the Senate Copyright Subcommittee. Extensive hearings were held and numerous informal meetings and explorations took place, but the revision bill was not reported. In the current, 91st Congress, Chairman McClellan reintroduced it as S. 543.

*CATV.* The principal stumbling block to revision in the Senate continued to involve the copyright status of CATV. As far as I have been able to discern, the parties have simply been unable appreciably to narrow the gap between them. Moreover, two developments outside the legislation arena have added color and heat to the CATV issue. On June 17, 1968, in *Fortnightly Corp. v. United Artists Television, Inc.*,<sup>2</sup> the Supreme Court reversed lower court decisions and held that the activities of the CATV operations involved in that case did not constitute infringing uses and were therefore immune from copyright demands. The court was of the opinion that these operations fell "on the viewer's [as distinguished from the performer's] side of the line."

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2. 392 U.S. 390.

Although this decision merely construed existing law, and no way determined what the new law "ought" to be, its obvious effect was immeasurably to strengthen the hand of the CATV interests. Much to the credit of those interests, I am advised, they continue to agree that the ultimate solution of the issue shall include fair payment by CATV.

The other development that has affected the CATV issue occurred in December 1968, when the Federal Communications Commission issued a notice of rule-making, proposing, among other things, to bar the carriage by CATV systems of so-called distant signals, without consent of the distant station, on the asserted ground that such practice competed unfairly with local TV stations. The element of alleged unfair competition was said to lie in the fact that local stations have to satisfy copyright whereas CATV (under *Fortnightly*) do not. The notice of rule-making evoked loud outcries, including proposals to abolish the Commission.

It is mildly ironic to recall that in connection with our Subcommittee's provisions for CATV copyright exemptions, we were accused of attempting to regulate communications practices under the guise of defining copyright liability. Now, it would seem, the FCC is criticized for allegedly manipulating copyright principles under color of regulating communications. In any event, although the *Fortnightly* decision and the FCC proposals had opposite impact on the CATV copyright issue, neither development appears materially to have accelerated resolution of that issue, as a part of the copyright revision program.

*Computer Uses.* In the Senate phase of revision strong presentations were made concerning the need to legislate or to be placed in a position to legislate with respect to computer uses of copyrighted materials. A number of Government agencies joined other parties in urging that the revision bill should contain specific provisions in this area or, in the alternative, that this tremendously difficult subject be studied in depth. As a result of these proposals, the Senate passed a bill establishing a "National Commission on New Technological Uses of Copyrighted Works" to study these problems and to report within three years. The measure was not enacted in the 90th Congress and has reappeared as Title II of S. 543, the current Senate copyright revision bill.

*Performing Rights.* In the 90th Congress also the Senate has seen the resumption of a vigorous campaign on the part of those who would extend public performance rights to phonograph record producers, including both record manufacturers and performing artists. What is more, an amendment to S. 543 that would accord such rights is pending and must be disposed of.

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Beyond this, I am advised that while there have been some brush fires involving educators and librarians, among others, it is believed and hoped that satisfactory accommodation can be reached on these issues.

On the basis of available hearsay, there are grounds for the belief that final Senate action on copyright revision may be taken in the present session of Congress, after which the bill must come back to the House for final action after consideration of Senate changes.

Meanwhile, copyright interests have requested introduction and enactment of what would be the fifth interim extension bill, to prevent inadvertent lapses of copyright at the end of 1969.

In closing on a somewhat personal note, I would like you to know that I regard my own involvement in the revision project as an invaluable experience. It has been a tremendous challenge and has yielded many satisfactions — the satisfaction of working out viable accommodations in the public interest, the interplay with a highly articulate and competent set of interest groups, the close association with the Register of Copyrights and his gifted staff, and the working together with my devoted colleagues. Hopefully, these labors and those of our brothers in the Senate will soon bear fruit.

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203. FIFTEEN YEARS AFTER *MAZER* v. *STEIN*:  
A BRIEF PERSPECTIVE<sup>1</sup>

By ALAN LATMAN

In 1951 Professor Derenberg called attention to a case<sup>2</sup> of "unusual importance in connection with establishing the somewhat nebulous legal distinction between copyrightable works of art and design patents."<sup>3</sup> The importance of this case was soon demonstrated conclusively. The plaintiffs brought additional lawsuits against other defendants in different courts with drastically different results.<sup>4</sup> The issue in each case was whether or not a lamp base in the form of a human figurine was copyrightable. Finally, the Supreme Court granted certiorari<sup>5</sup> and held in favor of copyrightability in the landmark decision of *Mazer v. Stein*.<sup>6</sup>

The *Stein* litigation dealt with the problem of defining the scope of "works of art"<sup>7</sup> protectible under the copyright law. The *Mazer* case defined this class in a negative way. The Court there held that a work is not disqualified from protection as a "work of art" solely because it is embodied in a functional article. Neither was the *potential* availability of a design patent a bar.<sup>8</sup>

The Court did not tell us what a work of art *is*. Perhaps the fact that a most traditional art form—a human figure—was before the Court made this unnecessary. On the other hand, the Court may simply have recognized the impossibility of defining "art" in a meaningful way

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1. © 1969 Alan Latman.

2. *Stein v. Expert Lamp Co.*, 188 F.2d 611 (7th Cir.), *cert. denied*, 342 U.S. 829 (1951).

3. 1951 ANNUAL SURVEY OF THE LAW 720, New York University Press (1952).

4. Compare *Stein v. Rosenthal*, 205 F.2d 633 (9th Cir. 1953) with *Stein v. Benaderet*, 96 USPQ 13 (E.D. Mich. 1952).

5. 346 U.S. 811 (1953).

6. 347 U.S. 201 (1954).

7. Section 5 of the Copyright Law, 17 U.S.C. §5 sets forth different classifications of the works protected under §4 as "writings of an author". This classification is for registration purposes only. It is, moreover, expressly provided that errors in classification shall be immaterial. Nevertheless, this specification has often been treated by courts as giving substantive meaning to the "writings of an author". Section 5(g) specifies "works of art; models or designs for works of art;" Section 5(h) covers "reproductions of a work of art."

8. The Court expressly refrained from deciding whether *both* copyright and design patent could be secured in the same work. Lower court decisions indicate that such double protection is not possible. See *e.g.*, *Korzybski v. Underwood & Underwood*, 36 F.2d 727 (2d Cir. 1929).

as a matter of law. However, even the limited holding in *Mazer* makes the case an important one. The decision resulted in a significant expansion of copyrightable subject matter and has engendered a series of new problems. These developments, against the background of pre-*Mazer* copyright principles, will be briefly examined.

#### STATUTORY BASIS

Works of the graphic arts received early recognition in United States copyright law. The first statute,<sup>9</sup> passed in 1790, included maps and charts and an 1802 amendment added "prints."<sup>10</sup> Three-dimensional works were added in 1870 in a statute<sup>11</sup> that spoke of "fine arts". Similarly, in 1874, prints, cuts and engravings were legislatively defined to apply "only to pictorial illustrations or works connected with the fine arts."<sup>12</sup>

In 1909, when the present Act was enacted, the term "works of art" was introduced for the first time. There is evidence that the deletion of the word "fine" was purposeful.<sup>13</sup>

#### RELATED LIMITATIONS ON PROTECTION

For a number of reasons, the 1909 Act did not immediately open the copyright doors to utilitarian works which incorporated a "work of art". For almost 40 years longer, utility and art were to be considered inconsistent.

Upon analysis there are several limitations on copyrightability inter-related to the concept of utility. For example, it has long been recognized that copyright protection is unavailable where the appearance of an article is dictated by its function. Thus, a chart for recording temperature changes was held not to be the "writing of an author" because there was present no conscious, creative authorship but merely a blank chart responsive to mechanical forces.<sup>14</sup> It is this limitation which, perhaps subconsciously, guided the earlier hostility of courts towards protection for useful articles. It should be noted, however, that this factor operates in only a limited sphere; there are very few situations

9. 1 Stat. 124 (1790).

10. 2 Stat. 171 (1802).

11. 16 Stat. 212 (1870).

12. 18 Stat. 79 (1874).

13. *Hearing before Committees on Patents on S. 6330 and H.R. 19853*, 59th Cong. 1st Sess. 11 (1906).

14. *Taylor Instrument Co. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943). Cf. *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir. 1947) (mandamus action).

in which the appearance of even a useful article is *dictated* by the function of the article. This is never true with respect to two-dimensional works such as prints for textile fabrics. Moreover, the function of even three-dimensional objects such as jewelry, silverware, ashtrays, etc. rarely determines the specific appearance of the item. Where appearance is dictated by the function of the article, protection remains unavailable even after *Mazer v. Stein*.<sup>15</sup>

Another closely related criterion, sometimes confused with utility, is the requirement that at least minimal standards of creativity or "originality" be present for any work to be copyrightable. Thus, in the pre-*Mazer* era, a staple fleur-de-lis design was held to lack the minimal degree of required originality.<sup>16</sup> And even after *Mazer*, a standard star design was refused registration by the Register of Copyrights and his determination upheld by the courts.<sup>17</sup>

It should be remembered, however, that this standard of originality is *minimal*.<sup>18</sup> It is satisfied by such works as carefully scaled reductions of public domain works of sculpture,<sup>19</sup> or projection on a two-dimensional print surface of a three-dimensional embroidery design.<sup>20</sup> But it should be noted that the copyist of such a print design escapes liability if his copy fails to achieve the same effect as the plaintiff's, namely the illusion of three dimensions on a two-dimensional surface. This is because in every case, protection extends only to the copyrightable matter added by the author.<sup>21</sup>

#### THE ROAD TO LIBERALIZATION

Before *Mazer v. Stein*, the trend was to follow the legislative pronouncements of the 19th Century and to ignore the hint of change introduced in the 1909 law by using the broad term "works of art". The few adjudicated cases in this area tended to restrict protection to the

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15. In *Armstrong Corp. Co. v. Kaminstein*, Docket No. 119-64, *dismissed by stipulation* (D.D.C. 1965), a mandamus action was brought against the Register of Copyrights to compel registration of a claim in a flooring design produced in a random fashion by computer. The Register's refusal was on the ground that the design was not the writing of an author.

16. *Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F.Supp. 964 (E.D. N.Y., 1950).

17. *Bailie & Fiddler v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958).

18. In *Alfred Bell & Co. v. Catalda Fine Arts Inc.*, 191 F.2d 99 (2d Cir. 1951), the standard was reduced to the absence of copying from someone else.

19. *Alva Studios v. Winninger*, 177 F.Supp. 265 (S.D.N.Y. 1959).

20. *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960).

21. See 17 U.S.C. §7.

fine arts. Attempts to circumvent this approach, particularly in the field of fabrics or garments, were unsuccessful.<sup>22</sup> This judicial approach was also reflected in the regulations of the Copyright Office. Thus, the regulations expressly stated that the class works of art "includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture)" and that "productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration even if artistically made or ornamented."<sup>23</sup>

A dramatic reversal took place in 1949 when the Office regulations were changed to provide that works of art include "works of artistic craftsmanship in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculptures . . ." <sup>24</sup> These regulations were quoted and relied upon by the Supreme Court in the *Mazer* case as part of a "contemporaneous and long continued construction of the statutes by the agency charged to administer them that would allow the registration of such a statuette as is in question here."<sup>25</sup>

In the wake of the *Mazer*, the Copyright Office further liberalized its regulations and the courts have continuously expanded the scope of copyrightable works. Thus, copyright protection has been secured for jewelry,<sup>26</sup> dolls,<sup>27</sup> artificial flowers<sup>28</sup> and, even more dramatically, textile fabrics.<sup>29</sup> Indeed, a pencil sharpener in the form of an antique telephone, has recently been held a "work of art."<sup>30</sup> There are, however, limits. A novel design for a watch face was held not to be a work of art despite the designer's somewhat ingenuous argument that the watch must be considered "art" since it is so difficult to tell time from it.<sup>31</sup>

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22. *E.g., Kemp & Beatley, Inc. v. Hirsh*, 34 F.2d 291 (E.D. N.Y. 1929); *Verney Corp. v. Rose Fabric Converters Corp.*, 87 F.Supp. 802 (S.D.N.Y. 1949).

23. 17 C.F.R. §201.4 (1938).

24. 37 C.F.R. §202.8 (a) (1949).

25. 347 U.S. at 213.

26. *Trifari, Krussman & Fishel, Inc. v. B. Steinberg-Kaslo Co.*, 144 F.Supp. 577 (S.D.N.Y. 1956); *Hollywood Jewelry Co. v. Dushkin*, 135 F.Supp. 738 (S.D. N.Y. 1955).

27. *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955); cf. *F. W. Woolworth v. Contemporary Art Inc.*, 344 U.S. 228, 95 USPQ 396 (1952).

28. *Prestige Floral v. California Artificial Flower Co.*, 201 F.Supp. 287 (S.D. N.Y. 1962).

29. *E.g., Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960).

30. *Ted Arnold Ltd. v. Silvercraft*, 259 F.Supp. 733 (S.D.N.Y. 1966).

31. *Vacheron & Constantin-LeCoultre Watches, Inc. v. Benrus Watch Co.*, 155 F.Supp. 932 (S.D.N.Y. 1957), *modified*, 260 F.2d 637 (2d Cir. 1958).

The Copyright Office has had increasing difficulty in attempting to demarcate an acceptable dividing line. The Office uses as its touchstone what it considers the essence of the *Mazer* decision — a work of art, as that term has been historically construed, does not cease to be such solely because it is embodied in a useful article. In other words, the Court did not hold that a lamp base is a work of art. Rather, it held that a statuette of a human figure does not cease to be a work of art merely because it is used as a lamp base.

This reading of *Mazer* has led the Copyright Office to look somewhat metaphysically, for features “which can be identified separately and are capable of existing independently as a work of art, regardless of where those features appear.”<sup>32</sup> Under this approach, the Copyright Office has registered representational features such as floral motifs, scrolls and the like and refused to register functional designs where the Office is of the view that “the sole intrinsic function of an article is its utility.” These definitions have not yet been expressly reviewed by the courts. The difficulty of their administration is one of the reasons for the support by the Copyright Office of specialized legislation protecting designs to be discussed below.<sup>33</sup>

#### OTHER RAMIFICATIONS

The *Mazer* case is important not only because it involved an expansion of copyrightable subject matter in the field of design. As a result of this expanding, this area has been much more heavily litigated than other areas of copyright, with the result that important issues having wide applicability have been decided in the context of designs.

Questions of similarity have been very closely examined in this area.<sup>34</sup> The courts have been forced to grapple here, more than in other contexts, with the consequences of immaterial variations in the works in question.<sup>35</sup> They have been forced to answer the question most frequently asked by laymen with respect to copyright infringement matters: How similar is similar? What if a change is made here or there? The courts have been quite up to the task, making fine distinctions<sup>36</sup>

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32. 37 C.F.R. §202.10(c).

33. See *Hearings before Subcommittee on Patents, Trademarks and Copyrights of Senate Judiciary Committee on S. 1884, 87th Cong. 1st Sess. 9 (1961).*

34. See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, note 29, *supra*.

35. *Scarves by Vera, Inc. v. United Merchants and Manufacturers*, 173 F.Supp. 625 (S.D.N.Y. 1959).

36. Compare *John Wolf Textiles, Inc. v. Andris Fabrics, Inc.*, 138 USPQ 365 (S.D.N.Y. 1962) with *Condotti, Inc. v. Slifka*, 223 F.Supp. 412 (S.D.N.Y. 1963).



and thus contributing to the overall study of similarity in areas far removed from design.

Because of the competitive, commercial world in which designs are used, a number of questions have been explored relating to the availability of monetary relief. To begin with, questions of individual liability of officers of close corporations have been examined in this context.<sup>37</sup> The long-debated question whether the provision for recovery of "damages and profits" in section 101(b) of the Act really means what it says has been resolved in a design case in favor of a cumulative recovery.<sup>38</sup> The formulation of damage awards based on the copyright proprietor's sales lost as a result of the infringement has been made in hearings to determine monetary relief in textile cases.<sup>39</sup>

Another area more specifically concerned with designs also has wider ramifications. Expansion of copyright protection to textile fabrics has raised a number of questions as to the notice provisions of the law.<sup>40</sup> Despite the early inclusion of graphic works in the copyright law, most technical provisions of the law, including the copyright notice, were designed for books, periodicals, sheet music and the like. Upon expansion of coverage under *Mazer*, the lower courts were faced with the difficult task of applying these provisions to a new class of items. The result has been an almost uniform liberalization in construing the notice provisions. Thus, it has been held that a copyright notice on the edge or "selvage" of a bolt of textile fabric was sufficient even though the selvage was later cut off or sewn in when the fabric was made into a garment.<sup>41</sup> A copyright notice on only one of a pair of earrings has been held sufficient,<sup>42</sup> as has a notice on the *back* of a wall plaque<sup>43</sup> or on the packaging of a doll.<sup>44</sup>

37. *H. M. Kolbe Co. Inc. v. Shaff*, 240 F.Supp. 588 (S.D.N.Y.) *aff'd*. 352 F.2d 285 (2d Cir. 1965).

38. *Peter Pan Fabrics, Inc. v. Jobela Fabrics*, 329 F.2d 194 (2d Cir. 1964).

39. *E.g., Fruit of the Loom, Inc. v. Andris Fabrics, Inc.*, 227 F.Supp. 977 (S.D. N.Y. 1963).

40. Section 10 of the Copyright Law, 17 U.S.C. §10, provides that copyright is secured by publication "with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor . . ." Section 19 provides for the form of notice; Section 20 provides for its position, but makes no express provision with respect to works of art.

41. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.* note 29, *supra*.

42. *Boucher v. Duboyes, Inc.*, 253 F.2d 948 (2d Cir.), *cert. denied*, 357 U.S. 936 (1958).

43. *Coventry Ware, Inc. v. Reliance Picture Frame Co.*, 288 F.2d 193 (2d Cir.), *cert. denied*, 368 U.S. 818 (1961).

44. *Uneda Doll Co. v. Goldfarb Novelty Co.*, 373 F.2d 851 (2d Cir. 1967).

One of the most troublesome areas of copyright law has been the distinction between an idea and its expression, protection being available for the latter but not the former.<sup>45</sup> This proposition has been put to its most severe test in the area of design. For example, it has long been held that the copyright in a cartoon is infringed by a doll reproducing the cartoon in three-dimensional form.<sup>46</sup> On the other hand, the copyright in a sketch of a dress<sup>47</sup> or furniture<sup>48</sup> does not prevent another from reproducing the dress or furniture in three-dimensional form. This distinction, which survives *Mazer v. Stein*,<sup>49</sup> is not easy to explain and will undoubtedly continue to be explored in the context of graphic and sculptural works.

#### BEYOND COPYRIGHT

Prior to achieving success under copyright in the *Mazer* case in 1954, those seeking design protection attempted various routes, virtually all unsuccessful. The design patent<sup>50</sup> approach was found to be of doubtful value because of the high and subjective standards involved, as well as the time and expense required to secure such patent.<sup>51</sup> Unfair competition was also relatively unsuccessful<sup>52</sup> as was assistance from the Federal Trade Commission<sup>53</sup> or self-help.<sup>54</sup> Long before turning to existing copyright law, proponents of design protection sought new legislation tailor-made to the needs of designs.<sup>55</sup> Instead of the partial success in the *Mazer* case weakening this effort, the campaign for such protection has actually been stepped up since 1954.<sup>56</sup> One reason for this is the realization that the copyright law protects too few designs with too much pro-

45. See *Baker v. Selden*, 101 U.S. 99 (1880).

46. *King Feature Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924), *Fleischer v. Freundlich*, 5 F.Supp. 808 (S.D.N.Y. 1934).

47. *Adelman Inc. v. Sonners & Gordon, Inc.*, 112 F.Supp. 187 (S.D.N.Y. 1934).

48. *Lamb v. Grand Rapids Furniture Co.*, 29 Fed. 474 (W.D. Mich. 1889).

49. *Kashins v. Lightmakers, Inc.*, 155 F.Supp. 202 (S.D.N.Y. 1956).

50. 35 U.S.C. §171 provides for a patent covering "any new, original and ornamental design for an article of manufacture".

51. See *Hearings before Subcommittee on Patents, Trademarks and Copyrights of Senate Judiciary Committee, 89th Cong. 1st Sess.* 16 (1965); Note, 66 HARVARD L. REV. 877, 883 (1953).

52. See e.g., *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930).

53. *F.T.C. v. Klesner*, 280 U.S. 19 (1929).

54. *Fashion Originators' Guild of America v. F.T.C.*, 312 U.S. 457 (1941).

55. BIBLIOGRAPHY ON DESIGN PROTECTION (Copyright Office, 1959); Latman, *A Proposal for Effective Design Legislation: S. 2075 Examined*, 6 BULL. CR. SOC. 279 (1959).

56. Hearings, note 33 *supra*, at 31 ff.

tection.<sup>57</sup> Accordingly, a number of bills have been introduced into Congress since 1957, three of which have passed the Senate.<sup>58</sup> This legislation has had the support of the Copyright Office, the Patent Office, the bar and industry groups and, more recently, the President's Commission on the Patent System which recommended that "all provisions in the patent statute for design patent shall be deleted, and another form of protection provided."<sup>59</sup>

It would appear that in the absence of such another form of protection, we will witness continuation of the trend ushered in by the *Mazer* case and encouraged by more recent Supreme Court decisions<sup>60</sup> severely limiting unfair competition relief against copying. The predictable result would be coverage of an increasing number of works within a scheme of protection that fits only imperfectly.

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57. 5 BULL. CR. SOC. 139 (1958).

58. S. 1884, 87th Cong.; S. 776, 88th Cong.; S. 1237, 89th Cong.

59. Report of President's Commission on the Patent System, Recommendation IV, subd. 1.

60. *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

## PART II.

**LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS**

## 1. United States of America and Territories

## 204. U. S. CONGRESS. HOUSE.

H.R. 10510. A bill to amend the Communications Act of 1934 to authorize the Federal Communications Commission to issue rules and regulations and to issue orders with respect to community antenna systems, and for other purposes. Introduced by Mr. Stratton, April 23, 1969, and referred to the Committee on Interstate and Foreign Commerce. 4 p. (91st Cong., 1st Sess.)

The principal feature of this bill is a proposal that the FCC may not prohibit a CATV system from importing distant signals unless a television station can prove, by substantial evidence, that it is "failing as a direct result of the distribution of signals of television broadcast stations beyond their established reception areas."

## 205. U. S. CONGRESS. SENATE.

S. 543. Amendment intended to be proposed by Mr. Williams of New Jersey (for himself and Mr. Brooke, Mr. Dodd, Mr. Hartke, Mr. Scott, Mr. Murphy and Mr. Young of Ohio) to S. 543, a bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Referred to the Committee on the Judiciary, April 3, 1969. 23 p. (91st Cong., 1st Sess., Amdt. No. 9).

See Item 206, *infra*.

206. U. S. CONGRESS. SENATE. *Scott, Hugh*.

Amendment of the copyright revision bill. (115 *Congressional Record* S4726-S4727, no. 75, May 8, 1969.)

Senator Scott's statement that he is joining as cosponsor of the Williams amendment providing for a performance right in sound recordings with the insertion of a letter from Mr. Kaminstein, Register of Copyrights, to three interested groups supporting the amendment. That letter states the endorsement of the Copyright

Office for the principle of a performance right in sound recordings, but "notes that the Copyright Office is not taking a position on the royalties proposed in the amendment," and "encourages all concerned parties to reconcile their differences and attempt to arrive at license-fee arrangements which would be acceptable to all."

207. U. S. CONGRESS. SENATE.

S. 1774. 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. Hart, April 3, 1969, and referred to the Committee on the Judiciary. 27 p. (91st Cong., 1st Sess.)

Identical to H.R. 3089, introduced by Mr. Ford on January 13, 1969, and H.R. 4209, introduced by Mr. St. Onge on January 23, 1969. See 16 BULL. CR. SOC. 167, Item 130.

208. U. S. CONGRESS. SENATE. *Williams, Harrison A., Jr.*

Performance rights amendment to S. 543, the Copyright Bill — Amendment. (115 *Congressional Record* S3535-S3539, no. 57, daily ed. Apr. 3, 1969.)

Senator Williams' remarks, upon his introduction of an amendment to the general revision bill, providing for a performance right in sound recordings. The amendment differs from the one the Senator introduced in the 90th Congress in that it reflects proposals, since the previous session, of proponents with respect to "a simple and equitable system, under the regulations of the Register of Copyrights, for the collection and distribution of performance royalties." Senator Baker of Tennessee follows with a statement expressing reservations about some of the provisions of the Williams amendment, but firmly supporting the attempt to secure performance rights in sound recordings.

## 2. Foreign Nations

209. BELGIUM. *Laws, statutes, etc.*

La législation belge sur les brevets, les marques, les modèles et le droit d'auteur. Belgian patent, trademark, design and copyright laws. Bruxelles, Bureau Vander Haeghen [1969]. 58 p.

"This booklet contains the main provisions of the Belgian laws and rules (including their subsequent amendments) concern-

ing the patents, trademarks, designs and copyright, with their English translation facing them."

210. BYELORUSSIA. *Laws, statutes, etc.*

Codice civile — Sezione IV — Articoli 472-511: Disposizioni sul diritto d'autore. (39 *Il Diritto di Autore* 548-559, no. 4, Oct.-Dec. 1968.)

An Italian translation of the copyright provisions in the Civil Code of the Soviet Socialist Republic of Byelorussia.

211. CZECHOSLOVAK REPUBLIC. *Laws, statutes, etc.*

Legge 25 marzo 1965, n. 35, riguardante le opere letterarie, scientifiche ed artistiche (legge sul diritto d'autore). (39 *Il Diritto di Autore* 532-548, no. 4, Oct.-Dec. 1968.)

An Italian translation of the Czechoslovak Copyright Law of 1965.

212. LIBYA. *Laws, statutes, etc.*

Law on the protection of copyright. (No. 9, of 1968.) (5 *Copyright* 116-121, no. 6, June 1969.)

BIRPI translation of the law which entered into force on March 30, 1968.

213. LIBYA. *Laws, statutes, etc.*

Loi relative au droit d'auteur du 16 mars 1968. (39 *Il Diritto di Autore* 560-572, no. 4, Oct.-Dec. 1968.)

The French version of the Libyan Copyright Law of 1968.

214. RUMANIA. *Laws, statutes, etc.*

Decree amending Article 40 of Decree No. 321/1956 relating to copyright. (No. 1172, of December 28, 1968.) (5 *Copyright* 121, no. 6, June 1969.)

An amendment which makes any false attribution of authorship concerning an intellectual work a criminal offense punishable by imprisonment or by a fine.

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## PART III.

## CONVENTIONS, TREATIES AND PROCLAMATIONS

## 215. NORWAY.

Exchange of notes between the Government of Spain and the Government of the Kingdom of Norway concerning the extension of the term of copyright protection. (Of June 4 and July 11, 1968.) (5 *Copyright* 115, no. 6, June 1969.)

This exchange of notes constitutes an agreement between the Governments of Spain and the Kingdom of Norway that the provisions of the Norwegian Act of June 3, 1966, modifying the Act of December 2, 1955, relating to the provisional extension of the copyright term, would apply in Norway to works of Spanish nationals and to those published works which are considered as having Spain as their country of origin, in the case they have not yet fallen into the public domain in Norway, with reciprocal extension of the term of protection in Spain for works of Norwegian nationals. See 14 BULL. CR. SOC. 179, Item 89 (1966).

216. UNIVERSAL COPYRIGHT CONVENTION. *Tunisia.*

The United States Department of State has been informed by the Director-General of UNESCO that Tunisia deposited its instrument of accession to the Universal Copyright Convention on March 19, 1969. Tunisia is the 58th country to become a party to the Universal Copyright Convention.

In accordance with Article IX, paragraph 2, of the Convention, the latter will come into force with respect to Tunisia on June 19, 1969, three months after the deposit of the instrument of accession.

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## PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## 1. Federal Court Decisions

217. *Concord Fabrics, Inc. v. Marcus Brothers Textile Corp.*, 161 USPQ 3 (2nd Cir., March 12, 1969) (*Per curiam*). For decision below, see Item 218, below. In reversing the decision of the Southern District of New York, the Court of Appeals said in part:

The design on both plaintiff's and defendant's fabric consists of a circle within a square within a square with the dimensions of the circles and squares being identical. The colors are essentially the same, although the defendant's are somewhat brighter and more garish. The designs within the circles, between the squares, and around the outer square, while having some differences, give the same general impression on both samples. While the trial court placed great emphasis on the minor differences between the two patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff. For example, the frames around the border on the defendant's sample are similar but run in opposite directions from the plaintiff's figures. The same is true of the figures around the outer part of the circle. In sum, a comparison of the samples strongly suggests that defendant copied plaintiff's basic design, making only minor changes in an effort to avoid the appearance of infringement.

218. *Concord Fabrics, Inc. v. Marcus Brothers Textile Corp.*, 296 F.Supp. 736, 161 USPQ 31 (S.D.N.Y., Feb. 26, 1969) (Edelstein, J.)

Motion for preliminary injunction in action between textile converters for infringement of copyright in a certain design pattern.

*Held*, motion denied.

Stating that although "it is well settled in [the Second Circuit] that in copyright infringement cases a preliminary injunction should issue



when the plaintiff has made out a prima facie case of infringement even without his having made a detailed showing of irreparable harm. . . .” plaintiff must still demonstrate a “reasonable probability” of ultimately prevailing on the merits, the court found plaintiff to have shown, “at worst”, merely that defendant used an idea of plaintiff’s and, at any rate, that the ordinary observer test failed to disclose substantial similarity between the parties’ designs. The court said:

The copyright in the instant case protects plaintiff’s particular motif — his original artwork. It does not protect the basic handkerchief design which is a common and popular one throughout the woman’s clothing industry. Consequently, any similarities must be found in the designs within the large squares which compose the handkerchief and not in the squares themselves. Plaintiff makes no claim that his copyright grants him the exclusive right to produce the handkerchief design.

The artwork within the squares does include some similarities, but the differences are at least as striking. In fact, other than the use of an inner circle and a circular design therein, defendant’s motifs are distinguishable from plaintiff’s. For example, defendant’s work has approximately 25 daisies in each handkerchief motif which are not found in plaintiff’s pattern, and plaintiff’s pattern has 12 geometrical designs and 32 kidney-shaped designs which have no counterpart in defendant’s pattern. . . .

At worst, what defendant has done here is to use an idea of plaintiff’s, to wit, the imposition of a smaller square and a circular design therein within the framework of a large handkerchief design. That the usurping of an idea as compared to the usurping of the expression of that idea is protected is clear. . . .

In any event, it is clear that the ordinary observer unless he set out to overlook the disparities, would be disposed to detect them and to regard their aesthetic appeal as somewhat different.

219. *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 161 U.S.P.Q. 119 (S.D.N.Y., Jan. 13, 1969) (Mac Mahon, J.)

Plaintiff’s motion for summary judgment in action for copyright infringement. Plaintiff purchased the textile design at issue from the creator thereof, engraved the design on printed rollers from which it was printed on fabric, and registered the printed design with the Copyright Office as a reproduction of a work of art. Defendant countered with a motion for summary judgment based on the alleged invalidity

of plaintiff's copyright and asserted that questions of fact on the issue of copying precluded the granting of plaintiff's motion.

*Held*, summary judgment for plaintiff.

I. *Validity of the Copyright:*

The design not having been "copyrighted" prior to its sale to plaintiff, defendant urged that such sale placed the work in the public domain. The court, however, held that a divestative publication had not occurred under the restrictive circumstances of sale:

The designer never offered any designs for sale to the general public. Rather, a few trusted customers were allowed to see the designs in confidence. No copies or sketches could be made until after purchase. Relying on these procedures, plaintiff purchased the [design] and all rights to it. A sale under these circumstances is not a publication and does not place the work of art in the public domain.

Although defendant argued that plaintiff had added nothing original to the purchased design and thus could not claim copyright therein as a reproduction of a work of art, the court found that some element of originality had been added at the engraving stage and, further, that even absent such contribution, plaintiff was entitled to claim copyright in the design as a work of art. The court said:

The testimony . . . shows that the design as purchased had to be embellished and expanded before it could be engraved on the rollers. This slight addition is a very modest grade of originality. Nevertheless, it is sufficient.

Even if nothing were added and the reproduction were an exact copy of the design, still the design or an exact copy of it could have been copyrighted as a work of art. The classification, here under 17 U.S.C. §5(h) as a reproduction of a work of art, is at most mere error and does not "invalidate or impair the copyright protection \* \* \* \*" [17 U.S.C. §5].

Defendant also asserted that the design itself lacked originality, but the court again held for plaintiff.

[Defendant] points to its expert's affidavit that plaintiff's design is similar to floral patterns used at the turn of the century. The similarities described, however, are limited solely to the daisy-like features of plaintiff's design and the designs used at the turn of the century. Plaintiffs do not argue that a daisy or any reproduction

of it or its features is original. Their argument is that "the juxtaposition of these flowers and their arrangement on the plain background \* \* \* and the layout and combination of the separate features are completely original". The argument is supported by the affidavit of plaintiff's designer. Plaintiff's assertion of originality is not called into question by defendant's affidavit which is directed at an entirely different and irrelevant question. Moreover, the ordinary observer would easily discern that plaintiff's design is completely different from the turn of the century patterns.

II. *Infringement*: The court found that undisputed access and a "remarkable" similarity between plaintiff's and defendant's designs justified the granting of summary judgment for plaintiff.

220. *Higgins v. Woroner Productions, Inc.*, 161 U.S.P.Q. 384 (D. Fla., Feb. 27, 1969) (Cabot, J.)

Defendant's motion for summary judgment in action for copyright infringement. *Held*, motion granted. Plaintiff offered no direct proof of copying and its proofs suggested only a "bare possibility" of access. The court said:

The only material evidence in the record as to access shows that at one time all three of the works to which plaintiff claims copyrights were in the Copyright Office and later transferred to the Library of Congress. Only one of the three is presently on file in the Library of Congress.

While there is evidence that the President of [defendant] was in Washington D. C. in 1958 . . . he has denied copying or even knowing about plaintiff's works . . . and plaintiff has stated he does not know whether [defendant's president] picked up copies of his works in Washington.

The court is of the opinion that the bare possibility of access is insufficient to establish indirect proof of copying and that on the record . . . there is no evidence of copying by the defendants. . . .

## 2. State Courts

221. *Stevens v. National Broadcasting Company*, Not yet reported (Cal. Ct. App., March, 1969) (Lillie, J.). *For decision below*, see 14 BULL. CR. SOC. 397, Item 295 (Cal. Super. Ct., 1967); *for decision on motion for preliminary injunction*, see 148 U.S.P.Q. 755 (Cal. Super. Ct., 1966), 13 BULL. CR. SOC. 348, Item 356 (1966); *for decision in contempt proceeding*,

see 150 U.S.P.Q. 96 (Cal. Super. Ct., 1966), 14 BULL. CR. SOC. 188, Item 96 (1966).

Plaintiff's appeal in action for breach of contract, unfair competition and declaratory judgment in dispute centering around the right to cut and edit motion pictures shown on television with interruptions and deletions for commercials.

*Held*, affirmed.

Plaintiff George Stevens' employment contract as a motion picture producer-director with Liberty Films, assigned with consent to defendant Paramount Pictures, contained (i) a grant to plaintiff of "sole control of the production and direction" of photoplays to be produced by him and a mention of his right to "edit, cut and score" such photoplays ("Paragraph Second"); (ii) an agreement by plaintiff that all "material or intellectual property that [plaintiff] may create or contribute during [his] employment . . . shall be [Liberty's] sole property. . . ." ("Paragraph Fifth"); (iii) a form of screen and advertising credit to plaintiff to be used for such pictures ("Paragraph Eighth"); and (iv) an agreement by plaintiff that "each photoplay produced or directed by [plaintiff] . . . shall conform to the requirements and standards set by the terms of any contract for the distribution of said photoplays which we may enter into. . . ." (Paragraph Sixteenth").

The lower court held that Paramount had the right to license the photoplays for television exhibition with interruptions for commercials (and that defendant NBC, as Paramount's licensee, had the right to thus exhibit the pictures) based upon its finding that the "interruption of the pictures for the insertion of commercials in the television program is not cutting and editing as referred to in plaintiff's employment contract" since such rights did not extend past completion of the pictures. Plaintiff contended that the evidence was insufficient to support this finding and that he retained the right to cut and edit both before and after completion, but the appellate court, considering the contract as a whole and custom and usage, sustained the decision. The court said:

Although they do not deal expressly with "editing" and "cutting," consideration necessarily must be given to paragraphs FIFTH, EIGHTH and SIXTEENTH because it is the statutory rule that "The whole of a contract is to be taken together, so as to give effect to every part, if reasonably practicable, each clause helping to interpret the other." (Civ. Code, §1641.) Under FIFTH, *supra*, Liberty was specifically granted the sole ownership of the pictures produced with "all rights therein and benefits therefrom." Too, the contract being

one of employment, the rule is settled that "Where an employe creates something as part of his duties under his employment, the thing created is the property of his employer unless, of course, by appropriate agreement, the employe retains some right in or with respect to the product. [Citation.]" (*Zahler v. Columbia Pictures Corp.*, 180 Cal. App. 2d 582, 589.) Accordingly, in the present case, was there an appropriate provision restricting or limiting Liberty's otherwise complete dominion over the "products" in question which is reflected in the provisions of the FIFTH paragraph? We find such restrictions in the EIGHTH, *supra*, whereunder plaintiff is given film credits by the legend therein expressly spelled out, but we find no such express covenant in paragraph SECOND giving plaintiff, as he contends, the exclusive right to edit, cut and score his pictures at all stages, both before and after completion. Nothing at all being therein stated about post-production editing, the meaning asserted by plaintiff must arise by implication from the language used. But, as shown by controlling decisions, implied covenants are held to be justified only when not inconsistent with some express term of the contract and when, in the absence of such implied term, the contract could not be effectively performed. (*Tanner v. Title Ins. & Trust Co.*, 20 Cal. 2d 814, 824.)

In two partially similar cases, neither of which is mentioned in appellant's briefs, the principle referred to in *Tanner* was applied. The first, *Lillie v. Warner Bros. Pictures, Inc.*, 139 Cal. App. 724, involved a contract under which defendant Warner Bros. acquired "full ownership in the picture, subject only to the limitations contained in the contract." (P. 728.) Since there were apparently no specific limitations upon the artist's right to prevent exhibition of the picture as a short, it was held that defendant's acquisition of its full ownership "included the right to use the picture publicly in any form of exhibition, except as such right is limited by the terms of the contract." (P. 728.) In the second case, *Republic Pictures Corp. v. Rogers* (9th Cir.) 213 F.2d 662, it was contended by the artist that the exhibition of motion pictures, wherein he was the leading actor, upon commercially sponsored television programs constituted an advertising use of his name, picture and voice, which right was not granted by the contract in suit. After noting that the actor had been paid full measure for his services in creating the films, and had specifically relinquished all rights of every kind and character therein, the court held (citing *Tanner*) "We are bound to give effect to the meaning of that agreement, that grant, and are bound not to cut it down by implication from another grant unless

it is necessary to the effective operation of the contract.” (P. 666.) Implied covenants not being favored and resorted to only when they are indispensable to effectuate the intention of the parties, the provisions of paragraph SIXTEENTH militate against their use to plaintiff’s advantage in the present case. Under SIXTEENTH the parties agreed that the pictures “shall conform to the requirements and standards set by the terms of any contract for the distribution of said photoplays which we may enter into. . . .” If the contract be taken by its four corners, paragraph SECOND when read with paragraph SIXTEENTH does not call for the construction advanced by plaintiff; certainly, if Liberty was to have the normal right of an owner to effect distribution, it had the accompanying right to take such steps as would “conform to the requirements and standards” specified in the instrument at bar. Furthermore, under paragraph SECOND the sole control of the several films given to plaintiff governs their “production” and not their distribution.

We deem it unnecessary to further pursue the instant point. The lower court’s finding is supportable on the basis of the express language used in the contract; and, in any event, the extrinsic evidence introduced during the course of the trial, both as to custom and usage and the contemporary conduct of the parties, amply sustains the determination presently challenged. Disregarding, as we must, testimony to the contrary, it was shown by competent witnesses that “production” activities were distinct from “distribution” activities. Thus, the term “production” was defined as “the making of the picture up to the delivery of a completed picture to the company that was either the employer or to the distributor of the picture.” Similar testimony was given by Jack L. Warner, who produced his first picture in 1912 and who, at the time of trial, had been involved in the making of more than 5000 films. The effect of such testimony clearly negated plaintiff’s claim that the right to edit, cut and score under his “sole control of production” included cutting and editing after the picture’s completion. Nor can we accept plaintiff’s argument that the question as to the meaning of the terminology is one of law (*Parson v. Bristol Development Co.*, 62 Cal. 2d 861); to the contrary, the correct rule governing here is that where extrinsic evidence has been admitted, and it is in conflict, any reasonable construction below will be sustained. (*Alperson v. Mirisch Co.*, 250 Cal. App. 2d 84, 95.)

In addition to the above testimony favoring the interpretation reached by the trial court, evidence was received indicating that Liberty Films, at or about the time of the execution of the agree-

ment, was granting post-production cutting and editing rights to pictures which it owned. . . . [P]laintiff was one of three parties (producers and directors) who controlled Liberty, and admittedly he was consulted on major questions of company policy. Two such written contracts of Liberty were received in evidence, one dated before and one after the instant agreement. Defendants properly point out that if these two documents followed the custom of owners in allowing others to re-cut and re-edit its films in the course of distribution, all the parties thereto interpreted paragraph SECOND in a manner wholly inconsistent with that presently advanced by plaintiff. Of interest is the granting in said documents of television rights; and of equal interest is the fact that one such picture was to be produced by Mr. Capra whose employment contract, according to plaintiff, was "in all essential matters the same." Of course, plaintiff was not a party in his individual capacity to either of the two contracts mentioned, thus he questions whether he is bound by the principle that the conduct of the parties, subsequent to the execution of the agreement, may be considered in determining its meaning. (*Universal Sales Corp. v. Cal. etc. Mfg. Co.*, 20 Cal. 2d 751, 761.) The evidence certainly establishes custom and usage; and we are also inclined to the view that in light of plaintiff's close relationship to the management of Liberty's business affairs, the construction apparently given the pertinent language by his business associates might well be imputed to him.

The lower court also found that certain deletions made in the pictures to accommodate commercials *were* a technical breach of plaintiff's agreement:

Under plaintiff's employment agreement the unusual and rare grant to plaintiff of sole control over production prevented subsequent deletions not required for distribution of the picture. The deletions which were made were not a requirement for distribution of the picture on television. The particular format used and time period allocated for the television exhibition allowed the motion picture to be shown in its entirety. The deletions were made with the intent to smooth the transition from the motion picture to the commercials and to improve the television exhibition. The deletions were a technical breach of plaintiff's employment contract.

Defendant argued that this finding, and the finding that the interruptions were *not* such a violation, were necessarily inconsistent. The appellate court, however, viewed the deletion finding as resting on the

“exclusive right of production” rather than the specific right to “cut and edit” and found the divergent treatment of the interruptions and deletions to be justified by the distinct effects on the “content of the picture”. The court said:

Contrary to plaintiff’s contentions, the trial court did not find that the subject deletions were “cutting and editing” as referred to in his employment contract; instead, and based upon evidence of custom in that regard, the court inserted in its deletions finding the proviso excepting deletions which were required for distribution of the picture: “Under plaintiff’s employment agreement the unusual and rare grant to plaintiff of sole control over production prevented subsequent deletions not required for distribution of the picture.” The finding further declared that the deletions were unrelated to any requirement for distribution, clearly implying that they affected the content of the picture. The effect on the film’s content was otherwise, however, with respect to the commercials which plaintiff refers to as the injection of foreign matter in the film itself. The court viewed the television program, and there was testimony by qualified witnesses that the picture was not changed nor the content affected by the commercial interruptions. As declared in the lower court’s finding on the interruptions “The integrity of the picture was preserved.” No contradiction appears; too, any claimed inconsistencies fall far short of the requirements warranting a reversal. . . .

The lower court had awarded plaintiff nominal damages for the technical breach due to deletion and plaintiff argued it was error to award damages yet refuse an injunction. The appellate court again sustained the action below:

Plaintiff’s final point is that it was error to deny an injunction and award any damages. The lower court found upon conflicting evidence that plaintiff suffered no actual damage as a result of defendants’ conduct; for example, Jack Warner testified that plaintiff’s ability to command the highest compensation was not adversely affected by the televising of his films. Since plaintiff admits that evidence on both sides of the issue was offered, and since the granting of a permanent injunction is largely within the discretion of the court . . . under no circumstances can it be said that appellate interference is called for as to this aspect of the case.

[*Editors’ Note:* For related decisions on the issue of commercial “mutilation” of televised motion pictures, see *Preminger v. Columbia Pictures Corp.*, 267 N.Y.S.2d 594, 148 U.S.P.Q. 398 (Sup. Ct. 1966), 13



BULL. CR. SOC. 199, Item 222 (1966), *aff'd*, 25 A.D.2d 830, 269 N.Y.S.2d 913, 149 U.S.P.Q. 872 (1st Dep't. 1966), 14 BULL. CR. SOC. 103, Item 30 (1966), *aff'd without opinion*, 18 N.Y.2d 659, 150 U.S.P.Q. 829 (1966); *Autry v. Republic Pictures, Inc.*, 213 F.2d 667, 101 U.S.P.Q. 478 (9th Cir. 1954), 2 BULL. CR. SOC. 7, Item 13 (1954), *cert. denied*, 348 U.S. 858 (1954), 2 BULL. CR. SOC. 37, Item 91(a) (1954).

An interesting article relating the charges of the *Stevens* and *Preminger* cases to "the difference between theatrical film and television screen shapes" appears in *Variety*, January 3, 1968 at 17, col. 1-5 (*see also*, *Variety*, October 9, 1968 at 7, col. 3) in connection with which one may consider the recent production of motion picture films specifically for television exhibition. For a noted critic's views on the "mutilation" issue, see Jack Gould's column entitled "We Interrupt This Commercial for a Movie" in the *New York Times* of December 3, 1967 p. D21, col. 1-3, and compare his comments on commercial interruptions of television drama (*Id.* at p. 80, col. 3-4) and special events coverage (*New York Times*, December 11, 1967 at 44, col. 1-4). Professor Nimmer considers the issue in a moral rights context in the 1969 *Supplement* to Section 110 of Nimmer on Copyright and Alexander Lindey takes an industry self-regulation approach to the problems raised in these cases, reviewed in 1 Lindey, *Entertainment, Publishing and the Arts - Agreements and the Law*, 1969 *Supplement* at lxxxiv-lxxxviii.

Finally, the obverse of the "mutilation" issue as raised in these cases should also be considered — i.e., the "padding" of motion pictures for television exhibition by the addition of outtakes and even "the deliberate filming of new scenes, having no plot connections with the film in question, solely for padding purposes". *Variety*, January 17, 1968 at 1, col. 5.

J.A.B.]

222. *Gordon v. Warner Bros. Pictures, Inc.*, 161 U.S.P.Q. 316 (Cal. Ct. App. Jan. 22, 1969) (Moss, J.)

Defendant's appeal from judgment for plaintiff in action to recover damages for title piracy. Plaintiffs are the authors of "FBI Story", a copyrighted novel depicting the fictitious exploits of an FBI agent nicknamed "Rip" and including a female character named "Lorrie", the agent's fiancée. Defendant released a motion picture entitled "The FBI Story" which was based on a best-selling non-fiction study of the FBI authored by Don Whitehead under the same title (with subtitle, "A Report to the People"). The motion picture dramatization of the Whitehead book incorporated a fictitious FBI agent nicknamed "Chip"

and his wife "Lucy". The trial court rendered judgment for plaintiff in the amount of \$54,800 on a jury verdict.

*Held*, reversed.

I. *Copyright*. The court said:

Plaintiffs have never contended that defendant's motion picture borrowed anything from their book other than its title. While plaintiffs note the similarity in the nicknames of the special agents and in the names of respective ladies, they do not claim that this similarity entitles their characters to copyright protection, *as indeed they could not*. See *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315, 317-318, 153 USPQ 649, 651-653 [15 BULL. CR. SOC. 37, Item 23 (1967)]; Nimmer on Copyright (1968) §30, pp. 134.1 et seq. Plaintiffs also recognize that they cannot claim copyright protection for their title. *Jackson v. Universal Intl. Pictures, Inc.*, 36 Cal.2d 116, 121, 87 USPQ 131, 134-135; Nimmer, *supra*, §34, p. 140; see *Netterville and Hirsch, Piracy and Privilege in Literary Titles*, 32 So. Cal. L.Rev. 101, 109. Therefore, their claim against defendant must rest upon the theory of unfair competition.\*

II. *Unfair Competition*. The court held that plaintiff might recover only upon a showing that their title had acquired a secondary meaning identifying the book exclusively with them and that the trial court had erroneously instructed the jury on the definition of secondary meaning and had failed to properly instruct on the relation between secondary meaning and priority of use. The court said:

A sine qua non of protection of titles on a theory of unfair competition is the establishment by the plaintiff of a secondary meaning in his title. . . .

The California Supreme Court has stated the rule as follows: "If plaintiff proves that the name or word has been so exclusively identified with his goods or business as to have acquired a secondary meaning, so as to indicate his goods or business *and his alone*, he is entitled to relief against another's deceptive use of such terms, but if he fails in such proof, he is not entitled to relief." (Italics added.) *Academy of Motion Picture Arts & Sciences v. Benson*, 15 Cal.2d 685, 690, 46 USPQ 488, 490; *Cowles Magazines & Broadcasting, Inc. v. Elysium, Inc.*, *supra*, 255 Cal.App.2d at 735. The Restatement of Torts, *supra*, §717, Comment (f), states, "A designation is a trade name only if, apart from other requirements, it has acquired a

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\* Emphasis added.

special significance as the name of the goods, services or business of *one person*. Until the designation has acquired this special significance, it is not protected as a trade name. Acquisition of this special significance, rather than priority of use, is, therefore, a necessary condition of protection against infringement of a trade name." (Italics added.) It can be seen from the foregoing statements of the rule of secondary meaning that a plaintiff "must show that his mark means him, else he cannot prevent others from using it." L. Hand, J., *Bayer Co. v. United Drug Co.*, 272 F. 505, 513.

The trial court refused an instruction offered by defendant which included a definition of secondary meaning in accord with the law as stated above and on its motion gave the following definition to the jury: "By a 'secondary meaning' is meant that the author's title has achieved recognition as associated or identified with his literary property in the minds of a substantial number of the public." The vice of this definition lies in the use of the phrase, "as associated or identified with." "Associated with" means "closely connected." (Webster's Third International Dictionary, G. & C. Merriam Co., 1964 ed.) "Identified with" has a similar meaning. (See Fowler, *Modern English Usage*, 2d ed p. 260.) To say that the title "FBI Story" is closely connected with plaintiffs' book in the minds of a substantial number of the public is not the same thing as to say that the title has been so exclusively identified with plaintiffs' book so as to indicate their book, and theirs alone, since as this case illustrates, it is possible to say that the title "FBI Story" was closely connected in the minds of a substantial number of people with both plaintiffs' and Whitehead's book. The error in the instruction given was aggravated by the failure of the court to instruct the jury, as requested by defendant, that "mere priority of use does not create or establish a secondary meaning for a title." The proposed instruction is a correct statement of the law (*Family Record Plan, Inc. v. Mitchell*, 172 Cal.App.2d 235, 243, 122 USPQ 414, 417; *Restatement of Torts*, supra, §717, Comment (f), and the court's failure to give it gave rise to the possibility that the jury could find that plaintiffs' title had acquired a secondary meaning as the name of their book by reason of the fact that their book was published first even though the jury also found that the title was also closely connected in the minds of a substantial number of people with Whitehead's book. In view of the fact that Whitehead's book was shown to have achieved considerably wider circulation than plaintiffs' book before the release of defendant's motion picture, the probability that the jury was misled by the errors in

the instructions is substantial, and, therefore, the errors were prejudicial.

III. *Title Piracy and Pre-emption.* Because, said the court, an action for money damages for unfair competition requires a showing of fraudulent intent, the action was held not barred by *Sears and Compco*. The court said:

Defendant contends that it was entitled to judgment as a matter of law because under the decisions of the United States Supreme Court in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 140 USPQ 524, and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 140 USPQ 528, even if it were proved that the title of the motion picture was actually copied from plaintiffs' book the court had no power to award damages for such copying. Defendant argues that plaintiffs' title is not protected by copyright and, therefore, that the doctrine of *Sears and Compco* . . . precludes protection under a theory of unfair competition. . . . We need not examine in detail the preemptive effect of *Sears and Compco* on the law of unfair competition as applied to titles because in this case, if plaintiffs are entitled to damages at all they must necessarily prove facts that would place this case within an express exception to the rule of federal preemption laid down in those cases. In *Compco*, the court stated the exception as follows: "A State of course has power to impose liability upon those who, 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." 376 U.S. at 238, 140 USPQ at 530-531. Although in an action for injunctive relief against unfair competition it is unnecessary to prove that the defendant's conduct was fraudulent. . . . such proof is required to establish a claim for damages. . . . Upon a retrial in order to recover damages, plaintiffs must prove as an essential element of their cause of action that defendant copied the title "The FBI Story" from plaintiffs with the intent to deceive the public into believing that its motion picture was based upon or connected with plaintiffs' book. *Sears and Compco* expressly do not preclude recovery upon such a showing.

223. *Wallace v. Helm*, 161 U.S.P.Q. 121 (Cal. Super. Ct., Feb. 3, 1969) (Davis, J.)

Action for infringement of common law copyright. Plaintiff building contractor created an original design for a private home which he expressed in the form of a preliminary drawing and then had reduced

to detailed working drawings by defendant M & S Drafting Associates. Plaintiff subsequently constructed a home for certain persons from blueprint copies of the working drawings and gave such persons a copy of the blueprints solely for their own use, taking from them an assignment of all rights in the house plan. Shortly thereafter, defendants Helm and Priamos decided to construct a house for sale similar to that constructed by plaintiff. Plaintiff refusing to sell any copies of the blueprints, Helm and Priamos purchased copies from M & S and constructed a home therefrom which they later sold at a loss.

*Held*, judgment for plaintiff.

The court held that plaintiff was the owner of exclusive rights in the plan expressed in the preliminary drawings under Cal. Civ. Cd. §980 (b); that plaintiff, "as hirer of" M & S was similarly the owner of all rights in the working drawings prepared by M & S during the course of its employment by plaintiff; that "plaintiff's acts in building a house from blueprint copies of said working drawings for particular customers of his, and delivery to such customers of a copy of said plans solely for their own use and not to reproduce the same, did not constitute a general publication of plaintiff's property rights in his said original working drawings under [Cal.] Civil Code Section 983(b)"; and that defendants had converted plaintiff's working drawings to their own use to the damage of plaintiff.

The court ascertained the value of the working drawings at \$1,200 and rendered judgment for plaintiff in that amount with an injunction against future infringement; an accounting of profits from Helm and Priamos was denied as no profit had been realized by these defendants.

*Also of interest:*

224. *Reno v. Cinerama Releasing Corp.*, N.Y.L.J., March 17, 1969 at 17, col. 1 (Sup. Ct. N.Y. Co., 1969) (Schweitzer, J.)

The complaint herein alleged that defendant's motion picture, "Custer of the West", falsely depicted plaintiff's great-uncle and that defendant knew or should have known that the fictitious portrayal would cause persons "to utter scurrilous remarks to and about plaintiff".

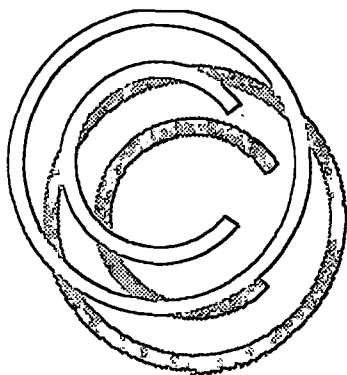
*Held*, complaint dismissed: Although one need not label his cause of action, "[c]learly the complaint sounds in libel and as such it cannot be sustained. It is settled law that a libel or slander upon the memory of a deceased person not reflecting upon his relatives does not give rise to a cause of action for defamation. . . ."

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NEW SERIES OF ANNUAL LECTURES ON COPYRIGHT  
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*The Donald C. Brace Memorial Lectures*

At the annual meeting of the Board of Trustees of The Copyright Society of the U.S.A. in May 1969, the following Resolution was passed:

WHEREAS, Mrs. Donna Brace Ogilvie, the daughter of the late Donald C. Brace, has proposed the sponsorship by The Copyright Society of the U.S.A. of a lecture on copyright to be named The Donald C. Brace Memorial Lecture (or words to similar effect); and

WHEREAS, Mrs. Ogilvie has graciously offered to contribute the sum of \$5,000 to the Society for such purpose, conditioned upon the use by the Society of said sum and any income therefrom to sponsor said Lecture at least annually until the said gift is exhausted; and

WHEREAS, the late Donald C. Brace was a co-founder and President of the firm of Harcourt, Brace & Co., and dedicated himself to a publishing career of the highest distinction; and

WHEREAS, the Executive Committee of the Society at its meeting on April 10, 1969 has recommended that the Board of Trustees accept the offer of the said contribution;

NOW, THEREFORE, BE IT

RESOLVED, that the Society gratefully accepts the kind offer of Mrs. Donna Brace Ogilvie to make said contribution to the Society to be used as aforesaid to sponsor The Donald C. Brace Memorial Lecture; and

FURTHER RESOLVED, that following receipt of Mrs. Ogilvie's gift, the Society shall make appropriate plans for the inception of The Donald C. Brace Memorial Lecture series at the earliest opportunity; and

FURTHER RESOLVED, that the Secretary of the Society is hereby authorized and directed to transmit this resolution to Mrs. Ogilvie together with an expression of the profound gratitude of the Society; and

FURTHER RESOLVED, that this resolution shall be published in the *Bulletin* of the Society.

## *The Lectures*

It was suggested during the discussion by the Board of Trustees of the Society that, since the Jean Geiringer Memorial Lecture, given annually for the past seven years, is devoted to international copyright matters, the proposed Brace Lecture could primarily be devoted to domestic copyright matters.

### *Donald Clifford Brace*

Donald Clifford Brace died at the age of 73 years on September 20, 1955. He was co-founder in 1919 with his Columbia College class-mate, the late Alfred Harcourt, of the firm, Harcourt, Brace & Co., now Harcourt, Brace & World, Inc. Mr. Brace received the Columbia University Medal for Excellence, awarded in 1950 in recognition of his firm's list of 1400 notable publications, which ranged from the early poems of Carl Sandburg and the latter's six-volume "Abraham Lincoln", and "Main Street" by Sinclair Lewis, to such post-World War I classics as John Maynard Keynes' "The Economic Consequences of the Peace" and "Germany Prepares for War", published in 1933 and written by the German professor, Dr. Ewald Banse, and which was banned in Germany but received with serious attention in France and England.

We are indebted to Mr. Paul Gitlin, Treasurer of our Society, through whom Mrs. Donna Brace Ogilvie's gift was tendered to the Society, for the following illuminating memoir of Donald Brace, which was written in 1955 by the late T. S. Eliot, O.M., for the London press:

The death of the New York publisher Donald Brace will be noted with sincere regret in the world of letters in this country. When, shortly after the First World War, Alfred Harcourt and Donald Brace founded the publishing house which bears their name, the task of establishing relations with British publishers, literary agents, and authors devolved upon the latter. Brace's acumen brought the firm *The Economic Consequences of the Peace*, a book which earned them both prestige and profit. By Maynard Keynes, Brace was put in touch with such authors as Virginia Woolf and Lytton Strachey.

No American publisher was better known or better liked in the literary world of my generation. His English friends will remember his keen sense of humour, which, expressed in his very slow and deliberate speech, was at times irresistibly droll. And they will remember most gratefully the confidence which he inspired as a publisher, by his combination of Yankee shrewdness, loyalty to his authors' interests, and sweetness of temper.

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PART I.

ARTICLES

225. CURRENT UNITED STATES DEVELOPMENTS IN  
COPYRIGHT LAW\*

By MORTON DAVID GOLDBERG\*\*

I. *Federal Legislation and Regulations*

*General revision.* On the all-important subject of general copyright revision, there is, alas, less here than meets the eye. George Cary, the Deputy Register, is reporting to you on developments (or lack thereof) in this area; and I shall therefore confine myself to only a brief mention of it.

In the last Congress, H.R. 2512 (90th Cong., 1st Sess.) passed the House of Representatives on April 11, 1967, but no action was taken on that bill or S. 597 (the companion bill to H.R. 2512 as introduced) in the Senate; and, therefore, of course no general revision bill was enacted in the Ninetieth Congress. The Senate Judiciary Subcommittee on Patents, Trademarks and Copyrights had deferred consideration of the important CATV provision in the revision bill pending decision of the United States Supreme Court in *Fortnightly Corp. v. United Artists Television, Inc.*,<sup>1</sup> but that decision was handed down on June 17, 1968, too late for action on the bill.

On January 22, 1969, Senator McClellan introduced S. 543 (91st Cong., 1st Sess.), which is now pending before the Senate Subcommittee. The bill contains two titles. Title I is identical, other than for technical amendments, with S. 597 (90th Cong., 1st Sess.). Title II is identical with S. 2216 (90th Cong., 1st Sess.), the bill to establish a National Commission on New Technological Uses of Copyrighted Works, which passed the Senate in the last Congress but died in the House Judiciary Subcommittee.

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\* Copyright © 1969 Morton David Goldberg. All Rights Reserved. Paper delivered before the Section of Patent, Trademark and Copyright Law of the American Bar Association at Dallas, Texas, Saturday, August 9, 1969.

\*\* Chairman, American Bar Association Committee on the Program for Revision of the Copyright Law.

1. 392 U.S. 390.

The National Commission in question would study and compile data on the reproduction and uses of copyrighted works of authorship (1) in automatic systems capable of storing, processing, retrieving, and transferring information and (2) by various forms of machine reproduction. The Commission would be directed to make recommendations to the President and the Congress for such changes as may be necessary to assure for such purposes access to copyrighted works and recognition of the rights of copyright owners.

It has now been two years since the National Commission was first proposed. "Some observers"—to use the journalistic synonym for the first person singular—feel that the intervening period has shown that the scope of the proposed Commission's jurisdiction may not be broad enough to cover all the problems which must be covered, but no one has suggested that the Commission would have an easy task even with the more limited jurisdiction now proposed.

Congress so far has not given much attention to the relationship between such problems and the Copyright Law. This is evidenced, for example, by the absence of any mention of copyright matters in important legislation such as Title III of the Public Broadcasting Act of 1967, P.L. 90-129, 81 Stat. 365. Under Title III of that Act, the Secretary of Health, Education and Welfare has set up a commission, which was to report by June 30, 1969, to study the use in education of instructional broadcasting systems, computers and related devices.

In any event, it seems to me that we must have an appropriate study of the relationship between the Copyright Law and burgeoning new technologies, so that suitable means may be fashioned in this area to achieve both proper incentives and rewards to copyright proprietors and optimum dissemination and utilization of their contributions to our culture, knowledge, science and education.

Lastly, on the subject of general revision, note should be taken of the bill providing for a further interim extension of expiring renewal copyrights, which became law in the last Congress as P.L. 90-416. The effect of P.L. 90-416, coupled with the earlier enactments of P.L. 90-141, 89-142 and 87-668, is to extend to December 31, 1969 the terms of renewal copyrights which would otherwise have expired between September 19, 1962 and December 31, 1969.<sup>2</sup>

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2. I have been informed just prior to coming to Dallas that Senator McClellan has this past Wednesday (August 5) introduced a bill for further extension of such renewal copyrights to December 31, 1970.

*Other federal legislation.* The Standard Reference Data Act, P.L. 90-396, became law on July 11, 1968. It authorizes the Secretary of Commerce to secure copyright on behalf of the government in compilations of standard reference data, notwithstanding the general prohibition against copyright in government publications as provided in Section 8 of the Copyright Act.

Companion design bills, H.R. 3089, H.R. 4209 and S. 1774 (91st Cong., 1st Sess.), have been reintroduced this year, but no action has as yet been taken.

The bill to enact a broad federal law of unfair competition, S. 1154 (90th Cong., 1st Sess.) was not acted upon this past year. It has now been reintroduced, however, as S. 766 (91st Cong., 1st Sess.) and is awaiting action in the Senate Judiciary Subcommittee on Patents, Trademarks and Copyrights.

*Federal regulations.* On March 1, 1968, the Office of Education of the Department of Health, Education and Welfare promulgated a new Statement of Policy concerning the availability of copyright protection for a limited term in materials produced under Office of Education grants or contracts.<sup>3</sup> Although the emphasis remains on placing such materials in the public domain, the new Statement of Policy appears to be a significant relaxation of the previous Statement of July 12, 1965, 30 Fed. Reg. 9408, which made public domain status a blanket requirement for such materials. To implement the revised Statement of Policy, the Office of Education has issued Guidelines on Authorizing Limited Copyright Protection for Materials Developed under Project Grants and Contracts, which became effective June 24, 1968.

On July 2, 1969 the National Aeronautics and Space Administration amended its procurement regulations with respect to copyright policies and procedures concerning rights in computer programs, data bases, motion pictures, television recordings and other works.<sup>4</sup> Modifications have been made in the circumstances under which NASA contractors will and will not be permitted to secure copyright, and changes have been made in the form of licenses prescribed for the securing of rights by contractors for NASA and by NASA itself.

## II. State Legislation

New York and California, perhaps the two centers of copyright activity, have enacted statutes recently which are of interest.

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3. 33 Fed. Reg. 3653.

4. Procurement Regulation Directive 69-11, amending Part 9, Subpart 2, "Data and Copyrights," NASA Procurement Regulations.

In New York, the Legislature has enacted Article 12-E, Sections 223 and 224 of the General Business Law (Ch. 668, L. 1966), effective September 1, 1966, which provides a statutory presumption that when the creator of an unpublished "work of fine art" sells such a work, the "right of reproduction" is reserved unless the reproduction right is expressly transferred in writing. The statute is designed to overcome the effect of *Pushman v. New York Graphic Society*,<sup>5</sup> which held that an artist selling an uncopyrighted painting under an unconditional bill of sale retained no reproduction rights in the painting.

In New York, the Legislature has also attempted to make unauthorized copying, or "dubbing," of phonograph records a misdemeanor, except where the dubbing is done by one with a performing rights license as part of a broadcast or for archival preservation. Section 561, New York General Business Law (Chs. 982, 988, L. 1966, effective September 1, 1967). I say the New York Legislature has "attempted" to make this a misdemeanor, because I have some doubts whether a State may enact such legislation in an area where the federal Constitution appears to have given Congress the right to govern the matter under the copyright law. See Sections 101, 102(7), 106, 114, etc., S. 543 (91st Cong., 1st Sess.).

The California Legislature seems not to have been overwhelmed by such concern for constitutional infirmity, however, because this past year it enacted a statute based upon Section 561 of the New York General Business Law. Section 653h, California Penal Code. The California statute, however, explicitly prohibits "dubbing" of motion picture sound tracks, even where done for broadcasting or archival purposes.

### III. Significant Recent Decisions

In the last year or so, there have been several significant copyright decisions. Most important, of course, was the decision in *Fortnightly Corp. v. United Artists Television, Inc.*<sup>6</sup> In that case, the United States District Court for the Southern District of New York and the Court of Appeals for the Second Circuit had held that a CATV system infringed copyright rights under 17 U.S.C., Section 1(c) and (d), in motion pictures which the system had taken off the air from television stations which had been licensed by the motion picture proprietors to broadcast the pictures.<sup>7</sup> The Supreme Court, however, held, after a rather simplistic analysis of the question, that the CATV operation in *Fortnightly* did

5. 287 N. Y. 302 (Ct. App. 1942).

6. 392 U.S. 390 (1968).

7. 255 F. Supp. 177 (S.D.N.Y. 1966), aff'd 377 F.2d 872 (2d Cir. 1967).

not constitute a "performance" of the motion pictures and hence was not an infringement. A dissent expressed the view that the Court's approach was "disarmingly simple" and an "over-simplification of the 'function' of CATV."

The *Fortnightly* decision has been discussed extensively and I believe most of you are aware of its significance, so I shan't belabor it.

#### A. *Lear, Sears and Compco*

The recent case which for the copyright bar is—or should be—second in significance only to the *Fortnightly* case is another decided by the United States Supreme Court, *Lear, Inc. v. Adkins*,<sup>8</sup> decided on June 16 of this year. This case, like the earlier cases of *Sears, Roebuck & Co. v. Stiffel Co.*,<sup>9</sup> *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>10</sup> and *Brulotte v. Thys Co.*,<sup>11</sup> is a patent case and not a copyright case. The principles enunciated by the *Lear* Court, however, are far-reaching. They expand significantly the impact of the federal preemption doctrine (under the patent and copyright clause of the Constitution, Art. 1, Sec. 8, Cl. 8, and the supremacy clause, *id.*, Art. 6) on what States may and may not do in trade secrets and unfair competition cases. I submit that for the copyright bar to ignore patent cases such as *Lear* and the others would be (as a recent copyright opinion said in another context, *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*,<sup>12</sup> "to carry 'ignorance is bliss' to absurd lengths."

In the *Lear* case, the Supreme Court of California had followed what it called "one of the oldest doctrines in the field of patent law" and held that *Lear*, a patent licensee operating under its license agreement with *Adkins*, was estopped to deny the validity of its licensor's patent in *Adkins'* suit for royalties. In the light of the *Sears* and *Compco* decisions, the United States Supreme Court granted certiorari to review its 1950 decision in *Automatic Radio Mfg. Co. v. Hazeltine Research, Inc.*,<sup>13</sup> in which it had invoked a similar estoppel against a patent licensee. The Court, speaking through Mr. Justice Harlan, viewed the California court's construction of the licensing agreement itself as solely a matter of state contract law and stated that it took as the only issue properly before it whether the estoppel doctrine barred *Lear*, the licensee, from proving patent invalidity.

8. 162 U.S.P.Q. 1.

9. 376 U.S. 225 (1964).

10. 376 U.S. 234 (1964).

11. 379 U.S. 29 (1964).

12. 161 U.S.P.Q. 119, 121 (S.D.N.Y. 1969).

13. 399 U.S. 827.

After reviewing the history of the treatment of the estoppel doctrine by the Court from the 19th century through the *Hazeltine* case, the Court concluded that *Hazeltine* was unsound law and specifically overruled it, thus giving it at least what Justice Frankfurter had termed in an earlier dissenting opinion the "decent public burial" to which the doctrine was entitled.

The Court analyzed the problem in terms of the conflicting policies of the common law of contracts and the federal law of patents: "On the one hand, the law of contracts forbids a purchaser to repudiate his promises simply because he later becomes dissatisfied with the bargain he has made. On the other hand, federal law requires that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent."<sup>14</sup>

It held that to comport with the "spirit of contract law" rather than with "the letter of contractual doctrine"—note that "law" is always on *our* side, whereas *they* rely only on mere "doctrine"—the equities would weigh in favor of permitting the licensee to offer proof that the patent is invalid. Not only is the licensor's case "buttressed by the presumption of validity," the Court said, but "surely the equities of the licensor do not weigh very heavily when they are balanced against the important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain."<sup>15</sup>

In what it called the "typical" situation of a patent license negotiated after issuance of the patent, it was "plain" that the technicalities of contract doctrine must give way to the public interest, i.e., that the estoppel rule must be rejected. But the Court said that the *Lear* situation presented a far more complicated question than that of estoppel in the most common licensing context, for *Lear* obtained its license from Adkins more than four years before Adkins' patent issued. "At the core of this case, then," the Court said, "is the difficult question whether federal patent policy bars a State from enforcing a contract regulating access to an unpatented secret idea."<sup>16</sup> In other words, the Court was raising the question whether there is anything left to the protection of contract rights in trade secrets and confidential disclosures after *Sears* and *Compco*.

The Court said that Adkins' claim to contract royalties for the period before issuance of the patent "squarely raises the question whether, and to what extent, the States may protect the owners of *unpatented* [emphasis the Court's] inventions who are willing to dis-

14. 162 U.S.P.Q. at 7, citing *Sears and Compco*.

15. 162 U.S.P.Q. at 8.

16. 162 U.S.P.Q. at 9.

close their ideas to manufacturers only upon payment of royalties. . . . Our decision today will, of course, require the state courts to reconsider the theoretical basis of their decisions enforcing the contractual rights of inventors and it is impossible to predict the extent to which this re-evaluation may *revolutionize* [emphasis my own, but the word is the Court's] the law of any particular State in this regard. Consequently, we have concluded, after much consideration, that even though an important question of federal law underlies this phase of the controversy, we should not now attempt to define in even a limited way the extent, *if any* [emphasis my own], to which the States may properly act to enforce the contractual rights of inventors of unpatented secret ideas."<sup>17</sup>

The Court rejected, as contrary to "overriding federal policy," Adkins' argument that the benefit to Lear from the right to use Adkins' invention in the four years before the patent issued was a sufficient *quid pro quo* to require Lear to continue royalty payments for the full term of the patent irrespective of validity. And it likewise rejected Adkins' second argument that, as provided in the license agreement, the royalties should at least be paid until the patent is adjudicated invalid. The Court again stated that State contract principles must give way here to a "strong federal policy favoring the full and free use of ideas in the public domain,"<sup>18</sup> a policy which it said would be frustrated if licensees could be required to continue royalty payments during the period of their court challenge of the patents.

Mr. Justice White, while concurring in the majority's rejection of the licensee estoppel doctrine, expressed doubt as to the Court's jurisdiction to decide whether federal law forbids the collectibility of royalties otherwise collectible under a contract under state law. This issue had not been the subject of any final judgment of the California courts but, Mr. Justice White contended, the majority had purported to decide the issue anyway, at least in part. His view was that it was unwise policy for the Court prematurely to undertake a ruling on the question, which should, like the question of patent validity, be left to the California courts in the first instance.

While the majority thus was criticized for going too far by Mr. Justice White, his brother Black criticized the majority for not going far enough. In an opinion concurring for the most part in the majority opinion, Mr. Justice Black, for himself, the Chief Justice and Mr. Justice Douglas, dissented strongly from the majority's reservation, for future decision, of the question whether the States may enforce a contractual obligation to pay royalties for use of an invention as a trade

17. 162 U.S.P.Q. at 10.

18. 162 U.S.P.Q. at 9.

secret while a patent application is pending even though the invention is later held unpatentable. He found such a reservation to be directly in conflict with his opinions for the Court in *Sears and Compco*. In his view, "[o]ne who makes a discovery may, of course, keep it secret if he wishes, but private arrangements under which self-styled 'inventors' do not keep their discoveries secret, but rather disclose them in return for contractual payments, run counter to the plan of our patent laws, which tightly regulate the kind of inventions that may be protected and the manner in which they may be protected. The national policy expressed in the patent laws, favoring free competition and narrowly limiting monopoly, cannot be frustrated by private agreements among individuals, with or without the approval of the State."

Presently, I have neither the time nor the wisdom to provide any answers to the impact of *Lear* in the copyright area, but let me mention a few sample questions:

(1) If a given character is not a service mark and character rights are outside the scope of copyright protection, will a license of character rights be enforceable under state law?

(2) Similarly, can a trade-secret type license for the use of a computer program (probably copyrightable and *maybe* patentable) be enforced?

(3) How about a license of the right to manufacture tapes from a master recording of the performance of a public domain symphony?

And so on.

It does not take much effort to think up the questions. They're easy. It's only the answers that are tough.

Let us not forget, of course, that there are also *differences* between the likely impact of *Lear* on patent situations and its copyright impact. For example, Section 2 of the federal copyright law expressly permits the States to protect unpublished works at common law or in equity, against unauthorized "copying, publication, or use."<sup>19</sup>

But *Lear* has already made its appearance on the copyright scene. Less than a month after the *Lear* case was handed down, a California intermediate appellate court has relied upon the *Lear* holding to reverse a summary judgment for a plaintiff copyright proprietor in an action to recover royalties under a license of a musical composition to

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19. See, *Edgar H. Wood Associates, Inc. v. Skene*, 141 U.S.P.Q. 454 (Mass. Sup. Ct. 1964).



a record company. In *Golden West Melodies, Inc. v. Capitol Records, Inc.*,<sup>20</sup> the appellate court held that the lower court had apparently relied on the licensee estoppel doctrine in finding no triable issue of fact: the defendant licensee had sought to show that the plaintiff licensor's copyright was invalid, but the lower court had applied the estoppel doctrine to conclude that such a showing was not proper. The appellate court therefore remanded the case to the trial court for reconsideration in the light of the *Lear* case.

The *Lear* case is, as each of the opinions in it makes clear, an extension of the principles enunciated in the *Sears* and *Compco* cases. There have also been several copyright cases recently which have dealt with other ramifications of these principles.

In *Columbia Broadcasting System, Inc. v. DeCosta*,<sup>21</sup> the Court held that the *INS* case, *International News Service v. Associated Press*,<sup>22</sup> had been clearly overruled by *Sears* and *Compco*. It therefore denied relief to the plaintiff who claimed that the defendant's television program, "Have Gun Will Travel," was a misappropriation of his property rights in the Paladin character which he had created and—unfortunately for him—published by passing out cards and photographs of his characterization without copyrighting the cards.

In *Grove Press, Inc. v. Collectors Publication, Inc.*,<sup>23</sup> the court held that the defendant's copying of the plaintiff's edition of a 19th century work, "My Secret Life" (uncopyrightable by reason of the triviality of its new matter) was enjoined on the ground that the defendant had misappropriated the benefit of the plaintiff's expenditure of substantial sums in setting new type and engraving plates. The defendant had photographed and reproduced plaintiff's book through offset lithography and, according to the court, had thereby obtained an unfair competitive advantage. The court relied on the *INS* case, and held the plaintiff entitled to relief notwithstanding the defendant's contention that *Sears* and *Compco* prohibited the protection of mere uncopyrightable typography.

In another misappropriation case, *Norton Printing Co. v. Augustana Hospital*,<sup>24</sup> still another court found some life left to the *INS* doctrine. It denied a motion to dismiss the plaintiff's claim for unfair competition arising out of the defendant's alleged misappropriation of the

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20. (Calif. Ct. of App., 2d App. Dist., Civ. No. 32765), decided July 10, 1969, not yet reported.

21. 153 U.S.P.Q. 649 (1st Cir. 1967).

22. 248 U.S. 215 (1918).

23. 152 U.S.P.Q. 787 (C.D. Cal. 1967).

24. 155 U.S.P.Q. 133 (N.D. Ill. 1967).

plaintiff's medical forms. While the court specifically referred to *INS*, the opinion makes no mention of *Sears and Compco*.

The Maryland Court of Appeals, in an extensive discussion of the ramifications of *Sears and Compco*, held invalid a Maryland statute which made it a misdemeanor to reproduce, without authorization, maps issued by the Maryland State Department of Assessments and Taxation.<sup>25</sup> Although the court found invalidity by virtue of conflict with the Copyright Act and the Supremacy Clause of the Federal Constitution, Art. VI, it added the dictum that the State of Maryland would be free to seek relief against such "unfair competition" in the equity courts.

*Urner Barry Publications v. Freeman*<sup>26</sup> was an interesting case involving, *inter alia*, the question whether *Sears and Compco* were applicable to an unfair competition claim against the Secretary of Agriculture arising out of the latter's alleged misappropriation of the plaintiff's news, information and price quotations pertaining to the dairy and poultry market. The court denied the defendant's motion to dismiss, holding that it was too early in the case to determine whether the defendant was guilty of passing off or some other "competitive tort" unaffected by *Sears and Compco*. It commented also that those cases involved copying of industrial products, unlike the case at bar, and the possibility remained that the *INS* doctrine might still be applicable to the plaintiff's claim.

Neither Nancy Sinatra nor "The Fifth Dimension" singing group were able to overcome the *Sears and Compco* doctrine in their respective claims for unauthorized imitation of their recorded performances of musical compositions. In *Sinatra v. Goodyear Tire & Rubber Co.*,<sup>27</sup> the plaintiff alleged that the tire company and its advertising agency were guilty of unfair competition by reason of their use in a radio and television commercial of imitations of her recording of "These Boots Are Made for Walkin'." Similarly, in *Davis v. Trans World Airlines*,<sup>28</sup> the plaintiffs claimed that the TWA commercial utilizing a performance of "Up, Up and Away" was a take-off, so to speak, on their own performance; but the court granted summary judgment for the defendants, holding that there was no actionable harm to the plaintiffs.

*Gordon v. Warner Bros. Pictures, Inc.*,<sup>29</sup> was an action for money damages for alleged wrongful use of the title "The FBI Story" for de-

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25. *State's Attorney for Prince George's County v. Sekuler*, 158 U.S.P.Q. 231 (Md. Ct. of App. 1968).

26. 155 U.S.P.Q. 257 (S.D.N.Y. 1967).

27. 159 U.S.P.Q. 356 (C.D. Cal. 1968).

28. 160 U.S.P.Q. 767 (C.D. Cal. 1969).

29. 161 U.S.P.Q. 316 (Cal. Dist. Ct. App., 2d Dist. 1969).

fendant's motion picture. Judgment for the plaintiff was reversed because the jury had been improperly instructed that secondary meaning meant only an association with the plaintiff's book title but not necessarily with that title *exclusively*. The defendant had argued that since titles are left in the public domain by the patent and copyright laws, *Sears* and *Compco* prevented protection of titles under state unfair competition theory. The court declined to rule on this argument because, under the applicable state law, fraud would have to be shown in order to entitle the plaintiff to damages (which was all the plaintiff sought); and such fraud (palming off) had been specifically excepted by *Sears* and *Compco* from the doctrine of federal preemption. The court left open, however, whether the *Sears* and *Compco* argument would preclude protection of a title were there an action for injunction only.

In what appears to be the first decision applying the *Sears* and *Compco* interpretation of federal patent and copyright policy to a federal statute rather than state law, *Black Hills Video Corp. v. F.C.C.*<sup>30</sup> held that the *Sears* and *Compco* cases did not require the court to upset the FCC "non-duplication" and "carriage" rules the validity of which the petitioner CATV systems had contested.

The carriage rule requires the CATV systems to carry the programs of local and nearby stations. The non-duplication rule prohibits a CATV system from carrying a program from one station on the same day that a higher priority station on the system is broadcasting the same program.

The court said that the carriage rule was not inconsistent with the Copyright Act, because under *Fortnightly* there would be no copyright infringement liability imposed on the CATV systems for their carrying of the television stations in compliance with the carriage rule.

In the more significant discussion of the non-duplication rule, the court held that the rule was not invalidated by the copyright laws. It distinguished *Sears* and *Compco* by pointing out that those cases involved a conflict between state and federal law, as to which federal law must control by reason of the supremacy clause of the federal constitution. The court went on to state:

Here the conflict if any is between two federal laws and at most the issue is whether the Commission's power to regulate non-duplication under powers granted it by the Federal Communications Act is inconsistent with federal policy underlying the Copyright Act. Petitioners have not shown that the non-duplication requirement, which the Commission found was needed to further the

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30. 399 F.2d 65 (8th Cir. 1968).

public interest in the broadcasting field, is inconsistent with the policy underlying the Copyright Act.<sup>31</sup>

The *Black Hills* discussion of this question was not an extensive one, and, of course, it was the Eighth Circuit Court of Appeals speaking, not the Supreme Court. Too much should therefore not be inferred from it. However, the opinion does suggest that the policy underlying the federal copyright law (and patent law) does not necessarily override the policy underlying other federal statutes. Most pertinent, of course, is the relationship between the copyright and patent statutes, on the one hand, and the Lanham Act, on the other.

Conceivably the Supreme Court might ultimately hold that the protection given under the Lanham Act is expressive of a policy consistent with the policy of the patent and copyright laws. If it were to so hold, much of the sting of the *Sears* and *Compco* cases for the members of this Section would be alleviated. But, much of the protection which the present version of the Lanham Act purports to provide against unauthorized copying of configurations of goods and, under Section 43(a), against false designations of origin and false representations, etc., might be deemed expressive of a policy inconsistent with patent and copyright policy. Therefore, a strong expression of Congressional intent that the respective statutes are consistent and of equal significance in the federal constellation would be most helpful. The Lanham Act has, of course, been enacted under the Commerce Clause, which would appear to be entitled to the same significance under the federal constitution as the patent and copyright clause, Art. 1, Sec. 8, Cl. 8.

Perhaps an appropriate legislative history for this purpose may be produced in the passage through the halls of Congress of certain bills now pending in the First Session of the 91st Congress: the unfair competition bill, S.766; the patent revision bill, S.2756; and the copyright revision bill, S.543 (see especially § 301 of S.2756 and the like-numbered section of S.543). In other words, I would advocate the approach of Winston Churchill, who prophesied that "history will deal gently with us, because I intend to write it."

B. "*Papa Hemingway*," his conversations, and common law copyright.

*Hemingway v. Random House, Inc.*<sup>32</sup> was an action by the estate of Ernest Hemingway and his widow, individually, against the publisher

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31. 399 F.2d at 70.

32. 23 N.Y.2d 341, 160 U.S.P.Q. 561 (1968).

and the author, A. E. Hotchner, of the book *Papa Hemingway*, a biographical portrait of the late Nobel laureate.

The complaint alleged four causes of action: infringement of common law copyright in Hemingway's oral comments, anecdotes and conversations; misappropriation, and unfair competition with Hemingway's other literary creations; breach of a confidential relationship between Hemingway and Hotchner; and invasion of the widow's right of privacy.

The New York Court of Appeals affirmed the lower court's grant of summary judgment dismissing all four causes of action.

The court phrased the first, and most significant, question as whether "conversations, at least those of a gifted and highly regarded writer, may become the subject of common law copyright, even though the speaker himself has not reduced his words to writing," a question for which it found no direct precedent. The opinion contains a most interesting discussion of the problem, which turns out, however, to be only thoughtful dictum. The court said that protection of conversational speech by common law copyright presents "unique problems," including those of avoiding undue restrictions on freedom of speech and press for historians and biographers and the difficulty of determining the extent of the contribution made by one party to a conversation.

The court pointed out that the current electronic devices which permit easy capture of one's speech made it unwise, as a policy matter, to preclude all possibility of the speaker himself deciding what private utterances might be published and "conceivably," the court said, there may be special situations where a conversation could adduce some "unique intellectual product of the principal speaker" which should be protectible. But it expressed no opinion on that question, leaving the matter open for consideration in cases presenting the issue more sharply.

The court said that if such an oral creation were to be protected, then at the very least the speaker would be required to "indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication." The court acknowledged the usual judicial reluctance to find a publication which has divested an author of his common law copyright but said that "in the case of conversational speech—because of its unique nature—there should be a presumption that the speaker has not reserved any common law rights unless the contrary strongly appears."

All this, as I say, was dictum, because the court pointed out that Hemingway had approved of Hotchner's writing and publication of several articles during Hemingway's lifetime in which he was quoted at

length from such discussions, and Hemingway had likewise not objected to his conversations with others being quoted in articles which they wrote even when he was displeased by the articles themselves. Therefore, and here we finally get to the holding on the copyright question, there was an implied authority from Hemingway to Hotchner to publish such conversations, "thus negating the reservation of any common law copyright."

On the second cause of action, the court held there was no "competition" between Hotchner's book and Hemingway's works, there was nothing "unfair" about the publication of the defendants' book and there was none of the palming off which would be necessary to make unlawful an otherwise lawful use of literary property. Since the applicable state law itself precluded any recovery for unfair competition, the court found it unnecessary to consider the defendants' contention that *Sears* and *Compco* did not permit states to grant such relief.

On the third cause of action, the court found that the confidential relationship between Hemingway and Hotchner, such as it may have been, extended only to projects for adapting Hemingway's published works for motion pictures and television and did not extend to the subject matter of the conversations reported in Hotchner's book.

On the fourth cause of action, the court relied on the United States Supreme Court decision in *Time, Inc. v. Hill*<sup>33</sup> and its own decision in *Spahn v. Messner*<sup>34</sup> to conclude that for such a public figure as Mrs. Hemingway there was no invasion of privacy unless it could be shown that the defendant published the books with knowledge of falsity thereof or reckless disregard of the truth; and there was no allegation of any knowing or reckless misstatement. The court added that the mere circulation of galley proofs of the book to 16 book reviewers did not amount to an invasion of her privacy "for advertising purposes" (the phrase used under §51 of the Civil Rights Law, the New York privacy statute) even if there were otherwise a right of action.

### C. *Dr. Seuss et al.—the scope of a grant of rights.*

In several recent cases, the courts have adjudicated the scope of rights granted under licenses or assignments to magazine, newspaper and book publishers as well as motion picture companies. The most recent such case of note is *Geisel v. Poynter Products, Inc.*,<sup>35</sup> in which "Dr. Seuss," the well-known artist and author, sued the successors and assignees of the defunct *Liberty* magazine on unfair competition and other

33. 385 U.S. 374 (1967).

34. 21 N.Y.2d 124 (1967).

35. 160 U.S.P.Q. 590 (S.D.N.Y. 1968).

grounds for their exploitation of three-dimensional "Dr. Seuss" dolls based on the cartoons which he had prepared for publication in *Liberty* in 1932.

On the copyright question involved, the *Geisel* court indicated that while it might theoretically be possible to spell out from an implied contract a theory that the magazine's proprietorship of the copyright on the cartoons was only under a constructive trust, the evidence showed the custom and usage in 1932 to be to the contrary.

The court held that in 1932 the custom was that, absent an explicit reservation by the author—there was none here—a magazine received all rights as proprietor without any trust relationship. Therefore, there was no custom applicable to the *Geisel-Liberty* transaction which took it out of the general rule that all rights pass with an absolute and unconditional sale. The court went on to hold that since *Liberty* owned the unqualified copyright on the two-dimensional cartoons, the defendants had the right to make three-dimensional figures from them.

In an interesting ancillary holding, the court in *Geisel* ruled that the prima facie evidentiary value accorded by Section 209 of the Copyright Act to the facts set forth in a registration certificate applied as well to renewal certificates, and that, prima facie, a renewal claimant owns all renewal rights.

In *Bartsch v. Metro-Goldwyn-Mayer, Inc.*,<sup>36</sup> the court held that a grant of motion picture exhibition rights in the musical play "Maytime" included the right to exhibit the motion picture on television.

*Goodis v. United Artists Television, Inc.*<sup>37</sup> held that a grant of motion picture rights together with a grant of the right to televise any photoplay produced in the exercise of those rights is deemed to include a grant of the right to produce a television film series based on the work. In a more far-reaching additional holding, however, the court ruled that plaintiff's work went into the public domain upon its serialization without separate copyright notice in a magazine which had acquired only the serialization rights. The court said that since the magazine was neither the owner nor the assignee of *all* rights, the magazine's overall copyright notice was not sufficient, on a constructive trust theory or otherwise, to prevent the plaintiff's work from falling into the public domain. The *Goodis* case is now on appeal.

In *Best Medium Publishing Co. v. National Insider, Inc.*,<sup>38</sup> the court found that a sale of articles to a newspaper without any conditions attached to the sale constituted a sale of all rights.

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36. 157 U.S.P.Q. 65 (2d Cir. 1968).

37. 157 U.S.P.Q. 334 (S.D.N.Y. 1968).

38. 152 U.S.P.Q. 56 (N.D. Ill. 1966), aff'd 155 U.S.P.Q. 550 (7th Cir. 1967).

*Dolch v. Garrard Publishing Co.*<sup>39</sup> held that the authors' grant to the publisher of "the exclusive right of publication of the books" included the right to publish the books either in hardcover or paperback form.

#### D. Copyright and the Government

In *Scherr v. Universal Match Corp.*,<sup>40</sup> the plaintiffs, while serving in the United States Army, created a statue of an infantryman in battle dress entitled, "The Ultimate Weapon." The court held that the statue was created as a work for hire by the plaintiffs as employees of the government and that the rights, if any, belonged to the government. The defendants had contended that the statue was a publication of the government within the proscription of Section 8 of the Copyright Act and that the work was therefore uncopyrightable. The court concluded, however, that the phrase in Section 8, "publications of the United States Government" refers only to *printed* works and does not include three-dimensional works such as the statue in question.

Although the plaintiffs had placed a copyright notice on the statue, the court found that the notice had been placed in as inconspicuous a location as possible (not on the base of the statue but rather in a location approximately 22 feet above the ground), making it impossible for one standing on the ground to observe the notice. The notice was therefore inadequate and the long public display of the statue at Fort Dix, New Jersey, without any restrictions against copying, constituted "a divestive publication under an invalid copyright," placing the work in the public domain.

In *Urner Barry Publications v. Freeman*,<sup>41</sup> discussed *supra*, the court denied a motion to dismiss the complaint for lack of jurisdiction, rejecting, *inter alia*, the defendants' contention that the plaintiff's claim was one for copyright infringement for which the sole remedy was an action against the United States in the Court of Claims pursuant to 28 U.S.C. Section 1498(b).

#### E. Fair Use

*Time, Inc. v. Bernard Geis Associates*<sup>42</sup> was an infringement action brought by the proprietor of the Zapruder film of President Kennedy's assassination. Summary judgment on the fair use question was granted to the defendant publisher and distributor of the book "Six Seconds in

39. 159 U.S.P.Q. 480 (S.D.N.Y. 1968).

40. 160 U.S.P.Q. 216 (S.D.N.Y. 1967).

41. 155 U.S.P.Q. 257 (S.D.N.Y. 1967). See *supra*, p. 314.

42. 159 U.S.P.Q. 663 (S.D.N.Y. 1968).



Dallas," which utilized without permission sketches made from frames of the Zapruder film. In determining the issue of fair use, the court was much influenced by the strong "public interest in having the fullest information available on the murder of President Kennedy."

The court noted also that although the plaintiff had specifically denied permission to the author of the book, the defendants, when requesting the permission, had offered to surrender to the plaintiff as a license fee the defendant publisher's entire profits from the publication of the book.

The court found also that there was not only an absence of any likely injury to plaintiff by the defendants' use, but such use was likely to enhance the value of plaintiff's copyrighted work.

The court also held, as a preliminary matter, that the Zapruder film showed the originality and authorship requisite for copyrightability, notwithstanding the defendants' claims that Zapruder had done nothing more than record events which were merely uncopyrightable news.

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## 226. MEETING OF THE INFORMATION INDUSTRY ASSOCIATION

*On Copyrights and Related Protections for Information Age Products (July 18, 19, 1969—Washington, D.C.)*

The Information Industry Association meeting at Airlie House on July 18 and 19 adopted a two-part resolution on the relationship between copyright, new proprietary rights and the optimal use of information.

The IIA resolution, adopted unanimously by the member firms assembled for the two day meeting on Copyright and Related Protections for Information Age Products, concludes that proprietary rights are comparable with and essential to the widest dissemination and use of information. It also urges that a national commission be established to consider not only new technological uses of *copyrighted* works but also, more broadly, the impact of new information technologies on the optimal development and use of proprietary information products and services. The resolution also notes that the new information technologies may require different legal concepts and the national commission should, therefore, not be limited to considering only copyright solutions to the problems.

The resolution reads:

The Information Industry Association, mindful of its unique responsibilities as an association of creators, generators, processors and vendors of information products and services, as well as manufacturers and suppliers of information related devices and services, and interested professionals in the field, in considering the relationship between proprietary rights and the optimal use of information in the public interest

RESOLVES that proprietary rights associated with the various information technologies and products are, as a fundamental principle, not only compatible with the widest dissemination and use of information, but essential thereto, and

FURTHER RESOLVES that, since the new information technologies may require extensions of or perhaps different legal concepts from those which heretofore have served the general welfare, a national commission should be established to study, not only new technological uses of copyrighted works, but also, more broadly, the impact of these new technologies on the optimal development and use of proprietary information products and services, and to recommend appropriate legislation.

## PART II.

LEGISLATIVE AND ADMINISTRATIVE  
DEVELOPMENTS

## 1. United States of America and Territories

## 227. U. S. CONGRESS. SENATE.

S.J. Res. 143. Joint resolution extending the duration of copyright protection in certain cases. Introduced by Mr. McClellan August 5, 1969, and referred to the Committee on the Judiciary.

The resolution reads as follows:

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution, or the term thereof as extended by Public Law 87-668, by Public Law 89-142, by Public Law 90-141, or by Public Law 90-416 (or by all or certain of said laws), would expire prior to December 31, 1970, such term is hereby continued until December 31, 1970.

228. U. S. CONGRESS. SENATE. *John L. McClellan.*

Senate Joint Resolution 143—Introduction of a joint resolution extending the duration of copyright protection in certain cases. *Congressional Record*, vol. 115, no. 132 (daily ed. August 5, 1969), p. S 9135.

Remarks of Senator McClellan upon his introduction of S. J. Res. 143. An extract from the Remarks follows:

I am aware that Members of the Congress are receiving considerable correspondence requesting favorable action on the legislation for the general revision of the copyright law. Many Americans—especially those involved in the creative and performing arts—look forward to the long, overdue modernization of the copyright law. It may, therefore, be useful for me to report to the Senate at this time concerning the prospects for action in this session of Congress on this legislation.

The public hearings by the subcommittee were completed during the previous Congress, but various developments precluded any action by the subcommittee to report a copyright

bill. The principal, if not exclusive, factor delaying action in the subcommittee has been the complex and highly controversial subject of cable television. During the last Congress there was pending before the Supreme Court litigation relating to the possible copyright liability of cable television systems under the Copyright Act of 1909. I indicated last year that I would initiate further efforts to advance the progress of the bill at the start of the 91st Congress. I have kept that commitment. As early as January 8, I scheduled a general meeting with all of the parties to the CATV question. I virtually pleaded on that occasion that the parties cooperate with the Congress in reaching at least a measure of agreement that could then be reviewed by the appropriate committees.

Following the January 8 conference, a number of smaller meetings were held with certain of the parties in Washington and New York. The counsel of the subcommittee represented me at those meetings. In addition, the parties themselves scheduled various meetings to conduct negotiations. In due course, the staffs of the National Association of Broadcasters and the National Cable Television Association reached agreement on a package settlement, reflecting both copyright and communication principles, and recommended this proposal to their respective boards. The board of the National Cable Television Association gave an affirmative response to the agreement, but the staff proposal was not approved by the board of the National Association of Broadcasters. The NAB indicated that the staff agreement required "major revision" and that various unspecified additional issues had to be resolved. Subsequent to the action of the NAB board, I was advised by the three principal parties, NAB, NCTA, and the motion picture producers and distributors, that they were prepared to resume discussions on an expeditious basis. While I welcome the willingness of the parties to resume their discussions, such efforts have been in progress under the subcommittee's sponsorship for about 2 years and little tangible progress has been made. Since the CATV question is delaying the markup in the subcommittee of the copyright revision bill, I felt obliged to request the parties to submit to the subcommittee not later than August 31 a report indicating what agreements, if any, have been achieved, and to identify the areas which remain to be resolved.

On the basis of the information currently available to the subcommittee, I am not optimistic that the parties will achieve

substantial agreement by August 31, or at an early subsequent date. Even if such a fortuitous event should at last occur, further discussions would then be necessary with various secondary parties, such as the music performing rights societies, educational broadcasters, and the professional baseball and football leagues. It will then be necessary to draft the required statutory language. Finally, some appropriate method would have to be developed to permit the Commerce Committee, which also has jurisdiction in this area, to review whatever provisions are approved by our subcommittee.

Under these circumstances, I am now reluctantly prepared to support the separation of the cable television issue from the general copyright revision bill so that the substance of the CATV question would be dealt with in a separate bill. While the general copyright revision bill was being processed, the efforts of the CATV parties to reach an agreement could continue. If the parties later were to achieve an understanding, this agreement could be reviewed by the appropriate committees of the Congress, and if found to be in the public interest, the necessary implementing legislation could be enacted. If the parties do not reach agreement, the appropriate committees could take whatever legislative action they deem necessary and desirable. While the general copyright bill would not be intended to deal in any permanent way with the substantive CATV question, it obviously will be necessary to include in that bill language preserving the status quo and providing that with respect to secondary transmissions by cable television systems, their possible copyright liability shall be determined by the provisions of the Copyright Act of 1909.

I believe that this approach is not adverse to the real interests of any of the major parties. It is unfortunate that the CATV issue apparently cannot be resolved as part of the general legislation. The responsibility for this condition rests with the parties and particularly those who persist in undermining efforts to achieve a compromise settlement. If it is not possible to separate the CATV issue from the general bill, I doubt that the Subcommittee would be able to report the revision bill during this session. The failure of the subcommittee to act on the revision bill in this session, in my opinion, would raise a very real prospect that this Congress would not be able to revise the copyright law and that the entire revision effort may well collapse.

I invite those organizations and individuals who have comments or suggestions concerning the separation of the CATV provisions from the general revision bill to submit them to me promptly. After the August recess, I shall consult with the other members of the subcommittee concerning our future procedure.

229. U.S. CONGRESS. HOUSE. *Committee on Appropriations. Subcommittee on Independent Offices and Department of Housing and Urban Development.*

Independent offices and Department of Housing and Urban Development appropriations for 1970; hearings, 91st Cong., 1st Sess. Part 1. Washington, U.S. Govt. Print. Office, 1969. 1489 p.

Includes testimony by officials of the Federal Communications Commission on proposed rulemaking in regard to community antenna television systems.

230. U.S. COPYRIGHT OFFICE.

Seventy-first annual report of the Register of Copyrights for the fiscal year ending June 30, 1968. Washington, Library of Congress, 1969. 25 p. "Reprinted from the *Annual Report of the Librarian of Congress* for the fiscal year ending June 30, 1969."

Includes statistical information on Copyright Office business, a survey of legislative and judicial developments relating to copyright, international developments, and a table showing the status of United States copyright relations with other independent countries of the world as of December 1, 1968.

231. U.S. LIBRARY OF CONGRESS. *Legislative Reference Service.*

The mechanical royalty rate on sound recordings: survey of issues before the Judiciary Committees of the Congress, by Edward Knight, analyst in industrial organization, Economics Division. Washington, June 30, 1969. 113 p. "Distribution limited."

"This study will attempt to review and place into perspective the principal arguments voiced by both the music publishers and the record producers in their respective testimony before Subcommittee No. 3 of the House Judiciary Committee and the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary during the 89th and 90th Congresses. Its primary objective is to determine whether or not the Congress to date has been furnished by the parties involved the type of

information which will be needed to render an informed and equitable judgment on the mechanical royalty rate issue." In his "Concluding Observations," Mr. Knight states that the findings to date with respect to such information "remain inconclusive."

232. U.S. NATIONAL AERONAUTICS AND SPACE ADMINISTRATION.

Copyright policy and rights in data—special situations. [Washington] July 2, 1969. 9 p. (NASA Procurement regulation directive, no. 69-11.)

"This Procurement Regulation Directive amends Part 9, Subpart 2 [*i.e.*, 41 C.F.R., Subpart 18-9.2], 'Data and Copyrights' of the NASA Procurement Regulation to establish policies and procedures concerning copyrights and to provide rights in data coverage for computer programs and computer data bases. The principal changes made by this directive (i) broaden and update the definition of 'data' used in the regulations and the term 'subject data' used in the Rights in Data clauses; (ii) provide new coverage as to when a contractor will, and will not, be permitted to copyright data first produced under a NASA contract; (iii) change the type of copyright license in private copyrighted material which the NASA contractor will obtain for the Government; (iv) revise the Rights in Data clause for motion pictures; (v) provides special instructions for procurements involving computer programs; (vi) add a new clause entitled 'Rights in Data—Special Situations' to preclude copyrighting by the contractor, where this is necessary to meet NASA's publication and dissemination needs; and (vii) set forth new provisions to be used when purchasing existing (off-the-shelf) motion pictures, television recordings or computer programs."

233. U.S. PRESIDENT'S TASK FORCE ON COMMUNICATIONS POLICY.

Final report. [Submitted to the President], December 7, 1968. [Washington, GPO, 1969]. Eugene V. Rostow, chairman. 1 v (various pagings).

The final report of the Task Force, established pursuant to President Johnson's message on communications policy (H.R. DOC. NO. 157, 90th Cong., 1st Sess. (1967)). Chapter 7, entitled "Future Opportunities for Television," includes a discussion and recommendations with respect to Government policy on F.C.C. regulation and copyright liability of community antenna television systems.

## PART III.

## CONVENTIONS, TREATIES AND PROCLAMATIONS

234. UNESCO. Committee of Experts on Translators' Rights. *Paris, 23-27 September 1968*. Participants, List of Points Discussed, and Recommendations.

As announced last year (16 BULL. CR. SOC. 63, Item 67, October 1968), pursuant to resolution 5.121 (d), adopted by the General Conference of Unesco at its fourteenth session (Paris, 1966), a meeting of experts on translators' rights was held in Unesco Headquarters in Paris from 23 to 27 September 1968. The purpose of the meeting was "to examine the situation of translators in law and in practice, and to make recommendations for improving the status of this category of intellectual workers." Mr. V. Strnad was named Chairman and Mr. Pierre Malinverni acted as rapporteur.

*List of Participants*

## EXPERTS

- |  |   |
|--|---|
| Mr. Manuchehr Amiri<br>Ministry of Culture and Arts<br>(Iran)  | Mr. N. P. Moragoda<br>Superintendent of translations,<br>Department of Educational Pub-<br>lications (Ceylon)       |
| Mr. S. H. Belvadi<br>Secretary, Maharashtra Legisla-<br>ture (India)   | Mr. Muneoki Morikawa<br>Secretary-General, Japan Society<br>of Translators (Japan)                                  |
| Professor Walter Derenberg<br>Executive Director, Copyright So-<br>ciety of the U.S.A. (U.S.A.)  | M. J. P. N'Diaye<br>Secrétaire Général, Commission<br>Nationale du Sénégal pour<br>l'Unesco (Sénégal)               |
| Dr. Hermano Duval<br>Avocat (Brazil)   | Mr. J. B. Odunton<br>Principal Secretary, Ministry of<br>Information (Ghana)  |
| Professor M. Fabiani<br>Società Italiana Autori Editori<br>(Italy)   | Mr. Ian M. Parsons<br>Chairman, Copyright Committee,<br>Publishers Association of Great<br>Britain (United Kingdom) |
| Licenciado Profesor Arturo<br>González Cosío<br>Director General de Derechos de<br>Autor de la Secretaría de Educa-<br>ción Pública (Mexico) | M. Zivan Radojkovic<br>Conseiller Juridique, Union des<br>Traducteurs Littéraires (Yugo-<br>slavia)                 |
| Mr. E. Jeppesen<br>Administrator, Danish Govern-<br>mental Copyright Council (Den-<br>mark)  | M. Vojtech Strnad<br>Conseiller Juridique du Ministère<br>de la Culture (Czechoslovakia)                            |
| M. Pierre Malinverni<br>Vice-président, Société Française<br>des Traducteurs (France)  |   |



## INTERGOVERNMENTAL ORGANIZATIONS

*United International Bureaux for the Protection of Intellectual Property (BIRPI)*

M. M. Stojanovic

Assistant Juridique de la Division du Droit d'Auteur

*Organization of American States (OAS) Secretariat General*

Mr. Emmanuel D. Ledan

## INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

*International Literary and Artistic Association (ALAI)*

M. le Professeur H. Desbois

Secrétaire Perpétuel de l'ALAI

Maître Renée Blaustein

Secrétaire du Bureau Exécutif et Membre du Bureau de l'ALAI

*International Confederation of Societies of Authors and Composers (CISAC)*

Mme Alba de Cespedes

Vice-présidente de la CISAC

M. Léon Malaplate

Secrétaire Général de la CISAC

M. J. A. Ziegler

Secrétaire Général adjoint de la CISAC

*International Federation of Translators (FIT)*

M. P. F. Caillé

Président de la FIT

*Internationale Gesellschaft für Urheberrecht (INTERGU) International Copyright Society*

M. Walter Jost

Délégué pour la France

*International Writers' Guild (IWG)*

M. Roger Fernay

Président de la Commission Internationale du Droit d'Auteur

*International Publishers' Association (UIE)*

M. André Géranton

Chef du Service Juridique, Syndicat National des Editeurs

## SECRETARIAT OF THE MEETING

Mr. H. Saba

Assistant Director-General for International Standards and Legal Affairs, Representative of the Director-General of Unesco

Miss M. C. Dock

Acting Head, Copyright Division, Unesco

Mr. Y. Matveev

Assistant Lawyer, Copyright Division, Unesco

## BOARD OF THE MEETING

Chairman: Mr. V. Stunad

Vice-Chairman: Mr. H. Duval

Rapporteur: Mr. P. Malinverni

*Points discussed:*

## STATUS OF THE TRANSLATOR

Independent translator

Salaried translator

Economic rights

Means of remuneration (lump-sum, royalty)

Commissioned work ( <i>Louage d'ouvrage</i> )	Repercussions of author's remuneration on translator's rights Sharing of rights between translators
CONTRACTUAL RELATIONSHIPS	Protection of an unauthorized translation
Relationship between author and publisher	SCOPE OF PROTECTION
Relationship between author and translator	
Relationship between publisher and translator	Published translations
Cession of translator's right	Translation of performed works
General cession	Translation of works broadcast by radio or television
Partial cession	Scientific translation
TRANSLATOR'S RIGHTS	Technical translation
Moral right—approval of the translation	Periodicals
	Documents
	Retranslations
	Libraries

### *Recommendations*

The committee of experts on translators' rights, meeting in Paris from 23 to 27 September 1968,

*Noting* that the spread of culture and the interplay of ideas facilitated by the international use, through translations, of publications helps to promote mutual understanding between peoples and co-operation between nations.

*Considering* the extremely important role that translation plays in regard to development generally,

*Considering* that the protection accorded to translators and/or translations largely influences the selection of works for translation as well as the quality of translations,

*Considering* that the principle and some of the terms of that protection are already established in international conventions and the national legislations of many countries through assimilation of the translator to author from both the moral and the economic points of view,

*Noting* that to promote the circulation of publications, certain measures should be taken to improve the status of translators,

*Having adopted* a report summarizing the results of its discussions,

*Recommends* that due account be taken of the principles set out below, as they may lead to positive results:

1. Equitable remuneration should in all cases be accorded to the translator and he should as a general rule, participate in all subsequent exploitations of his translation;
2. A translator not paid a salary should be remunerated by a percentage of the economic return on the work translated, and given an advance on this percentage, this advance in any case to remain the property of the translator, whatever the final return; but the possibility remains to pay a lump-sum for certain categories of

publications, such as scientific or technical works, anthologies, educational publishing etc.;

3. Contracts concluded between salaried translators and physical persons or legal entities employing them (service contracts in particular) should specify the purpose for which works translated under the terms of the contracts are intended, and make provision for a supplementary payment, should the normal use made of the work go beyond that contemplated under the contracts;
4. For purposes of contract interpretation, it should be assumed that only rights that have been expressly stipulated have been ceded by the translator.

Moreover, a translation of a work against payment, even of a lump-sum, should, as a general rule and for copyright purposes, be regarded as made under a contract for commissioned work, and not as a service contract; it should, however, be open to the contracting parties to provide explicitly and in writing that the copyright shall belong to the publisher or to any other person who has commissioned the translation;

5. Encouragement should be given to all measures calculated to improve the quality of translations, in particular, and in accordance with the systems adopted in the various countries, by intensifying contacts between authors and translators, and facilitating the consultation of the author by the translator in the course of translation; by promoting the creation of translators' professional bodies; by setting up private or public professional organs to verify the quality of translations and to settle any disputes arising in that connexion; by giving the name of the translator and the language from which the translation has been made; by taking all appropriate action to encourage the training of translators, etc.;
6. It should be acknowledged that it is generally the user of a translation who undertakes to obtain the necessary permission to use the work and is responsible to the translator for any consequences resulting from lack of permission;

It should be acknowledged that, even in the case of a lack of the author's permission, the translator (or his assigns) may prohibit the use of his own translation and that if he has carried out an unauthorized translation in good faith, he is not liable to any penalty, without prejudice for the original author to prohibit the use of the translation;

7. Article V, subsections 5 and 6, of the Universal Copyright Convention should be amended to assure that the name of a translator who has obtained a translation licence in accordance with Article V should appear on all printed copies of the published translation, as well as in the copyright notice, provided in Article III, in addition to the name of the original copyright proprietor;
8. The possibility should be studied of improving the economic status of translators, following national and international meetings which

might be arranged between the representatives of the various interests concerned (authors, translators, users) and, with a view to encouraging such meetings, consideration should be given to the setting up of an appropriate liaison committee;

9. With a view to facilitating adequate remuneration of translators belonging to developing countries, funds should be provided within the framework of bilateral co-operation programmes for payment of the royalties of authors belonging to producing countries, in cases where translations of their works are used in developing countries, as proposed, *inter alia*, in Unesco's Draft Programme and Budget for 1969-70;
  10. Model translation contracts should be drawn up in the light of the principles set forth in these recommendations, it being understood that such contracts should make due allowance for all situations likely to arise by reason either of the translator's status or of the nature of the translation;
  11. Professional statutes, collective agreements and contracts of employment based thereon should mention explicitly the class of translators of scientific and technical texts, so as to take account, particularly as regards their professional classification, of their status as translators holding copyright;
  12. The attention of governments, foundations, universities, international organizations and all other similar bodies concerned should be drawn to the need for ensuring the circulation of translations of works of outstanding importance for the promotion of education, science, technology and culture but likely to prove uneconomic, and accordingly guaranteeing adequate remuneration to the translator of such works;
  13. Consideration should be given to means of including the translator's name in the material used for promoting and publicizing the translated work, and particularly, his name should be included in all announcements or communications issued by the publishers or other users;
  14. Wherever possible, the translation of an original work direct into another language should be encouraged, recourse being had to retranslation only where absolutely unavoidable;
  15. Means should be sought of promoting the means of communication and meetings between translators with a view to improving the national and international organization of their profession, particularly in the developing countries.
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## PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY  
AND ARTISTIC PROPERTY**

## A. DECISIONS OF U.S. COURTS

## 1. Federal Court Decisions

235. *Mattel, Inc. v. S. Rosenberg Co., Inc.*, 226 F. Supp. 1024, 161 USPQ 809 (S.D.N.Y., Dec. 27, 1968) (Frankel, J.)

Motion for preliminary injunction in action for copyright infringement. Plaintiff alleged that its "Kiddy Kolognes"—dolls and scents encased in transparent bottles—were infringed by defendant's "Perfume Playmates", and that its "Jewelry Kiddles"—dolls in transparent cases mounted on jewelry items—were infringed by defendant's "Trinket-Teen" jewelry.

*Held*, motion granted in part and denied in part.

I. *Perfume items*: The Court denied temporary relief against the alleged infringement of plaintiff's "Kiddy Kolognes" because, in light of significant differences between the parties' products in a product line which is "old stuff" and the coinciding results of the court's "ordinary" observation and the testimony of an expert witness, plaintiff had failed to demonstrate sufficient probability of success upon the merits. The court said:

. . . there are . . . numerous resemblances between plaintiff's and defendant's. But there are also significant differences—especially significant because the scope of the creativity and originality plaintiff can claim on this aspect of the case is notably slight. . . .

Dolls in bottles, as the parties agree, are old stuff. It appears, in fact, that defendant came on the market over a year ago with a doll in a facsimile of a soda pop bottle, dubbing it "Soda Fizz Kid," and made no effort to copyright it, while plaintiff, thereafter, began to market a closely similar thing for which it obtained a copyright registration under the name "Kola Kiddles." Apart from that, third parties have produced a variety of dolls in bottles, including dolls in bottles containing some scent comparable to the "kologne" or perfume featured here. Evidently very conscious of what a well-

plowed field this is, the plaintiff has six separate copyrights on its six "Kiddle Kolognes"—the variations being trivial ones of cap color, scent, and other details, while the similarities among the six are numerous, detailed, and nearly total.

In this setting, the differences between plaintiff's copyrighted Kiddles and defendant's products become substantial and very possibly decisive. . . . The differences include shape of bottle, cap, and stand, and differences between the respective dolls. Considering these factors alone, it cannot be said now that plaintiff shows a high probability of success in its ultimate efforts to show copying.

On the particular facts, as they now appear, it is also of some measurable weight that an expert (a toy buyer for a chain of 5 and 10 cent stores, so-called) who deals with both parties and stocks both Kiddle Kolognes and Perfume Playmates reports that: (a) the products are distinctly different as he sees them; and (b) customer reactions indicate that the buying public distinguishes the two. These impressions accord with my own untutored reactions as I gaze upon the several specimens submitted for this adjudication. While no expert, however much more conversant with the subject matters could usurp the court's authority as an "ordinary observer" over this question, . . . it seems permissible to be influenced in some modest degree by such views as to whether the objects are so much alike that they should be supposed at this preliminary stage to be copied one from the other. . . .

II. *Jewelry items*: Finding the similarities between the parties' jewelry products to be so numerous and detailed and "on such a scale that it is exceedingly unlikely that these could have resulted from anything but copying . . .", the court granted a temporary injunction against infringement of plaintiff's "Jewelry Kiddles". The court said:

The misshapen and (to at least one observer) slightly gruesome dolls are almost microscopically identical in their dimensions and their distortions. Where there were obvious choices to be made in design, shape, position, and other attributes, the choices were, over and over again, identical. The minute resemblances extend to mounting, packaging, and combinations of the individual items as well as to each individual item in itself. There are differences, to be sure, and defendant's products are visibly inferior in several respects. But the divergences are such as to comprise no more than patently transparent efforts to conceal the overwhelming evidence of identity resulting from imitation.

236. *Marcus Brothers Textile Corporation v. The Acadia Company, Inc.*, 161 USPQ 774 (S.D.N.Y., May 21, 1969) (Tyler, J.)

Motion for preliminary injunction in action for copyright infringement in fabric patterns. Plaintiff's earlier motion for similar relief was denied on the grounds that, although an ordinary observer would "be disposed to regard the aesthetic appearance" of the parties' patterns as the same, defendant's affidavits to the effect that it had purchased its allegedly infringing design from a Paris design house several weeks prior to plaintiff's first publication raised a substantial question as to whether or not the defendant obtained its pattern without copying plaintiff's. Plaintiff then renewed its motion on the grounds of newly discovered evidence which consisted of an affidavit by the principal of the Paris design house stating that, while affiant had sold defendant a number of patterns over the years and did sell defendant four patterns on the date of its asserted purchase of the allegedly infringing design, the latter pattern was not in fact made by affiant nor sold by her to defendant.

*Held*, defendant not having submitted any evidence in contradiction of the new affidavit, "plaintiff now appears likely to prevail upon the merits and is entitled to a preliminary injunction to protect its copyright and avoid irreparable damage".

237. *Criterion Music Corp. v. Tucker*, 45 F.R.D. 534, 161 USPQ 140 (D. Georgia, Nov. 25, 1968) (Lawrence, J.)

Motion to resolve plaintiff's requests for admissions in action for infringement of performing rights in musical compositions. For lack of sufficient information, defendant neither admitted nor denied three requests pertaining to the fact of performance.

*Held*, that "this is not much of a response to the requests but I take it that Defendant has no personal knowledge and has not questioned his musical performers. If defendant has received information on that subject, it is his duty to admit or deny the requests, irrespective of what I hold herein."

Defendant responded to twenty other requests by asserting that he did not know the answers and could neither admit nor deny.

The court said:

I do not think lack of personal knowledge is a sufficient response when ascertainment is within the immediate reach of an answering party.

A good faith effort to ascertain the existence of the fact or genuineness of the document is required on a litigant's part where sources of corroboration are at hand. However, this does not require the defendant here to make an independent investigation in order to place himself in position to admit that the plaintiff is a corporation; that it is the owner of the copyrights, that the assignments have been duly recorded and that the contents of such documents are true. It seems to me that plaintiff can readily produce at the trial certified copies of these public records. This is normal procedure in proving a case and imposes no undue burden on a party. My idea as to [Fed. Rules Civ. Proc. rule] 36 is that a plaintiff has a greater duty to provide proof than a defendant has to supply it. I do not agree with the notion that a party should admit requested admissions when he intends to raise no issue as to the truth thereof. It is hard to deal with reluctant defendants under Rule 36 and we obviously have one here.

At any rate, I deem the answers of the Defendant to be sufficient in each case. . . .

I will add that the sanctions of [Fed. Rules Civ. Proc. rule] 37 (c) [relating to answering party's payment of reasonable expenses incurred in showing proof of fact or genuineness of documents] will not be applicable in this case since Defendant has answered in sufficient detail and has not denied under oath the truth of any fact or the genuineness of any document.

238. *Runge v. Lee*, 161 USPQ 770 (D. Cal., April 21, 1969) (Byrne, J.)

Action for copyright infringement and unfair competition. A jury had found for plaintiff on both counts and awarded damages in the amount of \$80,000 on the copyright claim. Upon an accounting, the court subsequently found that defendant's net profits from sales of the infringing work amounted to \$64,253.

*Held*, "inasmuch as the damages awarded to plaintiff by the jury for infringement of copyright . . . are larger than the net infringing profits of defendant . . . plaintiff is entitled to an award of the higher of the two—that is, damages in the amount of \$80,000 . . .".

*Also of interest:*

239. *DeSalvo v. Twentieth Century Fox Film Corporation*, Not yet reported (D. Mass., June 16, 1969) (Garrity, J.)



Action to enjoin release and exhibition of defendant's motion picture "The Boston Strangler" and for damages. After indictment on ten counts of robbery, assault and related non-capital offenses, plaintiff was committed to a state hospital upon a finding he was not competent to stand trial. During this period he became "connected in some fashion" with the so-called "Boston Strangler"—the supposed perpetrator of a wave of Massachusetts murders. During this period of commitment, and after a state Probate Court had dismissed a petition for appointment of a guardian upon testimony that he was competent to conduct his own business affairs, plaintiff signed an agreement with the author of a book which was to name plaintiff as the "Boston Strangler" and deal extensively and without any substantial sympathy for plaintiff with events in which he was said to have participated as the murderer. Under this agreement, in return for certain periodic payments, which were subsequently rendered, plaintiff released all rights he might have in any literary or biographical material concerning his life and in any motion picture or other dramatic portrayal of himself and further covenanted not to sue the author or his assignees (assignment rights having also been granted) for any libel, invasion of privacy, or "anything else" which might result from any work portraying plaintiff. Plaintiff was found never to have protested publication of the book, although he read it soon after its release and it enjoyed considerable commercial success. Plaintiff was later found competent to stand trial and was convicted on the non-capital indictments (during which trial plaintiff's counsel, in opening, asserted that plaintiff was insane and had committed thirteen murders within eighteen months). Defendant subsequently purchased "portions" of the plaintiff's agreement with the book author relating to motion picture and related rights and produced a motion picture based upon the Boston murders in which plaintiff was portrayed largely as a man "concerned . . . with a struggle within himself to confess to crimes of which he considered himself guilty" and was treated in a fashion "at the very least . . . no more condemnatory than the book". Plaintiff's first indication that he had criticisms of the picture and would attempt to bar its exhibition occurred about a year after he was aware of its impending release and after he had corresponded with the director of the work in connection with its production; further, the instant action was brought only eighteen days prior to defendant's scheduled public release of its picture. Defendant offered no explanation for the delay other than "a suggestion that [he] was confused".

*Held*, judgment for defendant.

The Court held for defendant on three grounds:

I. Plaintiff knowingly and intelligently entered into the agreement releasing his rights to the author of the book and, having received the consideration stipulated therein, is barred from recovering from the author's assignee for alleged defamation or invasion of privacy.

II. "Due to the exceptional public interest in the so-called 'Boston Strangler' incidents and the extensive publicity surrounding plaintiff as a possible 'Boston Strangler', . . . the public interest in the 'Boston Strangler' and in plaintiff as a possible 'Boston Strangler' preclude maintenance of any action by plaintiff for defamation or invasion of privacy unless plaintiff proves publication that is knowingly false or falsely made with reckless disregard for the truth. . . . Plaintiff has not met [this] burden . . . ; the vast preponderance of the evidence is to the contrary."

III. Plaintiff's unreasonable and unexcused delay in commencing suit constitutes laches barring maintenance of the action.

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## PART V.

## BIBLIOGRAPHY

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241. KASER, DAVID. *Book pirating in Taiwan*. Philadelphia, University of Pennsylvania Press [1969]. 154 p.

A report on the unauthorized reprinting of English-language books in the Republic of China, based on an examination of the files of publishing houses and appropriate government agencies, and extensive interviews with publishers, booksellers, government officials, educators and others, not only in the United States and Taiwan, but in the Philippines, Japan, Hong Kong, Macao, and Korea.

Dr. Kaser, a prolific author in the field of book publishing, presents this troublesome and still only partly resolved international problem in a work which while an important contribution to copyright law, reads like a detective story.

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A section-by-section commentary on the new Law on Copyright and Neighboring Rights of the German Federal Republic, preceded by an extensive introduction covering such topics, among others, as the historical development of the German laws on copyright and publishing, the development of international copyright, the development and reform of the laws on copyright and publishing of the German Democratic Republic, the nature and basis of the laws on copyright, publishing, and neighboring rights, the protection of titles of works, general personality laws, and the law on portraits. Appendices contain the texts in German of the Law on Administration of Copyrights and Neighboring Rights of the German Federal Republic, the Brussels and Stockholm revisions of the Berne Convention, the Universal Copyright Convention, and the Rome Neighboring Rights Convention.

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An updated examination of the case law on fair use, preceded by a comprehensive subject index.

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idea itself is still a helpful guide in explicating the limits of copyright protection, and is a highly useful tool to practitioners and the courts in making judgments from case to case on questions of infringement."

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An article which seeks to determine whether fraudulent conduct involving concealment of facts is or should be a defense independent of that of copyright invalidity. The authors recommend that "consideration should be given to amending the pending general revision bill to grant explicit recognition of fraud as a separate defense to infringement," in order to deter fraud in the registration process and thereby enhance the reliability of the certificate of registration.

271. GOLDSTEIN, PAUL. Federal system ordering of the copyright interest. (69 *Columbia Law Review* 49-92, no. 1, Jan. 1969.)

A critical examination of the doctrine of preemption of State law over the "copyright interest," as reflected in the *INS*, *Sears*, *Compco*, and post-*Sears* decisions, and the pertinent provisions of the Copyright Revision Bill. One of the conclusions reached by Professor Goldstein is that "a failure to recognize that the constitutional distinction between Writings and non-Writings imposes a duty to balance federal interests . . . has led to the Court's indiscriminate rule that a state law which has any impact upon the federal copyright scheme must be invalidated on the Court's own initiative."

272. HENN, HARRY G. Copyright law revision: paragon or paradox? (44 *New York University Law Review* 476-520, no. 3, May 1969.) "Symposium on copyright and patent law in honor of Professor Walter Julius Derenberg."

"Professor Henn analyzes the revision bill and finds that its meticulous draftsmanship results in inflexibility. The author concludes that the proposed act not only fails to solve modern copyright problems, but also preserves many anachronisms of the present statute."

273. HOLTZMULLER, PAUL E. Current tests of similarity in infringement proceedings. (10 *William and Mary Law Review* 186-200, no. 1, Fall, 1968.)

"[T]he purpose of this discussion [entered in the Nathan Burkan ASCAP Copyright Law Competition, August 1968] will be to evaluate the methods and evidence utilized by the courts in arriving at the determination of whether or not infringement has occurred."

274. JAEGER, WILLIAM L. Copyright: misappropriation of a character—a careful thief doesn't have to pay. (56 *California Law Review* 1780-1798, no. 6, Nov. 1968.)

A note on the appellate decision in *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315, 15 BULL. CR. SOC. 37, Item 23 (1st Cir.), cert. denied, 389 U.S. 1007 (1967).

275. KNICKERBOCKER, ROBERT P., JR. CATV and copyright liability: the final decision. (1 *Connecticut Law Review* 401-407, no. 2, Dec. 1968.)

A paper, awarded first prize in the 1968 Nathan Burkan Memorial Competition at the University of Connecticut School of Law, which discusses the history of pertinent litigation before the *United Artists* decisions, and the *United Artists* decisions themselves. Among the conclusions reached are "that the broad issues of public policy raised by CATV are once again back in the hands of Congress and the FCC," that the "FCC is best qualified to regulate this fast growing industry, and that substantial action will be taken soon."

276. LIPPER, JEROME. The Congress, the Court, and the Commissioners: a legacy of *Fortnightly*. (44 *New York University Law Review* 521-539, no. 3, May 1969.) "Symposium on copyright and patent law in honor of Professor Walter Julius Derenberg."

A critical examination of the currently proposed F.C.C. rules for the regulation of CATV systems and of the three alternative proposals made to the Congress by the Copyright Office for the resolution of the CATV-copyright controversy. "Mr. Lipper concludes by enumerating the elements necessary to balance copyright and communications policies effectively, emphasizing the importance of immediate congressional action to stabilize relations among copyright owners, broadcasters, CATV operators, and the public."

277. MILDE, KARL F., JR. Can a computer be an "author" or an "inventor"? (51 *Journal of the Patent Office Society* 378-405, no. 6, June 1969.)

In answer to the question whether the work of a computer may be copyrightable or patentable, the conclusion reached is that since this question "is one of novel impression for the courts, and since the rationale is available for the courts to hold either way, Congress would not be speaking to the wind if it made its policy clear."

278. MOYERS, MICHAEL C. Unfair competition after *Sears and Compco*. (22 *Vanderbilt Law Review* 129-158, no. 1, Dec. 1968.)

"This note will examine the effects of the *Sears and Compco* cases by analysis of the Supreme Court's reasoning and by a survey of lower court interpretations of the two decisions."

279. NATHAN, MARIAN R. Unfair competition in intellectual products in the public domain. (18 *Cleveland-Marshall Law Review* 92-105, no. 1, Jan. 1969.)

A comment on *Grove Press, Inc. v. Collector's Publication, Inc.*, 264 F.Supp. 603, 14 BULL. CR. SOC. 387, Item 293 (C.D. Cal. 1967), in which the commentator advocates the enactment of a Federal law of unfair competition.

280. NIMMER, MELVILLE B. Copyright and quasi-copyright protection for characters, titles and phonograph records. (59 *The Trademark Reporter* 63-75, no. 2, Feb. 1969.)

A discussion of pertinent cases, particularly in the light of the *Sears-Compco* preemption doctrine.

281. NIMMER, RAYMOND T. The law of parody—INFRINGEMENT. (3 *Valparaiso University Law Review* 34-55, no. 1, Fall 1968.)

This revision of an essay that was awarded Fifth National Prize in the 1967 Nathan Burkan Memorial Competition deals with the copyright law question in situations involving an unauthorized parody of a copyrighted work.

282. OLIN, SPENCER C. The administration of a character licensing program. (59 *The Trademark Reporter* 76-81, no. 2, Feb. 1969.)

A review of "the elements of a program by which copyright protection acquired in a comic strip character may be put to effective and profitable use."

283. ROTHENBERG, STANLEY. Need to assist Congress in a modern copyright law. Rights in multi (or mixed) media. (161 *New York Law Journal* 1, no. 29, February 11, 1969.)

The author concludes that: "The longer it takes Congress to provide us with a modern copyright law, the more problems it will have before it since the body of creative works and creative contracts continues to grow daily."

284. SARRAUTE, RAYMOND. Current theory on the moral right of authors and artists under French law. (16 *The American Journal of Comparative Law* 465-486, no. 4, 1968.)

Includes "A brief comparison with American law," with a conclusion that although "results analogous to those obtained in French courts under the theory of the moral right are reached in the United States by different legal means," the French concept of the moral right seems preferable "since, from a theoretical point of view, it takes better account of the nature of the creative act, and in practice it assures more effective protection of the interests of the artist or writer."

285. SHIENTAG, FLORENCE P. Some legal aspects of art and fake art. (54 *Women Lawyers Journal* 23, Winter 1967, reprinted in *New York Law Journal*, 1, Part I, April 12, 1968 and *same*, 1, part I, April 15, 1968.)

"... experts in art are fallible as are other experts. . . . Protective laws cannot cover every situation and there are loopholes in every law. . . . Experienced confidence men never waste their time on a man who has no cupidity; when they meet a man who does not want to take advantage of his fellow man, they know he cannot be sold fake art", the author concludes.

286. SULJAK, NEDJELKO D. Right to translate and international copyright conventions. (62 *Law Library Journal* 47-57, no. 1, 1969.)

"In this article, the conventions have been viewed in the international sphere as international instruments governing the protection of the author's right to translate, as *jus conventionis*."

287. TAUBMAN, JOSEPH. Book review. Baumol and Bowen, Performing arts: the economic dilemma. (XLIII *Tulane Law Review* 184-201, December 1968.)

Mr. Taubman reviews a "landmark work intended to debunk the myths of our latest glamor symbol, 'performing arts' ", which was published in 1966 by the Twentieth Century Fund.

288. TREECE, JAMES M. American law analogues of the author's "moral right." (16 *The American Journal of Comparative Law* 487-506, no. 4, 1968.)

"To assess the prospects of future interaction in the 'moral rights' realm between the French and American law of intellectual property, it will be necessary, *first*, to set forth the teaching about the French doctrine on moral rights provided by M. Sarraute [see Item 283, *supra*]; *second*, to identify those non-statutory cognates in American law that confer protection analogous to that conferred by the French moral right; and *third*, to determine whether the continued existence and development of these analogues is threatened by the contemplated revision of the federal copyright statute or by recent judicial pronouncements [*Sears and Compco*] describing the pre-emptive quality of existing national policy."

289. WEISS, WALTER S. Special tax problems of authors, composers and artists. (3 *Journal of the Beverly Hills Bar Association* 25-31, no. 2, Feb. 1969.)

An article which purposes to point out many unsettled questions with respect to the tax treatment of receipts from a sale, license or other disposition of rights in literary property, "as well as the otherwise unique tax problems confronting authors, composers and artists."

290. WILD, ROBERT W. Computer program protection: the need to legislate a solution. (54 *Cornell Law Review* 589-609, no. 4, Apr. 1969.)

"This comment examines the existing means of protection and suggests a more effective approach" by proposing that Congress provide for the patentability of computer programs with specialized standards similar to design and plant patents.

291. WITT, JOHN W. CATV and local regulation. (5 *California Western Law Review* 30-43, no. 1, Fall 1968.)

A discussion of the question whether local regulation of CATV is to be permitted at all and if so, what its allowed scope will be.

## 2. Foreign

## 1. English

292. ABEL, PAUL. Letter from Great Britain, dealing with copyright and related matters which occurred in 1968. (5 *Copyright* 85-91, no. 4, Apr. 1968.)

A survey of current legislative and judicial developments.

293. Comparative study on copyright: translators' rights. (2 *Copyright Bulletin* (UNESCO) 15-44, no. 3, 1968.)

"The purpose of the . . . study is to define: 1. General principles as regards protection of translators' rights; 2. Conditions governing protection; 3. Nature of protection; 4. Restrictions on protection; 5. Transitional measures."

For the Recommendations of the study, see *supra*, item, 234.

294. DUVAL, HERMANO. Letter from Brazil. (5 *Copyright* 105-111, no. 5, May 1969.)

A survey of copyright and related developments in Brazil in 1968, covering international relations, domestic legislation, local case law, and miscellaneous matters.

295. EVANS, J. M. Passing-off and the problem of product simulation. (31 *The Modern Law Review* 642-655, no. 6, Nov. 1968.)

A critical examination of pertinent British case law, with a conclusion "that the tort [unfair competition] should be confined to features which only serve to identify and that the existence of secondary meaning does not justify the courts in extending the protection given by Parliament." Includes a brief examination of the rationale of the *Sears* and *Compco* decisions.

296. FRANCON, ANDRE. Letter from France. (5 *Copyright* 15-18, no. 1, Jan. 1969.)

A survey of recent French court decisions in regard to copyright.

297. HAZAN, VICTOR. Letter from Israel: "Compulsory license records." (5 *Copyright* 67-69, no. 3, Mar. 1969.)

A note on a recent case decided in the District Court of Tel Aviv and involving a dispute over the interpretation of the com-



pulsory license provisions of the Israeli copyright law between ACUM, the Israeli performing rights society and the local branch of the International Federation of the Phonographic Industry.

298. International convention relations in the field of copyright. (2 *Unesco Copyright Bulletin* 18-20, no. 4, 1968.)

Consists of a list of conventions and multilateral agreements in force, information on the relationship among the various conventions and/or multilateral agreements, and a cross-reference chart, in tabular form, on ratifications, acceptances or accessions to various conventional texts.

299. International Copyright Union. *Permanent Committee. Extraordinary Session (Paris, February 3 to 7, 1969)* Final report. (5 *Copyright* 48-55, no. 3, Mar. 1969.)

Contents. 1st pt. Report on the meetings of the Permanent Committee alone; 2d pt. Report on the joint meetings of the Permanent Committee and of the Intergovernmental Copyright Committee, Annexes: A. Resolution of the International Joint Study Group. B. Statement of the American book publishers. C. List of participants.

"The Permanent Committee was convened in extraordinary session at the request of the director of BIRPI, for the special purpose of helping him in formulating the advice which he might be called upon to give to the Intergovernmental Copyright Committee on the revision of the Universal Copyright Convention with respect to matters of concern to the Berne Union (in particular, the amendment of Article XVII of the said Convention and the Appendix Declaration thereto)." Some of the meetings were held jointly with the Extraordinary Session of the Intergovernmental Copyright Committee. See also Item 300, *infra*.

300. Intergovernmental Copyright Committee. *Extraordinary Session (Paris, February 3 to 7, 1969)*

Report on the meetings of the Intergovernmental Committee held on its own. (5 *Copyright* 70-73, no. 3, Mar. 1969.)

"The Intergovernmental Committee adopted the following item for its agenda: 'Communication from the Director-General of Unesco concerning comments from States parties to the Universal Copyright Convention with regard to the revision of Article XVII of the Convention.'" Appended is a resolution, unanimously adopted, for the convening of a conference for the revision of

Article 17 of the U.C.C. and its Appendix Declaration, and for establishing a subcommittee to examine the issues raised by the proposals for such revision and reporting to the Intergovernmental Committee at its next regular session. See also Item 299, *supra*.

301. KLAVER, FRANCA. Current developments in wire television: copy and neighboring rights problems. (5 *Copyright* 56-66, no. 3, Mar. 1969.)

A comparative study of copyright and neighboring rights problems created by community antenna television systems in Europe and the United States. A conclusion is reached that these problems "cannot be resolved satisfactorily except by national and international regulation established in close cooperation with all parties concerned: the respective operators, broadcasting organizations, authors, performing artists, and Governments."

302. LOI, SALVATORE. Original manuscripts. (5 *Copyright* 82-84, no. 4, Apr. 1969.)

A translation of an article, first published in Italian in *Bolletino del Sind. Naz. Scrittori*, no. 3 (1968), which deals with the problem, on the international level, posed by the unanimously approved recommendation of the Intellectual Property Conference of Stockholm regarding accessibility of the original manuscripts of works, for purposes of consultation.

303. LUND, TORBEN. Letter from Denmark. (5 *Copyright* 122-126, no. 6, June 1969.)

A survey of administrative, legislative and judicial developments with respect to copyright in Denmark from 1964 to the beginning of 1969.

304. NAWROCKI, BOLESLAW. Electronic machines and intellectual creation; some legal problems arising in connection with the use of electronic machines in the creation and dissemination of intellectual works. (5 *Copyright* 29-37, no. 2, Feb. 1969.)

A discussion of the various aspects of electronic machines such as computers and electronic synthesizers and the contributions they can make, together with an analysis as to whether these contributions would be best protected under copyright or patent law. One of the conclusions reached is that "it seems to us essential that an adequate system of effective protection be provided as soon as possible and be made mandatory throughout the world."

305. RECHT, PIERRE. Copyright, a new form of property. (5 *Copyright* 94-104, no. 5, May 1969.)

A summary of the author's recently published work on the history and theory of copyright, entitled *Le droit d'auteur, une nouvelle forme de propriété* (Paris, Librairie générale de droit et de jurisprudence, 1969).

306. SAWER, G. The Commonwealth Copyright Act 1968. (43 *The Australian Law Journal* 8-12, no. 1, Jan. 31, 1969.)

A brief analysis of the new Australian copyright statute.

307. ULMER, EUGEN. The copyright concept of intellectual works in modern art. (5 *Copyright* 80-82, no. 4, Apr. 1969.)

A translation of a review of Professor Kummer's *Das urheberrechtlich schutzbare Werk*, which was published in 70 GRUR 527 (1968). See 16 BULL. CR. SOC. 148, Item 126 (1968).

308. United Nations Education, Scientific, and Cultural Organization. Committee of experts on translators' rights (Unesco). (Paris, Sept. 23-27, 1968). (5 *Copyright* 38-39, no. 2, Feb. 1969.) See also *supra*, item 234.

Recommendations of the Committee on such questions as the status of the translator, the contractual relationships, the translator's rights and the scope of protection, preceded by a brief introductory statement.

## 2. English, French & Spanish

309. AURIC, GEORGES. Les contrats entre compositeurs et organismes de radiodiffusion. (*Revue Internationale du Droit d'Auteur* 96-129, no. 59, Jan. 1969.)

An article on agreements between authors and broadcasters, which was first published in French in *Interauteurs*, no. 173 (4th quarter, 1968), pp. 256-273. See 16 BULL. CR. SOC. 197, Item 176 (February 1969).

310. DUCHEMIN, JACQUES LOUIS. La protection des oeuvres des arts appliqués et la marché commun. (*Revue Internationale du Droit d'Auteur* 46-75, no. 60, Apr. 1969.)

A survey of the protection of works of applied art in the Common Market countries under national laws and the Berne

and Universal Copyright Conventions, with a conclusion expressing the hope "that in the next few years all countries concerned with the protection of designs will adopt a single system of protection based on artistic property and industrial property similar to that adopted by the United Kingdom."

311. MENTHA, BENIGNE. L'organisation mondiale du droit d'auteur, un problème de co-existence. (*Revue Internationale du Droit d'Auteur* 2-51, no. 59, Jan. 1969.)

An historical summary of the evolution of international copyright, with reference to the Berne Convention of 1886 and its revisions culminating in the Stockholm Act and the Protocol, and the Universal Copyright Convention. The following conclusion is drawn: "Provisionally, we should encourage a sort of tacit separation of powers, the Berne Convention being devoted rather to advanced countries and the Universal Convention rather to developing countries. In order to promote the recruitment of the latter under the banner of the Universal Convention the system of safeguards in favour of the Berne Convention might be made less strict at a future revision of the Universal Convention, in exchange for which those responsible for the latter would support their opposite numbers of the Berne Convention in their propaganda directed towards the major countries that have remained outside the Union (USA, USSR, China)."

312. PLAISANT, ROBERT. Les obligations de l'éditeur de musique. (*Revue Internationale du Droit d'Auteur* 76-133, no. 60, Apr. 1969.)

A commentary on French court decisions pertaining to the obligations of music publishers, with special reference to exploitation and distribution of the work.

313. RADOJKOVIC, ZIVAN. La nouvelle réforme de la législation yougoslave sur le droit d'auteur. (*Revue Internationale du Droit d'Auteur* 52-95, no. 59, Jan. 1969.)

An exposition of the principal innovations of the new Yugoslav Copyright Law of July 20, 1968 by comparing it with the former law.

314. VAKSBERG, ARKDIY. Le contrat d'édition en Union Soviétique. (*Revue Internationale du Droit d'Auteur* 2-45, no. 60, Apr. 1969.)

A general outline of the most salient features of two model publishing agreements, mandatory for all Soviet authors and pub-

lishers, promulgated by the Governmental Publishing Committee under the Council of Ministers on April 10, 1967.

### 3. French

315. DEMARET, PAUL. Techniques modernes de reproduction graphique et droit d'auteur. (58 *Revue de Droit Intellectuel, l'Ingenieur-Conseil* 302-318, no. 12, Dec. 1968; 1-33, no. 1, Jan. 1969.)

A comparative study of the copyright situation with regard to modern duplicating techniques under Belgian, French, German and British laws, the Brussels and Stockholm revisions of the Berne Convention, and the Universal Copyright Convention, with special reference to reproductions for private use and by libraries. The conclusion demonstrates that the Belgian copyright laws should be adapted to the new situation resulting from the use of new copying devices, and makes some suggestions on how to achieve it.

316. DESBOIS, HENRI. Le décret d'application de la loi 8 juillet 1964 relative á la réciprocité dans les relations internationales du droit d'auteur. (39 *Il Diritto di Autore* 511-530, no. 4, Oct.-Dec. 1968.)

A critical analysis of the decree of March 6, 1967 implementing the decree of July 8, 1964, which conditions protection of foreign works in France on the basis of reciprocity.

### 4. German

317. ADAM, ROBERT. Community-Antenna Television in den USA—System und Aktivitäten des amerikanischen Drahtfernsehens. (13 *Film und Recht* 36-38, no. 2, Feb. 15, 1969.)

A brief report on the status of community antenna television systems in the United States with references to the *Fortnightly* decision and proposed rule-making by the Federal Communications Commission.

318. ASPROGERAKAS-GRIVAS, CONSTANTINOS. Das Urheberrecht in Griechenland. (51 *Archiv für Urheber- Film- Funk- und Theaterrecht* 127-164, Oct. 15, 1968; vol. 52, 3-47, Jan. 15, 1969.)

A study of the current state of domestic and international copyright in Greece, published in two parts. The first part comprises a brief commentary and texts, in German translation, of Greek copyright laws, and the second part is a survey of leading decisions of Greek courts involving copyright and related matters.

319. BLUM, ARNO A. Eine Novelle zum Urheberrechtsgesetz in Israel. (*Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil 364-366, no. 11, Nov. 1968.)

A somewhat critical analysis of a new, temporary addition to the Israeli copyright law which, in essence, sets up a commission to determine what compensation should be given to an author for the incidental use of his work in educational television.

320. BÖLLINGER, CHRISTOPH. Gerichtsstand bei Verfolgung von Verletzungen absoluter Rechte durch den Rundfunk (Hörfunk und Fernsehen). (13 *Film und Recht* 135-139, no. 4-5, Apr. 15, 1969.)

A brief discussion of questions of jurisdiction and venue, under laws of the German Federal Republic, in the prosecution of civil and criminal actions for infringements of "absolute rights," such as right of personality, right in a name, and copyright, by radio and television broadcasts.

321. BRUGGER, GUSTAV. Der Begriff der Bearbeitung und Verfilmung im neuen Urheberrechtsgesetz; unter Berücksichtigung der Verwendung von Musikwerken in Film und Fernsehen. (51 *Archiv für Urheber- Film- Funk- und Theaterrecht* 89-125, Oct. 15, 1968.)

A study of provisions of the new law on copyright and neighboring rights of the German Federal Republic which deal with adaptations and motion picture rights in connection with the use of musical compositions in films and on television.

322. BRUHN, WOLFGANG. Das Problem des Vervielfältigens und Verbreitens in seiner Bedeutung für die Bibliotheken. (52 *Archiv für Urheber- Film- Funk- und Theaterrecht* 115-134, Jan. 15, 1969.)

A discussion of the problem of reproduction and dissemination of copies by libraries in the light of the limitations on copyright imposed by art. 53 (reproduction for personal use) and art. 54 (reproduction for other internal uses) of the Law on Copyright and Neighboring Rights of the German Federal Republic.

323. DIETZ, GEORG. Die Besteuerung internationaler Filmlizenzen; System und Doppelbesteuerungsabkommen. (13 *Film und Recht* 99-131, no. 4-5, Apr. 15, 1969.)

A comparative exposition of the taxation of rentals and like payments in respect to motion picture films, either under bilateral treaties of the German Federal Republic for the avoidance of

double taxation, or in situations where the licensor or licensee is a national of a country with which the Federal Republic has no such treaty.

324. DROST, HANS WOLFGANG. Vervielfältigungen der Bibliotheken nach dem neuen Urheberrecht. IN Verband der Bibliotheken des Landes Nordrhein-Westfalen. (18 *Mitteilungsblatt*, n.s., 315-323, no. 4, Dec. 1968.)

A brief comment on when, and to what extent, copying by libraries is permissible under the fair use provisions of the new copyright law of the German Federal Republic. A short bibliography of cited works appears at the end of the article.

325. DÜNNWALD, ROLF. Zum Begriff des ausübenden Künstlers. (52 *Archiv für Urheber- Film- Funk- und Theaterrecht* 49-88, Jan. 15, 1969.)

A historical survey of the concept of the performing artists which culminated in the section on the protection of the performer, incorporated in the Law on Copyright and Neighboring Rights of the German Federal Republic.

326. GENTZ, GÜNTHER. Schutz von wissenschaftlichen und Erst-Ausgaben im musikalischen Bereich. (52 *Archiv für Urheber- Film- Funk- und Theaterrecht* 135-152, Jan. 15, 1969.)

A comment on the possible application of articles 70-71 of the German copyright law, which deal with the protection of scientific editions and first publications of posthumous works, to first published scholarly editions of musical works.

327. HARTLIEB, HORST VON. Die Freiheit der Kunst und das Sittengesetz. (51 *Archiv für Urheber- Film- Funk- und Theaterrecht* 5-67, Oct. 15, 1968.)

An analysis of constitutional legislation and court decisions of the German Federal Republic which deal with the problems involved in the freedom of artistic creation and moral law.

328. KNAP, KAREL. Die Entwicklung auf dem Gebiet des Immaterialgüterrechts in der Tschechoslowakei. (*Gewerblicher Rechtsschutz und Urheberrecht*, Internationaler Teil 79-84, no. 3, Mar. 1969.)

A brief survey of developments in the sphere of intangible property rights (patents, trademarks, unfair competition, and copyright) in the Czechoslovak Republic.

329. LEINVEBER, GERHARD. Nochmals: der urheberrechtliche Fall "Kandinsky"; zum Begriff der Erläuterung im Rahmen der Zitierfreiheit. (71 *Gewerblicher Rechtsschutz und Urheberrecht* 130-131, no. 3, Mar. 1969.)

A favorable comment on a recent decision of the Supreme Court of the German Federal Republic involving an interpretation of art. 51, para. 1 of the German copyright statute which provides, in effect, that single works which have already been published may be included in an independent scientific work, without permission of the author, in order to clarify its contents.

330. MÜLLER, BERND. Die Verwertungsgesellschaften und des Grundrecht der Kunstfreiheit; Vereinbarkeit des Verwertungsgesellschaftengesetzes mit dem Grundgesetz. (13 *Film und Recht* 139-142, nos. 4-5, Apr. 15, 1969.)

In essence, Dr. Müller refutes the thesis, expounded by Professor Leisner in his article, "Urheberrechtswertung und Verfassungsrecht," 48 UFITA 46 (1966), to the effect that the Law on the Administration of Copyright and Neighboring Rights of the German Federal Republic is incompatible with art. 5, sec. 3 of the Bonn Constitution dealing with "freedom of art" (Kunstfreiheit). Dr. Müller maintains that this provision is inapplicable to performing rights societies. See 14 BULL. CR. SOC. 350, Item 264 (1967).

331. NORDEMANN, WILHELM. Heimfallrecht und Rechtsverzicht im Urheberrecht. (71 *Gewerblicher Rechtsschutz und Urheberrecht* 127-130, no. 3, Mar. 1969.)

A comment on escheat and abandonment with respect to copyright in the German Federal Republic.

332. OHLSCHEGEL, HELMUT VON. Zur Schutzfähigkeit von Rechenprogrammen für Datenverarbeitungsanlagen. (70 *Gewerblicher Rechtsschutz und Urheberrecht* 679-682, no. 12, Dec. 1968.)

A brief review of the scope of protection available for computer programs in the Federal Republic of Germany.

333. PEINEMANN, BERTHOLD. Die Pflichten der Verwertungsgesellschaften gegenüber den Urhebern und Leistungsschutzberechtigten. (52 *Archiv für Urheber- Film- Funk- und Theaterrecht* 153-168, Jan. 15, 1969.)

An article on the obligations of performing rights societies in the German Federal Republic toward authors and owners of



neighboring rights, with respect to the licensing of copyrighted works and the collection and distribution of income derived therefrom.

334. SCHMIEDER, HANS HEINRICH. Geistige Schöpfung als Auswahl und Bekenntnis; neue Thesen zum urheberrechtlichen Werkbegriff im Hinblick auf maschinelle Kunstprodukte. (52 *Archiv für Urheber-Film- Funk- und Theaterrecht* 107-114, Jan. 15, 1969.)

A discussion of the question whether mechanically produced works are "personal intellectual creations" under art. 2, para. 2 of the Law on Copyright and Neighboring Rights of the German Federal Republic, so as to be eligible for copyright protection.

335. SCHRAMM, CARL. Zum Begriff "Kunst." (51 *Archiv für Urheber-Film- Funk- und Theaterrecht* 75-88, Oct. 15, 1968.)

A comparison of the various definitions of "art" in the copyright sense which have appeared in legal treatises and court decisions.

336. SCHULZE, ERICH. Die urheberrechtliche Wende in der Sowjetunion. (51 *Archiv für Urheber-Film- Funk- und Theaterrecht* 69-74, Oct. 15, 1968.)

The text in German of the Convention on the Reciprocal Protection of Copyright between Hungary and the U.S.S.R., signed Nov. 17, 1967 at Budapest, followed by a brief comment.

337. SCHUMANN, HERIBERT. Fair use im amerikanischen Urheberrecht. (*Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil 125-134, no. 4, Apr. 1969.)

A survey of the fair use doctrine as reflected in American case law, which concludes with a brief analysis of sec. 107 (Limitations on exclusive rights: Fair use) of the general revision bill, H.R. 2512, 90th Cong., 1st Sess. (1967).

338. ULMER, EUGEN. Urheberrechtsfragen in den Beziehungen zwischen Westen und Osten. (70 *Gewerblicher Rechtsschutz und Urheberrecht* 406-412, no. 12, Dec. 1968.)

A brief discussion of copyright problems with respect to relationships between the Western countries and those of the Communist Bloc, viewed in the light of the Stockholm Protocol Regarding Developing Countries.

339. Zur Ratifizierung der Stockholmer Übereinkunft; Regierungsvorlage. (13 *Film und Recht* 84-94, no. 3, Mar. 15, 1969.)

Material on a Government bill for ratification of the Stockholm Act, recently introduced in the Federal Diet (Bundestag) of the German Federal Republic. The material, which is devoted principally to the Protocol Regarding Developing Countries, includes editorial matter, pertinent debates in the Bundestag at the first reading of the bill, the position of the West German Book Trade Association in regard to the first reading, and the Stockholm list of the developing countries.

### 5. Italian

340. FABIANI, MARIO. Questioni di attualità in tema di protezione dei traduttori. (39 *Il Diritto di Autore* 322-326, no. 3, July-Sept. 1968.)

A brief article on translation rights under Italian copyright law and international conventions.

341. FRAGOLA, AUGUSTO. Problemi di diritto cinematografico. (39 *Il Diritto di Autore* 297-321, no. 3, July-Sept. 1968.)

The first of a series of studies on the problems of motion picture rights in Italy, inspired by recent court decisions and dedicated to the memory of Amedeo Giannini. The present article discusses the problems encountered in remaking motion picture films, censorship, performers' rights, film distribution, and the protection of motion picture titles.

342. LOI, SALVATORE. La riproduzione fotografica di opere protette. (39 *Il Diritto di Autore* 427-438, no. 4, Oct.-Dec. 1968.)

An article on efforts to solve the problem of the photographic reproduction of protected works in the international field and the situation under the Italian copyright law.

### 6. Scandinavian

343. Nordiska mötet för industriellt rättsskydd. 13th, Stockholm, Aug. 26-28, 1968. Anföranden och inlägg. (*NIR* 18-53, no. 1, 1969.)

Debates, in Danish, Finnish, Norwegian, and Swedish, on effective legal protection in connection with electronic data processing, at the 13th Nordic Conference on the Protection of Industrial Property, held in Stockholm, August 26-28, 1968.

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7. Swedish

344. KARNELL, GUNNAR. Arbetstagares upphovsrätt; några utgångspunkter för bestämning av rättens övergång på arbetsgivare. (*NIR* 54-67, no. 1, 1969.)

A comment, in Swedish with an English summary, which "considers the possibilities of *establishing general criteria* designed to facilitate the determination of whether, in various types of cases the author's right can be considered to pass to the employer as an immediate consequence of the contract of employment, although the latter does not have any provisions dealing with the matter." The article is written in light of the fact that, since the Swedish copyright statute "attaches no particular legal consequences to the fact that a protected work has been created under a contract of employment . . . the author's right must be evaluated on the merits of each particular case."

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