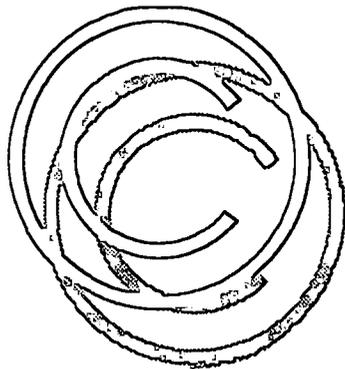

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OF THE
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ANNOUNCEMENT

The Copyright Extension Bill was signed by the President on October 25, 1972, becoming Public Law 92,566. (*See Item 8, page 42, infra.*)

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PART I.

ARTICLES

1. STATEMENT OF ABRAHAM L. KAMINSTEIN BEFORE THE
SENATE COMMITTEE ON FOREIGN RELATIONS – AUGUST
2, 1972.

Universal Copyright Convention, As Revised

My name is Abraham L. Kaminstein, and although I am an Honorary Consultant in Copyright at the Library of Congress, I must stress that today I represent only myself. It is a privilege for me to appear to urge ratification of the Universal Copyright Convention as Revised at Paris. Prior to my retirement on August 31, 1971, I spent 23 years in the Copyright Office, the last eleven years as Register of Copyright.

Following the adoption of the Stockholm Protocol to the Berne Convention, in 1967, international copyright entered a period of crisis. While the United States was not a member of the Berne Union, publishers in the United States, for example, relied upon and used the "back door" to Berne protection by publishing simultaneously in Great Britain or Canada. The Protocol was a direct threat to the standards of protection and to the structure of international copyright which had evolved over the past one hundred years.

The reaction to the Protocol among authors, publishers, and other copyright owners in the United States, Britain, and elsewhere, was very strong. To attempt to revise the Protocol quickly seemed an impossible task, made even more so by the suspicion abroad that we were not really interested in raising the level of copyright protection, so long as we could use the "back door" of Berne. Placing any doubts to one side, and speaking for the United States delegation in Geneva in December 1967, I proposed a plan for revising the Protocol, and amending both Berne and the Universal Copyright Convention. The Universal Copyright Convention, of which the United States was one of the principal founders, had not been amended since 1952, when it was negotiated.

The plan was considered by the governing bodies of both conventions and approved. During the next three years, negotiations, meetings, and conferences took place. Ordinarily, it takes 20 years to revise an international instrument. Four years from the Stockholm Conference almost to the month, the Paris revisions of the Universal Copyright Convention and of Berne Convention were adopted.

In the United States the plan, initiated by the Copyright Office and approved by the State Department, won the approval of most of the copyright bar and the groups they represented. My colleagues at the State Department were very helpful: Bruce Ladd, Deputy Assistant Secretary, who took over just before the Conference in Paris from his predecessor, Gene Braderman, and especially Harvey Winter, Director, Office of Business Protection, who was always there when we needed him. In the Copyright Office, we used three attorneys for research, as needed, and for two years before Paris we had the assistance of Bob Hadl. Barbara Ringer, Assistant Register of Copyright, conceived the entire plan, and with selfless dedication, directed, negotiated, drafted, and finally, produced a first draft of the comprehensive Report of the Paris Convention which has been made a part of Executive G.

Twenty years ago, our copyright relations with countries in Europe was a very intricate affair, a complex network of some 51 agreements, some requiring compliance with local law, which could result in loss of copyright — a kind of risky affair! Today, the United States is one of the major exporters of copyrightable material—our books, music, dramas, musicals, periodicals, motion pictures, TV go all over the world. We badly need the Universal Copyright Convention as revised in Paris. If we do not ratify the Paris revisions, it may be only a matter of time before states in Berne will close the “back door” and the entire fabric of international copyright could come apart.

The Paris revisions are not the complete answer to our problems, but they overcome the crisis of Stockholm, and pave the way for the future. To have two international conventions in any field is absurd, and it is my hope that in the future all nations will be parties to one convention.

I strongly urge that the Committee on Foreign Relations approve the Universal Copyright Convention, as revised at Paris, and recommend that the Senate advise and consent to early ratification.

2. REGISTRATION PROBLEMS ENCOUNTERED BY THE COPYRIGHT OFFICE UNDER THE RECENT SOUND RECORDING AMENDMENT

By DOROTHY PENNINGTON KEZIAH*

The amendment to the copyright law providing for a limited statutory copyright in certain sound recordings became effective on February 15, 1972. Seven months have now elapsed and during that time it has become obvious that most of the problems our remitters have been having fall within five rather well defined areas: (1) misunderstanding as to the scope of protection; (2) authorship problems; (3) claimant-notice problems; (4) publication-deposit problems; and (5) new matter and fixation problems. The purpose of this paper is to discuss these problem areas in light of the statutory requirements, and to clarify what is required for a Class N registration.

MISUNDERSTANDING OF THE SCOPE OF PROTECTION FOR SOUND RECORDINGS

"Sound recordings" are works that result from the fixation of a series of musical, spoken, or other sounds embodied in phono-records (discs, open-reel tapes, cartridges, cassettes, etc.). The copyright in a sound recording relates only to the series of sounds of which it is constituted. It protects only against unauthorized duplication of the sound recording or what is commonly called "dubbing." Copyright in a sound recording should not be confused with, and is not a substitute for, copyright in the underlying musical, dramatic, or narrative work of which a performance or rendition has been recorded. In other words, the sounds are protected; the content is not.

Some remitters do not seem to be aware of this distinction. For example, a Form N¹ for a sound recording may be deposited with a disc, but the numbered lines on Form N contain facts concerning the underlying work: line 1 may name the copyright owner(s) of the underlying musical composition that has been recorded; line 4 may name the author(s) of the musical composition; if the musical work that has been recorded is a new arrangement of a previously published com-

* Ms. Keziah is Head of the Music Section, Examining Division, of the Copyright Office. This paper, written for record manufacturers, for the purpose of clarifying difficulties in registration process is made available to the BULLETIN through the courtesy of the author and Register George D. Cary.

1. Form N is reproduced as Appendix I, *infra*.

position, line 6 may give "arrangement" as a statement of new matter in the sound recording when, in fact, all of the sounds are new and being published for the first time.

Or, Form N may be deposited with a cassette containing an instructional narration, or a series of taped interviews, panel-discussions, or an educational lecture. Although the amendment calls for the protection of sound recordings containing "spoken" sounds, there is a question whether narrations of this type contain sufficient original sound recording authorship, either on the part of the narrator or "record producer," to support a copyright. Such narrators generally have less latitude to create original interpretations than actors and musicians; moreover, the recording engineering may be more mechanical and less judgmental than that employed in recording music. We feel it is necessary to correspond in these cases and clarify the scope of protection available to sound recordings. In many cases we have found the remitter is really interested in protecting the underlying work. He has deposited the cassette, not because he sought protection for the sounds on the cassette, but merely because he mistakenly assumed it was an acceptable "copy" of the underlying work.

A Class N copyright does not protect the underlying work. To secure copyright protection for the underlying work it is necessary either to register a claim in the unpublished version (in Class C if a narration, in Class D if a dramatic work, in Class E if a musical composition), or to publish (place on sale, sell or publicly distribute) visually perceptible copies with notice of copyright, and then make the necessary registration in the appropriate class. Where the copyright owner is primarily interested in protecting the content on the phonorecords rather than the sounds, it may be very important to secure a statutory copyright in the underlying work *before* a rendition or performance of it is recorded and copies of the sound recordings are published. Several courts have indicated that the sale of recordings of a *musical* work prior to the securing of a statutory copyright in the musical composition divests the copyright owner of the musical composition of his common law rights in the music. This is apparently not the case if a statutory copyright is first secured in the musical work that is later recorded. Although it is not clear if this decision would apply to other fields, the best course is to obtain statutory copyright in the underlying material in *all* cases before it is recorded and published in phonorecords.

Still another example illustrating the misunderstanding that exists concerning the scope of protection in certain classes and what is covered by a particular registration is found in the multi-media area. Rather

than making separate registrations for the various component parts of the multi-media work in the respective classes (e.g., a printed booklet in Class A, film strips in Class J, a commercial print or label in Class KK), the remitter may elect to make a single collective registration in Class A for the entire unit of first publication. Frequently the deposit will include a phonorecord. It is possible some remitters assume the sound recording fixed in the phonorecord is covered by the A registration.

In the past, when a single registration was made for the entire multi-media deposit, we may have accepted phonorecords as part of the unit of publication, but this acceptance did not confer any protection on the sound recording or on the underlying work. Regardless of past practice, in view of the sound recording amendment providing protection for sound recordings, we now take the position that a phonorecord cannot be accepted for deposit when making registration in any class other than Class N. This is because of the divergent notice requirements for Class N material and because of the still binding decision in *White-Smith v. Apollo*, 209 U.S. 1 (1908). If the sound recording is registrable, a separate registration should be made for it in Class N. If the remitter is not claiming copyright in the sound recording, i.e., if he does not also file a Form N, he should remove any phonorecords (discs, cassettes, cartridges, etc.) from the booklet or kit before forwarding the material to the Copyright Office.

AUTHORSHIP PROBLEMS

Copyright in sound recordings is based on the original sound recording authorship present. Thus, the copyrightable elements in a sound recording will usually involve authorship on the part of the performer(s) whose performance is captured and perhaps on the part of the record producer, representing the contribution of the sound engineers, etc. Line 4 of the application should name the author(s) of the sound recording.

Line 4 of some applications names the author(s) of the underlying work rather than the author(s) of the sound recordings. This of course indicates a misunderstanding of the nature and scope of the Class N registration.

Even where one or more sound recording authors, e.g., the performers, are named, problems sometimes arise because some attempt has been made to identify the individuals with a group or company name. For example, line 4 may give "Fred Fang, aka The Monsters." Although a number of individuals collectively may be known under a

group name, a single individual is ordinarily not identified this way. Therefore, "aka" would not seem appropriate when followed by a group name. If the individual is a member of an unincorporated group and entitled to claim authorship as an individual performer, line 4 should give the individual's name followed by "(member of)." Any other members of the group who are performers may be listed in the same way. Another example: line 4 may name the performing group only, e.g., "The Box Cars." Unless the group is a separate legal entity, line 4 should list the names of the individual members of the group who contributed copyrightable authorship followed by the statement, "(member of)."

More difficult problems arise when a firm is named as author. For example, line 4 may name Fantastic Records as author but this name does not appear on the copies. The copies state only "Produced by Bob Bigdeal" or "Produced by Bob Bigdeal for Super-Hit Records." (The name following the "produced by" phrase is sometimes that of a performing group or a firm instead of an individual.) Are both Bob Bigdeal and Super-Hit Records employees of Fantastic Records? Or is the application in error? Another example: line 4 names You'll-Love-Our-Records, Inc. The copies contain the name of Sweet Sounds Recordings plus the statement, "Mfgd by You'll-Love-Our-Records, Inc." Are we to assume that "Mfgd by . . ." also means "Produced by . . .?" Still another example: line 4 names Zodiac Recording Corp. but the copies state "Prod. by Stanley Stargazer for Scorpio Records." "Scorpio Records" appears in bold type on the label as the logo and the only reference to Zodiac Recording Corp. is "Dist. by Zodiac Recording Corp." Is it not too broad an assumption in this case to assume "Dist. by . . ." also includes "Produced by . . .?" Is not Scorpio Records probably the record producer in this case?

The name of the record producer who is the author of the sound recording should be named in line 4 of the application. If it is not clear from the copies that the firm named in line 4 as author *is* the record producer, it would be helpful if remitters would explain the questionable statements on the copy in a covering letter. Of course, the entire problem could be virtually eliminated if the name listed in line 4 were clearly identified on the copies as THE record producer.

CLAIMANT-NOTICE PROBLEMS

To secure statutory copyright in a sound recording, all published copies must bear the statutory copyright notice required for sound recordings. This notice should appear on the surface in such a manner

and location as to give reasonable notice of the claim of copyright. The notice consists of the symbol © (the letter P in a circle), the year of first publication of the sound recording, and the name of the owner of copyright in the sound recording. The law provides, as an alternative, that the notice may consist of the symbol ©, the year date of first publication, and an abbreviation by which the name of the copyright owner can be recognized or a generally known alternative designation of the owner. Also, the law states that if the producer of the sound recording is named on the labels or containers of the copies of the sound recording, and if no other name appears in conjunction with the notice, his name shall be considered a part of the notice.

We have experienced relatively few problems with the position requirement or the requirement that the notice contain the symbol © and the year date of first publication. Most of our problems concern the name of the copyright owner and thus raise the question: who owns the copyright in the sound recording? In discussing these ownership problems it might be helpful to break them down according to cases where (1) the notice contains the name of the owner of copyright in the sound recording or an abbreviation or generally known alternative designation, and (2) where there is no name in conjunction with the notice and the producer's name is considered as part of the notice.

Where the notice contains "the name of the owner of copyright in the sound recording," this name should be the full legal name and line 1 of the application should contain this exact same name. We sometimes receive applications where the name given in line 1 does not agree exactly—or, in some cases, at all—with the name given in the notice. For example, the name in the notice may be Why Not Records Co., whereas line 1 gives a slightly different form of the name such as Why Not Recording Co. Or, the notice may contain the name of a record company, e.g., Cosmic Ray Record Corp. whereas line 1 names an individual performer, Sunny Day. Or, the notice may name one record company, Top Notch Records, whereas line 1 names an entirely different one, Bottom Rung Recording Corp. In still other cases the notice may name a corporation and its director, e.g., "Slim Sleep, Director of Snooze Records, Inc." whereas line 1 gives only the corporation, Snooze Records Inc., the label and/or jacket may bear two separate © 1972 notices with different names, whereas line 1 gives only one of these names.

If the name in the notice does not identify the copyright owner or someone authorized to secure the copyright, we cannot, of course,

register the claim. For example, we cannot register if the name of the copyright owner of the underlying musical work is mistakenly given in the notice on all copies through a printer's error. Unfortunately, once copies have been published without the statutory notice or with an inadequate notice, copyright protection is lost permanently and cannot be regained. Adding the correct notice later will not restore protection or permit us to register the claim.

If the name in the notice *is* that of the copyright owner of the sound recording or someone authorized to secure the copyright, and the application is in error, the problem may be remedied by the submission of a new application giving in line 1 the name that appears in the notice.

In other cases the remitter may have chosen to rely on one of the permissible alternative forms of notice, and the name in the notice is either an abbreviation of the claimant's legal name or a generally known alternative designation of the copyright owner. If so, this relationship should be explained in line 1. It is preferable to explain the relationship in all cases, but an explanation is vital where the full legal name does not appear anywhere on the label or container. Line 1 should give the abbreviation or designation exactly as it appears in the notice on the copies followed by the appropriate statement, for example, "Hippo Rec., abbreviation of the name Hippopotamus Records, Inc." or "Sahara, generally known alternative designation of Sahara Records, Inc." It is important to remember that where an abbreviation is used, registration can be made only if the abbreviated variant itself apprises the general public of the name of the claimant. Again, where the alternative designation is used, we can register only if the designation is known to the general public as distinguished from the trade itself, or from the specialized public in the trade. The mere presence in the notice of an abbreviated name or another designation of the claimant's name is not, in and of itself, sufficient to satisfy the notice requirements.

The law regarding the notice on reproductions of sound recordings does not require that the name of the owner (or an acceptable variant) and the year date "accompany" the symbol ©. Thus, we can register where all three elements are present, even though separate, provided it is reasonably clear that the "name" present is that of the claimant. However, our most difficult "name" problems to date have concerned this very situation, i.e., where no name "accompanies" the other elements in the notice.

If the separated name is the only name or variant appearing in conjunction with the remaining elements of the notice, i.e., when it

is positioned sufficiently near the remaining elements to give reasonable notice that copyright is claimed under that name, we can accept it as part of the notice if, indeed, this name identifies the copyright owner. The problem, however, is that inevitably the labels or jackets contain many names. These names may be those of the author(s) and claimant(s) of the underlying work, the performer(s), the sound engineer(s) as well as the manufacturer(s) and distributor(s). There may also be one or more statements such as "Produced by Sam Strange for One-of-a-Kind Records," or "Produced and Arr. by Ronald Rare" or "Recorded at Unique Recording Studios." In many cases, still another name, i.e., the name of the record label or logo, may appear in bold type.

Of course, the statute creates a presumption in favor of the record producer as the correct claimant if no other name or variant of a name appears in conjunction with the notice. Unfortunately, it is not always obvious from the various names and statements appearing on the copy that the firm or person named at line 1 is clearly or likely to be the record producer and thus that registration in that name is authorized. For example, line 1 may name Moon Goddess Records as the claimant but this name does not appear on the copies. The label states "Produced by Diana Hunter." The logo which appears prominently at the top of the label is in the name of Bow and Arrow Recording Co. Is the application correct? If so, we cannot register the claim. Is Diana Hunter an employee of Moon Goddess Records? Or is Diana Hunter actually *the* record producer? Could Bow and Arrow Recording Co. be the record producer? Take another example: line 1 names Poison Apple Productions as the claimant. The label contains only the name of Snow White Recording Co. and a logo in the name of Seven Dwarfs Records. The remitter explains that Poison Apple Productions is the record producer and that Seven Dwarfs Records is one of the labels that Poison Apple Productions uses in the course of its business. Is Seven Dwarfs Records a legal entity capable of claiming copyright? If not, we cannot register the claim. Still another example: line 1 names Wendell Winken as claimant. The label states "Produced by Blan Blinken" and there is a logo in the bold print in the name of Nod Productions. Is Nod Productions really the record producer and Blan Blinken an employee of Nod Productions? Are both Winken and Blinken employees of Nod Productions? Another example: line 1 names See Sharp Music Corp. as claimant. The label contains the names of See Sharp Music Corp. and "Be Flat Records" separated from and at equidistance from the "© 1972." Also appearing on the label in fine print are credits such as: "Produced by Clef Bros., Music Accomp. by

Sue Staff, Horns Arr. by Bill Bass, Recorded at Oz Recording Studios, Engineer: Ed Wizard." Who is the record producer?

The situation is further complicated when a name other than that listed in line 1 is *closer* to the "© 1972" on the label than the name identified in line 1. We must then decide whether the name appearing closest to the "© 1972" is so close that it must be regarded as being the name "in conjunction with" the notice. If it is, then we cannot look elsewhere to the record producer's name as being a part of the notice. These decisions are frequently close and difficult ones. If the name is directly (one typed space) above the "© 1972," is that name "in conjunction with" the notice? If two typed spaces above? What if it is slightly separated and to the right? Is it significant that this name may be in smaller type than the name identified as the claimant? Does the fact that this name is that of an individual, a performer, or the owner of the underlying work, bear one way or another in the decision?

. We attempt to interpret the notice provisions liberally, and we give weight to the name asserted by the remitter on the application to be the claimant. However, as the above examples suggest, there are times when the facts on the copies do not clearly support this assertion and we believe we must question ownership. These questions can be avoided if care is taken to see that the full legal name of the copyright owner of the sound recording "accompanies" the other two elements of the notice.

PUBLICATION AND DEPOSIT PROBLEMS

The law does not provide for statutory copyright in unpublished sound recordings. Therefore they should not be sent to us for registration.

The law provides statutory copyright only for *published* sound recordings fixed on or after February 15, 1972. A sound recording is "published" when copies (phonorecords) are placed on sale, sold or publicly distributed. Promptly after copies bearing the statutory copyright notice have been published, the claim to copyright should be registered in the Copyright Office by sending "two complete copies of the best edition thereof then published" accompanied by a claim of copyright. In the case of works published abroad by foreign authors, one copy may be deposited. A "complete" copy of a sound recording consists of the sound recording fixed in a particular physical object (disc, tape, etc.) together with any sleeve, jacket, or other container housing the work as it was first published, and any liner notes or other similar accompanying material.

Some remitters deposit only one complete copy. Some deposit two discs but fail to deposit the sleeve or jacket that houses the disc as it was published. Some file two separate applications, one on Form N for the sound recording and one on Form A for the jacket and liner notes, but they send only two complete copies of the sound recording. Where two such registrations are being made we need two complete copies for the Class N registration *plus* two additional copies of the jacket and liner notes only for the Class A registration.

The copies deposited should be of the best edition as first published and identical in every respect. Two '45 discs may bear labels that differ as to color or design. Or one sleeve on an LP may contain text matter, whereas the other sleeve is blank. In some openreel tape deposits, the plastic reels on which the tape is wound and the outer cardboard containers may be unidentical. Assuming in each case that copies have actually been published, we need one additional copy in whichever form the work was first published. The problem can be avoided, of course, by depositing two identical copies initially.

Some remitters deposit copies bearing a sticker or printed statement reading "DJ copy" or "Not for sale" or "Promotional use only." Such a deposit raises not only the question of whether the DJ copies represent the best edition but also the question of whether, in fact, publication has actually taken place. A general publication occurs when copies have been made available to the general public, without express or implied restrictions as to future use, usually by means of a sale, an offering for sale, or a public distribution. Sometimes copies are circulated privately, or are otherwise distributed to a limited group for a specific purpose. This kind of distribution is known as "limited publication," and it will not always be clear whether the work has been "published" within the meaning of the copyright law. The general understanding is that a "limited publication" will not be regarded by the courts as a publication that destroys copyright protection (for example, if the notice were omitted from the copies). It is less clear whether a "limited publication" will be regarded as publication for the purpose of *securing* statutory copyright. Because of the restrictions placed on the distribution of disc jockey copies, we feel obliged, when we receive such copies, to correspond with the remitter to clarify the publication concept and to inquire if the distribution made actually constituted a publication such as would invest statutory copyright. If the remitter regards the distribution of DJ copies as only a "limited distribution" and not an investitive publication, registration should be delayed until commercial copies are actually published. On the other hand, if the remitter regards the distribution to disc jockies as an

investitive publication, we will register on the basis of the DJ copies. If both DJ and commercial copies were actually "published" on the same day, we regard the commercial copies as the best edition and we would need two such copies. Presumably these will not contain any such statement as "DJ copy" or "Promotional use only," etc. If DJ copies and commercial copies were both published in the copyright sense, but on different days, we need the copies as *first* published. In any case, line 5 of Form N should give the date of *first* publication of the copies deposited. Where DJ copies are being deposited as the best edition as first published, it would be helpful to have a covering letter confirming the fact that the work is published and that the deposit copies represent the best edition as first published. (It is possible that at some later time the Library of Congress may adopt the view that DJ copies do not represent the "best edition," but this position has not been adopted at this writing.)

NEW MATTER AND FIXATION PROBLEMS

New versions of previously published sound recordings, like new versions of other classes of works, are subject to statutory copyright protection. The copyright in the new version covers only the copyrightable new matter (i.e., changes or additions) appearing in the sound recording for the first time. It is important therefore that line 6 of the application give a brief description of this new matter. New matter may consist of compilation, editorial revision, abridgment, as well as additional recorded material. Unless line 6 is properly completed the nature and extent of the present claim will not be clear.

Some remitters complete line 6 by giving a description of the *old* matter, i.e., the sounds that were previously published, rather than the sounds being published for the first time. For example, line 6 of the application for an LP containing 10 bands, two of which were published previously as singles, may give "2 bands previously published" whereas it should state "8 bands are new." If it is important that the new bands be identified by title, line 6 might state "bands 1, 2, 4 and 5 on Side A and bands 2, 3, 4 and 5 on Side B are new." Or, in an application for a '45 listing both titles in line 2, where one side was previously published in an LP, applicants have given the title of the previously published side at line 6 whereas the other title should be given.

Some remitters file applications which, because line 6 is left blank, purport to cover entirely new sound recordings. However, the copies accompanying the applications contain statements suggesting that some,

if not all, of the sounds in the recording were previously published in another sound recording. For example, the label on a '45 may state "From the LP . . ." Because of the statements on the copies we must correspond to establish the basis and extent of the claim. If the LPs were published *before* the '45s, then, of course, registration for the '45s is possible only if they contain substantial copyrightable new matter not appearing in the LPs. In such cases, line 6 of the applications must be amended to include a description of the new matter and line 4 to include the author of the new matter. If, despite the "From . . ." statement on the copies, the LPs were *not* published before the 45's (as apparently sometimes happens), then upon receipt of the remitter's statement to that effect, we can register as applied for. In either case, such correspondence could be avoided if the remitter would explain in a covering letter the presence of such questionable statements on the copies.

A similar problem arises when line 6 of the application is blank and the labels on a '45, for example, contain a statement such as "From the Musical Production . . ." It is not clear whether the sounds were previously published, possibly in an original cast album, in which case we could register the present deposit only if it contains substantial new matter, or whether the deposit is actually the first—or at least an entirely new—recording of the show tunes. We are obliged to inquire.

Another example: Line 6 may be blank but the copies bear a statement such as "From the motion picture soundtrack . . .," or "Original Soundtrack" or "Soundtrack Album." The sound recording amendment excludes from its coverage "sounds accompanying a motion picture." We must inquire therefore whether the sounds were originally fixed in a motion picture soundtrack and first published by distribution of the integrated motion picture. Possibly the release date of the motion picture was subsequent to the date of publication of the album, or possibly the sounds on the album are the result of an entirely separate recording session. If so, upon receipt of the remitter's statement to that effect, we can consider registration.

To be copyrightable as a new version, a sound recording must either be so different in substance from the original recording as to be regarded as a "new work" or it must contain a substantial amount of new recorded material. We cannot register a claim where only a few minor revisions or additions of no substance have been made or where the changes are the result of mechanical rather than creative processes.

These requirements pose difficult problems with respect to the copyrightability of new sound recordings such as those just mentioned that result from the transfer of sound from one speed (78 rpm, 45 rpm, 33-1/3 rpm) to another (for example, from an LP to a '45), one medium (soundtrack, disc, open-reel tape, cartridge, cassette) to another, or from one sound system (monophonic, stereophonic, or quadraphonic) to another. The question is whether the reprocessing of one master recording of which reproductions have been widely disseminated to achieve a "new" master recording of the same performance results in a copyrightable new version.

Where the sound in the new sound recording results *solely* from a mechanical re-recording of the sound of a previously fixed performance of which reproductions were published, it seems doubtful that registration for the new sound recording is possible. Such a transfer seems to involve only a mechanical process wherein the record producer functions more like a skilled technician than as an author under the copyright act.

Whether the record producer functions other than as a technician even when he alters the original master recording so as to accommodate the new medium, speed, or sound system also seems doubtful in some instances. Where the "new matter" is described in the application as "abridgment," a term that has a fairly well established meaning, the general type of authorship contributed by the sound engineers seems clear. Whether it is copyrightable, however, is another matter. For example, an "abridgment" may be copyrightable provided substantial authorship was involved in the selection of the particular sounds to be deleted; it would not be copyrightable if the sound engineer only lopped off a few sounds at the beginning and very end of the work. Where the new matter is described as "editing," the nature of the sound engineer's contribution is considerably less clear because the term "editing" is apparently used to describe a variety of specialized efforts which may or may not be copyrightable depending upon the nature and amount of the particular contribution. Where the new matter is described in specific technical terms peculiar to the record industry, e.g., "remixing," "new mix," "re-sequencing," "sweetening," "declicking," "reprocessing," "equalizing," "balancing," "master tape remixed and encoded for quadraphonic sound," it becomes extremely difficult to ascertain the real nature of the sound engineer's contribution and thus whether it is copyrightable. The difficulty is undoubtedly partly one of semantics. Our experience has been that the terms do not seem to have a single meaning within the industry. In addition, sound engineers themselves, even when they agree on the meaning of the terms, appar-

ently have differing opinions as to the degree of creativeness, if any, of the operations involved.

Unfortunately, we have virtually no judicial guide lines at the present time to aid us in evaluating the contributions of sound engineers in such cases. Moreover, the unique nature of certain contributions by sound engineers makes comparison with known types of copyrightable authorship in other classes of works difficult if not impossible. It is conceded that the efforts of the sound engineers can sharply affect the quality and clarity of the sounds recorded. The question remains whether the skill and efforts of these technicians, or sound engineers, at least in certain cases, qualify for protection under copyright.

Based on our present interpretation of the new amendment and our present understanding of recording technology we will not make registration where the new master recording represents a mechanical re-recording of the same sounds as contained in the original master. If the sounds in the new recording have been altered and a claim is asserted on the basis of these changes, we are presently ordinarily requesting that the remitter accompany his claim with a covering letter explaining in detail the exact nature of the changes made.

Problems concerning fixation appear to be diminishing as we get further away in time from February 15, 1972. However, several remain. Under the new amendment to the copyright law a sound recording may be subject to statutory copyright protection provided that the sounds constituting the sound recording as published were "fixed" on or after February 15, 1972. A series of sounds constituting a sound recording is "fixed" when that complete series is first produced on a final master recording that is later reproduced in published copies. Like the date of publication, the date of fixation is a vital factor in determining the extent of the copyrightable authorship in a particular version of a sound recording. In other words, statutory copyright in a particular sound recording cannot be secured in any sounds that were previously *published anytime* or in any sounds that were *fixed* before *February 15, 1972*, regardless of when they were first published.

Whereas line 6 of Form N calls for a positive assertion of the sounds being *published* for the first time (and thus by implication defines those that were previously published), the approach to line 7 is a negative one. Line 7 of Form N calls for a description of those sounds that are *ineligible* for protection, i.e., those sounds published for the first time that were fixed before February 15th. Some remitters give in line 7 a statement of the sounds that were previously *published*. As indicated above, pre-

viously published sounds will have been excluded from the claim by the statement of new matter given in line 6.

In other cases, line 7 may be blank implying all sounds were fixed after February 15, 1972. However, the copies contain a statement such as "Recorded live in 1971" suggesting that some, if not all, of the sounds may be ineligible for statutory copyright because they were fixed before February 15, 1972. If the sounds were fixed in a final master recording before this date, we cannot register the claim. On the other hand, if, although recorded live in 1971, the original tapes were substantially re-mixed and edited after the recording session and the sounds were not fixed in a final master until after that date, upon receipt of the remitter's statement confirming this, we can consider registration. As in cases mentioned earlier concerning publication questions, such correspondence could be avoided if the remitter would explain in a covering letter the presence of these questionable statements on the copies.

CONCLUSION

The passage of any new legislation ordinarily brings problems to the particular public sector which is affected by it and to the governmental agency charged with its administration—and the new sound recording amendment to the copyright law has been no exception. The first six months of operation under the act have disclosed numerous problems with which both record companies and the Copyright Office must come to grips. These problems concern the nature and purpose of the act as well as proper registration procedures. A look at some of our statistics for this period suggest the extent of the problems. We refused registration for 253 sound recordings. Of the 2,174 claims in sound recordings registered as of September 29, 1972, we had to correspond about roughly 383, or 17 per cent, of them. As set forth in this paper, an analysis of this correspondence shows that the problems generally fall into five major areas: (1) misunderstanding as to the scope of protection; (2) authorship problems; (3) claimant-notice problems; (4) publication-deposit problems; and (5) new matter and fixation problems. Undoubtedly, the amount of correspondence engendered by sound recording deposits will diminish as remitters become more familiar with the law and registration procedures.

APPENDIX I

Page 1

Application for Registration of a Claim to Copyright in a published sound recording

FORM N

REGISTRATION NO. DO NOT WRITE HERE NF NFO N

CLASS N

Instructions: Make sure that all applicable spaces have been completed before you submit the form. The application must be SIGNED at line 11. The application should not be submitted until after the date of publication given in line 5 (a), and should state the facts which existed on that date. For further information, see page 4.

and ink. Pages 3 and 4 should contain exactly the same information as pages 1 and 2, but may be carbon copies.

Mail all pages of the application to the Register of Copyrights, Library of Congress, Washington, D.C. 20540, together with 2 copies of the best edition of the work and the registration fee of \$0. Make your remittance payable to the Register of Copyrights.

Pages 1 and 2 should be typewritten or printed with pen

1. Copyright Claimant(s) and Address(es): Give the name(s) and address(es) of the copyright owner(s). Ordinarily the name should be the same as in the notice of copyright on the copies deposited. If, instead of the name of the copyright owner, the notice contains an abbreviation by which the name can be recognized or a generally known alternative designation of the owner, see page 4 under Alternative Form of Notice.

Name

Address

Name

Address

2. Title: (Give title of sound recording as it appears on the copies; also catalog number if one appears on the copies)

3. (a) Description of Sound Recording Deposited: (Characterize the general type of sound recording; for example, disc, open-reel tape, cartridge, cassette, etc.)

(b) Nature of Material Recorded: (Characterize the general type of material recorded; for example, music, drama, narration, etc.)

4. Author of This Sound Recording: Citizenship and domicile information must be given. Where a work is made for hire, the employer is the author. The citizenship of organizations formed under U.S. Federal or State law should be stated as U.S.A. If the copyright claim is based on new matter (see line 6) give information about the author of new matter.

Name Citizenship (Name of country)

Domiciled in U.S.A. Yes No Address

Name Citizenship (Name of country)

Domiciled in U.S.A. Yes No Address

5. (a) Date of Publication of This Sound Recording: Give the complete date when copies of this particular sound recording were first placed on sale, sold, or publicly distributed. The date when the sound recording was fixed or the date when copies were reproduced should not be confused with the date of publication. NOTE: The full date (month, day, and year) must be given.

(Month) (Day) (Year)

(b) Place of Publication of This Sound Recording: Give the name of the country in which this particular sound recording was first published.

NOTE: Leave line 6 blank unless the instructions below apply to your work.

6. New Matter in This Sound Recording: If any substantial part of the sounds fixed in this recording has been previously published in another recording, give a brief general statement of the nature of the new matter in this recording. New matter may consist of compilation, editorial revision, abridgment, and the like, as well as additional recorded material.

NOTE: Leave line 7 blank unless the instructions below apply to your work.

7. Fixation before February 15, 1972: If any substantial part of the sounds published for the first time in this recording was fixed before February 15, 1972, give a brief general statement of the nature of that material. (For further information concerning "fixation," see page 4.)

Complete all applicable spaces on next page

EXAMINER

8. If registration fee is to be charged to a deposit account established in the Copyright Office, give name of account:

9. Name and address of person or organization to whom correspondence and refund, if any, should be sent:

Name Address

10. Send certificate to:

(Type or print name and address)	Name
	Address
	(Number and street)
	(City) (State) (ZIP Code)

11. Certification:

(Application not acceptable unless signed)

I CERTIFY that the statements made by me in this application are correct to the best of my knowledge.
 (Signature of copyright claimant or duly authorized agent)

Application Forms

Copies of the following forms will be supplied by the Copyright Office without charge upon request.

- Class A Form A—Published book manufactured in the United States of America.
- Class A or B { Form A-B Foreign—Book or periodical manufactured outside the United States of America (except works subject to the ad interim provisions of the copyright law).
Form A-B Ad Interim—Book or periodical in the English language manufactured and first published outside the United States of America.
- Class B { Form B—Periodical manufactured in the United States of America.
Form BB—Contribution to a periodical manufactured in the United States of America.
- Class C Form C—Lecture or similar production prepared for oral delivery.
- Class D Form D—Dramatic or dramatico-musical composition.
- Class E { Form E—Musical composition the author of which is a citizen or domiciliary of the United States of America or which was first published in the United States of America.
Form E Foreign—Musical composition the author of which is not a citizen or domiciliary of the United States of America and which was not first published in the United States of America.
- Class F Form F—Map.
- Class G Form G—Work of art or a model or design for a work of art.
- Class H Form H—Reproduction of a work of art.
- Class I Form I—Drawing or plastic work of a scientific or technical character.
- Class J Form J—Photograph.
- Class K { Form K—Print or pictorial illustration.
Form KK—Print or label used for an article of merchandise.
- Class L or M { Form L-M—Motion Picture.
- Class N Form N—Sound Recording.
Form R—Renewal copyright.
Form U—Notice of use of musical composition on mechanical instruments.

FOR COPYRIGHT OFFICE USE ONLY	
Application received	
Two copies received	
Fee received	
Renewal	

3. SMALL AND GRAND PERFORMING RIGHTS? (*Who Cared Before "Jesus Christ Superstar"*).

By VINCENT LOUIS PERRONE*

"What's the buzz? Tell me what's happening" are lyrics from the "rock opera" *Jesus Christ Superstar*.¹ Coincidentally, and apart from their function in that opera, they capture appropriately the mood created by the recent copyright litigation involving this work. Suits brought for alleged infringement of the copyright in *Jesus Christ Superstar* have raised basic legal issues with respect to the licensing of performing rights in musical and dramatico-musical compositions. The following discussion will examine these issues in an attempt to answer the above question and tell "what's happening" in the related areas of copyright law.

Jesus Christ Superstar is a "rock opera" composed by two Englishmen, composer Andrew Lloyd Webber and librettist Tim Rice. It depicts the last seven days in the life of Christ.² Commercially, it is proving to be one of the most valuable and important contemporary musical works. "More than two million records and tape cartridges of the full opera have been sold, the authorized touring production grossed over one million dollars in its first four weeks," and the Broadway version at the Mark Hellinger Theater is playing to a "sold-out" house.³ It has been hailed as the "biggest all-media parlay in show business history."⁴ The opera has also received substantial critical acclaim from newspapers,

* This paper was awarded First Prize in the 1972 Annual Nathan Burkan Competition at New York University Law School.

1. Libretto of *Jesus Christ Superstar*.

2. For the historically curious: *Jesus Christ Superstar, A Rock Opera*, evolved, beginning in 1969, from a 45-rpm single entitled appropriately "Jesus Christ Superstar." The vast success of this single inspired the creators, Tim Rice, age twenty-seven and Andrew Lloyd Webber, age twenty-three, to compose the rest of the opera for which the song became the climactic number. Recording began at the Olympic Sound Studios in England and shortly thereafter the finished opera was released by Decca on a two-LP album with a total playing time of eighty-seven minutes and sixteen seconds. The large commercial success of the album, especially in the United States, triggered a series of concert versions of the opera. In October, 1971, the Broadway production, a show born from a recording, opened with the first six weeks of performances sold out and a \$1.2 million advance sale. Completing the cycle, an original cast album of the original Broadway cast was recorded in the same month.

3. *Robert Stigwood Group Ltd. v. Sperber*, No. 71-2057 (2d Cir., March 17, 1972). Cf. *BUS. WEEK* 46 (Sept. 11, 1971).

4. *VARIETY* cited in *NEWSWEEK* 84 (Oct. 25, 1971).

magazines and media throughout the United States and the world.⁵ From a legal viewpoint, however, the most fascinating aspect of the opera's phenomenal success is the litigation it has generated. During the course of this litigation, a relatively unnoticed distinction attracted much notice. Before enlarging upon this distinction, a brief consideration should be given to the statutory scheme underlying its significance.

IN THE BEGINNING: *Classify the Music*

Section 5 of the Copyright Act⁶ provides a system of classification whereby claims to copyright are registered.⁷ Subsection (d) of section 5 provides for the copyright of "Dramatic or dramatico-musical compositions." Registration of works under the class "musical compositions" is provided by section 5(e).⁸ At this point, an author, believing his work to be music and wishing to register his claim to copyright, might appropriately ask, "Under which class does my 'music' fall?" As will be seen below, the correct answer to this question will enable our author to ascertain the rights available to him under the Copyright Act.

The Copyright Office Regulations state that the class "dramatic" and "dramatico-musical compositions" includes "published or unpublished works dramatic in character such as the acting version of plays for the stage, motion pictures, radio, television and the like, opera, operettas, musical comedies and similar productions, and pantomimes."⁹ It would seem then that for music to be classified as a "dramatico-musical" composition it must be "dramatic in character." No definition of these terms is provided in the Copyright Act. One court has suggested that "[a] sketch, consisting of a series of recitations and songs, with very little dialogue and action, and with scenery, and lights thrown upon the singer, is a dramatico-musical composition, within the provisions of the copy-

5. See LIFE 21 (May 28, 1971); SATURDAY REVIEW 65 (Oct. 30, 1971).

6. 17 U.S.C. § 5.

7. It should be noted that the importance of the classification should not be minimized. A work must come within the confines of this classification system in order to qualify as a copyrightable work entitled to statutory protection. M. NIMMER, NIMMER ON COPYRIGHT § 12.23 (1971) [hereinafter cited as NIMMER].

8. "Dramatico-musical compositions" and "musical compositions" are terms used in 17 U.S.C. § 5 (d) & (e).

9. 37 C.F.R. § 202.7; Circular 48 of the Copyright Office states:

Operas, music dramas, musical comedies, musical plays for television and other productions in which music and drama are integrated are classified as 'dramatico-musical compositions' registrable in Class D.

right law.”¹⁰ Another court has stated that a dramatico-musical composition includes not only a plot, character and acting, but also musical and/or vocal accompaniment.¹¹

Perhaps it may be helpful to focus on the term “dramatico-musical.” The meaning of the word, according to Webster’s Dictionary,¹² is “consisting of drama and music.” Assuming that the work, if not copyrightable under § 5(d), would be registered as a musical composition under § 5(e),¹³ the remaining unknown is the term “drama.” What then is drama and what makes a work dramatic or nondramatic?

Tests for Drama. The usual criterion, with legal and dramaturgical authorities is: If the work has capacity for performance or stage presentation, it is a dramatic work. Others look to the work itself and determine whether or not it ‘tells a story.’ Still others (the minority) test the dramatic possibilities in an opus by questioning whether the work arouses the emotions. In this latter case, it is the contention that the stimulation of emotion is the purpose of drama and, what is more important, the source of greatest interest on the part of the audience.

All three schools have their good points, although the emotional theory has been rejected recently by the courts.

Looking at the representative criterion, stage presentation, we find that it has been assumed by some that ‘dramatic form’ — taking in the elements of action (whether by pantomime or dialogue), scenic effects and costume — is an essential attribute of drama. But we must remember that in the days of Shakespeare, the great dramatists’s works were presented without the benefit of lighting, scenery, or even costuming. Actors portrayed Caesar and Brutus walking about in doublet and hose. There was no change of scene; actors walked off and when they walked on again the audience was supposed to know that the locality was different.

The performance also of an oratorio is essentially dramatic (despite the fact that copyright must be obtained under ‘musical compositions’). Even in the absence of scenery, gesture or costume, the fact that the orchestra sits on the platform with the soloist rising to render their vocal numbers, gives the work a dramatic flavor. ‘The Messiah’ for example, chronicling the coming of Christ, and

10. *Green v. Luby*, 177 Fed. 287, 288 (S.D.N.Y. 1909).

11. *April Productions, Inc. v. Strand Enterprises Inc.*, 79 F.Supp. 515 (S.D.N.Y. 1948) citing Copyright Law and Practice, AMDUR § 20.

12. WEBSTER’S THIRD NEW INT’L DICTIONARY (3rd ed. 1968).

13. 17 U.S.C. § 5 (d) & (e).

various events in this lifetime, brings in all the elements of drama. So with Bach's 'St. Matthew Passion' and other like pieces: they are all dramatic in essence. There are many monologue dramas — for instance, such as given by Cornelia Otis Skinner and Ruth Draper; and it has been held in an English case that a song performed by a singer, accompanying himself on the piano, is dramatic.

Thus, neither scenery, costume nor any of the incidental accompaniments of a dramatic production are essential to dramatic presentation in this country. . . .

Whether we see the actors on the stage or listen to unseen actors over the radio, the essential element is always the story. Today, as three hundred years ago, the appropriate designation of the necessary qualities of a drama may be summed up in Hamlet's words 'The play's the thing.'¹⁴

In the words of Mr. Justice Holmes, the essence of drama then is "that we see the event or story lived."¹⁵ From the above it may be observed that for a composition to be deemed dramatic, it must at least relate a story.¹⁶ Accordingly, a musical composition may be held to fall within the class "dramatico-musical" if it possesses that dramatic element: relation of a story.¹⁷

But is the telling of a story enough to justify classifying a musical composition a "dramatico-musical" work? A song is a metrical composition composed of word and music.¹⁸ Often the words or lyrics do depict an event or events which generally could be termed a story.¹⁹ Does this mean that a song which relates a story is a dramatic composition? In *M. Witmark & Sons v. Pastime Amusement Co.*,²⁰ the court held that

14. SHAFER, *MUSICAL COPYRIGHT*, 55 (2d ed. 1939) (Citations omitted).

15. *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 61 (1911).

16. *Daly v. Palmer*, 6 Fed. Cas. 1132, No. 3552 (S.D.N.Y. 1868); *NIMMER*, § 16.1.

17. One commentator has suggested that "in order for a musical composition to also fall within the meaning of dramatico-musical composition, it must be adapted from, be part of, or form a dramatic composition." Comment, *Dramatic Performing Rights in Dramatico-Musical Compositions: Scope of Protection*, 34 S. CAL. L. REV. 447, 448 (1961).

18. A song may also be defined as "a short musical composition made up of mutually dependant words and music which together produce a unique aesthetic response. . . ." *WEBSTER'S THIRD NEW INT'L DICTIONARY*.

19. Ballads are "songs" which characteristically relate stories but are generally termed "musical compositions."

20. 298 Fed. 470, 475 (E.D. S. Car. 1924).

the song in issue, "Kiss Me Again," was not a dramatic composition. Judge Cochran did imply, however, that a song which contained "dramatic features" might be considered a dramatic composition.²¹ This suggests that for a song to be classified as a "dramatic composition" it must tell a story and be by its very nature dramatic.²² If it is music and meets these requirements, the work certainly could be registered under § 5(d). It is unlikely, however, that songs in general may be termed inherently dramatic.

The above semantic field trip may have created more problems for our author than it solved. As a practical matter though, he should have little difficulty in ascertaining the classification under which his work will be registered.

At the same time, it is important to note the distinction which should be made between the nature of the work itself and the nature of the performance presenting the work. A nondramatic musical composition may be performed in a dramatic manner.²³ It may be dramatized.²⁴ But the dramatic performance of a nondramatic composition does not necessarily transform the composition into a dramatic work. In other words, a dramatic performance of a "musical composition" does not make the composition a "dramatico-musical" work. In sum, it is the character of the work itself, not the type of performance by which it is rendered that determines the rights available to the copy-right proprietor.²⁵

21. *Id.* at 473; *accord Russell v. Smith*, 12 Q.B. 217 (1848), which held that a song "The Ship on Fire" was a dramatic song. The song related the burning of a ship at sea and the escape of those on board, describing their feelings in vehement language. It was sung by one vocalist at a piano without the assistance of scenery or appropriate dress.

22. Professor Nimmer has suggested that the two essential elements of a dramatic composition are the following:

1. that it relates a story, and
2. that it provides directions whereby a substantial portion of the story may be visually or audibly represented to an audience as actually occurring, rather than merely being narrated or described. NIMMER § 16.1.

23. 17 U.S.C. § 1 (e).

24. It should be noted that:

[T]he dramatic rendition of a musical composition merely represents the exercise of one of the rights granted to the copyright owner of a musical composition, i.e., the right to dramatize. NIMMER § 16.4; *See* 17 U.S.C. § 1 (b).

25. *M. Witmark & Sons v. Pastime Amusement Co.*, 298 Fed. 470, 474 (1924).

PERFORMING RIGHTS AND ASCAP:

*"What's it all about"*²⁶

Section 1 of the Copyright Act²⁷ enumerates the exclusive rights which an author or a proprietor²⁸ of a copyrighted work receives under the statute. The exclusive right to perform is conferred in dramatic works and musical compositions.²⁹ As was suggested by Judge Rodgers in *Herbert v. Shanley*,³⁰ dramatico-musical works are entitled to the performing rights given to dramatic works. That is, the author of a dramatico-musical work has the exclusive right to publicly perform his composition without regard to the profit limitation that is placed on the performance of musical compositions.

Prior to 1914, however, the exclusivity of the performing right seemed illusory. Individual authors, composers and publishers were unable to effectively enforce their performing rights. It was virtually impossible to detect unauthorized performances of musical compositions.³¹ "It was felt that an organization, with branches throughout the United States, could 'police' the public performances of musical compositions by bands and orchestras, in hotels, theatres and places of amusement."³² This feeling led to the formation of the American Society of Composers, Authors and Publishers, commonly known as ASCAP.³³ It is an "unincorporated association of approximately 17,500

26. Libretto of *Jesus Christ Superstar* from the composition "I Don't Know How to Love Him." This is another case demonstrating the appropriateness of the lyrics of the opera to the topic of discussion.

27. 17 U.S.C. § 1.

28. The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and terms specified in this title. 17 U.S.C. § 9.

29. 17 U.S.C. § 1 (d) & (e); § 1 (c) may also be considered to confer "performing rights" with respect to nondramatic literary works. NIMMER, § 107.1.

30. 229 Fed. 340 (2d Cir. 1916), *rev'd on other grounds*, 242 U.S. 591 (1917).

31. Detection of unauthorized performance of dramatic works did not present as difficult a problem as those involving musical compositions because of the lengthy preparation and publicity which must precede these productions. Furthermore, such productions, it was believed, were relatively infrequent. See, Nimmer, *Copyright 1955*, 43 CAL. L. REV. 791, 798 (1955).

32. *Alden-Rochelle, Inc. v. ASCAP*, 80 F. Supp. 888, 891 (S.D.N.Y. 1948).

33. The moving force in the founding of this first American performing rights society was Victor Herbert and his attorney, Nathan Burkan. ASCAP remains to date one of the most important of the performing rights societies. Another important such society currently in operation in the United States is Broadcast Music Inc., known as B.M.I. There are in addition several small performing rights societies which are privately owned. The most im-

authors, publishers and composers of musical compositions. . . ."³⁴ In general, it functions as a clearing house for performing rights in music. As do the other performing right societies, ASCAP provides a system for the collection of royalties for the performances of the musical works of its members.³⁵

The composers, authors and publishers who join ASCAP authorize it to license only the nondramatic performing rights of compositions in its repertory.³⁶ The exclusive right to license dramatic performances, therefore, is reserved by the members. These two licensing arrangements are known respectively as the "small rights" license and the "grand rights" license. ASCAP acquires only the small or nondramatic performing rights and, in turn, can only license such rights. This distinction, although often overlooked, is of paramount importance in determining whether a given performance is within the rights granted under a licensing arrangement. It is the apparent failure to so distinguish that has sparked litigation.

"A STRANGE THING, MISTIFYING"?:³⁷

*April Productions, Inc. v. Strand Enterprises*³⁸

Until recently, the distinction between small and grand performing rights was little noticed. One of the rare occasions in which a court

portant of these is SESAC, Inc., formerly known as the Society of European State Authors and Composers. Nimmer § 107.6.

34. *CBS v. ASCAP*, 337 F. Supp. 394, 396 (S.D.N.Y. 1972).

35. For an explanation of the operation of ASCAP, B.M.I. and SESAC, see Finkelstein, *Public Performance Rights in Music and Performance Right Societies*, 7 COPYRIGHT PROBLEMS ANALYZED 69 (CCH 1952).

36. The standard ASCAP agreement provides:

1. The *Owner* grants to the *Society* for the term hereof, the right to license non-dramatic public performances (as hereinafter defined), of each musical work:

Of which the *Owner* is a copyright proprietor. . . .

The rights hereby granted shall include:

. . . .

(b) The non-exclusive right of public performance of the separate numbers, songs, fragments or arrangements, melodies or selections forming part or parts of musical plays and dramatico-musical compositions, the *Owner* reserving and excepting from this grant the right of performance of musical plays and dramatico-musical compositions in their entirety, or any part of such plays or dramatico-musical compositions on the legitimate stage.

37. Libretto of *Jesus Christ Superstar*, from the composition "Strange Thing Mystifying."

38. 221 F.2d 292 (2d Cir. 1955).

was asked to interpret a small rights licensing agreement arose in *April Productions v. Strand*. In this case, the plaintiff, copyright owner of the musical production *The Student Prince*, sought to recover for alleged infringement of the work by defendant, a licensee under an ASCAP "small rights" license. The defendant owned a night club called "The Harem"; co-defendant was the leader of a choral group that entertained there. During the period relevant to the action, "The Harem" presented twice nightly a show entitled "The One Thousand and Second Night." The program of ten "scenes" listed the ninth as "Ben Yost and His Royal Guardsmen." In this "scene" the words of certain songs were sung, including a medley of songs from *The Student Prince*. These songs were in the ASCAP repertoire. Nevertheless, the plaintiff contended that the defendants exceeded the scope of the license which had granted the defendant the right "to publicly perform at The Harem . . . , non-dramatic renditions of the separate musical compositions copyrighted by members of the Society."³⁹

The fundamental question, the court declared, was whether anything done with the licensed compositions by the defendants constituted a "dramatic" rendition. Judge Dimock held that the defendants had not departed from the terms of the license. The performance of the medley from *The Student Prince* was but a "entr'acte." The court stated:

Even if The Harem put on a dramatic performance, the selections from "The Student Prince" were not part of it. The worst that could be said would be that they were sung in an intermission between the acts of the dramatic performance. Such a rendition is "non-dramatic" within the meaning of the license.⁴⁰

Yet, the most interesting element of the decision is the interpretation given by the court of the ASCAP licensing agreement. The court interpreted the language of paragraph three⁴¹ of this license to mean that the performance of "non-instrumental" musical compositions was

39. *Id.* at 293.

40. *Id.* at 296.

41. The paragraph is as follows:

3. This licence shall not extend to or be deemed to include:

(a) Oratorios, choral operatic or dramatico-musical works (including plays with music, revues and ballets) in their entirety, or songs or other excerpts from operas or musical plays accompanied either by words, pantomime, dance or visual representation of the work from which the music is taken; but fragments of instrumental selections from such works may be instrumentally rendered without words, dialogue, costume accompanying dramatic action or scenic accessory, and unac-

dramatic only if it were accompanied either by words, pantomime, dance or visual representation of the work from which the music was taken. It is suggested that this decision seems to hold that with respect to non-instrumental musical compositions,⁴² grand performing rights need only be obtained when the licensee wishes to perform such composition accompanied by material from the dramatico-musical work from which it is taken. This seems a strange thing, mystifying. If the decision is followed, Professor Nimmer suggests, the necessity of acquiring grand performing rights with respect to non-instrumental musical compositions would virtually disappear. As he states:

Under the rule of this case one could by simply obtaining an ASCAP license perform in a new musical play all of the music from 'South Pacific,' providing that the 'book' for the production is not borrowed from 'South Pacific.' The ASCAP membership could hardly have intended to permit the performance of their musical compositions in Broadway musicals or similar productions in return for mere payment of the ASCAP fee.⁴³

SMALL AND GRAND PERFORMING RIGHTS: "*The Buzz*"

After the decision in *April Productions v. Strand*, the distinction between grand and small performing rights seemed to interest few. An inconspicuous and unobtrusive lack of curiosity seemed to prevail in the legal community with respect to these rights. Surprisingly, this condition was noticeably altered by, of all things, a "rock opera." One

accompanied by any stage action or visual representation (by motion picture or otherwise) of the work of which such music forms a part

(b) Any work (or part thereof) whereof the stage presentation and singing rights are reserved.

42. A non-instrumental musical composition may be thought of as music and lyrics. One commentator has suggested that a performance of a non-instrumental selection could mean, under the ASCAP license as interpreted by Judge Dimock, a vocal rendition of the lyrics of the composition without musical accompaniment. Comment, *supra* note 17, at 460. If this interpretation is correct, it would follow that the license limits the opportunity of using material outside the work from which the music is taken to a performance of the musical selection unaccompanied by any musical instrument other than the human voice. The lack of demand for such performances might account for the language of the ASCAP agreement. Another interpretation which could be given is that the distinction between non-instrumental selections and instrumental selections lies in the fact that the former are accompanied by lyrics and the latter are not. See *Rice v. American Program Bureau*, 446 F.2d 685, 690 (2d Cir. 1971).

43. NIMMER § 125.6.

of the consequences of *Jesus Christ Superstar's* commercial success has been litigation. The cases involving alleged infringement of the copyright in the work have focused anew on the scope of the small rights licensing agreement. This paper will presently consider two of these cases, *Rice v. American Program Bureau*⁴⁴ and *Robert Stigwood Group Ltd. v. Sperber*.⁴⁵

In *Rice*, plaintiffs, the composers, copyright proprietor,⁴⁶ the assignee of the United States copyright, and the exclusive licensees of the rock opera, *Jesus Christ Superstar* brought an action seeking injunctive relief and monetary damages for alleged infringement of the copyright in the work. The defendants were a "rock opera company," its booking agency, and the agency's president. ASCAP, which had been granted the right to license the nondramatic performance of each song in the *Jesus Christ Superstar* album except one⁴⁷ by the copyright proprietor, had granted to defendant booking agent a small right license.⁴⁸ Under this license, the defendant "rock opera company" performed *Jesus Christ Superstar* in its entirety, and scheduled other performances of the work. Pursuant to plaintiff's motion for a preliminary injunction, the district court found that the songs in question were not in the ASCAP repertoire; that "no rendition was authorized [by the ASCAP license], be it dramatic or nondramatic."⁴⁹ The court issued a preliminary injunction enjoining the defendants from *inter alia*, "presenting or performing the opera 'Jesus Christ Superstar' or any portion thereof" and advertising any such performance.

44. 446 F.2d 685 (2d Cir. 1971).

45. No. 71-2057 (2d Cir., March 17, 1972), *modifying* 332 F. Supp. 1206 (S.D. N.Y. 1971); *see Id.* for a list of other cases involving claims of copyright infringement of *Jesus Christ Superstar*.

46. The copyright proprietor registered his claim to copyright in the opera *Jesus Christ Superstar* under the class "dramatico-musical compositions" pursuant to 17 U.S.C. § 5(d). Songs from the opera were separately copyrighted and registered under the class "musical compositions" pursuant to 17 U.S.C. § 5(e).

47. The rights to the separately copyrighted musical composition "King Herod's Song" were assigned to a different proprietor who in turned granted the licensing rights in the song to BMI.

48. Such license permits the licensee to perform for profit in a nondramatic manner any or all of the songs in the ASCAP repertoire. ASCAP is subject to a consent decree which directs it "to grant to any user making written application therefor a non-exclusive license to perform all of the compositions in the ASCAP repertoire." *U.S. v. ASCAP*, Civ. Action No. 13-95 (S.D.N.Y. March 4, 1945).

49. *Rice v. American Program Bureau*, 71 Civ. 1804 (S.D.N.Y., filed May 11, 1971).

Thereafter, defendants sought to modify the preliminary injunction by eliminating the words "or any portion thereof," thereby permitting them to perform individual songs from the opera in a nondramatic concert form. After hearing additional evidence and argument, Judge Motley found that pursuant to the usual and customary membership arrangement between ASCAP and the copyright proprietor, "all of the songs in the opera 'Jesus Christ Superstar' were in the ASCAP repertoire"⁵⁰ and that ASCAP had the right to license the nondramatic performance of each musical work. The court further found that ASCAP had agreed with defendant to grant it a license on the "non-dramatic renditions of the separate musical compositions copyrighted by members of the Society." Citing *April Productions v. Strand Enterprises*,⁵¹ Judge Motley held:

A non-dramatic public performance means the singing of a few songs without any other words or gestures from a dramatico-musical work along with an entire program of other works or the playing of a medley of songs during an intermission in such a program.

The motion to modify the preliminary injunction was granted to permit "the singing of not more than two (2)⁵² of the individual musical compositions which have been separately copyrighted as musical compositions . . . or not more than two (2) other individual songs from the opera during any one concert."⁵³

On appeal, defendant-appellants challenged the district court's holding that a "non-dramatic public performance," as used in the ASCAP license, meant the "singing of a few songs without any other words or gestures from a dramatico-musical work . . ." ⁵⁴ and sought modification of the preliminary injunction so as to permit them to perform all or substantially all of the songs from *Jesus Christ Superstar*. After examining the scope of the ASCAP small rights license, the court

50. Rice v. American Program Bureau, 71 Civ. 1804 (S.D.N.Y., filed May 21, 1971).

51. 221 F.2d 292 (2d Cir. 1955).

52. Whether the court took notice or not, it is the industry practice with respect to radio broadcasts of music from original cast albums to play in sequence up to two vocals and an instrumental, but no more. See SHEMEL & KRASILOVSKY, THIS BUSINESS OF MUSIC 102 (1964).

53. Rice v. American Program Bureau, 71 Civ. 1804 (S.D.N.Y., filed May 21, 1971).

54. Brief for Appellant at 15, Rice v. American Program Bureau, 446 F.2d 685 (2d Cir. 1971).

modified the preliminary injunction so as to trace essentially the language of this license.⁵⁵ The defendant-appellants were enjoined from performing the following:

(1) the overall opera *Jesus Christ Superstar*, (2) songs or excerpts from the opera (accompanied by lyrics in the original work) accompanied either by words, pantomime, dance, or visual representation of the work from which the music is taken, and (3) fragments of songs or instrumental selections (unaccompanied by lyrics in the original work) except insofar as they are instrumentally rendered without words, dialogue, costume, accompanying dramatic action or scenic accessory and are unaccompanied by any stage action or visual representation (by motion picture or otherwise) of the work of which such music forms a part. . . .⁵⁶

Interestingly, the court also enjoined the "advertising or in any way representing any presentation as being *from Jesus Christ Superstar* or any song, instrumental selection or excerpt *as taken therefrom* in whole or in part."⁵⁷

As in *April Productions*, ascertaining the scope of ASCAP's small rights license was held to be determinative of the case. In both *Rice* and *April Productions*, interpretation was given as to what is included within the terms of the license. A comparison of the two interpretations produces an interesting result.

With respect to separate songs, or excerpts from the opera, the court in *Rice* held that under the license the licensee may present these,

55. Paragraph 3(a) of this license provided that the license does not include:

(a) Oratorios, choral, operatic or dramatico-musical works (including plays with music, revues and ballets) in their entirety, or songs or other excerpts from operas or musical plays accompanied either by words, pantomime, dance, or visual representation of the work from which the music is taken; but fragments or instrumental selections from such works may be instrumentally rendered without words, dialogue, costume, accompanying dramatic action or scenic accessory, and unaccompanied by any stage action or visual representation (by motion picture or otherwise) of the work of which such music forms a part. (emphasis added).

A comparison between the above paragraph and the same paragraph as offered in evidence in *April Productions* shows but one change. In place of the language "but fragments of instrumental selections" in that part of the paragraph following the semicolon therein, paragraph three as submitted into evidence in *Rice* uses the phrase "but fragment or instrumental selections."

56. *Rice v. American Program Bureau*, 446 F.2d 685, 690 (2d Cir. 1971).

57. See note 76 *infra*.

including the lyrics of the original work, but may not “accompany such songs or excerpts with words, pantomime, dance, costumes, or scenery that will lend a visual representation of the work from which the music is taken.”⁵⁸ Judge Dimock in *April Productions* concluded that such songs or excerpts “have accompaniment forbidden only where it consists of words, pantomime, etc. ‘of the work from which the music is taken.’”⁵⁹ The former interpretation seems more restrictive than the latter and perhaps for that reason, more consonant with the understanding in the entertainment industry. Under the *Rice* interpretation, a performance of songs or other excerpts from a opera may be outside the scope of the license even if such selections are accompanied by material not taken from the same work from which the music is taken. The test is whether the accompanying material “will lend a visual representation of the work from which the music is taken.” This is an apparent recognition by the court that permission to perform a musical composition from a dramatico-musical work does not give the right to perform the dramatico-musical work. It is submitted that the court should have also recognized that the license to perform a musical composition from a dramatico-musical work does not grant the right to perform this composition in conjunction with any dramatico-musical work in such a way that its performance becomes part of or lends itself to the drama. Judge Dimock’s view also indicates an acknowledgement that the license does not grant the right to perform the dramatico-musical composition, but, as suggested above, it provides a larger “loop-hole” through which to evade the ban of the license.

With respect to the presentation of instrumental selections, the courts seem to have traded positions. Justice Clark, speaking for the court in *Rice*, concluded that the ASCAP license allows the presentation of instrumental selections, but “without words, dialogue, costume, stage action, dramatic action, scenic accessory or visual representation (motion picture or otherwise) of the work of which such music forms a part.”⁶⁰ The use by the court of the disjunctive “or” in place of the conjunctive “and” of the ASCAP license results in an interpretation opposite to that of Judge Dimock’s with respect to instrumental selections. Under this holding, where an instrumental selection is accompanied by words, dialogue, costume etc. not taken from the work of which such music forms a part, its performance will be considered within the scope of the license. May this not be considered the position taken in *April*

58. 446 F.2d at 689.

59. 221 F.2d at 295 (emphasis added).

60. 446 F.2d at 689.

Productions with respect to songs or other excerpts from a dramatico-musical composition? Yet, the court in *April Productions* held that instrumental selections under the license “may not be accompanied by *any* words, dialogue, etc. . . .,”⁶¹ such prohibition not being confined to any particular accompanying material. It is submitted that this view is more consistent with the language of the license than that expressed in *Rice*. Furthermore, it reflects more closely the probable intention of the ASCAP membership in licensing their compositions.

One further comment should be made concerning the interpretations given by the courts of the scope of ASCAP’s small rights license. The court in *Rice* held that “fragments of songs” may be presented by the licensee, but may not be accompanied by “words, pantomime, dance, costumes, or scenery that will lend a visual representation of the work from which the music is taken.”⁶² In comparing this language with that of the license, it is observable that the court has interpreted “fragments” to mean “fragments of songs.”⁶³ Furthermore, it has deleted the word “fragments” from that part of paragraph three following the semicolon and interpolated the phrase “fragments of songs” into the language of the first clause. Apart from the question of whether the construction of the word “songs” is supported by the intentions of the parties to the agreement, there seems to exist a basis for reaching a conclusion respecting those performances deemed outside the grant contrary to that reached by the court. It is submitted that “fragments” are treated under the license in the same manner as instrument selections. If this is true, then under Judge Dimock’s view, and perhaps under a view more consistent with the word order of paragraph three, the limitation imposed by the instrument with respect to “fragments” is not confined to any particular accompanying material. “Fragments” may not be performed if accompanied by *any* words, dialogue, etc. The position taken in *Rice* would allow “fragments” (of songs) to be accompanied by material as long as it does not lend a visual representation of the work from which the music is taken. The possible consequences of this reading have already been suggested.

In the last analysis, the words of Judge Dimock seem most appropriate. “[T]he form of the license is such that almost nothing is sure.”⁶⁴

61. 221 F.2d at 295 (emphasis added).

62. 446 F.2d at 689.

63. The court noted that at trial evidence might be presented as to the meaning of the word “fragments” as used in both the membership agreement and the ASCAP license that might require modification of the court’s holding, or even a different result. 446 F.2d at 688.

64. 221 F.2d at 293.

Yet, the continued use by ASCAP of essentially the same license form even after the holding in *April Productions* is possibly indicative of an understanding in the entertainment industry as to the meaning and scope of the small rights grant. In any event, it is clear that ASCAP is authorized by its members to license only the nondramatic performing rights of musical compositions in its repertory. The basic principle underlying the ASCAP licensing arrangement is that dramatic performances of repertory works are not included within the terms of the license. A corollary to this basic principle is that the performance of works which are inherently or characteristically dramatic also falls outside the scope of the small rights license. Although ASCAP is permitted to license the performance of musical compositions taken from a dramatico-musical work, it has no right or authority to license the performance of the dramatico-musical work or any part thereof. This is the thrust of paragraph 3(a).⁶⁵

The foregoing conclusions, however, raise at least three fundamental questions: 1) What constitutes a dramatic performance; 2) What constitutes the presentation of a dramatico-musical work in its entirety; and 3) What constitutes the presentation of a part of a dramatico-musical composition. Proper responses to these questions should facilitate the determination of whether for any given performance a grand right license or a small right license must be obtained.

In *April Productions v. Strand*, after "a close examination of the facts," Judge Dimock was unable to find that the singing of a medley of songs from *The Student Prince* in only a small part of one scene of a ten-scene show was a dramatic performance. In *Rice v. American Program Bureau*, a panel of the court in a 2-1 decision was unable to find, based on the record before it, that the defendants' performance, "the mere singing of the songs" from *Jesus Christ Superstar*, was dramatic. But the court did state:

[T]he presentation of all the songs from the opera *Jesus Christ Superstar* without costumes, words, or scenery, but in *sequence* could arguably develop the overall plot of the opera, and thus might possibly be 'dramatic' or be a presentation of the opera in its 'entirety.'⁶⁶

65. Paragraph 3(a) may be considered as divestitive of any right otherwise given to the licensee under the general grant clause of paragraph one. It does not invest the licensee with any new right not given pursuant to the grant of nondramatic performing rights. See Nimmer, *Copyright 1955*, 43 CAL. L. REV. 791, 799 (1955).

66. 446 F.2d at 690 (emphasis added).

From this it may be assumed that if the court found that the defendants' performance developed the "overall plot" of the dramatico-musical composition, then it might have found such performance to be either dramatic or a presentation of the dramatico-musical composition itself. Perhaps recalling the words of Hamlet, the court seems to be saying "the *plot's* the thing." If this is so, then a small rights licensee may not structure the presentation of songs taken from a dramatico-musical composition along the lines which delineate the composition itself. But what constitutes a plot-developing presentation which may be either dramatic or a performance of the dramatico-musical work in its entirety? Was the performance of all of the songs from *Jesus Christ Superstar* such a presentation? "[W]e have no proof of this here and until there is proof, we cannot so hold," was the answer given by the court in *Rice*.⁶⁷

In *Robert Stigwood Group Ltd. v. Sperber*,⁶⁸ the above questions were again raised. As in *Rice*, the exclusive licensee of the professional stage rights in *Jesus Christ Superstar* together with the copyright proprietor and the assignee of the United States copyright in the opera brought suit against certain ASCAP small rights licensees seeking a preliminary injunction enjoining these defendants from *inter alia* performing *Jesus Christ Superstar* or portions thereof and referring to the title of the opera in advertising their performances. The defendant-licensees were presenting so-called concert performances of *Jesus Christ Superstar*. Each "concert" consisted of twenty of the twenty-three songs from the dramatico-musical composition, sung sequentially, with one exception, and interspersed with three additional religious works. The presentation was without scenery, costumes or dialogue between songs. Plaintiffs argued that the singing of most of the songs from the opera in sequence created a dramatic effect rendering the defendants' presentation an unlicensed dramatico-musical production. In defense, the defendants argued that their presentation was within the scope of their small rights grant. Finding no proof to support plaintiff's allegations that the defendants' concert performances resulted in dramatic renditions of the opera, the district court denied plaintiffs' motion for a preliminary injunction restraining the licensees from performing selections from the opera. Judge Pierce did, however, grant plaintiffs' motion for a preliminary injunction with respect to the advertisement of defendants' concerts. The court stated:

67. *Id.*

68. No. 71-2057 (2d Cir., March 17, 1972), *modifying* 332 F. Supp. 1206 (S.D.N.Y. 1971).

On the issue of advertising *Rice* held that the ASCAP license did not include a right to advertise that a program consisted of the entire work, or even an adaptation thereof. . . . This court is bound by that holding.⁶⁹

The court, therefore, enjoined the defendants from advertising that the presented selections were from *Jesus Christ Superstar*. It also indicated that such injunction prohibited "the use of the title⁷⁰ of the opera in the advertisement for defendants' concerts."⁷¹ Both parties appealed.

Upon appeal, the Court of Appeals for the Second Circuit focused on the issue of whether or not defendants' presentation of twenty of the twenty-three songs from *Jesus Christ Superstar* in sequence was a dramatic performance. . . . The court concluded that the "fuller record" before it established that a dramatic story was, indeed, developed by defendants' productions. As the court stated:

The facts before us vividly paint the dramatic nature of [defendant's] performance. Nowhere has [defendant] disputed the accuracy of [plaintiff's] Exhibit 3 which is a program of one of [defendant's] concerts. A comparison between this exhibit and Exhibit 4, which is the list of songs incorporated in the recording of the opera, establishes that 20 of 23 *Superstar* selections are performed in defendant's concert, all but one in identical sequence as in the copyrighted opera. The conclusion is inescapable that the story of the last seven days in the life of Christ is portrayed in the [defendant's] performances substantially as in *Superstar*. . . . There can be no question that the . . . concerts, in which singers enter and exit, maintain specific roles and occasionally make gestures, and in which the story line of the original play is preserved by the songs which are sung in almost perfect sequence using 78 of the 87 minutes of the original copyrighted score is dramatic.⁷²

The analysis employed by Judge Kaufman in searching the record to determine whether defendant's performances possessed a dramatic element seems analogous to that used by the courts in other copyright infringement cases to ascertain whether proof of copying has been

69. 332 F. Supp. at 1209.

70. See note 76 *infra*.

71. 332 F. Supp. at 1209.

72. No. 71-2057 (2d Cir., March 17, 1972). (footnotes omitted).

adduced, namely the substantial similarity analysis. The court noted that the dramatico-musical composition depicted a story—the last seven days in the life of Christ, and found that the work did, indeed, have a story-line or plot. Performance of the dramatico-musical work would then tell this story, and therefore, be a dramatic performance. If a presentation of the separate musical compositions from the opera depicted substantially the same story as told in the opera, then such presentation must also be dramatic. A comparison between the defendants' concert performance and plaintiffs' recording of the work indicated to the court that when the songs were sung in essentially the same sequence as that of the recording, the opera's story-line was developed, rendering such presentation dramatic.

Interestingly, the court does not seem to have held that defendants' performance was a presentation of the opera in its entirety.⁷³ Perhaps, the deletion of three of the opera's songs from the concert performance as well as the addition of three extraneous compositions made it conceptually difficult to assert that the entire work had been performed. In any event, the court did hold that the singing of twenty of twenty-three songs from the opera in sequence did develop a dramatic story and did render the presentation dramatic. Judge Kaufman distinguished *April Productions v. Strand* on what seem to be quantitative grounds. The court said:

. . . Strand's use of several songs from *The Student Prince* pales by comparison with [defendant's] use of almost the entire score from *Jesus Christ Superstar*. The twenty musical compositions from *Superstar* were almost the entire defendant performance rather than less than one-tenth as in 'The Harem' club's show.⁷⁴

The crucial finding, however, was not the number of songs taken from *Jesus Christ Superstar*. The court probably would have had more difficulty with the case if all the songs from the opera were performed, but in random order. The "anathema" for the court was the sequential singing of the songs:

The sequence of the songs seems to be the linchpin in this case. If the songs are not sung in sequence, *i.e.*, no song follows another

73. Plaintiff-cross-appellants urged upon appeal that the defendants were performing the overall opera. As was noted, the question of whether an opera is being performed in its entirety is an issue distinct and apart from whether the presentation of songs from the opera is dramatic.

74. No. 71-2057 (2d Cir., March 17, 1972).

song in the . . . concert in the same order as in the original opera, and there are no costumes, scenery or intervening dialogue, we are confident that the resulting performance could not tell the story of *Jesus Christ Superstar*.⁷⁵

Accordingly, the court enjoined⁷⁶ the defendants from performing "any song in such a way as to follow another song in the same order as in the original *Jesus Christ Superstar* opera."⁷⁷

At first and perhaps even second blush, this injunction appears overly restrictive. Why would, for example, the presentation of the song "Everything's Alright" followed immediately by "I Don't Know How to Love Him," as it is followed in the original score, tell the story of the last days or day in the life of Christ. At the same time, an argument could be made that the presentation of the odd numbered songs or the even numbered songs in order might tell the story of *Jesus Christ Superstar*. No song performed pursuant to this format would be presented in such a way as to follow another song in the same order as in the original opera. Yet such a presentation might, indeed, be dramatic or resemble all too closely the performance of the dramatico-musical composition.

Obviously, the court's intention was to enjoin the unlicensed dramatic performances of plaintiffs' copyrighted work. Finding the sequential singing of twenty songs from the opera to be a plot-developing presentation, the court enjoined this manner of performance. The decision seems to suggest, if not limited to its facts, that as far as performances of musical compositions taken from dramatico-musical works are concerned, a grand rights license will have to be obtained in cases where two or more songs are to be performed sequentially, *i.e.*, where one song follows another song in the same order as in the original

75. *Id.*

76. The court also enjoined the defendants from advertising or in any way representing any presentation as being *from Jesus Christ Superstar* or any song as taken *from* the opera thereby affirming the district court. The injunction issued by the court in *Rice* was of the same import. It could be argued, as indeed it was argued, that such an injunction gave copyright protection to a title. It is horn-book copyright law, however, that titles are not copyrightable under the statute. See Samuel W. Tannenbaum, *Uses of Titles for Copyrighted and Public Domain Works*, 6 BULL. OF THE COPYRIGHT SOC'Y OF THE U.S.A. 64 (1958). For a discussion of the protection of titles under the law of unfair competition after *Compco Corp. v. Daybrite Lighting Inc.*, 376 U.S. 234 (1964) and *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) see NIMMER, § 34.

77. No. 71-2057 (2d Cir., March 17, 1972).

work. But is such performance beyond the scope of the small rights grant?

IN THE END: *Perform the Music*

About what, then, is this "buzz"? The ASCAP license grants the right to perform nondramatic renditions of musical compositions. What then is a nondramatic rendition? One recognized authority in the area has characterized nondramatic performances as "renditions of a song from a musical comedy without dialogue, scenery or costumes."⁷⁸ Professor Nimmer suggests that a literal acceptance of this definition might render a singer's performance dramatic if he is not "dressed in street clothes, or if a backdrop other than the curtain is used or if the singer engages in introductory patter."⁷⁹ At the same time, it is submitted that scenery, costume and recitative are not needed to perform dramatically. As Judge Kaufman suggested in *Sperber*, the lack of costumes and scenery does not necessarily prevent a performance from being dramatic.⁸⁰ Few would suggest that performances of operatic artists recorded without scenery or costume or visual representation are nondramatic. Furthermore, the absence of scenic accessory, costumes and intervening dialogue in the defendant's performances did not persuade the court in *Sperber* that such presentations were nondramatic. It would seem, therefore, that the renditions of songs⁸¹ from a dramatic-musical work in a certain manner, e.g., sequentially, even without dialogue, scenery, or costumes may be a dramatic performance.⁸²

Another way of determining what a nondramatic performance is, would be to determine what it is not. ASCAP, in one of its licensing agreements states:

For the purposes of this agreement, a dramatic performance shall mean a performance of a musical composition on a television program in which there is a definite plot depicted by the action and

78. Herman Finkelstein, *The Composer and the Public Interest—Regulation of Performing Right Societies*, 19 LAW & CONTEMPORARY PROBLEMS 275, 283 n. 32 (1954).

79. NIMMER, § 125.6.

80. No. 71-2057 (2d Cir., March 17, 1972).

81. Perhaps the accuracy of Mr. Finkelstein's definition lies in the use of the singular "song." The rendition of a song without dialogue, scenery or costumes would be a nondramatic performance under the industry practice. The problem arises when more than one song from a dramatic-musical work is to be performed.

82. Judge Motley's statement on what a nondramatic performance means should be reviewed at 29.

where the performance of the musical composition is woven into and carries forward the plot and its accompanying action. The use of dialogue to establish a mere program format or the use of any non-dramatic device merely to introduce a performance of a composition shall not be deemed to make such performance dramatic.⁸³

This seems to indicate that in ASCAP's view a musical composition may be injected into an intrinsically dramatic composition such that it becomes infused with the essence of the dramatic work. Accordingly, the separate musical composition loses for the time of the performance its nondramatic quality. At the same time, it becomes an integral part of the dramatic work.⁸⁴ Such use of the musical composition is not licensed under the ASCAP small rights grant.

The performance of a dramatico-musical work in its entirety or a portion thereof would also be dramatic. But when does the performance of its separate musical compositions become dramatic? As *Sperber* indicates, it becomes dramatic when the story-line or plot of the original work is developed. Furthermore, the entire drama need not be depicted to render the performance "grand." Even the presentation of a few songs could, under certain circumstances, develop an essential part of the drama and thus become a dramatic performance.⁸⁵

A presentation of compositions from a dramatico-musical composition need not develop the plot of the original dramatic composition to become dramatic. It is submitted that if the musical compositions are performed in such a way as to develop *any* story, their use must be licensed through a grand rights grant. Perhaps this provides occasion for applying the "ordinary observer" test. If to an audience a story is being depicted by the use of the musical compositions, such use would result in a dramatic performance.⁸⁶

83. ASCAP's Local Station Blanket Television License Agreement.

84. The situation is analogous to the playing of games with an ordinary rubber ball. A rubber ball may be played with by bouncing it or throwing it against a wall. It has, so to speak, a separate and distinct identity. Nevertheless, when this same ball is hurled at a "batter" by a "pitcher," it loses its separate identity and becomes part of the game of "stick-ball." After the game, it may still be bounced and thrown against a wall, regaining its separate usefulness.

85. See *Robert Stigwood Group Ltd. v. Sperber*, No. 71-2057 (2d Cir., March 17, 1972).

86. It should also be noted that the right to dramatize, an exclusive right given by 17 U.S.C. § 1(b) to the copyright proprietor, would also be infringed if the small rights licensee "dramatized" the musical composition by using it to develop the story-line of a production.

In the last analysis, the question is one of fact and may involve a host of variables, *e.g.*, the nature of the performed composition, the performer's talent. The *Jesus Christ Superstar* cases discussed herein perhaps are not in focus with the practice in the entertainment industry. The *Rice* decision seems to permit more in the way of performance than the small rights granters intend to license. On the other hand, the prohibition issued in *Sperber* may be unduly restrictive and not consonant with the needs of the industry. These decisions may have resulted from the nature of *Jesus Christ Superstar*. Unlike the works of Verdi, Rossini, Donizetti and others, the work of Webber and Rice really had no "book." The unity of the work is derived possibly from the universally known story it depicts. In performing all or substantially all of the musical compositions from the work without more, a story is told, as was found by Judge Kaufman. As with hard and great cases, an easy case may also make bad law. The virtue of the *Jesus Christ Superstar* cases may possibly be in delineating the workable middle ground for the licensing of performing rights in music.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. United States of America and Territories

4. U.S. CONGRESS. HOUSE.

H.R. 15968. A bill to protect art collectors by requiring disclosures in connection with the sale of certain fine prints and reproductions. Introduced by Mr. Monagan, July 20, 1972, and referred to the Committee on Interstate and Foreign Commerce. 3 p. (92d Cong., 2d Sess.)

Substantially similar to H.R. 15578, introduced on June 19, 1972 by Mr. Halpern, for himself and a number of other House members. The instant bill differs in that it requires additional disclosures with respect to "specific identification of the medium, if known" and an "attestation of the authenticity of the artist's signature, if known." See 19 BULL. CR. SOC., item 324.

5. U.S. CONGRESS. HOUSE. *Allott, Gordon.*

Office of Telecommunications Policy. *Congressional Record*, vol. 118, no. 137 (Sept. 6, 1972), pp. S14134-S14135.

A word of praise for Clay T. Whitehead, Director of the two-year old Office of Telecommunications Policy of the Executive Office of the President followed by a reprint of an article from the July 10, 1972, issue of *Television/Radio Age*, entitled "Inside the FCC — In 1 year Whitehead has turned the OTP into a dynamo." The article, which is characterized by Mr. Allott as "a deserved tribute to Mr. Whitehead and the OTP," refers to a forthcoming final report of a study of the future of cable television by a cabinet-level committee chaired by Mr. Whitehead, and to Mr. Whitehead's feelings concerning, among other matters, copyright aspects of CATV.

6. U.S. CONGRESS. HOUSE. *Monagan, John S.*

Art Collector's Protection Act. *Congressional Record*, vol. 118, no 113 (daily ed. July 20, 1972), pp. H6790-H6791.

Mr. Monagan's remarks on his introduction of H.R. 15968. See Item 4, *supra*.

7. U.S. CONGRESS. HOUSE. *Committee on House Administration.*

Authorizing the printing and binding of a revised edition of Senate Procedure and providing the same shall be subject to copyright by the author. Report to accompany S.J. Res. 254, submitted by Mr. Brademas, August 3, 1972. 1 p. (92d Cong., 2d Sess. H.R. Rep. No. 92-1285).

By voice vote the committee adopted a motion to report the measure without amendment. See Item 9, *infra*.

8. U.S. CONGRESS. HOUSE.

S.J. Res. 247, which extends copyright protection in certain cases for an additional two years, to December 31, 1974, was approved by the House Judiciary Committee, following approval by the Senate, and was passed by the House by a vote of 208 to 98 on October 11, 1972. As this issue goes to press, the bill was expected to be signed by the President on October 19, following adjournment of the Congress on the preceding day. This is the eighth in the series of copyright extension bills intended to keep protection in force for certain works which were due to expire, until the passage of the new revised U.S. Copyright Law, under which the term of copyright would be 75 years from first date of registration.

9. U.S. CONGRESS. SENATE.

[S.J. Res. 254. Joint resolution to authorize the printing and binding of a revised edition of Senate Procedure and providing the same shall be subject to copyright by the author. Submitted by Mr. Mansfield and Mr. Scott, July 20, 1972]. 2 p. (92d Cong., 2d Sess.)

Except for change in authorship and editions of *Senate Procedure*, identical to Senate joint resolutions introduced in previous Congresses. The measure passed the Senate on July 20 and the House on August 3.

10. U.S. CONGRESS. SENATE.

Universal Copyright Convention. *Congressional Record*, vol. 118, no. 129 (daily ed. Aug. 11, 1972), pp. S13407-S13414, S13420-S13421; no. 130 (daily ed. Aug. 14, 1972), p. S13464.

The proceedings in regard to Senate consideration of Executive G (92d Congress, 2d Session), the Universal Copyright Convention, as revised, with protocols, and which culminated in agreement on August 14 by a vote of 67 yeas and no nays, to the resolution of

ratification of the revised Convention. The United States thus became the second signatory nation to ratify the revised Convention, the United Kingdom having ratified it on May 19, 1972.

11. U.S. CONGRESS. SENATE. *Committee on Foreign Relations.*

Universal Copyright Convention. Report to accompany Ex. G, 92-2, submitted by Mr. Fulbright, August 10, 1972. 6 p. (92d Cong., 2d Sess., Ex. Rep. No. 92-32).

The Committee recommends that the Senate give its advice and consent to the pending revised Convention. On August 14, the Senate by a vote of 67 yeas to no nays ratified the revised text. See Item 10, *supra*.

12. U.S. FEDERAL COMMUNICATIONS COMMISSION.

[CFR] Title 47 — Telecommunication. Chapter I — Federal Communications Commission. Part I — Practice and procedure. Part 76 — Cable television service. Reconsideration of Report and order. *Federal Register*, vol. 37, no. 136, pt. II (July 14, 1972), pp. 13847-13910. "Docket 18397 etc.; FCC 72-530."

Amendments of the Cable Television Report and Order adopted by the Federal Communications Commission on February 2, 1972. Before taking up exceptions to specific rules, the amendments "deal with two matters of overriding and more general concern, i.e., whether, in adopting the rules the Commission followed the requirements of the Administrative Procedure Act and whether the effective date of the rules should be delayed pending the enactment of copyright legislation." The answers were in the affirmative for the first question and in the negative for the second.

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

Public Law 92-386, 92d Congress, S.J. Res. 254, August 16, 1972. Joint resolution to authorize the printing and binding of a revised edition of Senate Procedure and providing the same shall be subject to copyright by the author. 1 p. (86 Stat. 559).

See Item 9, *supra*.

2. Foreign Nations

14. BOLIVIA. *Laws, statutes, etc.*

Supreme decree. (No. 01068, of February 27, 1948). *Copyright*, vol. 8, no. 8 (Aug. 1972), pp. 164-165.

The preamble states in part that this decree was promulgated because the present copyright law of November 13, 1909 and its complementary provisions dated January 15 and October 30, 1949, "contain no specific rules governing artistic and journalistic works." The implementing decree is dated July 21, 1971 and is published in the *Gaceta Oficial de Bolivia* of December 17, 1971.

15. GREAT BRITAIN. *Working Party on Public Lending Right.*

Public lending right; report of the Working Party appointed by the Paymaster General. London, H. M. Stationery Off., 1972. 29 p. (At head of title: Department of Education and Science).

The Working Party was appointed in March 1971 with the following terms of reference:

"The task of the Working Party is to consider how an amendment to the Copyright Act 1956 which added lending to the public to the acts restricted by copyright might be implemented. The Working Party are not required to recommend particular courses of action, but to consider what form the amendment to the Act might take, to define possible methods by which it could be implemented and to set forth and compare their detailed implications. The Working Party's conclusions should be embodied in a report to the Paymaster General, designed to provide a basis for a decision of policy on whether such an amendment to the Act would be a practical and worthwhile step."

16. IRAQ. *Laws, statutes, etc.*

Law on the protection of copyright. (No. 3, of 1971). *Copyright*, vol. 8, no. 8 (Aug. 1972), pp. 165-169.

"This law entered into force on January 21, 1971, date on which it was published in the Official Gazette of the Republic of Iraq. WIPO translation based on the original Arabic text."

17. SWEDEN. *Laws, statutes, etc.*

Law amending the Law on Copyright in Literary and Artistic Works. (No. 488 of 1970). *Copyright*, vol. 8, no. 8 (Aug. 1972), p. 170.

Amendment of sections 1, 10, 43, 44, 63 and 65 of the Swedish copyright law. The Law came into force on October 1, 1970.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

18. BULGARIA. *Treaties, etc. Russia (1923- U.S.S.R.), Oct. 8, 1971.*

Agreement on the reciprocal protection of copyright concluded between the People's Republic of Bulgaria and the Union of Soviet Socialist Republics. *Copyright*, vol. 8, no. 8 (Aug. 1972), p. 163.

The agreement was concluded for a term of three years and entered into force on January 1, 1972.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions.

19. *The Robert Stigwood Group Limited, et al. v. Hurwitz d/b/a January Enterprises Company, et al.*, 174 USPQ 356 (2d Cir., June 29, 1972) (Kaufman, J.).

Appeal from denial of preliminary injunction in action for copyright infringement. Plaintiffs sought preliminary relief after learning of impending unauthorized performances of their dramatico-musical and musical compositions. The lower court denied relief and the performances took place as scheduled.

Held, appeal dismissed as moot. The court (i) noted that it would not exercise jurisdiction to review interlocutory denials of injunctive relief "when the act sought to be enjoined has occurred during the pendency of the appeal and 'there is no reasonable expectation that the wrong will be repeated'"; and (ii) found that the allegedly infringing performances comprised a "'one shot' series of performances which has long ago come and gone" and that there was no indication that any of the defendants would become involved with future performances of the works in question. In dismissing the appeal the court stated that "[a]lthough it is true that a voluntary cessation of illegal conduct does not itself render the issue of injunctive relief moot . . . it is 'some cognizable danger of recurrent violation, something more than the mere possibility which serves to keep the case alive.'"

20. *Columbia Broadcasting System, Inc., et al. v. Teleprompter Corporation et al.*, 173 USPQ 778 (S.D.N.Y., May 2, 1972) (Motley, J.).

Action for copyright infringement by owners of copyright in television programs against operators of CATV systems which intercepted broadcast signals embodying plaintiffs' programs and transmitted them to their subscribers.

In *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 158 USPQ 1, 15 BULL. CR. SOC. 316, Item 327 (1968), the Supreme Court

held that the CATV system there at issue did not "perform" the plaintiff's works since it functioned more as a "viewer" than as a "broadcaster". Plaintiffs urged that the CATV systems at bar differed from the *Fortnightly* system and served a "broadcasting" function because they included the following activities which were not engaged in, or were practiced only to a significantly lesser degree, by the latter system: "1) program origination, 2) the importation of distant signals, 3) selection of programs, 4) microwave transmission, 5) interconnection with other CATV stations, 6) advertising, and 7) sale of commercials."

Held, complaint dismissed.

The court concluded that the indicated factors did not remove defendants' system from the "viewer" category established in *Fortnightly* in respect of the intercepted programs, and thus that defendants did not "perform" plaintiffs' works within the meaning of the Copyright Act.

The court quickly dispensed with the last five of the above-listed claimed distinguishing factors:

Plaintiffs contend that defendants' CATV's are operating like broadcasters by using microwave, since microwave transmits signals through the air. Broadcasters propagate signals over-the-air, the argument goes; and since the microwave transmitters used by Teleprompter do also, Teleprompter, we are told, is functioning as a broadcaster. However, a broadcaster sends out signals to the public, while [defendant] uses microwave to carry signals from one of its facilities to another, no home-owner receives Teleprompter's microwave transmissions. Its use of microwave is thus completely analogous to the use of cable as a connecting carrier. Not every over-the-air transmission of signals by electromagnetic energy is a broadcast, human speech being just one example.

Nor does interconnection of several Teleprompter CATV's with closed-circuit theaters for [certain prize fight exhibitions] make these CATV systems into a broadcast network. This interconnection occurred on two separate, temporary and special occasions. Teleprompter's CATV's were interconnected only in the sense that several of them were linked to the same independent nationwide circuits. Whatever this brief interconnection may portend for the future, it does not transform defendants' present CATV systems into a broadcast network as plaintiffs suggest.

Defendants' advertising efforts are somewhat similar to those of the *Fortnightly* systems. . . .

The unique aspect of Teleprompter's advertising is its mention of programs originated by the CATV; as will be noted below, the Fortnightly systems originated only time and weather scans. We fail to see though how emphasis on its originated programs changes Teleprompter's function. This type of advertising demonstrates, of course, that Teleprompter felt its unique service would be more attractive to consumers if original programs were offered. But if any change in function occurred because of origination, it was due to the origination itself, not to Teleprompter's advertisement of that fact.

Nor do we find decisive significance in the sale of commercials to accompany Teleprompter's origination of sporting events in New York City. While the Supreme Court [in *Fortnightly*] described commercial sponsorship as an attribute of a broadcaster, it was listed as merely one of a number of indicia of broadcasting, not as a sole determinant. The sale of commercials in the case before us was small in both the amount of money involved and in relation to the amount of programming carried by the New York CATV. Importantly, these commercials were sold and carried as part of the programming *originated* by Teleprompter, and not in connection with its transmittal of over-the-air broadcasts. Of course, both types of programming were part of the same overall service, and realistically, some of the audience for the commercials was at least partly attracted to Teleprompter by its "reception service." But the commercials were not inserted in the midst of the received programs, and the sponsor seems to have geared the commercials closely to the originated sports events.

The court also concluded that defendants' interception and retransmission of "distant" signals — i.e., the bringing of broadcast signals to locals where they could not normally be received on rooftop or tower antennas — and selection of intercepted programs were not *meaningful* factors in terms of the Fortnightly viewer-broadcaster dichotomy. The court said:

Plaintiffs urge us to limit the copyright immunity resulting from *Fortnightly* to those CATV's which "enhance" the quality of picture that can already be received in the locale.

A reading of the *Fortnightly* opinions of the District Court, Court of Appeals and Supreme Court reveals that the *Fortnightly* systems did more than "enhance" poor quality pictures — they in fact brought in stations from which usable reception could not be

had at all. All of the courts recognized that the Fortnightly CATV's carried broadcasts to *additional* viewers. . . . [who] . . . could not receive broadcasts of other than local stations by ordinary rooftop antennas. 392 U.S. at 391, 158 USPQ at 2. It went on to distinguish CATV systems from broadcasters on the ground that the former "receive programs that have been released to the public and carry them by private channels to *additional* viewers. . . .

It is clear, then, that Teleprompter's importation of signals not receivable on rooftop antennas is no different from that in Fortnightly. This case differs from Fortnightly in that in a number of the systems the antenna tower receiving the signals is located not on a hill over the city but many miles away in the vicinity of the broadcasting station. . . . Does this greater distance alone between the receiving antenna and the CATV station and its customers change the function of the Fortnightly reception service? To put the question another way, did the Supreme Court mean to imply a geographical limit beyond which signals could not be imported? Though the Court, of course, was concerned with the system before it, which imported signals from a maximum distance of 82 miles there is no indication that it intended to imply a geographical limit. . . .

Furthermore, the Court's reasoning in Fortnightly would not support our creation of a difference between signals received on a local tower and signals received on a distant one. "The effective range of the broadcast is determined by the combined contribution of the equipment employed by the broadcaster and that supplied by the viewer." *Id.* at 398, 158 USPQ at 4. Here, the "viewer" (the CATV system) has, by supplying more sophisticated equipment, enlarged the effective range of the broadcast, just as the CATV in Fortnightly enlarged the range of broadcasts with its tower on a hill. The Court's description of a CATV in Fortnightly is equally apt for this case. "Essentially a CATV system no more than enhances the viewer's capacity to receive the broadcaster's signals; it provides a well-located antenna with an efficient connection to the viewer's set." *Id.* at 399, 158 USPQ at 5. What Teleprompter has done is to make its antenna even more "well-located" and even more "efficiently" connected to a viewer's set than in Fortnightly.

If a viewer erected an antenna on a hill, the Court said, he would not be performing the programs he received. *Id.* at 400, 158 USPQ at 5. Nor, it would seem, would a viewer be "performing" if he set up a strategically-placed antenna miles from his home and brought in signals from that antenna. The fact that the same oper-

ation is conducted here as a commercial enterprise by a viewing innovation does not change its functions — which is to “enhance the viewer’s capacity to receive the broadcaster’s signals.” We therefore find that Teleprompter’s importation of distant signals does not cause it to function as a broadcaster.

Plaintiffs contend that the importation of distant signals allows defendants greater latitude in program selection and that this latitude makes them more like broadcasters than viewers. We have found that Teleprompter’s practice of importing distant signals allowed it to exercise discretion in choosing which distant signals to import. It is not clear from the record what freedom the Fortnightly systems had to select the broadcast stations they would carry. Because they received broadcast signals on a single antenna located near the area it served, the Fortnightly CATV’s had less control over program selection than CATV’s that would mount antennas near selected broadcast stations in other cities. But though Teleprompter has greater freedom of choice than Fortnightly its latitude is not comparable to that of a broadcaster, which controls program content and scheduling.

In Fortnightly, the court expressly excluded consideration of CATV systems which originated their own programs in addition to retransmitting intercepted program signals. Now faced squarely with CATV systems which “do originate a substantial amount of their own programming”, the court concluded that such activities — albeit of a “broadcasting” nature — did not affect the nature of defendants’ operation with respect to its conceptually distinct retransmitting activity. The court said:

We do not doubt that Teleprompter’s program origination is similar to that done by broadcasters. These CATV’s select the programs, propagate them, and have control over program content and arrangements. . . . With respect to its program origination Teleprompter is functioning as a broadcaster.

We are thus faced with the question of whether a CATV’s function as a broadcaster with respect to program origination affect the nature of the function it performs in receiving and re-transmitting over-the-air broadcasts. We are of the opinion that the copyright liability for the “reception service” should not be affected by what can be considered an unrelated function — program origination. It is true that the originated programs and the received programs are sold to subscribers as a package; nobody buys one with-

out the other. But the nature of the function of a CATV with respect to received shows is not changed by the presence of original material on other channels or at other times. What Teleprompter is doing to plaintiffs' copyrighted material, and other over-the-air broadcasts, is the same whether the CATV's originate programs or not. The "function" of the reception service is not changed by simultaneous sale of original shows, just as it would not be changed by Teleprompter's simultaneous delivery of free ice cream or candy to every subscriber.

The court concluded its opinion with general observations on the CATV issue:

Having examined the separate activities which plaintiffs feel put defendants on the broadcaster's side of the line, it may be appropriate to look at defendants' systems as a whole. It is somewhat difficult to apply either the term "viewer" or "broadcaster" to the CATV systems in their entirety in this case. As we have already seen, these CATV's perform two functions: 1) delivery of the signals of over-the-air broadcast stations, and 2) transmission of original television programs. It often cannot fairly be said that one is the predominant function. The service sold by Teleprompter is the combination of these functions, not either in isolation.

Beyond the "functional test" we have discussed at length and attempted to apply, it may be that the lesson of *Fortnightly* is, as the Eighth Circuit Court of Appeals says in another context: "broadcast signals are dedicated to the public." *Midwest Video Corp. v. United States*, 441 F.2d 1322, 1326 (8th Cir. 1971), cert. granted, 40 U.S.L.W. 3314 (U.S. Jan. 10, 1972). Certainly, that is one conclusion that can be drawn from the Supreme Court's first finding that the range of a viewer is determined by the equipment of both the broadcaster and the viewer, and then analogizing a CATV to a viewer's antenna. For if a CATV is like a viewer and a viewer by his choice of equipment can determine the range of a broadcast, then there seems to be little limit to what can be done with broadcast signals by CATV's. The result indeed may be that "the right to receive and distribute [signals] may be exercised by any one with the capacity to capture the signals." *Id.* at 1327.

It should be remembered that our task here is to decide whether what defendants do infringes plaintiffs' exclusive rights under the Copyright Act of 1909, 35 Stat. 1075, as amended, specifically § 1, 17 U.S.C. § 1, by "performing" plaintiffs' copyrighted works. In

construing the Copyright Act in the years since 1909 the courts have built on the basic analogy of the producers of a stage play and their audience; the producers perform the play, the audience does not. See 392 U.S. at 395 n. 15, 158 USPQ at 3. This metaphor was then analogized to the dichotomy between a listener and a broadcaster, see e.g. *Jerome H. Remick & Co. v. American Automobile Accessories Co.*, 5 F.2d 411 (6th Cir. 1925); *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191, 201, 9 USPQ 17, 20 (1931), which in turn was used as a model for differentiating a broadcaster from a non-infringing CATV in *Fortnightly*. We have here carried this analogy yet another step by comparing the instant CATV's with those in *Fortnightly*. Undoubtedly, future technological change, drastic and otherwise, will see the courts asked to take further steps. Perhaps the time has come to cease piling analogy on analogy and to await word from Congress.

The copyright monopoly is "wholly statutory", *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 15 (1908), and we should perhaps be reluctant to expand an exception to the general disfavor of monopolies in the absence of a more precise expression of Congressional intent, particularly in light of the considerations of national communications policy that Congress may want to bring to bear on the CATV industry.

21. *The Roy Export Company Establishment, et al. v. The Trustees of Columbia University, et al.*, Not yet reported (S.D.N.Y., July 25, 1972) (MacMahon, J.).

Action for copyright infringement. Plaintiffs claimed copyright in a certain Charlie Chaplin film which was allegedly exhibited without authority by defendant Progressive Labor Party ("PLP") on the campus of Columbia University. Plaintiffs moved for a preliminary injunction against further unauthorized exhibition of the film. Defendant PLP consented to the motion; defendant Trustees of Columbia University opposed the motion.

Held, motion denied as against defendant Trustees.

The court found that plaintiffs had not made a sufficient showing of probable success on the merits as against the Trustees to warrant preliminary relief. The court considered the defect in plaintiffs' showing to lie in their failure to demonstrate that the University had a direct financial interest in the unauthorized exhibitions. Without such an interest, held the Court, the University could not be liable for copyright

infringement as a "vicarious" infringer, notwithstanding that it may have had the ability to prevent the alleged infringements. The Court said:

Plaintiffs' claim of ultimate success on the merits against defendants Trustees depends on the validity of their contention that the University is liable as a vicarious infringer of the copyright since it controlled the premises on which, and the projection equipment with which, the unlawful showings were conducted and since it had been informed in advance of the threatened infringements.

. . . .

It is clear that before one may be held liable as a vicarious infringer, absent a special relationship, such as agency or partnership, he must have had the right and ability to supervise the infringing activities, as well as a direct financial interest in those activities.

. . . .

Defendants Trustees suggest that they did not have the right and ability to control the infringing activities involved here. They claim that PLP is an autonomous organization neither organized, sponsored, nor financed by the University and is therefore solely responsible for its own actions and the actions of its officers. They further claim that the assignment of rooms and projection equipment is a purely ministerial function carried on by the University solely to insure that there is no conflict in the assignments and that the University does not inquire as to what use will be made of the room and equipment when an assignment is requested.

We do not think, however, that the University's policy of not interfering with its student organizations is synonymous with its not having the right or ability to have supervised the present infringing activities. The University's ability to control the use of its premises and equipment is clearly illustrated by the fact that since the [alleged infringing] showing it has taken steps to prevent subsequent showings of the film by PLP. We do not think that the University's claim that it sought to avoid the possibility of campus disruption by refusing to interfere at the last minute with the prior showings alters the fact that it had the right and ability to prevent those infringements.

However, in the present case, plaintiffs neither show benefit to the University, nor do they refute defendants Trustees' assertion that the University received no financial benefit from the two showings of the bootleg film. Plaintiffs, thus, fail to establish a vital element to their claim that the University is a vicarious infringer. . . .

... Plaintiffs suggest that the requirement that a direct financial interest exist applies only to infringements of musical compositions and not of dramatic works, but the courts have held otherwise. . . .

The court also held that (1) the "rule that upon a prima facie showing of copyright infringement a preliminary injunction should issue . . . without a detailed showing of irreparable harm . . . is not applicable here" since such a prima facie showing had not been made for the reasons indicated above; and (2) that plaintiff had not shown immediate irreparable harm sufficient to warrant extraordinary relief:

... in light of our injunction against [the consenting defendant] and in light of the University's own actions to prevent PLP from again exhibiting the film, the possibility of future unlawful exhibitions at Columbia is too remote and speculative to create a clear likelihood of immediate irreparable harm to plaintiffs. . . .

Plaintiffs' . . . contention . . . that failure to grant an injunction against Columbia will open a floodgate of illegal exhibitions of Chaplin films on campuses throughout the country with the result that legitimate theater operators will no longer pay top film rentals for the right to exhibit the films . . . [is] too speculative to serve as a clear showing of immediate irreparable harm.

22. *Compumarketing Services Corporation v. Business Envelope Manufacturers, Inc.*, 342 F. Supp. 776 (N.D. Ill., June 8, 1972) (McLaren, J.).

Action for breach of contract, conversion, misappropriation and common law copyright infringement. The court found that defendant had purchased certain mailing lists from plaintiff on a one-time use only basis, and had breached its contract with plaintiff by using certain list entries more than once. Defendant interposed *Sears* and *Compco* as a defense, but the court said:

... *Sears* and *Compco*, *supra*, do not preclude enforcement of this agreement. The Court was not dealing in those cases with a contractual relationship, and, in *Lear, Inc. v. Adkins*, 395 U.S. 653, 675, 89 S.Ct. 1902, 23 L.Ed.2d 610 (1969), it declined to extend *Sears-Compco* to contractual relationships. See *Painton & Co. v. Bourns, Inc.* 442 F.2d 216, 225 (2d Cir. 1971).

Furthermore, this case involves misappropriation, not copying, and the great majority of the courts which have considered the question have ruled that misappropriation is not within the scope

of *Sears-Compco*. . . . Whether the enforcement of the agreement is judged by its effect on federal patent-copyright law or its effect on competition in the mailing list market, this Court is unable to conclude that the agreement in question is an unreasonable one, or contrary to public policy. . . . This conclusion is reinforced by the fact that plaintiff made its list available on alternative bases, *i.e.*, plaintiff's list were available on an unlimited, as well as on a single-use, basis, on varying pricing arrangements. . . .

23. *Champion Map Corporation v. Twin Printing Company, et al.*, 175 U.S.P.Q. 185 (E.D. N.C., October 1, 1971).*

Action for infringement of copyright in plaintiff's registered wall maps. On plaintiff's motion for summary judgment *held*, granted.

1. Defendants urged that copyright in one of plaintiff's maps be held invalid because its application for registration failed to disclose that it was a new version of a previously-published map. The court, however, considered that "it appears to be the majority rule that mere technicalities are not to . . . cut down on the benefits conferred by the certification of registration" and held that "[t]here can be no justified inference that plaintiff has not 'substantially and in good faith' complied with the copyright laws or that the defendants had been 'misled into thinking that the work is not copyrighted' [and the copyright claim in question], therefore, cannot be declared unenforceable for the mere failure to indicate on the application . . . that the map contained 'new matter'".

2. Defendants also argued that since plaintiff's registrations were restricted to "wall maps," the embodiment of such maps in a "folding-map" form were not protected. The court, however, noting that "[t]he folding map differs from the 1966 copyrighted map only in a few insignificant respects," held this contention to be without merit. The court said:

Counsel on both sides have not been able to cite a case on point, but it appears to this court that the language of an 1869 case, *Lawrence v. Dana*, 15 Fed. Cas. 26, 52, is applicable. There the court stated:

"Protection is afforded by virtue of a copyright of a book, if duly granted, to all the matter which the book contained when the printed copy of the same was deposited in the office of the

* The *Dana* court was operating under an earlier copyright statute. [Ed.]

clerk of the district court, as required by Section 4 of the Copyright Act;* but *new matter made or composed afterwards, requires a new copyright*, and if none is taken out, the matter becomes public property, just as the original book would have become if a copyright of it had never been secured."

The content of the folding map consisted solely of matter which the wall maps contained and is, therefore, protected by the copyright of the wall map as the paperback edition of a book is protected by the copyright of the hardbound version. Defendants argue in support of their position that a new copyright could have been obtained for the folding map, but their contention is rebutted by the language of a case which they relied on in their argument that plaintiff needed to prove originality. In *Marken and Bielfeld, Inc. v. The Baughman Company*, 117 U.S.P.Q. 332 (E.D.Va. 1957), the court said:

"There must be originality resulting from the independent effort of the maker in requiring a reasonably substantial portion of the information. . . . As I view the evidence [he] prepared his base map from material collected by others, with such omissions as he saw fit to serve the purpose desired. The reduction in size by the use of a mechanical instrument is not an original idea. The omission of towns, highways or other markings superfluous for his purpose is not an indication of originality . . . As indicated, the only significant changes [he] made consisted of an adjustment of areas around Roanoke and Williamsburg, first appearing on the 1951 map in order that those cities might be shown . . . It is therefore my conclusion that the map relied upon does not contain sufficient original work to be protected by the copyright."

Therefore, it appears that an attempt to copyright the folding map would have been to no avail and, perhaps, constitute a copyright misuse since it would extend the duration of the original copyright protection.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

24. AMERICAN BAR ASSOCIATION. *Section of Patent, Trademark and Copyright Law*. 1972 Committee reports to be presented at the annual meeting to be held August 11-16, 1972, San Francisco, Calif. Editor: Beverly A. Vandenburg. Chicago, American Bar Center [1972]. 344 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, Government relations to copyrights, and copyright and new technology.

25. Annotation on ALR Fed 457. [1972] 35 p.

Our readers' attention is particularly drawn to this annotation on the application of the "works for hire" doctrine under the federal Copyright Act.

2. Foreign Publications

1. In English

26. COPINGER, WALTER ARTHUR. *Copinger and Skone James on copyright, including international copyright with the statutes and orders relating thereto and forms and precedents*. 11th ed., by E. P. Skone James. London, Sweet & Maxwell, 1971. 920 p.

The definitive text on the United Kingdom Copyright Act brought up to date.

27. HUANG, PAUL TE-HSIEN. *Bibliography on copyright*. [2d ed.] Halifax, N.S., 1972. 118 p.

In addition to general works on copyright, includes materials on computer programs, copyright revision, CATV, audio-visual

works, electronic video recording, and communications satellites. The list, cited from legal and non-legal sources, comprises English and European publications, published during 1965 to 1971, arranged by subject, and entered alphabetically by title.

2. In French

28. BONCOMPAIN, JACQUES. *Le droit d'auteur au Canada; étude critique*. Préf. de Marcel Pagnol. Montréal, Cercle du livre de France [1971]. 406 p.

A critical study of the Canadian copyright law, divided into the following two main parts: (1) Copyright law in internal relations; and (2) Copyright law in international relations.

3. In German

29. STOLZ, HANSJÖRG. *Der Ghostwriter im deutschen Recht*. München, Beck, 1971. 97 p. (Urheberrechtliche Abhandlungen des Max-Planck-Instituts für Ausländisches und Internationales Patent-, Urheber- und Wettbewerbsrecht, München, Heft 11).

A study of the rights of the ghostwriter under German laws.

B. LAW REVIEW ARTICLES

1. United States

30. BARROW, ROSCOE L. The new CATV rules: proceed on delayed yellow. *Vanderbilt Law Review*, vol. 25, no. 4 (May 1972), pp. 681-724.

An article on the FCC rules governing CATV, adopted February 2, 1972, which focuses upon the technology, economics and uses of CATV, outlines public policy goals for CATV, discusses jurisdictional questions, and, finally, evaluates and recommends changes in the new rules. Includes a discussion of the copyright problems.

31. CARNAHAN, WILLIAM H. Copyright in the military realm of learning. *United States Air Force JAG Law Review*, vol. 13, no. 4 (Fall 1971), pp. 251-258.

An attempt to answer copyright questions by faculty members of the Air Force Academy concerning their rights to their own articles and other publications and advice on how to obtain permission to

use copyrighted material of others. Includes a differential scale, in chart form, of legal implications arising from the preparation of faculty works and an appendix containing a recommended form for requesting permission for use of ordinary quotations.

32. DERENBERG, WALTER J. The twenty-fifth year of administration of the Lanham Trademark Act of 1946. Washington, Bureau of National Affairs, 1972. 54 p. (*Patent, Trademark and Copyright Weekly Reports*, vol. 174, no. 7, pt. II, Aug. 14, 1972).

Of interest to the copyright bar are discussions on registrability as trademarks of slogans, and configurations, ornamentation and color devices; section 43 (a) of the Lanham Act; and, unfair competition and the "Sears-Compco" doctrine.

33. DEVINS, THOMAS A., JR. The misappropriation doctrine: a search for literary title protection. *Santa Clara Lawyer*, vol. 12, no. 1 (1972), pp. 142-154.

A comment, to be entered in the 1972 Nathan Burkan Memorial Competition, which argues that the *Sears-Compco* decisions do not preempt state application of unfair competition law to prevent literary title piracy, and that, despite *Tomlin v. Walt Disney Productions*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971), "the misappropriation doctrine retains vitality and offers a flexible means of protecting literary titles which should not be abandoned."

34. HALPERN, MELVIN L. The Sound Recording Act of 1971: an end to piracy on the high ©'s? *The George Washington Law Review*, vol. 40, no. 5 (July 1972), pp. 964-994.

"This note will examine the protection afforded against record piracy prior to the Sound Recording Act, the nature of that statute, and its possible effectiveness in deterring record piracy and ensuring that composers, performers, and record manufacturers are not deprived of fair compensation."

35. Jazz and copyright: a study in improvised protection, *Northwestern University Law Review*, vol. 67, no. 2 (May-June 1972), pp. 216-244.

A paper, awarded Second National Prize in the 1971 Nathan Burkan Memorial Competition, and published essentially as submitted, which attempts to show that "the makeshift protection which improvised music has found in the past is inadequate," and to dem-

onstrate, through the example of jazz, "that there is a current and specific need for change."

2. Foreign

1. In Dutch

36. LIMPERG, TH. De juridische bescherming van letters en andere typografische tekens. *Bijblad Industriële Eigendom*, vol. 40, no. 5 (May 1972), pp. 96-101.

A resumé of the work of the Committee of Experts for the Protection of Type Faces since its inception in 1960, with a comparative analysis of the copyright-approach versus the patent-approach to the design protection. The proposal of having international deposit of the protected designs is also discussed.

2. In English

37. Committee of Governmental Experts on Problems in the Field of Copyright and of the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Raised by Transmission Via Space Satellites, 2d, Paris, May 9-17, 1972. Report. *Copyright*, vol. 8, no. 7 (July 1972), pp. 142-154.

Appended to the report are the Draft Convention Against Unauthorized Distribution of Programme-Carrying Signals Transmitted by Satellites, a resolution, and a list of participants.

38. HADL, ROBERT D. The new sound recording law in the United States. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 3 (May 1972), pp. 50-54.

An analytical commentary on Public Law 92-140.

39. HAZAN, VICTOR. Letter from Israel. *Copyright*, vol. 8, no. 2 (July 1972), pp. 155-158.

A survey of recent judicial and legislative copyright developments in Israel.

40. KOKTVEDGAARD, MOGENS. Letter from Denmark. *Copyright*, vol. 8, no. 8 (Aug. 1972), pp. 171-172.

A brief survey of legislative and judicial copyright developments in Denmark during the years 1969, 1970 and 1971.

41. MASOUYE, CLAUDE. The new Luxembourg copyright legislation, a commentary. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 3 (May 1972), pp. 40-49.

The commentary emphasizes the points in which the Luxembourg Copyright Act of March 1, 1972, is "in conformity with the Berne Convention and more especially with Articles 1 to 20 of the Paris Act (1971) of that Convention . . . in so far as they represent the most recent expression of international copyright law."

3. In English, French and Spanish

42. RINGER, BARBARA A. Judicial developments in United States copyright law (1969-1970). *Revue Internationale du Droit d'Auteur*, no. 73 (July 1972), pp. 41-169.

A periodic review covering the last half of 1969 and all of 1970.

4. In French, English and Spanish

43. BOUZAT, PIERRE. La présomption de mauvaise foi en matière de contrefaçon de propriété littéraire et artistique. *Revue Internationale du Droit d'Auteur*, no. 73 (July 1972), pp. 170-211.

A discussion of the problems and dangers posed by French jurisprudence in establishing a presumption of bad faith in the matter of infringement of literary and artistic property.

44. KEREVER, ANDRE. Les prérogatives des auteurs sur la communication publique d'émissions radiodiffusées. *Revue Internationale du Droit d'Auteur*, no. 73 (July 1972), pp. 2-39.

A critical comment on a recent French Supreme Court decision involving the question whether royalties must be paid for transmission of radio broadcasts by means of a central receiver linked by wire to hotel rooms furnished with loud speakers, permitting each occupant to choose one of three broadcasting networks.

5. In German

45. ADAM, ROBERT. Neuregelung des amerikanischen Kabelfernsehens; Community-Antenna Television (CATV) in besserer Position. *Film und Recht*, vol. 16, no. 5 (May 1972), pp. 165-168.

A survey of developments in FCC regulation of CATV in the United States, with special emphasis on the report and order adopted in February 1972.

46. BREPOHL, KLAUS. Kabelfernsehen: gegenwärtiger Stand und mögliche Entwicklungen. *Film und Recht*, vol. 16, no. 5 (May 1972), pp. 154-165.

A comparative study of the current status of cable television, with special attention to the situation and possible developments of CATV in the German Federal Republic.

47. HANDL, JOSEF. Die Ergebnisse der Genfer Tonträgerkonferenz; Abschluss einer Konvention zum Schutze der Tonträgerhersteller. *Film und Recht*, vol. 15, no. 12 (Dec. 15, 1971), pp. 376-380.

A report on the results of the Geneva diplomatic conference for the protection of record manufacturers, held October 18-28, 1971, which analyzes the resultant Convention with special reference to the changes from the original draft.

48. HANDL, JOSEF. Urheberrechtlicher Schutz für Fernsehsender? Kritische Bemerkungen zu einem österreichischen Urteil gegen einen fernsehprojizierenden Lichtspieltheater-besitzer. *Film und Recht*, vol. 16, no. 5 (May 15, 1972), pp. 168-174.

A critical comment on a recent decision by an Austrian court of first instance which held that the unauthorized projection on a theater screen of a telecast which consisted of two live performances and one that had been prerecorded on tape was a violation of the exclusive rights of the television authority, using as an analogy the special rules of the Austrian copyright law for cinematographic works commercially produced.

49. REIMER, DIETRICH. Der Erschöpfungsgrundsatz im Urheberrecht und gewerblichen Rechtsschutz unter Berücksichtigung der Rechtsprechung des Europäischen Gerichtshofs. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 7 (July 1972), pp. 221-234.

A discussion of the question whether, and under what postulates, the exclusive rights of authors, conferred by laws governing copyright and the protection of industrial property, are "exhausted" (erschöpfen) with reference to decisions by European courts.

50. SCHMIEDER, HANS HEINRICH. Die sogenannte Verwandtschaft zwischen Leistungsschutz und Urheberrecht. *Film und Recht*, vol. 16, no. 1 (Jan. 15, 1972), pp. 22-28.

A discussion of the "so-called" relationship between neighboring (related) rights and copyright in the copyright law of the German Federal Republic.

51. STEINMETZ, HELMUT. Gedanken zur photomechanischen Vervielfältigung. *Osterreichische Blätter für Gewerblichen Rechtsschutz und Urheberrecht*, vol. 21, no. 3 (May-June 1972), pp. 53-56.

Thoughts on the problem of photomechanical reproduction of protected works under the Austrian copyright law by an attempt to delineate the scope of section 15 (the author's exclusive right of reproduction) from the limitations on such right imposed by section 42 (reproduction for personal use).

52. STRUNKMANN-MEISTER, K. E. Systemfragen der sogenannten "kleinen Münze". *Film und Recht*, vol. 16, no. 1 (Jan. 15, 1972), pp. 29-32.

A case is made for the same treatment of "small change", that is, literary or artistic material of low cultural quality, such as directories, travel tickets, bookkeeping forms, shapes and the like as that of other materials under the copyright and design laws of the German Federal Republic.

53. ULMER, EUGEN. Zitate in Filmwerken. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 74, no. 5 (May 1972), pp. 323-328.

An article on the right of quotation in cinematographic works under the copyright laws of the German Federal Republic, published as a contribution to a Festschrift in celebration of the 70th birthday of attorney Richard Moser von Filseck.

6. In Italian

54. LEONELLI, LEONELLO. Per una legge sulla musica popolare. *Diritto di Autore*, vol. 43, no. 1 (Jan.-Mar. 1972), pp. 1-18.

An article on a bill, introduced February 1971 in the Italian Chamber of Deputies, dealing with the protection and development of folk music and of activities related thereto.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

55. BREWER, KAREN. A healthy approach to copyright problems. *Publishers' Weekly*, vol. 202, no. 11 (Sept. 11, 1972), pp. 21-22.

The serials librarian of the Cleveland Health Sciences Library, in regard to Paul Doeblers article, "IIA discusses the copyright

dilemma" (*PW*, July 24), suggests, among other things, a truce between publishers and librarians until final resolution of the *Williams & Wilkins* case. See Item 57, *infra*.

56. Cable policy in the making: open entry, little control by government; common-carrier status is foreseen in cabinet-level committee draft; ownership of systems and content would be separate, but available to anyone — including broadcasters. *Broadcasting*, vol. 83, no. 5 (July 31, 1972), pp. 22-23.

Article on forthcoming comments by a high-level administration committee "on a draft of a proposed report that views cable television as a virgin field for the development of federal policy . . . The draft pays little attention to precedents in the regulation of cable or broadcasting."

57. DOEBLER, PAUL. IIA discusses the copyright dilemma. *Publishers' Weekly*, vol. 202, no. 4 (July 24, 1972), pp. 52-54.

An article on recent meetings of the Information Industry Association at which the implications of the *Williams & Wilkins* decision were explored.

58. NISSIM, RUDOLPH. SACEM, France's performing rights society. *ASCAP Today*, vol. 6, no. 1 (July 1972), pp. 24-25.

A brief account of the formation and operations of the oldest of the foreign societies, Société des Auteurs, Compositeurs et Editeurs de Musique.

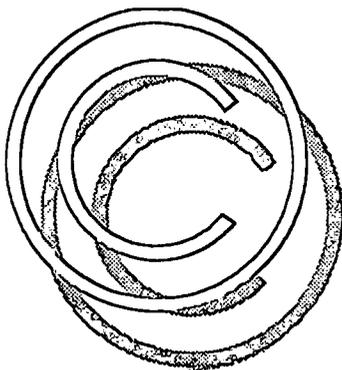
59. SHALES, TOM. He was looking for pirates. *The Washington Post* (Aug. 11, 1972), pp. B1, B6.

An article concerning the activities of Stanley M. Gortikov, president of the Recording Industry Association of America (RIAA) who "was on a kind of search-and-discourage mission" in the Washington area looking for pirated versions of best-selling stereotapes and who visited the chief of the administrative regulations section of the Justice Department's criminal division about getting the anti-piracy law enforced.

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60. WAGNER, SUSAN. Midnight oil burns after Williams & Wilkins rule. *Publishers' Weekly*, vol. 22, no. 7 (Aug. 14, 1972), pp. 29-30.

An article on the aftermath of Commissioner James F. Davis' report on the *Williams & Wilkins* case, which among other things, has spurred representatives of authors and periodical publishers to attempt to work out a legislative solution of the photocopying problem, and has caused the Justice Department to file exceptions to the decision "thereby taking it another step toward full adjudication."

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PART I.

ARTICLES

61. THE LITERARY OR ARTISTIC WORK IN COPYRIGHT.

By PROFESSOR SVANTE BERGSTRÖM*

1. According to most laws and conventions, copyright offers protection to "literary or artistic works", or, to be more accurate, to the authors of such works. What is meant by a literary or artistic work as a legal concept in the law of copyright? Practically no law or international convention gives a definition of this concept that has real substance. The problem is left to the judge and the legal writer.¹

To define the concept of "literary or artistic work" has two main functions. The first is to draw a borderline between products protected and products not protected by copyright. The other function is to determine whether the production of a work is the protection of a corporeal or an incorporeal phenomenon.

In a paper published in 1945, the Danish Professor Alf Ross introduced some new aspects of the second function.² The paper started

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1. *Reviews quoted in abbreviated form:*

FJFT = Tidskrift utgiven av Juridiska föreningen i Finland

NIR = Nordiskt immateriellt rättsskydd

SvJT = Svensk Juristtidning

TfR = Tidsskrift for Rettsvitenskap

UfR = Ugeskrift for Retsvaesen

Books and articles quoted in abbreviated form:

Bergström = Bergström, Uteslutande rätt att förfoga över verket. Uppsala, Wiesbaden 1954

Karnell 1968 = Karnell, "Verksbegrepp och upphovsrätt", *TfR* 1968 pp. 401 et seq.

Karnell 1970 = Karnell, Rätten till programinnehållet i TV. Stockholm 1970

Koktvedgaard = Koktvedgaard, Immaterialretspositioner. Kobenhavn 1965

Ljungman = Ljungman, "Något om verkshöjd", *Nordisk Gjenklang. Festschrift till Carl Jacob Arnholm*. Oslo 1969 pp. 179 et seq.

Strömholm = Strömholm, Upphovsrättens verksbegrepp. Stockholm 1970

2. "Ophavsrettens Grundbegreber", *TfR* 1945 pp. 321 et seq.

a vivid debate in Scandinavia which has gone on since then without being much noticed³ or having any real counterparts outside Scandinavia. In the late 1950's, a Scandinavian debate started about the first function also. This debate, which has some counterparts outside Scandinavia, has culminated in the last few years. The purpose of this article is to summarize some results of these debates and set forth some new aspects, principally concerning the first function.⁴

The debates deal with basic questions, common to all laws and conventions in the field of copyright. These basic questions will be treated here without special attention to Scandinavian law. The approach will be more general, or comparative. What are the best solutions of these basic questions from a technical point of view? They must be simple, easy to handle and able to serve as a kind of least common denominator for laws and conventions, especially for those which will be passed in the future, but also for those which already exist, without being too tightly bound to any specific doctrine. Emphasis is laid upon results that may interest the practical handling of copyright problems. Problems which are mainly theoretical will therefore largely be avoided.

I

2. The first problem is to define the concept of "literary or artistic work" in order to distinguish between products protected and products not protected by copyright. This problem has two aspects. What is a "work" as distinguished from products which are not works? What is a "literary or artistic" work as distinguished from other works? I begin with the first aspect.

"Work" is a vague term. In a copyright context it is often accompanied by an attribute which points in a specific direction: "original", "individual", "created", "independent", or "unique". In recent Scandinavian legal writing, much attention has been paid to the requirement "unique". One formula which has been used is that a product is unique, and therefore a "work", if it could not practically be made by

3. One of the few writers outside Scandinavia to have noticed the debates is Troller. See his *Immaterialgüterrecht* Band I. Basel, Stuttgart 1959 pp. 380 et seq.

4. The author's thanks are due to Professor Gunnar Karnell and Professor Stig Strömholm. We have discussed together the contents of the present article with a view to finding out on which points the Scandinavian debate has resulted in a general *consensus* and on which points there remains doubt and disagreement, especially between the three persons just mentioned.

two persons independently of each other.⁵ This formula can be called the *principle of uniqueness*.⁶

The formula has to be commented upon on four points.

The first point refers to the fact that the formula contains the word "practically". The uniqueness of a product is always relative. If you take into account the whole world and all times, a work can in theory never be absolutely unique. In practice you need not bother much about the risk of a duplicate creation, at least if you apply the principle in a sufficiently restrictive manner. The less restrictive you are, the greater risk you take. Within certain limits the principle is however *flexible*.

The second point deals with the following problem. It appears from the formula that the product must be made by a *person*. But is it enough that he contributes something to the product or must he *bring about* those very elements which constitute its uniqueness? The purpose of copyright protection is to promote a specific human activity, "to promote the progress of science and useful arts".⁷ For that purpose it makes no sense to induce people to pick up a branch of wood with a unique shape from the ground, to encourage unique paintings by a monkey or a donkey using its tail or to promote the act of pressing a button in a machine which produces unique pieces of music at random. We therefore ought to require that *the author brings about the uniqueness* of the product himself and thus exclude from copyright all so-called aleatoric products. A copyright work is the work of an *author*.⁸

5. See Ljungman p. 185. Professor Ljungman makes references to Lögdberg, Auktorrätt och film, Lund 1957 pp. 71 et seq. (cf also *op. cit.*, 255 and Lögdberg Upphovsrätten och fotografrätten, 2nd ed. Stockholm 1967 pp. 20 et seq.), Bergström in *Revue de l'U.E.R.* nr 68 B, 1961 p. 19 (also in *Gewerblicher Rechtsschutz und Urheberrecht. Ausl. u. Intern. Teil* 1962 pp. 364-365), Malmström in *Möbelvärlden* 1964, nr 5 and Koktvedgaard pp. 129 et seq. Cf. also Strömholm pp. 88 et seq. and Karnell 1970 esp. p. 56 and 108.

6. In French "le principe de l'unicité", in German "das Prinzip von statistischer Einmaligkeit" (cf. Kummer, *Das urheberrechtlich schützbares Werk*. Bern 1968 p. 38), in Swedish "unikumprincipen". Karnell 1970 (pp. 54-56) uses the term "requirement of independence". — The term "unicum" and a similar formula was used already by Eberstein in *NIR* 1941 p. 9.

7. United States Constitution art. I, sec. 8 cl. 8.

8. Kummer (*op. cit.* p. 75, p. 77 note 109) is of another opinion. He means that the author must only *recognize* a unique product as his own. Ljungman (p. 194-195) reports the critical remarks of Ulmer (in *Gewerblicher Rechts-*

The third point is a question of terminology. Let us take as an example "Death in Venice" by Thomas Mann. We can say that the whole book is Mann's work. But we can also say that his work consists only of those parts of the book which are protected in his favour. The last mode of expression means that from the "work" we exclude not protected ideas and other general lines, simple phrases, quotations etc. In a legal context the second meaning is the most appropriate. We therefore distinguish between the *product*, for instance a book, and the *work*, i.e. those parts of the product which are protected by copyright in favour of its author.⁹ This terminology fits in well with what was said above. For the formula of the principle of uniqueness, it is a requirement that the author has, himself, brought about the uniqueness of the product. Thus the work is only the unique part of the product that the author has brought about.¹⁰

The fourth point concerns the fact that nothing in the formula refers to the *aim* pursued by the author. It is sometimes maintained that in marginal cases the decisive factor is whether the author has had the aim to create a work or not.¹¹ At least from a practical point of view, the aim must be held outside the formula. In marginal cases it is usually rather impossible to prove the real aim of the author. This aim is still more impossible to clarify if you have access to the product you want to use but not to the author. There are certainly cases when a unique product does not deserve to be protected, for instance, if someone consciously places a lot of meaningless lines and points on a paper. But such cases will never create any real practical problems, because no one could have a serious interest in copying those lines and points.

3. One of the main advantages of the principle of uniqueness is that it explains in a simple way many basic rules in the copyright system. Even if other explanations may lead to the same practical results, they are often more complicated, they may more easily lead in a wrong direction, and they cover only a part of the system that the principle of uniqueness explains. I think that the principle of uniqueness can

schutz und Urheberrecht 1968 pp. 527 et seq.) but seems himself not unwilling to move in the direction of Kummer. Cf. also Karnell 1970 p. 314 et seq.

9. Karnell 1968 p. 444 has coined the expression "qualificatory work", i.e. in order to underline this difference.

10. Cf., however, Strömholm pp. 92 et seq.

11. Analysis of the problem has been made by Lögdberg in *NIR* 1960 p. 215 et seq. and Karnell 1970 pp. 61 et seq.

make several other commonly accepted ideas superfluous, at least for practical purposes.

It is sometimes said that ideas are not protected, because authors must not monopolize ideas. The principle of uniqueness provides the very simple explanation that ideas which are not sufficiently elaborated are not protected because they are not unique. Even if a person is the first to bring forth a very ingenious idea, there could always have been another person who sooner or later expressed the same idea. On the other hand, if the idea is elaborated in more detail, the protection starts at the point where the product has become unique. The principle of uniqueness thus gives a good explanation of the fact that ideas as such, up to a certain point, can not be monopolized.¹²

It is generally assumed that a simple statement, like a news item, is not protected. The reason is that it is not unique either. Another person could have given the same news information in the same way. Even here, further elaboration gives rise to protection at a given point, namely, where uniqueness is attained.

If I make a product by copying or otherwise imitating a previous work, I cannot get protection for my product. It is not unique. The same product could have been made by other persons. This is valid even if I use as a model a work for which the term of protection has expired or a work originating from times before the existence of copyright laws, e.g. an old manuscript.

If I imitate a previous work but at the same time add something of my own, which is unique, my contribution will be protected. The new product will then contain two unique parts, two "works", the work of the original author, and my work as an adaptor of the previous work.

4. The principle of uniqueness can also explain when a work is infringed upon. This is the same problem that has just been discussed as regards imitating and adapting a previous work, but it is looked upon from another angle.

In one case, A claims that B has infringed upon his work. A comparison is made between A's work and what B has produced. It shows that B has used A's work and that he has not added something of his own to his product. B is an infringer without any copyright for his own product.

12. Cf. also Karnell 1970 pp. 85 et seq., Koktvedgaard pp. 98 et seq.

In another case, B has used A's work in such a manner that the resulting new product is one-half A's work and one-half a unique new product. B's half is a "work" and protected as such. It is a different matter that B is not allowed to make an adaptation of A's work available to the public without A's consent and that B cannot exploit his work unless A consents.

In still another case, there is a similarity between A's product, containing a work of A, and B's product. B's product contains a work of B but no protected parts of A's product. B is protected in respect of his work, independently of A. This situation corresponds to the situation referred to in some statutes on copyright, under which a person by "using freely" a previous work has created a new and independent work.¹³ An example is an account of a book or a play. The author of the account is not using any protected parts of the book or the play. He therefore does not commit an infringement. On the other hand, his account may be protected if it is not too commonplace.

The precise point where B's infringement upon A's work begins varies considerably. It depends on how great a part of A's product is a "work". Let us take a musical theme as a simplified example (without bothering with rhythm or other similar elements). If the theme is very unusual, the infringement point may be reached when only a few notes in the protected theme have recurred in the later product. If it is a less original theme, the infringement point is not reached until several notes in the theme have passed. In other words, the point of uniqueness is reached earlier in the first than in the second case, because the work, the protected part of the product, is more extensive.

An infringement may hit only a small part of the work. A work can consist of a number of items which are unique *per se*, independently of other parts of the work. To infringe upon one of these "subworks" is enough to constitute an infringement of the work.

5. A cardinal point is, of course, whether the principle of uniqueness has anything to do with reality or if it is only an offspring of thought. To what extent is the principle compatible with existing copyright laws or conventions? An interesting fact is that, as far as I know, there are no laws or conventions that have specific general rules as to how duplicate creations should be handled, whereas patent laws have rules about the right of a prior user of an invention. This lacuna indicates that the

13. Cf. the essentially uniform Scandinavian Copyright Acts sec. 4.

legislators have not found any practical need for such rules. In other words, they have believed that the protected work should be practically unique. The principle of uniqueness fits in with the system of copyright laws and conventions.

It can also be mentioned that the principle of uniqueness stands well together with a reasonable freedom of expression. A person who makes a literary or artistic product does not risk to infringe upon works which are unknown to him. If he makes a unique product, no other author can make claims against him for infringement. If, without using a previous work, he makes a product that is not unique, a similar product, unknown to him, is not unique either, and its author can therefore not raise claims for infringement.

6. One thing is to accept the principle of uniqueness at least as a guiding star. Another thing is to apply it in practice. This may obviously be very difficult.

In the first place, however, it can be said that the principle always gives *some* guidance for the practitioner. He is better off with something like the principle than if he has no principle that he can use as a guide.

But yet there is much material available in case law and legal writing which gives us a more concrete idea of how the principle functions in practice in different literary or artistic domains. A modern pioneer work, which can be said to use the principle as a guiding star, is the Swiss writer Kummer's *Das urheberrechtlich schützbares Werk*, 1968.

As the principle is flexible within certain limits, it will easily be applied in a somewhat different manner from one literary or artistic domain to another and from one country to another. In some domains greater risks of duplicate creations are accepted than in others, particularly if there is a specific need for protection in the borderland. This is, for instance, true of musical works and applied art.¹⁴

As for national differences, it may for instance, be mentioned that English courts have granted copyright protection to football coupons.¹⁵ I doubt that more than a few courts in other European countries would follow that example. The most distinct difference appears, however, between a system like that of the United States and a system like that of the Berne Convention.

14. Cf. Ljungman pp. 190-191, Strömholm p. 99.

15. Copinger-Skone James, 10th ed. London 1965 p. 55. Cf. Ljungman pp. 189-190.

In the United States, where formalities are a basis for protection, it is possible to be rather liberal towards duplicate creations. Indirectly there is in principle a rule to handle duplicate creations: the work first copyrighted gets the priority. American law also seems to have small requirements for copyright protection. Nimmer refers, for instance, to a doctrine with *Bleistein v. Donaldson Lithographing Co.* (1903) as the leading case, according to which the originality required to support a copyright may be of a most minimal nature.¹⁶

In the system for the Berne Convention, copyright comes into existence without any formalities at all. That means that the copyright protection in principle starts at the moment when the author has fixed his work in some tangible form or when he has performed his work in a way that has made it audible or visible to another person. To determine, in case of duplicate creation, which of the first fixations or performances has the priority of time is often practically impossible, especially if the creations are made in different parts of the world. If you give both authors the same right, these common rights must be very difficult to exercise and exploit. Therefore, in a system like that of the Berne Convention, the principle of uniqueness that practically eliminates duplicate creation must be a real cornerstone in order to avoid all kinds of legal difficulties.

According to statistical laws, duplicate creations must, however, sometimes occur, even in a system like that of the Berne Convention. A question of principle, although one of very small practical importance, is how such cases should be settled.¹⁷

The correct solution will frequently be to deny copyright to both products. The existence of two independent products shows that neither of them is a unique work.

Sometimes this solution is difficult to apply, for instance when one of the products or other similar products have already been awarded copyright. In that case there are two other possibilities.

The first possibility is to give priority to the one which has the priority of time ("objective novelty"). For reasons of evidence it seems more appropriate to give the priority to the author who was the first

16. Nimmer on Copyright. Albany, San Francisco, New York 1966 p. 105. Cf. Ljungman p. 182.

17. The problem is discussed in greater detail and with results which differ in part from those in the text by Lund in *NIR* 1960 pp. 202 et seq. and by Karnell 1970 pp. 374 et seq.

to make the work available to the public rather than to the author who made the first fixation or performance. This solution is preferable in a country where the legal system does not permit duplicate creations except in very rare cases. If a person in such a country maintains that he has made a duplicate creation without knowledge of a previously available work, he must in most cases be wrong. Thus, the objective solution eludes the difficult question of evidence whether a person in a given case is lying or not. But of course in some few cases authors lose the right they should have had according to the basic principles of the system.

The other possibility is to give both copyright, if no one of the authors involved has used the product of the other ("subjective novelty"). If the copyright system of a country permits that duplicate creations are relatively frequent, the subjective solution is the most attractive one, at least from the point of view of principle. The law, in these cases, does involve a real risk for the emergence of at least a few duplicate creations, and therefore both authors ought to have their rights. But, as was said before, these common rights must be very difficult to exercise and exploit.

7. If the principle of uniqueness as defined here is accepted, it is of minor importance what name is given to it. Even terms such as "originality", "individuality" or "independence" can be used. I prefer the term "uniqueness", because it tells you immediately what it is all about, and because the other terms have often been used in a slightly different sense.

II

8. Not all works are protected, only those which are literary or artistic. What is the sense of "literary or artistic"?

We must not pay too much regard to the literal meaning of the words "literary" or "artistic". They have been used since the childhood of copyright to characterize the most important subject matter of copyright protection: great literature and great art. But they are of little assistance when drawing the line, in a modern society, between protected and non-protected so-called "small coins".

As a matter of fact, it seems likely that rather few products are unique and not at the same time "literary" or "artistic". For instance, there is very little need to distinguish between literary or artistic works and technical works. The technical solutions are governed by necessity. They generally "lie in the air" and are therefore not unique. If A had not found a certain technical solution at the given time, B would have made it, even if it had taken another 20 or 30 years. But if a technical

product would in fact, for some reason, be unique, it is not protected by copyright. There is a specific protection of inventions, and according to the principle *lex specialis legi generali derogat*, the patent protection prevails in its field over the copyright protection.¹⁸

What is said about inventions is in some respects true also for performances of artists, for sound recording and broadcasts. If there is a special protection for these categories, that protection prevails over the copyright protection except in a few cases, e.g. concerning directors of theatrical performances, that sometimes are said to have either copyright or neighbouring rights. Copyright then subsists in unique performances, neighbouring rights in non-unique performances.¹⁹ The film director seems always to be referred to the copyright sector.

9. There are, however, some unique works, made by man, that are not literary or artistic. Examples are economic or political "wonders", accomplished by statesmen, or voyages of discovery, carried out by explorers. It is obvious that such works are not protected by copyright. But why is it so?

Strömholm expresses the opinion that it is specific for copyright works that they are normally easy to reproduce and otherwise imitate, particularly by using means which are simpler or rather less evaluated under prevailing social conventions than those used by the author of the original work.²⁰

Karnell holds "literary works" to consist of works which are in a broad sense descriptive. He means that "artistic works" can only be described as works which are similar to those which earlier have been considered as artistic.²¹

I gather that Strömholm and Karnell on the whole have the same types of works in mind. Works that have earlier been considered as literary or artistic appear only in specific shapes: as writing in a large sense of the word, sound, picture, including motion and pantomime, or form. Works appearing in that shape are normally easy to reproduce or otherwise imitate by using simpler or less appreciated means than those used by the creating author. Such works are therefore in need of pro-

18. Cf. Strömholm pp. 93 et seq.

19. Strömholm, Teaterrätt. Stockholm 1971 pp. 53 et seq. means that there is no fundamental difference between directors of theatrical performances and film directors.

20. Strömholm pp. 124 et seq.

21. Karnell 1970 pp. 73, 108.

tection, while others, which cannot easily be reproduced or otherwise imitated with simpler or less expensive means, are not. The criterion "literary or artistic" thus implies that works protected by copyright can appear only in the specific shapes just mentioned.

III

10. When a work is protected by copyright, the author has, in principle, an exclusive right to do certain things with the work. If another person does the same things, he is an infringer. The exclusive right includes for instance the right to reproduce the work, to perform the work in public, to broadcast it, to exhibit it and to distribute it to the public. It is obvious that the "work" is used as an *object* of all these verbs: reproduce, perform, distribute, etc. But what is the nature of the objects towards which these acts of reproduction, performance, distribution, etc., are directed?²²

One of the classical problems of copyright is the nature of the work as "object" of copyright. There has been much disagreement about this question. One opinion is that the work as object of copyright is something incorporeal. By "incorporeal" can be meant at least two different things. (1) The work is neither a physical nor a psychological reality in our world. (2) The work is only a psychological reality in the mind of the author when creating the work or in the mind of those persons who perceive the created work. Others maintain that the work is corporeal. (3) It consists of the manifestations of the work which are perceptible in the outer world, like a copy of the book "Death in Venice" or a film picture from the film "Death in Venice".

22. In the debate about these problems, started by Ross in *TfR* 1946 pp. 321 et seq. and continued by him in *TfR* 1951 pp. 85 et seq. and 1953 pp. 410 et seq., *SvJT* 1955 pp. 245 et seq., the following contributions from other writers can be mentioned: Eberstein in *NIR* 1946 pp. 81 et seq., *TfR* 1955 pp. 113 et seq., Magnussen, *Naboretlige studier*. København 1950 pp. 34 et seq., Illum in *UfR* 1950 B pp. 343 et seq., Fr. Vinding Kruse in *TfR* 1951 pp. 8 et seq., Hartvig Jacobsen, *Forlagsretten*. København 1951 pp. 16 et seq., Hedfeldt in *TfR* 1952 pp. 152 et seq., Bergström (1954, with a summary of the previous debate), Lund in *NIR* 1954 pp. 131 et seq., Hesser in *NIR* 1954 pp. 203 et seq., Godenhielm in *FJFT* 1955 pp. 368 et seq., Weincke in *UfR* 1956 B pp. 226-227, Koktvedgaard (1965), Lögdberg, *Upphovsrätten och fotografirätten*, 2nd ed. Stockholm, Göteborg, Uppsala 1967, Karnell 1968, 1970, Strömholm (also in *Gewerblicher Rechtsschutz und Urheberrecht. Ausl. u. Internat. Teil* 1963, pp. 433 et seq., 481 et seq.). The contents of this section are mostly taken from my book 1954 with some adjustments implied by the debate which followed.

Most of the disagreement will probably disappear if we can, when discussing the problem, agree upon one common definition of the concept "object of copyright". The definition chosen here from among several alternatives will be the object towards which acts mentioned in copyright laws like reproduction, performance, distribution, are directed. Such acts can only affect directly exterior manifestations of the work. The reason is that law in principle deals with phenomena in the outer world and that no legal power can be exercised beyond that world. Thus the exterior manifestations of the work will here be considered as the object of copyright.²³

11. An exterior manifestation of the work has been called a *medium* of the work. When no registration is needed, copyright is born at the moment when the author has created one medium of his work, the so-called *primary medium*.²⁴

With regard to their physical characteristics, the mediums can be divided into two types. The first type is the *permanent* medium, or the *copy*. In principle it is durable and can be perceived successively by many persons. The second type is the *transient* medium. It is produced in the short moment when it is perceived by a person and it fades away immediately afterwards. A transient medium is the spoken word, music sung or played, a film or television picture shown on the screen, etc. As a primary medium it must be perceived by someone other than the author in order to give rise to copyright protection.

On the basis of these two types of mediums as object of copyright, the author's copyright can be divided into three main rights. The first right refers to the *reproduction* of the work. The object is copies which, before the reproduction takes place, are imaginary.²⁵ The second right

23. Strömholm and Karnell agree with me that copyright cannot be claimed in respect of any uncorporeal work. Strömholm (pp. 137-198) deals extensively with the problem as to what principles are adopted for picking out the "object" of various rights. He seems to reject in principle the idea of copyright being construed upon the pattern of property, as a right in a specific "object". This is also the opinion of Ross (in *SvJT* 1955 pp. 250 et seq.) and others. Karnell (1968 pp. 421 et seq.) seems to have a similar view. His analysis of the problem leads him to the conclusion that no unitary concept could be established with regard to the use of the word "the work", which differs in each individual context (p. 444).

24. I used these terms in my book (1954) and they have since been used by several authors. Karnell (e.g. 1970 p. 42-43) prefers another terminology, speaking of primary, secondary and original phenomena in a somewhat different sense.

25. Cf. also Karnell 1968 pp. 415 et seq.

covers the *public performance* of the work. A public performance of a work means that transient mediums are produced before a public which can perceive the work. Even these mediums are of course imaginary before they are produced. Performance rights are often divided into different subrights, as public performance in a strict sense, broadcasting and communication to the public.

The third right is the least observed of the rights. It is the right that the author may have, in copies already made, as to sale, loan, lease or other forms of distribution or exhibition. This third right has been called *right of distribution and exhibition* or *right to the copy*. It is the least observed, because the author has a very limited right in the copy in competition with the owner of the copy.

12. What is the advantage of making all these distinctions, essentially based upon the two types of mediums?

One advantage is that all specific rights to produce transient mediums can be brought together into one general right of performance. As all these rights have the same type of object, they have much in common in several respects.

Another advantage is that a clear distinction is made between the right of performance and the right to the copy. These two rights affect different types of mediums. It has sometimes been maintained that the object of the right of performance is the incorporeal work, which distinguishes this right from the right to the copy. Such a construction will only obscure realities. The same criticism can be advanced against another construction, which considers the incorporeal work as object of the right of performance and of those rights to the copy which are reserved for the author. According to this construction, the incorporeal work would be the object of copyright and the corporeal copy the object of property rights.

It is, however, important to have a realistic view of the right to the copy. The copy is the point of intersection between copyright and property rights. The mediums involved in the rights of reproduction and performance cannot be the objects of property rights. The imaginary copies which are the object of reproduction right and the transient (and imaginary) mediums which are the object of performance right lack the tangibility which is necessary for an object of property rights. The relations between copyrights and property rights will not be fully understood if the copy is not considered as the common object of both rights. Not until then will it become clear that the property rights of the owner

are the main rights in the copy and that copyright implies mostly minor restrictions on the property rights. A general opinion of legislators is that it is difficult to diminish in any substantial way the normal right of an owner to sell, to loan and otherwise distribute, to exhibit and to destroy the copy. It must be observed that as regards the other two rights of the author, the essential weighing of opposing interests is done between the author's interests and the interests of the general public.

13. The distinction made here finally gives us a clue to the legal-technical nature of copyright as distinguished from property rights. The property owner has a privilege in one single thing, for instance a copy which he owns. The author has a privilege in a whole class of things, all mediums of his work, including copies owned by others. The author's privilege has its counterpart in other types of so-called intellectual property, like patents and trade marks.²⁶

There is also another important aspect of the relation between copyright and property rights in combination with the general principle of freedom of action. Let us assume that there is a country with no copyright law! All persons, including the author, can use their freedom of action and their property rights to make copies of the work, distribute and exhibit the copies, and perform the work. By virtue of his property rights, the author can establish an exclusive right to his work as long as he is in possession of his primary medium or a similar medium and has not yet authorized any copies or other new mediums to be produced.

What happens when a copyright legislation is introduced in that country? The author retains his freedom of action and his property rights but a prohibition is issued against other persons to use *their* freedom of action and property rights to the same extent as before. A copyright law need not provide for more than this prohibition. Most laws do, however, grant the author an *exclusive* right,²⁷ which therefore includes (1) his original freedom of action and his original property rights as to reproducing and performing the work himself as well as distributing and exhibiting his own copies, but also (2) his rights to grant exemptions from the prohibition against other persons by authorizing, e.g., a publisher, to use his work. If he transfers his copyright, he will in a technical sense transfer both these elements of copyright.

26. Cf. also Koktvedgaard p. 126.

27. The practical reasons for this choice of legal technique has been discussed by Karnell 1968 pp. 415 et seq.

Conclusions

14. There are two criteria for a work protected by copyright. The first is that it must contain something *unique*. According to the principle of uniqueness, a work is at hand if it cannot practically be made by two persons independently of each other. The word "practically" indicates that the uniqueness is always relative, a fact which within certain limits makes the principle *flexible*. The author must bring about the uniqueness of the product himself. In this connection, we can distinguish between the *product*, for instance the book, and the *work*, i.e. the unique parts of the product, which are protected by copyright. The principle does not contain any reference to the aim of the author.

The principle of uniqueness explains in a simple way many basic rules in the copyright system, for instance, why the idea as such is not protected and why simple statements like news items are not protected either. It also explains, i.a., the rules about adaptation and infringement. The principle fits in with the system of copyright laws and conventions as they have no specific general rules as to how duplicate creations should be handled: no need for such rules has been found to exist. The principle, flexible as it is, can be applied in a somewhat different manner from one literary or artistic domain to another and from one country to another.

The second criterion for a protected work is that the work shall have a *literary* or *artistic* character. That seems to signify that the work shall consist of writing in a large sense of the word, sound, picture, including motion and pantomime, or form.

The exclusive right of the author includes, for instance, the right to reproduce the work, to perform the work in public, to broadcast it, to exhibit it or distribute it to the public. The work is placed as an object of all these verbs. Work in that sense may be defined in one of several senses as the "object" of copyright. The work so defined can only consist of exterior manifestations of the work, the so-called *mediums*.

The first medium the author produces, the *primary medium*, gives rise to copyright in the work. The mediums are either *permanent*, that is, *copies*, or *transient*, like the spoken word, music sung or played, or a film or television picture shown on the screen.

The three main rights of the author are modelled on the nature of these different mediums, so that every right has its own object. The *reproduction right* has imaginary copies, the *performance right* transient

mediums and the *distribution and exhibition right* or the *right to the copy* ready-made copies as objects.

These distinctions give us a better understanding of the relations between copyright and property rights, which collide in the copy. Property rights can be said to be a privilege in a single thing, while copyright is a privilege in a whole class of things, all exterior manifestations of the author's work. The exclusive right of an author is composed of two elements: (1) his freedom of action and his property rights to use his works with his copies, (2) his right to grant exemptions from the prohibition against other persons to use his work.

62. JAZZ AND COPYRIGHT: A STUDY IN IMPROVISED PROTECTION.*

By MARSHALL J. NELSON

*"We all go do-re-mi, but you got to find the other notes for yourself."*¹

— Louis Armstrong (1900-1971)

Louis Armstrong was "the first great classical figure of jazz."² He, more than any other person, was responsible for the rediscovery and development of improvised music in the twentieth century. His work dominated jazz for more than half the century and influenced musicians from Ravel to Miles Davis. It is ironic that at the time of his death, the law is just beginning to discover improvisation, trying to anticipate its *future* problems, and calling it the "new" music.³

The music is not new. During the eighteenth century — an age which produced the music of Bach, Mozart, and Beethoven — the art of musical improvisation was at its height. Improvised performances were an expected part of private "chamber" concerts, and to many, they represented the real test of a composer's genius.⁴ Although the art declined as music moved to the more formal concert hall, it did not disappear. It has been the essential element of American jazz for almost seventy years.

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1. *Good-by, Louis*, NEWSWEEK, July 19, 1971, at 76.
2. A. HODEIR, JAZZ: ITS EVOLUTION AND ESSENCE 62 (1956) [hereinafter cited as HODEIR]. For the reader who is not familiar with jazz, Hodeir's book is an excellent (if slightly technical) introduction to the subject.
3. See, e.g., Goldstein, *Copyrighting the New Music*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER SIXTEEN 1 (1968); Keziah, *Copyright Registration for Aleatory and Indeterminate Musical Compositions*, 17 BULL. CR. SOC'Y 311 (1970); Savelson, *Electronic Music and the Copyright Law*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER THIRTEEN 133 (1964).
4. For detailed description of improvised music during this period see G. MAREK, BEETHOVEN: BIOGRAPHY OF A GENIUS 12-20 (1969).

Until quite recently, the only extensive use of improvisation was in music that could be easily labeled "jazz," but with the tremendous impact of jazz on today's music, the technique is reaching a much wider and rapidly increasing audience. Jazz film scores are common; television theme and background music are jazz-oriented. Even radio, the domain of the popular *song* for so many years, has felt the influence of jazz in the form of "hard rock" and "soul" music. Jazz itself is moving away from its traditional form of theme-and-variations into areas of free form and pure improvisation, and on the concert stage, composers are experimenting with collective improvisation. While no one would argue that written music is about to disappear, it is quite possible that we are witnessing a renaissance of improvised music.

As the trend continues to develop, one basic and very current problem emerges: improvisation is the one form of musical composition in which the composer has no guaranteed rights. The existing discussions of electronic, "indeterminate" or "aleatory" music⁵ are not likely to change the situation. Members of the music industry, who are influential in shaping the law, are not concerned with the experimental "new music;" it has no economic significance. They must be shown that the makeshift protection which improvised music has found in the past is inadequate, and that there is a current and specific need for change. This paper attempts to demonstrate that need through the example of jazz. As the one form of improvised music which already has an established market, jazz offers a base for discussion beyond abstract questions of copyright registration, and provides a focus on practical problems in the area of recording and performance rights. In general, it may present a current perspective for what has been, up to now, a largely academic treatment of improvised music and the law.

THE UNDERLYING PROBLEM

American jazz emerged from the cabarets and brothels of New Orleans to become a major force in the world of music.⁶ Perhaps it is not, as sometimes claimed, the only true American music, but it is undoubtedly this country's most significant contribution to the art. Ironically, its success may be the underlying reason for its neglect under copyright law. The rhythms and harmonic structure of jazz have become so much a part of modern music that the general public does not distinguish between written music which incorporates these elements, and jazz, which

5. See note 3 *supra*.

6. See HODEIR 7-9, 245-63.

is largely improvised. To the average listener, jazz has become just another variety of "popular" music, and the law reflects this attitude. It is difficult to appreciate, or even recognize, the copyright problems of jazz, without first considering the process of improvisation and its effect on the music.

Improvisation, at its best, is among the most disciplined and, at the same time, purely creative of the arts. The musician must literally compose music as he performs, with no chance to revise a bad phrase or correct a dissonant chord. In jazz, this sense of spontaneous creation is the essence of the art. It can never be reduced to written notation, but is conveyed to the listener as an integral part of the music. It can only be preserved, if at all, through the use of sound recordings. As Andre Hodeir indicates in the preface to his classic treatise on jazz:

[T]he recording is the most trustworthy witness we have in dealing with an art form of which nothing that is essential can be set down on paper. The reader should not be surprised, therefore, if the words *work* and *record* are used interchangeably throughout.⁷

This observation, that the recording *is* the work, is the key to any discussion of improvised music and the law. Any effective protection for improvisation can be framed only in terms of recordings, and any protection of recordings which neglects improvisation is incomplete. The law has not only failed to recognize this relationship; it has completely ignored the fact that an improvised performance is an independent creative work. In the process it has excluded from protection a significant part of this country's musical heritage.

THE PROBLEM OF STATUTORY PROTECTION

Under the present Copyright Act,⁸ the composer of even the most elementary written music is granted "exclusive rights" in his work, while the composer-performer of improvised music is guaranteed nothing. This is the simplest statement of what has become a complex problem. Had it been considered earlier, while sound recording was still in its infancy, the problem might have been much simpler; but after sixty-one years under the same basic copyright statute,⁹ there is a tremendous inertia of

7. *Id.* at 2.

8. 17 U.S.C. § 1 *et seq.* (1964).

9. See REGISTER OF COPYRIGHTS, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW ix-x (Comm. Print 1961).

accepted precedent and established practice in the industry to be overcome if any workable solution is to be reached. By tracing some of the reasons for this situation, it may be possible to dispose of arguments which are today irrelevant or obsolete, and to suggest some solutions to the real problems which remain.

Before discussing the legal status of improvised music, however, it is important to recognize the protection available to written music under the Copyright Act. The exclusive rights guaranteed to the composer are itemized in section 1 of the statute.¹⁰ These rights fall into four general categories, characterized as: publishing rights, adaptation rights, performance rights, and recording rights.¹¹ In the case of music, performance and recording rights are subject to certain limitations.

The exclusive right to perform copyrighted music is limited to performances which are given "publicly for profit."¹² However, this clause has been interpreted to include performances with the immediate or ultimate purpose of attracting patronage or of selling goods,¹³ and thus includes performance of the music in hotels,¹⁴ restaurants,¹⁵ and even supermarkets.¹⁶ Most important from an economic standpoint, the clause has been held to include performance of the work on radio and television¹⁷ and specifically, performance by means of recordings.¹⁸

Recording rights themselves are more severely restricted by the so-called "compulsory license" provisions of subsection 1(e). Under this subsection, the copyright owner has the exclusive right to record his work, *until* he exercises that right. In the words of the statute:

[W]henver the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work [in a

10. 17 U.S.C. § 1 (1964).

11. B. RINGER & P. GITLIN, *COPYRIGHTS* 20-30 (rev. ed. 1965).

12. 17 U.S.C. § 1(e) (1964).

13. *Herbert v. Shanley Co.*, 242 U.S. 591, 594-95 (1917).

14. *Remick Music Corp. v. Interstate Hotel Co. of Nebraska*, 58 F. Supp. 523 (D. Neb. 1944), *aff'd*, 157 F.2d 744 (8th Cir. 1946), *cert. denied*, 329 U.S. 809 (1947).

15. *Leo Feist, Inc. v. Lew Tendler Tavern, Inc.*, 267 F.2d 494 (3d Cir. 1959). Where recorded music was transmitted to the restaurant by wire, *both* music service and restaurant were held to have performed the work publicly for profit.

16. *Chappell & Co. v. Middletown Farmers Market & Auction Co.*, 334 F.2d 303 (3d Cir. 1964).

17. *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191 (1931).

18. *Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc.*, 141 F.2d 852 (2d Cir.), *cert. denied*, 323 U.S. 766 (1944).

sound recording], any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of 2 cents on each such [recording] manufactured¹⁹

This paradoxical limitation was originally created in 1909 to prevent a threatened monopoly in the early recording industry.²⁰ Today, although there are strong arguments that the provision is obsolete and unduly restricts the copyright owner,²¹ it at least provides a guaranteed royalty for use of the composer's work. It should also be emphasized that the exclusive right to "perform" the derivative recording for profit is retained by the composer.²² In other words, although subsequent manufacturers may sell and otherwise use recordings they produce, any royalties from playing or broadcasting the records belong to the composer of the recorded music.

Basically, the copyright owner holds "a bundle of rights"²³ which he can sell outright or convey separately. During the statutory life of these rights — fifty-six years, if the option of renewal is exercised²⁴ — the

19. 17 U.S.C. § 1(e) (1964). Bracketed words are substituted for the archaic language of the original, "upon parts of instruments serving to reproduce mechanically the musical work," and "part," respectively.

20. Act of March 4, 1909, ch. 320, 35 Stat. 1075. See B. RINGER & P. GITLIN, *supra* note 11, at 29.

21. See, e.g. *Hearings on S. 597 Before the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary*, 90th Cong., 1st & 2d Sess. 453-70 (1967) [hereinafter cited as *1967 Hearings*]. See generally Henn, *The Compulsory License Provisions of the U.S. Copyright Law*, COPYRIGHT LAW REVISION, STUDY No. 5 (1960). This study is one of a series prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, 86th Cong., 1st & 2d Sess. (1960-61). [Hereinafter, these studies will be cited by author, title, and study number.]

22. 17 U.S.C. § 1(e) (1964):

The payment of the royalty provided for by this section shall free the articles or devices for which such royalty has been paid from further contribution to the copyright *except in the case of public performance for profit.*

(Emphasis added.)

23. B. RINGER & P. GITLIN, *supra* note 11, at 20.

24. 17 U.S.C. § 24 (1964):

The copyright secured by this title shall endure for twenty-eight years from the date of first publication . . . the author of such work . . . shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years . . .

See generally B. RINGER & P. GITLIN, *supra* note 11, at 56-63.

composer of a successful work can expect to receive income from many sources: sale of the published music; sale of authorized arrangements, editions, and compilations; manufacture and sale of recordings; use in motion pictures; and royalties from any use which involves the performance — live or recorded — of the work for profit.²⁵

The composer of improvised music is denied any of these statutory rights by a combination of factors. First, unless his music is recorded, the improvised composition ceases to exist as soon as it is performed; there is simply no tangible “work” in which exclusive rights can vest. A *recorded* improvisation, however, is an original composition which exists in the recording as concretely as if it had been written down on paper. Here, the statutory requirement of deposit and its implementing regulations act to exclude improvised music. Protection under the statute is conditioned upon the deposit of two copies of the work²⁶ with the Register of Copyrights, but the regulations of the Copyright Office specifically provide:

A phonograph record or other sound recording is not considered a “copy” of the compositions recorded on it, and is not acceptable for copyright registration. Likewise, the Copyright Office does not register claims to exclusive rights in mechanical recordings themselves, or in the performance they reproduce.²⁷

The statutory protection for music is clearly limited to “compositions in the form of *visible* notation.”²⁸

Despite this exclusion of recordings and performances, improvised music has not been totally barred from protection under the Copyright Act. Where an improvised performance can be linked to material that is registerable, it may share generally in the exclusive rights. The more traditional forms of jazz have been able to benefit from this practice.

Jazz traditionally has taken the form of a theme with improvised variations. Often the theme is a short, original composition or a carefully worked-out arrangement which is clearly entitled to copyright protection. By registering the theme as unpublished music,²⁹ the composer or ar-

25. See B. RINGER & P. GITLIN, *supra* note 11, at 20-30.

26. 17 U.S.C. § 13 (1964). If the work is not published for sale, one copy will satisfy the deposit requirement. *Id.* § 12.

27. 37 C.F.R. § 202.8(b) (1971).

28. *Id.* § 202.8(a) (emphasis added).

29. 17 U.S.C. § 12 (1964); 37 C.F.R. § 202.8(a) (1971).

ranger may receive royalties based on the entire recorded version, even if only twelve or sixteen measures of the recording are technically copyrighted. The improvised choruses, which comprise the greatest part of the work, are apparently treated as an arrangement or setting of the melody "for the purpose of public performance for profit."³⁰

This kind of "back-door" protection may be a practical solution for a certain segment of improvised music, but it is only effective where the improvisation is connected in some way to copyrightable material. Where the performance is based on a simple tune in the public domain, where the arrangement is not sufficient to constitute an original work of authorship, where the theme is a simple "blues" harmonic progression, or where the work is pure improvisation, the improvised works remain unprotected.

It is also possible to transcribe the recorded performance, note for note, into written music which can then be registered; but this process is very difficult and time-consuming. In cases where electronic instruments are used, or sounds are engineered in the recording process, it may be impossible to find notation, or even words, to represent the final result on the recording.³¹

Other possibilities have been suggested, including such Gordian solutions as registering a description of the work as a "book"³² or dramatic scenario,³³ or even filming the performance for registration as a motion picture.³⁴ The nature of the art suggests that any attempt to force improvised music into the present statutory scheme is, at best, illogical and contradictory. The very essence of improvisation is the absence of written music, and to the extent it is performed from written notation, it is no longer improvised. Visible notation, no matter how accurate, can only capture part of an improvised performance. It can indicate which musical notes were played, and in what order; it may indicate some accents and phrasing; but it cannot capture the vital element of improvisation, its spontaneity. Only a recording can reproduce the subtle nuances that convey this feeling to the listener.

30. 17 U.S.C. § 1(e) (1964).

31. See generally Goldstein, *Copyrighting the New Music*, ASCAP COPYRIGHT SYMPOSIUM NUMBER SIXTEEN at 13-20 (1968).

32. Keziah, *Copyright Registration for Aleatory and Indeterminate Musical Compositions*, 17 BULL. CR. SOC'Y 359 (1970).

33. Goldstein, *supra* note 31, at 15.

34. *Id.* at 15-20.

There is also no legal necessity for visible notation. In the case of written music, a visible copy may be important in litigation.³⁵ Claims of plagiarism and unauthorized use of the *music* often arise, and the copy of the music on deposit may be necessary as proof of the original version. In the case of an improvised work, whatever infringement there may be will almost certainly take the form of unauthorized use of the *recording*. There is little threat of imitation or unauthorized copying of the music, *per se*. Of course, it is conceivable that a performance might be transcribed into musical notation which could then be printed and sold.³⁶ It is also possible that an unauthorized arrangement or adaptation might be made in the same way.³⁷ Other performers could even memorize an improvised solo and attempt to perform it as their own. However, there is little, if any, economic or artistic incentive for these uses. The appeal of improvised music is in hearing the performer create; and in jazz, especially, a recording becomes popular more because of the performance than the specific titles on the album.³⁸ By the same logic, there is among jazz musicians a built-in incentive *not* to plagiarize these performances. An artist who can no longer offer imaginative, fresh improvisations, who imitates even his own earlier work, soon loses his audience.³⁹ The real concern of the improvising composer is not in preventing imitation, but in preventing unauthorized and uncompensated use of the actual recording. In such a case, where there is no claim of imitation, and nothing with which to compare the "original version," there is no need for a contrived, visible transcription of the music.

In short, the recording is the only practical, accurate and relevant version of an improvised work. By excluding both the deposit and regis-

35. See, e.g., Judge Frank's two-stage analysis of the plagiarism issue in *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), where the issue of "copying" may be determined by analysis of the music with the assistance of expert testimony.
36. Dave Brubeck, the jazz pianist, has done this with some of his own recorded improvisations, as has George Shearing (although in the case of Shearing, it is not as clear from the printed works that the works are transcribed improvisations).
37. Lambert, Hendricks & Ross (later Lambert, Hendricks & Bavan), a jazz singing group popular in the early sixties, was noted for transcribing and setting words to improvised instrumental recordings.
38. See *1967 Hearings*, *supra* note 21, at 496-98.
39. See A. HODEIR, *TOWARD JAZZ* 19-23 (1962). There is a certain amount of "phrase-borrowing" in jazz solos, which might technically be called plagiarism; but it is so much an understood part of the style of jazz, that it must be considered as something akin to fair use. See generally HODEIR, *supra* note 2, at 44-46.

tration of sound recordings, the Copyright Office effectively bars improvised music from statutory protection.

PROBLEMS OF COMMON-LAW PROTECTION

Section 2 of the Copyright Act specifically preserves the rights and remedies in unpublished works available "at common law or in equity."⁴⁰ These rights and remedies have never been defined with respect to improvised music. However, an improvised work may be approached as something other than a musical composition. Hodeir spoke of the *recording* as the work,⁴¹ and it is also, by definition, an improvised *performance*. In each of these areas, courts have spoken, but the implications for protection of improvised music are neither uniform nor adequate.

It is impossible to formulate a generalized statement of the common law as to either recordings or performances. The degree of protection is determined under state law,⁴² whether the theory be one of common-law copyright or unfair competition;⁴³ and the various decisions have been anything but uniform.⁴⁴ Further complicating any attempts at prediction is the still uncertain application of the *Sears* and *Compco* doctrine.⁴⁵ However, for the purposes of this discussion, a survey of common-law theories is not entirely academic. The rationale and emphasis of even the older cases will help to explain the continuing neglect of improvised music and sharpen the focus on the problem.

40. 17 U.S.C. § 2 (1964):

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.

41. See note 7 *supra*.

42. *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 662 (2d Cir. 1955).

43. See generally Feldman, *The Relationship Between Copyright and Unfair Competition Principles*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER TEN 266 (1959); Comment, *The Civil Remedies for Disklegging*, 33 S. CAL. L. REV. 190 (1960).

44. See text accompanying notes 61-96.

45. In *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), the Supreme Court enunciated a principle of federal preemption in the general area of intellectual property, but the scope and applicability of this principle are still unsettled. For a brief statement of the problem and commentary, see notes 110-11 *infra* and accompanying text.

It is important to note that none of the reported decisions directly involve protection of jazz or improvised music.⁴⁶ This absence of litigation may be the result of the indirect statutory protection which has been available in the past,⁴⁷ or because of the limited area of infringement,⁴⁸ or even because of indirect economic and racial inequities.⁴⁹ Whatever the reasons, it must be emphasized that the reported cases are only analogous, and the unique interests of the improvising musician should be borne in mind.⁵⁰

Common-Law Copyright in General

Under the Copyright Act, common-law remedies are preserved only in *unpublished* works.⁵¹ Because of this distinction, a key question in any case of common-law copyright is whether there has been "publication" sufficient to bring the work within the statutory scheme and divest the plaintiff of his rights at common law. The courts admit and have adopted a double standard for determining this question. Where statutory protection is sought, "publication" is broadly construed, enabling the claimant to rely on provisions of the statute; where the theory is one of common-law protection, a narrower definition is applied, to avoid preemptive application of the statute.⁵² In cases involving performances and recordings, where protection is not available under the statute, this principle has been applied to the extent that public sale of records did not prevent the artist from restricting their use,⁵³ and public performance of an opera on a nationwide broadcast "did not constitute an

46. The one case which might have raised some of the issues peculiar to jazz involved an action brought by CBS and Louis Armstrong against Paradox Industries, Inc., who had re-recorded some of Armstrong's Columbia recordings and sold them under the appropriate label of "Jolly Roger" records. Unfortunately for the development of the law in this area, the dispute was settled out of court. For a discussion of this case see *Miller v. Goody*, 139 F.Supp. 176, 185-86 (S.D.N.Y. 1956).

47. See text accompanying notes 28-30 *supra*.

48. See text accompanying notes 35-36 *supra*.

49. The fact that jazz was, for a long time, the domain of black musicians, and that jazz has never been "popular" music in the sense of "Top-40" or "Hit Parade" songs, suggests that the economic stakes may not have been high enough to precipitate a body of reported litigation.

50. See text following note 39 *supra*.

51. 17 U.S.C. § 2 (1964).

52. *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956).

53. *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 448, 194 A. 631, 638 (1937).

abandonment of . . . common-law rights.”⁵⁴ Setting aside the possible impact of *Sears* and *Compco* on these decisions, the question remains, exactly what common-law rights have been preserved. For purposes of analysis, an imperfect distinction is drawn between those cases which deal with the right to control the use of the recording, and cases involving the general rights of a performer in his work.⁵⁵

Common-Law Protection for Recordings

Remember that we are not dealing with the old question . . . can a record infringe? We are asking — can you infringe a record?⁵⁶

In reply to Professor Chafee’s often-quoted question, it is possible to infringe a record, but not in the layman’s usual understanding of infringement as plagiarism. While it is possible to plagiarize or imitate the underlying composition or performance, infringement of the recording itself takes the form of actual *use* of the record. These uses are many, but they can be divided into two general categories: physical duplication and sale of the recording, and the playing or “performance” of it.

Unauthorized duplication of recordings has become a wide-spread problem with serious economic consequences for the record industry.⁵⁷ Record “piracy” has existed almost as long as there have been records on the market,⁵⁸ but with the advent of cassette tape recorders, the problem has taken on new dimensions.⁵⁹ The convenience and mobility of these devices create a vast market for cassette recordings, and the minimal cost and ease of re-recording makes unauthorized duplication more profitable than ever. As might be expected, the major recording companies have created a considerable body of case law in attempting to prevent this practice.⁶⁰

54. *Metropolitan Opera Ass’n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 798, 101 N.Y.S.2d 483, 494 (Sup. Ct. 1950), *aff’d per curiam*, 279 App. Div. 632, 107 N.Y.S.2d 795 (1951).

55. The discussion, thus far, has emphasized a view that in the case of improvised composition, performance and recording can *not* be separated. See text accompanying note 7 *supra*.

56. Chafee, *Reflections on the Law of Copyright*: 11, 45 COLUM. L. REV. 719, 734 (1945).

57. See Ringer, *The Unauthorized Duplication of Sound Recordings*, COPYRIGHT LAW REVISION, STUDY NO. 26. See note 21 *supra*.

58. See, e.g., *Fonotipia Ltd. v. Bradley*, 171 F. 951 (E.D.N.Y. 1909); *Victor Talking Machine Co. v. Armstrong*, 132 F. 711 (S.D.N.Y. 1904).

59. *100-Million Market in Bootleg Tapes*, BUSINESS WEEK, May 15, 1971, at 132.

60. See, e.g., *Tape Industries Ass’n of America v. Younger*, 316 F. Supp. 340 (C.D. Cal. 1970); *Capitol Records, Inc. v. Erickson*, 2 Cal. App. 3d 526, 82

The fact situations are remarkably similar⁶¹ in these recent piracy cases. The defendant company simply obtains a commercial copy of the original recording, which is then re-recorded and sold in the form of tape cassettes. By substituting the purchase price of one record for the expense of producing and recording the original performance, the pirate is able to sell his unauthorized copies at a price far below the cost of the original recording. Courts have been uniform in finding the traditional elements of unfair competition and enjoining these operations, despite the absence of "passing off," and the presence, in some cases, of express disclaimers of affiliation or licensing agreement with the original producer.⁶²

A slightly more creative form of piracy which has been enjoined is exemplified by *Capitol Records, Inc. v. Greatest Records, Inc.*⁶³ There the defendant re-recorded selected recordings of the Beatles, originally released by Capitol, and sold them together on the Greatest label at a lower price.⁶⁴ The New York Supreme Court found not only unfair competition, but also actual misappropriation of the plaintiff's product.⁶⁵

Courts in these recent piracy cases have avoided, almost entirely, the considerations of common-law copyright or artistic property. The opinions have been based instead on theories of misappropriation of the results of plaintiffs' efforts, and these efforts have usually been described in terms of production costs and publicity,⁶⁶ neither of which involves the performer. This shift in emphasis may be an attempt to avoid the possible application of dictum in *Sears, Roebuck & Co. v. Stiffel Co.*⁶⁷ that:

Cal. Rptr. 798 (Ct. App. 1969), *cert. denied*, 398 U.S. 960 (1970); *Capitol Records, Inc. v. Spies*, — Ill. App. 2d —, 264 N.E.2d 874 (1970); *Columbia Broadcasting System, Inc. v. Spies*, 167 U.S.P.Q. 492 (Ill. Cir. Ct. 1970).

61. See generally Helfer, *Copyright Revision and the Unauthorized Duplication of Phonograph Records—A New Statute and the Old Problems: A Job Half Done*, 14 BULL. CR. SOC'Y 137, 144-47 (1966).

62. *Columbia Broadcasting System, Inc. v. Spies*, 167 U.S.P.Q. 492 (Ill. Cir. Ct. 1970).

63. 43 Misc. 2d 878, 252 N.Y.S.2d 553 (Sup. Ct. 1964).

64. *Id.* at 879, 252 N.Y.S.2d at 554. Ironically, the compulsory license provisions of the Copyright Act were complied with by paying royalties for use of the songs themselves to the composers' assignee.

65. *Id.* at 881-82, 252 N.Y.S.2d at 556-57.

66. See cases cited note 60 *supra*.

67. 376 U.S. 225 (1964).

[A] State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.⁶⁸

The problem with such an approach is suggested in the language of a pre-*Sears* record piracy case, *Miller v. Goody*.⁶⁹ The various recording companies who joined Mrs. Glenn Miller in that cause chose to proceed on the basis of their ownership of the copyrights of certain Miller compositions and arrangements. In limiting them to the statutory remedy, Judge Kaufman of the Southern District of New York pointed out that:

[A]lthough [plaintiffs'] plight is distressing, there are others in the industry, notably recording companies and talented performers, who at present receive even less protection from record pirates and those who distribute their wares.⁷⁰

The same observation is well applied to the recent record piracy cases which effectively restrict relief to the recording companies, and condemn the performer's interests to summary judgment under *Sears* and *Compco*.⁷¹

The second category of unauthorized use involves the public performance of genuine recordings (as distinguished from unauthorized copies) in the absence of an agreement or license to do so. This issue has been less frequently litigated than the duplication problem, but the existing cases involve problems closer to the present discussion. Here, the decisions are grounded specifically on the performer's rights in his recorded performance.

The era which gave rise to the landmark cases in this area was a time of "big bands" and live radio shows. A radio station which broadcast recorded music was often in direct competition with the artist who recorded it, and it was in the interest of the performer to prevent the performance of his recordings on radio.⁷² This was the basic controversy in *Waring v. WDAS Broadcasting Station, Inc.*,⁷³ which established the right of a performer to control the use of his "artistic product." The right was held to be one of property at common law, "which in no

68. *Id.* at 232-33 (emphasis added).

69. 139 F. Supp. 176 (S.D.N.Y. 1956).

70. *Id.* at 186.

71. See text accompanying notes 110-11 *infra*.

72. For an expanded discussion of this situation, see Note, *The Right of Public Performance in Sound Recordings*, 15 How. L.J. 452, 459 (1969).

73. 327 Pa. 433, 194 A. 631 (1937); *accord*, *Waring v. Dunlea*, 26 F. Supp. 338 (E.D.N.C. 1939).

way overlaps or duplicates that of the author in the musical composition,"⁷⁴ and is not lost by public sale of the recording.⁷⁵ The opposite result was reached by the Second Circuit in *RCA Manufacturing Co. v. Whiteman*.⁷⁶ There the court held whatever property interest the performer may have had was relinquished by "publication" and sale of recordings.⁷⁷ Fifteen years later, the same court faced a similar question in *Capitol Records, Inc. v. Mercury Records Corp.*⁷⁸ There, *Whiteman* was cited for the proposition that common-law protection ended with the sale of the records.⁷⁹ However, the court ruled that, under *Erie R.R. v. Tompkins*,⁸⁰ New York law must apply, and concluded that the *Whiteman* case no longer reflected the law in New York.⁸¹ By a questionable application of another New York case, *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*,⁸² the majority finally held that the plaintiff retained the right to restrict the sale of defendant's records, even after public sale of its own.⁸³

The *Capitol Records* case actually presented a combination of issues and theories. It was in the nature of an unauthorized duplication case which was decided on the basis of rights in a performance. At the same time, its reliance on the *Metropolitan Opera* case suggests that the controlling rationale was actually a species of unfair competition. For the present discussion, perhaps the only conclusion to be drawn is that *Capitol Records* does little to resolve the conflict between *Waring* and *Whiteman* and does even less to clarify the extent of common-law rights in recordings.⁸⁴

74. 327 Pa. at 441, 194 A. at 635.

75. *Id.* at 444, 194 A. at 636.

76. 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940).

77. 114 F.2d at 88.

78. 221 F.2d 657 (2d Cir. 1955).

79. *Id.* at 663.

80. 304 U.S. 64 (1938).

81. 221 F.2d at 663.

82. 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd per curiam*, 279 App. Div. 632, 107 N.Y.S.2d 795 (1951). See Diamond, *Sound Recordings and Copyright Revision*, 53 IOWA L. REV. 839, 860 n.140 (1968); Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 425-28 (1956).

83. 221 F.2d at 663.

84. The *Capitol Records* case is most often cited for Judge Hand's eloquent dissent, in which he recognized that a performance could be "quite as original a 'composition' as an 'arrangement' or 'adaptation' of the score itself There should be no doubt that this is within the Copyright Clause of the Constitution." *Id.* at 664.

Common-Law Rights in Performance

The fact situations in the previously discussed cases generally involved actual appropriation of the plaintiff's work — his recorded performance. Where rights in a performance, per se, are asserted, the challenged practice is usually imitation. The distinction is more than coincidental. When a performance has been preserved as a recording, its value is best exploited by use of the actual recording. Imitation is likely to occur when, for any reason, the performance itself is not accessible to the infringer.

*Supreme Records, Inc. v. Decca Records, Inc.*⁸⁵ involved an uncopyrighted arrangement which was made and recorded by Decca with the composer's permission, but which was alleged to imitate a similarly authorized and recorded arrangement of the same song by Supreme. After questioning whether any right could be recognized in an arrangement itself,⁸⁶ Judge Yankwich found that, in any event, the plaintiff's arrangement was not sufficiently original to warrant protection and could be imitated by anyone. Although the case involved a musical arrangement, it is most often cited for dictum which is more appropriate to performances in general:

We would have to hold that Mr. Charles Laughton, for instance, could claim the right to forbid anyone else from imitating his creative mannerisms in his famous characterization of Henry VIII, or Sir Laurence Olivier could prohibit anyone else from adopting some of the innovations which he brought to the performance of Hamlet.⁸⁷

Two recent cases have dealt with similar "mirror" recordings specifically as performances. In *Sinatra v. Goodyear Tire & Rubber Co.*⁸⁸ and *Davis v. Trans World Airlines*,⁸⁹ the respective defendants had each purchased from the composer the right to use a popular song in their radio and television advertising. The plaintiffs, Nancy Sinatra and members of the singing group, The Fifth Dimension, each contended that the versions used in defendants' commercials closely imitated their own popular renditions. In each case, the court specifically assumed there

85. 90 F. Supp. 904 (S.D. Cal. 1950).

86. *Id.* at 906-09.

87. *Id.* at 909.

88. 159 U.S.P.Q. 356 (C.D. Cal. 1968), *aff'd*, 435 F.2d 711 (9th Cir. 1970).

89. 297 F. Supp. 1145 (C.D. Cal. 1969).

had been imitation,⁹⁰ but granted summary judgment for defendant, citing *Sears and Compcó*⁹¹ as controlling.

Two other cases, not involving musical, but instead verbal, performances deserve mention. In the first of these, *Lahr v. Adell Chemical Co.*,⁹² the court recognized that an imitation of Bert Lahr's distinctive vocal delivery in a television advertisement was actionable, and reversed the lower court's dismissal of the complaint. The court suggested, however, that the basis for protection was not any kind of property right in Lahr's voice or performance and spoke, instead, in terms of a "mistake in identity," "passing off," "secondary meaning," and plaintiff's "market"⁹³ — all concepts associated with trade identity unfair competition.⁹⁴ This case, then, often cited in support of rights in a performance, might be said to involve actually the misuse of Lahr's "trademark."

A more recent case, *Columbia Broadcasting System, Inc. v. Documentaries Unlimited, Inc.*,⁹⁵ is based on artistic property rights. The defendant had incorporated into its recording approximately one minute of a well-known newscaster's announcement of the assassination of President Kennedy. The court granted summary judgment for the plaintiff, holding that

[a] broadcaster's voice and style of talking is . . . his personality, a form of art expression, and his distinctive and valuable *property*.⁹⁶

Anthony Liebig, who represented defendants in both the *Sinatra* and *Fifth Dimension* cases, capsulized the problem of performers' rights in his observation that "performers have traditionally been considered as persons who render *services* . . ." ⁹⁷ His own commentary on the cases seems to accept this view:

90. 297 F. Supp. at 1147; 159 U.S.P.Q. at 357.

91. See note 45 *supra* and accompanying text.

92. 300 F.2d 256 (1st Cir. 1962).

93. *Id.* at 259.

94. The court's reasoning is identical to the modern analytical approach in cases of trademark infringement:

That which should be prohibited is the unfair act which violates or is likely to invade the intangible individual trade identity, not the trespass upon an imagined property right in any particular word or symbol.

Pattishall, *Trademarks and the Monopoly Phobia*, 50 MICH. L. REV. 967, 987 (1952).

95. 42 Misc. 2d 723, 248 N.Y.S.2d 809 (Sup. Ct. 1964).

96. *Id.* at 725, 248 N.Y.S.2d at 811 (emphasis added).

97. Liebig, *Style and Performance*, 17 BULL. CR. Soc'Y 40, 41-42 (1969).

Indeed, stripped of preconceptions and legal verbiage, *Sinatra* and the *Fifth Dimension* were claiming that intentionally *doing* the same thing in the same manner is unlawful!⁹⁸

If applied to performance rights in general, this approach ignores both economic reality and the general trend of case law. A performance which is recorded takes on the attributes of property: it is a distinct entity which has a definite economic value. Perhaps the only general conclusion which can be drawn from the cases involving performers' rights is that they have inadvertently recognized this fact. "[W]here an actual tape or other recording of the [performance] of the plaintiff has been replayed,"⁹⁹ they have granted relief;¹⁰⁰ where the performance has been simply imitated, they have reached Mr. Liebig's conclusion that imitation of a performance is not unlawful.¹⁰¹

In music, the distinction between property and services is also more the result of history than of logic. At the time the first Copyright Act¹⁰² was passed, composers and musicians actually were household servants, whose standing was "a little above that of the scullery maid and a little below that of the gardener or the gamekeeper,"¹⁰³ and who provided the "service" of entertaining at private social gatherings. Only after music migrated from the private drawing room to the public concert hall, and the composer was recognized in his own right, did the law add musical compositions to the list of protected writings.¹⁰⁴ It was no longer possible to ignore the fact that composers' works were valuable economic *property* which drew royalties, both from performance and publication. The comparison with performers and their recordings, if imperfect, is at least obvious.

The second half of Liebig's argument — that there can be no exclusive rights in a particular *style* of performance — is a stronger basis

98. *Id.* at 46 (emphasis added; entire quotation is emphasized in original text).

99. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 713 (9th Cir. 1970), *aff'g* 159 U.S.P.Q. 356 (C.D. Cal. 1968), *See* note 88 *supra*.

100. *See* cases cited in notes 60-63 *supra*. *See also* Columbia Broadcasting System, Inc. v. Documentaries Unlimited, Inc., 42 Misc. 2d 723, 248 N.Y.S.2d 809 (Sup. Ct. 1964); *Baez v. Fantasy Records, Inc.*, 144 U.S.P.Q. 537 (Cal. Super. Ct. 1964).

101. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970); *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969); *Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904 (S.D. Cal. 1950). *But cf.* notes 92-94 *supra* and accompanying text.

102. Act of May 31, 1790, ch. 15, 1 Stat. 124.

103. G. MAREK, *BEETHOVEN: BIOGRAPHY OF A GENIUS* 18 (1969).

104. Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

for limiting performers' rights. He argues not only that standards of comparison would be unworkable in questions of imitation,¹⁰⁵ but also that freedom to imitate a particular style is essential to the development of any art form.¹⁰⁶ While these may be valid reasons for denying the performer protection against imitation, they do not reach, and should not be applied to deny, the right to compensation for actual use of the recorded performance.

Application of the Common Law to Improvised Music

If, as the cases surveyed suggest, the law generally recognizes rights in a performance where the recorded performance is actually misappropriated, but denies protection against imitation,¹⁰⁷ it would seem the improvising performer is well-protected under the common law. His work exists only as a recording, and he has no real interest in preventing the imitation of his performance.¹⁰⁸ The logic of this conclusion, however, breaks down with the recognition that these "misappropriation" cases arise out of claims of unfair competition. While the improvising performer shares the interest of the recording company in preventing unauthorized duplication of his recordings, his major interest is not in preventing competition. He is mainly concerned with receiving fair compensation for the use of his recorded work.¹⁰⁹ Where the intent of the court is only to prevent an unfair practice, the recognition of a protectible right in a performance appears to be only an intermediate step toward finding that the offender's conduct should be prohibited. It is doubtful that this tenuous "right" in the performance would support a direct claim for compensation.

It is especially doubtful in light of current interpretations of *Sears* and *Compco*. The broadest interpretation of these decisions holds that any "writing" which is not eligible for statutory copyright cannot be protected without subverting the federal scheme of limited protection.¹¹⁰

105. Liebig, *supra* note 97, at 46.

106. *Id.* at 47.

107. See notes 99-101 *supra* and accompanying text.

108. See text accompanying notes 36-39 *supra*.

109. See Note, *The Right of Public Performance in Sound Recordings*, 15 How. L.J. 452, 456 n.15 (1969).

110. The leading example of this view is *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315 (1st Cir.), *cert. denied*, 389 U.S. 1007 (1967). See Comment, *Sound Recordings, Records and Copyright: Aftermath of Sears and Compco*, 33 ALB. L. REV. 371 (1969); Comment, *Copyright Preemption and Character Values: The Paladin Case as an Extension of Sears and Compco*, 66 MICH. L. REV. 1018 (1968).

The narrowest application has been to limit the scope of the doctrine to cases of copying in the strictest sense.¹¹¹ This latter reading has left the courts free to enjoin misappropriation in unfair competition cases. Under the broad application, the clear intent of the copyright regulations to exclude recordings and performances¹¹² will also defeat common-law protection. Even with the narrower application of the doctrine, it would be frivolous to claim that a radio station which legally acquires the recordings, complies with statutory provisions, and pays license fees to a performing rights society, is somehow guilty of misappropriation. In addition, any theory of common-law protection requires court action against the users of the recording, and forces the performer into the uncomfortable position of bringing suit against the hand that feeds him. The situation would discourage the very use of his work for which he seeks compensation.

It is doubtful whether any common-law remedy could be adequate in view of the many interests involved. The problem of compensation demands federal statutory resolution. First, the music industry — recording, radio, and television — is national in scope. A right granted in New York and withheld in California, for example, would create legal chaos for any of the major broadcast networks. Secondly, as a purely administrative matter, the mechanics of collecting and distributing whatever compensation is granted is best handled by a national clearinghouse system like the present performing rights societies.¹¹³ The administrative burden of keeping up with the changing laws of fifty different states would be extremely difficult, at best. In the same vein, almost all broadcasters are presently licensed by at least one of the performing rights

111. The cases involving "tape piracy" cited at note 60 *supra* consistently take this approach.

112. 37 C.F.R. § 202.8(b) (1971). See note 28 *supra*.

113. The performing rights society acts as an agent for the copyright owner, to license the public performance of his works, and to collect royalties from these uses. Under the usual arrangement, the broadcaster or other user purchases a blanket license from the society who, in turn, pays the composer according to an established formula based on the approximate number of uses of his works. These licensing agreements bypass the complicated machinery of the statutory provisions, which would be unworkable with the present nature and scope of the music and broadcasting industries. See generally Blaisdell, *The Economic Aspects of the Compulsory License*, COPYRIGHT LAW REVISION, STUDY NO. 6; Henn, *The Compulsory License Provisions of the U.S. Copyright Law*, COPYRIGHT LAW REVISION, STUDY NO. 5, at 44-52. See note 21 *supra*.

societies,¹¹⁴ and could not be expected to deal individually with separate claims for compensation arising out of the common law.

Finally, and most important, the concept of case-by-case adjudication inherent in any common-law remedy runs counter to the constitutional intent of copyright protection. Copyright exists "[t]o promote the progress of . . . useful arts."¹¹⁵ If this mandate is to be given its literal and intended effect, protection for the artist must be based on a rational system which recognizes the art and defines protection sufficient to, in fact, *promote* the progress of that art. This approach contemplates a scheme of statutory protection. Under the common law, the improvising composer is instead forced to seek makeshift protection under whatever adopted theory seems most promising at the time, and would be hard-pressed to plead "progress of the arts" against a concrete economic interest on the other side. Thus, it appears that if musical improvisation is to be recognized as an art, it must be incorporated into the statutory framework which protects music in general. There is no apparent reason to exclude it, where the only difference between improvised and written music is in the method of creation. The recorded result is original music in either case, and this is certainly within the ambit of the Copyright Act.

IMPROVISED MUSIC UNDER THE PROPOSED COPYRIGHT LAW REVISION

In 1955 the Copyright Office began an extensive program of studies for a general revision of the present copyright statute. By 1961 the studies were completed¹¹⁶ and a report of the Register of Copyrights was issued,¹¹⁷ which incorporated recommendations for the proposed statute. In 1963, discussions of the report were attended by representatives of all the major interest groups involved.¹¹⁸ In 1965 the House of Rep-

114. Blaisdell, *supra* note 113, at 99.

115. U.S. CONST. art. I, § 8, cl. 8, empowers Congress "[t]o promote the Progress of . . . useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings"

116. *See* note 21 *supra*.

117. REGISTER OF COPYRIGHTS, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW (Comm. Print 1961).

118. These discussions were transcribed and published as: REGISTER OF COPYRIGHTS, 88TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, PT. 2, DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW (Comm. Print 1963).

representatives held extensive hearings on the proposed revision bill;¹¹⁹ in 1967 the Senate did the same.¹²⁰ Since then, the “new” copyright statute has been aging in the halls of Congress. In April, 1971 the section dealing with sound recordings found its way to the floor of the Senate as an amendment to the present copyright law and was passed.¹²¹ Senate Bill 646 provides for the addition of sound recordings to the list of “writings” protected by statutory copyright,¹²² but limits this protection

to the right to duplicate the sound recording in a *tangible* form that directly or indirectly recaptures the *actual* sounds fixed in the recording. . . .¹²³

As its title indicates, the bill is for “the purpose of protecting against unauthorized duplication and piracy of sound recordings, and for other purposes.”¹²⁴ A close reading of the bill’s provisions indicates that the “other purposes” do not include compensation for performance of the recordings. The basic inequity between written and improvised compositions remains. The traditional composer still receives compensation both from the sale and performance of his recorded work; the improvising composer still receives nothing from the performance of his recording.¹²⁵ Failure to resolve this problem not only condones and perpetuates the inequity; the reasons behind this failure cast some doubt on the effectiveness of the copyright revision effort.

The first explanation for the bill’s inadequacy is suggested by its title, and was discussed in connection with the unfair competition cases.¹²⁶ The legislative impetus was to prevent an unfair practice — to solve a specific economic problem. It was not the recognition of a “useful art” and its logically connected rights. Long-range foresight is not ordinarily expected of stop-gap legislation, however, and the urgency of the problem might excuse the amendment’s narrow scope, if urgency were its cause. The disturbing fact is that it clearly was not. Senate Bill 646

119. *Hearings on H.R. 4347, H.R. 5680, H.R. 6831, H.R. 6835, Before Subcomm. No. 3 of the House Comm. on the Judiciary, 89th Cong., 1st Sess. (1965) [hereinafter cited as 1965 Hearings].*

120. *1967 Hearings, supra* note 21.

121. 117 CONG. REC. S5939-42 (daily ed. Apr. 29, 1971) (S. 646, with minor changes, was subsequently enacted as Pub. L. No. 92-140 (Oct. 15, 1971)).

122. S. 646, 92d Cong., 1st Sess. § 1(b) (1971).

123. *Id.*, § (a) (emphasis added).

124. *Id.* (title).

125. See notes 26-27 *supra* and accompanying text.

126. See notes 104-05 *supra* and accompanying text.

is almost identical to provisions suggested in the preliminary draft¹²⁷ and incorporated into the basic copyright revision bill.¹²⁸ The sheer volume of work which went into the revision bill suggests, instead, that the sound recording provision represents careful deliberation of the problem. The care with which each section was considered is beyond question. The simple explanation is that the argument for protection of improvised music was never really considered.

At every stage of discussion, the sound recording provisions of the new statute provoked hours of argument and testimony, and a great deal of this time was spent on the question of performance rights for recordings.¹²⁹ However, the discussion was always in terms of "popular" songs and classical music, both of which assume an underlying written composition. The closest improvised music came to being considered in the process was during the Senate hearings.¹³⁰ A few examples of the context in which it was mentioned may explain why it was never considered as an independent form of musical composition.

Alan W. Livingston, president of Capitol Records, presented one of the most convincing arguments for inclusion of a performance right in sound recordings.¹³¹ Part of his testimony included the following:

Another glaring example of inequity involves the highly talented jazz musician whose original *interpretation* of a musical composition is often far removed from the original lines of the copyrighted work. His skilled performance and creative improvisations on what may be an extremely simple theme go unpaid when the jazz musician's record is broadcast; only the writer and publisher of the original theme receive payment when the record is performed.¹³²

Although the argument was excellent for his purpose, it cast the musician entirely in the role of performer and interpreter — not an original creator.

Erich Leinsdorf, then musical director of the Boston Symphony, presented written remarks on the same subject of performance rights

127. REGISTER OF COPYRIGHTS, 88TH CONG., 2D SESS., COPYRIGHT LAW REVISION, PT. 3, PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW (Comm. Print 1964).

128. See, e.g., H.R. 4347, 89th Cong., 1st Sess. (1965).

129. A cursory check of the subject index to any of the discussions and hearings (notes 117-20 *supra*) will indicate the volume of discussion which was addressed to this issue.

130. 1967 *Hearings*, *supra* note 21.

131. *Id.* at 494-510.

132. *Id.* at 498 (emphasis added).

for recordings.¹³³ He stressed the historical and conceptual importance of improvisation in classical performances, but he characterized it in terms of “embellishments” and “filling in harmonies” – again, basically as an interpretation of another’s work:

[I]mprovisation. That’s the key. . . . But it actually goes beyond improvisation, doesn’t it? I mean, you’re engaged in a creative act whenever you interpret a score.¹³⁴

The one clear statement of the problem came from Bobby Troup, a jazz pianist and also a composer. His comments were also directed to the subject of performance rights in recordings, but his presentation of jazz improvisation stressed the creative element:

Jazz is much more than just printed notes. In many cases, it is the complete lack of printed notes. The creativity of jazz is what jazz is all about. It is the taking of the bare “framework” of a tune – the basic chord progressions – and then using this skeleton to weave an original melody that becomes a creation in itself. This is a creation that belongs to only one individual: the musician who created it.¹³⁵

The only discussion which followed Mr. Troup’s testimony concerned one of his *written* songs and the performer who popularized it.¹³⁶ Apparently, the concept of an original composition which remained unprotected was overshadowed by the general subject before the committee. It is not entirely irrelevant to this observation that Mr. Troup was preceded by Julie London singing the “Mickey Mouse Club” song, as an example of a performer’s creative interpretation.¹³⁷

Had the final version of the bill included the exclusive right to perform the copyrighted recording, as these witnesses advocated, jazz and improvised music would have been adequately protected under the proposed revision. However, the performance right was specifically excluded,¹³⁸ and with it, any meaningful protection for improvised music. It should not be assumed from this discussion, however, that the absence

133. *Id.* at 820-22.

134. *Id.* at 821.

135. *Id.* at 829-30.

136. Mr. Troup was the composer of a then recent “hit” – “Route 66”, which was made popular by Nat “King” Cole. *See id.* at 831.

137. *Id.* at 818-19.

138. “The exclusive rights of the owner of copyright in a sound recording . . . do not include any right of performance” S. 597, 90th Cong., 1st Sess. § 114(a) (1967).

of protection was entirely accidental. Strong opposition to performance rights in recordings has been entered, and before proceeding to discuss solutions, these objections and their possible applicability to improvised music should be considered.

ARGUMENTS AGAINST COPYRIGHT FOR IMPROVISED MUSIC

The traditional argument against copyright for performances in general is that they are not "writings" within the meaning of the Constitution. The argument has not been urged with any regularity since Judge Hand's famous dissent in *Capitol Records, Inc. v. Mercury Records Corp.*,¹³⁹ but it does retain some vitality. Perhaps the best reply is found in the official copyright studies:

Since the object registered with the copyright offices is a paper [with] written notations thereon, it is possible without too much distortion of the word to consider a musical composition a type of writing. . . .

However, it is difficult to say that the notations on paper are really the essence of musical compositions as such notations probably are with respect to literary productions. . . .

It would seem . . . that the subject matter actually protected is the sound and not the "writings" on the paper.¹⁴⁰

If the argument that a performance is not a writing were pushed to its logical source, one would be forced to deny protection to all music and visual arts. In 1778, the "useful arts" consisted only of writings in the literal sense; music and visual arts were generally considered as entertainment and decoration, respectively.¹⁴¹ In this light, the extension of the scope of copyright protection is better seen as a redefinition of "useful," and not a formalistic expansion of the term "writings."¹⁴²

A second argument leveled against copyright in performance is that they create a multiple copyright, or a "copyright on a copyright," diluting the composer's rights and creating confusion.¹⁴³ Improvisation, by itself, avoids this argument, as it is assumed the improvised performance is an independent creative work. Even if it were not, section 7

139. 221 F.2d 657, 664 (2d Cir. 1955). See note 80 *supra*.

140. Derenberg, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, COPYRIGHT LAW REVISION, STUDY NO. 3, at 101-02. See note 21 *supra*.

141. See G. MAREK, *BEETHOVEN: BIOGRAPHY OF A GENIUS* (1969).

142. See generally Derenberg, *supra* note 140.

143. See Diamond & Adler, *Proposed Copyright Revision and Phonograph Records*, 11 AIR L. REV. 29, 50 (1940).

of the present Copyright Act provides a list of just such multiple copyrights which have been a workable part of the law for at least sixty years.¹⁴⁴

During hearings on revision, the major arguments against performance rights in sound recordings were economic, and they came from the primary user of recordings for profit, the broadcast industry.¹⁴⁵ The core of the argument was essentially the multiple copyright argument. Broadcasters were already paying royalties to the composer for every performance of his recorded work, and they argued that an *additional* royalty to performers for their work would be economically prohibitive.¹⁴⁶ The basic answer to this type of argument has been offered:

That someone must pay, does not justify denying protection where it is otherwise merited; indeed, the same argument used against performing rights in sound recordings applies equally to music; if there was no obligation upon the part of broadcasters . . . to obtain licenses to play musical compositions, advertising rates and consumer prices might not be at their present levels.¹⁴⁷

This argument is again avoided by the fact that the improvising composer and performer are the same person.

Broadcasters further argued that radio and television exposure encourages sales of records.¹⁴⁸ While this is undeniably true for "hits," it ignores the fact that a creative artist must survive longer than his popularity. The *performance* right in written music, as a practical matter, guarantees the composer some income during those times when he has no income from *sales*. In this respect, the performance right is especially important to the jazz musician, whose market has always been relatively limited.

Another objection offered was that under standard recording contracts, performers already receive dual compensation — once for their services in making the recording, and afterward, a percentage of every

144. "Compilations or abridgements, adaptations, arrangements, dramatizations, translations . . . shall be regarded as new works subject to copyright" 17 U.S.C. § 7 (1964).

145. See 1967 *Hearings*, *supra* note 21, at 863-74 (statement of Douglas A. Anello, General Counsel, National Association of Broadcasters).

146. *Id.* at 866-67.

147. Helfer, *Copyright Revision and the Unauthorized Duplication of Phonograph Records—A New Statute and the Old Problems: A Job Half Done*, 14 BULL. CR. SOC'Y 137, 164 (1966).

148. Statement of Douglas A. Anello, *supra* note 145, at 865-66.

sale of the record.¹⁴⁹ This can be answered simply by considering either the royalties as deferred compensation for the recording session, or the initial payment as an advance on royalties. The objection is more complex, however. It asserts that the performer is free to bargain for these rates, while the composer is forced to allow anyone to record his work, and is then restricted to the statutory rate of the compulsory license provision.¹⁵⁰ This argument seems to be directed more at inequities in the existing provisions than against proposed rights for performers. It also ignores the fact that, notwithstanding deficiencies in the statute, the composer is guaranteed compensation by federal statute. The performer's ability to "bargain" depends entirely on his popularity and value to the recording company, or on the successful negotiations of his union. When applied to improvised performances, the objection becomes especially weak. The composer of a written song is certainly free to bargain for his initial fee, and where the improvising performer is, by definition, the composer, there is no reason why he should not be allowed the same right.

A final argument which was never openly stated, but was implied throughout the discussions and hearings,¹⁵¹ suggests there is simply no need to protect the performer, and points to the wealth of popular performers. The irrelevance of this argument becomes evident if it is applied to equally successful composers who *are* protected by the copyright law. The successful creator has little need for copyright protection; his bargaining position and compensation are secured by his popularity. The most creative artists, on the other hand, are often ahead of their time and are seldom popular. If the copyright clause of the Constitution is to be given its literal effect — if the progress of the arts is to be promoted — it is the innovative creator who most needs the protection of copyright. In the case of the improvising composer, this can be done only by recognizing the same exclusive rights in his recording as are guaranteed in written musical works.

The arguments from users of recordings were the strongest influence in preventing the inclusion of performance rights for sound recordings,¹⁵² and thus denying improvised music any meaningful coverage under the proposed revision. The paradox — that none of the arguments can be seriously applied to improvised music — is compounded by the

149. *Id.* at 868.

150. *Id.*

151. See, e.g., 1967 Hearings, *supra* note 21, at 831-32.

152. See 1965 Hearings, *supra* note 119, at 1863.

fact that, at present, this is the only section of the revision effort that has a good chance of becoming law.* Had improvisation been presented as a legitimate form of musical composition, instead of in its secondary role as a performance, this sub silentio denial of protection might have been avoided.

A POSSIBLE SOLUTION

The most difficult problem in defining protection for improvised music is deciding what will be called an improvised work, and what will be regarded as simply creative performance. The logical solution is, of course, to provide full copyright in *all* recorded performances. Even if the immediate economic interests of the broadcast and music industries continue to prevent this, a satisfactory solution may still be written into the proposed Copyright Act.

As a first step, the statutory provisions must be shaped to reflect the unique position of an improvised work: an independent musical composition which has continuing existence only as a recording. This may be easily accomplished either by expanding the present proposed sections governing musical works and sound recordings, or by creating a separate and distinct category, if necessary. The scope of protection can then be codified to include only those rights which involve the use of the actual recorded performance, without seriously infringing the legitimate interests of the composer-performer.¹⁵³ Such limitation will also avoid the practical problems of deciding what use constitutes an imitation of a performance.¹⁵⁴

The only major conflict to be resolved arises when an essentially improvised work is based on a written theme which is already copyrighted. Who should receive royalties for performance of the work—the theme's composer, or the improvising performer? In such a case, the greatest creative effort is contributed by the improviser, but if use of a copyrighted popular theme helps to enlarge his audience, and thus increase sales and performances of his recording, some division of performance royalties is certainly warranted. The easiest solution is to divide the royalty equally between the theme's composer and the performer-composer.

The apparent flaw in this total proposed scheme is that any performer could claim that his rendition was improvised, and thus share

* See ed. note accompanying note 121 *supra*.

153. See text accompany note 39 *supra*.

154. See note 105 *supra* and accompanying text.

royalties with the composer. This problem may be avoided by defining an *improvised* work as one in which not more than a certain percentage of the work, based on playing time of the recording, consists of previously copyrighted music. This suggestion undoubtedly conjures up nightmares of an army of reviewing clerks listening to every recording and passing subjective judgment on each. In fact, it is not the function of the Copyright Office to determine whether statements of fact in the application for copyright are true, or to resolve conflicting claims. The claim to copyright is simply registered if it is complete and valid on its face. The party who is injured by an invalid or fraudulent claim will then challenge the purported copyright in the courts.¹⁵⁵ Under the suggested solution, the improvising composer could assert his compliance with this proposed "improvised work" provision by signing a short printed affidavit or completing an additional line on the form application for registration of copyright. If such a claim is fraudulent or otherwise invalid, the composer of the previously copyrighted music, who stands to lose half the royalties to which he would be otherwise entitled, can be expected to challenge the registration exactly as he would if there were *written* infringement of his work.

If these or similar provisions were adopted, improvised compositions would receive essentially the same protection as written music, while performances which are only interpretive would be excluded. Until such time as performance rights in all recordings are recognized, this approach offers distinct advantages. From a theoretical view, it offers a broad and flexible approach, amenable to any recorded sound which might in the future be called music. As a practical matter, it can be incorporated into the existing structure of the industry with minimal disruption of established practices.¹⁵⁶ The broadcasters and other users of recorded music will be paying more only to the extent that they will finally be required to pay for performance of original improvised works. In all other cases, they will continue to pay the same amounts, and the performing rights society can divide royalties between composer and improviser where both are involved in a work. The composer of written music will lose compensation only where his contribution to an improvised work is minimal. The improvising composer will finally be guaranteed fair compensation for his work.

155. See Berger, *Authority of the Register of Copyrights to Reject Applications for Registration*, COPYRIGHT LAW REVISION, STUDY NO. 18, at 93-94. See note 21 *supra*.

156. See note 109 *supra*.

Whatever solution is adopted, it must be more than a limited response to an immediate problem. The inequality of protection between written and improvised music has existed as long as there have been recordings, and must be attributed, in large part, to the restricted scope of the early recording provisions of the law. Perhaps the increasing popular appeal of improvisation and the opportunity of a still-pending copyright law revision will combine to remedy this situation. Music itself was not extended the protection of copyright until four years after Beethoven's death. With the passing of America's "Ambassador of Jazz," the time seems ripe to recognize improvised music as a "useful art."

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. United States of America and Territories

63. U.S. BUREAU OF CUSTOMS.

[CFR] Title 19 — Customs duties. Chapter I — Bureau of Customs, Department of the Treasury. [T.D. 72-266]. Trademarks, trade names, and copyrights. September 21, 1972. *Federal Register*, vol. 37, no. 192 (Oct. 3, 1972), pp. 20677-20683.

These revised rules provide for the recordation of trademarks, trade names and copyrights with the Bureau of Customs for the purpose of prohibiting the importation of certain articles. They also set forth procedures for the disposition of articles bearing prohibited marks or names and copyrighted or piratical articles, including release to the importer in appropriate circumstances. The regulations are a simplification and clarification of the 1961 regulations, with some existing practices given regulatory sanction. A new schedule of fees for certain services involved in the recordations has been included.

64. U.S. CONGRESS. HOUSE.

Copyright protection in certain cases. *Congressional Record*, vol. 118, no. 163, pt. 2 (daily ed. Oct. 11, 1972), pp. H9617-H9622.

The House debates on the copyright extension bill, S.J. Res. 247, which was passed by a record vote of 208 yeas to 92 nays. The measure was signed by the President on October 25 and became Pub. L. 92-566.

65. U.S. CONGRESS. HOUSE. *Committee on the Judiciary*.

Copyright protection in certain cases. Report together with dissenting views, to accompany S.J. Res. 247. Submitted by Mr. Celler, September 26, 1972.

6 p. (92d Cong., 2d Sess., H.R. Rep. No. 92-1449).

The eighth in a series of interim extensions to continue temporarily the renewal term of expiring copyrights, pending enactment

of a general revision law, is reported favorably to the House, but with "Dissenting views of Honorable Robert W. Kastenmeier, and concurrence therein by Hon. Don Edwards, Hon. John Conyers, Jr., and Hon. Robert F. Drinan."

66. U.S. FEDERAL COMMUNICATIONS COMMISSION.

FCC letter of intent re cable TV regulation. FCC 71-787. 63303. August 5, 1971. *Performing Arts Review*, vol. 3, no. 1 (1972), pp. 97-146.

A summary of the Commission's proposals for the "near-term regulation" of cable television resulting from "an intensive study of the issues, balancing all the equities," with a dissenting statement by Commissioner Robert Wells.

2. Foreign Nations

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

Copyright (Amendment) Act 1971. (Of February 17, 1971). *Copyright*, vol. 8, no. 9 (Sept. 1972), p. 179.

This amendatory Act makes provisions for the review by the Performing Right Tribunal of an order made by the Tribunal in a proceeding under the second two of the three categories mentioned in Part IV of the Copyright Act 1956, such review being possible previously only for a proceeding under the first category.

68. GREAT BRITAIN. *Privy Council.*

The Copyright (International Conventions) Order 1972. (No. 673, of April 28, 1972, coming into force on May 31, 1972). *Copyright*, vol. 8, no. 9 (Sept. 1972), pp. 180-183.

"This Order revokes the Orders mentioned in Schedule 8 (being Orders providing for the protection, in the United Kingdom and the countries to which the Copyright Act 1956 has been extended, of works and other subject-matter originating in other countries party to international copyright conventions) and re-enacts the revoked provisions with minor modifications.

"The Order also takes account of —

- (a) the accession of Fiji to the Berne Union, the Universal Copyright Convention and the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations,

- (b) the confirmation by Mauritius of its adherence to the Universal Copyright Convention and
- (c) the fact that Western Samoa is no longer a member of the Berne Union.

“Parts I and II of the Order are extended to the countries named in Schedule 6, being countries in which the Copyright Act 1956 is in force by virtue of Orders in Council made under that Act. In the case of Bermuda and Gibraltar Part III of the Order, which relates exclusively to sound and television broadcasts, is also extended (with modifications).”

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

Performers' Protection Act 1972. 1972 chapter 32. [29th June 1972]. An Act to amend the Performers' Protection Acts 1958 and 1963. 3 p. (Elizabeth II, c. 32).

This amendatory act, which came into force on July 29, 1972, has the effect of increasing the penalties for offenses specified in the 1958 and 1963 acts.

70. HUNGARY. *Laws, statutes, etc.*

Decree No. 9, of December 29, 1969, concerning the implementation of the Copyright Act No. III of 1969. (Article 56(3)). *Copyright*, vol. 8, no. 10 (Oct. 1972), pp. 201-205.

“Published in *Magyar Közdöny* of December 29, 1969, the Decree came into force on January 1, 1970. WIPO translation.”

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions.

71. *Hayden Publishing Co., Inc., et al. v. Van Valkenburgh, Nooger & Neville, Inc.*, 175 USPQ No. 4 at II (U.S. Sup. Ct., October 10, 1972). For decisions below, see *Van Valkenburgh, Nooger & Neville, Inc. v. John F. Rider Publisher, Inc.*, 16 BULL. CR. SOC. 134, Item No. 85 (Sup. Ct. N.Y. Co., 1968), affirmed in part and modified in part, sub. nom., *Van Valkenburgh, Nooger & Neville, Inc. v. Hayden Publishing Company, Inc.*, 33 AD2d 766 (N.Y. Sup. Ct., App. Div. 1st Dept., 1969), 17 BULL. CR. SOC. 438, Item No. 228 (1970), affirmed, 173 USPQ 740 (N.Y. Ct. App. 1972), 19 BULL. CR. SOC. 413, Item 262 (1972).

Petition for writ of certiorari.

Held, denied.

72. *Picture Music, Inc. v. Bourne, Inc.*, 175 USPQ 577 (U.S. Sup. Ct., Nov. 6, 1972). For decisions below, see 457 F2d 1213, 173 USPQ 449 (2d Cir., 1972), 19 BULL. CR. SOC. 312, Item 195 (1972), affirming, 314 F. Supp. 640, 167 USPQ 348 (SDNY, 1970), 18 BULL. CR. SOC. 324, Item 251 (1971).

Petition for writ of certiorari.

Held, denied.

73. *U.S. v. American Society of Composers, Authors and Publishers*, 442 F. 2d 601 (2d Cir., May 7, 1971) (Hays, J.).

Action under the ASCAP consent decree.*

In 1969, the Columbia Broadcasting System and the American Broadcasting Company reached an agreement with ASCAP on fees to be paid for their respective use of ASCAP music since 1962. ASCAP decided

* In 1941 the Government brought an anti-trust action against ASCAP. The action was concluded by a consent decree which, as subsequently amended, governs ASCAP's licensing practices.

(with judicial approval) to include the funds received in its regular 4th-quarter 1970 distribution to its members; appellants argued that such funds should be distributed under a special scheme for ASCAP members whose works were performed from 1962 to 1969.

The lower court enjoined appellants from prosecuting their claim in the California state courts and approved ASCAP's distribution.

Held, affirmed in part and reversed in part.

1. *Injunction*. Noting that "a variety of state court decisions would tend to violate the anti-trust policy of the consent decree", the court affirmed the district court's injunction against the bringing of the distribution challenge in the California state courts.

2. *Distribution*. The court held that appellants should be given the opportunity to propose methods of distribution alternative to that decided upon by ASCAP "and that the district court should make every attempt on the basis of such proposals, and of its own expertise, and with the assistance of [the Government], to work out a plan of distribution more equitable to appellants' class."

74. *Duchess Music Corporation, et al. v. Rosner, d/b/a National Manufacturing Company*, 173 USPQ 278 (9th Cir., March 13, 1972) (Choy, J.), reversing sub. nom., *Duchess Music Corporation, et al. v. Stern, et al.*, 331 F. Supp. 127, 170 USPQ 391 (D. Arizona, 1971), cert. denied, 175 USPQ No. 4 at II (U.S. Sup. Ct., Oct. 10, 1972).

Plaintiffs' appeal in action for copyright infringement. Plaintiff music publishers sought to enjoin defendant from electronically duplicating ("disklegging") sound recordings embodying their copyrighted musical compositions. In commencing the action, plaintiffs obtained seizure of thousands of defendant's completed recordings, blank tapes, printed labels, packaging and promotional materials, and sound transfer equipment.

Defendant Rosner contested the scope of seizure, and also argued that injunctive relief was unavailable since, after seizure but before hearing, she filed a Notice of Intent to Use plaintiff's compositions and was thus entitled to record them under the compulsory license provisions of the Copyright Act.

The lower court granted Rosner's motion for return of property improperly seized and held she was entitled to exercise the compulsory license.

Held, reversed.

1. *Seizure.* The lower court held that seizure was limited to materials specifically identifiable to infringing materials and, while allowing impoundment of recordings of plaintiffs' works and packaging and promotional materials referring thereto, ordered return of defendant's recording equipment, blank tapes and unmarked labels and packaging materials.

The Court of Appeals, noting that the Copyright Act refers to impounding of "all articles alleged to infringe a copyright" and destruction of "all . . . infringing copies or devices, as well as plates, molds, matrices, or other means for making such infringing copies . . .", disagreed and ordered continued impounding of all materials seized.

The court said:

The language used throughout the Supreme Court rules which implement these provisions is not uniform and there is some verbal confusion about what is to be seized and destroyed. But the statutory mandate is clear.

. . . .

There is no reason here to apply the statutory construction rule of *eiusdem generis* to narrow the items to be impounded and destroyed to the general class of plates, molds, and matrices, that is, to items embodying an identifiable impression of the copyrighted work. The statute and Supreme Court rules provide for the impoundment and destruction of three classes of items: (1) infringing copies; (2) plates, molds, matrices, etc.; and (3) other means for making the allegedly infringing copies. If *eiusdem generis* is applicable here, it is applicable to construe the word "etc.," not the words "other means for making such infringing copies." Machines, blank cassettes and cartridges, blank and printed labels, and other devices are "other means" for making infringing copies to appellants' copyrights. They fall within the scope of both the statute and the rules and were properly impounded.

In dealing with copyright infringers, Congress did not halt at injunctive and monetary relief. It prescribed impoundment and destruction. While the Joint Committee reporting the proposed Act did not elaborate on these remedies, they were often discussed in extensive hearings before the Joint Senate and House Committee, held in June and December, 1906, and March, 1908. Congressmen, supporters, and opponents of the copyright bill agreed that the impoundment and destruction provisions were sweeping in their scope,

and encompassed machines and items which could be used for other, allegedly innocent purposes.

2. *Compulsory License*: The lower court held, reluctantly, that nothing in the Copyright Act precluded “pirates” — i.e., unauthorized duplicators of prior recordings — from utilizing the compulsory license provisions to acquire mechanical rights in the recorded compositions. The Circuit Court disagreed, concluding that pirates do not make a “similar use” within the meaning of those provisions. The court said:

The statute provides that anyone who properly invokes the license provision “may make *similar use* of the copyrighted work.” (emphasis supplied.) Rosner admits that she duplicates appellants’ copyrighted compositions. She does not make “similar use” of them, she makes exact and identical copies of them. This is clearly outside the scope of the compulsory license scheme.

In *Aeolian Co. v. Royal Music Roll Co.*, 196 F. 926 (W.D. N.Y. 1912), a piano roll manufacturer having a license to use certain copyrighted musical compositions on its perforated rolls sought an injunction against a competitor who was duplicating the rolls. In granting the injunction, the court said,

“The provision of the statute (section 1e) that ‘any other person may make similar use of the copyrighted work’ becomes automatically operative by the grant of the license; but the subsequent user does not thereby secure the right to copy the perforated rolls or records. He cannot avail himself of the skill and labor of the original manufacturer of the perforated roll or record by copying or duplicating the same, but must resort to the copyrighted composition or sheet music, and not pirate the work of a competitor who has made an original perforated roll.” At 297.

Defendant argued that duplication of the prior recordings was sanctioned under *Sears* and *Compco*, but the court held that these cases:

... do not sanction Rosner’s outright appropriation, in violation of copyright, of the actual performances contained on appellants’ records. Rosner may, of course, record appellants’ songs, when she hires musicians, artists, and technicians. Instead, she steals the genius and talent of others. She deceives others into thinking that her tapes represent her own work. She has no “right to copy.”

3. Judge Byrne, arguing that the Copyright Act does not preclude duplication of sound recordings *per se** but applies only to the recorded musical composition which are subject to compulsory license, dissented.

75. *National Council of Young Israel, Inc. v. The Feit Company, Inc.*, 175 USPQ 351 (S.D.N.Y., September 13, 1972) (Weinfeld, J.).

Action for infringement of copyright in plaintiff's predecessor's (herein "plaintiff") sewing machine part catalogs. Defendant published photographic copies of certain apparatus originally appearing in plaintiff's catalogs.

Held, judgment for plaintiff.

The court held that plaintiff had not "abandoned" its copyright merely because one of its customers had reproduced plaintiff's catalog material without copyright notice. After noting that plaintiff had granted permission to its customers to "borrow" from its catalog, upon condition that notice be used, the court said (footnotes omitted):

It is well established that abandonment of rights gained under the copyright law must be evidenced by some overt act indicating a purpose to surrender the rights and to allow the public to copy. The fact that a copyright owner in its own interest and to gain the favor of its customers and their good will grants permission to use copyrighted material upon conditions that its rights be protected by the grantee's proper copyright notice by no means manifests a purpose to abandon one's copyrights — to the contrary, it indicates a positive and continuing purpose to maintain one's rights. So, too, the fact that [plaintiff] published and distributed all its materials with copyrighted [sic] notice affixed, clearly indicates a purpose to preserve its copyrights.

That [one of plaintiff's customers] violated the term of its permission to use [plaintiff's] copyrighted material does not reflect an intent by [plaintiff] to abandon its rights; indeed there is no basis for any claim that [plaintiff] was in any way responsible for the absence of copyright notices on [its customers'] publications, nor does the fact that it failed to police [its customers] to assure that it observed the terms of the grant indicate a purpose to surrender its copyrights.

* The instant action arose prior to the effectiveness of the recent amendment to the Copyright Act providing for a limited copyright in the sounds comprising a sound recording [ed.].

Finally, the [customer's] catalog contained hundreds of illustrations other than those in suit which constitute much new matter. 17 U.S.C., section 7 provides that the republications of works with new matter "shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof . . ." Thus, the publication of the Kennedy catalogs without the copyright notice did not work a forfeiture of Unity's copyrights of the items included in the Kennedy publication. In sum, the defendants have failed to establish that plaintiff by any affirmative or overt act on its part manifested an intention to abandon its copyrights.

76. *M. & M. Business Forms Corporation v. Uarco, Incorporated*, 175 USPQ 159 (S.D. Ohio, May 18, 1972) (Kinneary, J.). See also, *Donald v. Uarco Business Forms, Item 77, infra*.

Action for copyright infringement in certain textual "guarantee", "chattel mortgage" and "storage fee" provisions of a television service agreement form. (In an unreported decision, the court had previously held that "the arrangement of vertical and horizontal lines on a business form is not copyrightable.")

Held, judgment for defendant.

The court found that plaintiff's agreement forms were not sufficiently distinguishable from prior television service forms to possess even the minimal degree of originality required for copyright. The court said, in part:

As to the degree of originality necessary to sustain the copyright, the Court is aware of the cases holding the standard to be one of little more than a prohibition against copying. . . . The Court is in agreement with the statement of the law by the Fifth Circuit in *Donald v. Zack Meyer's T.V. Sales and Service* [426 F.2d 1027 (5th Cir. 1970)], where the Court said:

* * * Nevertheless, something more than merely refraining from outright copying is required before a new variation on an old work has sufficient originality to be copyrightable. The author must add "some substantial, not merely trivial, originality." . . . The variation must be meaningful and must result from original creative work on the author's part. . . .

Thus, the familiarity of [plaintiff's president and attorney] with the earlier television service forms and [plaintiff's attorney's] use of

forms and contracts present in his law office do not in and of themselves preclude plaintiff's Electronic Service Contract from being copyrightable. The plaintiff, however, must show existence of the requisite originality. . . .

Plaintiff does shoulder the burden of proving the validity of his copyright. . . . However, the obtainment of a copyright registration certificate . . . in effect means that a plaintiff in a copyright infringement action based upon a statutory copyright is entitled to a prima facie assumption of originality since among the facts to be set forth in the certificate is a statement of the authorship of the work and authorship connotes originality. Upon proof by the defendant of the plaintiff's access to similar prior works, the burden of proving originality shifts back to the plaintiff. . . .

The "Guarantee" provision of the plaintiff's Electronic Service Contract is not subject to copyright protection, because it does not possess the requisite originality. The plaintiff has failed to show that a distinguishable variation exists between the language of this provision and the language of [prior agreements].

[Plaintiff's president] had [prior forms] in his immediate possession during the period in which he drew up the "Guarantee" provision. He did not, by his own creative efforts, add a distinguishable variation. . . .

The "Chattel Mortgage Provision" of the Electronic Service Contract is not subject to copyright protection because it does not possess the requisite originality.

[Plaintiff's attorney's] testimony was that in preparing the "Chattel Mortgage Provision" he utilized similar contracts that were present at his law office and that he inserted wording of his own. The end product is a common garden variety chattel mortgage which vests title to the particular merchandise in the dealer in the eventuality that the customer defaults on his obligation to pay. [The attorney] admitted that he took the phrase "security interest" from the Michigan Uniform Commercial Code and that he had [a prior form] in his file at the time of preparation of the provision. The Court has searched but cannot find a distinguishable variation, which is more than not merely trivial, between the "Chattel Mortgage Provision" in the Electronic Service Contract and the [prior form].

The "Storage Fee Provisions" . . . allows the dealer to dispose of a particular piece of merchandise if the customer does not claim it within sixty days from the performance of the services on it and to charge the customer a per diem fee for leaving the merchandise with the dealer over sixty days. There has been no creative and

meaningful original work distinguishing this simplistic legal arrangement from that which is presently subsisting in the public domain.

77. *Donald v. Uarco Business Forms*, 175 USPQ 181, 344 F. Supp. 338 (W. D. Arkansas, June 19, 1972) (Williams, J.).

Defendant's motion for judgment notwithstanding a jury verdict for plaintiff in action for copyright infringement in certain provisions of a television service agreement. *Held*, motion granted for lack of originality. The court noted that "[t]he provisions under consideration in the *M & M Business Form* case [digested at Item 76, *supra*], found lacking in the originality necessary for copyright . . . [are] very similar to the 'Agreement' at issue herein. Plaintiff has cited no case in which the copyright on a form having no more originality than the plaintiff's 'Agreement' has been upheld by any court."

2. The Patent Office.

78. *Clamage Industries Ltd. v. Glendinning Companies, Ltd.*, 175 USPQ 362 (Pat. Off. Tm. Trial & App. Bd., April 20, 1972) (Bogorad, Acting Member).

Petition to cancel a service mark registration for the designation "Beat The Dealer" for services related to promotional games. Petitioner alleged that it owned copyright in a game bearing the name "Beat the Dealer". *Held*, petition dismissed: ". . . it is the prevailing law that ownership of a copyright confers no trademark rights on the copyright owner and therefore provides no proper basis for contesting the right of another to register a trademark. That is to say, petitioner owns no trademark rights in the term 'BEAT THE DEALER' simply by virtue of his ownership of a copyright for a game bearing these words as the name thereof. . . . Furthermore, the courts have unanimously held that the sole means for protecting a federally registered copyright from infringement is an action for copyright infringement in an appropriate federal district court."

3. State Court Decisions.

79. *Jet Air Freight v. Jet Air Freight Delivery, Inc., et al.*, 175 USPQ 298 (Fla. Dist. Ct. App., June 13, 1972) (Per Curiam).

Action to enjoin use of trade name. In affirming the lower court's judgment for plaintiff, the appellate court said, in part: "Repeal of statutes by implication are not favored. In this setting we cannot find an implied repeal of federal copyright law or the common law of trade names by the passage of the federal aviation laws."

4. Also of Interest.

80. *The Troxel Manufacturing Company v. Schwinn Bicycle Company*, 175 USPQ 65 [6th Cir., August 11, 1972).

Appeal from summary judgment for plaintiff in action to recover royalties paid under a license agreement prior to adjudication of invalidity of the licensed design patent.

Held, reversed.

The Court held that the Supreme Court's decision in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969) did not mandate the "offensive" assertion of patent invalidity to recover royalties already paid. The court felt that a contrary rule would defeat the public interest in early adjudications of patent validity and discourage recourse to the patent system (and its consequent public disclosure) and patent licensing. The court said, in part:

The precise holding of *Lear* was that a licensee was not estopped to interpose the invalidity of the licensed patent as a defense to an action brought by the licensor to enforce the license agreement. . . .

The Court reached its decision through extended consideration of the effect of federal patent-antitrust policy on traditional contract law concepts. The conflicting policies involved were placed in sharp focus:

"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."

. . . . Recognizing that it was seeking "an acceptable middle ground" which would "accommodate the competing demands of the common law of contracts and the federal law of patents," *id.*, the Court found that:

"[T]he equities of the licensor do not weigh very heavily when they are balanced against the important public interest to permitting full and free competition in the use of ideas which are in reality a part of the public domain.

With this background we turn to the question of whether a license agreement voidable under *Lear* is void *ab initio* entitling

the licensee to recoup royalties already paid. In *Lear* the respective equities of licensee and licensor were balanced in light of the public interest. . . .

“Licensees may often be the only individuals with enough economic incentive to challenge the patentability of an inventor’s discovery. If they are muzzled, the public may continually be required to pay tribute, to would-be monopolists without need or justification.” . . .

A.

A rule that licensees can recover all royalties paid on a patent which later is held to be invalid would do far more than “unmuzzle” licensees. It would give the licensee the advantage of a “heads-I-win, tails-you-lose” option. *Lear* states that it is in the public interest to encourage an early adjudication of invalidity of patents. Application of the holding of the District Court could defeat early adjudication of invalidity and encourage tardy and marginal litigation. If the licensee could recover royalties paid (subject to any statute of limitations) on the basis of an adjudication of invalidity accomplished by another litigant, without incurring the expense or trouble of litigation, there would be less inducement for him to challenge the patent and thus remove an invalid patent from the competitive scene. He would be more likely to wait for somebody else to battle the issue because he would have nothing to lose by the delay.

Rather than stimulating early litigation to test patent validity, such an interpretation of *Lear* would make it advantageous for a licensee to postpone litigation, enjoy the fruits of his licensing agreement, and sue for repayment of royalties near the end of the term of the patent. When a licensed patent is about to expire and the threat of injunction no longer exists, a licensee would have little to lose in bringing an action to recover all the money he has paid in royalties on the ground of the invalidity of the patent. The licensee would have a chance to regain all the royalties paid while never having been subjected to the risk of an injunction. Such an interpretation of *Lear* would defeat one of the expressed purposes of the court in announcing that decision.

B.

Further, the interpretation of *Lear* adopted by the District Court inevitably would discourage the licensing of patents. A patent is a

form of intellectual property. The licensing of patents is a business of considerable magnitude.

Under the decision of the District Court, any person who has licensed his invention or patent would have a continuous cloud over any payment of royalties made to him. The cloud might take the form of limiting his credit because of contingent liability. He would be compelled to retain all royalties received in a relatively liquid state until the expiration of the licensed patent, or the running of the applicable statute of limitations. If the licensor should put royalties to work by investing them, a subsequent requirement of repayment could result in the sudden disruption of the investment. The royalties would be taxable to the licensor as ordinary income. *See Fawick v. Commissioner*, 436 F.2d 655 (6th Cir. 1971). Thus royalties from patent licenses, being currently taxable but not distributable as profits or usable to operate or expand a business, could constitute a burden on all except the largest and most wealthy licensors. It is entirely logical to anticipate that the owner of more than one patent would demand higher royalties for each in order to hedge against the possibility that royalties received under one patent might be returned to licensees.

C.

An even more serious consequence of requiring royalty refunds with respect to patents held to be invalid is that it would deter inventors from resorting to the patent system in the first instance. The framers of the Constitution recognized the importance of promoting progress of science and the useful arts. (U.S. Constitution, Art. I, § 8, Cl. 8). They also recognized that it was important to encourage invention and the public disclosure of inventions to "add to the sum of useful knowledge." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

Soon after making a discovery, an inventor must decide whether to protect his invention by a patent or to maintain it as a trade secret. It is public policy to encourage the disclosure and public use of ideas as opposed to the maintenance of trade secrets. The exclusive rights conferred by a patent grant are designed not only to encourage invention, but more importantly, to disclose the invention to the public. It is through disclosure that others will be given the opportunity to improve on the invention. If an inventor must face the possibility of refunding all patent royalties collected by him, he may be encouraged to keep secret an invention which otherwise might have been disclosed through the patent process.

81. *Hozer v. Paramount Pictures, et al.*, not yet reported (N.J. Super. Ct., July 26, 1972) (Trautwein, J.) (Oral Opinion).

Motion for preliminary injunction in action for invasion of privacy. Plaintiff complained of a certain photograph of himself which was included, without his consent, in the motion picture "The Godfather." The photograph depicted plaintiff, along with several other persons, while he was a police officer engaged in investigating a gangland murder in 1951. [Three years after the investigation, plaintiff was convicted for non-feasance in duty in connection with a gambling operation; he subsequently received a full pardon]. The photograph appeared for about four seconds.

Plaintiff predicated liability on (i) the defendants' "appropriation" of his likeness for commercial purpose, and (ii) the defendants having caused him "substantial embarrassment and harassment".

Held, motion denied.

The court denied temporary relief because:

(1) Plaintiff failed to show an "immediate, irreparable injury for which there is no adequate remedy at law". With respect to plaintiff's "appropriation" claim, said the court, "if at . . . plenary trial [plaintiff] ultimately proves that his likeness within the context of this film is a valuable property right . . . and . . . that under the law he is entitled to compensation for its use, then he will be compensated in money damages for that remedy at law". The court noted that an adequate remedy at law for damages would also be available to plaintiff if he should prove "embarrassment and harassment" entitling him to such relief. The court added:

. . . much like a libel case . . . whatever the harm be it is so much more compounded by bringing it into the open arena of a court of law.

This was plaintiff's considered choice. I don't say he was wrong to make that choice. He had a perfect right to make it. But I sometimes wonder of all the millions of people who never knew Michael Hozer before or that he was in what he terms a gangster picture, now how many millions do know him? The Court has to weigh that considered choice and that result.

(2) A "balancing of the equities" favored defendants:

The substantial economic losses that would be incurred in the event this Court issued an injunction against the showing of the picture are . . . very obvious [in view of the success of defendants' picture].

I find at least at this posture, because of the status of being uncontradicted that a splicing of the film to eliminate this four-second shot objectionable to the plaintiff, would also involve substantial hardship to Paramount.

Aside from the obvious financial losses that would be incurred, a mandatory injunction would create enormous logistic and technical problems in supplying each of the thousand prints of the film with an appropriate clip.

(3) Plaintiff's right to recovery as a matter of law was "not clear" since the use of the photograph without plaintiff's consent might be privileged as a mere "incidental use", or by reason of plaintiff's past status as a public figure (albeit involuntary and during a prior period of time) and possible public interest in subject matter of defendants' motion picture.

The court said:

Appropriation is the subject of *Restatement (Second) of Torts*, Section 652C, page 108 (Tentative Draft No. 13, 1967), entitled "Appropriation of Name or Likeness." The rule reads as follows:

"One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy."

Comment d at page 110 entitled "Incidental Use of Name or Likeness," is particularly illuminating. I quote it.

"The value of the plaintiff's name is not appropriated by mere mention of it, or by reference to it in connection with legitimate mention of his public activities; nor is the value of his likeness appropriated when it is published for purposes other than taking advantage of his reputation, prestige, or other value associated with him, for purposes of publicity. No one has the right to object merely because his name, or his appearance, is brought before the public, since neither is in any way a private matter, and both are open to public observation. It is only when the publicity is given for the purpose of appropriating to the defendant's benefit the commercial or other values associated with the name or the likeness that the right of privacy is invaded. The fact that the defendant is engaged in the business of publication, for example of a newspaper, out of which he makes or seeks to make a profit, is not enough to

make such incidental publication a commercial use of the name or likeness. Thus a newspaper, although it is not a philanthropic institution, does not become liable under the rule stated in this Section to every person whose name or likeness it publishes.”

This incidental use exception is also accepted by Dean Prosser, and the cases are in accord.

It is noteworthy that in all of these cases incidental use was recognized as a complete and absolute bar to the cause of action alleged, thus mandating dismissal of the complaints.

At this posture of the case a serious question arises, albeit only a portion of the entire film was viewed, that the fleeting, opaque glimpse of what is alleged to be plaintiff's likeness as he appeared 21 years ago constitutes an appropriation of name or likeness for commercial exploitation

It is only commercial exploitation and not incidental use which warrants a finding of liability for invasion of privacy. Conceivably, a plenary trial may demonstrate the absence of this element, commercial exploitation

Having had, by reason of their geographical location in the center of the communications industry the greatest opportunity to mold the law of privacy in the context of media publications, New York's courts have uniformly refused to enjoin the use of name or likeness of individuals whose on-screen appearances are so fleeting as to be incidental with respect to the film or broadcast as a whole.

Indeed, at this stage in the proceedings a serious question is generated that whatever quantum of plaintiff's identifiable involvement in "The Godfather", it is still so slight a thing as not to warrant protection by any known law.

I am not deciding that. I am simply saying that there are serious questions involving this exception of incidental use.

Another question that arises in this case is an exception to liability for alleged invasion of privacy where further publicity is given to persons who in the past attained the status of a public figure. See *Prosser on Torts*, section 112, page 841 (3d ed. 1964).

Plaintiff says he was a lieutenant of detectives in the Cliffside Park Police Department and that in October 1951 he investigated the murder of underworld figure Willie Moretti.

There seems to be some foundation for the holding that the plaintiff became a public figure because, according to *Prosser*, the

plaintiff had adopted a profession or calling which gives the public a legitimate interest in his doings.

Indeed, by virtue of plaintiff's conviction in 1954 for non-feasance in office he had arrived at a position where public attention was focused on him. See *State v. Hozer*, 19 N.J. 301, (1955).

The *Restatement of Torts*, Second, Section 652F is to the same effect: "One is privileged to give publicity to facts concerning another which would otherwise constitute an invasion of his privacy, to the extent that such publicity is given to matters in which the public has a legitimate interest."

Nor does the *Restatement* engraft upon the privilege a niche for those whose public figure status is involuntary. It defines such persons, in comment d, as those "* * * who have not sought publicity or consented to it, but (who) through their own conduct * * * have become a legitimate subject of public interest. They have, in other words, become 'news'. Those who commit crime, or are accused of it, may not only seek publicity but may make every possible effort to avoid it, but they are nevertheless persons of public interest, concerning whom the public are entitled to be informed."

There is also a well settled rule of law in the field of invasion of privacy that holds that even though there has been a substantial lapse of time between the attachment of the public's interest to a plaintiff and a defendant's later use of his name or likeness, this factor does not operate to defeat the privilege to give him further publicity. Again see *Restatement (Second) of Torts*, Section 652F, comment i, page 132.

A case illustrative of this principle and strikingly similar on its facts to the instant case is *Estill v. Hearst Pub. Co., Inc.*, 186 F.2d 1017 (7th Cir. 1951).

This was the case of a plaintiff who was a district attorney of Lake County, Indiana, who had been inadvertently photographed with his arm around the shoulder of a gangster John Dillinger in 1934. He sued the publisher of the Chicago Herald-American for invasion of privacy when the newspaper republished the photograph in a series of crime articles in 1949.

The court of appeals affirmed the dismissal of the privacy claim, holding in effect that once plaintiff had become involved with a subject matter of public interest, the subsequent lapse of time during which he had returned to relative obscurity did not defeat the defendant's privilege to give him further publicity. . . .

Lastly, on this second essential element that must be present in a case at this posture to justify interlocutory injunction, there is

much case law that suggests that plaintiff may be foreclosed at the plenary hearing from ultimate success in this cause because of the constitutional privilege residing in defendant to re-publish the Moretti photograph.

See *Time Inc. v. Hill*, 385 U.S. 374 (1967) wherein the United States Supreme Court enunciated constitutional standards which give effect to the very same standards stated by Dean Prosser and the *Restatement*: The public cannot be deprived of access to media presentations involving subject matter of which they have a right to be informed by one whose name or likeness appears incidentally therein, unless such depiction was knowingly falsified or fictionalized, or was published with reckless disregard for whether the publication was true or false.

Subsequent to *Hill*, *supra*, the case of *New York Times Co. v. Sullivan*, was decided in 376 U.S. 254 (1964); the right of the public to have access to subject matter of public interest has taken on a constitutional dimension far surpassing in importance the right to be left alone of one accidentally or incidentally included in the relating of such subject matter.

Within this framework and viewed from a preliminary vantage point it would appear that the subject matter of "The Godfather", a film containing a screenplay adapted from an extraordinarily popular book describing the inside workings of a Mafia family, is the subject matter of undeniably great public interest value.

82. *Data General Corp. v. Digital Computer Controls, Inc., et al.*, 175 USPQ 486 (Del. Sup. Ct., October 2, 1972) (Walcott, J.).

Cross-appeals from denials of plaintiff's motion for preliminary relief and defendants' motion for summary judgment in action for appropriation of proprietary drawings. Plaintiff sells certain digital computers and makes engineering drawings thereof available to purchasers who wish to do their own maintenance. The "proprietary portions of these drawings", said the court, "bear a legend indicating their proprietary nature and that they are not to be used for manufacturing purposes." Defendants obtained certain of plaintiff's drawings from a customer of plaintiff and used them to develop a similar computer. Plaintiff owned no patents on its computer and the drawings were not "copyrighted".

Held, affirmed.

1. *Defendants' Motion for Summary Judgment.*

Defendants urged that plaintiff could not restrict use of its drawings under the pre-emption doctrine of *Sears* and *Compco* and because the Supreme Court's decision in *U.S. v. Arnold, Schwinn & Co.*, 388 U.S. 365 (1967), "holding that restraints on resale of goods by the original purchaser are violative of the [Anti-Trust Laws], requires the conclusion that [plaintiff] cannot restrict the future use of its plans . . ."

The court held, however, that:

Sears, *Compco* and *Schwinn* rest upon the conclusion that the material sought to be restricted had become part of the public domain. . . .

In this case, however, there is a factual question of whether or not [plaintiff's] trade secrets have been introduced into the public domain. [Defendants] urge that [plaintiff's] dissemination and lack of control measures over the drawings indicate that the drawings were in the public domain at the time [defendants] obtained a copy of them. However, there is evidence which may lead to a [contrary] conclusion. . . . [Plaintiff's] standard contract form contains a statement regarding its proprietary interest in the drawings which, themselves, bear a legend noting their proprietary nature.

It seems clear that there is a factual issue present in the case at bar which requires the denial of summary judgment.

Defendants also argued that plaintiff could not claim protection of trade secrets for failure of secrecy, but the court noted that "absolute secrecy is not essential" and that summary judgment was inappropriate in view of the factual issue of "the degree of dissemination of the [drawings] and the sufficiency of [Plaintiff's] efforts to protect [them]."

2. *Plaintiff's Motion for Preliminary Relief.*

The court held that the lower court had not abused its discretion in refusing a preliminary injunction.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

83. Copyright — the librarian and the law. Proceedings of the Eighth Annual Symposium sponsored by the alumni and the faculty of the Rutgers University Graduate School of Library Service. George J. Lukac, editor, New Brunswick, N.J., Bureau of Library and Information Science Research, Rutgers University Graduate School of Library Service, 1972. 1 v. (various pagings).

Contents: Our copyright law: present status and proposals, by B. A. Ringer. Library photocopying: the publisher's view, by C. H. Lieb. Copyright: the author's view, by Irwin Karp. Proprietary rights and the distribution of information, by P. G. Zurkowski. Libraries: on the spot with present and future copyright legislation, by V. W. Clapp. Panel discussion. Appendices: 1. Copyright Law of the United States of America. 2. Change in Copyright Office regulations. 3. Public Law 91-355—joint resolution. 4. "Patents, trademarks, and copyrights"—Report of the Senate Subcommittee on Patents, Trademarks and Copyrights, Ninety-first Congress, 1969-1970, with extensive reference to S. 543, the so-called "Copyright Revision Bill." 5. Facsimile of application for registration of a claim to copyright. "A forthright presentation of the conflicting points of view held by librarian, authors and publishers about the permissible extent of photocopying and the difficult matter of 'fair use.'"

84. Current Developments in copyright law. Practising Law Institute. *Patent, Copyright, Trademark and Literary Property*, Course Handbook Series, no. 31. 152 p. (1972).

Prepared for distribution at the Current Developments in Copyright Law seminar, held on October 23-24, 1972, this booklet includes articles on the following: (1) The anatomy of copyright, by Arthur J. Levine; (2) International copyright, by Heinz Dawid; (3) Misappropriation law, by Morton David Goldberg; (4) Rights and licenses for use on microfilm, photocopying, computers, cas-

ettes and CATV, by Bella L. Linden; (5) Specialized litigation techniques, by Eugene L. Girden; (6) Computation of damages for copyright infringement, by Bernard A. Helfat.

85. NIMMER, MELVILLE B. 1972 supplement to Cases and materials on copyright and other aspects of law pertaining to literary, musical and artistic works. St. Paul, West Pub. Co. [1972]. 110 p. (American casebook series).

“This Supplement contains significant developments occurring through June, 1972. This includes the Sound Recording Amendment of 1971, which for the first time renders sound recordings copyrightable under federal law. It also includes significant developments relating to Xeroxing as an act of copyright infringement, the distinction between dramatic and nondramatic performing rights in music, the scope of the compulsory license provision, and the right of publicity, as well as other material.

“Chapter and section titles from the principal book are reproduced in this Supplement in order to indicate the proper place for insertion of the supplementary material.”

2. Foreign Publications

1. In English

86. WORLD INTELLECTUAL PROPERTY ORGANIZATION. Teaching of the law of intellectual property throughout the world. Geneva, 1972. 72 p. (Third edition.)

A list identifying those universities and other higher education establishments in the world in which courses are offered in the field of industrial property or copyright law. The list includes information on the nature of the courses, where they are offered, their duration and number of hours per week, and special information where applicable.

2. In German

87. HÜBNER, HEINZ, and EUGEN ULMER. Fernstudium im Medienverbund: Hochschulrechte und urheberrechtliche Probleme. Weinheim, Beltz, 1972. 136 p. (Tübinger Beiträge zum Fernstudium, Schriftenreihe des Deutschen Instituts für Fernstudien an der Universität Tübingen, Bd. 6).

A study of legal problems, including copyright, in connection with the use of educational broadcasting in universities of the German Federal Republic.

88. RUMPHORST, WERNER. Der angestellte Urheber und die Filmurheberschaft im Recht der Vereinigten Staaten von Amerika. [München] 1972. 229 p. Inaug.-Diss.—Munich.

A dissertation on the question of the ownership of copyright in a motion picture in the United States when works of employees for hire and commissioned works are used in its production.

3. In Spanish

89. COSTA, HECTOR DELLA. El derecho de autor y su novedad: estructura, dinámica, problemática. [Buenos Aires] Cathedra, 1971. 167 p. Premio "Universidad de Belgrano" — 1970.

An attempt at a systematic analysis of copyright with particular reference to its application to new technological developments in communications media.

B. LAW REVIEW ARTICLES

1. United States

90. BAUMAN, LAWRENCE SCOTT. Legal control of the fabrication and marketing of fake paintings. *Stanford Law Review*, vol. 24, no. 5 (May 1972), pp. 930-946.

"This Note contends that existing criminal statutes do not provide an adequate apparatus for preventing the fabrication and marketing of fake paintings because they are designed to deal with commercial paper and documents rather than paintings and thus do not allow law enforcement officials to prosecute the perpetrators of art frauds effectively. A uniform model penal statute or federal legislation should be enacted making fraudulent simulation of paintings a separate punishable offense; this Note offers for consideration a suggested statute designed to deter the fabrication and marketing of fake paintings."

91. BERK, LEE ELIOT. Legal instruction for the college music student. *Performing Arts Review*, vol. 3, no. 1 (1972), pp. 149-173.

An extract of lecture materials used by the author in his course in two areas: "Copyright Control: The Employment Relationship,"

and "Copyright and Control: Joint Works." The extracts as given appeared in book form in the author's *Legal Protection for the Creative Musician* (Boston: Berklee Press Publications, 1970). The extract is followed by a final examination problem and a student answer to the problem.

92. CARNAHAN, WILLIAM H. Copyright in our realm of learning. *The College Counsel*, vol. 71, no. 1 (1972), pp. 421-449.

A discussion of the copyright problems confronting the faculty at the Air Force Academy, with particular emphasis on the fair use doctrine. It appears to be a revised version of the author's "Copyright in the military realm of learning," 13 *United States Air Force JAG Law Review* 251 (1971). See 20 BULL. CR. SOC. 58, item 31.

93. Copyright law — legality of photocopying copyrighted publications. *William and Mary Law Review*, vol. 13, no. 4 (Summer 1972), pp. 940-948.

A case note on *Williams & Wilkins Co. v. United States*, no. 73-68 (Ct. Cl. Feb. 16, 1972).

94. CUSTIN, JAMES R. Memorandum re: Copyrighting advertising material. *Wisconsin Bar Bulletin*, vol. 45, no. 5 (Oct. 1972), pp. 41-46.

"Written for non-lawyers and particularly for advertising personnel," but the memorandum also contains information "that is useful to the general lawyer and may not be known to him."

95. FLOYD, JOSEPH THAD, JR. Copyright — a copyright holder's protection may not, by use of the ordinary observer test, be extended to cover ideas. *Texas Tech Law Review*, vol. 3, no. 2 (Spring 1972), pp. 390-394.

A case note on *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 19 BULL. CR. SOC. 77, Item 22 (9th Cir. 1971).

96. HOLLINGSWORTH, ROBERT J. Copyright — libraries — unauthorized library photocopying of articles from copyrighted medical journals constitutes copyright infringement. *University of Cincinnati Law Review*, vol. 41, no. 2 (1972), pp. 511-519.

A case note on *Williams & Wilkins Co. v. United States*, no. 73-68 (Ct. Cl. Feb. 16, 1972).

97. MARTIN, JULIAN CLARK, and JACK R. SPRINGGATE. Protection of a businessman's proprietary information. *Louisiana Law Review*, vol. 32, no. 4 (June 1972), pp. 497-541.

"It is the purpose of this Article to discuss for general practitioners and businessmen the present state of the law protecting proprietary information [patent law, statutory and common law copyright, and the law of unfair competition], with emphasis on the law applicable to Louisiana, and to recommend certain actions a businessman can take to enhance his protection."

98. NIMMER, MELVILLE B. Proprietary rights, residual rights and copyright in cartridge TV in the United States and Canada. *Performing Arts Review*, vol. 3, no. 1 (1972), pp. 3-17.

An exploration of the questions as to what extent and in what manner the producer of cartridge TV "software" may claim exclusive rights in his product so as to require others to pay for its use, and as to what rights others may claim in material which the programmer wishes to incorporate in his productions. These questions are examined "primarily in the context of the laws of the United States, and occasionally, where significant differences appear, in the context of Canadian law."

99. RIVKIN, STEVEN R. The changing signals of cable T.V. *The Georgetown Law Review*, vol. 60, no. 6 (June 1972), pp. 1475-1511.

"[T]he development of broadband communications [is traced] in an attempt to develop a logical starting point for future regulation of the industry."

100. SLOANE, OWEN J. The new copyright in sound recordings. *Beverly Hills Bar Journal*, vol. 6, no. 4 (Sept. 1972), pp. 29-37.

An analysis of Pub. L. 92-140.

101. SOBEL, LIONEL S. Count Dracula and the right of publicity. *The Los Angeles Bar Bulletin*, vol. 47, no. 10 (Aug. 1972), pp. 373-378, 399-404.

A note on *Lugosi v. Universal Pictures Co.*, 172 USPQ 541 (Cal. Super. Ct., Los Angeles County 1972).

102. Toward artistic integrity: implementing moral right through extension of existing American legal doctrines. *The Georgetown Law Journal*, vol. 60, no. 6 (June 1972), pp. 1539-1562.

The adoption of certain principles is proposed which "would provide the courts with a means of effectuating the rights of paternity and integrity while focusing the court's attention on the particular problems of the author and artist."

2. Foreign

1. In English

103. DERENBERG, WALTER J. Letter from the United States. *Copyright*, vol. 8, no. 10 (Oct. 1972), pp. 206-213.

A survey of legislative, administrative and judicial developments in United States copyright law during 1971 and 1972.

104. FREITAS, DENIS DE. Letter from the United Kingdom. *Copyright*, vol. 8, no. 9 (Sept. 1972), pp. 184-193.

A survey of legislative, judicial, and other developments in copyright and related matters in the United Kingdom during the two years ending December 31, 1971.

105. KESHISHOGLU, JOHN E. To cable or not to cable? A summary of the development and potential of cable television. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 4 (July 1972), pp. 32-35.

A story, in brief, of the development and potential of CATV in the United States, by the chairman of the Television-Radio Department, Ithaca College, New York.

106. A Regulatory programme for cable television in the United States. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 4 (July 1972), pp. 49-50.

A summary of the Fourth Cable Television Report and Order and Cable Rules (Dockets 18397, 18397-A, 18373, 18416, 18892, 18894), adopted by the Federal Communications Commission, February 2, 1972.

107. ROBBINS, E. C. The BBC and the Performing Right Society. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 4 (July 1972), pp. 49-50.

An account of a dispute between the British Broadcasting Corporation and the Performing Right Society as to the rate of payment for broadcasting the PRS repertoire of musical works, and of the decision of March 27, 1972, handed down by the Performing Right Tribunal to which the dispute had been referred.

108. RUBINSTEIN, STANLEY. Law of copyright—Copying and subconscious and conscious. *The New Law Journal*, vol. 122, no. 5552 (June 29, 1972), pp. 579-580.

An attempt to justify a proposal that a work which results from subconscious copying should be considered a work of joint authorship under section 11(3) of the U.K. Copyright Act 1956, with all that such relationship would imply as to the respective rights of the owner of the copied work and the copier.

2. In French

109. IONASCO, OVIDIU. La protection du droit d'auteur dans les pays socialistes. *Il Diritto di Autore*, vol. 43, no. 2 (Apr.-June 1972), pp. 223-245.

A comparative survey of copyright protection in the socialist countries of Europe.

3. In Italian

110. SANCTIS, VALERIO DE. Le revisioni di Parigi (luglio 1971) della Convenzione universale sul diritto di autore e della Convenzione di Berna, Atto di Stoccolma. *Il Diritto di Autore*, vol. 43, no. 2 (Apr.-June 1972), pp. 131-185.

A report and evaluation of the Stockholm Act of 1967 and of the Paris revisions of the Berne and Universal Copyright Conventions in July 1971.

4. In Swedish

111. MOORE, GUNNAR. Första året med mönsterskyddslagen; en sammanfattning av föredrag och diskussion den 20 oktober 1971 vid Svenska föreningen för industriellt rättskydds sammankomst. *NIR*, 1972, no. 2, pp. 125-136.

A summary of a lecture and discussion at a meeting on October 20, 1971, of the Swedish Association for the Protection of Industrial Property. The subject of the lecture was the administration of the new Swedish design protection law during the first year of practice.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

112. BENJAMIN, CURTIS G. Reprint editions: some pertinent questions. *Publishers' Weekly*, vol. 202, no. 19 (Nov. 6, 1972), pp. 22-23.

An article commenting on the "unhappy situation" which "is the result of efforts of several developing countries to start their own reprint programs, largely of tertiary level textbooks and professional titles." Mr. Benjamin asks, "How can U.S. publishers keep their established reprint programs alive if they close important segments of already thin world markets by licensing reprint rights for exclusive national markets?"

113. DOEBLER, PAUL. Introducing a new PW section: the role of non-print in publishing. *Publishers' Weekly*, vol. 202, no. 12, pt. 1 (Sept. 18, 1972), pp. 60-63.

The first of a new monthly section, "New Media Publishing," provided a current overview of the use of media other than books, such as microforms, audiovisual tapes, video programming, computerized data bases and services, and the like, and some ideas on what the importance of such media may be to publishers in the future.

114. FOX, MARTIN. Composers and CBS reach accord on rights to music. *New York Law Journal*, vol. 168, no. 61 (Sept. 27, 1972), p. 1, cols. 5-6; p. 4, col. 2.

An article on an out-of-court settlement between the Columbia Broadcasting System, one of the defendants in a pending action by the Composers and Lyricists Guild (*Bernstein v. Universal et al.*). "The suit challenged the 'standard terms' in contracts providing that the producers of motion pictures and television shows hold all rights and title in perpetuity to music and lyrics composed and

written for these productions." "The suit will continue against the remaining defendants, NBC, ABC, and eight motion picture producers."

115. GOLDMAN, ABE A. Copyright and archival collections of sound recordings. *Library Trends*, vol. 21, no. 1 (July 1972), pp. 147-155.

An elucidation of copyright problems that arise in using archival collections of sound recordings by outlining some aspects of copyright pertaining generally to literary and musical works, for which copyright concepts have been established, and by considering the extension of these concepts to the new copyright class of sound recordings.

116. KEZIAH, DOROTHY PENNINGTON. Registration problems encountered by the Copyright Office under the recent sound recording amendment. *Cash Box*, vol. 34, no. 20 (Nov. 4, 1972), pp. 22, 24.

The problems discussed "generally fall into five major areas: (1) misunderstanding as to the scope of protection; (2) authorship problems; (3) claimant-notice problems; (4) publication-deposit problems; and (5) new matter and fixation problems."

117. SHAH, JAMAN H. Letter to Professor Eugen Ulmer. *Publishers' Weekly*, vol. 202, no. 19 (Nov. 6, 1972), pp. 15-17.

A copy of the letter was sent by its writer to *Publishers' Weekly* with the request that it be published. Mr. Shah of Jaico Publishing House in Bombay, India, takes issue with a statement made by Professor Ulmer in his Geiringer lecture on international copyright (19 BULL. CR. SOC. 263, Item 180 (1972)) to the effect that the principle of compulsory licensing weakens international copyright.

118. SULJAK, NEDJELKO D. Copyright and the question of authorship. *Library Resources & Technical Services*, vol. 15, no. 4 (Fall 1971), pp. 513-521.

An explanation of the terms "author's right" and "protected works" in copyright law is given as an aid to catalogers in understanding the "author principle," established by the revised *Anglo-American Cataloging Rules* when choosing the main entry for works involving various kinds of authorship.

119. WAGNER, SUSAN. Copyright minuet: Russian wallflower ready to dance? *Publishers' Weekly*, vol. 202, no. 18 (Oct. 30, 1972), p. 34.

An article on "a breakthrough in Soviet resistance to participation in the international copyright system — now being envisioned at the highest level of the U.S. government as part of general improved world climate and U.S.-Soviet relations."

120. WILLIAMS, WHITNEY. Songwriter asks \$4 billion in class action lawsuit against Capitol and others. *Daily Variety*, vol. 157, no. 30 (Oct. 18, 1972), p. 1, cols. 1-2; p. 9, cols. 3-4.

An article on what is described as possibly an "unprecedented class action and probably the largest showbiz sum in damages ever asked in a court", brought by veteran songwriter, John Blackburn, against Capitol Songs Inc. and others. The complaint for declaratory relief, filed in Los Angeles Superior Court by Blackburn on behalf of himself and "all other persons similarly situated," challenges the validity of song-writers' contracts containing assignments of renewal rights, used only with new and inexperienced songwriter-composers, and terms them "unconscionable and unfair" to the plaintiffs.

121. WILLIAMS & WILKINS COMPANY. A statement from Williams & Wilkins to the editors, *Publishers' Weekly*, by William M. Passano, chairman of the board, Williams & Wilkins Co. *Publishers' Weekly*, vol. 202, no. 20 (Nov. 13, 1972), pp. 17-18.

An answer to criticism of the Williams & Wilkins Company "for being premature in seeking compensation for photocopied articles from the journals which it publishes."

2. Foreign

1. In English

122. DOCK, MARIE CLAUDE. The revised Universal Copyright Convention. *Unesco Chronicle*, vol. 18, no. 5 (May 1972), pp. 175-185.

A "detailed analysis of the most important provisions of the revised convention."

NEWS BRIEFS

123. BRITISH SOCIETY OF AUTHORS SENDS MEMORANDUM ON PUBLIC LENDING RIGHT PROPOSAL. On September 1, 1972, The Society of Authors sent a memorandum to Lord Eccles, Paymaster-General of England, on the proposals of the Working Party on Public Lending Right.

The memorandum describes the public lending right as one “. . . not in terms of patronage or charity, but within the law of copyright. . . . In short, ‘payment for use under copyright.’” In a letter to the Minister, Geoffrey Trease, Chairman of the Committee of Management of the Society, discusses Blanket Licensing as the main point of controversy among authors for the following reasons:

- a. The possibility [exists] that libraries would cut down on book purchasing in order to pay the annual licence fee;
- b. The fact that copyright works on library shelves before PLR starts would not qualify for the lending royalty . . . would bear hard on the authors of those works;
- c. Since it is a once-for-all payment, calculated as a percentage of the published or sale price, the lending royalty is not directly related to lending as normally understood, i.e. a library loan; and this would work to the disadvantage of certain writers, notably fiction writers.”

Recognizing the force of these arguments, Mr. Trease continues:

“Perhaps the most controversial point and the hardest, at first sight, to resolve, concerns the apparent conflict between the two methods we favour for calculating and distributing PLR—by lending royalty and by flat-rate payment per loan. In fact the two can be reconciled to complement one another; and they could in due course be combined to give the fairest possible return for library use, viz. lending works both *on* and *off* the library premises.

“In general, the lending royalty favours the weightier and more expensive work (usually non-fiction) which—by reason of length and subject matter—is lent *off* the premises relatively infrequently; or which under library regulations may not be taken out at all. This applies particularly to academic libraries and the reference sections of public libraries. In other words, a work of this kind is available mainly, if not solely, for consultation *in situ*, a form of use impossible to record with accuracy under a loans-related scheme. For this reason the lending royalty is the fairest method of remunerating the authors of works of this kind and which are lent in this way.

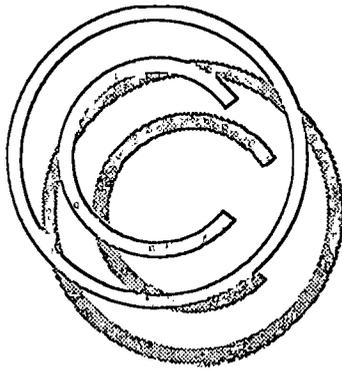
“In contrast, the flat-rate payment per loan favours the less expensive work (usually fiction, but some non-fiction as well), which

is most used by means of lending *off* the premises. On such works the return from the lending royalty would be lower, but from the loan payments higher, than in the case described above.

“In short, these two methods reflect the two main forms of library use and, once library computerization is sufficiently far advanced, could be operated together. Their administration and control would be the business of the collecting society, which would allocate its revenue accordingly — each author receiving both forms of income. There would, however, be no need to wait upon the loan-related scheme before launching the lending royalty one. Indeed it would be a grave injustice to delay the implementation of this long awaited right a moment longer than is absolutely necessary. Once the Copyright Act has been amended, the collecting society would proceed immediately to institute Blanket Licensing, both as to collection and distribution of income.

“May I request you, with all the earnestness at my command, and on behalf of all authors, to do everything in your power to introduce an amending Bill in the next session of Parliament, and to give early notice of the Government’s intention to do so?”

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PART I.

ARTICLES

124. THE TASK OF AUTHORS' SOCIETIES VIS-A-VIS NEW
TECHNIQUES OF COMMUNICATION AND EXPLOITATION
OF INTELLECTUAL WORKS

(*e.g., satellites, cable television, audio visual cassettes,
photocopying, public lending, etc.*)

By DENIS DE FREITAS*

1.—In the second half of the last century and indeed well into the first half of this century, the commercial exploitation of the works of authors and composers was conducted in a relatively simple way—literary works (other than dramatic works) were exploited by making copies and persuading the reading public to buy these copies; and musical works, composed to be performed by live performers, either publicly at concerts and dances, or privately at home, were exploited primarily through the sales of sheet music, supported by the growing practice—France leading the way, I think—of charging for performances. Today the scene is completely transformed, and as the changes have been most dramatic in the field of music, I shall illustrate them primarily by reference to the musical scene, though in principle the impact of the changes applies equally to literary works even if not quite so extensively or intensively.

2.—In the past the promotion of musical works involved a simple partnership between the composer and his business associate, the music publisher—the role of the former being to create the music, the role of the latter being to finance and administer its commercial promotion by printing copies of the works and seeking to sell as many as possible. The income for this partnership therefore flowed from the sales of sheet music, and later when statute had established that the right to control public performances of music was part of the copyright in that music,

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the granting of permission for a fee to those who wished to perform the music in public. Now, as we all know, it was the manifest practical impossibility on the part of the individual composer or publisher to administer this new public performing right which led to the formation of authors' societies, and the story about Victor Parizot and his friends in France which preceded the establishment of the doyen of authors' societies—SACEM—is too well known to be repeated here. Thus, the original task which authors' societies of the kind I am now discussing were established to carry out was the administration of the performing rights in the works of the two parties to the simple straightforward partnership between the composer and his publisher. This original task inevitably involved not merely the devising of administrative machinery for issuing licences, collecting royalties and distributing them but, equally important—indeed utterly vital—the task of making the public aware of these rights and of the equitable basis for them, through persuasion and, where unavoidable, through litigation. Moreover, human nature being what it is, there were, and still are, many users and categories of users who do not accept the justice of these rights and who have sought over the years to have them abolished or reduced. Therefore it early became an important part of the task of authors' societies to act on behalf of composers and publishers in resisting such pressures. A good example of such an attack was the attempt in the United Kingdom in 1929 to persuade Parliament to pass what was known as the "Twopenny Bill", the effect of which would have been to give the purchaser of the printed copy of a musical work the right to perform the work in public in any circumstances on the payment of a derisory fee of twopence. In defeating this attempt, the Performing Right Society in the United Kingdom played an important role in mobilising the resistance of composers and publishers. An example of an attempt which was not defeated is the exemption introduced into the U.S. copyright law whereby the public performances for profit of music by means of juke boxes are exempt from copyright control; although it is encouraging to note that the new draft copyright law being considered by the United States Congress contains provision for the payment of royalties by juke box operators—a proposal much resisted by the operators and one which would not have been officially put forward had it not been for the determined representations made by the U.S. authors' societies and other organisations representing composers' interests.

3.—From this brief, and necessarily telescoped, historical look backwards and with the knowledge that we all have of what authors' societies do today, their present roles may be summarised, I think, in this way:—

(i) to administer the performing right (which includes, of course, the broadcasting right where this exists under national legislation as a separate right) and the mechanical right on behalf of composers and publishers;

(ii) to distribute amongst the composers and publishers the royalties so collected;

(iii) to mobilise resistance to attempts, through legislation or otherwise, to eliminate or reduce the rights administered by them on behalf of composers and publishers.

4.—Before examining the impact on this role of authors' societies of the tremendous technological and other changes which have taken place during the last five decades I think I should briefly remind you of the changes which, in broad terms, have occurred within the societies themselves. In their early origins they were small organisations often representing only a part (sometimes not even half) of the national composers and publishers; they had meagre funds reflecting limited and fiercely opposed licensing operations; they were frequently involved in costly litigation to establish before the courts the validity of the composer's rights in the face of hostility from music users—settling the parameters of the new valuable performing right and thus establishing such important points as whether a performance in a private members club, in a factory, or given in private but audible in public, was a public performance and so on—from those early days when authors' societies were struggling groups surrounded by hostility and suspicion they have developed into the great corporate bodies which we know today handling, even by today's standards, large sums of money, employing considerable work forces as well as up to date management tools such as computers, and administered by persons recognized in their countries (and often internationally) as leading experts in the field of copyright. Authors' societies have today therefore become respected national institutions with large resources of money and talent, regarded by governments and others as one of the principal sources of knowledge, expertise and advice on the subject of intellectual property.

5.—By comparison with the picture of the music market in the last quarter of the last century and the first quarter of this century, how does the music scene look today? The changes are tremendous. Sheet music sales, save only in the case of serious music, constitute a minor, almost insignificant, element in the potential income to be derived from the commercial exploitation of musical works. Perhaps the feature of

the contemporary scene which first strikes one is the very variety itself of the ways in which music and other works of intellectual property may be commercially exploited—consider, for example, the many ways in which recordings may be made—discs, tapes, films, wires—and remember the excellence of the reproduction; the vast consumption of authors' and composers' output by the cinema throughout the last 5 decades; the already huge, and still growing, appetite of broadcasting, in all its forms, for copyrighted works; juke boxes, use in advertising, for teaching—one can go on indefinitely, the list is so long. Indeed, the purposes for which, and the different ways in which such purposes may be served, are, as a result of today's technology and commercial sophistication, virtually unlimited.

6.—Let us now turn to certain particular technological developments which, as implied in the title to this talk, may present new tasks for authors' societies today and in the future. While it would be inappropriate in this discussion for me to examine in depth the implications of each of these individual developments, as most of them are already the subject of full scale enquiries by various CISAC working parties, it is nevertheless helpful to record briefly the salient features of these developments in so far as they appear to have implications for copyright owners.

7.—Thus, the use of satellites for relaying broadcast transmissions across national boundaries presents all parties who have interests in such broadcasts, i.e., broadcasters themselves, authors, composers, performers and any others whose contributions may be included in such transmissions, with the problem of controlling the use to which those transmissions may be put after their original emission in the country of origin. As you know, I expect, the study of this development has made it plain how complicated these resulting problems are, and two international conferences of experts organized under the joint auspices of WIPO and UNESCO have so far failed to reach agreement even on the nature of the problems, much less on the solutions to them.

8.—On this continent it must, I am sure, be unnecessary to spell out the problems which have arisen from the new technology known in the United States of America as cable television. This began as a relatively simple commercial and technological operation to improve the quality of the signals available to receivers in areas of difficult terrain, indeed in some cases to bring in the signal where it was otherwise not received at all. This was done by the simple expedient of erecting a large receiving antenna on some suitable high point and conveying the signals thus

received along wires to the homes of the individual receiving set owners. From this simple operation there has developed a huge industry, notably in the United States of America but also in many other countries in which large commercial operators not merely provide householders with distant broadcast programmes otherwise unavailable, or unavailable in good quality straight off the air, but transmit programmes which they have originated themselves. Thus has sprung up a great new business enterprise making use of authors' works and competing with existing broadcasting systems. The problems in the field of copyright created by this development have received different treatment in different countries. Thus, under the copyright law of the United States of America—a law drafted long before such developments were dreamed of—the Supreme Court has ruled that the operations of the CATV companies do not fall under copyright control, and the difficulty of devising a formula for giving copyright owners a fair measure of control over such use of their works acceptable both to the new commercial interests, and to copyright owners and broadcasters, has been one of the stumbling blocks delaying the progress towards a new copyright law in the U.S.A. On the other hand, under most modern copyright laws the use of copyrighted works for such systems are in principle within the control of the copyright owner, although in some cases (such as under the Copyright Act of the United Kingdom) there are some serious restrictions upon this right.

9.—The subject of audio visual cassettes, and the problems for copyright owners created by these new devices, has been much discussed—in the press, at international gatherings and generally in communications, entertainment and education circles—and a great deal of what has been said is, I believe, misleading and somewhat hysterical. The various kinds of appliances which are being developed for the use of audio visual cassettes do not seem to me to introduce any new copyright concept but merely to involve the exercise of existing and traditional authors' rights in a manner very similar to that in which they have been exploited for years in the motion picture industry. Of course, there are a number of practical problems but most of these, I believe, fall into the area of contract law and business negotiation rather than the field of copyright per se.

10.—Photocopying is, of course, simply one of the methods whereby copies of copyrighted works may be made; it is, therefore, merely an example of the many different systems in existence today whereby copyrighted works may be reproduced—and reproduced at ease and without excessive cost. The problem posed for the author by this new equipment is not new. For years now, those concerned with musical interests have

been only too painfully aware of the extent to which their mechanical rights have been infringed extensively by the private use of tape recorders.

11.—The last example of the new techniques of communication mentioned in the title of my talk is “public lending.” I have taken this to mean the remarkable spread in this century, particularly in the developed countries, of networks of libraries making available to the public, often without charge, at first books, but, increasingly, musical works (both in the form of sheet music as well as records and tapes) and other copyrighted works such as photographs, pictures and so on. This is a development—perhaps not so much technological as social—which is in part the result of, and in part the cause of, the increasing standards of literacy and education throughout the world. The impact of this development on the writer or the composer is plain. A library may purchase a book and lend it to a thousand readers; the return the author receives from the communication of his work to those members of the public is a single royalty paid on the copy purchased by the library; if only half those readers had purchased a copy his income would have been multiplied by 500. The injustice of this is belatedly being recognised. In Denmark and Sweden schemes to compensate authors have been in existence for some years; the United Kingdom has under active consideration proposals to establish the public lending right as part of the author’s copyright and, I understand, similar consideration is being given by the Government of West Germany and possibly other European countries.

12.—Now, what general lesson or moral or common theme can be discerned from this brief survey of these technological developments? Before attempting to answer my own question I would like to remind you that technological development is not new; it is not peculiar to the middle of the twentieth century; perhaps the speed with which new technologies are developed and their range of application may be on a scale different from previous developments, but some of the most fundamental technological discoveries took place in the last century. Thus the basic inventions of Edison and his phonograph (1877), Berliner’s wax discs (1895), the clock spring motor (1897), Shellac discs (1904) and double sided discs (1905) converted the novelty phonograph into the commercially successful gramophone and laid the foundations for the huge international flourishing record industry from which today composers and publishers receive a major share of their income. So too, the inventions of Marconi and Baird have led to the vast systems of radio and television broadcasting which today encircle the world, communicating in ever increasing volume the literary, musical and artistic crea-

tions of mankind. My principal reflection on these technologies which are now commonplace features of every day life is that they were of enormous benefit to authors. Of course, they presented and still present practical problems, but I do not believe that these marvellous systems of reproducing, and recording, and of giving performances and of communicating to the community the creative output of authors and composers and artists has been other than a boon to society, and to authors, composers and artists in particular. Not only has it provided new large sources of income but, perhaps much more important, it has presented creative members of society with exciting and challenging new tools—for expression and for communication.

13.—If it be correct, as I think it is, to view those technological developments which have already, so to speak, matured in this way, then I suggest it is equally valid to view the new or as you might call them, second and third generation technologies which are being explored today in the same way. Too often I hear this or that development described as potentially dangerous for authors. I believe this to be a wrong reaction. Even from a purely practical standpoint it is wrong. The clock cannot be reversed. Man's ingenuity cannot be suppressed—nor should it be. Whether we like it or not, the technique of photocopying is with us; like Everest, it is there and no matter what we say about it or think about it, it will not go away. The only sensible thing to do, surely, is to make the best of it.

14.—My conclusion, therefore, is that the correct attitude for authors and all those who represent authors' interests is to direct their energies and resources, not into opposing the development, introduction or application of new technologies for the purpose of using copyrighted works, but simply to ensuring as far as possible that satisfactory legislative, contractual and other provisions are made to protect the legitimate interests of authors and to guarantee that they enjoy a fair share of the economic fruits of the resulting commercial exploitation.

15.—The impact of the new technologies is, however, wider than simply the direct effect of producing new and greater numbers of outlets for authors and their works. This is what one might term, the intermediate result with consequential practical problems in the field of rights and contracts. But, flowing from these technologies are other consequences of equal importance. Side by side with the purely scientific developments there has been an equally dramatic transformation in the world of business. The commercial promotion of copyrighted works, and music in particular, is no longer simply undertaken by the composer's original business partner, i.e., his publisher. The commercial use of copy-

righted works today is the business of those great industries which have arisen out of the new technologies, that is to say, the commercial broadcasters, both radio and television, the record manufacturers, the film producers and so on; it is they, by harnessing technology, entrepreneurial skill and modern management techniques, who effectively create the huge markets and public demands for authors' works today.

16.—But the matter does not rest there; there is another feature of today's scene which is a byproduct of the consequences of technology and which has a bearing on my subject. It is true that the publisher is still today the composer's business partner in the sense that it is to the publisher to whom he assigns, as he always did, his copyright in the first instance, and by virtue of this publishers are members of authors' societies; but publishers today may not be what they used to be—and I hope that remark will not be misunderstood. What I mean is simply this: in the past a publisher was a person, or a firm or company completely controlled by a person or persons whose principal interest lay in publishing, i.e., in general, the publisher's overall interest coincided with that of his partner, the composer, and this was the underlying basis for their association in authors' societies. Of course there are still many such publishers today. But there is also a change, and it seems to me a very important one. As in other sectors of the world of business, so in the publishing field, the takeover and the merger have become commonplace. This has meant that it is now frequently the case that large publishing businesses are owned by even larger businesses, often the users themselves. Thus music publishers are owned by film companies, by record companies and by broadcasting organizations. Stopping for a moment at this point, we see that, as an indirect consequence of the application of technology, the interests of composers are falling more and more under the control of those users with whom, in a commercial sense, composers' interests may be in conflict.

17.—This analysis of the background to the business side of the exploitation of authors' works does not end with the realisation that in many cases it is the user, i.e., the person who must pay the composer for the use of his works, by whom the composer's interests are owned. In recent years a new kind of corporation has emerged—the conglomerate, i.e., the large corporation not formed to operate in any particular field of business activity but simply to obtain the maximum return from the use of capital. In pursuit of this objective a conglomerate will acquire and operate as many separate businesses, no matter how unrelated, as seem to offer reasonable prospects of profit. I can think of a number of instances, and so I am sure can most of you, where very large publish-

ing houses operating internationally are owned by users, either record companies or film companies which are themselves owned by conglomerates. In the last resort, the policy of a conglomerate is solely governed by the profitability of a particular operation. It is true, of course, that an independent publisher will not normally, and obviously could not indefinitely, operate at a loss. But there may be a difference between the position of a person or company whose sole or principal reason for existence is the promotion of books or music when faced with a loss of profits, and that of a large international conglomerate corporation with a publishing division no longer producing the required return on investment. In the former case there is a greater chance that the independent publisher will be inspired to devise ways and means of continuing to publish and of returning to profitability, whereas in the case of a conglomerate there is a clear danger that the unprofitable division will simply be shut down.

18.—Of course the principal reason why the new technologies have been combined with the latest entrepreneurial and managerial skills with such remarkable results has been the realisation that the commercial exploitation of copyrighted works can be organised on such a scale and in such volume as to generate considerable financial return—today the music business is big business. In one sense this is good for composers and publishers, but I wonder whether there is not a danger in this development—this growth of “commercialism” in the music business. Let me give you an actual example of the degree to which commercial considerations today influence not only the creation but the form of intellectual works.

19.—I know of a particular prestige feature film, the musical score for which was commissioned from one of today's leading composers who was paid a considerable commissioning fee. The film was produced, the score composed and synchronised on the soundtrack of the film, and I understand—though admittedly I do not know this part at first hand—that it was a fine score well suited to support the theme of the film. However, before the film was released, those responsible for the production of the film, including of course the score, were advised that splendid though the score might be it was not the kind of music which could be commercially exploited through the sale of records. The score was therefore removed from the soundtrack; another composer was commissioned and a second commissioning fee paid, and his instructions were to write music which, of course, had to fit the film but equally, if not more important which could be sold in the form of records as well. In other words, the artistic considerations involved in matching the

score to the film were overridden by the commercial view that it was as necessary or possibly more necessary to ensure that the soundtrack of the film could also be exploited through the sale of records.

20.—In recent years I have attended a number of international conferences or conventions concerned with the music industry and I have been struck by the fact that at many of them I never heard the word “music” used—either in the formal speeches or in the discussions and conversations of those attending; I heard a lot about “product” and “package” and “market-research” and “consumer-demand” and “investment” and “return on investment” but never about music itself. There is another facet of the contemporary scene which may be linked with this. One of the great new tools of commerce and industry which has been devised and perfected in this century is the “art” or perhaps as others would prefer simply to call it the “practice” of advertising. Now advertising has utilised, indeed relies very considerably upon, creativity—from, amongst others, both authors and composers; and in the cause of advertising there is produced an astronomical amount of “original literary and musical works” all enjoying protection under the concept and the relevant laws of copyright. The question I ask, and it is a question to which I do not really know the answer, is whether this sophisticated organising of the output of literary, musical and other works, i.e., turning them out as it were on a production-line basis, tailor-made for a particular market need, and the use of such works primarily, if not exclusively, for the sole purpose of promoting the sale of ordinary goods and services, may not lead the public to think of intellectual works in the same way as tangible goods, i.e., merely to be produced, to be bought and to be sold in the same way as, say, a bottle of Coca-Cola. Let me put the question in a slightly different form: is the public in danger of being led to think that while it is reasonable for the works of Simone de Beauvoir or Bela Bartok to enjoy the kind of rights afforded by the law of copyright, such works are totally different from the text of a commercial advertisement or the musical jingle accompanying it which are written, not for the normal purpose which usually motivates an author or a composer, i.e., the communication to the public of the views of that author or composer but for the sole purpose of persuading the public to buy a particular commodity?

21.—Quite apart from the qualitative considerations, so to speak, which I have just mentioned, the sheer quantity of works being currently used and produced is prodigious and grows daily—and under European copyright philosophy all these works are individually and immediately entitled to full copyright protection without any formality.

22.—Now, from this broad survey of the direct and indirect effects of technology upon the commercial exploitation of authors' works, what conclusions may properly be drawn as to the role which authors' societies should today and in the future play? In a very general sense, probably the role is little different from what it always has been, namely to administer on behalf of authors those rights which it is impracticable for them to administer on their own: and on their behalf, together with other bodies, to mobilise defences to all attempts to take away or reduce those rights. But within that general responsibility it certainly does seem that there are a number of specific matters which the state of technology and the contemporary structure of the business world require authors' societies to concern themselves with and I would list these in the following summary.

(i) To keep before composers and publishers the belief that technology is not to be regarded as an enemy but as an ally, exploring new opportunities and devising new tools by means of which authors and composers may express their creativity, communicate with their public and participate in new sources of income.

(ii) At the same time, to take the initiative in preparing and proposing new legislation whenever existing legislation appears inadequate to deal with a situation created by a new technology or business development. This means that societies must keep such developments continuously under review and for this purpose must maintain on their staffs sufficient numbers of qualified persons for this purpose. By and large, the big societies already do this although even in the large society there is often considerable strain upon the senior management.

Small societies may not be able to afford the professional staff and other facilities needed for such work, but it is just as important that this function be carried out in small countries as in large. Inadequate protection of copyright in any country creates a dangerous precedent for all. Consideration might therefore be given to the establishment within CISAC of a full-time research section the services of which would be available to societies, primarily the small ones, for the purpose of assisting them in dealing with actual practical problems in their own country.

(iii) To devise new contractual arrangements for securing to their members a proper measure of control over new uses and ensuring a fair remuneration for such uses. It goes without saying that the new contractual arrangements needed for licensing the new uses created by technology and new business enterprise should

provide the best possible terms for authors and composers. There may, however, be a danger that certain societies may not always have the resources to negotiate the best contracts and therefore consideration might be given to the special section of CISAC mentioned above making its service available, if required by a society, to assist that society in negotiating particularly difficult new contracts, e.g., for the licensing of CATV.

Allied with this task is the need, I suggest, to bring about greater uniformity both in the nature of the rights enjoyed by authors and composers in different countries, and in the contractual terms regulating their exploitation. Because of the intangible nature of intellectual works they are uniquely capable of virtually instantaneous promotion round the world; their export involves no aircraft, no ships, no customs barriers and, by comparison with most tangible goods, very little storage. It is clearly in the interests of authors and composers, and their advisers and business partners, to be able to make single world-wide contracts for the exploitation of their works and, for this purpose, to be in a position to know what effect such contracts will have under the laws of all the countries intended to be covered by them.

At present this is far from the case, and I believe societies could do a valuable service for authors and composers by seeking to bring about greater harmonisation. This is a task, by its very nature, which can hardly be done otherwise than internationally and therefore if it is accepted as a desirable objective, then it would seem that CISAC is the right organisation to accept responsibility for it, probably by using the services of the special section proposed above.

(iv) To take measures (including, where necessary, the amendment of their constitutions) to ensure that the policies of societies are not influenced by the interests of bodies and enterprises which, in the last resort, are in conflict with the true interests of authors and composers. This is a task which must be faced squarely. A record manufacturer and a composer have a mutual interest in seeing the sales of records of the composer's work reach the highest possible number, but on the question as to what share of the proceeds should be paid to the composer there is a clear conflict of interest; and between the composer and a publisher which is a subsidiary of that record company there is, in the last analysis, exactly the same conflict. This principle applies equally where the publisher is owned by a film producer or a broadcaster or any other music user. But this consideration, important though it is, must be

seen in proper perspective. Such publishers can, and in most cases do, provide a genuine publishing service for their composers in respect of which they are fully entitled to share in the revenues collected by authors' societies. They are also, in many cases, sources of information and advice of great value to societies and this benefit which arises from their membership of societies should not be lost. But in the final analysis when a decision has to be taken on an issue where there is a conflict between the interests of a composer and the interests of the person or company owning or controlling a publisher it is essential that the latter should not be in a position to impose his influence upon such a decision. Societies must ensure therefore that they are completely independent of interests which might conflict with those of the authors and composers whom they serve.

(v) To improve, and possibly devise new methods of distributing royalties collected. One of the spectacular features of the contemporary scene is the multiple scale on which copyrighted works are used. The performances of a popular work which actually take place, round the world, in the course of a relatively short period, say six months, would probably be measured in millions rather than thousands; similarly with the sales of recordings of a song at the top of the charts. In broadcasting, when one takes into account those countries such as the United States of America, where there are thousands of individual stations transmitting round the clock an almost unbroken output of musical works, the number of times one of the current popular works is broadcast must be enormous. The basic principle on which authors' societies operate is that composers and others interested in a work should receive a share of the royalties collected by the societies from their licensed users which is directly related to the extent to which those licensees have used that composer's works. The measurement, for this distribution process, of the extent of use of each work—in the broadcasting and in the public performance spheres—has always presented a problem. The volume and variety of uses which technology today makes possible means that the magnitude of the problem has been multiplied and new solutions to it must be sought. There are two facets to the problem, on the one hand to ensure that the extent of use of works currently in popular demand is accurately measured, even if every single use is not identified; on the other hand, to ensure that the occasional use of works not currently in popular demand is identified and credited with a fair payment. In approach-

ing this task societies should not only examine, as they already do, statistical sampling techniques but, I suggest, consider the possibility that technology itself may be able to produce devices for metering electronically the number of times individual works are used in various ways. This possibility might be explored in conjunction with the potential value of proposals like the universal numbering system, and I suggest that the investment by societies in such a research project, possibly administered centrally by CISAC, would be well worthwhile.

(vii) To study in depth the situation created by the increasing influence of commercial considerations over the creation and use of intellectual works, and the associated phenomenon of mass-produced output; and to examine whether the copyright system may not be in danger of, on the one hand, being undermined by changing standards of quality of output and, on the other hand, being overwhelmed by the ever-increasing quantity of output. Perhaps it may be possible to harness technology itself to the task of obtaining, recording and processing the information needed for protecting and enforcing the economic interests in this increasing avalanche of copyrighted works. At the same time it might be worthwhile to examine the question of whether it might be desirable, or practicable, to seek ways and means of limiting the full enjoyment of copyright protection in certain ways. For example, a system of registration which was a necessary condition to the enforcement of copyright through the courts, though not to the eligibility for copyright protection—along the lines of the U.S. copyright system—might serve to winnow out those “ephemeral works” created for a specific commercial objective with a purely transitory existence. Of course, it goes without saying that nothing must ever be done to imperil the basic concept that every “original” work is, without formality, eligible for copyright protection.

23.—My conclusion from this summary is that in one sense the role of authors' societies has not changed. It is, as it always has been, to administer as effectively as possible the rights entrusted to it and to be the watchdog and defender of authors' rights against attack from whatever quarter. But today's circumstances demand that this role be played on many stages and with new interpretations. Perhaps the most difficult aspect of the role of the authors' society today is the duty to serve the interests of the author with determination but at the same time to have that proper regard for the public interest as a whole which must go with the national status and prestige enjoyed today by our societies.

125. COPYRIGHT LAW AND COMPUTERIZED LEGAL RESEARCH.*

By HOWARD A. LEVY**

I. INTRODUCTION: WHAT IS COMPUTERIZED LEGAL RESEARCH?

The demands of law practice put a premium upon speed and thoroughness in problem-solving, and have given rise to legal research systems on computers. Take, for example, the attorney who needs an almost immediate answer to a problem involving "usage of an easement by prescription" under the law of a particular state. If he has access to a system like O.B.A.R.,¹ he may conduct a rapid "search" of the question. First, the attorney-operator telephones his identification number to the central computer whose data base or memory contains the state constitution, the code of statutes, and the full text of all opinions of the courts of the state. (Our hypothetical system has leading journals as well.) The computer replies in words flashed upon a television screen in the attorney's office. Attorney and computer now conduct a "dialogue," in which the former types out a key word—here, "easement"—to which the computer responds by transmitting the number of cases available that contain the word "easement" anywhere in the text of the opinion. The computer has been programmed to develop an inverted index that is like a concordance² and can respond with not only the full text of these cases, but with syllabi, abstracts, or citations. When the attorney gives another key word—"prescription"—the number of cases will be narrowed, and should he add another—"usage"—the number could be reduced to a more manageable figure. At this point he could request a

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1. The Ohio Bar Automated Research Corp. is a nonprofit corporation formed by contract between the Ohio Bar Association and Data Corp., a subsidiary of Mead Data Central, Inc. See Harrington, *Computers and Legal Research*, 56 A.B.A.J. 1145, 1146 (Dec. 1970).
2. A concordance is "an alphabetical verbal index showing the places in the text of a book or in the works of an author where each principal word may be found often with its immediate context." WEBSTER'S THIRD NEW INT'L DICTIONARY 471 (1970 ed.).

print-out of the cases in full, or the syllabi, abstracts, or citations. In addition, the computer could retrieve opinions from its "hot" file of most recent cases, or from a "cool" file of older cases, or from a file of cases from a certain period of years (e.g., before a statute changed the law regarding easements by prescription). To complete the search, there would be retrieval of pertinent statutes, a digest of relevant articles in legal periodicals, and even selected briefs and memoranda on file. The attorney has conducted his own search using key words in context and a computer-generated index. He has made use of both computer *hardware*, the machines, electronic circuitry and fixed control terminals, and computer *software*, the tape which records the signal combinations stored in the computer memory and which function as changeable control logic.³

Computer data retrieval systems now in operation have other features that assist legal research. While O.B.A.R. may offer West-type subheads, the LITE⁴ system uses SCOPE lines that appear at the head of each decision. Such lines are "limited editorial comment and are in essence concise descriptions of each decision."⁵ Another system, Aspen,⁶ has a unique on-line text editing system, which uses cathode ray tube terminals to conduct its search. Systems like these are being developed to offer various editorial aids. First, there is the "thesaurus-search," in which the computer would offer a list of synonyms for the key words

3. Jacobs, *Proprietary Protection of Hardware and Software*, COMPUTERS AND THE LAW 147-53 (A.B.A. Standing Comm. on Law and Technology, 2d ed. 1969).

4. Legal Information Through Electronics, managed by the U.S. Air Force as executive agent for the Defense Department.

LITE's data base contains the U.S. Code (1964 ed.), Decisions of the Comptroller General, U.S. Court of Claims Decisions, International Law Materials (D.O.D.), Court Martial Reports and the Manual for Courts-Martial.

LITE also uses a KWIC (key word in context) index, based upon the SCOPE lines discussed in the text.

See Lite Newsletter, 9 AFRP 1-4 (Oct.-Dec. 1971).

5. *Id.* at 3.

6. Aspen is an affiliate of the American Can Co., and specializes in litigation research. It was organized as the Health Law Center at the University of Pittsburgh in 1956. Literature is available from: Aspen Systems Corp., 4615 Forbes Ave., Pittsburgh, Pa. 15213.

GIPSY or the General Information Processing System, originated at the University of Oklahoma, has been patented.

transmitted by the operator, to provide a more complete examination of the topic. Second, there is electronic "shepardizing," whereby the computer would give a list of citations subsequent to the case at hand. Third, it may be possible to place the full texts or abstracts of legal books and periodicals in the data base, with a "specialized library" as a result. The method or *idea* of each of these aids, may not be copyrightable, but the *expression*, the particular input and the program/index for retrieval (other than the KWIC index), may be protected by copyright subject to the judicial doctrine of fair use. This essay will examine the copyright problems raised by computerized legal research systems, particularly those of the input, index, abstracts and editorial aids, the transmission from print to tape, and journals. Economic consequences of the use of computerized legal research will also be considered, with a view toward the problems of cost, the limitations of antitrust law, and the feasibility of a clearinghouse for legal "data." Finally, the essay will explore the competing interest groups and legal policies, and assess the directions in which computerized legal research may go.

II. LEGAL PROBLEMS OF COPYRIGHT AND COMPUTERIZED LEGAL RESEARCH

In the hypothetical above, the researcher created his own index of key-words-in-context, but the index in another sense was computer-generated, because the machine was programmed to develop an inverse index. The availability of copyright protection for the program is a major issue whose outcome has yet to be determined conclusively under the present Copyright Act.⁷ Whether subheads or other editorial aids are protected "expressions" is another problem, perhaps resolvable under the judicial doctrine of "fair use" of copyrighted material. A further difficulty lies in the transmission from print to tape, for this act may or may not be a "copy" or "performance" to which the copyright holder has the exclusive right,⁸ although it may be modified by the Revised Bill.⁹ When legal journals become part of the computer memory, there are special problems of copyright infringement at the input and retrieval levels, whose outcome may also turn upon "fair use," if not upon "un-fair competition" or judicial construction of the Copyright Act.

7. Title 17, U.S.C., as amended, Oct. 15, 1971, Pub. L. 92-140, 85 Stat. 391.

8. 17 U.S.C. §§ 1 (a), (d).

9. For text of the 1965 Revised Bill, see *Hearings before Subcomm. No. 3 of the House Comm. on the Judiciary*, H.R. 4347, 89th Cong., 1st Sess., § 8, pts. 1-3 (1966) [hereinafter cited as *Hearings*].

A. *The Inverse Index*

What is a computer program? For purposes of copyright law, the program is the "expression" of an underlying "idea" called an algorithm, which is translated into a set of instructions to the machine, written in symbolic form.¹⁰ The difficulty is that ideas lie in the realm of patent law, while expression lives in the domain of copyright, and the computer program does not fit neatly into the categories of expression protected under present law. While the Copyright Law of 1909 protects copyrighted works, which include the "writings of an author,"¹¹ the term "writings" may not cover coded programs on punched cards or magnetic tape stored in a computer memory, because they may be viewed as mere control mechanisms and therefore not subject to copyright protection.¹² On the other hand, computer programs may be registered under the present statute,¹³ and two proposed bills would protect "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated either directly or with the aid of a machine or device."¹⁴ Under the "tangible medium of expression" standard of the Revised Bill, original programs may be copyrightable.¹⁵ It is suggested that if this definition were binding, the user would pay a charge or "permissions" fee.¹⁶

At present, however, we are left with the basic distinction between "idea" and "expression" and the question as to whether the computer program fits either category or is *sui generis*. The United States Supreme Court held in *Baker v. Selden*,¹⁷ a decision predating the Act, that the copyright to a book describing a particular system of bookkeeping does not protect "the use of the art itself":

The use of the art is a totally different thing from a publication of the book explaining it. The copyright of a book on bookkeeping

10. Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 338-40 (1970).

11. 17 U.S.C. § 4.

12. Jacobs, *supra* note 3, at 150.

13. See Copyright Office Circular 31D (Jan. 1965).

14. Proposed § 102(a), 17 U.S.C.; see S. 597 and H.R. 2512 (90th Cong., 1967).

15. See R.B. §§ 101 (defining "copies" and "literary works"), 102, 106(a)(1), (5) (1965).

16. Breyer, *supra* note 10, 84 HARV. L. REV., at 340.

17. 101 U.S. 99 (1879).

cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book.¹⁸

Therefore in the absence of a patent upon the bookkeeping system, the defendant could legally sell forms similar to those described in the plaintiff's book. Even exact copies might seem allowable.¹⁹ However, where a copyrighted plan of insurance for the replacement of lost securities contains forms for a blanket bond and an indemnity agreement, close imitation of the bonds' language would be an infringement under 17 U.S.C. § 4. The latter situation is distinguishable from *Baker v. Selden*, because language explanatory of the insurance plan was "inseparably included" in the copied bonds; there is no infringement where one uses the language of the originator's forms as merely "incidental to its use of the underlying idea."²⁰ In the case of programs, the problem is that the instructional language might not be included with the index — in terms of *Baker v. Selden*, the "explanation" would be separate from the "use." It has been argued that a method, if sufficiently elaborated, should be the subject of copyright,²¹ but the difficulty remains that a computer program may be changed by a minor variation in sequence, causing doubt as to whether either the algorithmic idea or symbolic expression would be protected.

Despite this uncertainty, there are possible arguments available under patent and antitrust law. Hardware — the machine, circuitry, et al. — is covered by patent, but software may not meet the conditions of novelty and "unobviousness to the skilled artisan"²² requisite for a patent. Yet a computer with controls built into the hardware is patentable as a machine,²³ although the control hardware could be replaced by a stored program.²⁴ By extension of the latter position, a computer system having a novel stored program would be patentable as a complete and unique machine.²⁵ Absent patent protection, the computer software proprietor could take preventive action by means of a contract of use based on trade

18. *Id.* at 104.

19. B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 33, 64 (1967).

20. *Continental Casualty Co. v. Beardsley*, 253 F.2d 702 (2d Cir.) *cert. denied*, 358 U.S. 816 (1958).

21. Rubenstein, *Unfair Use of Elaborated Ideas*, 10 BULL. CR. SOC. 351 (1963).

22. 35 U.S.C. § 103.

23. *Id.* at § 101.

24. *Ex parte King*, 146 USPQ 590 (Pat. Off. Bd. App. 1964); *see* 35 U.S.C. 103, 101.

25. Jacobs, *supra* note 1, at 151.

secrets, under which an injunction or damages for wrongful disclosure might be obtained. The drawback is that one cannot prevent those who secure knowledge independently from making a practical application. In some instances the software owner might turn to antitrust law, for an action based on the tying arrangement by which a library of computer programs is given "free" with the purchase of hardware. The Justice Department's suit in 1969 against I.B.M. Corporation demanded separate pricing for hardware and software.²⁶

B. *Input, Storage and Retrieval*

Does a computer "copy" the material in its memory and "perform" the retrieved information in violation of the Copyright Act? To the extent that the input consists of court opinions or judge-authored syllabi, the material would seem to be in the public domain and consequently available to the computer.²⁷ However, where subheads or abstracts bearing substantial resemblance to a competitor's are used, the copyright proprietor may have a claim against the computerized legal research system for infringement. The system's defense of "fair use" will be examined below, in the context of case law, the Revised Bill, and the doctrines of unfair competition and common law copyright. In addition, the legal research system owners must anticipate the argument that the transmission from print to tape may be considered "copying," and that retrieval in the form of television images or printouts may be viewed as a "performance," so that both input and output may be limited by the copyright holder.

1. *Syllabi, Abstracts and Editorial Aids.* — It is clear that the computerized legal research system cannot infringe a copyright in original syllabi, a thesaurus, abstracts, digests or other "editorial aids,"²⁸ but these devices could be used either by arrangement with the copyright proprietor, or outright within the bounds of fair use. The Copyright Act of 1909 is silent as to this concept. 17 U.S.C. section 1 gives the copyright proprietor the exclusive rights: "(a) To print, reprint, publish, copy, and vend the copyrighted work," and the right to perform the copyrighted work publicly for profit if it is "(d) a drama or (e) a musical composition." The courts, though, have engrafted "fair use" onto the

26. *Id.* at 149-52.

27. *West Pub. Co. v. Lawyers' Co-Operative Pub. Co.*, 79 F. 756, 761 (2d Cir. 1897).

28. Special devices may include "phrase searching," "distance searching," and "date searching." See *Search Strategies*, 20-24 OBAR-MDC Pamphlet.

statute with emphasis upon the following elements: the nature of the original authorship and intention; status and purpose of the user; extent of the use; whether or not there is competitive effect upon the proprietor's interests; whether there is intent to plagiarize and the presence or absence of proper acknowledgment.²⁹ While scholarly research is generally considered fair use of copyrighted material, the realities of the market place are that law firms and law schools represent substantial demand for devices like syllabi and case digests, and that the copyright holder merits some protection for his original "expression." At the same time, there is the social need for dissemination of information in usable form.

Standards for the use of copyrighted syllabi, reports and digests were established in *West Pub. Co. v. Lawyers' Co-Operative Pub. Co.*³⁰ The defendant's employees had compiled a digest, "repeatedly and systematically [making] an unfair use of the [plaintiff's] copyrighted work, in order to save themselves the time and labor of original investigation," by taking nearly 6000 cases from the plaintiff's reporters, which had copyrighted syllabi and footnotes.³¹ Copyright protects only the original work of the reporter, but the subsequent compiler is bound to do what was done by the first compiler. Even the absence of identical language may not be enough to protect the user, if the court finds a pattern of repetition in verbal technique and common speech. In fact a presumption of copying can arise from a similarity of errors — Lawyers' Co-Operative repeated thirty-four of the mistakes West had made in digesting opinions.³² The relief granted was an injunction of the publication of defendant's whole work, with the exception of paragraphs digested from original sources like the advance sheets of the United States Supreme Court or court-prepared syllabi. However, the defendant was left free to show which paragraphs were prepared by non-infringing editors and thereby immune from the injunction. The legal research system, then, must do its original labor in preparing syllabi or head notes, or face the prohibitions of *West*.

29. See B. KAPLAN & R. BROWN, *CASES ON COPYRIGHT* 309-10 (1960).

The antecedents of the fair use criteria lie in *Folsom v. Marsh*, 9 Fed. Cas. 342 (CCD Mass. 1841). "Fair use" has also been defined as "a privilege in other than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the 'owner.'" See *Toksvig v. Bruce Pub. Co.*, 181 F.2d 664, 666 (7th Cir. 1950).

30. 79 F. 756 (2d Cir. 1897).

31. *Id.* at 772.

32. *Id.* at 759, 763-65.

Care must also be used in the compilation of a word list for the "thesaurus-search," to insure originality. In the first *Amsco* case,³³ the defendant copied the word list, with only trivial changes, from the plaintiff's copyrighted books which were used by high school students in preparation for the Regents' examination in French. The court found that copyright protects not only "writings," but "composite and cyclopedic works, directories, gazeteers, and other compilations,"³⁴ and that the "defendant's copying was unquestionably to avoid the trouble or expense of independent work."³⁵ Combined with the fact that defendant's book met the same demand in the same market, the copying contributed an unfair use.³⁶ In the second *Amsco* case,³⁷ another defendant copied diagrams from eleven pages of Amsco's book used by high school students for the Regents' examination in chemistry. Again this was an unfair use, because the diagrams were "original and novel and of high pedagogical value," and defendant and Amsco had appealed to the identical market.³⁸ The "thesaurus search" then, may or may not be a patentable "idea," but its contents or "expression" would appear to be copyrightable and subject to fair use.

Abstracts must also be original, and cannot be mere paraphrases of another's work. In *Rosemont Enterprises, Inc. v. Random House, Inc.*,³⁹ the copyright holder of three *Look* magazine articles concerning Howard Hughes was granted an injunction against the publication of a biography of Hughes by one John Keats. The defendant had directly appropriated information from the magazine articles, in lieu of doing his own independent research. Relying upon *West*, the court stated that copying by paraphrasing may be inferred even where there is little or no identity of language between the original and later passages, if the claimed infringer had access to the copyrighted work, made actual use of it, and copied certain portions. An unfair use has been made when

33. *College Entrance Book Co. v. Amsco Book Co.*, 119 F.2d 874 (2d Cir. 1941).

34. 17 U.S.C.A. 4, 5.

35. 119 F.2d 874, at 876.

36. *Id.*

The court pointed out that the plaintiff's originality in his choice of French words, articles and translations required an ingenuity equal to that needed to supply case annotations to statutes. *Id.*, citing *W. H. Anderson Co. v. Baldwin Law Pub. Co.*, 27 F.2d 82 (6th Cir. 1928).

37. *Colonial Book Co. v. Amsco School Publications, Inc.*, 41 F. Supp. 156 (S.D.N.Y. 1941).

38. 41 F. Supp. 156, at 160.

39. 256 F. Supp. 55 (S.D.N.Y. 1966).

substantial material has been taken from the copyrighted work by the infringing work — “substantiality” does not turn upon how much of the allegedly infringing work contains material from the copyrighted work.⁴⁰

As to digests, the criteria for determining fair use were reinforced in *Benny v. Loew's Inc.*,⁴¹ a leading case on the question of parody as infringement. The court, in dictum, pointed out that federal courts have dealt with fair use “in cases having to do with compilations, listings, digests, and the like, and . . . with the use made of prior compilations, listing, and digests.” While the author may consult earlier works in support of his own text, “it is generally held that if he appropriates the fruits of another’s labors, without alteration, and without independent research, he violates the rights of the copyright owner.”⁴²

Continued allowance of the fair use defense may be made in the future, if the Hearings for the 1965 Revised Bill⁴³ are an accurate indication. The Bill’s draftsmen accepted the doctrine of fair use in section 107, but rejected any statutory definition of its criterion.⁴⁴ This position seems to leave the matter up to the federal courts, because section 301(a) declares that the Revised Bill governs “exclusively” and that no person is entitled to rights of copyright ownership under common law or state statutes. The remaining statutory issue before the House Committee on the Judiciary was whether the computer could “copy” or “perform” so as to infringe an existing copyright.⁴⁵ Under the 1909 Act, only the input or retrieval that results in “visually perceivable material” constitutes the making of a “copy.”⁴⁶ How *should* the Revised Bill treat “copying” in the context of fair use? The Register of Copyrights has stated that present technology should not fix the limits of the

40. 256 F. Supp. 55, at 63.

41. 239 F.2d 532 (9th Cir.), *aff'd sub. nom.*, *Columbia Broadcasting System, Inc. v. Loew's Inc.*, 356 U.S. 43 (1958).

42. *Quoted in* B. KAPLAN & R. BROWN, *supra* note 29, at 319.

43. See note 9 *supra*.

44. B. KAPLAN, *supra* note 19, at 99-102.

For a discussion of the problems of statutory enactment of fair use, see Cannon, *Fair Use: The Advisability of Statutory Enactment*, 13 IDEA 240 (1969).

On the difficulties of passage in the Senate of the entire Revised Bill, see Nimmer, *New Technology and the Law of Copyright, Reprography and Computers*, 16 UCLA L. REV. 93 (1968).

45. B. LINDEN, LAW AND COMPUTERS IN THE MID-SIXTIES. See *Hearings* at part 3, 1421-24.

46. *Id.* at 1422.

exclusive rights granted to the copyright proprietor.⁴⁷ Conversely, it has been suggested that the use of a computer to perform an act which is otherwise a fair use, should also be a fair use.⁴⁸ Specific acts which a leading member of the copyright bar considers fair use include the citation of excerpts from a work, the preparation of an index to a work and the making of an abstract of a work. The items produced should be protected so long as they do not displace the original copyrighted work and are not sold to the reading public in competition with the original copyrighted work. Where an abstract becomes more of an extensive synopsis, or a book is rewritten in another form, it should be an unfair use because of its substantial borrowing from the author, without independent labor or research. Yet on balance, allowing abstracts to be made from literary material can benefit the copyright owner, to the extent that interest is increased in the original work.⁴⁹

Even where fair use is asserted as a valid defense, the copyright proprietor might still claim that there has been a "misappropriation" of his work product by a data retrieval system. He could argue that the market for his work has been diminished as a result of access to it (or to excerpts) by means of the computer system.⁵⁰ This is the doctrine of unfair competition, which has its origins in *International News Service v. Associated Press*.⁵¹ The United States Supreme Court held that I.N.S.' continuous practice of appropriating and publishing news dispatches from A.P., its competitor, constituted "unfair competition." Judge Learned Hand criticized the *I.N.S.* doctrine as justifiable only on its facts (an instance of news piracy) and that constructing unfair competition as a kind of irregular patent or copyright clashes with the statutory scheme already in existence.⁵² Judge Hand's criticism seemed to foreshadow two cases which have eroded *I.N.S.* except in cases of outright appropriation.⁵³ In *Sears, Roebuck & Co. v. Stiffel*⁵⁴ and *Compco*

47. *Id.* at 1423.

48. Letter of Reed C. Lawlor, in *Hearings*, at 1914.

49. *Id.* at 1915.

50. LINDEN, *supra* note 45, at 1424.

See *Addison-Wesley Publishing Co. v. Brown*, 133 U.S. Patent Quarterly 647 (Eastern Dist. N.Y. 1962) (defendant's book of answers to questions in plaintiff's text would cause schools to stop purchasing plaintiff's book).

51. 248 U.S. 215 (1918).

52. See *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir.), *cert. denied*, 281 U.S. 728 (1930).

53. Nathan, *Unfair Competition in Intellectual Products in the Public Domain*, 10 PEAL 456, 466 (1970-71).

54. 376 U.S. 225 (1964).

Corp. v. Day-Brite Lighting, Inc.,⁵⁵ the Supreme Court held that where an article is not protected by patent or copyright (pole lamps in *Stiffel*, fixtures in *Compco*), state law of unfair competition cannot prohibit copying of the article itself. Consequently, Sears had the right to copy, design and sell lamps almost identical to those of Stiffel. On the surface, *Sears* and *Compco* threaten the protectibility of the easily-varied computer programs required for legal research systems. However, these decisions do not invalidate state laws based upon fraudulent practices or the use of an identical product.⁵⁶ Section 5 of the proposed Unfair Competition Act of 1966 gave blanket jurisdiction to the federal courts and condemned "any act in Commerce which results or is likely to result in misappropriation of quasi-property of another, not otherwise protected by federal statute."⁵⁷ The thrust of the statute is to reconcile *Sears* and *Compco* with *I.N.S.*, and protect both the literary author and the proprietor of the computer program from acts of misappropriation.

It should be noted that an attorney's brief or judicial memorandum might be protected under the common law of copyright that pertains to *unpublished* material.⁵⁸ For example, in the more recent dispute concerning a purported Howard Hughes autobiography, it was suggested that Rosemont Enterprises, Inc. has a claim to a common law copyright over an unpublished biography of Mr. Hughes.⁵⁹

When the computer's input, storage or retrieval does constitute infringement, the copyright proprietor has a number of remedies. The present Copyright Act provides for injunction, damages and profits, impounding during action, destruction of infringing copies and plates, royalties (and compulsory licensing in the case of phonograph records under 17 U.S. section 1(e)), and payment of costs and attorney's fees⁶⁰

55. 376 U.S. 234 (1964).

56. M. NIMMER, COPYRIGHT 145 (1963).

57. 10 PEAL, *supra* note 53, at 470-71.

58. 'Common law copyright' refers to protection for unpublished work under state law. A work is protectible under common law copyright if the expression is developed beyond the point of a mere abstract idea, if the work is original with its author and if it is unpublished. See M. NIMMER, COPYRIGHT (1971 ed.), Secs. 10, 11.2.

59. Celsner, *Dispute Over Hughes Book: Law Professor's Dream Case for Examination Day*, N.Y. Times, Feb. 5, 1972.

Note that *Rosemont Enterprises, Inc. v. Random House, Inc.*, 256 F. Supp. 55 (S.D.N.Y. 1956), involved the infringement of material in which Rosemont had a copyright. See text accompanying notes 39, 40, *supra*.

60. 17 U.S.C. §§ 101(a)-(e), 116.

in appropriate cases. It is important that the copyright proprietor follow the procedure for notice and registration.⁶¹

2. *Transmission From Print to Tape.*— In order to store data in its memory, a computer must transmit material from print to tape, discs, or cards. Is this act “copying” and therefore an infringement? The United States Supreme Court in *White-Smith Music Pub. Co. v. Apollo Co.*⁶² held that a perforated roll of paper was not a copy of a musical composition because the roll could not be read without a peculiar skill and was therefore not a system of “intelligible notation.” It requires special skill to read a computer’s symbolic language as well, and it is believed that the “intelligible notation” test would allow computers to use copyrighted material.⁶³ On the other hand, Justice Holmes, concurring in *White-Smith*, stated that “protection ought to go to the ‘essence’ of the collocation; [to] . . . the possibility of reproducing the result which gives the invention its meaning and worth.”⁶⁴ This language may mean that transmission to computer tape, which gives the *result* of copyrighted material is an infringement.

3. *Output.*— Computers present an additional problem in defining output. Is the mere scanning of material, where a copy is created in the course of a computer’s search of its memory and then erased, a “copy” that constitutes output? The president of a small clearing-house for computer programs has urged that such activity of a strictly transitory nature should be excluded from the definition of “copies.”⁶⁵ It could also be argued that duration should not be relevant to the act of copying when technology is continually transforming notions of time. A “performance,” after all, is given only once and is finished, while a “copy” connotes a degree of permanence.

Interestingly, the courts have split on the question of whether the “ephemeral reproduction” of a motion picture film constitutes an in-

61. B. KAPLAN, *supra* note 19, at 82.

62. 209 U.S. 1 (1908).

63. Lawlor, *Copyright Infringement by Computer*, COMPUTERS AND THE LAW 161-64 (A.B.A. Comm. on Law and Technology, 2d ed. 1969). See also Bigelow, *The Computer as a Copyright Infringer*, 1 LAW & COMPUTER TECHNOLOGY 2-5 (May 1968).

64. 209 U.S. 1, 18 (1908).

65. Statement of John F. Banzhaf III, President, Computer Program Library, in *Hearings, supra* note 9, at 1148, 1149.

fringing copy.⁶⁶ One wonders, then, whether images on O.B.A.R.'s television screen could constitute an infringing reproduction. They may be "performances," if not "copies;" both are terms of art. In *Fortnightly Corporation v. United Artists Television, Inc.*,⁶⁷ the United States Supreme Court held that CATV systems which received a licensed broadcast and retransmitted it to subscribers did not infringe the rights of the copyright owner, because CATV was not part of a transmitting or performing system.⁶⁸ By analogy, a computer that is part of a reading system (at least at the input or storage levels) might be protected.⁶⁹

C. Input and Retrieval of Legal Journals

1. *Photocopying of Legal Journals.* — It is conceivable that the contents of legal journals might be typed directly onto magnetic tape and stored in the computer memory for retrieval by legal researchers. This possibility raises the issue of input of copyrighted material, and constitutes a legal and economic threat to journal publishers. The reproduction of excerpts from law reviews by means of photocopying is a particularly troublesome "use." Where the copying is too frequent or is overly substantial, the computer proprietor (who offers printouts from his data base, if not photocopies) risks an infringement suit. An analogy may be drawn to *The Williams and Wilkins Company v. The United States*,⁷⁰ where the unauthorized photocopying of medical journals by the libraries of the National Institute of Health and the National Library of Medicine was held an infringement. The journal's publisher was entitled to recover "reasonable and entire compensation" under 28 U.S.C. section 1498(b).⁷¹

Williams and Wilkins made an impact upon the authors, publishers and libraries — including the American Association of Law Libraries —

66. Compare *MGM Distributing Corp. v. Wyatt* (21 *Copyright Off. Bull.* 203) (Dist. Ct., Md. 1932) (projection of motion picture film on a screen is not an infringing copy) with *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (1937) (ephemeral reproduction of a motion picture film does constitute an infringing copy).

67. 392 U.S. 380 (1968).

68. A similar result was just reached in a suit by CBS, in which Tele Prompter's pick up of signals broadcast by CBS was ruled not in violation of copyrights because the cable television system did not "perform" plaintiffs' works but was merely a "reception service." See *Cable T.V. Ruled Not in Violation of Copyrights*, WALL ST. J., p. 2, May 3, 1972.

69. Lawlor, *supra* note 63, at 163.

70. 73-68 U.S. Ct. of Claims (Comm. Report, Feb. 16, 1972).

71. Under this statute, agencies of the U.S. may be liable for infringement.

who filed *amicus curiae* on their respective sides,⁷² because the Court recognized that even where research personnel are involved, photocopying, unlike the traditional copying by scholars, may be conducted to the extent of infringement.⁷³ Consider that the NIH and the NLM operate massive libraries for professional research, so that a photocopy of a particular article could be requested by many different users. While the defendant argued that 17 U.S.C. section 1 allows the making of single copies, one at a time, as opposed to the "publication" of multiple copies of a copyrighted work, the Court felt that Congress proscribed unauthorized duplication: ". . . in essence, the systems [of defendant] are a reprint service which supplants the need for journal subscriptions."⁷⁴ It should follow that computer printouts of articles from legal journals going to a number of different users could constitute infringement under *Williams and Wilkins*. On the other hand, a legal research system that avoided wholesale copying might succeed.

One solution might be licensing by the journal publisher directly, or by payment of royalties to a clearinghouse.⁷⁵ Payment would run to the journal publisher, who by custom is assigned the author's copyright,⁷⁶ unless a clearinghouse or private agreement between author and publisher is to the contrary. The "real-party-in-interest" in *Wilkins* was not the medical societies as defendant contended, but the publisher, who as the record owner, is responsible for procuring copyright registration.⁷⁷ Consequently, it is the publisher's market that is diminished by photocopying.⁷⁸

72. The Association of American Publishers, Inc., and the Authors League of America, Inc. filed *amicus* for the plaintiff; the American Library Association, the Association of Research Libraries, the Medical Library Association and the American Association of Law Libraries filed in support of the defendant.

73. 73-68 U.S. Ct. Cl., at 11-15, 21-24.

74. *Id.* at 14. Exact duplication of even a single copy of a copyrighted work can constitute infringement. See dictum in *White-Smith Music Co. v. Apollo Co.*, 209 U.S. 16, 17 (1908).

75. The NLM and NIH libraries kept track of photocopy requests for plaintiff's journals for a 90-day period in 1967 and calculated that they would have owed \$250 to \$300 on the basis of a royalty of two cents per page. 73-68 Ct. Cl. at 30, n.17.

A clearinghouse for libraries was suggested in H.R. REP. NO. 83, 90th Cong., 1st Sess. 36 (1967). See also text accompanying notes 93-96 *infra*.

76. See *Geisel v. Poynter Prod. Inc.*, 295 F. Supp. 331, 160 U.S.P.Q. 590 (S.D.N.Y. 1968).

77. 73-68 Ct. Cl. 10, 11. Generally the bar associations and law reviews act as the publishers of their own journals.

78. *Id.* at 21-23.

2. *Effect Upon Law Review Publication.* — To ascertain the potential effects of the input of legal periodicals in computerized legal research systems, the writer questioned the editors of a number of law reviews. It was learned that the *Ohio State Law Journal* has no statutory copyright on its earliest volumes (i.e., volumes 1-8 were not formally copyrighted) but had a general copyright on its later volumes. However, it sold the inventory of volumes 9-24 to a publisher together with a right to reproduce those volumes; this is a common practice. The present editor believed that contract obligations or University regulation might prevent granting of permission to an O.B.A.R. type system for reproduction on tape, but that permission could probably be granted on the latest volumes (25-32), which had not been sold. Another barrier might be the retained rights of the authors, who must receive at least credit for excerpts of their work. In the event of transmission to computer tape, the law journal would require a royalty for the expected decrease in circulation. Currently, Ohio State exchanges 175 copies of its journal with other reviews.⁷⁹

Like Ohio State, the *Land and Water Law Review* of the University of Wyoming holds a general copyright, except where an author individually copyrights his article. Moreover, Wyoming's policy is not to grant permission for reproduction of articles unless the author gives approval. The Wyoming faculty editor recognized that once articles were put into the computer, at least a "minimal royalty" would be "desirable." Once computer systems for legal research were widespread, however, the situation would be more ominous:

I think the effect of extensive use of complete retrieval systems would reduce our circulation. It isn't very large, as is. Since we depend on subscription payments for the bulk of our financing and alternative financing is not readily available, we would be left with few choices: reduce size or reduce quality, or both. Perhaps we would be forced to quit publishing. I do not think attorneys, professor[s] and students now supporting the Review (by subscribing to it) would continue to send us their checks for fewer "published" copies (i.e. if they subscribe to the computer service) . Why pay twice?⁸⁰

Wyoming too conducts exchanges with other reviews. It loses no money on them by billing its library for its own subscription rate for "ex-

79. Letter to the writer from Mr. Frederick R. Reed, Editor-in-Chief, *Ohio State Law Journal*, May 2, 1972. See Appendix to this essay.

80. Letter to the writer from Mr. Calvin E. Ragsdale, Faculty Editor, *Land and Water Law Review*, April 3, 1972. See Appendix.

change" copies received.⁸¹ A clearinghouse for material in a data base would function similarly, *i.e.*, there would be no cost for reciprocal exchanges conducted by the computer itself.

III. ECONOMIC PROBLEMS OF COMPUTERIZED LEGAL RESEARCH

The future of computerized legal research depends to a large degree upon the evolution of a system that takes into account the economic power of competing groups. At stake are the interests of copyright proprietors (authors and publishers) who would charge royalties at the time of input, educational institutions who would claim exemptions from such charges, professional groups who would support the data systems, government agencies who seek free use of intellectual property in the public interest, and the brokers who propose a central licensing agency for input material.⁸² While the matter is unresolved, development costs of computerized legal research have been quite substantial.⁸³ Further, the proposed broadening of the "fair use" standard would have economic effects upon these groups. Perhaps cost-sharing through a clearinghouse would be a workable solution.

A. *Economic Consequences of the Liberalization of Fair Use*

In response to the increased copyright protection offered by the Revised Bill of 1969,⁸⁴ it was argued that the exclusive rights granted under copyright law would prevent competition and keep the prices of textbooks from falling.⁸⁵ On the other hand, abolition or reduction of copyright protection could cause economic damage to the initial publishers to a degree that would harm authors and society without significant competitive benefit.⁸⁶ It is useful to examine both of these arguments, because of the possibility that computer services could replace, to no small degree, the hardcover books and journals that might form a substantial part of the backbone of a legal research system.

81. *Id.* The complete text of the letters from Mr. Reed and Mr. Ragsdale may be found in the Appendix to this essay.

82. Lawlor, *supra*, note 63, at 162.

83. Programs for legal research systems like those discussed in Part II of this essay have been estimated by private sources to run to millions of dollars in Ohio.

84. Copyright Revision Bill S. 543, 91st Cong., 1st Sess. (1969).

85. Breyer, *supra* note 10, at 281.

86. Tyerman, *The Economic Rationale for Copyright Protection for Published Books: A Reply to Professor Breyer*, 18 U.C.L.A. L. REV. 1100 (1971).

One of the basic assumptions underlying the law of copyright is that the initial publisher needs protection for a given period from copiers, to enable him to recover the fixed costs of author royalties, editing, typesetting and promotion.⁸⁷ Absent copyright, the copier would enjoy the advantages of publication without these "start-up" costs. Yet it has been contended that the copier may lose his advantage, where, with the aid of the computer, a printer may make plates directly from a typed manuscript, eliminating the cost of retyping copy onto a linotype machine.⁸⁸ The initial cost of printing is thereby lowered, and the publisher gains the advantage of "lead time" over copiers in the market place.⁸⁹ This contention fails to take into account the weight of other fixed costs, which, in the tradebook field, require the publisher to wait months to recover initial expenses; in the case of textbooks, it is a matter of years. By contrast, the photocopier can produce a softcover edition in a matter of hours.⁹⁰ It is also contended that the publisher's threat of retaliation — by selling a "fighting edition" below cost — would act as a countervailing force, but there is no guarantee that he could do so profitably.⁹¹ To maintain publisher's revenue, organized groups of buyers (such as practicing attorneys) might engage in advance buying of books, guaranteeing a return. The problem with this method is that it would involve administrative costs, deprive buyers of the opportunity to examine books beforehand, and create an opportunity for freeloading.⁹² On balance, however, subsidies from professional groups might not be unreasonable for two reasons: First, university subsidization of law journals is often necessary to maintain quality. Secondly, selection of revised case books exists on an advance-order basis already. With copyright in its present form, it has been argued that transaction costs for permission to make copies are an unnecessary economic burden, and that photocopying can bring wider dissemination of works at lower cost. Yet the current fair use doctrine keeps transaction costs at a minimum, while protecting the copyright proprietor from duplication. In fact, future changes in photocopying services (*e.g.*, printing or copying of a single book at the command of an individual buyer) may require a

87. *Id.* at 1103-07.

88. M. LEE, BOOKMAKING: THE ILLUSTRATED GUIDE TO DESIGN PRODUCTION 57-61 (1965).

89. 84 HARV. L. REV. 299-302.

90. 18 U.C.L.A. L. REV. 1108-12.

91. 84 HARV. L. REV. 301, 302; 18 U.C.L.A. L. REV. 1112, 1113.

92. 84 HARV. L. REV. 302-06; 18 U.C.L.A. L. REV. 1115-17. Government subsidies would be an alternative, perhaps unwelcome in an area of private creativity and market competition.

strengthening of the requirement of accounting to the copyright proprietor.⁹³ There may be antitrust problems if exclusive rights could be shown to increase market concentration, but the evidence is that the publishing field has a relatively low barrier of entry.⁹⁴

B. *A Clearinghouse for Legal Research*

The optimum need is to reduce transaction costs to insure maximum availability of materials for legal research. A clearinghouse for copyrighted programs is already in operation in New York City,⁹⁵ and the Defense Department maintains a clearinghouse for scientific and technical information.⁹⁶ The real prototype is the clearinghouse operated by the American Society of Composers, Authors and Publishers. Members of ASCAP grant non-dramatic performing rights on a non-exclusive basis to the Society. ASCAP then contracts for bulk licensing on a blanket basis to the broadcasting industry, with royalties divided between the publishers and writers. Revenues are distributed on the basis of performance surveys which give rise to weighted "credits" to each member.⁹⁷ An antitrust decree prevents ASCAP from prohibiting a copyright owner who is a Society member from licensing his own works.⁹⁸ It is conceivable that accredited law schools could form a clearinghouse partially along the lines of ASCAP, to which each would contribute the contents of its legal journal, on a non-exclusive basis, in exchange for the right to use whatever legal material is available to members. The clearinghouse

93. 84 HARV. L. REV. 316-18; 18 U.C.L.A. L. REV. 1122, 1123.

94. 84 HARV. L. REV. 318-31; 18 U.C.L.A. L. REV. 1123-25.

95. This is the Computer Program Library. See statement of John F. Banzhaf III in *Hearings, supra* note 9, at 1146-49.

96. The government disseminates technical information through the Dept. of Defense Documentation Center and the Dep't of Commerce Clearinghouse of Federal Scientific and Technical Information. See Statement of Maxwell C. Freudenberg, Dep't of the Air Force in *Hearings, supra* note 9, at 1162-72.

An important sub-issue, beyond the scope of this essay, is to what extent the government and its attorneys should be exempt from restrictions upon users of copyrighted materials. Competing interests are internal security needs and the rights of the copyright proprietor.

97. B. KAPLAN & R. BROWN, *supra* note 29, at 428-38. Other major licensing organizations in the music field are Broadcast Music, Inc. (BMI) and the Society of European Stage Authors and Composers (SESAC).

98. *U.S. v. ASCAP*, 341 F.2d 1003 (2d Cir. 1965). Its antecedents are: *Alden-Rochelle, Inc. v. ASCAP*, 80 F. Supp. 888 (S.D.N.Y. 1948) and *M. Whitmark & Sons v. Jensen*, 80 F. Supp. 843 (S.D. Minn. 1948).

would have to go beyond the exchange of law reviews and the Index to Legal Periodicals to have economic appeal. "Performance" ratings could be given to member law reviews in terms of frequency of usage, which would not be unlike the practice in music publishing. A computer could be programmed to record such usage, though at considerable expense. The ultimate aim is to expand the O.B.A.R. type of legal research system to include journals and certain books and memoranda, so that a computer search of relative thoroughness may be made through a clearinghouse, while the individual copyright proprietor remains free to license his works for publication.

IV. CONCLUSION

THE FUTURE OF COMPUTERIZED LEGAL RESEARCH

The development of computerized legal research would be furthered by a clear determination of the status of the computer program as an "idea", an "expression" or as a new entity, so that patent, copyright or another form of legal protection becomes available for the inverse index that makes the system useful. Under the Copyright Act and the Revision Bills, it is also unclear whether the input, storage or retrieval of data by the computer constitutes "copying" or a "performance" to the point of infringement. As the data base for legal research expands to include statutes, opinions, indexes, agency documents, briefs and memoranda, the proprietary rights to the material will be exclusive within the judicial boundaries of fair use. In addition, the publishers of legal books and periodicals must realize the possibility of competition from computer printouts and photocopies of material stored in the computer memory. Accordingly, the legal profession ought to anticipate the legal and economic results of widespread use of the computer for legal research, and determine priorities among royalties, licensing and a clearinghouse.

The underlying policy of article I, section 8 of the United States Constitution is to balance the incentives to authors and publishers with the need to disseminate their work for the benefit of society:

The Congress shall have 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.

Through the assurance of rights to compensation, the copyright law gives the incentive to write and to publish. Therefore, the future

utilization of computerized legal research may depend upon how the copyrightable data and methods of organization may be employed without lessening the professional and monetary rewards of authorship and publication.

APPENDIX

- A. Letter from Mr. Frederick R. Reed, Editor-in-Chief, *Ohio State Law Journal*, The Ohio State University College of Law, Columbus, Ohio 43210 (May 2, 1972). See attached letter.
- B. Letter from Mr. Calvin E. Ragsdale, Faculty Editor, *Land and Water Law Review*, University of Wyoming College of Law, Laramie, Wyoming 82070 (April 13, 1972). See attached letter.

OHIO STATE LAW JOURNAL
THE OHIO STATE UNIVERSITY
COLLEGE OF LAW
COLUMBUS 43210

May 2, 1972

Mr. Howard A. Levy
The Franklin Thomas Backus School
of Law
Case Western Reserve University
Cleveland, Ohio 44106

Re: Use of Ohio State Law Journal in data retrieval systems

Dear Mr. Levy:

The Ohio State Law Journal is currently in the process of publishing Volume 33. The copyright status of earlier volumes varies so that no general answer to your questions may be correctly given. Volumes 1-8, published between the years 1935 and 1942 inclusive, were never copyrighted; a common law copyright therefore exists as to these volumes.

We have a general copyright on Volumes 9-24, but our entire inventory of Volumes 1-24 has been sold to a publishing company together with a right to reproduce those volumes. We are presently researching the question of our right to permit the O. Bar computer system to place these volumes of the Journal into a data retrieval system.

We hold a general copyright on Volumes 25-32 and are almost certainly able to grant O. Bar permission to so use the Journal material,

but such a decision may be subject to University regulation or contract obligations to the publisher described above.

With respect to your question concerning rights retained by authors, although we hold a general copyright on our materials, authors do retain some rights. Sections from the work of contributing writers cannot be excerpted without provisions being made to properly credit their work.

The use of journal material by computer services would probably not immediately affect our financing, but we feel that the payment of a royalty would be required to maintain our financial position into the future. Currently we are at least partially dependent upon circulation to subsidize the operation of our journal. As the use of such computer services increases, our circulation could decrease and we would then be required to rely on the royalty to compensate us for that loss.

In response to your final question, we currently exchange 175 copies of the Ohio State Law Journal with other law reviews.

Thank you for your interest in the Ohio State Law Journal. I hope this information is helpful to you.

Sincerely,

Frederick R. Reed
Editor-in-Chief

FRR:ne

University of Wyoming
College of Law

LAND AND WATER

LAW REVIEW

UNIVERSITY STATION, BOX 3035
LARAMIE, WYOMING 82070

PHONE 766-3359
AREA CODE 307

April 13, 1972

Howard A. Levy
The Franklin Thomas Backus School of Law
Case Western Reserve University
Cleveland, Ohio 44106

Dear Mr. Levy:

Thank you for your letter regarding putting law review texts on magnetic tapes or discs for use in data retrieval systems. I will try to answer your questions as best I can.

First, so far as I am aware, we hold a general copyright to the articles published, except insofar as an occasional article is individually copyrighted by the author. It is, however, our present policy to condition our permission to reprint or reproduce articles on the approval of the author concerned. So far as I am aware, an author has never refused such permission. (I think that takes care of questions one and two of your letter).

Question three presents some problems. I simply do not know what our attitude would be if ever such a request were presented us. I would assume that we would make such a decision on the basis of what we thought the effect on our circulation would be, and whether the requesting enterprise was in any way commercial. I personally think that a minimal royalty would be desirable, but the decision has never been made and is not completely mine to make.

I think the effect of extensive use of complete retrieval systems would reduce our circulation. It isn't very large, as is. Since we depend on subscription payments for the bulk of our financing and alternative financing is not readily available, we would be left with few choices: reduce size or reduce quality, or both. Perhaps we would be forced to quit publishing. I do not think attorneys, professor and students now supporting the Review (by subscribing to it) would continue to send us their checks for fewer "published" copies (i.e. if they subscribe to the computer service). Why pay twice?

Finally, we do have some arrangements for exchange of copies with other law reviews, although it may be unusual. (It probably is not). We exchange with those Reviews willing to reciprocate. We direct that such "exchange" copies be delivered to our library and we bill our library our subscription rate for each such exchange. Thus, we lose no subscription money.

I would appreciate knowing the results of your project. It is also probably worth noting that the Wyoming Law Journal ceased publication in 1965 and was replaced in 1966 by the Land and Water Law Review.

Very truly yours,
Calvin E. Ragsdale
Faculty Editor

CER:gep

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. United States of America and Territories

126. U.S. CONGRESS. SENATE. *Committee on Foreign Relations.*

Revised Universal Copyright Convention; hearing, Ninety-second Congress, second session, on Executive G, 92d Congress, 2d Session: The Universal Copyright Convention, as revised at Paris on July 24, 1971, together with two related protocols. August 2, 1972. Washington, U.S. Govt. Print. Off., 1972. 158 p.

Most of the testimony was in support of Senate ratification of the Universal Copyright Convention as revised at Paris in 1971.

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

Public law 92-566, 92nd Congress, S.J. Res. 247, October 25, 1972. Joint resolution extending the duration of copyright protection in certain cases. [Washington] GPO [1972]. 1 p. (86 STAT. 1181)

This eighth in a series of laws providing for the automatic extension of copyrights in their renewal term extends the duration of those copyrights to December 31, 1974.

2. Foreign Nations

128. BULGARIA. *Laws, statutes, etc.*

Law on copyright (as last amended on April 28, 1972). *Copyright*, vol. 8, no. 11 (Nov. 1972), pp. 223-226.

"The basic Law is dated November 16, 1951; it was amended by Decree No. 207 of July 4, 1956. WIPO translation."

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

129. BERNE COPYRIGHT CONVENTION. *Revisions, 1971.*

Der Pariser Akt der Berner Übereinkunft. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, nos. 8/9 (Aug./Sept. 1972), pp. 300-332.

English, French and German in parallel columns.

130. UNIVERSAL COPYRIGHT CONVENTION. *Revisions, 1971.*

Das revidierte Welturheberrechtsabkommen. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, nos. 8/9 (Aug./Sept. 1972), pp. 282-300.

English, French and German in parallel columns.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

131. *Custom Recording Co., Inc., et al. v. Columbia Broadcasting System, Inc.*, 175 USPQ 641 (U.S. Sup. Ct., November 13, 1972). *For decisions below, see* 174 USPQ 309 (S. Car. Sup. Ct., 1972), 19 BULL. CR. SOC. 504, Item 349 (1972), *reversing*, 171 USPQ 502 (S. Car. Ct. Comm. Pleas), 19 BULL. CR. SOC. 412, Item 261 (1972).

Petition for writ of certiorari.

Held, denied.

132. *Picture Music, Inc. v. Bourne, Inc.*, 175 USPQ 577 (U.S. Sup. Ct., November 6, 1972). *For decisions below, see* 457 F.2d 1213, 173 USPQ 449 (2d Cir., 1972), 19 BULL. CR. SOC. 312, Item 195 (1972), *affirming* 314 F.Supp. 640, 167 USPQ 348 (S.D.N.Y. 1970), 18 BULL. CR. SOC. 324, Item 251 (1971).

Petition for writ of certiorari.

Held, denied.

133. *Marcel Dekker, Inc. v. Anselme et al.*, 175 USPQ 513 (1st Cir., October 12, 1972) (Coffin, J.)

Defendants' appeal from denial of its motion for summary judgment and injunctive relief (on counterclaim) in action for copyright infringement and unfair competition.

Held, appeal dismissed.

The court held that the order refusing relief below was not appealable under 28 U.S.C. § 1292 (a) (1), stating in part:

[Defendants made several arguments against the validity of the plaintiff's copyrights, only some of which were rejected by the court below]

The court has not yet decided that the copyright was valid or even that the defendant had failed to show the probability of success as to the invalidity of the copyright, which would be one of the findings necessary to entitle him to injunctive relief. Nor did the court find a lack of irreparable injury or other separate requirement for injunctive relief which would mandate denial of the injunction regardless of its findings as to the merits. The policy of the federal appeals statutes against piecemeal litigation would be seriously frustrated were we to permit parties to appeal rejection of any argument which if successful would have provided one of the several elements necessary for injunctive relief. Indeed to allow appeals under such circumstances would deter district judges from processing cases efficiently by deciding each issue at the time that it is ready for decision.

134. *L & L White Metal Casting Corp. v. Cornell Metal Specialties Corp., et al.*, 175 USPQ 464 (E.D.N.Y., June 7, 1972) (Moore, J.)

Action for copyright infringement in metal castings.

Held, judgment for plaintiff.

1. *Copyright Notice*

The notice on plaintiff's castings bore the designation "L & L WMC" in lieu of its corporate name. The court held that, notwithstanding that there was little evidence that this designation was well known in the industry, plaintiff had "substantially" and sufficiently complied with the notice provisions of the Copyright Act since "plaintiff has existed as either a company or a corporation for over 35 years in an industry in which there are apparently relatively few established manufacturers. In addition, L & L WMC is a registered trademark, [and plaintiff] has filed a state certificate permitting it to do business under these letters and the letters appear on all of its advertising brochures."

Defendant argued that plaintiff's notices were insufficient since they would be covered on finished—i.e., plated—castings. However, the court observed:

If the defendants had only copied the finished works they could have then argued that there was no possibility the notice could be seen. Here, however, only the raw castings were copied. The notice was plainly visible to anyone seeking to copy the castings.

The defendants also argue that the notice could have been placed on a more accessible portion of the castings. The Court

has examined the castings and concludes that the defendants have not carried their burden in this respect.

2. *Abandonment*

Defendant urged that plaintiff had "abandoned" its copyrights by permitting the distribution of copies of its castings without notice and publishing an "improperly copyrighted" catalog depicting same, but the court held that there was "no evidence indicating any intent to abandon the copyright . . . and there was no evidence that the plaintiff permitted many unauthorized and uncopyrighted 'copies' to circulate over a long period of time. . . . Also, while the copyright notices on some of the catalogues were not technically accurate, this does not divest the plaintiff of his interest in the copyrighted castings."

135. *Uneda Doll Co., Inc. v. Eugene Doll & Novelty Co., Inc.*, 175 USPQ 469 (S.D.N.Y. June 27, 1972) (Motley, J.)

Motion for preliminary injunction in action for copyright infringement, trademark infringement and unfair competition. The parties manufactured and sold certain dolls.

Held, motion granted for infringement of copyright in plaintiff's doll display box. The court said:

The showing required before a preliminary injunction against copyright infringement will issue in this Circuit consists of a prima facie case of infringement, plus some likelihood of irreparable harm. Detailed proof on the latter issue is unnecessary since injury is presumed where a copyright is infringed. . . . A prima facie case of infringement is established by proof of both ownership of a valid copyright (this is presumed where a certificate of registration has been issued), and copying by the alleged infringer. Copying can be inferred from evidence of access to the copyrighted material by the alleged infringer, and substantial similarity between the copyrighted material and that produced by the alleged infringer. . . .

In the instant case Eugene's arguments attacking the validity of Uneda's copyright are unconvincing. There is no question that Eugene had access to Uneda's box since it was on display in Uneda's showroom, which is located in the same building as an office of Eugene. . . . The pictures and text and the artistic layout of Eugene's doll box are so similar, to the ordinary observer's eye, to those of Uneda's box that the inference that Eugene copied

Uneeda is compelling. Thus we hold that Uneeda has made a prima facie case of copyright infringement by Eugene.

As proof of the likelihood of irreparable harm Uneeda has stressed through its affidavits that a number of its customers have expressed a desire to purchase the less expensive "knock-off" of Uneeda's product produced by Eugene. No more detailed showing of probability of injury than this is required on a motion for a preliminary injunction based on copyright infringement. . . .

The court refused to grant preliminary relief against defendant's use of certain names for its dolls as plaintiff failed to make a clear showing of probable success on the merits.

136. *Walco Products, Inc. v. Kittay & Blutz, Inc., et al.*, 175 USPQ 471 (S.D.N.Y. July 31, 1972) (Briant, J.)

Motion for preliminary injunction in action for copyright infringement and unfair competition. Plaintiff alleged that certain Christmas tree ornament kits manufactured by defendants infringed its copyrighted ornaments, ornament kit, and catalog and photographic illustrations of its ornaments.

Held, motion granted.

Although the court found that defendants may have thought the copied designs were owned by a third party, it held that "[whether] the copying was unintentional is no excuse, since it is the result and not the intention that determines the question of infringement."

The court concluded that, under the standards governing preliminary relief, plaintiff was entitled to a temporary injunction against the copying of one of its ornaments. The court said:

Christmas ornaments, actively sold in December, enter the channels of commerce in the summer months. At this time of year particularly, the consequences of withholding injunctive relief are likely to be more serious to the plaintiff than the consequences would be to the defendants, if granted. Delay pending trial may be fatal to plaintiff's copyright protection. . . . Plaintiff need not make out his entire case on this motion, and show conclusively that he would be entitled to final judgment. It is enough if he establish a prima facie case as to the validity of his copyright and its infringement, in which event a temporary injunction will issue. . . . Here, defendants do not contest the validity of plaintiff's copyrights.

Furthermore, where, as here, a plaintiff makes out a prima facie case of copyright infringement, it is entitled to a preliminary injunction even without a detailed showing of danger or irreparable harm. . . . However, in the instant action there is substantial danger of a loss of good will and future sales in this seasonal market for Christmas tree ornaments which is likely to be exhausted within weeks. . . .

It is also alleged, without contradiction, that defendants' product is 'inferior'. A copyright owner is presumed to suffer irreparable damage when his right to the exclusive use of copyrighted material is invaded.

The court also found there was a "strong possibility" that defendants infringed plaintiff's catalog by making three dimensional ornaments copied from two-dimensional illustrations shown therein. The court said:

While there are no copyright notices on [certain of] plaintiff's ornaments . . . that is of no moment in the instant action. The infringement involved herein concerns the copying not from the ornaments themselves but from the copyrighted catalogues. The substance of a design produced through a different medium is likewise prohibited. . . .

Defendants have apparently infringed plaintiff's copyrighted work of art by reproducing in two-dimensional form the works found in its catalogues and advertising materials, as well. A comparison of plaintiff's copyrighted photograph with defendants' catalogue likewise shows a possibility of copying. The motif, layout and general appearance are so similar, and the differences so insubstantial, as to permit no other inference.

137. *Jondora Music Publishing Company, et al. v. Melody Recordings, Inc., et al.*, 176 USPQ 110 (D. New Jersey, November 22, 1972) (Lacey, J.).

Motion to quash writ of seizure and vacate preliminary injunction (stipulated) in action for copyright infringement in musical compositions. Plaintiffs sought to hold defendant tape duplicators ("pirates" in plaintiffs' categorization) liable for infringement of mechanical reproduction rights. Although the moving defendant, U.S. Tape, Inc., apparently paid statutory royalties and served notices of intent under the compulsory license provisions of the Copyright Act, plaintiffs urged that

unauthorized duplicators of prior recordings were not entitled to such statutory licenses.

Held, writ vacated and order dissolved.

The court, disagreeing with the 9th Circuit decision in *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 20 BULL. CR. SOC. 2, Item 74 (9th Cir. 1972), concluded that duplicators were not barred from utilizing the compulsory license provisions of the Copyright Act to avoid liability for recording the previously-recorded *musical compositions*; the court also noted that plaintiffs could not claim copyright in the duplicated *performances*.

The court said:

For an understanding of the music publishing and recording industry, and the issues herein, there is to be distinguished a musical composition (the words and music of a song or tune) on the one hand, and the musical performance of that composition by recording artists, on the other. Also, the musical composition and the performance thereof must be differentiated from the physical objects, such as the records and tapes, on which the performance is mechanically reproduced. The legal issue in this case can then be stated: Did Congress by the Copyright Act of 1909 grant to musical composition copyright holders the power to prevent third persons from copying a particular performance of that composition, where (a) with the copyright holder's permission, the performance has already been fixed on a physical object capable of reproducing it, and (b) the third person has complied with the compulsory license provisions of the Act by filing and serving notices of intention and paying royalties to the copyright holders?

. . . .

Construction is required of the remedial and compulsory licensing provisions of the Copyright Act of 1909, 17 U.S.C. §§ 1(e) and 101 (c), (d) and (e), relating as they do to copyright protection for musical compositions and its application to sound recordings.

We start with the Act insofar as it gave protection to composers against mechanical reproduction of their music. As is stated in *Duchess*, while giving the composer the exclusive right to prohibit the use of his music "by the mechanical reproducers," it also provided that if he permitted mechanical reproduction, then, upon the payment of a reasonable royalty, all who desired might "reproduce the music."

Congress thus passed § 1(e) [the "compulsory license" provision] of the Copyright Act. . . . It is upon this that defendant relies. It claims that it has taken advantage of it, has filed the requisite notices of intention, and made (or tendered) the requisite royalty payments, all of which I must credit in view of the record. Plaintiffs on the other hand contend that the "compulsory license" provision is not available to a duplicator of the recordings of the licensees of the copyright proprietor.

[The *Duchess* Court stated that the] "statute provides that anyone who properly invokes the license provision may make *similar use* of the copyrighted work. (emphasis supplied.) [Defendant] admits that she duplicates appellants' copyrighted compositions. She does not make similar use of them, she makes exact and identical copies of them. This is clearly outside the scope of the compulsory license scheme."

The *Duchess* court relied upon *Aeolian Co. v. Royal Music Roll Co.*, 196 Fed. 926 (W.D.N.Y. 1912) [in] which . . . to afford the licensee [of mechanical rights] a remedy against piracy of this kind. The court concluded that not only the copyright owner, but its licensee, alone, could invoke the general injunction provision of the Act against such practice.

I think *Aeolian* was wrongly decided as I think *Duchess* was wrongly decided.

I can do no better in analyzing *Aeolian* than did the District Judge in *Duchess* (who was reversed by the Court of Appeals) [repeated only in part here]:

"Although *Aeolian* has never been expressly overruled, it has been meagerly cited and severely criticized. [S]ections 1 (e) and 101 (e) dictate that there be no exclusive licensee of the rights of mechanical reproduction. The *Aeolian* decision which would nevertheless allow a licensee to seek an injunction on such grounds is fundamentally incompatible with the above-mentioned compulsory license principle. . . .

Nevertheless, plaintiffs would argue that *Aeolian's* rationale condemning the practice of a subsequent manufacturer appropriating the labor and skills of a competitor by duplicating the latter's product is significantly similar to and compatible with certain common law rules of unfair competition which would prohibit such duplicating or pirating. By this approach they would have the Court infer that the manufacturing defendants are not entitled to avail themselves of the compulsory

license feature of the Act. But this point only serves to illustrate another woeful inadequacy of the present copyright legislation. Copyright plaintiffs seek injunctive relief exclusively under the Act and not under any theory of unfair competition or unfair trade practice and, under the Act, Congress has not differentiated between a subsequent manufacturer who imitates another manufacturer's product and one who merely duplicates or appropriates the product with little or no investment of skill, talent or money."

. . . .

It is my view that the *Duchess* opinion in the Court of Appeals erroneously interprets the "compulsory license" provision of the Copyright Act. Simply stated, that court believed that because a musical composition is copyrighted, the unauthorized reproduction of the performance embodied in the sound recording of that composition, is and ought to be, prohibited by federal copyright laws. But that clearly was not the law when *Duchess* was decided. Neither performance nor recording was copyrightable. It might have been unethical, or, in some states, because there was a felt necessity for statutory intervention, a crime to "steal" a recording of a performance and thereafter sell it as your own. But clearly the licensee-manufacturer had no claim under the Copyright Act. . . .

. . . .

Plaintiffs argue it would be inconceivable to afford duplicators the benefit of the "compulsory license" provision and thereby allow a duplicator to do that which is a crime, or unfair competition, under state law. Their argument carries them too far. It is precisely because licensee-manufacturers had no relief under the Copyright Law where the Copyright holder accepted the "compulsory license" royalties that the national recording companies got state legislation on the books. . . . Of course, the existence of relief by way of unfair competition does not call for an interpretation of the Copyright Act that effectively gives the aggrieved licensee-manufacturer statutory relief where it does not exist.

.

We turn now to a consideration of P.L. 92-140, the Sound Recording Amendment of 1971. . . .

That defendant U.S. Tape's activities in no way infringe upon plaintiffs' musical composition copyrights is . . . demonstrated by the nature of the remedy chosen by Congress to deal with tape and record duplication. As stated above, the musical compositions,

which are generally owned by publishing companies, must be distinguished from the performances of the compositions on a sound recording, which are arranged and paid for by the record companies. Since any record manufacturer is free to use the composition (once the copyright proprietor has permitted any record to be made of his song), and since duplicators should pay the creators of the composition at least the same royalty that the record companies pay, the copyright proprietor suffers no pecuniary loss from duplication, as long as the statutory royalties are paid by the duplicator. (Parenthetically, it is noted that many duplicators were operating outside the law, and were not paying the statutory royalties to the copyright proprietor). On the other hand, the duplicators' activities did reduce the profits of the record companies (and the performing musicians as well, if this were being paid by the record company on a royalty basis). But neither the record companies nor the performers had any copyrights in the recordings.

To remedy the situation, Congress, in §1 of Public Law 92-140, created a limited copyright in sound recordings of performances of musical compositions. However, Congress also provided in §3 of the Amendment that:

The provisions of Title 17, United States Code, as amended by Section 1 of the Act shall apply only to sound recordings fixed, published and copyrighted on and after the effective date of this Act [i.e., February 15, 1972] and before January 1, 1975, and nothing in title 17, United States Code, as amended by section 1 of this Act, shall be applied retroactively or be construed as affecting in any way any rights with respect to sound recordings fixed before the effective date of this Act.

Thus, the record companies, which therefore had no federal copyright protection for their recordings, or for the musical performances they served to reproduce, were afforded a sound recording copyright. But such protection . . . applied only to sound recordings that were "fixed (i.e., first recorded), published, and copyrighted" after February 15, 1972.

It is noteworthy that, while the "compulsory licensing" provisions remained for the musical composition copyright, the copyright protection for the sound recordings did not include, as granted by the Amendment, a provision for "compulsory licensing."

. . . .

[T]he music publishers, on the other hand, neither sought nor obtained any enlargement of the scope of their non-exclusive musical

composition copyrights. No changes were made in the language of the compulsory license provisions in 17 U.S.C. §1(e) or in the "notice of intention to use" requirement 17 U.S.C. §101(e). Thus, with respect to the records and tapes which were not "fixed" after February 15, 1972, any person could still engage in record and tape duplication "without violating Federal Copyright law," provided he complied with compulsory license provisions of the Act.

However, Congress did give the music publishers a more effective weapon to deal with the illegal duplicators who did not pay royalty. Section 2 of P.L. 92-140, which unlike §1 was effective immediately, amended 17 U.S.C. §101(e) so as to subject those who did not comply with the compulsory license provision of the Act to civil liability "in accordance with all provisions of this title dealing with infringements of copyright and, in the case of a willful infringement for profit, to criminal prosecution pursuant to [17 U.S.C.] §104."

Thus, the legislative history of P.L. 92-140, and the precise remedies chosen by Congress to deal with the subject, manifest an expressed intent by Congress to permit such tape and record duplication to continue under the compulsory licensing provisions of the Copyright law, with respect to all sound recordings "fixed" prior to February 15, 1972.

I also find persuasive defendant's argument that if Congress had intended to make duplicators liable after October 15, 1971, for infringement of musical composition copyrights, regardless of whether the duplicator complied with the compulsory license provision, Congress could have simply amended §1(e) by excluding from the benefits thereof those making an "exact" or "identical" copy of a pre-existing recording. Thus, if Congress had desired to make all duplicators immediately liable for infringement of musical composition copyrights, it easily could have done so by restricting the compulsory license privilege in some fashion. Instead, Congress created a new copyright in the sound recordings of performances of copyrighted musical works, effective, however, only with respect to performances on recording that were "fixed, published and copyrighted" four months after the effective date of the 1971 Amendment.

Plaintiffs, of course, do not and cannot invoke herein this newly-created "sound recording" copyright, because (a) the records which defendant duplicates all were "fixed" (first recorded) prior to February 15, 1972 and (b) the plaintiffs-publishers would not, in any event, own the copyrights to the post-February 15, 1972 sound recordings. Rather those rights will inure to the benefits of the

record companies, which hire the musicians, artists and technicians involved in creating the musical performances.

138. *Independent Tape Merchant's Association v. Creamer, et al.* Not yet reported (D.Pa., July 24, 1972) (Sheridan, J.)

Action to enjoin criminal prosecutions under a Pennsylvania statute outlawing unauthorized duplication of sound recordings, and to declare same invalid.

Held, action dismissed.

The court denied injunctive relief since plaintiff failed to demonstrate a sufficient present interest warranting federal intervention. The court said:

A federal court should not enjoin threatened state prosecutions except when necessary to prevent irreparable harm which is great and immediate.

Plaintiff has alleged that a failure to enjoin state officials from prosecuting will yield a multiplicity of harassing and vexatious litigation. However, the exercise of equitable discretion to avoid a multiplicity of litigation is restricted to cases in which there would otherwise be a necessity for numerous suits between the same parties involving the same issues; it does not ordinarily extend to cases involving numerous parties in which the issues between them and the state are not necessarily identical. . . . On the contrary, it is clear that the cost, anxiety, and inconvenience which any of plaintiff's members may suffer in defending against a single criminal prosecution brought in good faith cannot in itself constitute irreparable harm. . . . Moreover, the mere allegation of the threat of prosecution falls far short of establishing irreparable harm if the state is allowed to prosecute in the normal manner. . . .

Relative to plaintiff's contention that prosecution will destroy the business which its members have developed in Pennsylvania, it suffices to say that no one is immune from prosecution, in good faith, for his alleged criminal acts. . . . At no time has plaintiff alleged that prosecutions are being threatened in bad faith or for the purpose of harassment. Without such an allegation, there is no basis for a finding of irreparable harm.

The court also refused to issue declaratory relief:

[The] policies which require that a declaratory judgment with respect to pending state criminal prosecutions be evaluated pursuant

to criteria essentially similar to those which govern the issuance of an injunction may point to the same result even if there is no state prosecution pending.

. . . .

Assuming that 18 P.S. § 4878.1 (Supp., 1972) were to be declared unconstitutional, the decision might well lead to a request for an injunction to protect or effectuate the declaratory judgment if the state were subsequently to decide to prosecute. This could effectively circumvent the requirements for injunctive relief, and it would seem to imply that a declaratory judgment should not issue absent a showing of irreparable harm if there is reason to believe that an injunction might later be necessary. . . . In addition, a declaratory judgment itself is, as a practical matter, no less disruptive than an injunction in its impact on the orderly functioning of state criminal processes; it is equally likely to preclude the initiation of state prosecutions. . . . These concerns are particularly apposite where the federal action has been commenced under circumstances indicating an intent to effectively prevent the prior initiation of state action. A declaratory judgment should not be granted if its issuance appears calculated to reward the winner of a race to the courthouse. . . . This is not a case in which the lack of a pending state action means that the impact of federal intervention upon a state's administration of its criminal laws will be minimal. . . . On the contrary, it is the opinion of the court that the issuance of a declaratory judgment would be highly disruptive in the present context and that the factors which require the denial of plaintiff's request for an injunction also require that declaratory relief be denied. . . .

Moreover, additional factors exist which compel the same conclusion. Plaintiff alleges that 18 P.S. § 4878.1 (Supp., 1972) is unconstitutional because it purports to grant an unlimited copyright to producers of sound recordings, thereby frustrating the federal regulatory scheme the purpose of which is to require that any sound recording without limited federal copyright protection become part of the public domain. It contends that Pennsylvania's attempt to make certain activities criminal constitutes the de facto creation of an additional alternative the very existence of which is anathematic to a system of federal regulation which contemplates either limited federal protection or no protection at all. Defendants and intervenor defendant argue that it is clear that not all non-federal regulation is precluded by federal copyright legislation, e.g., 17 U.S.C.A. § 2;

that [the] recent [sound recordings amendment to the Copyright Act] manifests an intention that certain rights coexist with those created by federal law and is in fact an invitation to the states to enact complementary legislation designed to protect coexisting rights; and that the Pennsylvania statute is not a copyright law at all, but rather is a state unfair competition law which applies to recordings fixed prior to the effective date of the federal act and which is therefore fully consistent with the intent of Congress . . .

The issuance of a declaratory judgment is discretionary. . . . In exercising its discretion, a federal court confronted with a federal constitutional question should abstain from deciding an unresolved issue of state law if the state law is fairly subject to an interpretation which may avoid or modify the federal constitutional issue. . . .

If the construction of 18 P.S. § 4878.1 (Supp., 1972) advocated by defendants and intervenor defendant is correct, the scope of the constitutional issue before the court will be narrowed significantly. Furthermore, there is a legitimate disagreement about the intended effect of the Pennsylvania statute. Therefore, this is not a case in which abstention is improper because the state law is unambiguous or in which, on any reasonable construction of state law, it is not open to an interpretation which would modify the constitutional question. . . .

Conversely, abstention would appear to be appropriate for several reasons. The Pennsylvania law is a very recent enactment, and the state courts have not yet had an opportunity to construe it. Any interpretation of 18 P.S. § 4878.1 (Supp., 1972) rendered by this court could only be a prediction of what Pennsylvania courts will decide when they ultimately face the issues raised. . . . It does the rule of law a disservice if a federal decision on an issue of state law may be overturned by a controlling decision of a state court.

139. *Gate City Record Service Company et al. v. Custom Recording Company Inc. et al.*, 176 USPQ 20 (N.D. Ga., September 29, 1972) (Freeman, J.)

Action by tape recording distributors (who purchase their recordings from non-party producing companies) against alleged "tape pirates" for unfair competition.

Held, complaint dismissed.

The court held that plaintiffs, as mere distributors of tapes produced by others, lacked standing to maintain the action. The court said:

Plaintiffs' brief in opposition to the defendants' motion to dismiss relies entirely upon a number of decisions which involves instances wherein the plaintiffs had some interest by way of copyright or exclusive contractual arrangement in the performances comprising the commodity alleged to have been copied by the parties charged. In the instant case plaintiffs have alleged no such interest whatsoever in and to the performances comprising the tape recordings manufactured by others and subsequently distributed by them and have not contended that they have any such interest in the same. Plaintiffs do not allege that even the unnamed manufacturers who manufactured the tapes distributed by the plaintiffs have an exclusive right, such as by copyright, to manufacture and sell the recorded performances of the artists. But if there is any right to be protected, such would lie with the manufacturers and not with the distributors. Accordingly, the complaint is hereby ordered dismissed since plaintiffs totally lack standing to prosecute this action.

2. Court of Customs and Patent Appeals

140. *Knickerbocker Toy Company, Inc. v. Faultless Starch Company*, 175 U.S.P.Q. 417 (C.C.P.A., October 12, 1972) (Rich, J.)

Appeal from decision of Patent Office Trademark Trial and Appeal Board granting appellee's motion to strike certain portions of appellant's pleadings in consolidated trademark opposition and cancellation proceedings.

Appellee owned certain trademark registrations, and an application for registration, of marks depicting a rag doll. In seeking to challenge same, appellant relied (in part) upon its copyright in a stuffed rag doll entitled "Raggedy Ann" and claimed that it would be damaged by registration of appellee's marks, since publication thereof would infringe, destroy and/or diminish the value of appellant's copyright. The Trademark Trial and Appeal Board granted appellee's motion to strike the allegations pertaining to appellant's claimed copyright.

Held, modified and remanded.

The Court noted that "this is one of those often perplexing cases involving the interrelationship between various forms of intellectual property" and, based upon the Patent Office restriction to matters of *registration* (as opposed to use), affirmed the decision below insofar as it struck appellant's allegations of copyright *infringement*. However, the Court held that a party *may* rely upon the copyrighted appearance of

its goods in establishing prior rights over a trademark user of a confusingly similar depiction, and therefore disagreed with the decision below insofar as it struck portions of appellant's pleadings charging that confusion would result from appellee's use of a mark imitative of appellant's copyrighted doll. "Because portions of appellant's pleadings relating to . . . these separate issues [were] hopelessly intermingled", the Court remanded to allow appellant to replead. The Court said:

Section 13 of the Trademark Act (15 USC 1063) provides (our emphasis) that "Any person who believes that he would be damaged *by the registration* of a mark upon the principal register may * * * file a verified opposition in the Patent Office," and section 14 (15 USC 1064) provides (our emphasis) that "A verified petition to cancel a registration of a mark * * * may * * * be filed by any person who believes that he is or will be damaged *by the registration* of a mark on the principal register * * *." The statute does not expressly define damage or state in what way a person must believe himself to be damaged *by the registration*, actual or potential, in order to have standing to maintain an opposition or cancellation proceeding. Appellee's strongest argument in support of its motion proceeds as follows: Section 2 of the Trademark Act (15 USC 1052) in effect specifies the grounds upon which the belief of damage must be based. Section 2 provides that "No trademark by which the goods of the applicant may be distinguished from the goods of others may be refused registration on the principal register on account of its nature unless it" falls within certain prohibited categories. Only two of these categories are possibly relevant here. The first category is (d) "a mark which so resembles a mark registered in the Patent Office of a *mark* or *trade name* previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive * * *." (Emphasis ours.) The other category is (e) "a mark which * * * when applied to the goods of the applicant * * * is merely descriptive or deceptively misdescriptive of *them* * * *." (Emphasis ours.) Neither of these categories is squarely applicable to this situation. The stricken portions of appellant's pleadings do not allege prior use of its Raggedy Ann doll per se as a trademark or as a trade name or that appellee's mark is descriptive or deceptively misdescriptive of *appellee's* goods.

If we were writing upon a clean slate, this argument might have persuasive force. However, we are not, and it has long been the law that, in an opposition based on likelihood of confusion,

mistake, or deception, "It is sufficient if an opposer establishes 'priority of use analogous to a trade-mark use' of a trade-name, and the 'likelihood of damage to him *by the registration* of such mark to another.'" We see no reason why a different rule should obtain in cancellations. This court has held that a party to a trademark opposition may rely on advertising and promotional use of a term or slogan, . . . and grade- or model-mark use of a word . . . to establish superior rights over a subsequent trademark user of the term, slogan, or word. We now hold that a party to such a proceeding can similarly rely on the copyrighted appearance of its goods, *per se*. . . . What appellant seems to have lost sight of in its pleadings in the opposition and two cancellations is that in the Patent Office it can properly attack *only* appellee's right to register and that the Patent Office is not the place to complain about appellee's *conduct* in *using* representations of the Raggedy Ann doll or *publishing* representations of it. Such conduct is no concern of the Patent Office, and allegations thereof are truly immaterial if not impertinent also. The allegations of the pleadings should be restricted to matters bearing on appellee's *right to register* and actual or potential damage to appellant *from registration*. The existence of copyright, copyright registration, and property rights derived therefrom may be relevant to these matters, but allegations of copyright infringement and unfair competition, which are intermingled with such statements of fact and law in the present pleadings, are not.

In this case appellant's pleadings go far beyond allegations of likelihood of confusion, etc., bearing on the issue of likelihood of damage, or actual damage, from registrations of appellee's trademark, and we agree with the board that it has no jurisdiction over the issues raised by appellant's pleadings insofar as they allege copyright *infringement*, *unfair competition*, and the like. . . . *However, we do not wish to be read as holding that the board is thereby precluded from passing on the validity of a copyright if it is necessary to do so** in the course of the exercise of its statutory jurisdiction, as it may very well be in this case. . . .

3. Also of Interest

141. *Gottschalk, Comr. Pats. v. Benson*, 175 U.S.P.Q. 673 (U.S. Sup. Ct., November 20, 1972) (Douglas, J.)

Petition for writ of certiorari to review decision of the Court of Customs and Patent Appeals sustaining certain claims to patent pro-

* This emphasis is supplied; others in original. [Ed.].

tection for an alleged invention pertaining to computer programming technology.

Held, reversed & claims disallowed.

The court said, in part:

Respondents filed in the Patent Office an application for an invention which was described as being related . . . to the programmed conversion of numerical information in general purpose digital computers. They claimed a method for converting binary-coded-decimal (BCD) numerals into pure binary numerals. The claims were not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use. They purported to cover any use of the claimed method in a general purpose digital computer of any type. . . .

The question is whether the method described and claimed is a "process" within the meaning of the Patent Act. [35 U.S.C. §100(b), §101.]

A digital computer, as distinguished from an analogue computer, is that which operates on data expressed in digits, solving a problem by doing arithmetic as a person would do it by head and hand. Some of the digits are stored as components of the computer. Others are introduced into the computer in a form which it is designed to recognize. The computer operates then upon both new and previously stored data. The general purpose computer is designed to perform operations under many different programs.

The representation of numbers may be in the form of a time-series of electrical pulses, magnetized spots on the surface of tapes, drums, or discs, charged spots on cathode ray tube screens, or the presence or absence of punched holes on paper cards, or other devices. The method or program is a sequence of coded instructions for a digital computer.

The patent sought is on a method of programming a general purpose digital computer to convert signals from binary coded decimal form into pure binary form. . . . The procedures set forth in the present claims . . . are a generalized formulation for programs to solve mathematical problems of converting one form of numeral representation to another. . . .

The conversion of BCD numerals to pure binary numerals can be done mentally through use of [a] table. The method sought to be patented varies the ordinary arithmetic steps a human would use by changing the order of the steps, changing the symbolism for

writing the multiplier used in some steps, and by taking subtotals after each successive operation. The mathematical procedures can be carried out in existing computers long in use, no new machinery being necessary. And, as noted, they can also be performed without a computer.

The Court stated in *MacKay Co. v. Radio Corp.*, 306 U. S. 86, 94, that "While a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be." That statement followed the long-standing rule that "An idea of itself is not patentable." *Rubber-Tip Pencil Co. v. Howard*, 20 Wall. 498, 507. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; and these cannot be patented, as no one can claim in either of them an exclusive right." *LeRoy v. Tatham*, 14 How. 156, 175. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work. As we stated in *Funk Bros. Seed Co. v. Kalo Co.*, 333 U.S. 127, 130, "He who discovers a hitherto unknown phenomenon of nature has no claim to a monopoly of it which the law recognizes. If there is to be invention from such a discovery, it must come from the application of the law of nature to a new and useful end." We dealt there with a "product" claim, while the present case deals only with a "process" claim. But we think the same principle applies.

Here the "process" claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure-binary conversion. The end use may (1) vary from the operation of a train to verification of drivers' licenses to researching the law books for precedents and (2) be performed through any existing machinery or future-devised machinery or without any apparatus.

In *O'Reilly v. Morse*, 15 How. 62, Morse was allowed a patent for a process of using electro-magnetism to produce distinguishable signs for telegraphy. *Id.*, at 111. But the Court denied the eighth claim in which Morse claimed the use of "electro-magnetism, however, developed for marking or printing intelligible characters, signs, or letters, at any distance." The Court in disallowing that claim said, "If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification.

His invention may be less complicated — less liable to get out of order — less expensive in construction, and its operation. But yet if it is covered by this patent the inventor could not use it, nor the public have the benefit of it without the permission of this patentee." *Id.*, at 113.

In *The Telephone Cases*, 126 U. S. 1, 534, the Court explained the *Morse* case as follows: "The effect of that decision was, therefore, that the use of magnetism as a motive power, without regard to the particular process with which it was connected in the patent, could not be claimed, but that its use in that connection could." Bell's invention was the use of electric current to transmit vocal or other sounds. But the claim was not "for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specified condition suited to the transmission of vocal and other sounds, and using it in that condition for that purpose." 126 U. S., at 534. The claim, in other words, was not "one for the use of electricity distinct from the particular process with which it is connected in his patent." *Id.*, at 535. The patent was for that use of electricity "both for the magnetic and variable resistance methods." *Id.*, at 538. Bell's claim in other words, was not one for all telephonic use of electricity.

In *Corning v. Burden*, 15 How. 252, 267-268, the Court said "One may discover a new and useful improvement in the process of tanning, dyeing, etc. irrespective of any particular form or mechanical device." The examples given were the "arts of tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores." *Id.*, at 267. Those are instances, however, where the use of chemical substances or physical acts such as temperature control change articles or materials. The chemical process or the physical acts which transform the raw material are, however, sufficiently definite to confine the patent monopoly within rather definite bounds.

Cochran v. Deener, 94 U. S. 780, involved a process for manufacturing flour so as to increase its quality. The process first separated the superfine flour and then removed impurities from the middling by blasts of air, reground the middlings, and then combined the product with the superfine. *Id.*, at 785. The claim was not limited to any special arrangement of machinery. *Ibid.* The Court said,

"That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed.

If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but if the patent is not confined to that particular tool or machine, the use of the others would be an infringement, the general process being the same. A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." *Id.*, at 787-788.

Transformation and reduction of an article "to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines. So it is that a patent in the process of "manufacturing fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure" was sustained in *Tilghman v. Proctor*, 102 U. S. 707, 721. The Court said, "The chemical principle or scientific fact upon which it is founded is, that the elements of neutral fat require to be severally united with an atomic equivalent of water in order to separate from each other and become free. This chemical was not discovered by Tilghman. He only claims to have invented a particular mode of bringing about the desired chemical union between the fatty elements and water." *Id.*, at 729.

Expanded Metal Co. v. Bradford, 214 U. S. 366, sustained a patent on a "process" for expanding metal. A process "involving mechanical operations and producing a new and useful result." *Id.*, at 385-386, was held to be a patentable process, process patents not being limited to chemical action.

Smith v. Snow, 294 U. S. 1, and *Waxham v. Smith*, 204 U. S. 20, involved a process for setting eggs in staged incubation and applying mechanically circulated currents of air to the eggs. The Court in sustaining the function performed (the hatching of eggs) and the means or process by which that is done, said:

"By the use of materials in a particular manner he secured the performance of the function by a means which had never occurred in nature, and had not been anticipated by the prior art; this is a patentable method or process. A method, which may be patented irrespective of the particular form of the mechanism which may be availed of for carrying it into operation, is not to be rejected as 'functional,' merely because the

specifications show a machine capable of using it." 294 U. S., at 22.

It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a "different state or thing."

We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents. It is said that the decision precludes a patent for any program servicing a computer. We do not so hold. It is said that we have before us a program for a digital computer but extend our holding to programs for analog computers. We have, however, made clear from the start that we deal with a program only for digital computers. It is said we freeze process patents to old technologies, leaving no room for the revelations of the new, onrushing technology. Such is not our purpose. What we come down to in a nutshell is the following.

It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting binary code to pure binary were patented in this case. The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is affirmed, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.

It may be that the patent laws should be extended to cover these programs, a policy matter to which we are not competent to speak. . . .

If these programs are to be patentable, considerable problems are raised which only committees of Congress can manage, for broad powers of investigation are needed, including hearings which canvass the wide variety of views which those operating in this field entertain. The technological problems tendered in the many briefs before us indicate to us that considered action by the Congress is needed.

142. *Thomas J. Lipton, Inc. v. Borden, Inc.*, N.Y.L.J., Nov. 28, 1972 at 17, col. 1 (Sup. Ct., N.Y. County) (Fraiman, J.)

Motion for preliminary injunction in action for unfair competition. Plaintiff claimed that defendant unfairly simulated elements of its packaging for an instant soup product so as to be likely to confuse the public.

Held, motion denied.

After reviewing various decisions involving simulation of trade dress,* the court concluded that “the difference between the [parties’] packages are of a more substantial character . . . but more importantly, the source of defendant’s product [i.e., its trade name] is clearly indicated on its package. Even an unthinking purchaser desiring to purchase Lipton’s soup can see by a glance at defendant’s package that she has the wrong thing. “The court also said:

Although there are [various] distinctions in the package designs . . . one would have to conclude that they are substantially similar to each other in design [both parties’ packages depicting water being poured from a kettle spout into a clear glass cup] and in their designation of “Cup-a-Soup” and “Cup of Soup” respectively. However, this is not the end of the matter. . . . [S]imilarity as to name and packaging does not by itself necessarily establish palming off. . . . The Photograph of a cup being filled with hot water which rehydrates the soup mix in the cup to become instant soup cannot be the exclusive property of one company. The instantaneous creation of soup by pouring water into a cup is the essence of the product sold by both plaintiff and defendant and a photograph of the process is the most natural way of describing the product being sold. The fact that the cup into which the water is being poured is transparent is not unusual and in fact is the only way in which the soup mix can be shown mixing with the water. With respect to the term “Cup of Soup” this is the normal common phrase for describing a quantity of that liquid refreshment normally consumed by an individual at a single sitting. It is in no way unique or fanciful. Indeed, as defendant notes in its opposing affidavits, it is used on virtually every restaurant menu to describe an individual serving of soup. Lipton acknowledges that it has no special right to any of these elements, but as noted above, it claims that it is the combination of all the similar factors that makes Borden’s package an unfair copy of its own. The defendant, however, should not be deprived of the usefulness of the photograph and the term “Cup of Soup” in promoting its product if, by distinctively labeling its package, it has put the consumer on notice as to the source of its product, and thus avoiding a likelihood of confusion.

* The Supreme Court’s product simulation decisions in *Sears* and *Campco* were not discussed. [Ed.]

143. *Rosemont Enterprises, Inc., et al. v. Choppy Productions, Inc., et al.* N.Y.L.J., December 6, 1972, at 18, col. 3 (N.Y. Sup. Ct., N.Y. Co.) (Markowitz, J.)

Action for violation of N.Y. Right of Privacy law (Civil Rights L., Sec. 51). Plaintiff Howard Hughes alleged that defendants manufactured certain clothing items bearing his name, purported signature and likeness, without his consent.

Held, judgment for plaintiff, the court stating in part:

I find no validity in their argument that the violation is protected by the constitutional right of free speech. The authorities they cite do not bear them out in the type of situation presently before the courts; and this court, affirmed by the Appellate Division, has heretofore held to the contrary.

Plaintiff is presumed to be alive (*Rodak v. Fury*, 31 A.D. 2d 816) On the proof submitted in his behalf in support of the motion he is entitled to a permanent injunction.

144. *In the Matter of The Complaint Against Parker Publishing Co.*, Unreported (U.S. Postal Service, December 14, 1971; reconsideration denied March 9, 1972) (Wenchel, Judicial Officer).

Appeal from recommendation of Postal Service Hearing Examiner that an order be issued against respondent on a complaint filed under statutory provisions prohibiting the obtaining of money through the mail by means of false representations.

Held, complaint dismissed.

Respondent advertised and sold through the mails a certain book entitled "Helping Yourself With Foot Reflexology". The Postal Service complaint, as summarized by the Judicial Officer, alleged:

1. The advertising does not merely describe the contents of the book, but independently represents that an article (the book) offered for sale will enable the purchaser to obtain cures or relief from a wide variety of ills.

2. The representations are false because foot reflexology will not achieve the results represented.

3. The advertising, therefore, is part of a scheme or device for obtaining money through the mails by means of false representations.

Respondent asserted that its advertising accurately represented the contents of its book. The Judicial Officer concluded:

[A]lthough the present case comes within the literal language of 39 U.S.C. 3005, the Postal Service should not issue an order under that section on the present record. In a prior proceeding (*Parker Publishing Co., Inc.*, P.O.D. Docket No. 3/41) relating to advertising concerning a different book, an order under 39 U.S.C. 3005 was issued on the determination that, assuming the truth of what was said in the book, the advertising representations about the contents of the book were false. While there may be justification for making such a determination in other circumstances, it would not be appropriate to do so here. Under the present state of the law, it is possible such an order would be regarded as abridging the freedom of the press with respect to the book in question. While, as the Initial Decision demonstrates, a contrary view could also be reasonably held, the undersigned believes the appropriate course of action for the Postal Service to follow is to dismiss the complaint.

On complainant's motion for reconsideration the Judicial Officer added (footnotes omitted):

It is a tenet of statutory construction that a statute ought to be construed so as to avoid the necessity of deciding serious constitutional doubts.

. . . .

It is sometimes broadly stated that administrative officials do not consider constitutional questions. What is meant, however, is that administrative officials should not declare statutes they administer to be unconstitutional.

. . . .

Thus a federal administrative agency must take the applicability of constitutional grants of power and the limitations and restraints on federal powers into consideration in the normal performance of its federal functions, particularly in determining the perimeters of the area in which it will seek to apply legislation it administers. This is what was done here.

. . . .

Basically, Complainant asks the Judicial Officer to look at the enterprise as one purveying medical treatment. However, looking at the questioned advertising and the nature of Respondent's busi-

ness we must conclude that the business is one of selling books. Therefore, the question is whether the advertising misrepresents the book.

The dilemma posed by the Complainant's argument is that although Complainant states he is not attacking the book and does not question that the advertising accurately represents the contents of the book, the order which would result from upholding the complaint would cover all mail relating to the enterprise of selling the book at the current address. The result of upholding the complaint, therefore, would be substantial interference with the sale of the book even though the advertising as far as shown in this proceeding accurately represents what the book says.

Notwithstanding Complainant's disavowal of any intention of questioning the contents of the book, his brief attacks the book in the following language:

"Where, however, a seller advertises a book which is alleged to reveal curative or alleviative formulae for identifiable physiological conditions, a lay purchaser — absent appropriate disclaimer — may reasonably be expected to believe that he is being offered information of currently accepted scientific validity which, if followed, would be of benefit to himself. In such case — and the instant case is typical — any explicit or implicit misrepresentation by the seller respecting the validity of the content could be material to the purchaser."

As stated above, the advertisement is for a book and the question presented is whether that advertising misrepresents the book whose purchase it is soliciting.

Despite Complainant's language quoted above, Complainant has conceded for the purposes of this proceeding that the advertising accurately portrays what the book says or at least that there is no evidence to the contrary. Thus, in this proceeding the advertising can be held to falsely represent the book only:

(a) if a fiction is made that the principles and procedures espoused by the book are false; and

(b) from that finding it is concluded that the book will not confer the knowledge that the advertising represents the book will confer; and

(c) it is further concluded that the advertising thus misrepresents the product offered for sale.

As the Judicial Officer has refused to accept or to make finding of falsity such as is described above, he cannot reach the ultimate conclusion that the advertising misrepresents the product advertised.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. Foreign Publications

1. In German

145. SCHULZE, ERICH. *Urheberrecht in der Musik*. 4., neubearb. Aufl. Berlin, De Gruyter, 1972. 308 p.

The fourth, revised edition of a comprehensive work, by the general director of the West German performing rights society, GEMA, on the protection of music in the German Federal Republic, with emphasis on GEMA's contributions toward such protection.

146. SONTAG, PETER. *Das Miturheberrecht*. Köln, C. Heymann [1972]. (Abhandlungen zum deutschen und europäischen Handelsund Wirtschaftsrecht, 2.)

Originally presented as the author's thesis, Tübingen.

A study of the problems of joint authorship under the copyright law of the German Federal Republic.

B. LAW REVIEW ARTICLES

1. United States

147. BLAIN, ROBERT K. Regulation of cable television: the Federal Communications Commission's 1972 rules. *The University of Illinois Law Forum*, vol. 1972, no. 3, pp. 608-624.

"This comment discusses the background of the new regulations and attempts to evaluate their impact on the CATV and broadcast industries."

148. Copyright — fair use — photocopying and distribution of copyrighted journal articles by government library constitutes actionable infringement. *Vanderbilt Law Review*, vol. 25, no. 5 (Oct. 1972), pp. 1093-1107.

A case note on *Williams & Wilkins Co. v. United States*, 172 USPQ 670 (1972).

149. CURTIS, FRANK R. Protecting authors in copyright transfers: revision bill § 203 and the alternatives. *Columbia Law Review*, vol. 72, no. 5 (May 1972), pp. 799-846.

A study of the termination-of-transfers provision, last incorporated in S. 644, 92d Cong., 1st Sess. (1971), and of several possible alternative measures. An earlier version of the study was a winning paper in the national Nathan Burkan prize competition.

150. LEONARD, BRIAN EDMUND. Copyright protection for the architect: leaks in a legal lean-to. *California Western Law Review*, vol. 8, no. 3 (Spring 1972), pp. 458-487.

A comment, entered in the 1972 Nathan Burkan Memorial Competition at the California Western School of Law, which analyzes common law and statutory copyright protection afforded architects, demonstrates that such protection is inadequate, and, in conclusion, proposes administrative, legislative, and judicial solutions to the problem.

151. PHELPS, JOHN V. A conceptual analysis of idea appropriation. *Memphis State University Law Review*, vol. 2, n. 1 (July 1972), pp. 67-84.

"The concept of idea appropriation in a factual context is not esoteric; however, the remedies and theories of recovery which such appropriation invokes are perplexing and inconsistently applied. Although no general statement of the law is possible, this note will examine the theoretical bases of this body of law in an effort to provide the student and practitioner with as succinct a conceptual analysis as is historically possible."

152. SPRATLING, GARY R. The protectability of package, container, and product configurations. *University of San Francisco Law Review*, vol. 5, no. 2 (Apr. 1971), pp. 451-515; vol. 6, no. 1 (Oct. 1971), pp. 172-202.

Three types of protection from copying of a shape are considered: (1) common law unfair competition protection; (2) design

patent protection; and (3) protection under the Lanham Act. The effect of the *Sears* and *Compro* decisions on these three types of protection receive special attention.

153. WALSH, DAVID G. CATV: let the cables grow. *Marquette Law Review*, vol. 55, no. 2 (Spring 1972), pp. 205-240.

A critical analysis of the development of the regulatory policy of the Federal Communications Commission over CATV. The writer maintains that "not until August 5, 1971, did . . . [the Commission] take a positive step toward effectuating . . . [CATV's] potential to serve the public interest."

2. Foreign

1. In English

154. African Seminar on Intellectual Property, *Nairobi, October 16 to 20, 1972*. Note. *Copyright*, vol. 8, no. 12 (Dec. 1972), pp. 239-240.

"In the field of copyright, the discussions centered on the 1971 revisions of the Berne and Universal Copyright Conventions." The list of participants appears at the end of the Note.

155. BARKER, RONALD. Legal, moral and practical considerations. *Scholarly Publishing*, vol. 3, no. 4 (July 1972), pp. 297-304.

A case is made, based on legal, moral and practical considerations, for the protection by originating book publishers of the absolute exclusivity of their licensees in other markets, with particular reference to the United Kingdom and the United States.

156. BOGUSLAVSKY, M. Legal protection of industrial designs in the U.S.S.R. *NIR*, 1972, no. 3, pp. 240-247.

A survey of the main principles of the protection.

157. GALTIERI, GINO. The protection of computer programs under the Italian legal system. *Copyright*, vol. 8, no. 11 (Nov. 1972), pp. 227-228.

According to the writer, the most suitable provision in current Italian copyright law for application to computer programs is the neighboring rights provision, article 99, which "provides . . . for two categories of rights belonging to authors of engineering projects

or other analogous works which constitute original solutions of technical problems.”

158. Intergovernmental Committee of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations. *Extraordinary Session, Geneva, September 21 and 22, 1972*. Report, submitted by the Secretariat. *Copyright*, vol. 8, no. 11 (Nov. 1972), pp. 220-222. A list of participants is appended to the report.

Included in the agenda were the conclusions of the second committee of governmental experts on neighboring rights problems raised by transmission via space satellites, and the “Progress report on the preparation of a draft model law to facilitate ratification and implementation of the Rome Convention.”

159. LEDUC, CLAUDE ALPHONSE. National applications of the Rome Convention on neighboring rights. *Copyright*, vol. 8, no. 11 (Nov. 1972), pp. 228-234.

A study of the Convention with special attention to the options it offers to national legislations and to “practical problems arising from the secondary use of commercial records, and the manner in which they have been solved in certain countries which grant equitable remuneration to performers and producers of phonograms.”

160. SANCTIS, VALERIO DE. The Paris revisions of the Universal Copyright Convention and the Berne Convention. *Copyright*, vol. 8, no. 12 (Dec. 1972), pp. 241-260.

Translated from the original Italian which appeared in 43 *Il Diritto di Autore* 131 (1972). See 20 BULL. CR. SOC. 138, Item 110.

161. ULMER, EUGEN. The Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms. *IIC*, vol. 3, no. 3 (1972), pp. 317-334.

An English version of the author’s “Das Übereinkommen zum Schutz der Hersteller von Tonträgern gegen die unerlaubte Vervielfältigung ihrer Tonträger,” published in the March 1972 issue of *GRUR Int.*, pp. 68-76. See 19 BULL. CR. SOC. 518, Item 382 (1972).

2. In French

162. PARISOT, BERNARD. L'inalienabilité du droit moral de l'auteur d'une oeuvre littéraire ou artistique. *Recueil Dalloz Sirey*, 1972, 13. Cahier (Mar. 29, 1972), Chronique, p. 71-78.

A doctrinal study of the inalienability of the moral right of the author of a literary or artistic work under the French copyright law.

3. In German

163. ROEBER, GEORG. Rechtsfragen der audiovisuellen Kassettensysteme; eine Bestandsaufnahme im Grundsätzlichen. *Film und Recht*, vol. 16, no. 8 (Aug. 15, 1972), pp. 247-250.

A discussion of legal questions in regard to audio-visual cassette systems in the German Federal Republic presented in the following four problem areas: (1) definition; (2) spheres of exploitation; (3) user rights; and (4) contractual relationships.

164. SCHULTZE, FRIEDRICH. Rechtsbeziehungen zwischen Autor und Regisseur; einige Bemerkungen zu den dramaturgischen Problemen der Bearbeitungen (und ihrer Grenzen!) durch den Regisseur. *Film und Recht*, vol. 16, no. 8 (Aug. 15, 1972), pp. 250-260.

A discussion of the legal relationship between author and producer in the German Federal Republic with regard to dramaturgical problems of adaptations and to the permissible modifications that may be made by the producer.

165. THOMA, HELMUT. Urheberrechtlicher Schutz für Fernsehsender; eine Replik zu den Ausführungen von Dr. Josef Handl in *FILM UND RECHT*, Nr. 5/1972 (S. 168ff.). *Film und Recht*, vol. 16, no. 9 (Sept. 15, 1972), pp. 290-293.

A reply to Dr. Josef Handl's criticism of a recent Austrian court involving the projection of a telecast on a theater screen. Dr. Handl's article appeared in 16 *Film und Recht* 168 (1972) under the same title as this reply. See 20 *BULL. CR. SOC.* 62, Item 48.

4. In Swedish

166. KARNELL, GUNNAR. Upphovsrättslagens katalogskydd. *NIR*, 1972, no. 3, pp. 248-260.

A study in Swedish, with an English summary, which analyzes the specific protection of catalogs under article 49 of the Swedish copyright act.

167. WESTERLIND, MIKAL. Titelskydd. *NIR*, 1972, no. 3, pp. 261-289.

A discussion, in Swedish with an English summary, of title protection under Swedish laws.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

168. A campaign for arbitration on copyright; the author sees no more chance of compromise with cable interests, vows direct appeal for legislation. *Broadcasting*, Jan. 8, 1973, pp. 36-37.

An article on the failure of copyright owners to reach an agreement on a copyright fee schedule, and the reactions of Jack Valenti, president of the Motion Picture Association of America, who contended, as a representative of the copyright owners, that an independent tribunal with no fixed fee schedule should be in the copyright revision bill to set the fees instead of Congress.

169. GRANNIS, CHANDLER B. Copyright protects the public interests. *Publishers' Weekly*, vol. 202, no. 21 (Nov. 20, 1972), p. 48.

An editorial comment on the *amicus curiae* brief by Attorney Irwin Karp, filed for the Authors League of America in support of the Williams & Wilkins complaint against the Government for copyright infringement.

170. JAHN, MIKE. The royalty cheaters; a funny money game sometimes leaves composers singing the blues. *High Fidelity*, vol. 22, no. 12 (Dec. 1972), pp. 56-58.

An article on the lot of a number of composers of rock and roll music — principally Arthur "Big Boy" Crudup, called "The Father of Rock 'n' Roll" by his record company — who have never been paid for the recording of their works.

171. MACKENZIE, JOHN P. Tape 'parasites'. *The Washington Post*, Dec. 14, 1972, p. C1, cols. 7-8; C4, cols. 1-2.

A summary of the arguments before the Supreme Court on December 13 in the case of *Goldstein v. California* (U.S. Sup. Ct., No. 71-1192).

172. MURPHY, JAMES P. The legal effect of Williams & Wilkins. *Publishers' Weekly*, vol. 202, no. 24 (Dec. 11, 1972), pp. 11-12.

In a letter to the editors of *Publishers' Weekly*, a lawyer and librarian from Dallas refutes the statement of William M. Passano of Williams & Wilkins (*PW*, Nov. 13, pp. 17-18) on Commissioner Davis' report of February 16, 1972 on the *Williams & Wilkins* case. Mr. Murphy points out that the report is, in essence, only a recommendation, and does not constitute a judgment or decision of the Court of Claims.

173. New ASCAP agreement gives radio big break; new five-year license expected to reduce station payments by at least \$2.4 million a year. *Broadcasting*, Dec. 11, 1972, p. 9.

An article on an agreement between ASCAP and the All-Industry Radio Music License Committee, which will cut radio stations' rate of payment about 14 percent. It will be submitted to Judge Sylvester J. Ryan of the U.S. District Court for the Southern District of New York, where suit between the parties is pending, for approval.

174. The new federal copyright law. *High Fidelity*, vol. 22, no. 12 (Dec. 1972), pp. 54-55.

An article on the recent amendment to the copyright law which makes it possible to copyright sound recordings, thus protecting them from unauthorized duplication.

175. ROTHENBERG, STANLEY. Danger for 'style piracy.' *Variety*, vol. 269, no. 8 (Jan. 3, 1973), p. 134.

An article on the new law for the protection of sound recordings.

176. Video piracy — a new problem. Participants: Tony Palms, and others. Moderator: Charles Tepfer. *Videoplay Magazine*, vol. 1, no. 1 (Oct. 1972), pp. 2-4, 9-10. Bound with *Educational and Industrial Television*, vol. 4, no. 10 (Oct. 1972).

A transcript of a meeting at which eight producers/distributors discuss the problem of unauthorized copying of films and videotapes.

177. WAGNER, SUSAN. Photocopying talks collapse; new solutions sought. *Publishers' Weekly*, vol. 202, no. 24 (Dec. 11, 1972), p. 20.

An article on the failure of the so-called "Cosmos Club" talks to resolve the differences over library photocopying between publishers and librarians and its possible effect on copyright revision.

NEWS BRIEFS

178. UNESCO CONFERENCE ON TRANSLATORS' RIGHTS, PROTECTION OF SATELLITE-TRANSMITTED TELEVISION SIGNALS.

The question of adopting an international instrument on the protection of translators was considered at the 17th Session of the General Conference of UNESCO, held in Paris on September 16-October 17. According to the *Library of Congress Information Bulletin*, vol. 31, no. 49, Dec. 8, 1972, pp. 529-530, the Commission approved a resolution inviting the Intergovernmental Copyright Committee of the Universal and the Executive Committee of the Berne Union to examine at their joint sessions in 1973 the adequacy of copyright protection for translators under the two conventions and in national laws and to propose any steps deemed necessary to ensure that such protection is adequate. In addition, the Commission invited the Director General of UNESCO to submit to the Conference a report on the desirability and possible scope of an international instrument on this subject.

Also considered at the Conference was the question of an international instrument for the protection of television signals transmitted by satellite. The Commission authorized the Director General to convene in 1973 jointly with the Director of the World Intellectual Property Organization a third Committee of Government Experts and decided that if the third committee should so recommend that the Director General, in cooperation with the Director of WIPO, should make plans for a conference in 1974 to adopt an appropriate international convention on the subject.

179. SENATE CONSIDERS MECHANICAL AND JUKEBOX ROYALTY RAISE.

The Senate Copyrights Subcommittee is actively considering a 26.6 percent cost-of-living increase for mechanical and jukebox performance royalty rates on copyrighted music, according to

Billboard, Dec. 16, 1972, pp. 1 and 51. The raise would lift the mechanical royalty rates on recordings to 3.1 cents per tune and the jukebox rates to slightly over \$10 per box per year. The original rates, proposed in 1967 for the then-pending copyright revision bill, were 2.5 cents per tune for mechanical recordings and \$8 for jukeboxes.

A letter was sent out by the Subcommittee requesting comment from interested parties. The letter pointed out that "It has been proposed that the fixed royalty rates in the bill should be adjusted to reflect the rate of inflation during the period in which the copyrighted legislation has been necessarily delayed. It is argued that such adjustment is necessary to provide the equivalent in 1973 dollars of a sum determined to be reasonable in the mid-sixties."

No public hearings are likely to be held on this issue. The comments and the subcommittee vote will decide.

180. COORDINATION OF PERFORMING RIGHTS SOCIETIES SOUGHT BY CISAC.

The new administrative committee elected at the 28th world congress of authors and composers organized by the Confederation of International Societies of Authors and Composers (CISAC), held in Mexico City on October 16-21, 1972, is expected to emphasize coordination of the performing rights societies throughout the world during its two-year term of office (1972-1974).

CISAC's new officers, according to *Variety*, Nov. 1, 1972, p. 54, will particularly stress collections in the Latin American countries — except Mexico and Argentina — where the problem of collecting royalties due on recorded music has been particularly difficult.

See item 124, *infra*.

181. PAKISTAN WAIVES COPYRIGHTS. According to the *Evening Sun* of Baltimore, Dec. 6, 1972, p. 3, President Aulfikar Ali Bhutto has authorized Pakistani publishers to ignore foreign copyright laws and reproduce English-language college textbooks because the prices of imported books is "beyond the reach of the common man in Pakistan."

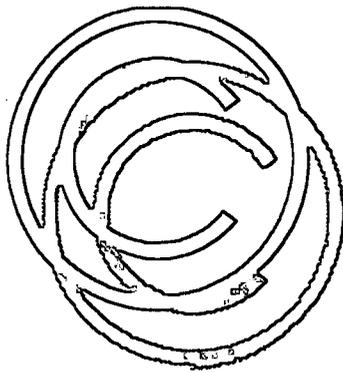
The order, issued on December 5, 1972, waives copyright regulation to allow reproduction in the original language or after translation into local dialect. Only British and American texts will be reproduced, officials said.

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ANNOUNCEMENTS

GEORGE CARY RESIGNS AS REGISTER

George D. Cary, who has served as Register of Copyrights since late 1971, retired on March 9 after 35 years of government service, 26 in the Library of Congress.

The Librarian of Congress, L. Quincy Mumford, said, in announcing his retirement, "His expertise in copyright law will be sorely missed by me and his colleagues here in the Library as well as the national and international copyright community."

Abe A. Goldman, General Counsel of the Copyright Office, will serve as Acting Register of Copyrights until the appointment of a new Register. Mr. Goldman has served in the Copyright Office since 1952.

U.S.S.R. JOINS UNIVERSAL COPYRIGHT CONVENTION

On February 27, 1973, the Union of Soviet Socialist Republics deposited its instrument of adherence to the Universal Copyright Convention. The effective date of adherence is May 27, 1973.

The version of the Convention to which the U.S.S.R. has adhered is that of September 6, 1952, which came into force on September 16, 1955.

In general, the application of the Convention is not retroactive, so that neither the U.S.S.R. or any other member country is obligated, as a result of the adherence by the U.S.S.R. to the Convention, to protect the works of the other country that were first published before May 27, 1973.



DR. YURI MATVEEV

PART I.

ARTICLES

182. COPYRIGHT PROTECTION IN THE U.S.S.R. — *THE ELEVENTH ANNUAL JEAN GEIRINGER MEMORIAL LECTURE ON INTERNATIONAL COPYRIGHT LAW.**

By DR. YURI MATVEEV**

Let me say first of all, how honored I am to be here and to have the privilege of delivering the annual Jean Geiringer Memorial Lecture which has become a symbol of international cooperation and exchange in the field of copyright.

During the short time at my disposal I'll try to give you a general survey of Soviet copyright. This may be of particular interest to you at this moment since after the Soviet Union joined the Universal Copyright Convention, the works of American authors will receive protection in the USSR according to provision of Soviet copyright. May I underline in this connection that in accordance with article IX of the U.C.C., this Convention will come into force in the Soviet Union on 27 May 1973, i.e., three months after the deposit of the instrument of accession. Therefore, only beginning from that date will the works of American authors — first published in any contracting state — be protected in the Soviet Union, since the U.C.C. is not retroactive.

The accession by the Soviet Union to the Universal Copyright Convention of 1952 should be considered a natural consequence of the development of literary arts and science in my country. It not only opens new perspectives in the development of international cultural and scientific relationships, but it has also led to important changes in the domestic Soviet copyright legislation, resulting from the need to bring it into accord with the provisions of the Universal Copyright Convention.

* See EDITORIAL NOTE, p. 233.

** This lecture was delivered on April 13, 1973, in the Auditorium, Time-Life Building, New York. Dr. Matveev was a senior lecturer at the University of Kiev Law School before joining the Copyright Division of UNESCO where he has been working for the past three years in connection with the most recent revision of the Universal Copyright Convention. He is the author of several articles on International Copyright, and his book, entitled "International Copyright Protection" is expected to be published next year in Moscow.

The recent Decree of the Presidium of the Supreme Soviet of the USSR,¹ which provides the additions and changes in the Basis of Legislation of Civil Code of USSR,² meets the requirements of article X of the U.C.C., which stipulates that each Contracting State must adopt such measures as are necessary to ensure the application of the Convention. Moreover, I should mention Article 64 of the Code of Civil Procedure of the Soviet Union which states that, where a treaty or international agreement in which the Soviet Union participates provides rules other than those provided in the Soviet civil legislation, the provisions of the international agreement are to be applied.

The objective of any country joining an international copyright arrangement is, of course, to obtain better rights for its authors in exchange for granting better rights to foreign authors. Thus, bearing in mind the aim to establish a better legal system for the use of Soviet works abroad, the Soviet Union has taken the necessary steps to safeguard the adequate and effective protection for the rights of foreign authors and other copyright proprietors in the USSR, in accordance with the requirements of the U.C.C.

I think you will agree that one of the first questions which arises in connection with the accession of the Soviet Union to the Universal Copyright Convention is whether the quantity of works published in translation in the Soviet Union will be decreased, since factors of international commercial relationships now enter into effect which did not exist before.

In an effort to try to answer this question, I might first refer to the opinion expressed by the Chairman of the State Committee of the Council of Ministers of the USSR for publishing, printing and book trade, Mr. Stoukaline, in his recent statement for the literary newspapers. He pointed out that the Soviet publishing houses have been publishing all of the best literary works of the world, and will continue to do so. Moreover, the majority of the publishing houses have already completed their plans for publication for 1974, and these plans indicate an increase in the number of translations. On the other hand, it is to be hoped that the negotiation of contracts and the resulting increase in cooperation between copyright organizations in the USSR and other countries will lead to an improvement in the number, variety, and quality of works by Soviet authors published abroad in translation, and

1. 21 February 1973.

2. This Decree has no retroactive effect and applies only to rights arising after 1 June 1973. It does not apply to treaties and agreements concluded before this date, nor does it apply to rights which terminated before that time.

that foreign readers can get a broader and more balanced picture of Soviet literature.

Before giving you a general survey on Soviet copyright, let me say a few words about the history and sources of this branch of the civil law of my country.

The first law in the field of copyright was published two months after the October Revolution, on 4 January 1918. This Decree concerning the state publishing house was adopted with the aim of giving the public the possibility of buying the works of the best writers, critics and scholars at low prices. Because of the specific conditions of that period, works for which the terms of protection had terminated were transferred to the publishing houses for reproduction and publication without formalities. As far as other works were concerned, the Decree declared that the state monopoly to publish those works would last for not more than five years.

The first special law on copyright, which was adopted in 1925 under the title "The Bases of Copyright Legislation" was replaced in 1928 by another statute bearing the same title. Both the 1925 law and its amended version were adopted throughout the Republics. The main distinctive features of these laws were the establishment of a fifteen-year term of copyright protection and provisions specifying cases in which works could be used without the consent of the authors. Subsequently, a number of special laws were introduced concerning the manner in which different kinds of works could be used in the fields of radio broadcasting, the cinema, and the like.

Today, Soviet copyright derives from numerous legal acts, the most important of which are included in Chapter IV of the Bases of Legislation in Respect of Civil Law of the Union of Soviet Socialist Republics and of the Federated Republics, as well as in Section 4 of the Civil Code of the Soviet Republics. A number of decisions of the Council of Ministers of the USSR and Soviet Republics have been adopted on various specific copyright problems, and there are numerous orders and instructions issued by different ministers and other departments in charge of the management of scientific, cultural and educational activities. I wish to mention specifically the standard contracts governing the use of protected works in publishing, public presentation or performance, and for other purposes. I should also mention the decision of the Plenary of the Supreme Court of the Soviet Union, dated 19 December 1967, concerning the practice of the Courts in disputes arising from copyright. This decision, which includes a number of explanations and interpretations of copyright provisions, must be followed by all courts in the Soviet Union.

From a general theoretical point of view, Soviet copyright presents itself as a system of legal norms regulating the relations that arise in connection with the creation and utilization of works of literature, art and science, with the ultimate purpose of satisfying the cultural, artistic and scientific interests of our society. The point to be emphasized here is the need to combine protection of the interests of authors with protection of the public's interest in the development of science, technology, arts and literature.

Subject matter of protection

Without going too deeply into theoretical observations concerning the subject matter of copyright, I should like to point out that it includes all work which is the result of intellectual activity of its author. The list of specific works protected by copyright is given in article 475 of the Civil Code. This list is not limitative or exhaustive in character but I should nevertheless like to quote the article as a whole:

ARTICLE 475

Works in Which Copyright Subsists

Copyright subsists in scientific, literary or artistic works, whatever their form, purpose and value or their means of expression.

Copyright subsists in all works, published or unpublished, expressed in any tangible form from which the result of the author's creative activity may be reproduced (manuscript, drawing, picture, public utterance or performance, film, mechanical or magnetic recordings, etc.).

The following may be subject of copyright:

- . oral works (speeches, lectures, reports, etc.);
- . written works (literary, scientific, etc.);
- . dramatic and dramatico-musical works, and musical works, with or without words;
- . translations;
- . scenarios, synopses;
- . cinematographic or television films, as well as radiophonic or television transmissions;
- . choreographic works and pantomimes, the acting form of which is fixed in writing or otherwise;

- works of painting, sculpture, architecture, graphic or applied art, illustrations, drawings and sketches;
- plans, sketches and models relating to science, techniques, or stage performances of dramatic or dramatico-musical works;
- geographical, geological or other maps;
- photographic works and works obtained by processes analogous to photography;
- phonographic discs and other types of technical recordings of works;
- and other works.

Copyright subsists in photographic works or in works obtained by processes analogous to photography, provided that each copy bears the name of the author, the place and the year of publication.

The following conclusions can be drawn from this provision:

First, it is not necessary for a work to be completely finished to bring it under copyright protection.

Secondly, although the form and intended use of the work are not taken into account, it is necessary that the work be in a tangible form which permits its reproduction without the participation of the author. Sometimes the methods of fixation are envisaged in the law itself, as in the case of works of choreography and pantomime. The new Decree of 1973, which amended the copyright legislation, also mentions the necessity for the subject matter of copyright protection to be in tangible form.

In this connection, I should like to comment on some remarks which appeared recently in your press, and which indicate a measure of confusion on this subject. On March 16th I read an article in the International Herald-Tribune on the new copyright legislation, in which the author said that he was very surprised to find a provision stating that copyright will apply to works first published in the territory of USSR and also to unpublished works found in the territory of the USSR. The writer concluded that any work not officially published but circulated in manuscript form is not protected by copyright. I think that this interpretation has no basis and could be explained by the fact that the writer of the article was unaware of the provisions of Soviet copyright legislation underlying the recent amendments.

A third conclusion that can be drawn from an analysis of Article 475 is that the copyright law protects any work without taking into account its value and the intentions of the author in creating it.

Among the works that are not protected by copyright, I should mention the following:

- a/ works of folklore;
- b/ works of authors who die without heirs, and works whose terms of protection have expired;
- c/ works belonging to citizens outside the USSR, if these works were first published abroad or exist abroad in any tangible form, provided these works are not subject to applicable international bilateral or multilateral treaties to which the USSR has adhered. As you undoubtedly know, the Soviet Union has concluded bilateral agreements on the protection of copyright with Hungary and Bulgaria.

As a final point concerning the subject matter of protection, I should like to draw your attention to the concept of publication, which is of great importance in Soviet copyright law. Article 467 of the Civil Code specifies that a work is deemed to be published when it is released to the public, performed in public, displayed in public, diffused by radio or television, or communicated in any other manner to an indeterminate group of persons. In this connection, a very important detail is that the work will be considered published on the 1st January of the year in which it is communicated to the public in one of the specified ways.

Persons protected

Here again, without going deeply into the theory, I should explain that the person protected by the law is considered to be the person whose creative activity resulted in the work. It is accepted law that the right of the author derives from the fact of creation itself, without necessity for fulfilling any kind of formality.

A Soviet citizen is considered to be entitled to copyright protection in the USSR, independently of whether his work was published in the USSR or abroad; if his work is not published, it is sufficient if it exists in any material form. Copyright in works first published in the territory of the USSR or not published but existing in the territory of the USSR in any objective form is recognized for the author and his heirs independently of his citizenship. The procedure by which an author who is a national of the USSR transfers the right to use his work in the territory of a foreign state shall be established by the law of the USSR. After the accession of the Soviet Union to the Universal Copyright Convention comes into effect, the citizens of foreign countries belonging to

the U.C.C. will be protected in the territory of the USSR under the provisions of the Convention, as is now the case for authors who are citizens of Hungary and Bulgaria. Works first published in U.C.C. countries will also be protected, regardless of the citizenship of their authors.

In addition to physical persons, legal persons may be considered entitled to copyright protection in the cases and under the conditions established by law. Articles 485 and 486 of the Civil Code stipulate such cases:

- Copyright in periodicals or similar publications such as scientific collections, encyclopaedic dictionaries, reviews or other serial publications belongs to the organizations which publish them. The authors of works included in these publications also enjoy copyright in their works, and the two types of copyright exist concurrently.
- Copyright in a cinematographic or television film belongs to the enterprise which makes the film. The author of the scenario, the composer of the musical score, the producer, the chief cinematographer, the director and the authors of other contributions forming a constituent part of a cinematographic or television film each also enjoy copyright in respect of their contribution.
- The copyright in a broadcast transmission, whether sound or visual, belongs to the transmitting organizations, but the copyright in works included in the transmission belongs to the authors.

Co-authorship exists when the creative participation of two or three persons leads to the creation of a single and integral work; this co-authorship is considered divisible when each part of the work also has its autonomous significance, and indivisible when the work itself represents an integrated entity. In cases of co-authorship, the copyright belongs to all persons participating in the creation of the work, but at the same time each co-author of a part of the work which has an independent significance retains his copyright on the part of the work created by him.

A part of a collective work is regarded as having the character of an autonomous creation if it can be utilized independently of the other parts of the work.

Relationships between co-authors can be regulated by common agreement between them: in the absence of agreement, copyright in a collective work is exercised by all the co-authors jointly, and the royalties are divided between them according to the rules prescribed by the laws of the USSR and by the decrees of the Council of Ministers of the Soviet Socialist Republics.

The Essential Elements of Copyright

The Soviet copyright divides the rights of authors into personal (non-patrimonial) and patrimonial rights. These rights are very closely connected and include:

- i/ the rights to claim authorship and to the use of the author's name
- ii/ the rights of publishing, translation into other languages, reproduction and dissemination
- iii/ the right to maintain the integrity of the work
- iv/ the right to compensation for utilization of the work by other persons.

The right to claim authorship guarantees that the author be identified with the work and includes the right to request the mention of his name when his work is used. The right to the use of the author's name is closely connected with the right to claim authorship, and includes the right to issue his work under his own name, under a borrowed name (pseudonymously), or without revealing his name (anonymously). No one is entitled to change the name of the author without his previous consent.

Though very closely related, the rights of an author to publish his work and to disseminate it are not identical. They have the common aim of revealing the contents of the work to society. It is possible to make the work known to society by different methods, as by publishing a book, delivering a lecture, by displaying a sculpture or picture at an exhibition, by making a recording of the work, and so forth. "Publication" of a work involves a wide range of consequences, particularly the condition that under certain circumstances it is possible to utilize the work without the consent of the author and even sometimes without royalties. The right of the author to reproduce his work—in other words, the right to multiply the work in copies or by any other means—usually is closely connected to the publication of the work. It is one of the methods by which a work can be published, but it is not the only method. For instance, to display a picture publicly is to publish it, but of course there is no reproduction in this case.

One of the most important peculiarities of Soviet copyright is a comparatively wide range of possibilities for reproduction of the work protected by copyright without the consent of the author. Such reproduction may take place with payment of royalties to the owner of the

copyright or without such payment. Reproduction of a work which has been already published without the consent of the author and without payment of royalties is authorized in the following cases, subject to the requirement that the name of the author and the source of the borrowing are indicated:

1. Reproduction in scientific publications, critical analyses or scholastic publications and those serving political education, of scientific, literary or artistic works published separately, or of extracts from such works, within the limits established by the Council of Ministers of the Soviet Republics.
2. Reproduction in newspapers, by cinema, on radio or television of speeches and lectures that have been delivered in public, as well as published literary, scientific or artistic works. Reproduction also includes direct retransmission by radio or television from the actual place of performance of works that are being publicly performed.
3. Reproductions for the purpose of teaching and instructional activity without profit.
4. The reproduction in any manner (except for copies made by means of a mechanical process) of works of plastic art located in places that are accessible to the public, other than in exhibitions and museums.
5. The reproduction of a published work for personal use. Reproductions of printed works for scientific teaching and educational purposes without deriving profit therefrom.

The utilization of a work without the consent of the author, but with payment of royalties and subject to the requirement that the name of the author be indicated, is authorized in the following cases:

1. The public performance of published works. However, if spectators do not pay an admission charge, the author is entitled to remuneration only in cases specified by the Council of Ministers of the Soviet Republics.
2. The recording on a film, on discs, on magnetic tape or other media, with a view to public reproduction or to the diffusion of published works, other than the utilization of works by cinema, by radio or by television.

3. The utilization of plastic works and photographic works for industrial products. In this case, indication of the name of the author is not required.

In connection with the problem of use of protected works, I should mention that the right to publish the work, to perform it publicly or to use it in some other way may form the subject of a compulsory purchase by the government from the author or from his heirs, by virtue of a special decision taken in each individual case by the Council of Ministers of the Soviet Republics. In such cases, the Council of Ministers determines the manner and the conditions under which the work may be used.

The right of the author to protect the integrity of his work means that without his consent it is prohibited to make any modification in the work itself, in its title, or in the designation of the name of the author. While talking about the right of integrity, I would also like to draw your attention to the possibility of composers using published literary works for the creation of musical works with words. This utilization is permissible without the consent of the author but with payment of royalties, which should be payable to the author by the organization which utilizes the work.

The Soviet law also permits the utilization of another published work for the making of a new and original creation, except for the adaptation of a story into a dramatic work or into a scenario, and conversely, or the adaptation of a dramatic work into a scenario, and conversely. Such a utilization is permissible without the consent of the author and without payment of royalties.

Until now the translation of a work into another language was possible without the consent of the author, subject to the conditions that notice be given to the author and that the integrity and spirit of the work be respected. Until 1967, the author of the original work of the published translation was not always remunerated. In some Soviet Republics the author was not remunerated for the translation of his work from Russian into the languages of the Republics. But when the translation from the national language into Russian took place, the remuneration to the author of the original work was obligatory. However, since 1967 the trend has been towards adopting new legislation in the Federal Republics providing for the remuneration of the author of the translated work in all cases, irrespective of the language of the original or of the translation. The newly-adopted legislation provides that the translation of a work into another language is permissible only with the consent of the author and subject to the payment of royalties to

him. But the competent authorities may permit the translation without the consent of the author in accordance with the provisions of international agreements and treaties in which the Soviet Union participates.

The Right of Remuneration

As a rule, the author of a work is entitled to compensation for its utilization, but it is comparatively rare for the size of this compensation to be agreed upon by the parties themselves. One instance where the amount of payment can be agreed upon involves the case of an artist commissioned to create a portrait or statue. In the majority of cases, the size of compensation is defined by law, since as a rule the author licenses his work to organizations rather than to individual persons. In the majority of cases, the size of remuneration is established by the laws of the separate Soviet Republics, but in some cases, the law of USSR is used for this purpose. While establishing the size of remuneration, the law takes into account the quantity and quality of the efforts which the author used for the creation of this work. For these purposes some kind of unit of measures is established. For instance, for works of literature and science, a so-called "author's page" is established which is equal to 40,000 typed letters of symbols. For poetry, lines are used as units, and for short works the work itself is the unit. Within the limits established by law, the amount of remuneration is specified in the contract which the author concludes with the organization for the utilization of his work; in such cases the quantity and the number of copies is usually taken into account. For some works, a limit of edition is established. For instance, for a work of fiction, 15,000 copies are established as a limit, for a work of poetry this limit is equal to 10,000 copies. Each copy exceeding this limit is considered as a second edition, which is subject to separate payment.

For some kinds of works, special rules are established. For instance, for works of drama, remuneration is established in the form of the royalties based on percentage of receipts which theaters, in particular the first theater to produce the work, must pay to the author for each performance. The first theater to produce an unpublished work also pays the author the remuneration due in a lump sum. The amount of this payment is fixed in the contract in accordance with the tariffs laid down by the Governments of the Republics.

Works created within the scope of an author's employment are not remunerated in the form of royalties, since the author receives a salary. This is true, for instance, in a case where the author works for a scientific organization or university. In such cases, the author is required

to prepare a so-called work plan, and, therefore, for such plan, the author does not get royalties. But if the author creates something besides such plan, he gets royalties according to the general rules. As an exception, authors of textbooks, or training manuals, get royalties in spite of the fact that such works are approved upon submission of a personal plan.

Term of Protection

Until very recently, the period of protection of copyright in the USSR was equal to the author's life plus 15 years. As you know, the term of protection was recently increased up to 25 years, calculated from the 1st January of the year of the death of the author. But for works of photography and applied art, the term of protection still is equal to 10 years. The limits of the sums payable to the heirs of the author as copyright royalties are determined by the law. But under no circumstances may the sums payable to the heirs exceed 50 per cent of the compensation which would have been payable to the author himself. And for works on political subjects, technical works, scientific and other works except belles-lettres, this sum cannot exceed 20 per cent of the compensation which would have been payable to the author himself. In case of a collective work, the heirs of each co-author enjoy copyright calculated from January 1st of the year in which the death occurred. After this term is over, the right of compensation belonging to the co-authors, and having passed to his heirs, expires.

Copyright belonging to organizations is unlimited in duration.

The expiration of a copyright does not mean that the work may be changed, shortened and otherwise utilized by others. The integrity of a work is secured by the State through the corresponding organizations. These organizations decide problems such as the necessity of making some changes in the work, or including some additional material, etc.

The author, if he has a will, may designate heirs to his copyright, but in the case of absence of a will, the copyright goes to the husband or wife, to children and other relatives as prescribed by law. If the heir dies before the termination of the term of protection, the remaining part of the term goes to his own heirs.

I must add that not all rights which are included in the copyright are subject to inheritance. Rights such as the right to claim authorship and to use of the author's name cannot be transmitted, since only the creator of the work is considered the subject of such protection. On the other hand, the right to the integrity of the work can be transmitted to the heirs; in cases where there is doubt as to the validity of an heir's

claim involving this right of integrity, the final decision rests with the appropriate State organization.

As a rule, use of protected works is regulated by contract relating to the utilization of the work. According to law, the author's contract is the agreement by which the author delivers his work to the organization or undertakes to compose and deliver it within a specific period, with a view to its utilization in the manner stipulated. The organization undertakes to assure or to undertake such utilization within the period fixed in the contract and to pay compensation to the author. Depending on the mode of utilization, the Soviet law recognizes the following types of contracts:

1. Contracts relating to the publication of reproduction of a work (publishing contracts).
2. Contracts relating to the public presentation or performance of a published work (contract for stage production); a contract for stage production making provision for a lump sum payment can be concluded by the author with only one organization with respect to the same work.
3. Contracts relating to the utilization of an unpublished work in a cinematographic or television film contract or for radio diffusion by sound or visual means.
4. Contracts relating to the creation of a work of plastic art with a view towards public exhibition (contract to order an artistic work).
5. Contracts relating to industrial utilization of an unpublished work of applied decorative art.
6. All other contracts relating to the utilization of literary, scientific or artistic works.

The author's contract must be concluded in writing. A written form is not obligatory in the case of contracts relating to the publication of works in periodicals and encyclopaedic dictionaries.

As a rule, authors' contracts are concluded in accordance with standard contracts approved by the competent organs of the USSR. The author's contract may contain clauses which are not included in the standard contract, but if those clauses are less favorable than those established by a standard contract, they are invalid and have to be replaced by the provisions of that contract. Independently of some of the provisions of the standard contracts, Soviet legislation envisages a specific

rule concerning the delivery and approval of the work created in accordance with the clauses of the contract; limits on the exploitation by third parties of a work forming the subject of a contract; the obligation upon the organization to utilize the work in the manner stipulated in the contract; and responsibilities of the parties resulting from violation of the contract.

Authors' rights in the Soviet Union are prosecuted both by civil and criminal law. The letter sanction is available in case of more serious violations such as illegal reproduction or unauthorized dissemination of works.

Article 149 of the Criminal Code of Russian Federation states that publication under one's own name of the scientific, literary, musical or artistic work of another person or in any other way appropriating the authorship of such a work or illegally reproducing such work or usurping the title of co-authors is a criminal offense punishable by a jail sentence up to a maximum of one year or a fine of a maximum of 500 rubles. On the other hand, the criminal law cannot protect all rights of authors which may be violated. Therefore, the Soviet civil law provides for the main method of protection by civil action. The violation of personal (extra-patrimonial) rights may require various forms of restitution (insertion of appropriate corrections, publication in the press or other appropriate means) or may result in enjoining the publication of the work or require the cessation of its dissemination. In the case of violation of patrimonial rights which may cause material damage, the author may seek such damages independently of the above-mentioned provisions concerning the violation of extra-patrimonial rights.

The protection of personal rights is available without necessity to prove intent of the defendant; but in a case requiring damages, knowledge of the infringement on the part of the defendant is obligatory. To the protection of patrimonial rights, the Soviet legislation applies the usual statute of limitations for civil actions (three years), but the protection of personal rights is not subject to such kind of limitation. If the work is distorted or wrongly claimed by a third party, the civil action will lie independently of the time when the violation took place.

There are several organizations in charge of the protection and representation of the interests of authors in the Soviet Union. For instance, for the defense of rights of authors of works of plastic art, there is an office for the protection of authors' rights within the Artists Union of the USSR. The office for the protection of copyright which comes under the Writers Union of the USSR represents and protects the interests of authors throughout the territory of the USSR. Among the important

tasks of this organization is the collection and distribution of royalties for the utilization of works protected by copyright.

I hope I have been able to present to you the basic ideas of the Soviet copyright system. I hope opportunities for such an exchange of views can occur more often for the mutual benefit of both your country and mine.

EDITORIAL NOTE: We are most grateful to Mr. Matveev for delivering this year's Geiringer Lecture and for providing us with a general survey of Soviet copyright law. However, for some time prior to the announcement by the Soviet Union that on May 27, 1973 it would adhere to the 1952 version of the Universal Copyright Convention, a number of people had expressed the fear that the Soviets might use the Universal Copyright Convention as a means to further silence those of its citizens who seek to publish abroad without the consent of the government. On February 28 of this year the Soviet Union issued certain amendments to its copyright laws, many of which are referred to by Dr. Matveev in the accompanying lecture. These amendments, among other things, provide for the possibility of prohibiting the transfer of publishing rights abroad without the consent of the Soviet government and would permit the "reproduction" of scientific and educational materials in the Soviet Union without consent of the author and without the payment of royalties. In addition, the Soviet copyright law continues to contain a provision allowing for the compulsory purchase of copyrights by the government. Dr. Matveev indicated at his lecture that he had only just recently been informed of the new amendments and although he did comment upon them, he emphasized that his answers were based on his "personal feelings" and did not represent the formal views of his government. He indicated also that further regulations were to be promulgated in the Soviet Union prior to the adherence date of May 27, 1973 and that these regulations should, in most instances, clarify the Soviet intention. He stated his personal belief that Soviet adherence to the UCC and the addition of amendments and new regulations to the Soviet copyright law were not intended and would not be used to further limit publication abroad of materials written in the Soviet Union. Many copyright experts in this country and others concerned with the flow of communicated ideas from the Soviet Union, while applauding Soviet adherence in principle, continue to express doubts and reservations as to its ultimate effect on dissident Soviet writers. As this issue goes to press, the expected additional regulations have not as yet been revealed. We hope, however, that in the near future we will be able to give our readers a more comprehensive picture of what the final Soviet copyright law will look like. It hardly needs to be added that the final proof of the Soviet intention with regard to copyright will come from their actions and not their words.

183. RECORDING PIRACY IS EVERYBODY'S BURDEN: AN EXAMINATION OF ITS CAUSES, EFFECTS AND REMEDIES

By JULES E. YARNELL*

At the outset I would like to state that the broad scope of this little talk is dictated by the fact that although you are all experts in the field of Copyright law, few of you have direct, frequent contact with the booming racket of recording piracy, and hence cannot appreciate the scope, the critical seriousness, and direct importance to every one of us, of this theft of the creative efforts of the music and recording industry. While I will try to cover the more important recent decisions affecting this problem, it is my intention to acquaint you fully with the disease itself so that you can more readily understand and appreciate the need for, and the efforts to supply, the cure.

First, what is this piracy we are dealing with? It is the unauthorized duplication for commercial purposes of sound recordings which are then sold in pirate packaging. When the pirate also duplicates the label, packaging and trademark of the legitimate recording it is called counterfeiting.

Who are the people engaged in recording piracy? They range from the seemingly legitimate businessman who smells a quick, easy profit with little risk to the hardened members of organized crime. Do I really mean "Organized Crime"? These days, as even Art Buchwald points out, there is universal interest in "The Godfather" and its subjects and the popular attribution to this element of our society of everything from narcotics to sun spots which interfere with our radio reception. Lest I be accused of following this popular, even romantic preoccupation with organized crime, without a factual basis for my charges, let me say that a substantial part of my time is occupied in dealing with a number of organized crime task forces on the federal, state and local level throughout the United States. There is no question about the involvement of this nefarious element in recording piracy on a large-scale basis. In fact, just last week, in Tennessee, when a raid on the plant of tape pirates was conducted by the local Sheriff's forces under the Tennessee recording anti-piracy law, one of the men arrested turned out to be on the FBI's TEN MOST WANTED LIST. One member of organized crime, Tommy (Ryan) Eboli, who is no longer involved in record-

* This paper was delivered as an informal address to the Copyright Luncheon Circle on March 23, 1973. Mr. Yarnell is the Special Counsel on Piracy to the Recording Industry of America.

ing piracy, was under intensive federal and local investigation for such activities at the time of his gangland assassination.

How big is recording piracy? At present, it is estimated that nearly one in three stereo tape recordings sold in the United States is produced by pirates. In dollar volume, that's nearly \$4,000,000 of pirate recordings sold weekly. The main reasons for the great proliferation of recording piracy in recent years are the lack, until recently, of any effective federal protection for recordings and the easy availability of sophisticated duplicating equipment for duplicating tape recordings. In addition, uncertainty in the law occasioned by the Supreme Court's decisions in *Sears* and *Compco* has greatly added to the problem.

It is not just an American problem. Tape piracy is worldwide in scope, and efforts to combat it are under way throughout Europe, Asia, and elsewhere. Large quantities of American-produced pirate recordings are shipped to Europe, Africa and South America. Some of the pirate recordings sold in this country are produced elsewhere. The size and scope of the problem affects everyone, whether or not connected with the recording or music industry.

The pirate has a great advantage over the legitimate manufacturer. He copies only the hit records and thus does not risk the economic losses suffered by manufacturers who have less than one of ten recordings break even or make a profit. He does not incur the legitimate manufacturers' other huge expenses, including payments to arrangers, performers, technicians and engineers, music publishers, and large outlays for promotion. He merely sits back and skims the cream off the top of the best sellers.

And it is not only the record companies that are hurt by piracy. The public, artists, musicians, composers and publishers, the legitimate retailers and wholesalers, as well as the legitimate recording companies, are all hurt.

Piracy also contributes to a lessening respect for the law. The biggest buyers are young people and poor people. Legitimate retailers are tempted to carry pirate goods, because they are cheap (and, usually, poor quality). Many pirates masquerade as legitimate businessmen, as some bootleggers did during prohibition. And some of the pirates play rough — threatening phone calls to those investigating pirate activities, pirate factories bombed, apparently by other pirates seeking to make territorial inroads.

Piracy touches many people, and it is harmful to all of them. Piracy hurts various segments of the public, ranging from the youthful record buyer, to the artist, to the law enforcement official.

The public is hurt in four important ways:

1. *Pirate merchandise is generally of poor quality, so the sound is not as good as a legitimate recording.* Since a pirate tape is a reproduction of a reproduction, the sound cannot be as good as the initial version. It's like reproducing a photograph from a photograph, instead of from the original negative.

Also, the equipment and materials used by pirates are rarely the same high quality as those used by legitimate companies. Some pirate tapes are of such poor quality that they foul up tape players.

2. *Legitimate companies are hampered in their efforts to offer a wide selection of recordings, to meet the widely varying interests of the public.*

Pirates copy only the big-selling records. And these big sellers subsidize thousands of other recordings, including much of the classical and jazz output. Without the income from the big sellers that are pirated, the selection of recordings available to the public will decline. Most recordings do not appeal to the masses, but there is a need to provide recordings for those with different tastes. By pirating the big sellers, the pirates are making that harder and harder to do. The \$200 million the pirates steal each year could finance a lot of different legitimate records.

3. *It is more difficult for recording companies to invest in new artists, new musicians and song writers, as well as the classical orchestras, because of the income lost to the pirates.* Introducing new talent requires money, and that money has to come from the profitable recordings.

4. *Pirates seldom pay taxes. That means the rest of the public has to pick up the slack.* It is estimated that 75 percent of the \$200 million pirate take is not reported to the Internal Revenue Service. That's a lot of taxable income. Recent tax liens and convictions by Federal authorities support this estimate.

The artist gets no income at all from pirate recordings. His talent, his unique performance, his time, his contractual rights, all go unrewarded. Since the professional life span of the average popular artist is short, he is entitled to 100 percent of the income from his artistry.

Musicians and arrangers are heavily dependent on the income from recordings to make their livelihood. The pirates pay them nothing. Income from legitimate recordings goes to their pension and welfare funds, to pay for retired musicians and those who are out of work and sick. These funds get nothing from pirates. Moreover, the Musicians'

Union Music Performance Trust, which gets regular funds from legitimate tape and record sales, is also bypassed by the pirates. These trust funds are used to finance concerts by unemployed musicians; they are usually held in urban and in rural areas where such concerts normally would not occur.

Music composers and publishers are legally entitled to royalty income from all record and tape sales. Generally the pirates ignore these legal rights. Some pirates claim to pay these royalties in an attempt to seem legitimate. And some have been known to pay *token* amounts. But as John Clark and Bob Osterberg of the firm of Abeles, Clark & Osterberg (attorneys for the Harry Fox Agency) can attest, the publishers have been taking a beating on royalties.

Legitimate retailers and wholesalers are badly hurt by pirate record sellers. The honest businessman has trouble competing with competitors who sell cheap merchandise. Stolen goods are cheap, and pirate tapes and records are in effect stolen goods. Remember, pirates copy only the big sellers. So the legitimate retailer finds himself trying to sell his records and tapes at fair prices, while the pirate is selling his stolen goods at half the price.

Legitimate recording companies are hit where it hurts the most—right in the pocketbook. The pirates take much of the profit from the *only* recordings that really make a profit. This makes it hard for the record company to recover the funds invested in making the record successful—for recording, promoting and merchandising, and artists' and musicians' fees. Most of the recordings produced by legitimate companies lose money. A successful record producer has to have occasional hits to help pay for the losers. With piracy rising, this is becoming tougher and tougher.

The law enforcement community is also affected because piracy has become so widespread. Any criminal business that flourishes in practically every major city, that produces illegal income of \$4 million a week, contributes to the erosion of public respect for the law and its enforcers. The ease of bootlegging whiskey during prohibition contributed to a breakdown in morality. Piracy of recordings has not reached that stage yet, but it could, unless strong steps are taken to eliminate the pirates.

Until enactment of the Sound Recording Act passed by Congress and which became effective February 15, 1972, to amend the Copyright Act and extend federal protection against recording piracy, there was little protection afforded recordings other than through state criminal statutes and state unfair competition suits by record companies.

Under the 1909 Act, the only party granted protection was the composer of the sheet music, and even he was required to grant compulsory licenses to persons wishing to make similar use of the composition once he recorded the composition or allowed it to be recorded by another. The Act provided for filing notices of intent to record or allow a recording, and any manufacturer who desires to record the composition must then serve notice upon the composer and file a copy of this notice in the Copyright Office and account to the composer and pay the compulsory rate of two cents per record per composition. Of course, pirates, being clandestine, seek to avoid these payments or grossly understate the amounts due.

In a landmark decision interpreting the compulsory licensing provisions, the 9th Circuit limited the apparent right of pirates to make free use of musical compositions in pirating recordings. The case was:

Duchess Music Corp. v. Rosner, 485 F2d 1035, 173 U.S.P.Q. 278 (9th Cir. 1972), which held that a record pirate could not seek to escape liability by paying or offering to pay the compulsory licensing fee because a manufacturer relying upon section 1 (e) is entitled only to make "similar use" of the copyrighted work, not to make exact copies of the recording. The Court interpreted "similar use" to mean recording the raw musical composition, through use of his own arranger and performers. A dissenting opinion claimed that this view was against the weight of authority.

This decision, however, was followed very recently by Senior Judge Lynne of the United States District Court for the Northern District of Alabama, Northeastern Division in *Fame Publishing Co. v. S&S Distributors* (Cir. No. 72-1141), Not Yet Reported. There, the Court refused to follow contrary views expressed by a District Court in New Jersey and one in Florida.

Judge Lynne's opinion contains the following, which is worth reading:

"(4) The use made by the defendants of the plaintiff's copyrighted musical compositions is not a 'similar use' as the term is used in 17 U.S.C. § 1 (e), but is an 'identical use' of such compositions not sanctioned by § 1 (e). A compulsory licensee acquires no right to duplicate or reproduce the recordings of another. Anyone who seeks to rely on the compulsory license provision must hire some musicians, take them into a studio and make his own recording. *Duchess Music Corporation v. Stern*, 458 F.2d 1305,

rehearing and request for rehearing *en banc* denied April 26, 1972, cert. denied October 11, 1972.

(5) Defendants place reliance on certain dicta in *International Tape Manufacturers Association v. Gerstein*, 344 F. Supp. 38 (S.D. Fla. 1972), and on *Jondora Music Publishing Company, et al. v. Melody Recordings, Inc.*, 176 U.S.P.Q. 110 (D. New Jersey, 1972), following the District Court decision which *Duchess* reversed. Neither correctly states the law. It is the opinion of this Court that those cases misconstrue the purpose of compulsory licensing as correctly stated in *Duchess* and in *Shaab v. Kleindienst*, 345 F. Supp. 589 (D. D.C. 1972).

It is not lightly to be inferred that Congress, in carrying out the compulsory licensing exception to the otherwise exclusive rights of the copyright proprietor, intended thereby to sanction the type of activity in which defendants engage. The compulsory licensing system was designed to encourage various recordings of musical composition. To permit duplication of existing recordings under compulsory licensing would have the opposite effect. Rather than encourage a multiplicity of recordings it would obviously discourage the production of new recordings."

The Federal Copyright Act earlier had thus seemingly provided little, if any, protection against recording piracy for composers and none at all for performers and record manufacturers. The two-cent royalty fee required by the compulsory licensing provision has rarely been paid by pirates. And the burden of providing protection at all thus fell on the states.

State Law Protection

States have endeavored to combat recording piracy in a variety of ways. Twelve states have enacted statutes designed to eliminate recording piracy, and even Los Angeles, a center of recording activity, has enacted a municipal ordinance prohibiting unauthorized dubbing of sounds from a recording. In other states, the performers and legitimate recording producers were forced to rely upon common law remedies. These not only vary among the several states; they also often conflict. In addition, judges in less sophisticated jurisdictions are often troubled by the complexities of the concepts. While a number of theories have been used to grant protection, including right to privacy, interference with contractual relations, interference with em-

ployer-employee relations, and quantum meruit, the two most prevalent in most jurisdictions have been common law copyright and unfair competition.

Common Law Copyright Protection

Common law copyright is the doctrine applied to an author's proprietary interest in his literary or artistic creations before they are published. This doctrine gives an author exclusive control over the first publication of his work and enables him to prevent publication entirely.

To be eligible for common law copyright protection, a work need only be original in the sense that it originates with one particular author and contains some element of intellectual creativity. Although it has long been settled that common law copyright exists in sound recordings, this protection has generally been limited to the contributions of performers and has not been applied to record manufacturers, despite persuasive arguments for such application.

The right of common law copyright, though potentially indefinite in duration, is extinguished once a work is published, and the author must then rely upon statutory copyright for protection. Publication normally occurs when, by consent of the copyright owner, the original work or tangible copies of a work are "sold, leased, loaned, given away, or otherwise made available to the general public or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not occur." State courts, relying upon equity considerations, have generally held that the release of a recording is only a publication of the musical composition and not of the sound recording. Common law copyright protection for a sound recording therefore continued despite public distribution of the record. (For a fuller discussion, see 40 Geo. Wash. L. Rev. 964 (1972).)

A decision within the past month in the Southern District of New York by Judge Gurfein is most noteworthy. In that case, *Rosette v. Rainbo Record Mfg. Corp.* (66 Civ. 3864), Not Yet Reported, the Court sought to resolve the dispute whether mechanical reproduction as a recording of plaintiff's compositions constituted "publication" as distinguished from mere "performance" which would have retained her common law copyright. He rejected the view of Judge Igoe in *Shapiro, Bernstein v. Miracle Record Co.* 191 F. Supp. 473 (N.D. Ill. 1952) which held that a composer abandoned his right, if any, to a copyright by permitting his composition to be produced on phonograph records and sold some time before copyright. Instead, he followed

the view that performance of a composition through a recording does not constitute the publication of the composition itself. However, to prevent such a composer from enjoying greater benefits than one who files under the Copyright Act, he held that although it would not constitute "publication", nevertheless suits could not be maintained against infringers until the statutory copyright is obtained by the composer and Notice of Use is filed.

The major protection for recordings granted by state courts has been on the theory of unfair competition, namely, on the theory of misappropriation, following the landmark Supreme Court decision in *International News Service v. Associated Press*, 248 U.S. 215 (1918). In numerous cases, pirates have been enjoined for misappropriation under this doctrine.

In 1964, in the famous (or should I say infamous) *Sears and Compco* decisions, 376 U.S. 225 (1964) and 376 U.S. 234, the Supreme Court cast doubt upon the protection afforded performers and record manufacturers under state law.

Both of these cases involved imitation of unpatentable designs, and the Court held that the paramount federal interest in national uniformity of patent protection precluded the states, under any common law theory, from recognizing any right which conflicted with the policies and objectives of the federal patent laws. The Court recognized that its decision would not affect common law copyright in "unpublished writings", but held that a State may not, when an article is published but unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.

The pirates, of course, have sought to rely on this decision for protection from suits by record companies. The Courts, however, have generally continued to hold that the sale of a record was not a publication, and continued to follow *INS*, holding that *Sears and Compco* could be distinguished by the fact that recording piracy was not a "copying" in the *Sears-Compco* sense but actually a misappropriation of the original sounds themselves. Thus, if a manufacturer independently imitated a recording using his own arranger and a different performer, he was not subject to liability no matter how close the resemblance, but protection was granted against the actual unauthorized reproduction and sale of the original recording. Of course, an additional element has been the fact that pirates use the name of the original performer and album. Otherwise, their product would not be readily salable regardless of price.

The Sound Recording Act of 1971

After many years of struggle to achieve an omnibus, much-needed revision of the 1909 Copyright Act, which would include protection for recordings, Congress could not resolve the conflicting interests of certain industries and groups. Because of the urgency of the need for federal protection of recordings, however, special legislation to amend the Copyright Act was passed in October, 1971, granting copyright protection to recordings fixed and issued after February 15, 1972 and before January 1, 1975. The latter date was added by the House to act as a stimulus to consideration by the Senate of the omnibus Copyright Revision before that date.

An additional stimulus to passage of the 1971 legislation was the United States' participation in an international treaty giving producers of sound recordings protection against the unauthorized making, distribution or importation of duplicates. A requisite to ratification was the existence of similar domestic law.

By its terms, the Sound Recording Act took effect immediately as to rights granted to copyright owners of musical compositions but became effective four months after enactment as to the recording copyright. The four-month period was requested by the Copyright Office to enable it to prepare to handle these new types of applications. The Act specifically stated that it applied only to sound recordings fixed, published and copyrighted on and after the effective date and before January 1, 1975, and was not to be applied retroactively or construed as affecting in any way any rights with respect to sound recordings fixed before the effective date of the Act.

The Tenth Circuit thereafter construed this last provision as a refusal by Congress to preempt the field as to pre-February 15, 1972 recordings and as reserving this area for state court action. *Tape Head Co. v. RCA Corp.*, 452 F.2d 816 (1971). Just this month, here in the Southern District of New York, Judge Metzner in *Harrison v. Audiotape*, 73 Civ. 794, Not Yet Reported, followed this reasoning in remanding to the state court a case removed by the defendants on the ground of federal preemption.

Judge Metzner stated:

"There is a great deal of dispute as to whether the state courts have lost jurisdiction to entertain a suit for unfair competition where sound recordings are involved. Compare *Nimmer on Copyright*, S 35.22 at 146.15-146.16 (1972), with *Jondora Music Publishing Company v. Melody Recordings, Inc.*, 351 F. Supp. 572 (D.C.N.J. 1972).

"While it may be true that Congress preempted the field in the area of sound recordings by its recent enactment of Public Law 92-140, 85 Stat. 391, that change only applies to records and tapes 'fixed' between February 15, 1972 and January 1, 1975. We are dealing here with records which antedate 1972. As of that time Congress had not spoken in this area and the state remedy of unfair competition appears to exist. Cf. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F. 2d 711 (9th Cir. 1970)."

The pirates have not only been vigorously defending suits by record companies and music publishers but have mounted many counterattacks, some quite ingeniously.

Even before the effective date of the Sound Recording Act of 1971, an attack on its constitutionality was made in the District of Columbia in *Shaab v. Kleindienst*, 174 U.S.P.Q. 197. The Act was upheld.

Suits were commenced in Texas, California, Pennsylvania, Florida and Tennessee seeking to have the state anti-piracy laws declared unconstitutional. The suit, very recently filed, is still pending in Tennessee, but in all other states except Florida, the complaints were dismissed. In California, the decision (*TIAA v. Younger*) was by a three-judge court originally convened as a three-judge statutory court. In Florida, a visiting judge from Delaware declared the Florida statute unconstitutional. He also questioned *Duchess v. Rosner* (not there applicable) and held *Sears & Compco* applicable to unauthorized duplication of recordings. That case is on appeal.

In the interim, several tape pirates, who had been convicted under the California statute, appealed through the California courts in a case now well known as the *Goldstein* case.

Upon petitioning the Supreme Court for Certiorari, the Petition was granted, and argument was had on December 13, 1972. The thrust of the argument of the appellants was that *Sears and Compco* applied, prohibited the states from protecting sound recordings against unauthorized duplication, and that the California statute, in effect, unconstitutionally granted a permanent state copyright to producers of sound recordings.

The Supreme Court's decision will, of course, have a vital effect on the existence of the recording industry.

Despite the pendency of the *Goldstein* decision by the Supreme Court. Utah has this month enacted a similar antipiracy law, and others are in various stages of legislation in many other states. One

can well imagine the mounting tensions as this all-important decision is awaited.

After the Goldstein Decision

If, as I hope, the Supreme Court affirms in *Goldstein*, it will help immeasurably to set to rest many of the defensive arguments raised by tape pirates. Enforcement of the rights of recording companies and performing artists will be speedier, more certain and more effective even in the less sophisticated jurisdictions and courts.

Should the pirates prevail, however, disaster and chaos will strike the entire industry unless additional federal legislation covering the pre-February 15, 1972 recordings is promptly enacted. Although recent recordings are covered by the 1971 Act, many companies, both large and small, rely for their very existence on reissuance of past hits, either alone or in compilation. Anyone who watches television cannot help but be confronted with the many special offerings of "Hits of the Sixties", "Fifties", "Forties", and even the "Big Bands of the Thirties" as well as classical and mood music. We are passing into an era of nostalgia. A victory for the unauthorized duplication forces will lead to an era of record company paraplegia.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. United States of America and Territories

184. U.S. CONGRESS. HOUSE.

H.R. 696. A bill relating to the tax treatment of transfers of rights to copyrights and literary, musical, and artistic compositions. Introduced by Mr. Koch, January 3, 1973, and referred to the Committee on Ways and Means. 4 p. (93d Cong., 1st Sess.)

Identical to H.R. 15616 (91st Cong., 2d Sess.) and H.R. 843 (92d Cong., 1st Sess.), also introduced by Mr. Koch, and similar to a number of bills introduced in prior Congresses, the bill would provide for taxation, at the capital gain rate, of sums received as the result of transfer of rights in literary property, under certain conditions.

185. U.S. CONGRESS. HOUSE.

H.R. 697. A bill to modify the restrictions contained in section 170(e) of the Internal Revenue Code in the case of certain contributions of literary, musical, or artistic compositions, or similar property. Introduced by Mr. Koch, January 3, 1973, and referred to the Committee on Ways and Means. 2 p. (93d Cong., 1st Sess.)

A proposal to modify the restrictions contained in section 170(e) of the Internal Revenue Code so as to permit deductions from taxable income of the full market value, not reduced by the amount of appreciation, of contributions of literary or similar property to public institutions. Identical with H.R. 9103 and H.R. 15215, and similar to H.R. 9505, all introduced in the 92d Congress.

186. U.S. CONGRESS. HOUSE.

H.R. 3152. A bill relating to the income tax treatment of charitable contributions of copyrights, artistic compositions, or a collection of papers. Introduced by Mr. Mills of Arkansas, January 29, 1973, and referred to the Committee on Ways and Means. 2 p. (93d Cong., 1st Sess.)

Identical with H.R. 9505, also introduced by Mr. Mills in the 92d Congress (see 18 BULL. CR. SOC. 432, Item 371 (1971) and similar

to H.R. 9103 and H.R. 15215, introduced by Mr. Reid and Mr. Monagan, respectively, also in the 92d Congress.

187. U.S. CONGRESS. HOUSE.

H.R. 3483. A bill to exempt certain income of nonresident alien authors, artists, and composers from taxation. Introduced by Mr. Reid, January 31, 1973, and referred to the Committee on Ways and Means. 3 p. (93d Cong., 1st Sess.)

Identical with H.R. 15778, introduced by Mr. Reid in the 92d Congress. See 19 BULL. CR. SOC. 466, Item 326 (1972).

188. U.S. CONGRESS. HOUSE.

H.R. 4850. A bill to establish a commission to study and make recommendations on methods for compensating authors for the use of their books by libraries. Introduced by Mr. Reid, February 27, 1973, and referred to the Committee on House Administration. 7 p. (93d Cong., 1st Sess.)

This bill proposes the establishment of a commission to include the Librarian of Congress and ten other members, who would report their findings to Congress and the President within 18 months from the date of its enactment. The bill also provides, *inter alia*, that "lending royalties," if found appropriate by the commission, would be provided by the Federal Government, that the methods and procedures considered by the commission "shall not be incorporated into, and shall not affect the provisions of, the United States Copyright Act," and that the commission be authorized to evaluate the system presently in effect in Sweden and Denmark in preparing its report. See the remarks of Mr. Reid on his introducing of the bill in 119 *Cong. Rec.* E 1067 (daily ed. Feb. 27, 1973).

189. U.S. CONGRESS. HOUSE. *Reid, Ogden R.*

Compensating authors for the use of their books by libraries. *Congressional Record*, vol. 119, no. 30 (Feb. 27, 1973), p. E 1067.

Remarks by Mr. Reid on his introduction of the "lending royalties" bill, H.R. 4850. See Item 188, *supra*.

190. U.S. CONGRESS. SENATE.

S. 320. A bill to amend title II of the Social Security Act to provide that, for purposes of the provisions thereof relating to de-

ductions from benefits on account of excess earnings, there be disregarded, in certain cases, income derived from the sale of certain copyrights, literary, musical, or artistic compositions, letters or memoranda, or similar property. Introduced by Mr. Javits, January 11, 1973, and referred to the Committee on Finance. 2 p. (93d Cong., 1st Sess.)

A measure, identical with S. 961, introduced by Senator Javits in the previous Congress, and to section 143 of H.R. 1, which passed the Senate on September 5, 1972, but was lost in conference. "The Social Security Act now provides that individuals 65 years and over who are receiving royalty income attributable to copyrights or patents obtained before age 65 may exclude such income from their gross income in determining their social security entitlement." The instant bill "extends the provision to artists and composers who sell uncopyrighted works; thereby placing them on an equal basis with artists and composers receiving royalty income from copyrighted or patented works." — Statement of Senator Javits on his introduction of S. 320, 119 *Cong. Rec.* S. 446 (daily ed. Jan. 11, 1973).

191. U.S. CONGRESS. SENATE.

S. 1361. A bill for the general revision of the United States Copyright Law. Introduced by Senator John L. McClellan, chairman of the Subcommittee on Patents, Trademarks and Copyrights of the Senate Judiciary Committee. (93d Cong., 1st Sess.)

Except for technical changes relating to the effective dates of various provisions, the present bill is identical to S. 644 (92d Congress, 1st Session). That bill, other than for minor amendments, was substantially the same as the bill (S. 543) in the 91st Congress that was approved by the Subcommittee in December 1969. A similar bill (H.R. 2512, 90th Congress) was passed by the House of Representatives in April 1967.

Attached is the statement made by Senator McClellan on introducing the present bill:

S. 1361. 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.

MR. McCLELLAN. Mr. President, as chairman of the Subcommittee on Patents, Trademarks and Copyrights, I introduce, for appropriate reference, a bill for the general revision of the

copyright law, title 17 of the United States Code, and for other purposes. Title I of this legislation provides for the general revision of the copyright law, title II establishes the National Commission on New Technological Uses of Copyrighted Works, and title III provides for the protection of ornamental designs of useful articles.

Other than for necessary technical amendments relating to the effective dates of various provisions, the bill is identical to S. 644 of the 92d Congress. That bill, other than for minor amendments, is identical to the bill reported by the subcommittee in December 1969.

As is by now well known, any significant progress on general revision of the copyright law has been effectively precluded in recent years by the multifaceted cable television issue. A major section of the revision bill relates to the resolution of the copyright status of the cable television industry. Progress on the revision bill had to await the adoption by the Federal Communications Commission of a new cable television regulatory scheme. These rules became effective during 1972.

Section 111 of the legislation approved by the subcommittee contains a comprehensive resolution of the CATV question, including both regulatory and copyright matters. The subcommittee adopted such a comprehensive provision in response to the recommendations of the then Chairman of the Federal Communications Commission. When Mr. Dean Burch became Chairman of the FCC he consulted the subcommittee concerning the development of coordinated procedures by the Congress and the Commission to facilitate a resolution of the CATV issue, and to permit the orderly development of the cable industry. Under the effective leadership of Chairman Burch substantial progress has been achieved in creating a constructive cable television policy for this Nation. The regulations adopted by the Commission are generally consistent with the recommendations made by the subcommittee in section 111 of the copyright bill. It is therefore anticipated that when the subcommittee processes the revision bill, it will eliminate those provisions of a regulatory nature that were the subject of the recent FCC rulemaking proceedings.

The subcommittee determined that the public interest justified, and practical realities required, the granting in certain circumstances of a compulsory license to perform copyrighted

works. The subcommittee approved such licenses as part of the cable television, mechanical royalty, jukebox royalty, and performance royalty sections of the revision bill. With respect to each of those issues the subcommittee decided that the Congress would determine the initial royalty rate, and that a Copyright Royalty Tribunal would be established for the purpose of making periodic review and adjustment of the rates.

It has been proposed that special treatment should be accorded the cable television royalty issue. The principal justification for this position is a private agreement developed by Dr. Clay T. Whitehead, Director of the Office of Telecommunications Policy. The Whitehead agreement has been generally interpreted as seeking to eliminate the Congress from any role in determining cable television royalty rates. Even though public law places copyright affairs exclusively in the legislative branch, neither the Copyright Office of the Library of Congress, nor the House or Senate subcommittees having jurisdiction in copyright matters, were represented at Dr. Whitehead's meetings.

Another major issue in the revision legislation that requires brief comment at the present time is the photocopying of copyrighted works. There has recently been an organized letter-writing campaign by presidents of universities and others in support of a substitute photocopying section of the revision bill. Certain of these letters reflect an incomplete and somewhat distorted understanding of the decisions taken by the subcommittee. For example, Dr. Jerome B. Wiesner, president of the Massachusetts Institute of Technology, has written me that the subcommittee position:

Seems likely to result in the imposition of a fee or a delay whenever a student or scholar wants to copy part of a copyrighted work in order to facilitate his study or research.

This is grossly inaccurate. The bill approved by the subcommittee, together with the draft of the report on that legislation, has made adequate and reasonable provision for the needs of research and scholarship.

Dr. Wiesner says the payment of any copyright fees would "constitute a regressive tax on education and research to give a windfall to publishers." Authors, publishers, librarians, and

educators share many common goals. It is still to be hoped that a satisfactory accommodation can be achieved, and that the discussions currently in progress will result in the presentation of recommendations to the subcommittee with the endorsement of both the copyright and academic communities.

Prior to the suspension of action on the revision bill, the subcommittee conducted 17 days of hearings during which there was testimony by 149 witnesses. Subsequent to the hearings a number of public and staff meetings have been held on issues involved in this legislation. The subcommittee has also requested on a number of occasions supplementary written statements on specified issues.

The subcommittee has now received several requests to conduct additional hearings because of events which have transpired since the original action by the subcommittee on this legislation. My personal view is that additional hearings are unlikely to produce any significant new information. There is also the possibility that public hearings would tend to polarize positions on some issues where efforts to secure accommodations are still in progress. Despite these reservations the subcommittee will reopen the hearings to hear supplementary presentations on selected issues where there have been significant developments since the previous action of the subcommittee. The subcommittee will allocate equal time on these issues to the principal spokesmen for the various points of view. These issues include:

First. Library photocopying — sections 107 and 108 of the bill.

Second. The proposed amendment of the ad hoc committee — of educational organizations and institutions — on copyright law revision, relating to a general exemption for education purposes.

Third. The cable television royalty schedule.

Fourth. The application of the compulsory license provisions of the cable television section 111 to the carriage of sporting events by cable television systems.

Fifth. The proposed exemption for the making of copies of tapes of religious broadcasts — section 112(c) of the bill.

Since efforts to achieve a resolution of certain of these issues are continuing, it would not be feasible to conduct hearings at the present time. I shall follow the progress of the current discussions, and review the situation at a later date. When it would serve a constructive purpose, I shall schedule the hearings as soon as my other legislative responsibilities permit.

192. U.S. COPYRIGHT OFFICE.

[C.F.R.] Title 37 — Patents, Trademarks and Copyrights. Chapter II — Copyright Office, Library of Congress. Part 202 — Registration of Claims to Copyright. Catalog of Copyright Entries; Refunds; Blank Forms; Ad Interim Registrations. *Federal Register*, vol. 38, no. 21 (Feb. 1, 1973), p. 3045.

“The Regulations of the Copyright Office are amended in four miscellaneous respects: (1) To change the amounts of the subscription prices for the Catalog of Copyright Entries; (2) to change the amount of small overpayments that are not refunded unless requested; (3) to clarify the reference to blank forms not subject to copyright; and (4) to clarify the reference to English-language works subject to ad interim registration.”

2. Foreign Nations

193. BULGARIA. *Laws, statutes, etc.*

Law on copyright (as last amended on April 28, 1972). *Copyright*, vol. 8, no. 11 (Nov. 1972), pp. 223-226.

“The basic Law is dated November 16, 1951; it was amended by Decree No. 207 of July 4, 1956. WIPO translation.”

194. GERMANY (Federal Republic, 1949-) *Bundestag. Rechtsausschuss.*

Schriftlicher Bericht des Rechtsausschusses (5. Ausschuss) über den Entwurf eines Gesetzes zur Änderung des Urheberrechtsgesetzes. Bericht der Abgeordneten Frau Dr. Kuchtner and Metzger. *Blatt für Patent-, Muster- und Zeichenwesen*, vol. 74, no. 12 (Dec. 1972), pp. 359-363.

A report of a committee of the Federal Diet (Bundestag) of the German Federal Republic on the bill to amend the copyright law. See Item 195, *infra*.

195. GERMANY (Federal Republic, 1949-) — *Laws, statutes, etc.*

Gesetz zur Änderung des Urheberrechtsgesetzes vom. 10. November 1972. In *Blatt für Patent-, Muster- und Zeichenwesen*, vol. 74, no. 12 (Dec. 1972), pp. 358-359. "Bundesgesetzblatt I Nr. 120 vom. 15. November 1972, 2081 f."

Amendments, effective January 1, 1973, of sections 26, 27, 46, and 135 of the copyright law of the German Federal Republic.

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

Performers' Protection Act 1972. (Of June 29, 1972). An Act to amend the Performers' Protection Acts 1958 and 1963. *Copyright*, vol. 9, no. 2 (Feb. 1973), pp. 36-37.

An amendment increasing the fines for criminal violations of the 1958 and 1963 Acts.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

197. Conventions not administered by WIPO. *Copyright*, vol. 9, no. 1 (Jan. 1973), pp. 28-29.

Contents: European agreements, state of signatures, ratifications and accessions as of December 31, 1972; European Agreement concerning Programme Exchanges by Means of Television Films (Paris, December 15, 1958); European Agreement for the Prevention of Broadcasts Transmitted from Stations Outside National Territories (Strasbourg, January 22, 1965); European Agreement on the Protection of Television Broadcasts (Strasbourg, June 22, 1960); Protocol to the said Agreement (Strasbourg, January 22, 1965) — Universal Copyright Convention (Geneva, September 6, 1952), state of ratifications and accessions as of December 31, 1972.

198. International Copyright Union. *Copyright*, vol. 9, no. 1 (Jan. 1973), pp. 17-24.

Contents: State of the Berne Union. Table of member states as of December 31, 1972. Membership of the administrative bodies Monaco: application of the transitional provisions (five year privilege) of the Stockholm Act of the Berne Convention. Netherlands: accession to the Brussels Act (1948) of the Berne Convention (with effect from January 7, 1973). The Berne Union and international copyright in general in 1972.

199. World Intellectual Property Organization. Conventions administered by WIPO. *Copyright*, vol. 9, no. 1 (Jan. 1973), pp. 25-26.

Contents: Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms: State of ratifications and accessions as of December 31, 1972; Phonograms notification no. 5, of January 26, 1973, of Finland's ratification; Phonograms notification no. 4, of January 26, 1973, of the United Kingdom's ratification. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations: State of ratifications and accessions as of December 31, 1972.

200. World Intellectual Property Organization. The World Intellectual Property Organization in 1972. *Copyright*, vol. 9, no. 1 (Jan. 1973), pp. 2-8.

The annual report of the activities of WIPO.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY****A. DECISIONS OF U.S. COURTS**

1. Federal Court Decisions

201. *Columbia Broadcasting System, Inc., et al. v. Teleprompter Corporation*, Not Yet Reported (2d Cir., March 8, 1973) (Lumbard, J.). For decision below, see 173 USPQ 778 (S.D.N.Y., 1972), 20 BULL. CR. Soc. 46, Item 20 (1972).

Plaintiffs' appeal from judgment dismissing the complaint in action for copyright infringement. Plaintiff claimed that defendant's CATV interception and transmission of copyrighted television programs constituted infringement.

Held, affirmed in part and reversed and remanded in part.

I. "The starting point in our analysis", said the court, "must, of course, be the Supreme Court's decision in *Fortnightly Corp. v. United Artists Television, Inc.*, [392 U.S. 390 (1968), 15 BULL. CR. SOC. 316, Item 327 (1968)]. In deciding whether the Fortnightly CATV system 'performed', within the meaning of the Copyright Act, the programming that it provided to subscribers, the Court [there] applied a functional test and held that the CATV system there involved was functionally related more to the television viewer, who does not 'perform', than to the television broadcaster, who does 'perform'." [However, continued the court] "the operations of each of the CATV systems involved here were different and broader than those of the system before the Supreme Court in *Fortnightly*. . . . The question before us is whether the character of CATV is so changed [in the operation of the] cable systems here . . . that their total operation, including the reception service, under the *Fortnightly* functional test, have become functionally equivalent to those of a broadcaster, and thus these systems should be deemed to "perform" the broadcast programming that they distribute. The additional operations undertaken by these CATV systems, which appellants contend distinguish this case from *Fortnightly* and bring about this asserted metamorphosis in the character of CATV, are the following: 1) origination of programming on non-broadcast channels, and the sale of commercial time on such non-broadcast programming; 2) interconnection

with neighboring CATV systems; 3) use of microwave links in bringing broadcast programming to subscribers; and 4) the importation of distant broadcast signals from outside the area served by the CATV system. [The lower court held these factors not to legally distinguish the applicability of *Fortnightly*.]

II. The Circuit Court agreed with the lower court that program origination and ancillary advertising, system interconnection and microwave transmission as practised by these defendants did not render these CATV systems engaged in a "performance" of intercepted signals. The court said:

[*Non-Broadcast Program Origination
and Advertising*]*

- * The court noted that it was considering only "the origination of programming on channels not used for the distribution of broadcast signals and the sale of commercials on such non-broadcast channels. . . . [Thus we] do not consider, the question of what the effect would be on the *Fortnightly* doctrine if programs originated by the CATV system were used to replace selected broadcast programming received from network or independent stations that would otherwise have been distributed without alteration to subscribers on broadcast channels. Similarly, we do not have before us a CATV system that sold commercials on broadcast programming to replace the commercials sold and transmitted by the broadcast station."

Although the Supreme Court noted in *Fortnightly* that it was not dealing with a CATV system that originated non-broadcasting programming, we fail to see why a system's program origination on channels other than those on which it relays broadcast programming should alter the result in *Fortnightly*. Obviously, the system "performs" those programs that it originates for distribution to its subscribers. However, we do not see the logic in appellants' contention that this program origination serves to convert the CATV system into a "performer" of those programs that it [intercepts and] distributes to its subscribers on broadcast channels. Even though the origination service and the reception service are sold as a package to the subscribers, they remain separate and different operations, and we cannot sensibly say that the system becomes a "performer" of the broadcast programming when it offers both origination and reception services, but remains a non-performer when it offers only the latter. . . .

With regard to the sale of commercial time on non-broadcast programming, although this is another step bringing cable origination programming in competition to some extent with broadcast

programming, again, we do not agree with appellants' position that there is some sort of "spill-over" effect by which the system becomes a "performer" with regard to its reception service.

[*Interconnection*]

[Defendant's] New York CATV system has occasionally interconnected its facility with those of the two other CATV systems operating in the New York area. Appellants analogize this activity to the networking that is common among broadcast stations, and they point to this as another factor making the New York system functionally equivalent to a broadcaster. However, the only interconnection with which we are concerned occurred in two instances of sporting events that the system originated on non-broadcast channels. There was no interconnection here relating to the reception of any telecast of appellants' copyrighted programs, or indeed of any broadcast programming, received by the system and distributed to subscribers. Therefore, we are not presently in a position to evaluate what effect interconnection may have on CATV copyright liability if and when it ever reaches the point at which it is equivalent to a network of CATV systems. In light of the minimal interconnection we have before us, we must agree with the district court that [the present interconnection does not create liability].

[*Microwave Transmission*]

Appellants contend that the use of microwave [from the point of interception] in and of itself, is sufficient to make a CATV system functionally equivalent to a broadcaster and thus subject to copyright liability for all the programming it receives and distributes to its subscribers. We are unconvinced by this contention. Neither do we believe that the use of microwave makes the system a "performer" only of that programming with respect to which the microwave is used. Microwave utilizes point-to-point communication and is merely an alternative, more economical in some circumstances, to cable in transmitting a broadcast signal from one point in a CATV system to another. Hence, we see no reason to attach legal significance, in terms of copyright liability, to the decision to utilize microwave links.

III. The Circuit Court held, contrary to the decision below, that a CATV system *does* "perform": a work within the meaning of the

Copyright Act when it imports "distant signals" into a community which would otherwise be beyond their range. The court said:

The CATV system in *Fortnightly* brought television signals to viewers who could not otherwise have received them. However, these signals were already in the community and were not imported by the CATV system from another community, as is evidenced by the fact that the system received them from an antenna located in or directly adjacent to the CATV community. It was only because of topographical conditions in and around the community that residents could not receive the signals on their receivers. Thus, it was the office of the CATV system in *Fortnightly* to use its advanced antenna technology and equipment to overcome these adverse conditions and thereby to bring the signals to members of the community. The Supreme Court held that, in performing this function, the CATV system did not "perform", within the meaning of the Copyright Act the programming carried on those signals. However, in *United States v. Southwestern Cable Co.*, 392 U.S. 157 (1968), decided just a week before *Fortnightly*, the Court explicitly recognized that this was only one of two major services that CATV systems render to the communities they serve. In this regard, Mr. Justice Harlan, speaking for the Court, stated at p. 163:

CATV systems perform either or both of two functions. First, they may supplement broadcasting by facilitating satisfactory reception of local stations in adjacent areas in which such reception would not otherwise be possible; and second, they may transmit to subscribers the signals of distant stations entirely beyond the range of local antennae.

When a CATV system is performing this second function of distributing signals that are beyond the range of local antennas, we believe that, to this extent, it is functionally equivalent to a broadcaster and thus should be deemed to "perform" the programming distributed to subscribers on these imported signals. . . . The system's function in this regard is no longer merely to enhance the subscriber's ability to receive signals that are in the area; it is now acting to bring signals into the community that would not otherwise be receivable on an antenna, even a large community antenna, erected in that area.

In *Fortnightly*, the CATV system distributed the programs to an audience to which they would not otherwise have been presented. But the Court did not find this fact significant for copyright pur-

poses. The Court found that the CATV system made these programs available to this new audience by providing it with the services of an advanced antenna. It then reasoned that, since a television viewer was privileged to view whatever programs he could receive using any available antenna, a CATV system should not be deemed a "performer" for copyright purposes when it provided this antenna service as a commercial venture. When a distant signal is involved, CATV is again distributing television programming to a new audience that could not otherwise have viewed it. However, in this case, the new audience is one that would not have been able to view the programs even if there had been available in its community an advanced antenna such as that used by the CATV system. The added factor in such a case is the signal transmitting equipment, such as microwave links, that is used to bring the programs from the community where the system receives them into the community in which the new audience views them. The viewer's ability to receive the signal is no longer a product solely of improved antenna technology; rather, it results from the system's importation of the signal into the CATV community from a separate, distant community.

As a result, we no longer have a system that "no more than enhances the viewer's capacity to receive the broadcaster's signals." *Fortnightly*, p. 399. We hold that when a CATV system imports distant signals, it is no longer within the ambit of the *Fortnightly* doctrine, and there is then no reason to treat it differently from any other person who, without license, displays a copyrighted work to an audience who would not otherwise receive it. For this reason, we conclude that the CATV system is a "performer" of whatever programs from these distant signals that it distributes to its subscribers.

[The court then considered "the difficult problem of defining what is a distant signal" and concluded that "any signal capable of projecting, without relay or retransmittal, an acceptable image that a CATV system receives off-the-air during a substantial portion of time by means of an antenna erected in or adjacent to the CATV community is not a distant signal." The court then dealt further with this standard and established certain presumptions it felt should govern resolution of whether a signal is "distant" within this standard].

IV. The court concluded its opinion with the expressed hope that "Congress will in due course legislate a fuller and more flexible accom-

modation of competing copyright, anti-trust and communications policy considerations, consistent with the challenges of modern CATV technology.”

202. *Alberto-Culver Company v. Andrea Dumon, Inc.*, 175 USPQ 194 (7th Cir., August 29, 1972). See also, 160 USPQ 822 (D. Illinois, 1969), 17 BULL. CR. SOC. 61, Item 16 (1969).

Cross appeals from judgment for plaintiff in part and defendant in part in action for copyright and trademark infringement and unfair competition and counterclaims for monopolization and abuse of process. The lower court sustained a part of plaintiff's copyright claim, but dismissed its trademark and unfair competition claims and the counterclaims. *Held*, judgment for plaintiff for copyright infringement reversed. (The copyright claim only is discussed herein).

The parties marketed competing feminine hygiene deodorant sprays, and plaintiff charged defendant with infringement of copyright in its product label. The lower court held, *inter alia*, that the phrase “is the most personal sort of deodorant” appearing on plaintiff's label was, as opposed to other “descriptive language” on its label, validly subject of copyright and infringed by defendant's label statement that its product is “the deodorant of the most personal kind”. The Circuit Court approved the lower court's statement that “the textual part of a label generally requires different treatment than the pictorial aspects [since] where the text is merely descriptive matter that does not aid or augment the pictorial illustration, it is not subject to copyright.” However, the court concluded that this same standard (and other authorities relied on by the lower court) mandated the conclusion that plaintiff's phrase in question was not subject to copyright, because:

“First, to the extent that the phrase was connected with the artwork by different typography than the rest of the text, it is not protected because . . . mere distinctiveness in typographic ornamentation will not ordinarily qualify otherwise non-copyrightable material for copyright protection.

Second, this portion of the text is merely a ‘short phrase or expression’ which hardly qualifies as an ‘appreciable amount of original text.’

Third, and perhaps most important, the phrase is just as descriptive as the rest of the text. The ingenuity and creativity reflected in the development of the product itself does not give appropriate descriptive language, such as ‘personal sort of deo-

dorant,' any separate value as a composition or as an extension of a work of art. We conclude that this ordinary phrase is not subject to copyright protection."

202a. *Donald v. Uarco Business Forms*, 176 USPQ 513 (8th Cir., January 30, 1973) (*Per Curiam*). For Decision below, see 175 USPQ 181, 344 F.Supp. 338 (D. Ark., 1972), 20 BULL. CR. SOC. 122, Item 77 (1972).

Appeal from order granting defendant's motion for judgment notwithstanding the verdict in action for copyright infringement. Plaintiff claimed copyright in a certain chattel mortgage agreement form for use by television service repairmen. The trial court held that plaintiff's form lacked the requisite originality for copyright.

Held, affirmed.

"[The record shows that] appellant had knowledge of, and drew upon, legal forms which already existed in the public domain when he drafted his form. Most of the form is phrased in standard legal language. The appellant's testimony leads us to the conclusion that he had seen similar language many times before . . . [Although] appellant argues that he is entitled to a copyright because this is the first time such language has been used in a *service* contract even though the language has previously been used in *sales* contracts which were already existing in the public domain, [w]e do not believe that this difference makes the appellant's work more than a trivial variation from that already in the public domain. Therefore, the appellant is not entitled to a copyright on his 'Agreement'."

203. *Rosette v. Rainbo Record Manufacturing Corporation, et al.*, Not Yet Reported (S.D.N.Y., February 27, 1973) (Gurfein, J.)

Action for infringement of common law and statutory copyrights by unauthorized recording of musical compositions.

Held, judgment for plaintiff in part.

Defendants argued that various of plaintiff's compositions had been dedicated to the public domain by publication in the form of phonograph recordings (prior to registering the compositions for statutory copyright in unpublished form). The court extensively discussed this "important issue which has intrigued . . . law professors" and concluded that the distribution of recordings is *not* a "publication" of recorded musical compositions so as to divest common law copyright therein.

However, the court held that the policy and scheme of the Federal copyright law required that no recovery be allowed for infringement* of recorded musical compositions until after (and only for infringements occurring after) statutory copyright is secured therein and a notice of use filed. The court said, in part:

. . . so long as [a] work is unpublished the author retains common law rights in the composition, including the sole right of its performance. On the other hand, if the author chooses to publish the work without meeting the requirements for statutory copyright he will lose his common law protection. . . .

Here the plaintiff did not publish some of her musical compositions as sheet music for sale to the public. She kept some of her musical manuscript in unpublished form but she, nevertheless, authorized the mechanical reproduction of such unpublished compositions on phonograph records. If she had lent an original manuscript to an orchestra for performance without publishing it as sheet music she would have retained her common law rights. . . . If she had published her composition as sheet music without getting statutory copyright protection she would have lost her rights in its performance. The question is whether the mechanical reproduction on a phonograph record of an otherwise *unpublished* composition itself constitutes publication so as to divest the author of common law rights.

The plaintiff contends that it is not publication but *performance* of an unpublished work. The defendants argue that the phonograph record is a copy of the composition and is also a publication because it is perpetuated and is not ephemeral like a stage performance.

On this modern version of a scholastic dialogue the law professors enjoy the disputation, but the judicial process must resolve the dispute one way or the other. . . .

The familiar tools of statutory construction, of precedent and its *ratio decidendi*, of the weight to be accorded *stare decisis* and of the vaguer notions of public interest in the face of claims to monopolize, all come into play. On the one hand there is distaste for the perpetual monopoly that sustaining common law rights unlimited in time involves. On the other, there is a strong reaction that precedent should be reliable rather than a trap for the un-

* See fn. below.

wary, particularly in a technical field where the lawyers, assumed to be learned, guide the hand of the untutored artist.

It may be noted, incidentally, that the Universal Copyright Convention (UCC) to which the United States is a party has clearly eliminated mechanical production on phonograph records as "publication." The Convention in Article VI defines publication as "the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived." Curiously the definition was reached not so much on a theoretical basis as on the belief shared by the conference "that according to the United States law the issuance of phonograph records does not amount to publication, and that an unpublished work remains unpublished. . . ." It was believed that a contrary provision in the Convention would require an amendment of the United States Copyright Law unlikely to be accepted by Congress.

And the practicing copyright bar has voiced its objection to relinquishing what they consider *stare decisis* so as to cast into the public domain thousands of works of popular and classical music, performances of which have been distributed on phonograph records without statutory copyright in reliance upon the rule of law that a distribution of phonograph records is not a publication.

The distinction between sheet music, a literal copy of the original manuscript, and a mechanical reproduction of a musical composition originally came before the Supreme Court in the famous case of *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908). There the Court held that a music roll for mechanical pianos did not constitute a "copy" of the recorded music and hence was not an infringement of it. From this result it was logical to conclude that if the infringing music roll was not a copy of the composition so as to cast its maker in liability, the creation of a music roll by the author himself would not make it a "copy" of his work and hence not a publication of it. The *White-Smith* result can be also rationalized as an opinion that mechanical reproduction is performance, like live performance, and is, therefore, not publication. . . .

The Copyright Act was completed [sic] revised in 1909.

The impact of the *White-Smith* case was limited by the statutory provision in the 1909 Act that . . . [provided] copyright protection . . . for *unpublished* musical compositions. And the sale of records of a musical composition registered [as unpublished works]

under Section 11 of the Copyright Act will not terminate its copyright protection.

But the Court of Appeals has not yet had occasion to consider the protection of unpublished musical compositions which rely on *common law rights* against unauthorized phonograph records. Section 2 of the Copyright Act recognizes the continued validity of common law rights in an "unpublished work" and confirms the right of an author to prevent "the use of such unpublished work."

The 1909 Act was a comprehensive revision of the Copyright Law. As we have seen, the Supreme Court in *White-Smith* had previously ruled that the recordation of a musical composition by mechanical means did not make the record (piano roll) a "copy" of the composition. The drafters of the 1909 Act stated that "it is not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves, but only to give the composer or copyright proprietor the control, in accordance with the provision of the bill, of the manufacture and use of such devices." House Reports, 60th Cong. 2d Sess. Vol. 1 (1909), p. 9. The provisions of the bill referred to included the now familiar compulsory licensing provision whereunder the payment of a royalty of two cents per record anyone may use the copyrighted composition (§1(e)). The assumption remained, however, that the musical composition itself was a thing apart from its performance on a phonograph record.

In this light the Act provided for two different protections for the unpublished musical composition itself. First, a new statutory method of copyright was provided in Section 11 for *unpublished* works and second, common law rights were preserved in *unpublished* works. It has been held, however, that an author is not compelled to resort to a Section 11 copyright to avoid forfeiture of his common law rights. *Nutt v. National Institute Inc. for the Imp. of Memory*, 31 F.2d 236 (2 Cir. 1929).

While that is true of the author of an unpublished manuscript it does not follow that it is also necessarily true of a composer of an unpublished composition who has chosen to make and sell phonograph records for which special provision has been made in the Copyright Act.

The Copyright Act does not define publication and it is true that generally a performance of an unpublished musical manuscript is not a publication. . . . *supra*. This accords with the expressed view of the Copyright Bar and the music industry that making a

record of an unpublished composition is not a "publication." Their reliance is on accepted doctrines of copyright law.

It is small wonder then that a brief opinion by Judge Igoe in *Shapiro, Bernstein & Co. v. Miracle Record Co.*, 91 F.Supp. 473 (N.D. Ill. 1950) raised the hackles of the Copyright Bar. Judge Igoe, by way of dictum, expressed the view that the composer "abandoned his right, if any, to a copyright by permitting his composition to be produced on phonograph records and sold some time before copyright". . . .

In *Mills Music v. Cromwell Music*, 126 F.Supp. 54, 69-70 (S.D. N.Y. 1954) Judge Leibell [*in dictum*] expressed the view that "[t]he manufacture and sale of phonograph records in this country by a person or corporation duly authorized by [the copyright owner] would have constituted a publication of his composition."

In *McIntyre v. Double A-Music Corporation*, 166 F.Supp. 681, 683 (S.D.Cal. 1958) Judge Solomon [*in dictum*] expressed the view that the sale to the general public of hundreds of thousands of phonograph records of his arrangement "was a general publication of plaintiff's arrangement and destroyed whatever rights he had in the arrangement under the common law of copyrights". . . .

None of the distinguished judges cited made any reference to *White-Smith* or the impact of the 1909 Act on its doctrine.

In this District, Judge Cooper has expressed a contrary view, also by way of dictum, that "a phonograph record is not a copy of a musical composition . . . nor is the sale of the record 'a publication' of the underlying composition." *Nom Music Inc. v. Kaslin*, 227 F.Supp. 922, 926 (S.D.N.Y. 1964), *aff'd on other grounds*, 343 F.2d 198 (2 Cir. 1965).

This leaves us with the conviction that higher judicial authority has not passed directly on the point. It has remained since 1909 a bone of contention between the Copyright Bar and some of the law professors.

Section 2 of the Copyright Act was reenacted at the same time that phonograph recordings were themselves a current subject of debate. It would have been simple to carve out an exception to the protection of unpublished musical compositions for the production and sale of phonograph records otherwise covered by Section 1 and Section 11. This was not done.

The questions nevertheless confront us (1) whether the 1909 Act overruled *White-Smith* and made a phonograph record a "copy" or a "publication," and (2) whether the special statutory scheme in-

volving phonograph records is a gloss on the scope of Section 2 of the Act.

With regard to the first question it is difficult to rationalize accepted principles of copyright law to make performance of a composition a publication of the composition itself. The argument that the permanency of the recording makes it more than a mere performance is an argument that the Congress did not accept or it could easily have made such an enactment. And the Copyright Office held that the phonograph record itself may not be registered under Section 11. C.F.R. 202.8(b).

The difficult second question still remains. The common law right in the unpublished composition makes no requirement of notice of use of the musical composition on phonograph records by the composer or the copyright owner as is required under Section 1(e) where a statutory copyright has been obtained. This puts the statutory copyright owner at an apparent disadvantage, for if the statutory copyright owner fails to file his notice in the Copyright Office "any failure to file such notice shall be a complete defense to any suit, action or proceeding for any infringement of such copyright." * (§1(e)) Can the States by virtue of the common law constitutionally impose a lesser requirement when copyright has been vested by the Constitution in the national Government? Must the impediments to the free exercise of the *statutory* copyright be held to limit the exploitation of the common law copyright to the same degree? A statutory construction that avoids a constitutional problem is desirable. [The Court then discussed the Supreme Court decisions in *Sears* and *Compco*.]

. . . .

The failure of a copyright owner to file his notice of use in effect puts his composition into the public domain — at least from the time of use to the date of filing. *Norbay Music, Inc. v. King Records, Inc.*, 290 F.2d 617 (2 Cir. 1961) During such time it would seem that granting protective rights under State law would be inconsistent with the Congressional policy of requiring notice by copyright owners to would-be users so that they in turn may protect themselves under the two-cent royalty provision by paying the royalty to the copyright owner (§§1(e)1 101(e)).

* It has been held that despite the language of §1(e), the failure to file a notice of use is not a defense to actions for infringement of rights other than recording rights. See Nimmer, Copyright §108.41. [Ed.]

To avoid the constitutional problem I think that the exception of Section 2 of the Copyright Law must be limited to exclude the sale of phonograph records from the protection given to the owner of an unpublished manuscript to the extent that the common law right exceeds the rights of statutory copyright owners. The conditions for use of the musical composition on phonograph records are so well defined in the comprehensive Copyright Act of 1909 that it is unlikely that the Congress intended that contradictory principles of State law should survive.

This leads to the conclusion that the use of phonograph records without compliance with the Copyright Act bars claims for infringement not because the record is a "copy" or a "publication," but because any other interpretation leads to conflict with the Federal statutory scheme. Section 2 would still be read as applying to unpublished works protectible at common law including unpublished musical compositions where no mechanical recordings have been made.

On the other hand the failure to file notice of use does not bar the copyright owner forever, *Norbay, supra*. By analogy then I hold that the sale of phonograph records is not a divestment of common law rights by publication but that it does inhibit suit against infringers until the statutory copyright is obtained and the notice of use is filed. Thereafter, applying the rule of *Norbay*, the statutory copyright owner may sue for subsequent infringement. This provides an accommodation to basic copyright *stare decisis* in preventing the loss of rights in the "unpublished" composition by an unintended dedication to the public while preserving the supremacy of the Federal copyright law and effecting its policy.

204. *The Robert Stigwood Group Limited, et al. v. O'Reilly, et al.*, 175 U.S.P.Q. 403 (D. Conn., July 25, 1972) (Zampano, J.)

Motion for preliminary injunction against infringement of copyright by unauthorized performances of the "rock opera" Jesus Christ Superstar.

Held, motion granted.

1. The court first discussed the applicability of Section 104 of the Copyright Act to defendant's performances, stating:

Section 104 has been characterized by scholars as 'meaningless', Nimmer, *supra*, §107.33, "curious", Shafter, *Musical Copyright*, pp. 287-288 (1939), and having "inapt phraseology", Weil, *American Copyright Law*, p. 497 (1917). It provides in effect an exemption to

the copyright laws when certain religious and secular works are performed by public schools, church choirs, or vocal societies, if the performances are given for charitable or educational purposes and not for profit. . . .

The only judicial interpretation of the exemption clause is in *John Church Co. v. Hilliard Hotel Co.*, 221 F. 229, 230 (2 Cir. 1915), rev'd on other grounds, 242 U.S. 591 (1917), wherein the court stated by way of dictum:

We think it was to permit certain high-class religious and educational compositions to be performed at public concerts where an admission fee is charged, provided the proceeds are applied to a charitable or educational purpose.

. . .

The Court is of the opinion that the provision has a meaning and a purpose. A court should be most reluctant to hold that a Congressional enactment is "meaningless." The legislative history, meager as it is, indicates that Congress intended to carve out an exception to § 1(d), as well as § (e), possibly along the lines suggested by the Second Circuit in the Church case. . . . Congress probably had in mind that school children, church choirs, and small vocal groups, banded together as a "society", should not be restricted by civil and criminal penalties, that the benefits derived from such works should be available to them for educational and religious purposes, and that it would be highly unlikely that their performances of the works would seriously diminish attendance at professional productions of the same works.

Thus the Court must consider whether the defendants, on the present state of the record, sustained their burden of proof with respect to the requirements relevant to this case as set forth in § 104 that: 1) they are a church choir or vocal society who 2) perform a work such as an oratorio, which 3) was rented or obtained from a public library, public school, church choir, school choir, or vocal society, for 4) charitable or educational purposes and not for profit.

Church Choir or Vocal Society

. . .

. . . The Court is of the firm opinion that . . . [the performing "company" including defendants] certainly cannot be so classified.

The Company is not a church choir. The performances of Jesus Christ Superstar are not given in churches nor are they part of any church services; rather they are highly professional productions,

presented in school auditoriums and theatres across the country. Fifty performances to date grossed \$300,000; the Company's net income has been approximately \$220,000. The mere fact that the many professional performers are under the direction of a few priests cannot turn a professional touring company into a church choir.

Nor is the Company a vocal society. As the Court reads the meaning of this phrase in the statute, in the light of the apparent intent of Congress, it connotes an enduring, cooperating and unified group of singers, with common aims and ends, periodically meeting together because of a community of interests in the songs they sing. The defendants failed to produce a scintilla of evidence that [all] . . . the members of the Company share a clearly marked identity as a unit distinguished by similar beliefs, particular concerns, and the same interests. From the present record, it appears that the lay performers are professionals selected for their singing and musical abilities, and not because of homogeneous beliefs, charitable motives or religious affiliation.

Therefore, the Court finds that the defendants, doing business as and in association with the International Rock Opera Company, are neither a church choir nor a vocal society, within the meaning of those terms as used in § 104.

Oratorio

Much has been presented by the parties concerning whether the defendants' production of Jesus Christ Superstar is an oratorio or an opera. The major premise for the argument, according to the parties, is that an oratorio is within the scope of § 104 while an opera is not. The Court disagrees with this reasoning. The phraseology of the pertinent portion of the statute contains the general words "such as" which precede the particular classes of works set forth. Therefore, since the similarities between an oratorio and an opera are significant, in the context of the present subject matter . . . the application of the principle ejusdem generis is proper and, therefore, § 104 includes within its boundaries an opera or a rock opera.

. . .

Source of the Material

The Court agrees with the defendants that a group that otherwise qualifies for a statutory exemption under the Act may obtain the lyrics and music for the work from the sources specified in § 104

in addition to any other available source. It is difficult to conceive that Congress would grant a broad exemption to a qualified group on the one hand, and then, at the same time, unduly restrict them on such a highly technical point.

Charitable and Educational Purposes

. . .

In the light of the Court's ruling that the Company is neither a church choir nor a vocal society, there is no need to resolve this issue.

. . .

The plaintiffs . . . contend that the defendants' performances were not given for charitable or educational purposes and not for profit, within the meaning of § 104. The factual record necessary to resolve this issue is largely undeveloped and, therefore, final determination of the question must await the trial.

2. The court held that enforcement of the Copyright Act against defendants' performances did not interfere with defendants' Constitutional rights of free speech and free exercise of religion. The court said, in part:

Were the First Amendment to be applied literally, our statutes pertaining to perjury, obscenity, mail fraud, among many others, would constitutionally fall. While the Court must be alert to protect the defendants' right to a free exercise of their religious beliefs, it must recognize that the "free exercise" does not include the wholesale appropriation of another's literary, artistic and musical works. In the balance must be weighed the constitutional right of authors to have "the exclusive right" to their "writings," U.S. Const. art. I, § 8, cl. 8, and the need to protect those of ability who justifiably seek compensation for their ingenuity and labor. It is settled law that Congress may confer copyright protection to writers and publishers to secure their monetary reward and to afford encouragement for the production of literary or artistic works. . . .

The plaintiffs do not possess copyrights to the Biblical narration, characters, or sequence of events of the last seven days of Christ. They do, however, have the right to their original musical *expression* of those last days of Christ.

. . . the defendants' argument that their presentation of the rock opera is a form of "protest" which portrays the "true" events

in the life of Christ is not persuasive. The defendants' performance is almost identical to the plaintiffs' production While the defendants, from a theological point of view, sincerely feel [certain] changes are material variations, the Court is satisfied that, from a realistic, practical standpoint, they are really minor variations. The defendants have copied in wholesale fashion the lyrics and score, the sequence of songs, and the overall pattern of plaintiffs' rock opera; there is outright plagiarism here, pure and simple. . . . [Defendants] are perfectly free to compose and sing their own musical interpretation of the events of the last seven days of Christ; however, insofar as they chose "to avoid the expenditure of time and skill necessary to evolve their own expressions, and instead copied the plaintiffs' expression, there can be no first amendment justification for such copying." Nimmer, Copyright And The First Amendment, 17 U.C.L.A. L. Rev. 1180, 1203 (1970).

3. The court held that defendants' "almost total copying of plaintiffs' work" could certainly not be considered a fair use. Although defendants argued that their presentation of plaintiffs' work portrayed a more scriptural depiction of Jesus' life and death, the court noted that "a careful review of the pertinent authorities discloses no suggestion that the doctrine of fair use protects a defendant who copies practically verbatim the plaintiffs' work, but adds a few variations in order to make the plaintiffs' production a 'better' one."

205. *Fame Publishing Co., Inc. v. S & S Distributors, Inc., et al.*, 177 USPQ 358 (D. Alabama, February 6, 1973).

Motion for preliminary injunction in action for infringement of recording rights in musical compositions. Defendants manufactured and sold duplicates of plaintiff's compositions as previously recorded, and invoked the compulsory license provision of section 1(e) to sanction their activities. *Held*, motion granted. The court concluded that unauthorized duplicators — so-called tape and record "pirates" — could not rely on the compulsory license since their activities comprise not a "similar" use of previously recorded compositions as specified by the Copyright Act, but an "identical use" outside the ambit of the compulsory license. The court noted its agreement with the same holding in *Duchess Music Corporation v. Stern*, 458 F.2d 1305 (9th Cir., 1972), 20 BULL. CR. SOC. 116, Item 74 (1972) and considered that the recent contrary decision in *Jondora Music Publishing Co. v. Melody Recordings, Inc.*, 176 USPQ 110, 20 BULL. CR. SOC. 187, Item 137, was incorrect. The court said:

A compulsory licensee acquires no right to duplicate or reproduce the recordings of another. Anyone who seeks to rely on the compulsory license premium must hire some musicians, take them into a studio and make his own recording It is not lightly to be inferred that Congress, in carving out the compulsory licensing exception to the otherwise exclusive rights of the copyright proprietor, intended thereby to sanction the type of activity in which defendants engage. The compulsory licensing system was designed to encourage various recordings of musical composition. To permit duplication of existing recordings under compulsory licensing would have the opposite effect. Rather than encourage a multiplicity of recordings it would obviously discourage the production of new recordings.

[Earlier in its opinion the court stated that: "During the past several years, northern Alabama has become an important center of recording and publishing of popular musical compositions. Many individuals are engaged in this fast-growing Alabama industry (in the Muscle Shoals area). . . . The stability of this industry in the Muscle Shoals area has been threatened by the intrusion of parties (described in the trade as 'pirates' or 'bootleggers') who systematically appropriate the currently most popular recordings and reproduce and market them in the form of tape cartridges . . . at prices substantially below the prices which the original manufacturers must charge for their recordings. They are in a position to do so because they do not incur the substantial costs of producing recordings with singers, orchestras and other essentials".]

206. *Prather v. Camerarts Publishing Co., Inc., et al.*, 176 USPQ 68 (D. Ill., April 19, 1972) (Campbell, J.)

Action for infringement of copyright in several novels authored by plaintiff. Defendants are the publisher of the allegedly infringing works, one of its distributors, and certain of their officers.

Held, judgment for plaintiff.

1. The court found that numerous of the accused books "contained word for word copying" from numerous of plaintiff's books. Although defendants argued that the copying amounted to *de minimus* appropriation of "insubstantial bit[s] here and there" the court concluded that "while in some instances the plagiarism was limited, the general course was one of flagrant violation of [plaintiff's] copyrights."

2. The court held that "the statute of limitations in copyright cases runs from the last infringing act" and dismissed a limitations defense for all but two of plaintiff's works. (The court noted that certain acts of the distributor within the limitations period bound defendant publisher since the former acted only as an agent for the latter, taking books on consignment with full right of return.)

3. The court held that "in this case, where neither the extent if any of plaintiff's injury nor the amount of defendants' profits can be ascertained with any degree of reasonable certainty, the statutory 'in lieu of' measure of damages should be applied."

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

207. Infringement Liability. Annotation on 14 ALR Fed 825 [1973] pp. 825-844.

Annotation on liability as "vicarious" or "contributory" infringer under the Federal Copyright Act.

208. BUSH, GEORGE P., *ed.* Technology and copyright: annotated bibliography and source materials. Foreword by Lowell H. Hattery. Mt. Airy, Md., Lomond Systems, Inc., 1972. 454 p.

"The objective of this book is to present selected references and resource materials in the narrow field of the impact of technology upon copyright, with special attention to the revision process now in progress." The bibliography is divided into the following eleven topics: A. Technology. B. Computers. C. Systems. D. Reprography. E. CATV-TV. F. Microforms. G. Fair Use. H. Library. I. Education. J. Legislation/Legal. K. International.

209. CHOATE, ROBERT A. Cases and materials on patent law, also including trade secrets, copyrights, trademarks. Assisted by William H. Francis. St. Paul, West Pub. Co., 1973. 1060 p. (American case-book series).

"Copyrights and trademarks are treated only as they affect the every day practice of a patent attorney and also to give some of the flavor of these fascinating branches of the law which can become specialties in themselves."

210. McCARTHY, J. THOMAS. Trademarks and unfair competition. Rochester, N.Y., Lawyers Co-operative Pub. Co., 1973. 2 v. (Commercial law library).

Includes such subjects as trademarks compared to patents and copyrights, product and container shapes, simulation of trade dress and packaging as unfair competition, literary titles, artistic rights, and the misappropriation doctrine.

211. SEIDEN, MARTIN H. Cable television U.S.A.; an analysis of Government policy. New York, Praeger Publishers, 1972. 252 p. (Praeger special studies in U.S. economic, social, and political issues).

"[A]n analysis and detailed description of how the Federal Communications Commission (FCC) has altered the concept of governmental regulation by involving itself unnecessarily in the innermost workings of a minor part of the communications industry."

2. Foreign Publications

1. In English

212. CARTER-RUCK, PETER F. Libel and slander. England, Faber & Faber [November 1972].

"A comprehensive work on libel and slander, sufficient to meet the needs of all whose livelihood depends upon the printed word." With a foreword by Colin Duncan, Q.C.

213. TAUBMAN, JOSEPH. Performing arts management and law. Introd. by Jed Harris. New York, Law-Arts Publishers, 1972. 2 v. (1417 p.).

The first two volumes of a treatise on performing arts management and law, "wherein copyright is a major component," and both current law and proposed copyright revision are considered. "The text has been divided into three parts: Part I, Scope; Part II, Arts Market Place, Copyright and Contract (comprising together Volume 1 of the text), and Part III, Torts and Crimes, together with appendices, bibliography, table of cases and subject index (comprising Volume 2 of the text). Additional parts will be added in the future as the preparation of further textual material progresses."

2. In German

214. GRÜNINGER, RUDOLF. Die Oper im Urheberrecht. Bern, Herbert Lang; Frankfurt/M., Peter Lang, 1971. 124 p. (Europäische Hochschulschriften. Reihe 2: Rechtswissenschaft, Bd. 47). Originally presented as the author's thesis, Basel.

A comparative study of copyright protection of operatic works, including such subjects as the opera as a collective work, performing rights, and unauthorized reprints.

215. REINSHAGEN, URS M. Satellitensendungen und Urheberrecht. Ein Beitrag zur rechtlichen Problematik von Weltraumübertragungen. Zürich, Schulthess Polygraphischer Verlag, 1971. 125 p. (Zürcher Beiträge zur Rechtswissenschaft, n. F., Heft 381). Originally presented as the author's thesis, Zürich.

A thesis dealing with the copyright problems posed by the geographically unrestricted transmission of radio and television broadcasts through the intermediary of communications satellites.

B. LAW REVIEW ARTICLES

1. United States

216. BREYER, STEPHEN. Copyright: a rejoinder. *UCLA Law Review*, vol. 20, no. 1 (Oct. 1972), pp. 75-83.

An answer to Mr. Barry W. Tyerman's criticisms of the writer's study of copyright law, published under the title "The Uneasy Case for Copyright" in 84 HARV. L. REV. 281 (1970). The Tyerman criticisms were first published under the title "The Economic Rationale for Copyright Protection for Published Books: a reply to Professor Breyer" in 18 U.C.L.A. L. REV. 110 (1971), and reprinted in 19 BULL. CR. SOC. 99, Item 57 (1971).

2. Foreign

1. In English

217. Commentary on the draft Convention against the unauthorized distribution of programme-carrying signals transmitted by satellites. *Copyright*, vol. 9, no. 1 (Jan. 1973), pp. 9-16.

"This commentary has been prepared by the Secretariat of Unesco and the International Bureau of WIPO in accordance with paragraph (i) of the resolution adopted by the second Committee of governmental experts (Paris, May 9 to 17, 1972)."

218. KUROKAWA, JIRO. Enactment of the cable television broadcasting law in Japan. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 5 (Sept. 1972), pp. 47-50.

An outline of "the process of enactment of the law, its contents and significance."

219. MASOUYE, CLAUDE. The gestation of a new international convention regarding space satellites. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 5 (Sept. 1972), pp. 51-62.

An introductory survey of the events leading to the preparation of the "Draft Convention against the Unauthorized Distribution of Programme-Carrying signals Transmitted by Satellites" and an examination of the substance of the draft. The text of the draft convention is appended.

220. MENTHA, BENIGNE. Satellites in the service of copyright. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 5 (Sept. 1972), pp. 63-64.

A review of Dr. Urs Reinshagen's thesis from Zurich, entitled *Satellitensendungen und Urheberrecht*. (Satellite broadcasts and copyright), published by Schulthess Polygraphischer Verlag, Zurich 1971. See Item 215, *supra*.

221. NATIONAL COUNCIL FOR EDUCATIONAL TECHNOLOGY. Copyright and education. Working paper no. 8. London, Councils and Education Press Ltd. [1972] 91 p.

A guide, prepared by the NCET Working Group on Rights, to the use of copyright material in educational institutions.

222. NAWROCKI, BOLESŁAW. Some problems raised by the publication abroad of scientific works by Polish authors. *Copyright*, vol. 9, no. 2 (Feb. 1973), pp. 38-45.

An examination of the following problems: (1) publication abroad of a scientific work which has not been published for the first time on the territory of the Polish People's Republic; (2) reproduction abroad of a scientific work published for the first time on the territory of the Polish People's Republic; (3) certain financial aspects of the exploitation abroad of the copyright in a scientific work by a Polish author.

223. OLSSON, HARRY R., JR. Cable television—District Court decision in 'CBS v. Teleprompter.' *EBU Review: Programmes, Administration, Law*, vol. 23, no. 5 (Sept. 1972), pp. 45-46.

The general attorney of the plaintiff comments on the decision in *Columbia Broadcasting System, Inc. v. Teleprompter Corp.*,

173 USPQ 778, 20 BULL. CR. SOC. 46, Item 20 (S.D.N.Y. 1972), and indicates that "CBS disagrees with every aspect of the decision," and that it has appealed the decision to the United States Court of Appeals for the Second Circuit.

224. RINGER, BARBARA. Recent cable television developments in the United States involving copyright. *EBU Review: Programmes, Administration, Law*, vol. 23, no. 5 (Sept. 1972), pp. 36-44.

"[A]n oversimplified chronological review of some of the major events since 1968," with a rather pessimistic prognosis of the chances for enactment of copyright legislation with regard to cable television in the near future.

2. In French, English & Spanish

225. FRANCON, ANDRE. Les droits sur les films en droit international privé. *Revue Internationale du Droit d'Auteur*, no. 74 (Oct. 1972), pp. 2-45.

A survey of the problems of international private law posed by films in which reference is made "to both French law and the Berne Convention in studying first the system of authors' rights in a cinematographic work . . . and thereafter the system of assignments of authors' rights in a cinematographic work."

226. LIMPERG, TH. La protection juridique des lettres et autres caractères typographiques. *Revue Internationale du Droit d'Auteur*, no. 74 (Oct. 1972), pp. 86-119.

A commentary on and analysis of the draft "Agreement for the protection of type faces and their international deposit," revised by the Committee of Experts for the Study of the Protection of Type Faces at its sixth meeting, March 13-17, 1972. The draft is to be submitted at a Diplomatic Conference which will take place in Vienna from May 7 to June 2, 1973.

227. ULMER, EUGEN. La protection par le droit d'auteur des oeuvres scientifiques en général et des programmes d'ordinateur en particulier. *Revue Internationale du Droit d'Auteur*, no. 74 (Oct. 1972), pp. 46-85.

The English translation was first published in 2 *IIC* 56 (1971) under the title, "Copyright protection of scientific works with

special reference to computer programs." See 19 BULL. CR. SOC. 96, Item 48 (1971).

3. In German

228. DORFFELDT, SIEGFRIED. Urheberrechtliche Fragen im Bereich der öffentlichen Bibliotheken. Berlin, Deutscher Büchereiverband Arbeitsstelle für das Büchereiwesen, 1972. 37 p. (Bibliotheksdienst, Beiheft 72).

A legal opinion as to the permissible uses of copyright-protected works, without the consent of the authors, by public libraries and their patrons in the German Federal Republic.

229. FROTZ, GERHARD. Zur Reform der Vervielfältigung zum eigenen Gebrauch. *Osterreichische Blätter für Gewerblichen Rechtsschutz und Urheberrecht*, vol. 21, no. 5 (Sept.-Oct. 1972), pp. 105-112.

A discussion of the question whether the existing Austrian copyright law offers satisfactory protection to authors and performers in the case of all forms of reproduction for private use, in the light of technological advances in copying processes, or whether a revision of the law is indicated. Several suggestions for revisions are offered.

230. GAMM, OTTO FRIEDRICH, FREIHERR VON. Die Pariser Revisionen der Revidierten Berner Übereinkunft und des Welturheberrechtsabkommens. *Neue Juristische Wochenschrift*, vol. 25, no. 46 (Nov. 14, 1972), pp. 2065-2067.

A survey of the 1971 Paris revisions of the Berne and Universal Copyright Conventions with reference to the changes made to accommodate the needs of developing countries, preceded by a brief review of the developments leading to the revisions.

231. RUMPHORST, WERNER. Comment on the "School Book" decision. *IIC*, vol. 3, no. 3 (1972), pp. 401-406.

A note on the decision of the German Federal Constitutional Court declaring Sec. 45, Copyright Act unconstitutional to the extent that it permits the incorporation of protected works into collections intended for religious, school, or other instructional use free of charge.

232. RUMPHORST, WERNER. Der angestellte Urheber in den U.S.A. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 10 (Oct. 1972), pp. 345-358.

A study of the legal status of the authors of works made for hire and on commission in the United States under sec. 26 of the U.S. Copyright Act, the proposed revision of the law, and international law.

4. In Italian

233. FABIANI, MARIO. Problemi di protezione del design industriale. *Il Diritto di Autore*, vol. 43, no. 3 (July-Sept. 1972), pp. 265-280.

A study of the problems of protecting industrial designs under Italian and international laws.

5. In Swedish

234. Kataloghojd — en nyhet som kan avoaras? *NIR*, 1972, no. 4, pp. 393-397.

A brief survey of the protectibility of catalogs under Scandinavian copyright laws.

235. HILLERT, STEN. Fonogrammen och upphovsrätten. *NIR*, 1972, no. 4, pp. 357-392. "Artikeln har förut publicerats i Festskrift till Per Olof Ekelöf, Norstedts, Stockholm, 1972, och återges här efter en mindre justering med vederbörliga tillstånd."

A study of the provisions of the Swedish copyright law relating directly or indirectly to phonograph records.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

236. ASTRACHAN, ANTHONY. Soviets join copyright system. *The Washington Post*, Mar. 1, 1973, pp. H1, cols. 5-7; H8, cols. 1-5.

An article on the recent decision of the Soviet Union to join the Universal Copyright Convention, and on several interpretations as to the economic implications of Soviet adherence.

237. Court ruling sets cable liability on distant signals for first time. *Broadcasting*, Mar. 12, 1972, p. 12.

An article on reactions to a recent appellate decision in the case of *Columbia Broadcasting System, Inc. v. Teleprompter Corp.* which held, *inter alia*, that CATV systems are subject to copyright liability on copyrighted programming imported from distant stations.

238. Dolinsky class action vs. U.S. seeks to upset copyright law limitation. *Variety*, Dec. 1, 1972, p. 1, cols. 5-6; 13, cols. 1-2.

An article on a class action instituted recently by author Mike Dolinsky which challenges the constitutionality of section 24 of the Copyright Law imposing limitations on duration of copyright.

239. FREUND, ANDREAS. Soviet will honor law of copyright on foreign works; royalty payments expected after Moscow becomes party to Convention. *New York Times*, Feb. 28, 1973 (city ed.), pp. 1, cols. 3-4; 43, cols. 1-2.

An article on an announcement by UNESCO headquarters that the Russians had indicated their intention to become a party to the Universal Copyright Convention in a letter from the Soviet Foreign Minister Andrei A. Gromyko, to Rene Mahou, Director-General of UNESCO. According to UNESCO, Soviet adherence will become effective May 27, 1973, and the Soviet Union will become the Convention's 64th member state.

240. LUKAC, GEORGE. The copyright controversy. *Writer's Yearbook '73*, pp. 84-87.

An article based to a large extent on a symposium sponsored by Rutgers University Graduate School of Library Service. The proceedings of the symposium, published under the title "Copyright—the librarian and the law," and edited by the writer of the article, dealt with the conflicting points of view held by librarians, authors and publishers about library photocopying and fair use. See 20 BULL. CR. SOC. 132, Item 83 (1972).

241. Moscow amends law on copyright; outflow of dissident writing is apparent target. *New York Times*, Mar. 18, 1973, sec. 1, p. 5, col. 1 (late city ed.).

An article on a recent amendment of the Soviet copyright law "in an evident attempt to curb the unauthorized outflow of

dissident literatures," and on publishers' reaction in the United States.

242. The 93rd Congress: Stakes are high for publishers. *Washington Newsletter*, vol. VII, no. 12 (December 31, 1972), pp. 1, 5.

A news item prepared by the Association of American Publishers, Inc., discussing the forthcoming Senate hearings on the copyright revision bill.

243. PACE, ERIC. Publishers hail Soviet move despite problems. *New York Times*, Feb. 28, 1973 (city ed.), p. 43, cols. 1-4.

An article on reactions of American publishing figures and copyright experts on the Soviet Union's decision to become a party to the Universal Copyright Convention.

244. SHAW, RALPH R. Williams & Wilkins v. the U.S.; a review of the commissioner's report. *American Libraries*, vol. 3, no. 9 (Oct. 1972), pp. 987-999.

A critical comment on the commissioner's report in which the late Dr. Shaw maintains that "[t]he library, making a copy, by any means, at the specific request of a scholar, of an article for his *private* study and use, is simply acting as his agent to do for him, at his specific request, and for his *private* use, what the scholar has every right to do for himself." (emphasis supplied). He then argues, in part, that copying for private use is outside the scope of the copyright law.

245. WAGNER, SUSAN. Authors, publishers deplore Soviet moves to curb dissident writers by copyright laws. *Publishers Weekly*, March 26, 1973, pp. 47-48.

An article discussing the Author's League of America's and other publisher's groups' concern about the Soviet Union's adherence to the Universal Copyright Convention. The fear is expressed that the adherence was motivated by a desire to suppress Soviet underground writers. Another concern is that Soviet copyright law will provide a broad exemption for educational materials, thus leaving a vast proportion of all U.S. books published in the U.S.S.R. without any copyright protection.

246. WAGNER, SUSAN. Pakistan: a potential test for revised UCC? *Publisher's Weekly*, vol. 203, no. 4 (Jan. 22, 1973), p. 46.

An article on a recent meeting at the State Department of the Government Advisory Committee on International Book and Library Programs. It was reported at the meeting that "U.S. authors and publishers face a potentially 'very grave' piracy situation in Pakistan unless the current wave of unauthorized reprinting can be halted and copyright protection restored to American works."

2. Foreign

1. In English

247. BONHAM-CARTER, VICTOR. PLR: setting it straight. *The Author*, vol. 83, no. 4 (Winter 1972), pp. 166-174.

An answer to the criticism, by a group of authors, now known as Writers Action Group or WAG, of certain clauses in a so-called Working Party Report on the public lending right as well as in the Joint statement issued by the Society of authors and the Publishers Association in the *Author*, vol. 83, no. 2 (Summer 1972), pp. 65-82, and reprinted in 19 BULL. CR. SOC. 443, Item 322 (1972).

NEWS BRIEFS

248. ONE STATE PASSES, TWO INTRODUCE ANTIPIRACY LEGISLATION.

As reported in *Billboard*, March 23, 1973, pp. 3 and 74, the state of Utah has passed anti-piracy legislation making the duplication and sale of unauthorized sound recordings a misdemeanor. This makes Utah the eleventh state to pass an anti-piracy law.

In other developments, an anti-piracy bill for West Virginia will be submitted to that state's Senate, following the House of Representatives' unanimous approval of the bill. The bill, originally modeled after the Pennsylvania law, would set penalties for the first offense at not more than a \$1,000 fine and/or imprisonment of not more than sixty days. The second offense would carry a \$10,000 fine and/or a one-to-three year prison term.

In addition, an anti-piracy bill has been introduced into the New Jersey Assembly by Assemblyman John N. Dennis. The bill, which in context parallels New York's law, would prohibit unauthorized duplication of phonograph records, wires and tapes.

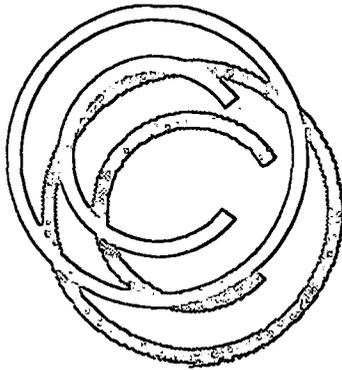
249. NEW ASSISTANT REGISTER OF COPYRIGHTS NAMED.

Mr. L. Clark Hamilton has been appointed Assistant Register of Copyrights, effective February 26, 1973. L. Quincy Mumford, Librarian of Congress, announced the appointment on February 15, 1973. Mr. Hamilton will administer the principal management, operational, and personnel functions of the Copyright Office. This will include directing the automation of operations in the Office and coordinating these plans with the Information Systems Office.

250. COPYRIGHT OFFICE ZIP CODE CHANGED TO 20559.

The zip code of the Copyright Office has been changed to 20559. The change is effective January 1, 1973. All future mail addressed to the Copyright Office should bear the new zip code.

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PART I.

ARTICLES

251. COPYRIGHT PROTECTION FOR ORAL WORKS — EXPANSION OF THE COPYRIGHT LAW INTO THE AREA OF CONVERSATIONS.

By KENT DUNLAP*

As society has become more complex, the law has gradually enlarged the scope of copyright in order to protect new forms of valuable authorship. The growth of copyright protection has been reflected in the area of oral works. Initially, the first copyright statute dealt only with printed material.¹ However, in 1833 Parliament enacted the Bulwer-Lytton's Act which "conferred statutory playwright in perpetuity throughout the British dominions in the case of dramatic pieces not printed and published."² In America, Justice Story in his classic treatise on equity provided an author of a drama with exclusive rights in his work.³ In addition, the treatise established protection for lectures and speeches from unauthorized appropriation.⁴ Approximately 150 years passed before another variety of oral work was brought within the ambit of copyright protection. In 1971, Congress enacted the record piracy bill which brought published sound recordings, i.e. generally, records and tapes offered for sale, within the federal copyright law.

Recently some cases have arisen which have indicated that copyright law may move into an area heretofore unexplored. This is the area of spontaneous utterances and conversations. Undoubtedly, if such a shift in the law does occur, one of the primary reasons for such a change will be the ease of recording such material through the use of tape recorders. Thus, where previously recording the utterances of another was a laborious task, it can be accomplished today with little or no effort.

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1. 8 Anne c. 19 (1710).

2. *Ferris v. Frohman*, 223 U.S. 424, 432 (1912).

3. *STORY, EQ. JUR.* §950 (4th Ed. 1846).

4. *Id.* at §§943, 949.

The purpose of this article is to examine the nature of protection which an author of an oral work can expect to receive. Since copyright protection for dramas, lectures, speeches and published sound recordings is relatively clear under the present law, protection in these areas will only be mentioned in passing. Emphasis will be given to copyright protection of spontaneous utterances, since this is an area of potential growth in the near future. In addition, an examination will be made of cases where protection is sought for ideas which are orally disclosed.

I. HISTORICAL OVERVIEW

Modern notions of common law copyright can trace its origins to the greed of the London booksellers in the first half of the eighteenth century. In the hope of maintaining their monopoly of the book publishing business in certain famous works which had been published before the statute of Anne (1710), they claimed an exclusive and perpetual right under the common law to copy and reprint such works indefinitely.⁵ This claim was eventually supported in the case of *Millar v. Taylor*.⁶

Common law copyright in America today is vastly different from its early English predecessor, due largely to the early case of *Wheaton v. Peters*.⁷ This historic case emanated from a suit brought by Henry Wheaton, official reporter for the Supreme Court from 1816 to 1827, against Richard Peters, his successor as official reporter. He alleged that Peters had copied and placed in a new volume much of the material contained in the Wheaton Reports. Wheaton framed his action under the alternative grounds of common law copyright and federal statutory copyright infringement. The court rejected the plaintiff's common law count and remanded the case for a determination as to whether the plaintiff had complied with the statutory formalities so as to entitle him to protection under the federal statute.

In regard to the common law count, the Court acknowledged the existence of a common law copyright in unpublished manuscripts. How-

5. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY*, at 470 (1944).

6. 4 Burr 2303. This case was the first of two landmark decisions involving the same work — James Thomson's *The Seasons*. In *Millar*, Lord Mansfield, Chief Justice of King's Bench, held that the book publishers possessed "an incorporeal right to sole printing and publishing of somewhat intellectual, communicated by letters." Five years later the *Millar* ruling was in effect overruled by the House of Lords in the case of *Donaldson v. Becket*, 4 Burr 2408. In that case the Court held that although publication did not divest an author of his common law rights, the Statute of Anne did divert common law rights since it preempted the field.

7. 33 U.S. 591 (1834).

ever, upon publication of the work, the Court reasoned that common law copyright was divested since under our federal system there could be no national common law. Due to this holding, common law copyright has developed into a remedy available under state law to protect an author's proprietary interest in his creations before they become generally available to the public. It allows an author to exercise control over the first publication of his work or to prevent publication entirely. In addition, this protection never ends and may be asserted by distant heirs long after the author's death.⁸

Under the present federal copyright act, the province of state courts to protect unpublished works is clearly established. Section 2 of Title 17 provides as follows:

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent copying, publication, or use of such unpublished work without his consent, and to obtain damages thereof.

Upon publication of the work, the author must either secure federal statutory copyright protection or lose protection since his common law rights are divested. Under federal law, copyright protection is secured through publication with a notice of copyright.⁹ In order to enforce his rights, however, the copyright owner must secure a certificate of registration from the Copyright Office.¹⁰ Should the author unwittingly publish his work without a notice, his creation is thrust into the public domain and his rights are forever ended.¹¹

For works primarily oral in nature, divestment of common law copyright protection through publication without a notice is not a problem since courts have found performance or delivery of such a work is not

8. BALL, *supra* note 5 at 472.

9. 17 U.S.C. §19 (1964).

10. 17 U.S.C. §13 (1964); in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 200 F.2d 637 (2d Cir. 1958), the Register of Copyrights refused to register the plaintiff's claim to copyright in a watch. Undaunted, the plaintiff brought a copyright infringement action against Benrus. Speaking for the majority of the Second Circuit, Judge Learned Hand ruled that no action could be maintained for copyright without first securing a certificate of registration from the Copyright Office.

11. NIMMER, *ON COPYRIGHT* at 302 (1970); Section 21 of the Copyright Law does provide some relief for an accidental omission of the notice provided the copyright proprietor "has sought to comply with the provisions of this title with respect to notice." In these situations a copyright owner may recover from an infringer who has actual notice of the copyright.

a publication.¹² Undoubtedly the furthest extension of this principle was reached in *King v. Mister Maestro, Inc.*¹³ In that case, Dr. Martin Luther King delivered his famous "I Had A Dream" speech before a crowd of 200,000 in Washington, D.C. Before the speech, Dr. King distributed to the press a "summary or excerpts" of his prepared text without notice of copyright. Subsequently, the speech received extensive coverage from the news media, and millions of Americans became familiar with portions of the speech. Subsequently, two record companies, seeking to take advantage of Dr. King's popularity, released records of his Washington speech. Dr. King brought an action for injunction, damages and accounting. The defendants argued that the enormous coverage the speech had received published the work, thereby thrusting it into the public domain. The court rejected this argument, choosing instead to follow the traditional doctrine that delivery of a speech was not a publication. In regard to the advance text distributed to the press, the court found that there had been only a "limited publication" rather than a general public publication, and therefore no divestment of copyright protection had occurred.

Due to the inadequate protection sound recordings had received over the years,¹⁴ Congress was recently moved to enact the record piracy

12. Ferris, *supra* note 2; Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946); Nutt v. National Institute Inc. for the Improvement of Memory, 31 F.2d 236 (2d Cir. 1929); Uproar Co. v. National Broadcasting Co., 8 F.Supp. 358, 362 (D. Mass. 1934).

13. 224 F.Supp. 101 (S.D.N.Y. 1963).

14. Sound recordings were included into the scheme of federal copyright protection only after many years of being without such protection. In the early 1900's deliberations concerning revision of the copyright law occasionally included discussions in regard to the inclusion of sound recordings. However, when the 1909 Act was passed, sound recordings were not enumerated as a protected work. Possibly contributing to this omission was the Supreme Court case of *White-Smith v. Apollo Company*, 209 U.S. 1 (1908) which held that piano rolls were not "copies" under the copyright law at the time. Apparently, this decision was interpreted by some as indicating that sound recordings were not a "writing" in the Constitutional sense and therefore could not be protected. See generally, RINGER, *The Unauthorized Duplication of Sound Recordings*, COPYRIGHT LAW REVISION STUDY no. 26 (1961).

In 1945, Professor Chafee wrote an article in which he took the position that sound recordings were within the "writing" requirement of the Constitution and hence potentially copyrightable under federal law. CHAFEE, REFLECTIONS ON THE LAW OF COPYRIGHT, 45 COL. L. REV. 719, 733-737 (1945). Ten years later, the Second Circuit adopted this position in *Capital Records v. Mercury Records Corporation*, 221 F.2d 657 (2d Cir. 1955). In that case, the Court found that sound recordings could consti-

bill which protected commercial sound recordings fixed after February 15, 1972. This legislation created an exception to the general rule that oral works are unpublished by treating sound recordings as published works.¹⁵ The statute established that "any person . . . upon complying with the provisions of this title, shall have the exclusive right to reproduce and distribute to the public by sale or other transfer of ownership, or by rental, lease, or lending, reproductions of the copyrighted work if it be sound recording."¹⁶ In order to comply with the statutory formalities, the copyright proprietor must affix a notice consisting of a "p" in a circle, year date, and owner's name "on the surface of reproductions thereof or on the label or container in such manner and location as to give reasonable notice of the claim to copyright."¹⁷

For authors of unpublished dramas and lectures, two separate schemes of protection are available. He may either rely on his common law rights under state law or secure his rights under federal law by registering his claim under Section 12 of Title 17.¹⁸ By registering these claims, several advantages are achieved. A record of priority of authorship is built up in the Copyright Office which assists the author in managing and disposing of his property.¹⁹ In addition, the records promote confidence in the proprietor's title and validity of the copyright and

tionally be protected although the 1909 Act failed to provide for such protection. In the absence of federal statutory protection, the Court held that New York unfair competition law would apply. Dissenting, Judge Learned Hand advanced a theory of constitutional preemption by the Copyright Clause of all published works that constitute the "writing of an author." Since sound recordings were not protected under federal law, Judge Hand argued that state law could not constitutionally protect them.

Further complicating the law surrounding protection of sound recordings were the Supreme Court decisions of *Sears Roebuck & Co. v. Stiffel*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (1964). In these cases the Supreme Court greatly restricted unfair competition relief by articulating a theory of federal preemption of matters coming within the purview of the Patent and Copyright Clauses of the Constitution.

Due to the uncertainty surrounding state law protection for sound recordings, record piracy became a lucrative venture. In order to stop the tremendous losses the record producers were experiencing at the hands of the pirates, Congress was moved to include sound recordings into the federal scheme of protection.

15. PUBLIC LAW 92-140, 92nd Congress S. 646.

16. 17 U.S.C. §1(f) (1971).

17. 17 U.S.C. §5(c) (1971).

18. 17 U.S.C. §12 (1971).

19. KAPLAN, *The Registration of Copyright*, COPYRIGHT LAW REVISION STUDY no. 17 at 42 (1960).

thereby assists him in marketing his work. Furthermore, registration of his claim allows him into federal court. Since a large body of federal copyright law has been developed, he is more likely to get into a court with expertise in copyright law. Finally, an injunction, which is a frequently-utilized remedy in infringement cases, can have a national effect in federal court.²⁰

As can be seen from this brief historical overview of copyright, protection of oral works spans both common law copyright and federal statutory copyright. Distributed sound recordings are treated as "published" works and must be marketed with a proper notice in order to effect federal copyright protection. Dramas and lectures may be protected under either common law or federal law, depending on the author's willingness to register. Finally, other less-developed oral works, such as conversations and spontaneous radio broadcasts, must be protected under the common law.

II. DETERMINATION OF NATURE OF PROTECTION

The nature of rights which the creator of an oral work receives greatly depends on the theory under which he proceeds. Generally speaking, a copyright theory will protect an author's expression but not the underlying ideas. On the other hand, a variety of legal theories are available to the creator of an idea which has been taken.

One problem in analyzing the applicable theory of recovery in the area of oral works is the imprecision of some courts in designating the theory which controlled the decision. This seems to be due largely to two reasons. First, these cases are often brought in state courts whose experiences in this area are limited. Secondly, these cases often arise on a motion to dismiss for insufficiency, and therefore the courts are not given a chance to fully develop their theory of recovery. The problem of imprecision notwithstanding, this section will attempt to explore the differences in seeking protection for expression versus ideas.

A. *Protection For Oral Works Under Copyright*

The purpose of copyright is not to enrich an author, as might be expected, but instead, to encourage authorship for the public benefit. Probably the best articulation of this principle was contained in *Mazer v. Stein*,²¹ in which the Supreme Court said:

20. 17 U.S.C. §§112, 113 (1964).

21. 347 U.S. 201 (1954).

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talent of authors and inventors in "Science and useful Arts."²²

Ironically, while copyright is designed to promote authorship, an overbroad view of the scope of copyright protection would stifle free expression. Clearly, if a few authors were given a limited monopoly in words, short phrases, familiar symbols, general ideas and the like, expression itself would be curtailed.²³ Therefore the courts have had to reconcile the policy of granting authors exclusive rights in their creations with the policy of promoting the free exchange of ideas and information.

One method of mediating the rights of authors with the rights of others to develop works of their own was to extend copyright protection to only the form of expression an author utilizes and not to the underlying ideas.²⁴ As might be expected, an author receives more protection for well-developed authorship than for generalized expression. Learned Hand made this point in *Nichols v. Universal Pictures Corp.*,²⁵ when he said:

If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort

22. *Id.* at 219.

23. Perhaps the best expression of this principle was made by Judge Manton in *Eichel v. Marcin*, 241 Fed. 404, 408-409 (S.D.N.Y. 1913). "The object of copyright is to promote science and the useful arts. If an author, by originating a new arrangement and form of expression of certain ideas or conceptions, could withdraw these ideas or conceptions from the stock of materials to be used by other authors, each copyright would narrow the field of thought open for development and exploitation, and science, poetry, narrative, and dramatic fiction and other branches of literature would be hindered by copyright, instead of being promoted. A poem consists of words, expressing conceptions of words or lines of thoughts; but copyright in the poem gives no monopoly in the separate words, or in the ideas, conception, or facts expressed or described by the words. A copyright extends only to the arrangement of the words. A copyright does not give a monopoly in any incident in a play. Other authors have a right to exploit the facts, experiences, field of thought, and general ideas, provided they do not substantially copy a concrete form, in which the circumstances and ideas have been developed, arranged, and put into shape."

24. *Holmes v. Hurst*, 174 U.S. 82, 86 (1899).

25. 45 F.2d 119 (2d Cir. 1930).

of the household, or a vain and foppish steward who became amorous of his mistress.

The fact that copyright protection extends to only "expression" would seem to limit the application of this remedy in cases where the expression was a spontaneous utterance which was never reduced to writing. For example, in a situation where an author discloses his creation in a conversation without there being a recording, infringement could only occur if a defendant recalled from memory a significant portion of the expression. Individuals blessed with such a faculty would seem to be few. The most plausible situation in which infringement of an unrecorded oral work could occur would be the wrongful appropriation of an original song. Clearly, there are some individuals sufficiently skilled in music to have the ability to recall from memory a song which they have heard. Such recall could be utilized to infringe an author's right in his unrecorded song.

Perhaps the clearest example of a situation involving infringement from memory was the case of *Fred Fisher Inc. v. Dillingham*.²⁶ In that case Judge Learned Hand was presented with two highly similar musical compositions and the defendant's denial of any conscious plagiarism. Judge Hand said that while he tended to believe the testimony of the defendant, the works were too similar in nature to be a mere coincidence. Under the circumstances he indicated that he felt the defendant "unconsciously" infringed the plaintiff's work.²⁷

B. *Protection For Ideas Disclosed Orally*

Due to the inherently informal nature of spontaneous oral communication, often the "property" for which protection is sought consists of nothing more than ideas. Although a few courts have mistakenly protected ideas under a copyright theory,²⁸ the vast majority have held that ideas are outside the ambit of copyright.²⁹ Various other theories, however, have been used to protect ideas, such as misappropriation of property, quasi contract, express contract, implied contract, and confidential relationship.³⁰

With the exception of cases relying on theories of express or implied contracts, courts have usually required concreteness and novelty as pre-

26. 298 Fed. 145 (S.D.N.Y. 1924).

27. *Id.* at 147.

28. NIMMER, *supra* note 11 at 717.

29. *Id.* at 717.

30. NIMMER, *The Law of Ideas*, 27 S. CAL. L. REV. 119 (1954).

requisites to recovery.³¹ The concept of concreteness is utilized in the field of ideas to require that an idea be sufficiently developed before it can be protected.³² Thus, concreteness is the doctrine which courts use to separate general, abstract ideas from those ideas which are sufficiently specific to have value. The requirement of novelty, which is often imposed in idea cases, is a much more rigorous test than originality, which is the requirement in copyright cases.³³ Novelty requires not only that the idea originate with its creator but that it be unique and not formally known.³⁴

The requirements of concreteness and novelty seem to be used by the courts to insulate from liability a defendant who has received an unsolicited idea. Apparently, most courts feel it is unfair to obligate a defendant to pay for an idea without a previous understanding regarding compensation. Justice Traynor probably articulated this concern best when he said:

Even though the idea disclosed may be widely known and generally understood it may be protected by an express contract providing that it will be paid for regardless of its lack of novelty. An implied-in-fact contract differs from an express contract only in that the promise is not expressed in language but implied from the promisor's conduct. It is not a reasonable assumption, however, in the absence of an express promise, or unequivocal conduct from which one can be implied, that one would obligate himself to pay for an idea that he would otherwise be free to use. Even an express contract to pay for "valuable information" to be submitted by the plaintiff does not carry the implication of a promise to pay if it is found upon disclosure to be common knowledge. If the idea is not novel, the evidence must establish that the promisor agreed expressly or impliedly to pay for the idea whether or not it was novel.³⁵

Generally, courts have not drawn a distinction between cases where ideas are disclosed in a writing and cases where such a disclosure is effected orally. However, where the disclosure is solely oral it would seem that the defendant has a much greater burden to prove that the idea is sufficiently concrete and novel to merit protection. Probably the

31. *Id.* at 140.

32. *Id.* at 140, 141, 142, 143.

33. *Id.* at 144.

34. NIMMER, *supra* note 11 at 755.

35. *Stanley v. Columbia Broadcasting System*, 35 Cal.2d 653, 221 Pac.2d 73, 85, 86 (1950) (citations omitted).

strictest courts in regard to oral disclosures of an idea are the New York Courts. In *Grombach Productions Inc. v. Waring*,³⁶ the plaintiff had four telephone conversations with the defendant's agent in regard to an idea for a radio program. Subsequently, the defendant allegedly used the idea without compensating the plaintiff. A jury rendered a judgment for the plaintiff basing recovery on contract implied-in-law. The New York Court of Appeals reversed, holding that the lack of a prior "deal" between the parties precluded compensation for a gratuitous unsolicited disclosure.³⁷

In another case, decided by the New York Supreme Court, it was implied that an idea which was disclosed orally could not be sufficiently concrete to merit protection. In *Bailey v. Haberle Congress Brewing Co.*,³⁸ the plaintiff orally disclosed to the defendant her advertising slogan "Neighborly Haberle" and explained how it could be used in an advertising campaign.³⁹ The defendant said he was not interested, but two months later he used the slogan without compensating the plaintiff. The court rejected the plaintiff's claim for recovery using the following language:

She disclosed this slogan to the defendant merely as an idea, oral and abstract, without any advertising layout on paper to give it concrete form and she did this voluntarily and unsolicited, without the protection of any express agreement.⁴⁰

Despite the result in the preceding case, most cases have not limited a creator's rights merely because he orally disclosed his idea. Thus in *Jones v. Ulrich*,⁴¹ the plaintiff orally instructed the defendant how to build a spreader which the plaintiff had invented. After completion, the two orally agreed for the defendant to produce and market the spreader and pay the plaintiff royalties. The defendant marketed the spreader but refused to pay royalties. The appellate court of Illinois held that the plaintiff could recover under a theory of breach of confidential relationship.⁴²

Another case with somewhat similar facts chose to base recovery on a unique property theory. In *Belt v. Hamilton National Bank*,⁴³

36. 293 N.Y. 609, 58 N.E.2d 425 (1944).

37. *Id.* at 428-29.

38. 193 Misc. 723, 85 N.Y.S.2d 51 (1948).

39. *Id.* at 52.

40. *Id.* at 52.

41. 324 Ill. App. 16, 95 N.E.2d 113 (1950).

42. *Id.* at 121.

43. 108 F.Supp. 689 (Dist. Col. 1952).

the plaintiff orally presented an advertising scheme to the defendant bank. The defendant originally seemed interested in the plan and hired the plaintiff briefly to develop it further. Interest seemed to wane quickly, however, and soon the project appeared dead. Several months later the defendant renewed his original interest, and the program was initiated minus any compensation for its creator. The jury awarded the plaintiff \$3,300, and on a motion for judgment notwithstanding the verdict the Court affirmed the award. It supported its decision by saying:

The law has recognized a qualified property right in trade secrets and grants injunctive relief against their use or disclosure by a breach of contract or a violation of confidence. It is but one short step further to extend to ideas at least a limited property right. This step has been recently taken. The law now gives effect to a property right in an idea even though the idea may be neither patentable nor subject to copyright.⁴⁴

Not surprisingly, there are some decisions protecting ideas disclosed orally which cannot be reconciled with decisions denying such protection. In *High v. Trade Union Courier Publication Corporation*,⁴⁵ the defendant agreed to compensate the plaintiff if he disclosed information concerning a provision of the Internal Revenue Code. The plaintiff orally made the disclosure, but the defendant refused to pay despite the fact that he made a substantial tax savings. The Court held a cause of action had been stated in express contract even though the tax provision was available to the public.⁴⁶ In *Masline v. New York, New Haven and Hartford Railroad Company*,⁴⁷ the defendant railroad agreed orally to compensate the plaintiff for an idea which earned the company money. The idea of selling advertising space on railroad property was disclosed orally. The defendant refused to pay the plaintiff although the company began to make substantial sums selling advertising space shortly after the suggestion. The Court held no recovery was possible since "the idea was common knowledge and that it could not be considered property nor could it constitute consideration for a promise."⁴⁸

In retrospect, the cases involving protection for ideas disclosed orally indicate that the plaintiff will have to satisfy a high burden of

44. *Id.* at 691.

45. 69 N.Y.S.2d 526 (1946).

46. *Id.* at 530.

47. 95 Conn. 702, 112 Atl. 639 (1921).

48. *Id.* at 641.

proof in order to prevail. While several theories may be utilized on which to base recovery, under any theory, the plaintiff will have to show more than disclosure of an idea which had value to the defendant. Proof of an understanding between the plaintiff and defendant seems to be a necessary element in establishing a basis for recovery.

III. THE REQUIREMENT OF TANGIBILITY

In cases involving copyright protection of oral works, it is often said that no protection is possible unless the work is evidenced by a "writing." This requisite is usually termed the requirement of tangibility. In considering this requirement, a sharp distinction must be drawn between cases arising under the common law and those cases brought under federal statutory law. In order to discuss the differences the nature of the suit will make on the requirement of tangibility, this section will examine its impact on federal statutory law and state common law separately.

A. Federal Protection — Tangibility As A Constitutional Limitation

The Constitution provides that Congress shall have the power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.⁴⁹ Due to this provision, an author is required to bring his work within the meaning of "writing" in order to secure federal copyright protection. Fortunately, the term "writing" in the constitutional sense has been given a broad reading by the courts. This has enabled the present copyright law to protect works such as photographs,⁵⁰ reproductions of work of art,⁵¹ motion pictures,⁵² sound recordings,⁵³ maps,⁵⁴ architectural drawings,⁵⁵ and works of art.⁵⁶ However, if the word "writing" is to be given any meaning whatsoever, it must, as a minimum, denote some tangible form capable of identification and having a more or less permanent endurance.⁵⁷

49. U.S. CONST. ART. I SEC. 8.

50. 17 U.S.C. §5(j) (1964).

51. 17 U.S.C. §5(h) (1964).

52. 17 U.S.C. §§5(l), 5(m) (1964).

53. 17 U.S.C. §5(n) (1971).

54. 17 U.S.C. §5(f) (1964).

55. 17 U.S.C. §5(i) (1964).

56. 17 U.S.C. §5(g) (1964).

57. NIMMER, *supra* note 11 at 20.

This constitutional requirement has significance in the area of oral works since the works will fall outside the ambit of federal copyright protection unless they become fixed into a "writing." Thus it would seem that conversations which go unrecorded could not be constitutionally protected under federal law since they would not be evidenced by a "writing." Similarly, live television programs which are not simultaneously recorded, and evanescent performances, would fall outside the "writing" requirement if they were performed without a script.⁵⁸ In these cases where federal protection is impossible, the author must look to the common law to defend his rights.

B. *Tangibility As It Relates To Common Law Copyright*

The constitutional requirement that a work must fall within the meaning of a "writing" in order to claim federal statutory copyright is not applicable in the realm of common law copyright. Despite this fact, several courts have stated that a work can not qualify for common law copyright unless it was embodied in a writing or some other material form.⁵⁹ In criticizing this position, Professor Nimmer postulates that the requirement of "concreteness" in expression has become confused with tangibility as it relates to the medium of expression.⁶⁰ The concept of concreteness is utilized in the field of ideas to require that an idea be sufficiently developed before it can be protected.⁶¹ This doctrine, according to Nimmer, has been carried over into the copyright field and had led some courts to conclude that an author must express his work in tangible form in order to effect common law copyright protection. However, Nimmer reasons that this is a misuse of the concreteness doctrine, and a nontangible oral work should receive as much protection as a similar expression in written form.⁶²

Although no case has ruled directly on the question of whether common law copyright may be claimed in nontangible oral or visual expression,⁶³ several cases have implied such protection is possible. In *Dane v. M & H Co.*,⁶⁴ plaintiff instituted an action for unfair competition and infringement of common law copyright based on her claim that she originated and created and defendants appropriated a chore-

58. *Id.* at 21, 22.

59. *Id.* at 38.

60. *Id.* at 39.

61. *Id.* at 750.

62. *Id.* at 38-39.

63. *Id.* at 40.

64. 136 USPQ 426 (N.Y. Sup. Ct. 1963).

ographic musical composition which told a story about and was a satire on "strip teasers." The plaintiff originated a number with bumps and grinds and gyrating the pelvis back and forth to portray a "stripper" without taking anything off. She was hired to perform her number in "Gypsy" and was paid \$110 per week. The court found that since the plaintiff had not written the song, her only claim to copyright was her performance of bumps and grinds and the blowing of a bugle. The court concluded that this short performance was insufficient to support a copyright and held in favor of the defendants.

In the dicta of the decision, the court postulated that despite the fact that the plaintiff's choreographic number had never been reduced to "concrete form," this alone would not preclude the right to assert ownership to the piece of property.⁶⁵ From the context of this statement it would seem that the court was really addressing itself to the issue of tangibility rather than concreteness. If the plaintiff's work had not been in concrete form, she should be precluded from protection since her work would only consist of an abstract idea.⁶⁶ Instead, the court seemed to be saying that despite the fact that the plaintiff had never reduced her work to a tangible writing, this reason alone would not deny her recovery. The confusion the court seemed to have between the concepts of concreteness and tangibility lends support to Professor Nimmer's argument that confusion of these two doctrines had muddled the law surrounding tangibility as it relates to common law copyright.

In addition to the imprecise use of the concepts of concreteness and tangibility, the *Dane* decision offered another reason for the occasional carrying over of the federal constitutional requirement of tangibility into the common law area. Despite the fact that the suit was based on common law copyright infringement, the court extensively discussed federal statutory requirements.⁶⁷ Undoubtedly this was due largely to necessity, because frequently state copyright law is lacking in the more obscure areas. When this carrying over occurs, however, there is a danger that federal requirements which are not applicable to the common law will be applied to deny protection to a work which could come within the scope of common law copyright.

In *Jenkins v. News Syndicate Co., Inc.*,⁶⁸ the first count of the plaintiff's complaint alleged that she discussed with the defendant newspaper contemplated news articles covering New York society. After

65. *Id.* at 429.

66. NIMMER, *supra* note 11 at 714.

67. *Dane*, *supra* note 64 at 428.

68. 219 N.Y. Supp. 196 (1926).

negotiations for the sale fell through, the defendant published a purported interview with the plaintiff substantially reproducing the discussions. In her second count, the plaintiff alleged that she had furnished the defendant with a written synopsis of the proposed articles and that this writing had also been appropriated. On a motion to dismiss for insufficiency, the Court allowed both counts to stand. The court justified denying the motion by saying the plaintiff owned literary property which could not be properly classified as news.

Another case which is often cited for the proposition that a writing should not be required under the common law is *Columbia Broadcasting Systems, Inc. v. Documentaries Unlimited, Inc.*⁶⁹ In this case, a broadcasting company and its news broadcaster brought an action for infringement of common law copyright. The defendant made a record depicting the assassination of President Kennedy, utilizing a one-minute excerpt of the plaintiff's live radio broadcast which was not based on a written script. The court found there had been an improper appropriation of the plaintiff's property and enjoined further use of the plaintiff's property.

Although this case is useful to commentators arguing against a tangibility requirement, it would seem that his case should be more properly considered as a case where the "writing" requirement was fulfilled. Clearly the defendant would have to have had a tangible writing of the plaintiff's broadcast in order to insert it into his record. To require that the plaintiff also have such a "writing" would set up a rather artificial distinction in an already amorphous area of the copyright law. Therefore it would seem that a broad reading of the writing requirement would put this case within the vast majority of copyright cases where the infringed work is evidenced by a writing.

Most commentators on the tangibility requirement seem to take the position that it should not be required in common law copyright cases. However, in the area of spontaneous utterances it is difficult to imagine a situation where a defendant could infringe another's expression without the aid of writing. It would seem that such an infringement would require the use of a rather extraordinary memory on the part of the defendant.

There do seem to be some circumstances, however, where copyright protection for a nontangible work, i.e. oral work or evanescent performance, would seem to be merited. As mentioned in Section II of this article, the most plausible situation where an infringement of a work not reduced to writing could occur would be in the area of original musical

69. 248 N.Y.S.2d 809 (1964).

compositions. Furthermore, another situation where infringement of a nontangible work would seem to be possible would be in the area of choreographic works.

Since it seems clear that there are some circumstances where an author of nontangible work does deserve protection, courts should be careful not to exclude such authorship from protection by imposing a tangibility requirement. In cases where the work lacks sufficient development to merit protection, the suit should be dismissed on grounds of copyrightability rather than tangibility.

IV. PROTECTION FOR ORAL CONVERSATIONS AND SPONTANEOUS UTTERANCES

Until recently it seemed clear that a speaker received no protection for his spontaneous utterances. Although this approach was unambiguous, it was overly simplistic. With the development of tape recorders, it has become easy to convert spontaneous utterances into "writings." As a result, the law surrounding copyright protection for conversations seems to be in a state of flux. In order to analyze the problems arising in this area, this section will discuss the recent cases and then consider the factors which may influence a court's decision.

A. *Cases Involving Copyright Protection For Conversations.*

1. Reporter's Rights To Conversations Of Another Against A Third Person.

The first American court to face the issue of protection for conversations was *Harris v. Miller*.⁷⁰ In this case, the widow of author Frank Harris sued the defendants for infringement of her husband's biography of the life of Oscar Wilde. Twenty years after the book had been published, the defendants produced a play which made liberal and verbatim use of quotations contained in the book. Defendants claimed these conversations fell outside copyright protection since they did not originate with Harris. Judge Leibell rejected this defense and stated:

The use of quotation marks to set out the conversations, Harris, the biographer, had with his subject, Wilde, does not put that matter in public domain. It is apparent no stenographer was present and that the statement of the conversations is the biographer's version, the result of his literary effort. If Harris was only trying to reconstruct the conversations he had with Wilde that would be

70. 50 USPQ 306 (S.D.N.Y. 1941).

authorship. What was taken involved authorship, literary quality and style, apart from any recital of facts. The biography was the result of literary effort in analyzing a personality. Harris was a man of recognized literary ability. It likewise appears that this method of direct discourse, instead of the narrative form was resorted to by the biographer to vitalize the biography.⁷¹

Thus the Court in this case seemed to feel that reporting of conversations in the format of a biography involved extensive authorship and should be protected against a third party who sought to appropriate the work. In fact, in the quotation just cited, the Court implied that actually the quotes may not have been a verbatim account of conversations of Wilde, but instead merely an alternative writing form of the author's recollection of incidents involving Wilde.

2. The Hemingway Litigation

Undoubtedly the most important case in the area of copyright protection for conversations is the *Estate of Hemingway v. Random House Inc.*⁷² In that case, Hotchner, a younger, less famous author, cultivated the friendship of Ernest Hemingway and made careful notes regarding conversations between himself and the well-known writer. During Hemingway's life, Hotchner used some of this conversational material in writing and publishing several articles about the author. Apparently Hemingway made no objection to the use of this material. After Hemingway's death, Hotchner wrote *Papa Hemingway*, a biographical portrait of the author which utilized extensively quotations as noted or remembered by Hotchner.

Subsequently, an action was brought by Hemingway's estate and his widow alleging four causes of action.⁷³ One count, brought on the behalf of Mary Hemingway, claimed that references to her in the book violated her right to privacy as guaranteed by Section 51 of the New York Civil Rights Law. The remaining three counts were brought by Mary Hemingway as executrix of her husband's estate and charged (1) use of the conversations of Hemingway infringed his common law copyright, (2) the book unfairly competed with other works written by Hemingway, and (3) Hotchner obtained the material by breaching a confidential relationship.

71. *Id.* at 307.

72. 23 N.Y.2d 341, 296 N.Y.S.2d 771, 244 N.E.2d 250 (1969).

73. 268 N.Y.S.2d 531 (1966).

In deciding that a preliminary injunction was not warranted, Justice Frank of the New York Supreme Court was able to summarily dispose of all the counts except the allegations of infringement of Hemingway's common law copyright. Mary Hemingway's privacy count was found to fall outside the purview of the New York statute since that statute prohibited invasions of privacy for advertising purposes.⁷⁴ In regard to the counts of unfair competition and breach of confidence, Justice Frank found them "so vague and conclusory as to be almost meaningless."⁷⁵

Frank, however, was forced to struggle with the common law copyright issue. In deciding that common law copyright could not exist in "spontaneous oral conversation," four grounds were articulated. First, Frank claimed common law copyright in conversations would unduly impinge free speech:

The free and unfettered exchange of ideas and information of all types has been a hallowed tradition that has served to nourish an alert citizenry. The intellectual benefits derived from access to the intimate articulations and experiences of figures of note and achievement are emphatically demonstrated by the enduring fame and inspirational stimulus of the work of recorders such as Plutarch, Boswell and Carlyle.⁷⁶

Secondly, Judge Frank reasoned that any conversational exchange reflected upon the participants and was not solely the work of one individual.⁷⁷ As the third reason, he emphasized the considerable skills which Hotchner utilized in compiling conversations into a readable book.⁷⁸ Frank's fourth and final reason for denying the injunction was a rather weak equitable-waiver theory.⁷⁹ He cited the plaintiff's silence and seeming acquiescence over the three year period during which she knew the defendant was working on the book. Granting the injunction at this point, Judge Frank reasoned, would inflict undue economic hardship on the defendant.

After publication of the book, Hemingway's widow brought a similar action in the same court seeking a permanent injunction and dam-

74. *Id.* at 539.

75. *Id.* at 535.

76. *Id.* at 536.

77. *Id.* at 537.

78. *Id.* at 537.

79. *Id.* at 537.

ages.⁸⁰ Alleged as causes of action were the same counts brought in the first action. Judge Schweitzer summarily dismissed the unfair competition, breach of confidential relationship and invasion of privacy on the same grounds as the previous decision.⁸¹

In regard to the copyright count, the Court seemed to have more difficulty. It first decided that distribution of 16 galley proofs and a press release had not been a divesting publication.⁸² Facing the issue of whether there had been a copyright infringement of Hemingway's common law copyright in his oral conversations, the Court essentially followed the approach of Judge Frank. It agreed with Frank that conversations were the product of interaction between the parties and were not individual intellectual productions. To the plaintiff's argument that Hemingway's contributions were so unique that they amounted to literary compositions in themselves, the Court responded that a subjective inquiry, such as suggested by the plaintiff, would be impossible.⁸³ To further support their conclusions, the Court restated Frank's opinion that the literary value of the book arose from Hotchner's selection and ordering of the conversational materials used.⁸⁴ Furthermore, the Court reasoned that a common law copyright in oral conversations would too greatly hinder free speech rights.⁸⁵

One issue which was not dealt with in the previous litigation was whether one party of a conversation could have literary property rights over another participant. Judge Schweitzer concluded that each participant had equal rights in the conversation and said:

Assuming that each party to any conversation makes some contribution to it, it would seem that the only rational rule is that any party is free to publish his own version — whether verbatim or not.⁸⁶

Following these two decisions there were several law journal articles concerning the Hemingway litigation. Probably the best article presented a negative view of the two decisions.⁸⁷ It pointed out that copyright protection in general impinged free speech, and that this argument

80. 279 N.Y.S.2d 51 (1967).

81. *Id.* at 61.

82. *Id.* at 55.

83. *Id.* at 59.

84. *Id.* at 59.

85. *Id.* at 60.

86. *Id.* at 60.

87. Comment, "Copyright: Right to Common Law Copyright in Conversations of a Decedent," 67 *COL. L. REV.* 366 (1966).

should not alone divest protection.⁸⁸ In addition, the commentator argued that free speech would be encouraged, since the speaker would know his words could not be misappropriated by another.⁸⁹ Furthermore, the writer argued that mere interaction between participants in a conversation should not negate the originality of a speaker's words and deny him copyright protection.⁹⁰ Lastly, he reasoned that the fact Hemingway put the conversations in a coherent format should not divest Hemingway of protection since similar protection is given to letters. The fact that an author made substantial contributions to an appropriated work is no defense to a copyright infringement action.⁹¹

Upon receiving this case on appeal, the New York Court of Appeals differed in its approach to the problem from that of the lower courts, indicating that possibly the law review article had influenced them. Rather than hold that conversations could not be protected, Judge Fuld, speaking for the majority, chose instead to decide the case on a much narrower ground. The Court cited that due to the ease of recording conversations, courts should be wary of offhandedly excluding them from copyright protection.⁹² In addition, it found that the lower court had been overbroad in their statements concerning free speech and said:

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.⁹³

Not wanting to choose avenues for future decisions, Judge Fuld specifically avoided deciding whether oral conversation may ever effect common law copyright protection. He did, however, imply that if an author of a unique intellectual oral property specifically reserved his rights in his statements, protection could be extended.⁹⁴

Turning to the facts of the case at hand, the Court said Hemingway never suggested that he regarded his conversational remarks as literary

88. *Id.* at 367.

89. *Id.* at 367.

90. *Id.* at 368.

91. *Id.* at 367.

92. Hemingway, *supra* note 72 at 777.

93. *Id.* at 777.

94. *Id.* at 777.

property.⁹⁵ Further, the Court stated Hotchner wrote articles about Hemingway during Hemingway's life and he never objected.⁹⁶ From this Judge Fuld reasoned that even if oral conversations could be subject to common law copyright protection, it would be necessary for the speaker "to mark off the utterance in question from the ordinary stream of speech."⁹⁷ Moreover, the Court added that where evidence was lacking as to the speaker's intent, a presumption should arise that the speaker reserved none of his common law copyrights. Looking to facts of the Hemingway litigation, the Court concluded that since Hemingway indicated a willingness for Hotchner to draw freely from their conversations, no action for copyright infringement could be maintained.⁹⁸

Thus the Court of Appeals of New York backed away from the lower courts' sweeping holdings that oral conversations were outside the ambit of common law copyright protection. Instead it articulated an intent theory whereby it seemed possible that a speaker could effect copyright protection in his statements if he manifested his intention to the other participants.

3. The Lenny Bruce Litigation

Recently, two decisions regarding copyright protection for oral conversations have been decided in which the plaintiff prevailed. Both cases involved the life of Lenny Bruce. In *Marvin Worth Prod. v. Superior Films Corp.*,⁹⁹ the plaintiffs moved for an injunction restraining the defendants from releasing a film depicting the life of Lenny Bruce which infringed their copyrights. The copyrights covered two books by and about Lenny Bruce to which the plaintiff had received an assignment to produce a film concerning his life. Defendant, an associate of Bruce, also produced a film about his life despite being rebuffed in his attempts to receive permission to use material contained in the books.

As one of the defenses, the defendants argued that much of the material in which infringement was claimed emanated from conversations between Bruce and the defendants. Moreover, the defendants claimed that material was frequently exchanged between comedians and that Bruce did not care if his material was used. The Court, however, found the defendants' statements self-serving and pointed out

95. *Id.* at 778.

96. *Id.* at 774.

97. *Id.* at 778.

98. *Id.* at 779.

99. 319 F.Supp. 1269 (S.D.N.Y. 1970).

that no outside evidence had been submitted to support their claims. Furthermore, the Court added that the defendants made no claim that they took notes or recorded any of the conversations of Bruce. This fact clearly implied that the extensive use of conversational material was accomplished through appropriation of materials contained in the books. In deciding for the plaintiff on this issue, the Court said abandonment of copyright can not be effected by negative behavior.¹⁰⁰

In *Douglas International Corporation v. Baker*,¹⁰¹ the licensee of two copyrighted books concerning Bruce sought a preliminary injunction restraining the production of an alleged infringing play. In this case the defendants had hired for \$1200 an acquaintance of Bruce to devote three weeks in Jamaica to write a play about the late entertainer.¹⁰² When completed, the play contained numerous routines which were in the book. The Court granted the preliminary injunction.

Raised as a defense to the injunction was the claim that much of the material was taken from conversations and tape recordings between Bruce and the author of the infringing play. The Court found such allegations insufficient since the defendants had not specified which routine they had had access to without the books.¹⁰³

In the Bruce litigations the Courts were faced with a substantially different situation than in the Hemingway case. In the Lenny Bruce cases there was a writing in which the plaintiff had federal statutory copyright protection. Moreover, the defendants in both cases involving Bruce had made no record of the conversations they claimed they had with Bruce. Therefore, when the infringing movie and play substantially reproduced the conversations contained in the books, the conclusion was inescapable that the defendants had merely appropriated the copyrighted material for their own use. In deciding the conversation issue, neither court cited the Hemingway presumption that a speaker is presumed not to reserve his copyright protection in his spontaneous utterances. Instead, the Court, in *Marvin Worth Productions*, said a speaker would have to positively abandon his rights in order to lose protection.¹⁰⁴

4. Commercial Use Of Taped Interviews With Celebrities

Two conflicting cases involving the commercial exploitation of tape interviews with nationally known celebrities have been decided in New

100. *Id.* at 1273.

101. 335 F.Supp. 282 (S.D.N.Y. 1971).

102. *Id.* at 285.

103. *Id.* at 285.

104. *Marvin Worth*, *supra* note 99 at 1273.

York lower courts. In *Lennon v. Pulsebeat News Inc.*,¹⁰⁵ the Beatles sought a temporary injunction restraining the defendants from commercially distributing taped interviews given by them. The defendants argued that the interviews "were furnished as news for immediate purpose of publicity" and therefore dissemination was constitutionally protected. In a short opinion, this defense was rejected, and the injunction was granted. The Court pointed out "that while it is true that there is no bar to the reporting of news events, there can be no justification for utilizing for profit, without plaintiff's permission, their distinctive manner of speech and expression which for reasons not material herein have become valuable property."¹⁰⁶

Most recently, Judge Frank of the Supreme Court of New York was faced with a declaratory judgment action involving a press conference held by Elvis Presley. In *Current Audio Inc. v. RCA Corp.*,¹⁰⁷ the plaintiff planned to market a mixed media "magazine" which included a phonographic recording of a Presley news conference. Relying on two theories, the defendant RCA sought to prevent the distribution of the record. RCA first argued that New York law recognized "one who performs a musical or dramatic composition has a property right in the oratory or artistic performance which is distinct from the copyright of the speech, music or literature itself."¹⁰⁸ The Court rejected the applicability of this theory on several grounds. First, it said that a taped oral interview could not be construed as a "performance" of a singer since it would be outside of his "form of art expression." Next, Judge Frank pointed out that Presley's comments were newsworthy and hence could not be constitutionally restrained. Furthermore, the Court claimed that the huge size of the audience published the interview, and thus protection was lost. Finally, since the interview could not be considered a performance by Presley, Judge Frank said that it fell outside of the exclusive recordings contract which Presley had with RCA.

RCA's second theory of relief was predicated on the doctrine of the right of publicity. It argued that the "pecuniary value" which attached to the name of Elvis Presley had been appropriated by the defendants for purely commercial purposes. The Court rejected this argument, saying that the doctrine of right of publicity could not apply where the material used was newsworthy. Judge Frank further reiterated his statement that the interview could not constitutionally be restrained

105. 143 USPQ 309 (N.Y. Sup. Ct. 1964).

106. *Id.* at 309.

107. 337 N.Y.S.2d 949, 176 USPQ 271 (N.Y. Sup. Ct. 1972).

108. *Id.* at 952. Although not designated as such in the opinion, this theory is commonly referred to as the doctrine of neighboring rights.

due to the public interest in the content of the interview. He reasoned that while the First Amendment had originally been limited to the printed word, the ambit of protection had been enlarged to cover "whatever new media have emerged." Under today's standard Judge Frank said the "talking magazine" was "entitled to broad protection and its right to freely communicate the newsworthy must supersede any private pecuniary considerations."¹⁰⁹

In reviewing both the *Beatles* and *Presley* decisions, it is revealed that neither case relied on copyright law. This omission would appear to be correct, since neither the Beatles nor Presley were seeking to protect their expressions. On the contrary, since the usual motivation for a celebrity to grant an interview is the desire for publicity, it would seem that both the Beatles and Presley would want as wide a dissemination of their comments as possible. What these celebrities did not want was the commercial exploitation of their voice and style without any pecuniary benefit accruing to themselves. In comparing the *Beatles* and *Presley* decisions, what accounts for the striking difference in results appears to be the judge's impression of the newsworthiness of the interview. If the interview is viewed as "news," it becomes constitutionally protected under the First Amendment. However, if distribution of the interview is viewed merely as the commercial exploitation of the celebrity's name and style, such a distribution would not be constitutionally protected under the First Amendment. However, if distribution of the interview is viewed merely as the commercial exploitation of the celebrity's name and style, such a distribution would not be constitutionally protected and probably would be enjoined as a violation of the celebrity's right of publicity.

B. *An Analysis — Copyright, Free Speech And The Public Interest.*

Undoubtedly, the most difficult issue in the area of protection for spontaneous utterances is the free speech issue. Clearly, the principle of free speech, as embodied by the First and Fourteenth Amendments, is one of the inherent rights of the American people. Many commentators have maintained that the primary importance of the free speech right is not as an individual right to speak but rather a public right to listen.¹¹⁰ When viewed from this perspective, it becomes apparent that the public may pay a price for giving an author copyright protection. Every time a defendant is enjoined from vending or performing a work

109. *Id.* at 955-56.

110. P. GOLDSTEIN, COPYRIGHT AND THE FIRST AMENDMENT, 70 COL. L. REV. 893, 988-89 (1970).

due to copyright infringement, the public loses access to a possibly valuable work.

The principles of copyright, however, are also firmly entrenched in the Constitutional fabric of America through Article I Section 8. Again, the framers of the Constitution intended that the primary beneficiary of the Copyright clause was to be the public rather than the individual author.¹¹¹ It was reasoned that encouraging authorship through copyright protection would advance the public welfare by increasing the quality and quantity of works at the disposal of the public. Thus, while the copyright and free speech principles appear to be conflicting in some cases, both theories were designed to effect the same end — encourage public access to information and intellectual works. With this in mind, cases which seem to involve a conflict between copyright and free speech should be resolved in a manner which will maximize the quality and quantity of material available to the public.

In reconciling copyright and free speech doctrines in cases involving spontaneous utterances, several factors seem to play a part. In order to discuss the elements which may affect a court's decision, this section will discuss the following factors separately — finality of the speaker's form, whether the speaker is an interested party in the litigation, quality of the infringer's authorship, and the interview situation.

1. Finality of Form.

Perhaps the most significant factor in determining the extent of protection an oral expression will receive is the finality of form. In *Hemingway*, the material in which protection was sought consisted of disconnected thoughts which were clearly not a completed work. Thus, without Hotchner's book to serve as a vehicle for Hemingway's utterances, his statements would have been lost forever. Therefore, in cases where it appears that the plaintiff would never have reduced his utterances into a work which would be disseminated to the public, the courts will hesitate to find infringement.

An entirely different situation was presented in the *Lenny Bruce* cases, since Bruce's routines had been finalized in two forms. First, his routines were performed, and then they were included in two popular books. Since these routes were clearly available to the public, the Court was not hesitant in enjoining production of an infringing work.

111. Mazer, *supra* note 21.

2. Whether The Speaker Is An Interested Party In The Litigation.

In *Harris v. Miller* the speaker (Oscar Wilde) was not an interested party. Rather, the litigation involved the recorder of Wilde's statements versus an infringing playwright. In situations such as these the decision of the Court should protect the recorder. The public already has access to the quotations through the recorder's efforts and therefore will not be injured by enjoining an infringing work from using such quotes. By encouraging biographical works which use a conversational format, the public should be benefited by an increase of such works.

Another consideration which may arise in these cases is whether quotations truly represent an appropriation of another's expression or whether they are merely a literary technique of the author. This factor was significant in *Harris v. Miller*, where the Court said a reconstruction of conversations was enough to give the recorder copyright protection.

3. Quality of Defendant's Authorship.

Because of the danger of denying public access to a significant work, the courts are undoubtedly influenced by the quality of the defendant's authorship. Technically, this should not be a consideration, since substantial original additions to an appropriated work do not serve as a defense to copyright infringement. As a practical matter, however, the courts do take the quality of authorship into consideration. Thus the lower courts in the Hemingway litigation stressed Hotchner's ability to organize the material into a readable book. Moreover, the appellate court chose to characterize Hotchner's book as a "serious and revealing biographical portrait of the world-renowned writer."¹¹²

On the other hand, in deciding whether the defendant's play about Bruce infringed the plaintiff's copyrights, the Court pointed out that it was written in three weeks in Jamaica, hardly a lengthy exercise in authorship.¹¹³

4. Unauthorized Use Of An Interview.

A unique situation is presented in cases involving unauthorized use of a news interview given by a celebrity. Copyright principles are not directly applicable in these cases, since the celebrity wants his comments quoted as widely and as frequently as possible. These cases arise where the celebrity's name and style are appropriated through the distribution of an unauthorized sound recording; thus the applicable principle seems to be the celebrity's right of publicity.

112. Hemingway, *supra* note 72 at 774.

113. Douglas International Corp., *supra* note 101 at 285.

Along with the diminutive role of copyright in these cases, the principles of free speech also seem to have a limited applicability despite the great emphasis Judge Frank gave it in the *Presley* case. Clearly a news conference is given with the view that the celebrity's statements will be widely reported. Therefore, the public's right to listen is protected by a wide reporting of the news conference. However, when a sound recording of the interview is distributed, much more than just the celebrity's expression is being utilized. The material which gives such a work value is the celebrity's name and style. Clearly a record of an unknown reading of the content of an Elvis Presley interview would never be distributed because it would never sell. Therefore, the *Presley* case would seem to involve the appropriation of the personality of Elvis Presley rather than factual reporting of an interview.

When considered from the point of view of the public's right to receive information the result in the *Presley* case would seem to be wrong. Due to the wide reporting of the Presley interview, the public already had access to the content of the interview without the record. By allowing appropriation of a celebrity's personality in the name of news reporting it is certain that fewer interviews will be granted by celebrities in the future. Therefore, in the long run, a decision like the one in *Presley* will tend to lessen rather than increase the total information available to the public.

V. THE PROTECTION OF PRIVACY THROUGH COMMON LAW COPYRIGHT.

It has often been articulated that an important function of common law copyright is to protect privacy. The primary authority for this proposition stems from the leading article of Warren and Brandeis on the right of privacy.¹¹⁴ This article traces the development of common law copyright protection in regard to personal letters and concludes by showing that a major consideration in these cases is protecting an author's personal right to privacy.

The principle which protects personal writings and all other personal productions in any form is in reality not the principle of private property, but that of an inviolate personality.¹¹⁵

While there are numerous common law copyright cases concerning personal letters which cite privacy as the major consideration, there is

114. 4 HARV. L. REV. 193 (1890).

115. *Id.* at 205.

no such case law in the area of common law copyright for conversations. Only the *Hemingway* case has dealt squarely with the issue of common law protection for conversations, and that case did not discuss the privacy issue. Since that Court was satisfied that Hemingway had, by his conduct, consented to the public disclosure of his conversations, the privacy issue was not relevant.

It is the position of this paper that common law copyright should not be used to protect the personal right of privacy. Instead, the tort of invasion of privacy should be the sole remedy to protect a person's right to be left alone.

For three reasons, utilizing common law copyright to protect privacy should be avoided. First, common law copyright protection is perpetual and will not end upon the death of the author.¹¹⁶ Thus while most actions for injuries to personality, such as slander, are ended at the death of the injured, common law copyright knows no such limits. As a result, access to creations protected under common law copyright could be denied the public for eternity. The potential damage which could be caused by such a result is obvious. An obscure relative of a deceased renowned personality could utilize this remedy to prevent public disclosure of a valuable work.

The second problem associated with using common law copyright to protect privacy is the fact that protection extends to only copyrightable expression. In some situations, a communication which could prove embarrassing if disclosed will consist of only a few words and should therefore fall outside the scope of copyright protection. Because of this limitation, common law copyright can not fully protect one's privacy from unwarranted disclosure.

The third problem in utilizing common law copyright to protect privacy is the fact that no distinction is made between a public figure and an average citizen. Thus a politician who makes a damaging statement could utilize common law copyright to prohibit public disclosure. This seems to be contrary to public policy as expressed in *Times v. Sullivan*.

Clearly the courts could develop mitigating doctrines to smooth some of the harsh results which a strict application of common law copyright could cause. However, such mitigating doctrines would also diminish the value of common law copyright to protect valuable copyrightable expression. As an alternative, the courts should consider pro-

116. NIMMER, *supra* note 11 at 10.

117. RESTATEMENT OF TORTS §652(b).

protecting private communications under tort law protecting privacy. The Restatement of Torts establishes a cause of action against:

One who intentionally intrudes, physically or otherwise upon the solitude or seclusion of another, or his private affairs or concerns, is subject to liability to the other for invasion of his privacy, if the intrusion would be highly offensive to a reasonable man.

By using this remedy to protect privacy, the bad effects of the common law copyright remedy are eliminated. The action would be limited to injuries sustained during the creator's life, thereby eliminating the problem of permanently rendering disclosure impossible. The action would not be limited to protection for copyrightable authorship. Finally, adjustments could be made in the case of a public figure, since the test is a reasonable man approach rather than a copyrightable expression test.

VI. IMPACT OF THE REVISION BILL ON COPYRIGHT OF ORAL WORKS.

Presently before Congress is a copyright revision which, if passed, would greatly alter the scheme of copyright protection. Section 102 would establish the subject matter of federal copyright protection as "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device."¹¹⁸ By using the phrase "original works of authorship" rather than "all the writings of an author" which is in the present Act, the draftsmen of the revision bill are seeking to avoid exhausting the constitutional power of Congress to legislate in the field. The recent history of copyright showed an expansion of the types of works needing protection due to increased technology. For this reason it was deemed advisable not to use the full extent of Congressional power under the Constitution so copyright protection could be extended to new forms of authorship which might later be developed.

An additional departure from the present scheme of copyright protection would be accomplished by Section 301 of the bill. This section provides for federal pre-emption of all rights which an author may secure in works copyrightable under Sections 102 and 103 of the bill. Thus the dichotomy between published and unpublished would be largely broken down by this section. With only one exception, an author would have to bring his work within the purview of federal

118. S. 644, 92nd Congress.

statutory protection in order to receive copyright protection. The exception would rest in works not reduced to a writing. In these limited situations, the states would be allowed to extend common law copyright protection if they chose.

The House report which accompanied the bill asserted four advantages to federal pre-emption of rights concerning copyrightable writings.¹¹⁹ First, it would promote "national uniformity" and avoid the pitfalls "of determining and enforcing an author's rights under the differing laws in the separate courts of the various states." Second, the significance of the "artificial and obscure" concept of publication is greatly diminished. Third, the limited times provision of Article I Section 8 would be better implemented, since the perpetual common law would be abolished in favor of the statutory term of years. Fourth, the elimination of a dual system of copyright protection would improve our international copyright relations, since the United States is presently the only country with such a system.

The elimination of the dual system would not greatly affect the oral works which can already be registered under the present statute, such as dramas, lectures, and published sound recordings. A great change in protection, however, is effected in spontaneous utterances which are recorded. In these cases, the creator would have to utilize federal statutory law to receive any protection for his conversations.

In cases in which copyright protection for conversations is sought under the revision bill, a problem could arise where an author is not in possession of a copy of his oral work and therefore is unable to meet the deposit requirements of the Copyright Office. This situation could arise where an author's spontaneous utterances are taped without his knowledge. Should these cases occur, the courts could provide an equitable remedy whereby a plaintiff author would be given access to the defendant's tape for the purpose of making a copy to comply with the deposit requirement of the Copyright Office.

The change which the revision bill would effect in the area of copyright protection for conversations would be advantageous to authors, the potential users of conversational material, and the public. Under the federal system of registration of a claim to copyright, an author would have better supporting evidence of the copyrightable material and of his intent to "mark off the utterance in question from the ordinary stream of speech." In order to meet the deposit requirements of the Copyright Office, the author would take care his utterances were recorded in a tangible medium of expression. Moreover, with federal

119. House of Representatives Report no. 83, 90th Congress.

registration looming in the near future, an author would be much more likely to communicate to others his intention to claim copyright in his utterances. Finally, the fact that he has bothered to register his claim with the Copyright Office would serve as evidence of his intention to copyright his conversational material.

A potential user of conversational material would be benefited by having a record available at the Copyright Office of the utterances in which copyright had been reserved. In addition, the user would be less susceptible to infringement suits brought as harassing action by speakers who never intended to claim copyright at the time of their utterances. This would be due to the fact that a creator would have to take steps before speaking to see that there is a recording of his utterances to meet the deposit requirements of the statute.

Besides benefiting both the author and the potential user, the public would also receive an advantage. Instead of perpetually denying the public access to unpublished works, as would the common law, under the revision bill, protection would be limited to the statutory term. Therefore, the public would never be permanently denied access to a potentially valuable work.

Considering the forementioned advantages of the revision bill, it would seem that passage of the bill would greatly stabilize copyright law in the area of spontaneous utterances. Unfortunately, passage of the bill is presently jeopardized by the unresolved copyright problems concerning cable television. Hopefully these problems will soon be resolved so a clearly better system of protection may be enacted.

252. STATUTORY COPYRIGHT — A VALUABLE RIGHT FOR THE VISUAL ARTIST.*

By THOMAS KENNERLY CARROLL, JR.**

I. INTRODUCTION

In the United States visual artists¹ are not receiving remuneration commensurate with the eventual economic value of their work.² The reason for this disparity is that artists generally sell their work at a relatively low price without reserving adequate rights to participate in any subsequent proceeds derived from their work. This Note addresses this problem of inadequate compensation and suggests that an artist, to reap maximum financial benefits under existing law, should obtain statutory copyright on his work and then enforce this right aggressively. First, the rights an artist may possess in his work without securing statutory copyright together with the procedures for securing those rights are examined; then the statutory copyright and procedures for obtaining it are considered; and finally the desirability of forming a national organization capable of enforcing artists' rights is discussed.

Many commentators have advocated the passage of a statutory *droit de suite* or "art proceeds right" in this country as the most effective way

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** Mr. Carroll was Editor-in-Chief of the *Georgia Law Review*.

1. "Visual artists," as the term is used in this Note, refers only to painters and sculptors.
2. Recently a museum reproduced a popular painting from its collection as a Christmas card. The artist was paid no royalties from the sale of the cards, and, indeed, he was required to pay the full price to purchase some of them. Nathan, *Rights and Permissions*, PUBLISHERS WEEKLY, Oct. 20, 1969, at 56.

The largest reproduction house in the nation, the New York Graphic Society, Ltd., pays the artist, if he owns the painting reproduced, a royalty of 1.7 percent of the proceeds from the reproduction. If a museum or private collector owns the painting, the artist usually gets nothing. B. CHAMBERLAIN, *THE ARTIST'S GUIDE TO HIS MARKET* 64 (1970) [hereinafter cited as CHAMBERLAIN] [Ms. Chamberlain's book has been the primary source of information on the current practices of visual artists and has been invaluable in the preparation of this Note]. In Los Angeles one dealer, who retains the reproduction rights in works sold by his gallery, has often recalled the painting, had it photographed and then sold the prints to interior decorators without allowing the artist to participate in the proceeds. Price, *Government Policy and Economic Security for Artists: The Case of the Droit de Suite*, 77 YALE L.J. 1333, 1358 n.62 (1968).

to alleviate the depressed financial condition of artists.³ Simply stated, this right would entitle an artist or his heir to receive payment each time his art work is resold.⁴ The rationale underlying this argument is that an artist's creation generally is not nearly as valuable when he originally sells it, before his reputation is established, as it is after he has been recognized. Thus, an artist who wishes to receive fair compensation for his work must participate in this increase in the value of his art. However, one commentator⁵ doubts that American artists would receive substantial economic benefits from a *droit de suite* because of the infrequent resale of art in the United States.⁶ In any event the present Copyright Act⁷ and the proposed revision⁸ does not contain an art proceeds right.

However, alternative means of protection are available. Today with the improved techniques of copying, substantial proceeds may be derived from selling copies of art works and from exhibiting them.⁹ Artists may share in these proceeds under existing law by three ways: (1) common law copyright,¹⁰ (2) contractual rights¹¹ and (3) statutory copyright.¹² Moreover, a contractual right to proceeds on resale may be possible.

3. E.g., Hauser, *The French Droit de Suite: The Problem of Protection for the Underprivileged Artist under the Copyright Law*, in 11 ASCAP COPYRIGHT LAW SYMPOSIUM 1 (1959); Schulder, *Art Proceeds Act: A Study of the Droit de Suite and a Proposed Enactment for the United States*, 61 Nw. U.L. REV. 19 (1966) (contains a proposed art proceeds act); Sherman, *Incorporation of the Droit de Suite into United States Copyright Law*, in 18 ASCAP COPYRIGHT LAW SYMPOSIUM 50 (1968). The right was first conceived in France; but now many countries, including Belgium, Czechoslovakia, Poland, Uruguay and West Germany have enacted an art proceeds right. See Sherman, *supra*, at 50-56.

4. In France the artist receives a percentage of the resale price regardless of whether or not the work has increased in value. On the other hand, in Czechoslovakia, Poland, Uruguay and Italy the artist receives only a percentage of the increase in value. See Sherman, *supra* note 3, at 51, 54-56.

5. Price, *supra* note 2.

6. *Id.* at 1348-52. Price, himself, is somewhat skeptical of the accuracy of his data. *Id.* at 1349.

7. 17 U.S.C. §§ 1 *et seq.* (1970).

8. S. 644, 92d Cong., 1st Sess. (1971).

9. See Price, *supra* note 2, at 1344-46; cf. CHAMBERLAIN at 63-65. Price suggests that the market for works of art approximates that for limited edition books. Price, *supra* at 1346. The examples given in note 2, *supra* show that some museums, reproduction houses and dealers consider the reproduction rights valuable.

10. See pp. 136-42 *infra*.

11. See pp. 142-46 *infra*.

12. See pp. 146-50 *infra*.

II. RIGHTS AN ARTIST MAY POSSESS WITHOUT SECURING STATUTORY COPYRIGHT

In the absence of statutory copyright, an artist may have similar legal rights in his work from either of two sources — common law copyright or contract. However, in actual practice few artists are protected by either of these sources. Most artists initially have a common law copyright in their creation,¹³ but it is often lost by publication prior to the sale of the work;¹⁴ and few artists obtain contractual rights because of their inferior bargaining position with respect to art collectors and dealers.¹⁵

A. Common Law Copyright

By virtue of section 2 of the Copyright Act,¹⁶ the United States has a dual system of copyright — common law and statutory.¹⁷ Common law copyright is the right of first publication.¹⁸ The owner of this right may prevent an unpublished work of art from being made available to the general public either by distribution of copies or by exhibition since either one may result in a publication of the work.¹⁹ Moreover, common law copyright is independent of the object itself; and thus, may be retained although the object is sold.²⁰ Since many people and institutions are willing to pay artists for the right to distribute copies of a work of art²¹ or to exhibit to the general public,²² this is a valuable right. However, with the common law copyright an artist may have an opportunity to reap monetary reward only once — when he sells his consent to publication; for after publication the common law copyright is

13. However, if an artist is hired to create a work of art, then the person hiring the artist owns the copyright instead of the artist. See 1 M. NIMMER, NIMMER ON COPYRIGHT § 62.2 (1972) [hereinafter cited as NIMMER].

14. See pp. 137-41 *infra*.

15. See text accompanying notes 97 & 98 *infra*.

16. 17 U.S.C. § 2 (1970).

17. The dual system of copyright has been abolished in England. 1&2 Geo. 5, c.46, § 31 (1911). The proposed revision bill would also abolish it in this country. S. 644, 92d Cong., 1st Sess. § 301 (1971).

18. *E.g.*, *Werckmeister v. American Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904); *Chamberlain v. Feldman*, 300 N.Y. 135, 89 N.E.2d 863 (1949).

19. See subsection 1 *infra*.

20. *Stevens v. Gladding*, 58 U.S. (17 How.) 447 (1854).

21. See note 9 *supra*.

22. *Cf.* CHAMBERLAIN at 108. See also Jonakait, *Do Art Exhibitions Destroy Common-law Copyright in Works of Art?*, in 19 ASCAP COPYRIGHT LAW SYMPOSIUM 108 (1971).

extinguished.²³ On the other hand, if there is no publication, this right will extend indefinitely. For this reason it has been suggested that an artist could charge admission to an exhibition of his work under conditions not amounting to a publication and be protected from copying indefinitely.²⁴

The primary disadvantage of common law copyright is that an artist may lose it inadvertently²⁵ without ever obtaining any valuable consideration for it. This occurs when there is a general publication²⁶ or a sale of the work of art without reserving the copyright.²⁷

1. *Publication.*²⁸ — The occurrence of a general publication of a copyrightable work is an important time, for at that instant, theoretically,²⁹ the artist is divested of his common law copyright;³⁰ and if a notice of copyright is affixed to the work, he is invested with statutory copyright.³¹ However, if the work is generally published without a notice of copyright, then it will enter the public domain,³² and the artist cannot prevent others from copying the work.³³

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23. *E.g.*, *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908); *Public Affairs Associates, Inc. v. Rickover*, 284 F.2d 262 (D.C. Cir. 1960), *vacated*, 369 U.S. 111 (1962); *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952).
24. *Jonakait*, *supra* note 22, at 110. But an exhibition for money may be a publication. *See Letter Edged in Black Press v. Public Building Comm'n*, 168 U.S.P.Q. 559, 563 (N.D. Ill. 1970) (implication that an artist must use his work only for his own pleasure to enjoy the common law copyright).
25. The prevailing rule is that publication may occur regardless of intent. *E.g.*, *White v. Kimmell*, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952); *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *see* 1 NIMMER § 58.3.
26. *See* subsection 1 *infra*.
27. *See* subsection 2 *infra*.
28. For a more complete discussion of the concept of publication, *see* 1 NIMMER §§ 46-59.
29. In actual practice the courts have a proclivity to protect the artist, and may require more publication to divest an artist of his common law copyright protection when the publication would not also invest him with statutory copyright protection. *Hirshon v. United Artists Corp.*, 243 F.2d 640 (D.C. Cir. 1957); *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956).
30. *E.g.*, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834); *White v. Kimmell*, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952).
31. 17 U.S.C. § 10 (1970).
32. *DeJonge & Co. v. Breuker & Kessler Co.*, 235 U.S. 33 (1914); *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951).
33. *Press Publishing Co. v. Atlantic County Advertiser, Inc.*, 59 N.J. 356, 283 A.2d 102 (1971).

For a publication to be general and precipitate the legal consequences discussed above, the work must be made available to the general public.³⁴ If the work is made available only to a select group for a limited purpose, the publication is said to be limited and the common law copyright is extant.³⁵ A general publication of a work of art may conceivably occur in two ways:³⁶ (1) by distribution of copies of the work, or (2) by exhibition of the work.

(a) *Publication by distribution of copies.* — The Copyright Act does not directly define the word “publication,” but it does refer to “the date of publication” as “the earliest date when copies of the first authorized edition were placed on sale, sold or publicly distributed by the proprietor of the copyright”³⁷ Thus, it is said that “the public distribution of copies is the prototype of publication.”³⁸ Moreover, in *Grandma Moses Properties, Inc. v. This Week Magazine*,³⁹ the distribution of only one copy of a painting was held to constitute a publication. In that case the dispute arose over a painting entitled “Over the River to Grandma’s House.” Grandma Moses later completed another painting with the same title which she claimed was a copy of the first. The second painting was sold and eventually became the property of *This Week Magazine* which offered reproductions of the work to its readers for a low price. After the sale of the second painting, statutory copyright of the first painting was obtained, and the assignee of this copyright subsequently sought a preliminary injunction to restrain *This Week Magazine* from distributing reproductions of the second painting. In denying the preliminary injunction, the court held that the unrestricted sale of the copy of the original painting was a publication; and therefore, since it was

34. *White v. Kimmell*, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952); *see* 1 NIMMER § 49, at 194-95. The following definition is typical:

A general publication consists in such a disclosure, communication, circulation, exhibition, or distribution of the subject of copyright, tendered or given to one or more members of the general public, as implies an abandonment of the right of copyright or its dedication to the public.

Werckmeister v. American Lithographic Co., 134 F. 321, 326 (2d Cir. 1904).

35. *E.g.*, *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226 (2d Cir. 1972); *Schellberg v. Empringham*, 36 F.2d 991 (S.D.N.Y. 1929); *see* 1 NIMMER § 58.

36. Sale of the original work of art probably does not amount to a publication. *See* note 63 *infra*.

37. 17 U.S.C. § 26 (1970).

38. A. LATMAN, *HOWELL’S COPYRIGHT LAW* 63 (4th ed. rev. 1962) [hereinafter cited as *HOWELL’S COPYRIGHT LAW*].

39. 117 F. Supp. 348 (S.D.N.Y. 1953).

without notice of copyright, the subsequent attempt to secure a statutory copyright on the original was a nullity.⁴⁰

There is no general publication if the copies are distributed for a limited purpose to a select group upon the condition that the copies are not to be made available to people outside the group,⁴¹ but if the distribution is not so restricted then a general publication will occur.⁴² For this reason, artists must exercise care when allowing a gallery to distribute copies of their work to potential customers. Most galleries operate on a commission basis⁴³ and are understandably eager to generate sales. A successful dealer will make every effort to publicize an artist and his paintings by allowing reproductions of the art without charge in art columns, catalogs, journals, and books⁴⁴ and by distributing copies of a work to the press and general public.⁴⁵ Generally, no effort is made by the dealer or artist to limit the distribution of these copies to a select group. Indeed, they want the copies to be distributed as widely as possible, for this increases the likelihood of selling the artist's work. Accordingly, an artist who allows copies of his work to be distributed in this manner probably has lost his common law copyright.

(b) *Publication by exhibition.*⁴⁶ — It could be argued that the technical language of the statute precludes publication by exhibition.⁴⁷ But the touchstone for publication in this context should be the "availability

40. *Id.* at 351.

41. See cases cited note 35 *supra*.

42. *Continental Casualty Co. v. Beardsley*, 253 F.2d 702 (2d Cir. 1958); *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956).

43. Most galleries charge 40 percent and a few still charge 33 $\frac{1}{3}$ percent. CHAMBERLAIN at 44.

44. *Id.* at 65.

45. *Id.* at 77, 80-1.

46. See Jonakait, *supra* note 22, at 81, for an exhaustive and careful analysis of the case law concerning publication by exhibition.

47. The Copyright Act defines the "date of publication" as "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright . . ." 17 U.S.C. § 26 (1970). This definition does not mention publication by exhibition because the term publication was first used when the act protected only literary works which were normally published by copies being sold or distributed. See Act of May 31, 1790, ch. 15, 1 Stat. 124. When paintings were given copyright protection in 1870 the literal statutory definition of "date of publication" remained unchanged. See Act of July 8, 1870, ch. 230, 16 Stat. 198.

of copying";⁴⁸ and consequently, the reported federal cases⁴⁹ establish the rule that an exhibition in which copying by the general public is permitted is a general publication.⁵⁰ If copying is not permitted, the exhibition has been held to be only a limited publication.⁵¹

The exhibition of a painting in a public gallery was held to be a general publication in *Pierce & Bushnell Manufacturing Co. v. Werckmeister*.⁵² In that case the First Circuit did not discuss the circumstances of the exhibition — specifically, it did not discuss whether or not copying was prohibited; but it simply held that this particular public exhibition equaled a general publication.⁵³ A more definite statement is contained in *Werckmeister v. American Lithographic Co.*⁵⁴ There the Second Circuit concluded that an exhibition of a painting in which there was an express rule against copying was only a limited publication.

48. HOWELL'S COPYRIGHT LAW at 66.

49. Federal cases have been specifically examined because if a state rule differs from the federal rule, the federal rule for publication should be used. As Nimmer has said:

[T]he determination of whether a work is published . . . is ultimately a question of federal law. Otherwise, a state could determine that a work is "unpublished" and therefore protected in perpetuity by common law even though the work has been disseminated in such manner that under the federal law the only available alternatives are a limited statutory term of protection or an immediate status in the public domain.

1 NIMMER § 59, at 230. Authority for this statement can be found in dicta in two patent infringement cases, *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). These cases stand for the proposition that because of the supremacy clause, state law may not prohibit copying whatever the federal patent or copyright laws have left in the public domain. *Id.* at 237; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. at 232-33.

However, the federal rule regarding publication by exhibition is probably the same as the common law rule. *Compare* *Turner v. Robinson*, 10 Ir. Ch. 121, *aff'd*, 10 Ir. Ch. 510 (App. 1860), *with* *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907).

50. *Pierce & Bushnell Mfg. Co. v. Werckmeister*, 72 F. 54 (1st Cir. 1896); *cf.* *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907).
51. *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Werckmeister v. American Lithographic Co.*, 134 F. 321 (2d Cir. 1904).
52. 72 F. 54 (1st Cir. 1896).
53. An Illinois appellate court has also held that exhibition of a painting to the general public amounts to a general publication. *Morton v. Raphael*, 334 Ill. App. 399, 79 N.E.2d 522 (1948).
54. 134 F. 321 (2d Cir. 1904).

The Supreme Court in *American Tobacco Co. v. Werckmeister*⁵⁵ concurred with the holding in *American Lithographic Co.* and also strongly implied that if copying was not expressly prohibited, then a public exhibition would amount to a general publication. In that case Werckmeister allegedly owned the copyright in a painting entitled "Chorus" which depicted "a company of gentlemen with filled glasses, singing in chorus,"⁵⁶ and he sued the American Tobacco Company to recover copies of this painting which allegedly infringed his copyright. One defense raised by the American Tobacco Company was that the exhibition of the painting in the Royal Gallery without notice of copyright was a "publication" that prevented subsequent statutory copyright protection of the painting. The Court held that the exhibition was not a general publication that would deprive the copyright owner of statutory protection since (1) the painting was expressly entered at the gallery with copyright reserved; (2) there were gallery rules against copying; and (3) officers were present to rigidly enforce these rules. The Court implied that if these factors were not present a general publication may occur:

We do not mean to say that the public exhibition of a painting or statue, where all might see and freely copy it, might not amount to publication within the statute, regardless of the artist's purpose or notice of reservation of rights which he takes no measure to protect. But such is not the present case, where the greatest care was taken to prevent copying.⁵⁷

A lower federal court has discussed this dictum and also implied that an exhibition may be a general publication. In *Letter Edged in Black Press v. Public Building Commission*,⁵⁸ an exhibition of the "Chicago Picasso" maquette was held to be a general publication, and a subsequent attempt to obtain statutory copyright protection for the monumental sculpture was declared invalid. The defendant argued that the exhibition was a limited publication and relied on *American Tobacco Co.* for authority. The court quoted the above dictum from *American Tobacco Co.*, and said that the exhibition of the maquette "more closely resembles the situation postulated in the aforementioned dicta than it does the actual facts of the *American Tobacco* case."⁵⁹ Specifically, at the exhibition

55. 207 U.S. 284 (1907).

56. *Id.* at 285.

57. *Id.* at 300.

58. 168 U.S.P.Q. 559 (N.D. Ill. 1970).

59. *Id.* at 564.

there were no restrictions on copying and no guards to prevent copying. Also, as a final distinction the court pointed out that uncopyrighted pictures of the maquette were made available to the general public upon request. This last fact may have been sufficient in itself to constitute a general publication,⁶⁰ but the court probably would have held the exhibition to be a general publication without it.⁶¹

From the above cases, it is clear that an artist who allows his work to be exhibited in a gallery which has no rules against copying has lost his common law copyright. Even if the artist exhibits in a gallery which restricts copying, it may be necessary for the gallery to strictly enforce its rules against copying in light of the emphasis the Supreme Court in *American Tobacco Co.* placed upon the fact that security officers were present to enforce strictly the no-copying rules.

2. *Sale of the original work of art.*—Even if the artist retains his common law copyright prior to the sale of his work, the sale itself may operate to divest him of it.⁶² This divestment occurs not because the sale is a publication⁶³ but rather because the sale may be deemed to transfer the common law copyright.

60. See note 42 and accompanying text *supra*.

61. The court made the statement that "the display of the maquette constituted general publication," and cited *Morton v. Raphael*, 334 Ill. App. 399, 79 N.E.2d 522 (1948), as its authority. 168 U.S.P.Q. at 564 & n.23 (N.D. Ill. 1970). From the opinion of *Morton v. Raphael* it does not appear that the painter had distributed copies of her murals, and only the unrestricted exhibitions of the murals were sufficient to constitute a general publication.

62. *Pushman v. New York Graphic Soc'y*, 287 N.Y. 302, 39 N.E.2d 249 (1942).

63. One commentator has suggested that the sale of an original work of art is a publication. "[T]he unrestricted sale or other public disposition of a work of art, or of a tangible copy thereof, results in its publication." 1 NIMMER § 54, at 212. This statement is qualified in a footnote to the effect that if the sale of a work of art is not preceded by a general offer of sale to the general public then it is not a general publication. *Id.* at 212 n.143. If the sale is preceded by a general offer to the public, the publication has probably occurred during this general offer and before the sale. Cf. *Pierce & Bushnell Mfg. Co. v. Werckmeister*, 72 F. 54 (1st Cir. 1896).

The case authority cited for the above statement that the sale of the original work of art results in publication is *Pushman v. New York Graphic Soc'y*, 25 N.Y.S.2d 32 (Sup. Ct. 1941), *aff'd*, 287 N.Y. 302, 39 N.E. 2d 249 (1942). But in *Pushman* the court was not only influenced by the sale but also by the fact that after the sale the painting was "displayed for a long period of time" in a public institution. *Id.* at 34. The court did not say whether it was the sale or the public display that constituted the publication. Analytically, it could have been that the common law copyright was transferred with the painting upon its sale, and the subse-

Whether or not the common law copyright passes on the sale of a painting involves the application of contract principles which must be derived from a state's case law in the absence of any statutory law. As a general rule, American case law creates a presumption that a sale of a work of art without an express reservation carries with it the common law copyright unless there is evidence of a contrary intent.⁶⁴ However, this rule has limited effect as a practical matter because most artists write "all reproduction rights reserved" on the bill of sale and on the back of their painting.⁶⁵ Certainly this inscription would be sufficient indication of an intent to reserve the common law copyright. Perhaps, if the reservation is oral or on the back of the painting and the sales agreement concerning the work itself is in writing, it could be argued that the parol evidence rule will not allow extrinsic evidence of the reservation. This argument would probably not prevail since a writing which pro-

quent display was the publication. The court of appeals affirmed the lower court's decision because it held that upon the sale the common law copyright passed to the buyer. It did not enter into a separate discussion on whether or not the work had been published; but in stating the lower court's holding it emphasized both "the sale *and* the public exhibition." *Pushman v. New York Graphic Soc'y*, 287 N.Y. 302, 308, 39 N.E.2d 249, 251 (1942) [the emphasis is the court's].

In the few cases that have discussed the issue it appears that the federal rule is that an unconditional sale of an original work is not a publication. *Parton v. Prang*, 18 F. Cas. 1273 (No. 10,784) (C.C.D. Mass. 1872); *cf. Werckmeister v. Springer Lithographing Co.*, 63 F. 808 (C.C. S.D.N.Y. 1894); *Pushman v. New York Graphic Soc'y*, 287 N.Y. 302, 39 N.E.2d 249 (1942).

This rule has its beginning in the English case of *Turner v. Robinson*, 10 Ir. Ch. 121, *aff'd*, 10 Ir. Ch. 510 (App. 1860). In that case the court said that the argument "that the sale [of a painting] by Wallis to Egg amounted to a publication, is destitute of all color of foundation." *Id.* at 143. The Turner rule was picked up in the United States in the case of *Parton v. Prang*, 18 F. Cas. 1273 (No. 10,784) (C.C. D. Mass. 1872). In *Parton* an artist's painting after several conveyances ended up in the hands of a publisher who intended to publish and sell chromolithographic copies of it. The artist's suit for an injunction to stop the publisher was denied, and the court said that the transfer of the painting, although unconditional and absolute, was not a publication. Instead, it said that this transfer passed the common law copyright to the buyer of the painting. *Id.* at 1278.

64. *E.g., Grandma Moses Properties, Inc. v. This Week Magazine*, 117 F. Supp. 348 (S.D.N.Y. 1953); *Pushman v. New York Graphic Soc'y*, 287 N.Y. 302, 39 N.E.2d 249 (1942). This rule has been persuasively criticized. Cohen, *An Artist Sells a Painting: The Courts Go Astray*, 5 U.C.L.A. L. Rev. 235 (1958).

65. CHAMBERLAIN at 63, 118.

vides for the transfer of the work of art itself but does not discuss the associated copyright could not be an exclusive statement of the complete agreement between the parties. Thus, the *Uniform Commercial Code* would allow an extrinsic agreement concerning the copyright to supplement such a writing.⁶⁶ In New York this argument is unnecessary since reproduction rights are reserved to artists by state statute.⁶⁷

B. Contract

Currently artists are being counseled to reserve rights in their work primarily by the use of a standard form contract.⁶⁸ The counseling includes little or no discussion of the simpler, and perhaps equally valuable, statutory copyright.⁶⁹ This disparity in emphasis can be explained by the fact that the standard form contract being circulated attempts to secure to the artist fifteen percent of the proceeds received by the seller upon each subsequent transfer or sale of the art work,⁷⁰ a right that is not included in the statutory copyright.⁷¹

The standard form contract being circulated among artists in New York was drafted by attorney Robert Projansky and is called the Artists' Reserved Rights Transfer and Sales Agreement.⁷² Under its terms the artist retains certain valuable rights in his work for his lifetime. Some of these rights pass to his surviving spouse; and after the death of both, the buyer continues to be bound by certain covenants for a period of 21 years.⁷³ The rights secured by the artist include: (1) 15 percent of the proceeds received on any subsequent transfer of the work;⁷⁴ (2) control of any public exhibition of the work including the right to prohibit the exhibition altogether;⁷⁵ (3) 50 percent of the proceeds received for any exhibition;⁷⁶ (4) the right to repossess for the purpose of a public ex-

66. UNIFORM COMMERCIAL CODE § 2-202(b).

67. N.Y. GEN. BUSINESS LAW art. 12-E, § 223-24 (McKinney 1968).

68. NEWSWEEK, March 29, 1971, at 65-67. The standard form contract currently being circulated is called the Artists' Reserved Rights Transfer and Sales Agreement. It was developed by Robert Projansky, an attorney, with the assistance of Seth Sieglaub, an art dealer. A copy of it is reproduced in STUDIO INTERNATIONAL, April 1971, at 186-88.

69. See note 132 *infra*.

70. Artists' Reserved Rights Transfer and Sales Agreement art. 2.

71. 17 U.S.C. §§ 1 *et seq.* (1970).

72. NEWSWEEK, March 29, 1971, at 65-67.

73. Artist's Reserved Rights Transfer and Sales Agreement art. 16.

74. *Id.* art. 2.

75. *Id.* art. 7.

76. *Id.* art. 11.

hibition by a public institution;⁷⁷ and (5) all reproduction rights.⁷⁸ In addition, the collector covenants not to destroy or modify the work of art.⁷⁹

Arguably, all of these rights, except the right to proceeds on resale and the right to repossess for a public exhibition at a public institution, are also included in the statutory copyright.⁸⁰ Since the right to repossess probably would not be very valuable, the significance of the Projansky-contract lies in its attempt to secure proceeds to the artist on each resale of his work.

The effectiveness of the Projansky-contract in securing these rights depends on whether or not it legally binds sub-purchasers to its terms. If sub-purchasers are not bound, the artist perhaps could sue the original purchaser for not requiring the sub-purchaser to complete the sub-contract; but the original purchaser may have disappeared. Also the relief available from him may be inadequate. For example, if an artist desires to enjoin a certain exhibition or reproduction of his work by a subsequent purchaser, he must look to the current owner, who is not a party to the contract; and the injunction will probably be denied.⁸¹

Binding a sub-purchaser to the terms of a contract of which he is not a party is no easy feat. Professor Chafee has described two methods by which attempts are made to bind sub-purchasers — the sub-contract device and the notice or equitable servitude device.⁸² Both of these devices are used in the Projansky-contract.

The sub-contract device is cleverly drafted, and if properly executed would probably bind the sub-purchaser since in effect the sub-contract is a new contract between the sub-purchaser and the artist. The sub-contract is in the form of a transfer agreement in which the sub-purchaser agrees to fulfill all of the covenants set forth in the original agreement.⁸³ Consideration to support these covenants flows from the original agreement in which the artist covenants to authenticate the art work to the sub-purchaser and also to provide him with a history of it.⁸⁴ However,

77. *Id.* art 8.

78. *Id.* art. 12.

79. *Id.* art. 9.

80. *See* pp. 146-50 *infra*.

81. *Cf.* *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908); *Independent News Co. v. Williams*, 293 F.2d 510 (3d Cir. 1961); *Burke & Van Huesen, Inc. v. Arrow Drug, Inc.*, 233 F. Supp. 881 (E.D. Pa. 1964). *But cf.* *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 A. 631 (1937).

82. Chafee, *Equitable Servitudes on Chattels*, 41 HARV. L. REV. 945 (1928).

83. STUDIO INTERNATIONAL, April 1971, at 188, contains a reproduction of this transfer agreement.

84. Artist's Reserved Rights Transfer and Sales Agreement art. 6.

execution of the transfer agreement depends upon the original purchaser, and if for some reason he does not insist upon it, the artist cannot use this device to hold the subpurchaser liable.⁸⁵

The Projansky-contract also attempts to create on the art object an equitable servitude which would reserve to the artist all of the rights that the transfer agreement attempts to reserve by contractual means.⁸⁶ The notice or equitable servitude device is a method by which the seller of a chattel places a notice of restrictions or servitudes on it in an attempt to bind all subsequent purchasers to the restrictions.⁸⁷ This method resembles restrictions placed on land recorded in a deed to which subsequent purchasers are bound. Accordingly, the Projansky-contract includes a form notice that is to be separated from the contract and attached to the painting. The notice states that the painting is subject to covenants set forth in an agreement on file at a designated place.⁸⁸

"[E]quitable servitudes on chattels seem a reasonable and flexible device which the courts might use when desirable."⁸⁹ In deciding whether or not an equitable servitude is desirable a court must balance the good to be derived from the servitude against the public policy of encouraging the unrestrained alienation and use of chattels.⁹⁰ More-

85. Chafee, *supra* note 82, at 952.

86. One commentator has suggested that equitable servitudes would be an excellent device with which to fill the "vacuum created by the inadequate protection afforded under the present Copyright Act . . ." Bertz, *Protecting Artistic Property with the Equitable Servitude Doctrine*, 46 MARQ. L. REV. 430, 450 (1963). Bertz in his article discussed several gaps in the Copyright Act that could be filled by the equitable servitude doctrine, but he never discussed the art proceeds right. *Id.* at 438-43.

87. Chafee, *supra* note 82, at 953-54.

88. See STUDIO INTERNATIONAL, April 1971, at 188, for a reproduction of this notice.

89. Chafee, *supra* note 82, at 1007.

90. *E.g.*, RCA Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940); Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 A. 631 (1937). See generally Bertz, *supra* note 86; Chafee, *The Music Goes Round and Round: Equitable Servitudes and Chattels*, 69 HARV. L. REV. 1250 (1956).

The *Waring* case is a good illustration of the kind of public policy analysis a court should use. In this case Fred Waring had affixed the notice "Not Licensed for Radio Broadcast" to the recordings of his orchestra, and the Supreme Court of Pennsylvania enforced this restriction as an equitable servitude. The court discussed earlier cases that had held equitable servitude unenforceable and said that in those cases the attempted restrictions were either in restraint of trade and against public policy or reserved rights that were protected by statutory copyright. Since

over, if a chattel is copyrightable, the courts must also consider whether or not the right reserved by the servitude is also available from statutory copyright.⁹¹ If it is, it should not be enforced because to do so would be an unwarranted circumvention of the Copyright Act.⁹²

A right to proceeds on resale is not within the protection of the Copyright Act;⁹³ and accordingly, whether or not the right to fifteen per-

the Copyright Act at that time did not give a recording artist the right to control the radio broadcast of his work, the court considered whether or not the restriction was an unreasonable restraint of trade. It decided that the restriction was good because it worked "for encouragement of art and artists" and was not unreasonable because it only limited the use of records for radio broadcasting and not "in private homes or even public halls." The court also drew a fine distinction and said that the restriction was on the privilege of playing the record and not on the sale of chattel-records themselves. This distinction, of course, is wrong since a restriction on playing a record could possibly hinder the sale of it. Thus the court in effect balanced the good to be derived from the servitude against the extent to which the servitude would "clog the free and untrammelled circulation of personal property." *Id.* at 446, 194 A. at 637. It struck the balance on the side of the artist, sustained the injunction and restrained the radio station from broadcasting Waring's records.

On the other hand, Judge L. Hand in *Whiteman*, held that the same notice on Paul Whiteman's records would not be enforceable. In so holding, Judge Hand paid extreme deference to the public policy of unrestricted alienation of chattels: "Restrictions upon the uses of chattels once absolutely sold are at least prima facie invalid; they must be justified for some exceptional reason, normally they are 'repugnant' to the transfer of title." 114 F.2d at 89. Although unexpressed, the inference is that the benefit artists would derive from the servitude was not an exceptional reason.

Many courts have summarily denied enforcement of notice restrictions without discussing the considerations of public policy. *E.g.*, *Independent News Co. v. Williams*, 293 F.2d 510 (3d Cir. 1961); *Burke & Van Huesen, Inc. v. Arrow Drug, Inc.*, 233 F. Supp. 881 (E.D. Pa. 1964); *cf.* *Pratte v. Balatsos*, 113 A.2d 492 (N.H. 1955), *criticized in Chafee, The Music Goes Round and Round: Equitable Servitudes and Chattels*, 69 HARV. L. REV. 1250 (1956).

91. See Bertz, *supra* note 86, at 437-38.

92. Under the rationale of *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), state law, such as the equitable servitude doctrine, may not reserve rights in chattels left in the public domain if the rights are included in the federal copyright. See note 49 *supra*. Therefore, the rights included in the Projansky-notice restriction that are within the federal copyright would not be enforced. These rights include the reproduction rights and arguably the right to control public exhibitions. See pp. 146-50 *infra*.

93. 17 U.S.C. §§ 1 *et seq.* (1970).

cent of the resale proceeds would be upheld would depend on how the court struck the balance. Of course the right to resale proceeds would benefit artists and encourage the arts;⁹⁴ but the servitude probably would be considered such an unreasonable restraint of trade that a court would not enforce it. First, its effect on the resale of the art work would be similar to the effect that price maintenance servitudes had on the resale of a manufacturer's product, and these price maintenance servitudes were uniformly held invalid until the passage of the fair trade laws.⁹⁵ Second, the servitude imposes an affirmative duty on the sub-purchaser to remit the proceeds, and affirmative servitudes would probably be considered more restrictive on alienability than passive servitudes such as price maintenance.⁹⁶

The Projansky-contract secures as many rights for the artist as is perhaps possible without obtaining statutory copyright. However, only a few artists are using these contracts.⁹⁷ One of the primary reasons for the lack of acceptance is that few artists are in a sufficient bargaining position to demand the contractual rights secured by the standard form contract currently being circulated. An artist seeking to establish a reputation is eager to sell his work and may reason that prospective buyers will be more inclined to deal with artists who do not demand that the Projansky-contract be followed. Perhaps another reason artists are not insisting on these contractual terms is that their disposition is to

94. It is questionable if this right would be very beneficial to an artist in his lifetime because works of art change owners infrequently. Price, *supra* note 2, at 1348-52.

95. See Bertz, *supra* note 86; Chafee, *supra* note 90; Chafee, *supra* note 82. Prior to the fair trade laws courts did not enforce attempted price maintenance servitudes on the grounds that they would unreasonably restrain trade. *E.g.*, *Bauer & Cie v. O'Donnell*, 229 U.S. 1 (1913); *Dr. Miles Medical Co. v. John D. Park & Sons Co.*, 220 U.S. 373 (1911). However, price maintenance was subsequently legalized with the passage in most of the states of the fair trade laws. See Bertz, *supra* note 86; Chafee, *supra* note 90; Note, *The Operation of Fair-Trade Programs*, 69 HARV. L. REV. 316 (1955).

96. Affirmative servitudes on real property are not as readily enforced as are negative servitudes. See 2 AMERICAN LAW OF PROPERTY § 9.36 (A.J. Casner ed. 1952). However, an affirmative servitude to remit royalty payments on a copyright was upheld in *In re Waterson, Berlin & Smyser Co.*, 48 F.2d 704 (1931).

97. Letter from Jan Ellen Rein, Executive Director of Volunteer Lawyers for the Arts, to Thomas K. Carroll, Jr., Mar. 10, 1972; Letter from Richard M. Weiner, member, N.Y. Attorney Gen.'s Comm. on the Fine Arts, to Thomas K. Carroll, Jr., Mar. 6, 1972.

tally alien to the hard bargaining, businesslike attitude which is needed to persuade buyers to sign contracts of this nature.⁹⁸

III. STATUTORY COPYRIGHT

In view of the unsatisfactory aspects of both common law copyright and contract protection, statutory copyright might be thought to enjoy wide acceptance among artists. On the contrary, the artist who avails himself of this valuable right is a rarity.⁹⁹ What reasons could possibly cause an artist to forego this protection? Statutory copyright includes many valuable rights;¹⁰⁰ it is not difficult to obtain;¹⁰¹ it is not transferred upon the sale of a work of art unless done so expressly;¹⁰² its duration may soon exceed the term of the contractual rights secured by the Projansky-contract;¹⁰³ and the disfigurement caused by the copyright notice is minor.¹⁰⁴ The only plausible explanation for the failure of artists to copyright is that they are ignorant of its potential value to them and the ease with which it may be obtained.

Statutory copyright on a visual work of art includes the right "[t]o . . . publish, copy and vend the copyrighted work."¹⁰⁵ This statutory language means that the copyright owner has the right to control copying of the work, the initial distribution of any authorized copies and, arguably, exhibitions of the work. Since many people are willing to pay for a copy of an art work or for the right to exhibit it, this control may be valuable; and an artist may receive substantial compensation by transferring the copyright completely¹⁰⁶ or by selling his consent to

98. Price suggests another reason why artists are not insisting on contractual rights. The artist's agent desires rapid sales, an interest which conflicts with the artist's desire for subsequent control over his work. Price, *supra* note 2, at 1357-58.

99. ASSOCIATED COUNCILS OF THE ARTS, THE ASS'N OF THE BAR OF THE CITY OF NEW YORK & VOLUNTEER LAWYERS FOR THE ARTS, *THE VISUAL ARTIST AND THE LAW* 3 (1971) [hereinafter cited as *THE VISUAL ARTIST AND THE LAW*].

100. See text accompanying notes 105-06 *infra*.

101. See notes 117-26 and accompanying text *infra*.

102. 17 U.S.C. § 27 (1970). On the other hand, common law copyright is transferred upon sale of a work of art unless reserved. *Pushman v. New York Graphic Soc'y*, 287 N.Y. 302, 39 N.E.2d 249 (1942). See notes 62-67 and accompanying text *supra*.

103. See notes 127-29 and accompanying text *infra*.

104. See notes 130-31 and accompanying text *infra*.

105. 17 U.S.C. § 1(a) (1970). See 1 NIMMER §§ 100-11, for more exhaustive treatment of the rights included in statutory copyright.

106. A transfer of the entire copyright is an assignment, *Goldwyn Pictures Corp. v. Howells Sales Co.*, 282 F. 9 (2d Cir. 1922); *M. Witmark & Sons v.*

reproductions, distribution of reproductions, or exhibitions of the work.¹⁰⁷

The right to control the copying of the work is, of course, the primary right in a copyright.¹⁰⁸ An unauthorized copy of the work, even if made for only private purposes and not for sale,¹⁰⁹ is an infringement of this right for which the copyright owner can seek relief.¹¹⁰ Also, indirect copying is prohibited. For example, a photograph was held to infringe another copyrighted photograph when the infringing photograph was of objects arranged in substantially the same manner as objects in the copyrighted photograph.¹¹¹

In addition to the right to authorize copying of the work, the copyright owner has the right to control the initial distribution of these authorized copies.¹¹² Thus, a copier even though he made the copies with the permission of the copyright owner could still infringe the copyright if he distributes the copies without permission.¹¹³ This control extends only to the initial distribution, and the artist has no control over subsequent redistributions of the copies.¹¹⁴

It could well be argued that an unauthorized public exhibition of a work of art in which there were no restrictions on copying would be an infringement of the statutory copyright. The statute itself gives the copy-

Pastime Amusement Co., 298 F. 470 (E.D.S.C.), *aff'd*, 2 F.2d 1020 (4th Cir. 1924); and should be recorded in the copyright office to ensure its validity against subsequent purchasers for value without notice. 17 U.S.C. § 30 (1970). *See generally* 2 NIMMER §§ 119-30.

107. The transfer of less than the total copyright is said to be a license. *Hirshon v. United Artists Corp.*, 243 F.2d 640 (D.C. Cir. 1957); *Rohmer v. Commissioner*, 153 F.2d 61 (2d Cir. 1946). The owner of the copyright may grant an exclusive license, which is similar to an assignment; or he may grant a nonexclusive license, which is a mere permit to use the work in a specified manner. *See* H. WALLS, *THE COPYRIGHT HANDBOOK FOR FINE AND APPLIED ARTS* 37-38 (1963).
108. 1 NIMMER § 101.1.
109. *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962); *Chappell & Co. v. Costa*, 45 F. Supp. 554 (S.D.N.Y. 1942). *See generally* 1 NIMMER § 101.3.
110. *E.g.*, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354 (9th Cir. 1947). *See generally* 1 NIMMER § 101.
111. *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914).
112. *Cf. Platt & Munk, Inc. v. Republic Graphics, Inc.*, 315 F.2d 847 (2d Cir. 1963).
113. *Id.*
114. *Fawcett Publications, Inc. v. Elliot Publishing Co.*, 46 F. Supp. 717 (S.D. N.Y. 1942); *cf. Bobbs-Merrill Co. v. Straus*; 210 U.S. 339 (1908) (construction of an earlier copyright law).

right owner the right to "publish . . . the copyrighted work,"¹¹⁵ and since exhibition under such circumstances probably amounts to a general publication,¹¹⁶ it follows that the right to publish should include the right to exhibit.

Under the present Copyright Act statutory copyright may be obtained in either published¹¹⁷ or unpublished works of art.¹¹⁸ To obtain it for a published work, the work must have been published with a copyright notice affixed,¹¹⁹ and no action for infringement may be maintained unless a proper application, two photographs of the painting,¹²⁰ and a six dollar registration fee are promptly deposited with the Copyright Office.¹²¹ For an unpublished work statutory copyright may be obtained by sending an application to the copyright office together with one photograph of the painting¹²² and a six dollar fee.¹²³ It is not difficult for an artist to comply with these procedures; the application form is supplied upon request and without cost by the Copyright Office;¹²⁴ it may easily be completed by the artist himself;¹²⁵ and most artists have available photographs of their work since photographs are generally used to show the work to art dealers.¹²⁶

One objection to the present statutory copyright is that it will last for only a maximum of 56 years.¹²⁷ However, the proposed revision of the Copyright Act will extend the life of the statutory copyright to the life of the artist plus 50 years,¹²⁸ which will generally be longer than the term secured by the Projansky-contract.¹²⁹

115. 17 U.S.C. § 1(a) (1970).

116. See pp. 137-41 *supra*.

117. 17 U.S.C. § 10 (1970).

118. *Id.* § 12. This section only provides for copyright in works, "copies of which are not reproduced for sale," *id.*; but this phrase has been interpreted to mean unpublished works. *Shilkret v. Musicraft Records, Inc.*, 131 F.2d 929 (2d Cir. 1942), *cert. denied*, 319 U.S. 742 (1943).

119. 17 U.S.C. § 10 (1970).

120. *Id.* § 13.

121. *Id.* § 215.

122. *Id.* § 12.

123. *Id.* § 215.

124. 37 C.F.R. § 202.3(c) (1972).

125. For a work of art, Form G should be submitted. *Id.* An example of a correctly completed Form G is shown in *THE VISUAL ARTIST AND THE LAW* at 12-15.

126. *CHAMBERLAIN* at 35.

127. The original term is for 28 years with a possibility of renewal for another 28 years. 17 U.S.C. § 24 (1970).

128. S. 644, 92d Cong., 1st Sess. § 302 (1971).

129. Artists' Reserved Rights Transfer and Sales Agreement art. 16.

It is sometimes said that artists do not obtain statutory copyright because they do not wish to disfigure their work by placing the copyright notice on it.¹³⁰ However, the only requirement for copyright notice on the face of a work of art in the United States is the symbol © plus the artist's initials or mark;¹³¹ and since artists generally put their name or initials on the face of their painting anyway, certainly the addition of the symbol © would not be a substantial disfigurement of the painting.

The conclusion is indisputable that many valuable rights can be secured for artists through statutory copyright. But the various advisors of artists have failed to impress upon artists the importance of obtaining this protection.¹³² The artists' organizations and advisors should initiate a massive campaign to educate the artist about statutory copyright: how easily obtainable it is, and how valuable it may become. Organizations such as the Art Information Center, Artists Equity, and National Art Workers Community should make copyright application forms available to the artist together with instructions on how to obtain the statutory copyright.

130. *THE VISUAL ARTIST AND THE LAW* at 3.

131. 17 U.S.C. § 19 (1970). If this abbreviated notice form is used then the artist's name should be placed on the back of the painting or on the base or pedestal of the sculpture. *Id.* However, to ensure protection in foreign countries, the artist should place his name and the year of first publication in addition to the symbol © on the face of his work. Universal Copyright Convention, Sept. 6, 1952, art. III, para. I, [1955] 3 U.S.T. 2731, T.I.A.S. No. 3324. For protection in Latin America, the phrase "All Rights Reserved" should appear on the back of the painting or on the base of the sculpture. Buenos Aires Convention, Aug. 11, 1910, art. III, 38 Stat. 1785 (1914), T.S. No. 593.

132. The National Art Workers Community advises that "copyright is bunk." NAWC, *ART WORKERS NEWSLETTER* Vol. 1, No. 2, at 2. The motivation for this statement is to gain support for copyright law revision, but the effect may be to stop artists from securing any legal rights. Ms. Chamberlain in her book mentions copyright only once to say that "[a]ll reproductions are copyrighted." *CHAMBERLAIN* at 64. Nowhere does she advise artists to copyright their work. Artists Equity Association, Inc. (AEA) does encourage artists to utilize existing copyright laws. AEA, *Code of Ethics No. 9, WHY EQUITY* (an informational pamphlet distributed by AEA), and has a pamphlet for sale describing copyright and the mechanics of obtaining it. J. CAHN, *COPYRIGHT IN WORKS OF ART* (2d ed. 1956) (distributed by AEA). The authors of the monograph *THE VISUAL ARTIST AND THE LAW* recognize the value of statutory copyright and say that failure to copyright "from a legal point of view [is] outright foolishness." *THE VISUAL ARTIST AND THE LAW* at 3.

IV. THE ENFORCEMENT PROBLEM

Obtaining statutory copyright is only the first step an artist should take. To develop the legal rights available to the artist to their fullest capacity, concerted action by a nationwide organization authorized to speak for artists is required. In order for such an organization to operate effectively, artists who have copyrighted their work must assign this copyright to the national artists' organization. This assignment is necessary since an individual artist would be severely handicapped in enforcing his copyright. The artist might never discover an infringement of his copyright, and even if he did learn of an infringement, in most cases he would not have the financial resources to maintain an unprofitable suit against the infringer.

Authors and composers of music have proven that the most desirable way to realize economic gain from a copyrighted work is to assign it to a national organization for enforcement.¹³³ In the early part of this century, a composer who obtained a statutory copyright in his work very seldom realized financial remuneration from it because he was unable to enforce it.¹³⁴ "Detection of the innumerable infringements that occurred every day was impossible for any single composer, and prosecution of the offender was often financially impractical."¹³⁵ To assist them in asserting their rights, the composers and publishers of music formed the American Society of Composers, Authors and Publishers (ASCAP).¹³⁶ ASCAP often had to resort to the courts before music pirates realized that it would be unprofitable for them not to pay for the use of a copyrighted piece in the ASCAP repertory.¹³⁷ The subsequent success of ASCAP and music composers and publishers is history.¹³⁸

133. See Charles, *ASCAP—A Half Century of Progress*, 11 COPYRIGHT BULL. 133 (1964); Cohn, *Music, Radio Broadcasters and the Sherman Act*, 29 GEO. L.J. 407 (1941); Shull, *Collecting Collectively: ASCAP's Perennial Dilemma*, in 7 ASCAP COPYRIGHT LAW SYMPOSIUM 35 (1956); White, *Musical Copyrights v. the Antitrust Laws*, 30 NEB. L. REV. 50 (1951); Comment, *ASCAP and the Antitrust Laws: the Story of a Reasonable Compromise*, 1959 DUKE L.J. 258.

134. Charles, *supra* note 133, at 135-37; Shull, *supra* note 133, at 37-38.

135. Shull, *supra* note 133, at 38.

136. For a description of the organization of ASCAP and its operation, see S. ROTHENBERG, COPYRIGHT AND PUBLIC PERFORMANCE OF MUSIC 29-41 (1954).

137. Charles, *supra* note 133, at 137. This early litigation was very expensive and unprofitable for ASCAP and for several years ASCAP was not even able to compensate its counsel, Nathan Burkan. *Id.*

138. See articles cited note 133 *supra*.

One of the national visual artist associations should now start assuming a role similar to that of ASCAP. Such an organization should encourage artists to copyright their work and in turn to assign the copyright to the national group. The organization should have enforcement committees in various cities around the nation that would be responsible for scanning periodicals and visiting art shows in their area in order to detect infringements of an artist's copyright. If a violation is reported and the infringer refuses to make reparation to the artist, the organization should take legal action against the infringer even if the suit would be economically unprofitable. After a few such suits infringers would be more willing to pay on demand.

The assignment contract should provide that the organization retain a small percentage of any royalties received from the licensing of the copyright and that the remainder be disbursed to the artist. The organization would then have a source of income other than dues with which it could establish an artist relief fund and provide other services for the artist.

In addition to fulfilling its enforcement role, the organization should also serve in the capacity of negotiator. Anyone desiring a license to reproduce or exhibit an art work under its control would have to negotiate with the organization for this right, and the organization, staffed by professional negotiators, would be able to obtain a better price for this license than if the negotiations were carried on by the artist himself.

Moreover, as the organization becomes more successful and as an increasing number of artists profit financially from their association with the national group, other artists will be encouraged to join. With the strength enjoyed by numbers and unity, artists will be in an advantageous position to insist upon a contractual right to proceeds upon resale. Thus, just as the statutory copyright was the conduit by which musical composers more fully realized their legal rights, so could it also be with the visual artist.

V. CONCLUSION

The statutory copyright is the only existing method by which an artist may effectively retain rights in his work after it has been sold. Common law copyright affords inadequate protection because it is usually lost prior to the sale of the work. Even if it is still extant at the time of the sale, it may pass to the buyer along with the work. An artist may retain more rights by contractual means, but to obtain contractual rights the artist must enjoy a strong bargaining position which is generally not possessed by the struggling artist.

Thus, all artists should obtain statutory copyright, but few do so. The only adequate explanation is that they are ignorant of how to copyright their work and of the value of the statutory copyright. Therefore, artists' advisors, especially the national artist organizations, should inform the artists about the statutory copyright — how valuable it is and how to obtain it. However, the national organizations should not content themselves only with an education program. Instead they should encourage artists to assign their copyrights to them, and then proceed to enforce vigorously these copyrights. Only then will artists fully realize a proper reward for their creations.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. United States of America and Territories

253. Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms.

Message from the President of the United States transmitting the Convention . . . done at Geneva October 29, 1971. The Convention, together with accompanying papers, referred to the Committee on Foreign Relations, April 11, 1973. Washington, U.S. Govt. Print. Off., 1973. 5 p. (U.S. 93d Congress, 1st Session. Senate. Ex. G.) The text of the Convention, together with the report from the Department of State, is transmitted to the Senate with a recommendation from the President that it give "early and favorable consideration" to the treaty and give its advice and consent to its ratification.

254. U.S. *Commission on Government Procurement*.

Report. [E. Perkins McGuire, chairman. Washington, U.S. Govt. Print. Off.] Dec. 1972. 4 v.

"The Commission . . . was created by Public Law 91-129 in November 1969 to study and recommend to Congress methods 'to promote the economy, efficiency, and effectiveness' of procurement by the executive branch of the Federal Government." Volume 4 includes material on the question of who is to obtain copyrights in works produced under Government contracts, together with the Commission's recommendations on the question.

255. U.S. CONGRESS. HOUSE.

H.R. 6214. A bill to protect copyrights of foreign authors in the United States. Introduced by Mr. Bingham, March 28, 1973, and referred to the Committee on the Judiciary. 2 p. (93d Cong., 1st Sess.)

A companion bill to S. 1359, differing only in the caption. See Item 261, *infra*.

256. U.S. CONGRESS. HOUSE.

H.R. 6418. A bill to amend section 9 of title 17 of the United States Code. Introduced by Mr. Biaggi, April 2, 1973, and referred to the Committee on the Judiciary. 2 p. (93d Con., 1st Sess.)

Identical to S. 1359 and H.R. 6214 of the same Congress.

257. U.S. CONGRESS. HOUSE.

H.R. 6764. A bill to amend the Internal Revenue Code of 1954 to modify the restrictions contained in section 170 (e) in the case of certain charitable contributions of ordinary income property. Introduced by Mr. Brademas, April 10, 1973, and referred to the Committee on Ways and Means. 3 p. (93d Cong., 1st Sess.)

A companion bill to S. 1510. See Item 268, *infra*.

258. U.S. CONGRESS. HOUSE. *Committee on the Judiciary.*

Summary of activities, 92d Congress. [Submitted by Mr. Celler] January 2, 1973, and committed to the Committee of the Whole House on the State of the Union. Washington, U.S. Govt. Print. Off., 1973. 38 p. (92d Cong., 2d Sess., H. Rep. No. 92-1636). "Union calendar no. 849."

Includes the activities of the House Judiciary Committee covering copyright.

259. U.S. CONGRESS. SENATE.

Removal of injunction of secrecy from the Convention for the Protection of Producers of Phonograms. *Congressional Record*, vol. 119, no. 57 (daily ed. Apr. 11, 1973), pp. S7065-S7066.

Senator Mansfield receives unanimous consent for the removal of the injunction of secrecy from the Convention (Ex. G, 93d Cong., 1st Sess.), which had been transmitted to the Senate that day by President Nixon, for the referral of the convention, with accompanying papers to the Committee on Foreign Relations, and for the printing of the President's transmittal message in the *Record*. See Item 253, *supra*.

260. U.S. CONGRESS. SENATE.

S. 1237. A bill to amend the Communications Act of 1934 to provide for the regulation of community antenna television systems. Introduced by Mr. Williams, March 14, 1973, and referred to the Committee on Commerce. 3 p. (93d Cong., 1st Sess.)

Senator Williams, in his remarks upon his introduction of the bill (119 *Congressional Record* S4594 (daily ed. Mar. 14, 1973)), indicated that it is intended to answer the question whether and to what extent the Federal Communications Commission has jurisdiction over CATV, since it is a matter "too pressing to be left for the courts to decide on a case-by-case basis."

261. U.S. CONGRESS. SENATE.

S. 1359. A bill to amend section 9 of title 17 of the United States Code. Introduced by Mr. McClellan, March 26, 1973, and referred to the Committee on the Judiciary. 2 p. (93d Cong., 1st Sess.)

Senator McClellan indicated in a statement appearing in 119 *Congressional Record* S5613-S5614 (daily ed. Mar. 26, 1973) that he sponsored the bill at the request of the Authors League of America, because of the League's concern that a new amendment of the Soviet copyright law "apparently is designed to permit that country [as a member of the U.C.C.] to prevent publication abroad of anti-Soviet works by bringing suits for infringement of United States or other copyrights, against publishers in foreign countries who issue these works." The Senator states that the bill is designed to preserve the fundamental right of an author to decide whether his work may be published in any country. One of the bill's provisions bars an action for infringement by any nation claiming rights in an author's copyright by virtue of its domestic laws. Appended to the statement are several editorials and articles on the subject from the *New York Times*, the *Miami Herald*, and the *Washington Post*.

262. U.S. CONGRESS. SENATE. *McClellan, John L.*

Soviet copyright law. *Congressional Record*, vol. 119, no. 49 (Mar. 29, 1973), pp. S6192-S6193.

Senator McClellan, in an additional statement with reference to his introduction on March 26 of S. 1359 in response to recent developments in the U.S.S.R., causes to be printed in the *Record*, by unanimous consent, two more newspaper articles. The first article is a lead editorial from the *Wall Street Journal* of March 29, entitled "From Russia With Vengeance," concurring in the view that Soviet membership in the UCC "was aimed primarily at suppressing foreign publication of underground works by Russian authors critical of the regime." The second article, which appeared

in the *New York Times* of March 28 under the title "Six Soviet Intellectuals Warn of Danger in Moscow's Acceptance of World Copyright Law," reports a statement issued by a group of distinguished Soviet intellectuals "to the effect that the Soviet membership in the Universal Copyright Convention could be used to deprive Soviet authors of their rights."

263. U.S. CONGRESS. SENATE.

S. 1360. A bill to amend title 35 and title 17 of the United States Code to provide a remedy for postal interruptions in patent, trademark and copyright cases. Introduced by Mr. McClellan, March 26, 1973, and referred to the Committee on the Judiciary. 5 p. (93d Cong., 1st Sess.)

This bill would provide relief from injury which might be sustained by patent, trademark and copyright applicants due to disruptions of postal services in those instances in which the respective laws contain certain time periods during which specified actions must be taken to avoid forfeitures of rights. See Senator McClellan's statement on his introduction of the bill in 119 *Congressional Record* S-5614-S5615 (daily ed. Mar. 26, 1973).

264. U.S. CONGRESS. SENATE.

S. 1361. 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, March 26, 1973, and referred to the Committee on the Judiciary. 85 p. (93d Cong., 1st Sess.)

Other than for necessary technical amendments relating to the effective dates of various provisions, the bill is identical to S. 644 of the 92d Congress. Senator McClellan indicated in a statement on his introduction of the bill, appearing in 119 *Congressional Record* S5615 (daily ed. Mar. 26, 1973), that, despite certain reservations, the subcommittee will at some future date reopen previously held hearings to hear supplementary presentations on certain selected issues which will include library photocopying, the proposed amendment of the ad hoc committee on copyright law revision relating to a general exemption for educational purposes, the CATV royalty schedule, the application of compulsory license provisions to the carriage of sporting events by cable television systems, and the proposed exemption for the making of copies of tapes of religious broadcasts.

265. U.S. CONGRESS. SENATE.

S. 1362. 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 of Pennsylvania), March 26, 1973, and referred to the Committee on the Judiciary. 6 p. (93d Cong., 1st Sess.)

Other than for several amendments, suggested by the National Coordinating Committee which has been established to seek passage of this legislation, the bill, which would establish a uniform body of Federal unfair competition law, is for the most part, identical to S. 647 of the 92d Congress, and to S. 766 of the 91st Congress. See the statement of Senator McClellan in 119 *Congressional Record* S5615-S5616 (daily ed. Mar. 26, 1973) and 18 BULL. CR. Soc. 315, Item 233 (1971).

266. U.S. CONGRESS. SENATE.

S. 1367. A bill relating to the income tax treatment of charitable contributions of copyrights, artistic compositions, or a collection of papers. Introduced by Mr. Church, March 26, 1973, and referred to the Committee on Finance. 2 p. (93d Cong., 1st Sess.)

In a statement published in 119 *Congressional Record* S5626-S5635 (daily ed. Mar. 26, 1973), Senator Church indicated that his bill "is similar in intent, though not in language, to S. 1212," which he introduced during the 92d Congress. He stated that "changes have been made in the text of the bill . . . to rectify a serious technical flaw in the legislation which would have granted tax benefits beyond the scope intended." The bill would partially reinstate the tax treatment given to authors and artists prior to the passage of the Tax Reform Act of 1969 for up to 50 percent of the fair market value of their works, but this tax advantage would not be granted to public officials. Appended to the statement are the Senator's remarks in support of the change in the law which appeared in the *Congressional Record* at the time he introduced S. 1212, together with the supportive material which he presented at that time, an in-depth study which was done by Mr. Mike Wetherell of the Senator's staff on the background of the problem and the need for a change in the law, and, finally, the text of the new bill.

267. U.S. CONGRESS. SENATE.

S. 1476. A bill to amend the Federal Trade Commission Act to prevent unfair competition in interstate commerce and for other purposes. Introduced by Mr. Moss, April 5 (legislative day, April 4), 1973, and referred to the Committee on Commerce. 4 p. (93d Cong., 1st Sess.)

Different in approach from, but similar in purpose to, a number of bills to create a federal law of unfair competition, introduced in the current and previous Congresses. See statement of Senator Moss pertaining to his introduction of the bill. 119 *Congressional Record* S6761-S6762 (daily ed. Apr. 5, 1973).

268. U.S. CONGRESS. SENATE.

S. 1510. A bill to amend the Internal Revenue Code of 1954 to modify the restrictions contained in section 170 (e) in the case of certain charitable contributions of ordinary income property. Introduced by Mr. Javits, April 10, 1973, and referred to the Committee on Finance. 3 p. (93d Cong., 1st Sess.)

A bill, similar in purpose to several other bills introduced in the present and previous Congresses, which would allow artists to deduct 75 percent of the market value of their work contributed to non-profit organizations like museums, universities, and libraries, and would require that these deductions be taken only to the extent the artist had art-related income. See Item 269, *infra*.

269. U.S. CONGRESS. SENATE. *Javits, Jacob.*

S. 1510. A bill to amend the Internal Revenue Code of 1954 to modify the restrictions contained in section 170 (e) in the case of certain charitable contributions of ordinary income property. Referred to the Committee on Finance. *Congressional Record*, vol. 119, no. 56 (daily ed. Apr. 10, 1973), pp. S6890-S6891.

Senator Javits, in connection with his introduction of S. 1510, states, *inter alia*, that its purpose is "to correct certain inequities created by the 1969 Tax Reform Act which disallowed tax deductions for the full market value of charitable contributions of art works by the original artist." An article on the subject matter of the bill, by Jo Ann Lewis, entitled "Artists, Taxes and the Law" from the *Washington Star and News* of April 8, 1973, appears at end of the statement. See Item 268, *supra*.

270. U.S. CONGRESS. SENATE. *Committee on the Judiciary. Subcommittee on Patents, Trademarks, and Copyrights.*

Report, pursuant to S. Res. 256, Ninety-second Congress, Second Session. March 26, 1973. Washington, U.S. Govt. Print. Off., 1973. 13 p. (93d Cong., 1st Sess. S. Rep. No. 93-88).

Report of the activities of the Subcommittee during the Second Session of the 92d Congress.

271. U.S. CONGRESS. HOUSE. *Bingham, Jonathan B.*

Legislation to protect U.S. publishers of Soviet works. *Congressional Record*, vol. 119, no. 48 (Mar. 28, 1973), pp. H2233-H2234.

An extension of Mr. Bingham's remarks on his introduction of H.R. 6214. The remarks include a statement that "[w]e seek only in this bill to prevent the Soviet Union from imposing on us — on our citizens and publishers — the repressive system they maintain in their own country." Reprints of recent articles from the *Washington Post*, *Publishers Weekly*, and the *New York Times* concerning developments on this matter appear at the end of the remarks.

2. Foreign Nations

272. AUSTRALIA. *Laws, statutes, etc.*

Copyright regulations: Regulations under the Copyright Act 1968. (Of April 24, 1969). *Copyright*, vol. 9, no. 4 (Apr. 1973), pp. 68-78.

"These Regulations were published in the *Commonwealth of Australia Gazette* of April 28, 1969 (Statutory Rules, 1969, No. 58)."

273. IRAN. *Laws, statutes, etc.*

Gesetz zum Schutz des Rechts der Autoren, Komponisten und Künstler vom 12. Januar 1970. *Blatt für Patent, Muster- und Zeichenwesen*, vol. 75, no. 1 (Jan. 1973), pp. 19-21.

German translation of the Iranian copyright law of January 12, 1970.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

274. *Donald Goldstein, Ruth Koven and Donald Koven v. State California*, 177 U.S.P.Q. No. 12, Part II (June 18, 1973). On writ of certiorari to the Appellate Department of the Superior Court of California for the County of Los Angeles.

Affirmed.

EDITORIAL NOTE:

On June 18th, the United States Supreme Court, in a 5 to 4 decision, upheld the constitutionality of the California anti-record piracy statute with regard to sound recordings "fixed" before February 15, 1973, the date on which the Federal Act dealing with limited copyright protection of sound recordings became effective. (Public Law 92-140, Oct. 15, 1971, 19 BULL. CR. Soc. Item 59, p. 129 (1971)). Inasmuch as this eagerly awaited Supreme Court decision will have a tremendous effect on the future battle against record piracy and probably also on the ultimate interpretation of the Court's *Sears-Roebuck* and *Compco* cases (cited below in the decision), we are publishing here in full both the majority decision and the two dissenting opinions.

In view of the fact that these opinions became available shortly before this issue of the BULLETIN went to press, it would seem premature at this time to have an extensive analysis or comment on the *Goldstein* case. Suffice it to say that the reasoning and method by which Chief Justice Burger justifies the validity of state anti-piracy legislation with regard to records "fixed" prior to February 15, 1972, will at first glance seem rather baffling and unorthodox to members of the copyright bar. This is true particularly of the observation of the majority opinion that, to the extent that Congress has not exercised its legislative power under the patent and copyright clause of the Constitution, the states have remained in a position "to issue copyrights".

Throughout the opinion, it is emphasized that state power "to grant copyrights" has not been relinquished to exclusive federal

control and that in those cases in which state protection would not conflict with federal action, the language of the Constitution does not preclude the states from "granting copyrights".

This would seem to make strange reading in at least two respects:

In the first place, the California statute and other similar state statutes, neither by their language nor by their objective, are copyright statutes. On the contrary, they purport to deal with a form of unfair competition, which even under the dissenting opinion of Justice Marshall, cannot be considered an "attractive" business. Furthermore, if the state statutes really were copyright statutes rather than legislative efforts to combat an extreme form of misappropriation or unfair competition even beyond the "limited times" provision of the Constitution, how can it be said that the "duplicators" or pirates are not precluded from "recording an exact imitation of the performance embodied on the master recording"? The real question — not decided by the Court — would be whether the freedom to imitate unpatented or uncopyrighted products under *Sears-Roebuck* and *Compco* should be extended to even those cases in which not only an independent imitation is made, but which consist of outright dubbing or duplication. In this country, as well as in many other countries, such a distinction has been made. While the majority does attempt to distinguish the present sound recording case from *Sears-Roebuck* and *Compco* on other grounds, it fails to throw any light upon this distinction or upon the availability to duplicators of the alleged right to proceed under the Compulsory Licensing provision of Section 1(e) of the Act of 1909.

There undoubtedly will be much more detailed and critical analysis in months and years to come of this important ruling by our highest court.

W.J.D.

BURGER, C. J., delivered the opinion of the Court, in which STEWART, WHITE, POWELL and REHNQUIST, JJ., joined. DOUGLAS and MARSHALL, JJ., filed dissenting opinions, in which BRENNAN and BLACKMUN, JJ., joined.

MR. CHIEF JUSTICE BURGER delivered the opinion of the Court.

We granted certiorari to review petitioners' conviction under a California statute making it a criminal offense to "pirate" recordings produced by others.

In 1971, an information was filed by the State of California, charging petitioners in 140 counts with violating § 653h of the California Penal Code. The information charged that, between April 1970, and March 1971, petitioners had copied several musical performances from commercially sold recordings without the permission of the owner of the master record or tape.¹ Petitioners moved to dismiss the complaint on the grounds that §653h was in conflict with Art. I, § 8, cl. 8, of the Constitution,² the "Copyright Clause," and the federal statutes enacted thereunder. Upon denial of their motion, petitioners entered pleas of *nolo contendere* to 10 of the 140 counts; the remaining counts were dismissed. On appeal, the Appellate Department of the Superior Court sustained the validity of the statute. After exhausting other state appellate remedies, petitioners sought review in this Court.

I

Petitioners were engaged in what has commonly been called "record" or "tape piracy" — the unauthorized duplication of recordings of perform-

1. In pertinent part, the California statute provides:

"(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, . . . tape, . . . or other article on which sounds are recorded, with intent to sell or cause to be sold, . . . such article on which such sounds are so transferred, without the consent of the owner.

"(2) . . .

"(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 tape, . . . or other device used for reproducing recorded sounds on phonograph records, . . . tapes, . . . or other articles on which sound is recorded, and from which the transferred recorded sounds are directly or indirectly derived."

Specifically, each count of the information alleged that, in regard to a particular recording, petitioners had "at and in the City of Los Angeles, in the County of Los Angeles, State of California . . . wilfully, unlawfully and knowingly transferred and caused to be transferred sounds recorded on a tape with the intent to sell and cause to be sold, such tape on which such sounds [were] so transferred. . . ."

2. Article I, § 8, cl. 8, provides that Congress shall have the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"

ance by major musical artists.³ Petitioners would purchase from a retail distributor a single tape or phonograph recording of the popular performances they wished to duplicate. The original recordings were produced and marketed by recording companies with whom petitioners had no contractual relationships. At petitioners' plant, the recording was reproduced on blank tapes, which could in turn be used to replay the music on a tape player. The tape was then wound on a cartridge. A label was attached, stating the title of the recorded performance — the same title as had appeared on the original recording, and the name of the performing artists.⁴ After final packaging, the tapes were distributed to retail outlets for sale to the public, in competition with those petitioners had copied.

Petitioners made no payments to the artists whose performances they reproduced and sold, nor to the various trust funds established for their benefit; no payments were made to the producer, technicians, or other staff personnel responsible for producing the original recording and paying the large expenses incurred in production.⁵ No payments were made for the use of the artists' names or the album title.

The challenged California statute forbids petitioners from transferring any performance fixed on a tape or record onto other records or tapes with the intention of selling the duplicates, unless they have first received permission from those who, under state law, are the owners of the master recording. Although the protection afforded to each master recording is substantial, lasting for an unlimited time, the scope of the proscribed activities is narrow. No limitation is placed on the use of the music, lyrics or arrangement employed in making the master recording.

3. Since petitioners did not proceed to trial, the factual record before the Court is sparse. However, both parties indicate that a complete description of petitioner's method of operation may be found in the record of *Tape Industries Asso. of America v. Younger*, 316 F. Supp. 340 (C.D. Cal. 1970), appeal dismissed for lack of jurisdiction, 401 U. S. 902 (1971), appeal pending United States Court of Appeals, CA 9, No. 26,628.
4. An additional label was attached to each cartridge by petitioners, stating that no relationship existed between petitioners and the producer of the original recording or the individuals whose performances had been recorded. Consequently, no claim is made that petitioners misrepresented the source of the original recordings or the manufacturer of the tapes.
5. The costs of producing a single original long playing record of a musical performance may exceed \$50,000 or \$100,000. *Tape Industries Asso. of America v. Younger*, 216 F. Supp., at 344 (1970); Hearings on S. 646 and H. R. 6927 before Subcommittee No. 3 of the Committee on the Judiciary, House of Representatives, 92d Cong., 1st Sess., at 27-28 (1971). For the performance recorded on this record, petitioners would pay only the retail cost of a single long playing record or a single tape.

Petitioners are not precluded from hiring their own musicians and artists and recording an exact imitation of the performance embodied on the master recording. Petitioners are even free to hire the same artists who made the initial recording in order to duplicate the performance. In essence, the statute thus provides copyright protection solely for the specific expressions which comprise the master record or tape.

Petitioners' attack on the constitutionality of § 653h has many facets. First, they contend that the statute establishes a state copyright of unlimited duration, and thus conflicts with Art. I, § 8, cl. 8, of the Constitution. Second, petitioners claim that the state statute interferes with the implementation of federal policies, inherent in the federal copyright statutes. 17 U. S. C. § 1 *et seq.* According to petitioners, it was the intention of Congress, as interpreted by this Court in *Sears, Roebuck and Co. v. Stiffel Co.*, 376 U. S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting*, 376 U. S., 234 (1964), to establish a uniform law throughout the United States to protect original writings. As part of the federal scheme, it is urged that Congress intended to allow individuals to copy any work which was not protected by a federal copyright. Since § 653h effectively prohibits the copying of works which are not entitled to federal protection, petitioners contend that it conflicts directly with congressional policy and must fall under the Supremacy Clause of the Constitution. Finally, petitioners argue that 17 U. S. C. § 2, which allows States to protect unpublished writings,⁶ does not authorize the challenged state provision; since the records which petitioners copied had previously been released to the public, petitioners contend that they had, under federal law, been published.

We note at the outset that the federal copyright statutes to which petitioners refer were amended by Congress while their case was pending in the state courts. In 1971, Pub. L. 92-140 was passed to allow federal copyright protection of recordings. However, § 3 of the amendment specifically provides that such protection is to be available only to sound recordings "fixed, published and copyrighted" on and after February 15, 1972, and before January 1, 1975, and that nothing in Title 17, as amended is to "be applied retroactively or [to] be construed as affecting in any way any rights with respect to sound recordings fixed before" February 15, 1972. The recordings which petitioners copied were all "fixed" prior to February 15, 1972. Since, according to the language of

6. 17 U. S. C. § 2 — "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, or to obtain damages therefor."

§ 3 of the amendment, Congress did not intend to alter the legal relationships which govern these recordings, the amendments have no application in petitioners' case.⁷

II

Petitioners' first argument rests on the premise that the state statute under which they were convicted lies beyond the powers which the States reserved in our federal system. If this is correct, petitioners must prevail, since the States cannot exercise a sovereign power which, under the Constitution, they have relinquished to the Federal Government for its exclusive exercise.

A

The principles which the Court has followed in construing state power were stated by Alexander Hamilton in Number 32 of *The Federalist*:

“An entire consolidation of the States into one complete national sovereignty would imply an entire subordination of the parts; and whatever powers might remain in them, would be altogether dependent on the general will. But as the plan of the [Constitutional] convention aims only at a partial union or consolidation, the State governments would clearly retain all the rights of sovereignty which they before had, and which were not, by this act, *exclusively* delegated to the United States. This exclusive delegation, or rather this alienation, of State sovereignty, would only exist in three cases: where the Constitution in express terms granted an exclusive authority to the Union; where it granted in one instance an authority to the Union, and in another prohibited the States from exercising the like authority; and where it granted an authority to the Union, to which a similar authority in the States would be absolutely and totally *contradictory* and *repugnant*.⁸

The first two instances mentioned present no barrier to a State's enactment of copyright statutes. The clause of the Constitution granting to Congress the power to issue copyrights does not provide that such power shall vest exclusively in the Federal Government. Nor does the Constitu-

7. No question is raised in the present case as to the power of the States to protect recordings fixed after February 15, 1972.

8. A. Hamilton, J. Madison, J. Jay, *The Federalist*, B. F. Wright, ed. (Cambridge, Mass., 1961) (hereafter “*The Federalist*”) 241; see *Cooley v. Board of Wardens*, 12 How. (53 U. S.) 299, 318-319 (1851).

tion expressly provide that such power shall not be exercised by the States.

In applying the third phase of the test, we must examine the manner in which the power to grant copyrights may operate in our federal system. The objectives of our inquiry were recognized in *Cooley v. Board of Wardens*, 12 How. (53 U.S.) 299 (1851), when, in determining whether the power granted to Congress to regulate commerce⁹ was "compatible with the existence of a similar power in the States," the Court noted:

"Whatever subjects of this power are in their nature national, or admit of only one uniform system, or plan of regulation, may justly be said to be of such a nature as to require exclusive legislation by Congress." 12 How. (53 U. S.), at 319.

The Court's determination that Congress alone may legislate over matters which are *necessarily* national in import reflects the basic principle of federalism. "The genius and character of the [federal] government," Chief Justice Marshall said,

"seem to be, that its action is to be applied to all external concerns of the nation, and to those internal concerns which affect the States generally; but not to those which are completely within a particular State, which do not affect other States, and with which it is not necessary to interfere, for the purpose of executing some of the general powers of government." *Gibbons v. Ogden*, 9 Wheat. (22 U. S.) 1, 195 (1824).

The question whether exclusive federal power must be inferred is not a simple one, for the powers recognized in the Constitution are broad and the nature of their application varied. The warning sounded by the Court in *Cooley* may equally be applicable to the Copyright Clause:

"Either absolutely to affirm, or deny that the nature of [the federal power over commerce] requires exclusive legislation by Congress is to lose sight of the nature of the subjects of this power, and to assert concerning all of them, what is really applicable but to a part. 12 How. (53 U. S.), at 319.

We must also be careful to distinguish those situations in which the concurrent exercise of a power by the Federal Government and the States or by the States alone *may possibly* lead to conflicts and those sit-

9. Article I, § 8, cl. 3.

uations where conflicts *will necessarily* arise. "It is not . . . a mere possibility of inconvenience in the exercise of powers, but an immediate constitutional repugnancy that can by implication alienate and extinguish a preexisting right of [state] sovereignty." The Federalist, No. 32, at 243.

Article I, § 8, cl. 8, of the Constitution gives to Congress the power —

"To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"

The clause thus describes both the objective which Congress may seek and the means to achieve it. The objective is to promote the progress of science and the arts. As employed, the terms "to promote" are synonymous with the words "to stimulate," "to encourage," or "to induce."¹⁰ To accomplish its purpose, Congress may grant to authors the exclusive right to the fruits of their respective works. An author who possesses an unlimited copyright may preclude others from copying his creation for commercial purposes without permission. In other words, to encourage people to devote themselves to intellectual and artistic creation, Congress may guarantee to authors and inventors a reward in the form of control over the sale or commercial use of copies of their works.

The objective of the Copyright Clause was clearly to facilitate the granting of rights national in scope. While the debates on the clause at the Constitutional Convention were extremely limited, its purpose was described by James Madison in No. 43 of the Federalist Papers:

"The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.¹¹

10. See *Kendall v. Winsor*, 21 How. (62 U. S.) 322, 328 (1858); *Mitchell v. Tilghman*, 19 Wall. (86 U. S.) 287, 418 (1873); *Bauer v. O'Donnell*, 229 U. S. 1, 10 (1913).

11. The Federalist, at 309.

The difficulty noted by Madison relates to the burden placed on an author or inventor who wishes to achieve protection in all States when no federal system of protection is available. To do so, a separate application is required to each state government; the right which in turn may be granted has effect only within the granting State's borders.¹² The national system which Madison supported eliminates the need for multiple applications and the expense and difficulty involved. In effect, it allows Congress to provide a reward greater in scope than any particular State may grant to promote progress in those fields which Congress determines are worthy of national action.

Although the copyright clause thus recognizes the potential benefits of a national system, it does not indicate that all writings are of national interest or that state legislation is, in all cases, unnecessary or precluded. The patents granted by the States in the 18th century show, to the contrary, a willingness on the part of the States to promote those portions of science and the arts which were of local importance.¹³

12. Numerous examples may be found in our early history of the difficulties which the creators of items of national import had in securing protection of their creations in all States. For example, Noah Webster, in his effort to obtain protection for his book, *A Grammatical Institute of the English Language*, brought his claim before the legislatures of at least six States, and perhaps as many as 12. See B. Bugbee, *The Genesis of American Patent and Copyright Law* (Wash., D. C., 1967) 108-110, 120-124; H. R. Rep. No. 2222, 60th Cong., 2d Sess., at 2 (1909). Similar difficulties were experienced by John Fitch and other inventors who desired to protect their efforts to perfect a steamboat. See Federico, *State Patents*, 3 *J. of the Patent Office Society* 166, 170-176 (1931).
13. As early as 1751, Massachusetts granted to Benjamin Crabb the exclusive right to employ a specific process for the manufacture of candles out of whale oil. It is not clear whether Crabb invented the process. The *Acts and Resolves, Public and Private of the Province of Massachusetts Bay*, Vol. III. Session of Jan. 10, 1751, c. 19, at 546-547 (1878). In 1780, Pennsylvania granted a patent to Henry Guest for the processing of tanning oil and blubber, noting specifically that the patent was "a reward for his discovery and for the purpose of promoting useful manufactories in this state." *The Statutes at Large of Pennsylvania from 1682 to 1801*, J. Mitchell and H. Flanders, eds., Vol. X: at 132 (1904). Similarly, South Carolina granted protection to Peter Belin in 1786 for newly designed water works which aided in the production of rice, a staple of South Carolina agriculture, and other products. Another patent relating to the processing of rice was granted by South Carolina in 1788. *The Statutes at Large of South Carolina*, T. Cooper, ed., Vol. IV, at 755 (1838); Vol. V, at 69 (1839). In 1787, Maryland granted a patent on a spinning and carding machine "to encourage useful invention, as well as promote the manufacture of cotton and wool within this state. . . ." *The Laws of Maryland*, W. Lilty, ed., Vol. II, Session of Nov. 6, 1786-Jan. 20, 1787, c. 23 (1800). In the same year,

Whatever the diversity of people's backgrounds, origins and interests and whatever the variety of business and industry in the 13 colonies, the range of diversity is obviously far greater today in a country of 210 million people in 50 States. In view of that enormous diversity, it is unlikely that all citizens in all parts of the country place the same importance on works relating to all subjects. Since the subject matter to which the copyright clause is addressed may thus be of purely local importance and not worthy of national attention or protection, we cannot discern such an unyielding national interest as to require an inference that state power to grant copyrights has been relinquished to *exclusive* federal control.

The question to which we next turn is whether, in actual operation, the exercise of the power to grant copyrights by some States will prejudice the interests of other States. As we have noted, a copyright granted by a particular State has effect only within its boundaries. If one State grants such protection, the interests of States which do not are not prejudiced since their citizens remain free to copy within their borders those works which may be protected elsewhere. The interests of a State which grants copyright protection may, however, be adversely affected by other States that do not; individuals who wish to purchase a copy of a work protected in their own State will be able to buy unauthorized copies in other States where no protection exists. However, this conflict is neither so inevitable nor so severe as to compel the conclusion, that state power has been relinquished to the exclusive jurisdiction of the Congress. Obviously when some States do not grant copyright protection — and most do not — that circumstance reduces the economic value of a state copyright, but it will hardly render the copyright worthless. The situation is no different from that which may arise in regard to other state monopolies, such as a food concession in a limited enclosure, such as a state park, or a state lottery; in each case, citizens may escape the effect of one State's monopoly by making purchases in another area or another State. Similarly, in the case of state copyrights, except as to individuals willing to travel across state lines in order to purchase records or other writings protected in their own State, each State's copyrights will still serve to induce new artistic creations within that State — the very objective of the grant of protection. We do not see here the type of prejudicial conflicts which would arise, for example, if each State

Pennsylvania patented certain devices relating to flour mills, noting that these devices would "tend to simplify and render cheap the manufacture of flour which is one of the principal staples of this commonwealth. . . ." The Statutes at Large of Pennsylvania from 1682 to 1801, J. Mitchell and H. Flanders, eds., Vol. XII, at 483-485 (1906).

exercised a sovereign power to impose imposts and tariffs;¹⁴ nor can we discern a need for uniformity such as that which may apply to the regulation of interstate shipments.¹⁵

Similarly, it is difficult to see how the concurrent exercise of the power to grant copyrights by Congress and the States will necessarily and inevitably lead to difficulty. At any time Congress determines that a particular category of "writing" is worthy of national protection and the incidental expenses of federal administration, federal copyright protection may be authorized. Where the need for free and unrestricted distribution of a writing is thought to be required by the national interest, the Copyright Clause and the Commerce Clause would allow Congress to eschew all protection. In such cases, a conflict would develop if a State attempted to protect that which Congress intended to be free from restraint or to free that which Congress had protected. However, where Congress determines that neither federal protection nor freedom from restraint is required by the national interest, it is at liberty to stay its hand entirely.¹⁶ Since state protection would not then conflict with federal action, total relinquishment of the States' power to grant copyright protection cannot be inferred.

As we have seen, the language of the Constitution neither explicitly precludes the States from granting copyrights nor grants such authority exclusively to the Federal Government. The subject matter to which the copyright clause is addressed may at times be of purely local concern. No conflict will necessarily arise from a lack of uniform state regulation, nor will the interest of one State be significantly prejudiced by the actions of another. No reason exists why Congress must take affirmative action either to authorize protection of all categories of writings or to free them from all restraint. We therefore conclude that, under the Constitution, the States have not relinquished all power to grant to authors "the exclusive Right to their respective Writings."

B

Petitioners have an additional argument on the language of the Constitution. The California statute forbids individuals from appropriating recordings at any time after release. From this, petitioners argue

14. The Federalist, No. 42, at 305.

15. Cf. *Morgan v. Virginia*, 328 U. S. 373; *Bibb v. Navajo Freight Lines*, 359 U. S. 520; *Southern Pacific Co. v. Arizona*, 325 U. S. 761; *Pennsylvania v. West Virginia*, 262 U. S. 553 (1923).

16. For example, Congress has provided that writings which may eventually be the subject of a federal copyright, may be protected under state law prior to publication. 17 U. S. C. § 2.

that the State has created a copyright of *unlimited* duration, in violation of that portion of Art. I, § 8, cl. 8, which provides that copyrights may only be granted "for limited Times." Read literally, the text of Art. I does not support petitioners' position. Section 8 enumerates those powers which have been granted *to Congress*; whatever limitations have been appended to such powers can only be understood as a limit on congressional, and not state, action. Moreover, it is not clear that the dangers to which this limitation was addressed apply with equal force to both the Federal Government and the States. When Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach. As we have noted, however, the exclusive right granted by a State is confined to its borders. Consequently, even when the right is unlimited in duration, any tendency to inhibit further progress in science or the arts is narrowly circumscribed. The challenged statute cannot be voided for lack of a durational limitation.

III

Our conclusion that California did not surrender its power to issue copyrights does not end the inquiry. We must proceed to determine whether the challenged state statute is void under the Supremacy Clause. No simple formula can capture the complexities of this determination; the conflicts which may develop between state and federal action are as varied as the fields to which congressional action may apply. "Our principal function is to determine whether, under the circumstances of this particular case, [the state] law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." *Hines v. Davidowitz*, 312 U. S. 52, 67 (1941). We turn then to federal copyright law to determine what objectives Congress intended to fulfill.

By Art. I, § 8, cl. 8, of the Constitution, the States granted to Congress the power to protect the "Writings" of "Authors." These terms have not been construed in their narrow literal sense but, rather, with the reach necessary to reflect the broad scope of constitutional principles. While an "author" may be viewed as an individual who writes an original composition, the term, in its constitutional sense, has been construed to mean an "originator," "he to whom anything owes its origin." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U. S. 53, 58 (1884). Similarly, although the word "writings" might be limited to script or printed material, it may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor. *Id.*, *Trade Mark Cases*, 100 U. S. 82, 94 (1879). Thus, recordings of artistic performances may be within the reach of Clause 8.

While the area in which Congress *may* act is broad, the enabling provision of Clause 8 does not require that Congress act in regard to all categories of materials which meet the constitutional definitions. Rather, whether any specific category of "Writings" is to be brought within the purview of the federal statutory scheme is left to the discretion of the Congress. The history of federal copyright statutes indicates that the congressional determination to consider specific classes of writings is dependent not only on the character of the writing, but also on the commercial importance of the product to the national economy. As our technology has expanded the means available for creative activity and has provided economical means for reproducing manifestations of such activity, new areas of federal protection have been initiated.¹⁷

17. The first congressional copyright statute, passed in 1790, governed only maps, charts, and books. Act of May 31, 1790, c. 15, 1 Stat. 124. In 1802, the Act was amended in order to grant protection to any person "who shall invent and design, engrave, etch or work . . . any historical or other print or prints. . . ." Act of April 29, 1802, c. 36, 2 Stat. 171. Protection was extended to musical compositions when the copyright laws were revised in 1831. Act of Feb. 3, 1831, c. 16, 4 Stat. 436. In 1865, at the time when Mathew Brady's pictures of the Civil War were attaining notoriety, photographs and photographic negatives were expressly added to the list of protected works. Act of Mar. 3, 1865, c. 123, 13 Stat. 540. Again in 1870, the list was augmented to cover paintings, drawings, chromos, statuettes, statuary, and models or designs of fine art. Act of July 8, 1870, c. 230, 16 Stat. 198.

In 1909, Congress agreed to a major consolidation and amendment of all federal copyright statutes. A list of 11 categories of protected work was provided. The relevant sections of the Act are discussed in the text of our opinion. The House Report on the proposed bill specifically noted that amendment was required because "the reproduction of various things which are the subject of copyright has enormously increased," and that the President has specifically recommended revision, among other reasons, because the prior laws "omit[ted] protection for many articles which, under modern reproductive processes, are entitled to protection." H. R. Rep. No. 2222, *supra*, n. 12, at 1 (quoting Samuel J. Elder and President Theodore Roosevelt).

Since 1909, two additional amendments have been added. In 1912, the list of categories in § 5 was expanded specifically to include motion pictures. The House Report on the amendment noted:

"The occasion for this proposed amendment is the fact that the production of motion-picture photoplays and motion pictures other than photoplays has become a business of vast proportions. The money invested therein is so great and the property rights so valuable that the committee is of the opinion that the copyright laws ought to be so amended as to give to them distinct and definite recognition and protection." H. R. Rep. No. 756, 62d Cong., 2d Sess., at 1 (1912).

Finally, in 1971, § 5 was amended to include "sound recordings." Con-

Petitioners contend that the actions taken by Congress in establishing federal copyright protection preclude the States from granting similar protection to recordings of musical performances. According to petitioners, Congress addressed the question of whether recordings of performances should be granted protection in 1909; Congress determined that any individual who was entitled to a copyright on an original musical composition should have the right to control to a limited extent the use of that composition on recordings, but that the record itself, and the performance which it was capable of reproducing were not worthy of such protection.¹⁸ In support of their claim, petitioners cite the House Report on the 1909 Act, which states:

“It is not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves, but only to give the composer or copyright proprietor the control, in accordance with the provisions of the bill, of the manufacture and use of such devices.” H. R. Rep. No. 2222, 60th Cong., 2d Sess., 9 (1909).

To interpret accurately Congress' intended purpose in passing the 1909 Act and the meaning of the House Report petitioners cite, we must remember that our modern technology differs greatly from that which existed in 1909. The Act and the report should not be read as if they were written today, for to do so would inevitably distort their intended meaning; rather, we must read them against the background of 1909 in which they were written.

In 1831, Congress first extended federal copyright protection to original musical compositions. An individual who possessed such a copyright had the exclusive authority to sell copies of the musical score; individuals who purchased such a copy did so for the most part to play the composition at home on piano or other instrument. Between 1831 and 1909, numerous machines were invented which allowed the composition to be reproduced mechanically. For example, one had only to insert a piano roll or disc with perforations in appropriate places into a player piano to achieve almost the same results which previously required

gress was spurred to action by the growth of record piracy, which was in turn due partly to technological advances. See Hearings on S. 646 and H. R. 6927, *supra*, n. 5, at 4-5, 11 (1971). It must be remembered that the “record piracy” charged against petitioners related to recordings fixed by the original producer prior to Feb. 15, 1972, the effective date of the 1971 Act. See p. 5, *supra*.

18. 17 U. S. C. § 1 (e).

someone capable of playing the instrument. The mounting sales of such devices detracted from the value of the copyright granted for the musical composition. Individuals who had use of a piano roll and an appropriate instrument had little if any need for a copy of the sheet music.¹⁹ The problems which arose eventually reached this Court in 1908 in the case of *White-Smith Music Publishing Co. v. Apollo Co.*, 109 U. S. 1 (1908). There, the Apollo Company had manufactured piano rolls capable of reproducing mechanically compositions covered by a copyright owned by appellant. Appellant contended that the piano rolls constituted "copies" of the copyrighted composition and that their sale, without permission, constituted an infringement of the copyright. The Court held that piano rolls, as well as records, were not "copies" of the copyrighted composition, in terms of the federal copyright statutes, but were merely component parts of a machine which executed the composition.²⁰ Despite the fact that the piano rolls employed the creative work of the composer, all protection was denied.

It is against this background that Congress passed the 1909 statute. After pointedly waiting for the Court's decision in *White-Smith Music Publishing Company*,²¹ Congress determined that the copyright statutes should be amended to insure that *composers of original musical works* received adequate protection to encourage further artistic and creative effort. Henceforth, under § 1(e), records and piano rolls were to be considered as "copies" of the original composition they were capable of reproducing, and could not be manufactured unless payment was made to the *proprietor of the composition copyright*. The section of the House Report cited by petitioners was intended only to establish the limits of the *composer's* right; composers were to have no control over the recordings themselves. Nowhere does the report indicate that Congress considered records as anything but a component part of a machine,

19. H. R. Rep. No. 7083, 59th Cong., 2d Sess., pt. 2, at 2 (1907) (Minority Report).

20. "After all, what is the perforated roll? The fact is clearly established on the testimony in this case that even those skilled in the making of these rolls are unable to read them as musical compositions, as those in staff notation are read by the performer. . . .

"These perforated rolls are parts of a machine which, when duly applied and properly operated in connection with the mechanism to which they are adapted, produce musical tones in harmonious combination. But we cannot think that they are copies within the meaning of the copyright act." 209 U. S., at 18.

21. H. R. Rep. No. 7083, *supra*, n. 19, Part I, at 10; Part II, at 3-4.

capable of reproducing an original composition²² or that Congress intended records, as *renderings of original artistic performance* to be free from state control.²³

Petitioners' argument does not rest entirely on the belief that Congress intended specifically to exempt recordings of performances from state control. Assuming that no such intention may be found, they argue that Congress so occupied the field of copyright protection as to preempt all comparable state action. *Rice v. Santa Fe Elevator Corporation*, 331 U. S. 218 (1947). This assertion is based on the language of 17 U. S. C. §§ 4 and 5, and on this Court's opinions in *Sears, Roebuck and Co. v. Stiffel Co.*, 376 U. S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting*, 376 U. S. 234 (1964).

Section 4 of the federal copyright laws provides:

"[T]he works for which copyrights may be secured under this Act shall include all writings of an author.

Section 5, which lists specific categories of protected works, adds:

22. This is especially clear from the comment made by the Committee on Patents in regard to a foreign statute which, to some extent, protected performances. The committee stated that the foreign statute "in no way affects the reproduction of such music by phonographs, graphophones, or the ordinary piano playing instruments, for in these instruments the reproduction is purely mechanical. H. R. Rep. No. 2222, *supra*, n. 12, at 5.

23. Petitioners do not argue that § 653h conflicts with that portion of 17 U. S. C. § 1(e) which provides:

"[W]henver the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of two cents on each such part manufactured.

Assuming *arguendo* that petitioners' use of the composition they duplicated constitutes a similar use, the challenged state statute might be claimed to diminish the return which is due the composer by lessening the number of copies produced, and thus to conflict with § 1(e). However, as we have noted above, the means presently available for reproducing recordings were not in existence in 1909 when 17 U. S. C. § 1(e) was passed. We see no indication that the challenged state statute detracts from royalties which Congress intended the composer to recover. Furthermore, many state statutes may diminish the number of copies produced. Taxing statutes, for example, may raise the cost of producing or selling records and thereby lessen the number of records which may be sold or inhibit new companies from entering this field of commerce. We do not see in these statutes the direct conflict necessary to render a state statute invalid.

“[T]he above specifications shall not be held to limit the subject-matter of copyright as defined in section four of this Act.”

Since § 4 employs the constitutional term “writings,”²⁴ it may be argued that Congress intended to exercise its authority over all works to which the constitutional provision might apply. However, in the more than 60 years which have transpired since enactment of this provision, neither the Copyright Office, the courts, nor the Congress has so interpreted it. The Register of Copyrights who is charged with administration of the statute, has consistently ruled that “claims to exclusive rights to mechanical recordings . . . or in the performance they reproduce” are not entitled to protection under § 4, 37 CFR § 202.8 (b) (1972).²⁵ With one early exception,²⁶ American courts have agreed with this interpretation;²⁷ and in 1971, prior to passage of the statute which extended federal protection to recordings fixed on or after Feb. 15, 1972, Congress acknowledged the validity of that interpretation. Both the House and Senate Reports on the proposed legislation recognized that recordings qualified as “writings” within the meaning of the Constitution, but had not previously been protected under the federal copyright statute. H. R. Rep. No. 92-487, 92d Cong., 1st Sess. (1971), at 2, 5; S. Rep. No. 92-72, 92d Cong., 1st Sess. (1971), at 4. In light of this consistent interpretation by the courts, the agency empowered to administer the copyright statutes, and Congress itself, we cannot agree that §§ 4 and 5 have the broad scope petitioners claim.

24. H. R. Rep. No. 2222, *supra*, n. 12, at 10.

25. The registration of records under the provisions of the 1909 Act would give rise to numerous administrative difficulties. It is difficult to discern how an individual who wished to copyright a record could comply with the notice and deposit provisions of the statute. 17 U. S. C. §§ 12, 13, 19, 20. Nor is it clear to whom the copyright could rightfully be issued or what constituted publication. Finally, the administrative and economic burden of classifying and maintaining copies of records would have been considerable. See Chafee, *Reflections on the Law of Copyright II*, 45 Col. L. Rev. 719, 735 (1945); Ringer, *The Unauthorized Duplication of Sound Recordings*, Studies Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, 86th Cong., 2d Sess., at 2 (1961); Hearings on S. 646 and H. R. 6927, *supra*, n. 5, at 11, 14.

26. *Fonotopia Limited v. Bradley*, 171 Fed. 951, 963 (EDNY 1909).

27. *Aeolian Co. v. Royal Music Roll Co.*, 196 Fed. 926, 927 (WDNY 1912); *Waring v. WDAS Broadcasting Station*, 327 Pa. 433, 437-438 (1937); *Capitol Records v. Mercury Records Corp.*, 221 F. 2d 657, 661-662 (CA2 1955); *Jerome v. Twentieth Century Fox-Film Corp.*, 67 F. Supp. 737, 742 (SDNY 1946).

Sears and Compco, on which petitioners rely, do not support their position. In those cases, the question was whether a State could, under principles of state unfair competition law, preclude the copying of mechanical configurations which did not possess the qualities required for the granting of a federal design or mechanical patent. The Court stated:

“[T]he patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition. Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article lacking the level of invention required for federal patents. To do either would run counter to the policy of Congress of granting patents only to true inventions, and then only for a limited time. Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws.” *Sears, Roebuck and Co. v. Stiffel Co.*, 376 U. S., at 230-231 (1964) (footnotes omitted).

In regard to mechanical configurations, Congress had balanced the need to encourage innovation and originality of invention against the need to insure competition in the sale of identical or substantially identical products. The standards established for granting federal patent protection to machines thus indicated not only which articles in this particular category Congress wished to protect, but which configurations it wished to remain free. The application of state law in these cases to prevent the copying of articles which did not meet the requirements for federal protection disturbed the careful balance which Congress had drawn and thereby necessarily gave way under the Supremacy Clause of the Constitution. No comparable conflict between state law and federal law arises in the case of recordings of musical performances. In regard to this category of “Writings,” Congress has drawn no balance; rather, they have left the area unattended, and no reason exists why the State should not be free to act.²⁸

28. Petitioners place great stress on their belief that the records or tapes which they copied had been “published.” We have no need to determine whether, *under state law*, those recordings had been published or what legal consequences such publication might have. *For purposes of federal law*, “publication” serves only as a term of the art which defines the legal relationships which Congress has adopted under the federal copyright statutes. As to categories of writings which Congress has not brought within the scope of the federal statute, the term has no application.

IV

More than 50 years ago, Justice Brandeis observed in dissent in *International News Service v. Associated Press*:

“The general rule of law is, that the noblest of human productions — knowledge, truths ascertained, conceptions, and ideas — become, after voluntary communications to others free as the air to common use.” 248 U. S. 215, 250 (1918).

But there is no fixed, immutable line to tell us which “human productions” are private property and which are so general as to become “free as the air.” In earlier times, a performing artist’s work was largely restricted to the stage; once performed, it remained “recorded” only in the memory of those who had seen or heard it. Today, we can record that performance in precise detail and reproduce it again and again with utmost fidelity. The California statutory scheme evidences a legislative policy to prohibit “tape” and “record piracy,” conduct that may adversely affect the continued production of new recordings, a large industry in California. Accordingly, the State has, by statute, given to recordings the attributes of property. No restraint has been placed on the use of an idea or concept; rather, petitioners and other individuals remain free to record the same compositions in precisely the same manner and with the same personnel as appeared on the original recording.

In sum, we have shown that § 653h does not conflict with the federal copyright statute enacted by Congress in 1909. Similarly, no conflict exists between the federal copyright statute passed in 1971 and the present application of § 653h, since California charged petitioners only with copying recordings fixed prior to February 15, 1972.²⁹ Finally, we have concluded that our decisions in *Sears* and *Compco*, which we reaffirm today, have no application in the present case, since Congress has indicated neither that it wishes to protect, nor to free from protection, recordings of musical performances fixed prior to February 15, 1972.

We conclude that the State of California has exercised a power which it retained under the Constitution, and that the challenged statute, as applied in this case, does not intrude into an area which Congress has, up to now, pre-empted. Until and unless Congress takes further action with respect to recordings fixed prior to February 15, 1972, the California statute may be enforced against acts of piracy such as those which occurred in the present case.

Affirmed.

29. *Supra*, at 6.

MR. JUSTICE DOUGLAS, with whom MR. JUSTICE BRENNAN and MR. JUSTICE BLACKMUN concur, dissenting.

Article I, § 8, cl. 8 of the Constitution provides:

“Congress shall have power . . . to promote the progress of science and useful arts, by reserving for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

Madison made a brief comment on this provision governing both patents and copyrights:

“The States cannot separately make effectual provisions for either of these cases and most of them have anticipated the decision of this point by laws passed at the instance of Congress.”¹

We have been faithful to that admonition. In *Sears Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225, 230-231, we said:

“Thus the patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition. Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents. To do either would run counter to the policy of Congress of granting patents only to true inventions, and then only for a limited time. Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws.”

An unpatentable article is “in the public domain and may be made and sold by whoever chooses to do so.” *Id.*, at 231. In that case we did not allow a State to use its unfair competition law to prevent copying of an article which lacked such novelty that it could not be patented. In a companion case, *Compco Corp. v. Day-Brite Lighting*, 376 U. S. 234, where an unfair competition charge was made under state law, we made the same ruling stating:

“Today we have held in *Sears, Roebuck & Co. v. Stiffel Co.*, *supra*, that when an article is unprotected by a patent or a copy-

1. Federalist No. 43.

right, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

Prior to February 25, 1972, copyright protection was not extended to sound recordings. *Sears* and *Compro* make clear that the federal policy expressed in Art. I, § 8, cl. 8, is to have "national uniformity in patent and copyright laws," 376 U. S., at 231, a policy bolstered by Acts of Congress which vest exclusive jurisdiction to hear patent and copyright cases in federal courts . . . and that section of the Copyright Act which expressly saves state protection of unpublished writings but does not include published writings." *Ibid.*

Prior to February 15, 1972,² sound recordings had no copyright protection. And even under that Act the copyright would be effective "only to sound recordings fixed, published, and copyrighted on and after the effective date of this Act (February 15, 1972) and before January 1, 1975."³

California promotes in her law monopoly; the federal policy promotes monopoly only when a copyright is issued, and it fosters competition in all other instances. Moreover, federal law limits its monopoly to 28 years plus a like renewal period,⁴ while California extends her monopoly into perpetuity.

Cases like *Sears* were surcharged with "unfair competition" and the present one with "pirated recordings." But free access to products on the market is the consumer interest protected by the failure of Congress to extend patents or copyrights into various areas. The drive for monopoly protection is strong as evident from a reading of the Committee Reports on the 1971 Act.⁵ Yet Congress took but a short step, setting up a trial period to consider the new monopoly approach. It was told that state laws, such as we have in this case, were being challenged on the ground that the Federal Constitution had pre-empted the field, even in absence of a provision for making it possible to obtain a copyright for sound recordings. But the House Committee made only the following comment:

2. The effective date of Pub. L. 92-140, 85 Stat. 391, 53.

3. *Id.*, § 3.

4. 17 U. S. C. § 24.

5. H. R. Rep. No. 92-487, 92d Cong., 1st Sess.; S. Rep. No. 92-72, 92d Cong., 1st Sess.

“While the committee expresses no opinion concerning this legal question, it is clear that the extension of copyright protection to sound recordings would resolve many of the problems which have arisen in connection with the efforts to combat piracy in State courts.”

The Department of Justice in commenting on the proposals that resulted in the 1971 Act told the House:⁶

“We believe that extending copyright to reproduction of sound recordings is the soundest, and in our interpretation of *Sears and Compco*, the only way in which sound recordings should be protected. Copyright protection is narrowly defined and limited in duration, whereas state remedies, whose validity is still in doubt, frequently create broad and unwarranted perpetual monopolies. Moreover, there is an immediate and urgent need for this protection.”

The need for uniformity was stated by Judge Learned Hand in a dissent in *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F. 2d 657. That case involved the duplication of uncopyrighted sound recordings, the court holding that state law prevailed where there was no federal copyright provision. Judge Hand emphasized in his dissent that “uniformity” was one of the principal purposes of the Patent and Copyright Clause and that “uniformity could be obtained only by preemption.” He said:

“If, for example in the case at bar, the defendant is forbidden to make and sell these records in New York, that will not prevent it from making and selling them in any other state which may regard the plaintiff’s sales as a ‘publication’; and it will be practically impossible to prevent their importation into New York. That is exactly the kind of evil at which the clause is directed.”

I would reverse the judgment below.

MR. JUSTICE MARSHALL, with whom MR. JUSTICE BRENNAN and MR. JUSTICE BLACKMUN join, dissenting.

The argument of the Court, as I understand it, is this: Art. I, § 8, cl. 8, of the Constitution gives Congress the power “to promote the

6. H. R. Rep., *supra*, n. 5, at 3.

7. *Id.*, at 13.

Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The Framers recognized that individual States might have peculiarly local interests that Congress might not consider worthy of attention. Thus, the constitutional provision does not, of its own force, bar States from promoting those local interests. However, as the Court noted in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225 (1964), with respect to every particular item within general classes enumerated in the relevant statutes, Congress had balanced the need to promote invention against the desire to preserve free competition, and had concluded that it was in the national interest to preserve competition as to every item that could not be patented. That is, the fact that some item could not be patented demonstrated that, in the judgment of Congress, it was best to let competition in the production of that item go unrestricted. The situation with regard to copyright is said to be similar. There Congress enumerated certain classes of works for which a copyright may be secured. 17 U. S. C. § 5. Its silence as to other classes does not reflect a considered judgment about the relative importance of competition and promotion of "Science and useful Arts." Thus, the Court says, the States remain free to protect as they will "writings" not in the enumerated classes, until Congress acts. Since sound recordings fixed prior to February 15, 1972, were not enumerated by Congress as subject to copyrighting,¹ the States may protect such recordings.

With respect, I cannot accept the final step of this argument. In my view, Congress has demonstrated its desire to exercise the full grant of constitutional power. Title 17, U. S. C. § 4 states: "The works for which copyright may be secured under this title shall include *all the writings of an author*" (emphasis added). The use of the constitutional terms "writings" and "author" rather strongly suggests that Congress intended to follow the constitutional grant. It could exercise the power given it by the Constitution in two ways: either by protecting all writings, or by protecting all writings within designated classes and leaving open to competition all writings in other classes. Section 5 shows that the latter course was chosen, for it enumerates various classes of works that may be registered.² Ordinarily, the failure to enumerate "sound

1. Sound recordings fixed after that date may be copyrighted. Pub. L. 92-140, 85 Stat. 391 (1971), 17 U. S. C. § 5 (n) (Supp. I, 1971).
2. From the language of § 4 and the proviso of § 5, it could be rather strongly argued that Congress had intended to afford protection to every writing. I agree with the Court, however, that the consistent administrative interpretation of those sections, in conjunction with the practical difficulty of applying to novel cases certain statutory requirements, like that requiring place-

recordings" in § 5 would not be taken as an expression of Congress' desire to let free competition reign in the reproduction of such recordings, for, because of the realities of the legislative process, it is generally difficult to infer from a failure to act any affirmative conclusions. Cf. *Cleveland v. United States*, 329 U. S. 14, 22 (1946) (Rutledge, J., concurring). But in *Sears* and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U. S. 234 (1964), the Court determined that with respect to patents and copyrights, the ordinary practice was not to prevail. In view of the importance of not imposing unnecessary restraints on competition, the Court adopted in those cases a rule of construction that, unless the failure to provide patent or copyright protection for some class of works could clearly be shown to reflect a judgment that state regulation was permitted, the silence of Congress would be taken to reflect a judgment that free competition should prevail. I do not find in *Sears* and *Compco* a limitation on that rule of construction to general classes that Congress has enumerated although of course on the facts of those cases only items in such classes were involved; rather, the broader language was used in those cases.³ Nor can I find in the course of legislation sufficient evidence to convince me that Congress determined to permit state regulation of the reproduction of sound recordings. For whenever technological advances made extension of copyright protection seem wise, Congress has acted promptly. See *ante*, n. 17.⁴ This seems to me to reflect the same judgment that the Court

ment of the notice of copyright on every copy, 17 U. S. C. § 10, precludes such an argument.

3. It bears noting that in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225 (1964), repeatedly referred to the patent and copyright statutes as if the same rules of interpretation applied to both. See, e. g., 396 U. S., at 228, 231 n. 7; *Compco Corp. v. Day-Brite Lighting Inc.*, 376 U. S. 234, 237 (1964).
4. Between 1909 and 1951, Congress' attention was repeatedly drawn to problems of copyrighting sound recordings. Many bills to provide copyright protection for such recordings were introduced, but none were enacted. See Ringer, *The Unauthorized Duplication of Sound Recordings 21-37* (Study No. 26 of Studies Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, 86th Cong., 2d Sess.) (1961). Respondent argues that Congress failed to enact these bills primarily out of uncertainty about the relationship between federal law and international copyright conventions, and was comforted in the knowledge that protection was available under state law. See Brief for Respondent, 28-32. However, it is enough that Congress was aware of the problem, and could have acted, as it did when other technological innovations presented new problems, rather expeditiously. The problems that Congress confronted in 1971 did not spring up in 1970, but had existed, and Congress had not acted, for many years before.

found in *Sears and Compco*: Congress has decided that free competition should be the general rule, until it is convinced that the failure to provide copyright or patent protection is hindering "the Progress of Science and useful Arts."

The business of record piracy is not an attractive one; persons in the business capitalize on the talents of others without needing to assess independently the prospect of public acceptance of a performance. But the same might be said of persons who copy "mechanical configurations." Such people do provide low-cost reproductions that may well benefit the public. In light of the presumption of *Sears and Compco* that congressional silence betokens a determination that the benefits of competition outweigh the impediments placed on creativity by the lack of copyright protection, and in the absence of a congressional determination that the opposite is true, we should not let our distaste for "pirates" interfere with our interpretation of the copyright laws. I would therefore hold that, as to sound recordings fixed before February 15, 1972, the States may not enforce laws limiting reproduction.

275. *Fame Publishing Co., Inc. v. S & S Distributors, Inc., et al.*, 177 U.S.P.Q. 358 (D. Alabama, February 6, 1973) (Lynne, J.). Compare *Columbia Broadcasting System, Inc. v. Melody Recordings, Inc.*, Item 276, *infra*.

Motion for preliminary injunction in action for infringement of copyright by unauthorized recording of musical compositions. Defendants, who recorded plaintiff's compositions by duplicating ("pirating") prior recordings thereof, asserted compliance with the compulsory license provisions of the U.S. Copyright Act [17 U.S.C. §1(e)] by filing appropriate notices and tendering of statutory royalties. Plaintiff's mechanical rights agency refused to accept such royalties on the grounds that duplication of prior recordings was a use outside the scope of the compulsory license. *Held*, motion granted, the court saying:

The use made by the defendants of the plaintiff's copyrighted musical compositions is not a 'similar case' as the term is used in [the compulsory license provision of the Copyright Act] 17 U.S.C. §1(e), but is an 'identical use' of such composition not sanctioned by §1(e). A compulsory licensee acquires no right to duplicate or reproduce the recordings of another. Anyone who seeks to rely on the compulsory license premium must hire some musicians, take them into a studio and make his own recording. . . .

. . . .

It is not lightly to be inferred that Congress in carving out the compulsory licensing exception to the otherwise exclusive rights of the copyright proprietor, intended thereby to sanction the type of activity in which defendants engage. The compulsory licensing system was designed to encourage various recordings of musical compositions. To permit duplication of existing recordings under compulsory licensing would have the opposite effect. Rather than encourage a multiplicity of recordings it would obviously discourage the production of new recordings.”

2. State Court Decisions

276. *Columbia Broadcasting System, Inc. et al. v. Melody Recordings, Inc., et al.* Not yet reported (N.J. Super. Ct., May 28, 1973) (Kummelman, J.). *Compare Fame Publishing Co., Inc. v. S & S Distributors, Inc.*, Item 275, *supra*.

Cross motions for summary judgment in class action for common law copyright infringement and unfair competition by tape and record producers against unauthorized duplicators (“pirates”). Defendants relied on their asserted compliance with the compulsory license provisions of the U.S. Copyright Act [17 U.S.C. §1(e)] and payment of statutory royalties to the proprietors of copyright in the recorded musical compositions. Plaintiffs argued that the availability of a compulsory license for recording the musical compositions did not sanction duplication of the prior recorded performances thereof.*

Held, summary judgment for defendants.

Noting conflicting decisions on the issue, the court concluded that common law relief against unauthorized duplication of sound recordings was barred by the Supreme Court decisions in *Sears, Roebuck & Co. v. Stiffel Company*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Bright Lighting Inc.*, 376 U.S. 234 (1964). The court refused to accept the distinction made in some cases between mere copying, insulated from common law relief by *Sears and Compco*, and actionable “appropriation” of a competitor’s product, stating in part:

[The] issue for decision depends upon whether Congress intended to permit upon compliance with the compulsory licensing provisions unlimited mechanical reproduction of musical recordings

* The “pirated” recordings at bar were fixed before February 15, 1972 and hence ineligible for copyright under the recent Sound Recordings Amendment to the U.S. Copyright Act.

by means of pirating and whether such pirating can be prohibited by resort to state laws dealing in general with the subject of unfair competition. Included within such issue is whether congressional enactments in this area have preempted state unfair competition laws insofar as pirated recordings are concerned.

The subject is complex and divergent decisions have emanated from various judicial districts. . . .

The difficulty arises from the lack of any uniform interpretation concerning the Supreme Court's holdings in [*Sears and Compco*] and from uncertainty as to whether *Sears and Compco* undercut the ruling in *International News Service v. Associated Press*, 248 U.S. 715, 39 S.Ct. 68 (1918). . . .

Based upon my review, I conclude that the Supreme Court's decisions in *Sears* and *Compco* are controlling and dispositive of the issues here involved. In *Sears*, it appeared that Sears at relatively small expense manufactured and marketed a substantially identical copy of a pole lamp originally designed, manufactured and marketed by Stiffel. The issue as posed by the Supreme Court was whether a state's unfair competition laws can, consistently with the federal patent laws, impose liability for or prohibit the copying of an article if protected by neither a federal patent nor a copyright. . . .

Sears specifically held that because of the federal patent laws, a state may not, when the article is unpatented and uncopyrighted prohibit the copying of the article itself or award damages for such copying.' (376 U.S. at 232). If otherwise, the Court reasoned, perpetual state protection by use of its unfair competition laws would be granted to an article which federal law has said belongs to the public by simple virtue of its lack of entitlement to patent or copyright protection.

In *Compco*, which involved the identical copying of a distinctive but unpatentable fluorescent lighting fixture, the Court again rejected the application of state unfair competition laws reiterating its holding in *Sears* as follows:

' . . . when an article is unprotected by a patent or copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy found in Art. I, §8, cl. 8, of the Constitution and in the implementing statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.' (376 U.S. at 237).

International News Service v. Associated Press, *supra*, which preceded *Sears* and *Compco* by some 46 years, under *Pre-Erie R. R.*

Co. v. Tompkins doctrine invoked a general federal common law of 'unfair competition' to prevent I.N.S. from copying news bulletins from early editions of newspapers serviced by Associated Press. In effect, I.N.S. was held to have wrongfully pirated and published as its own, uncopyrighted news which A.P. had gathered. As above noted, a question exists as to the continuing vitality of the ruling by the United States Supreme Court in that case. . . .

While some courts . . . have found a distinction between the copying of an unpatented design and the exact duplication of a recorded musical composition I find, conceptually, such distinction to be meaningless. There is absolutely no difference in the end result when Sears makes a mold from a lamp pole designed and produced at great expense by Stiffel or when a so-called "pirate" makes an exact duplicate of a recording produced at great expense by C.B.S. Although the means may differ, the end result is exactly the same. . . . In each instance a businessman has appropriated the unpatented or uncopyrighted product of another and placed on the market as his own an identical product. To draw a distinction in the case of 'pirating' or 'disklegging' is to invent a difference without substance. The rights of the parties cannot be made to rest on so fine a subtlety.

No comment is required as to the morality or ethics of the business practice involved. The federal intendment is clear. In the absence of patent protection or copyright protection exact copies or duplicates may be made by anyone. If a person is not an infringer under federal patent or copyright law and thereby insulated from liability, a contrary result in state courts is not dictated simply because the very same conduct is earmarked by a different label. To allow state law to prohibit such copying or duplication would be to afford state protection in a federal area where Congress itself has provided for none."

3. Also of Interest

277. *Ballard H. T. Kirk & Associates, Inc. v. Poston, et al.*, 177 U.S.P.Q. 92 (Ohio Ct. App., July 24, 1972) (Hess, J.).

Plaintiff's appeal from judgment dismissing the complaint in action for infringement of common law copyright in architectural plans and drawings. *Held*, affirmed. The court concluded that since plaintiff's complaint alleged that it had permitted a certain developer to use its plans in constructing an apartment project and did *not* allege that

provision of the plans to the developer "was made with any express restrictions, reservations or other limitations by means of an agreement, annotation on the plans, or otherwise, concerning the use and dissemination of such plans," the complaint acknowledged a general publication divestive of common law rights.

278. *The C. M. Paula Company v. Logan*, 355 F. Supp. 189 (D. Texas, March 5, 1973) (Mahon, J.).

Action for copyright infringement. Plaintiff creates and markets various greeting cards and items of stationery bearing copyrighted artwork and design features; defendant purchased plaintiff's cards and stationery at retail and through an emulsion or similar technique stripped the designs therefrom and transferred them to ceramic plaques.*

Held, copyright relief denied; limited injunction granted to avoid public confusion.

The court concluded that since defendant used the actual original images marketed by plaintiff he did not violate plaintiff's exclusive right to "copy" or "adopt" its work. The court said:

"The Court notes at the outset that without copying there can be no infringement of copyright. Further, plaintiff has the burden of establishing that there has been a copying — a 'reproduction or duplication' of a thing.

The process utilized by defendant that is now in question results in the use of the original image on a ceramic plaque; such process is not a 'reproduction or duplication'.

. . . . Each ceramic plaque sold by defendant with a Paula print affixed thereto requires the purchase and use of an individual

* Plaintiff described the technique used by defendant as "involving the use of acrylic resin, emulsions, or similar compounds which act as a transfer medium to strip the printed indicia from the original surface on which it is printed, whereupon the image-carrying film is applied to another article, such as the plaster base of a wall plaque. In effect, a decal picture is created. In a typical example of this type of transfer technique, the print to be transferred is first coated with a number of coatings of the resin emulsions to form a film. . . . After the applied coatings are thoroughly cured, the coated print is soaked in water to thoroughly wet the paper backing on which the picture was initially printed, whereupon the paper backing is peeled away, with the picture forming printing ink adhered to the resin film, which is insoluble in water. The rear surface of the film containing the transferred image is then coated with one or more additional layers of the resin emulsion, whereupon the film is adhered to a new support, such as a ceramic plaque, plate, or the like,"

piece of artwork marketed by the plaintiff. For example, should defendant desire to make one hundred ceramic plaques using the identical Paula print, defendant would be required to purchase one hundred separate Paula prints. The Court finds that the process here in question does not constitute copying. . . .

It is also urged by plaintiff that the making of the ceramic plaques here shown would be an adaptation protected by the Copyright Act and that *National Geographic Soc. v. Classified Geographic*, 27 F. Supp. 655 (D. Mass. 1939), should herein be controlling. There the defendant disassembled plaintiff's periodicals, reorganized them and sold them as new publications. The Court said that defendant's acts 'amounted to a compilation or an 'adaption' (sic) or an 'arrangement' of copyrighted works . . .' 27 F. Supp. at 660. This court does not believe the process here in question results in a compilation, adaptation, or arrangement as those terms are contemplated by Section 7 of the Copyright Act."

The court also found that the "first sale" doctrine, under which the right to control sales or other dispositions of copies of a protected work is exhausted upon the first authorized sale of each such copy, precluded any violation of plaintiff's right to "vend" its work.

Although concluding that defendant did not infringe plaintiff's copyright (and thus denying an injunction against defendant's continued production of ceramic plaques incorporating transfers of plaintiff's works), the court was ". . . of the opinion that some action should be taken to insure that no confusion exists in the marketplace as to the source of defendant's product. [Thus] defendant is [ordered] to indicate on the back of all of its products upon which appear any of plaintiff's copyrighted artworks, by plainly visible label or stamp in easily readable letters of the same size, the following: 'Artwork hereon is copyrighted design of C. M. Paula Co. which is in no way connected with L. Gene Logan Co., manufacturer of this plaque'."

279. *Rosemont Enterprises, Inc. v. Urban Systems, Inc.*, N.Y.L.J., January 23, 1973 at 16 Col. 5 (Sup. Ct. N.Y. Co., 1973) (Amsterdam, J.). Action for violation of N.Y. Civil Rights Law §§ 50 & 51 (Right of Privacy). Defendants marketed a game entitled "The Howard Hughes Game" based upon biographical data of the life of Howard Hughes. Plaintiff Hughes did not consent to either the use of his name or biographical data and asserted that the unauthorized use of his name violated the Civil Rights Law's prohibitions against use of one's name for purposes of advertising or trade. Defendant asserted that its product

was in the nature of an expositive biography of a public figure and hence outside the prohibitions of the Civil Rights Law. Noting the "paucity of decisions having to do with [this] peculiar set of facts," the court *held* that plaintiff Hughes stated a valid cause of action and was entitled to judgment. The court said:

"Apparently the success or failure of either party to this action depends upon how this court chooses to characterize 'The Howard Hughes Game'. Is it free from proscription by sections 50 and 51 of the Civil Rights Law because it merely restates in another form the events of the Hughes career. Can it logically be considered another form of distributive publication as any biography, magazine article, or motion picture would be; or, on the other hand, should the marketing and distribution of 'the game' be characterized as an act of appropriation. . . .

This court by an earlier decision established that plaintiff, a person of well publicized exploits and achievement, had no statutory or common law right to the exclusive commercial exploitation of his personality in biographical form (*Rosemont Enterprises, Inc. v. Random House, Inc.*, 58 Misc. 2d 1; *aff'd* without opinion, 32 A. D. 2d 892) [see 16 BULL. CR. SOC. 51, Item 33 (1968)]. The courts, however, have permitted recovery where a person's name, . . . picture or other likeness has been used without consent to advertise the defendant's product or to accompany an article sold. The present situation, however, is somewhat unique in that the commodity or article sold is closely identifiable with the major events in plaintiff's career.

. . . . Defendants rely most heavily on *Paulsen v. Personality Posters, Inc.*, 59 Misc. 2d 444 [16 BULL. CR. SOC. 177, Item 147 (1969)] where this court determined that plaintiff, a well known comedian, could not enjoin the defendant from marketing a poster which was derived substantially from a photograph owned by him but issued to defendant. Similar to the present situation, *Paulsen* never consented to the photograph being used for a poster.

However, this court treated the poster as an alternate form of distributive publication and exempted it from the proscription of the Civil Rights Law (*Paulsen v. Personality Posters, Inc.*, *supra*, p. 448). The *Paulsen* case is unique to its facts and must be so considered.

The instant action is quite clearly premised upon an appropriation for commercial exploitation of plaintiff's property rights in his name and career rather than upon an injury to feelings. There is

no question but that a celebrity has a legitimate proprietary interest in his public personality. He must be considered as having invested years of practice and competition in a public personality which eventually may reach marketable status. That identity is a fruit of his labors and a type of property. . . . The question apparently is where does one draw the line between the right of the public to 'know' and an act of appropriation. In reality, defendants are not disseminating news. They are not educating the public as to the achievements of Howard Hughes. They are selling a commodity, a commercial product, an entertaining game of chance, the outcome of which is determined by maneuvering tokens on a game board by the throw of the dice. The use of plaintiff's name, biographical data, etc. in this context is not legitimate to the public interest. It is merely the medium used to market a commodity familiar to us all in its varied types and forms. Use for such purposes is an act of appropriation of those property rights belonging to plaintiff Hughes. . . . Although that conclusion is reached in the present circumstances, the court does not wish or intend to formulate a hard and fast rule. As the Paulsen case, *supra*, would indicate this area of the law is plastic. Each case must be decided by weighing conflicting policies; the public interest in free dissemination of information, against the interest in the preservation of inviolate personality and property rights. Among the relevant factors in such decisions are the media used, the nature of the subject matter, and the extent of the actual invasion of privacy. . . . The court however in the present situation has no difficulty in finding that the marketing and publication of the game is violative of the Civil Rights Law. Plaintiffs, therefore, have not only stated a cause of action, but are entitled to relief.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

280. COPYRIGHT LAW SYMPOSIUM, No. 20. New York, Columbia University Press, 1972. 217 p. (Nathan Burkan Memorial Competition, 1970).

The prize essays are analyzed separately, *infra*.

281. TEBBEL, JOHN. The creation of an industry, 1630-1865. New York, R.R. Bowker, 1972. 646 p. (In *his* A History of book publishing in the United States, vol. 1).

The first volume of a projected three-volume, comprehensive history of book publishing, which includes such topics as copyright, best sellers, bookselling, censorship, book piracies, and the economics of publishing.

2. Foreign Publications

282. NATIONAL COUNCIL FOR EDUCATIONAL TECHNOLOGY. *Working Group on Rights*. Copyright and education; a guide to the use of copyright material in educational institutions. [London] National Council for Educational Technology [1972]. 91 p. (Working paper no. 8).

"The present Working Paper describes matters of copyright [in Great Britain] as they concern the teacher who uses copyright material."

B. LAW REVIEW ARTICLES

1. United States

283. ADAMS, PAUL E. Superman, Mickey Mouse and gerontology. *Journal of the Beverly Hills Bar Association*, vol. 6, no. 5 (Nov.-Dec. 1972), pp. 6-12.

An article on the protectibility of a cartoon character, with special reference to the "life span" of such protection.

284. AMERICAN ASSOCIATION OF LAW LIBRARIES. *65th Annual Meeting, July 2-6, 1972*. General session on copyright. Moderator: Marian G. Gallagher. Panelists: Jack S. Ellenberger, Carleton W. Kenyon, Julius J. Marke, Peyton R. Neal, Jr., and Ervin C. Surrency. *Law Library Journal*, vol. 65, no. 4 (Nov. 1972), pp. 443-453.

The session was devoted to a discussion of Commissioner Davis' report to the Court in the case of *Williams & Wilkins Co. v. United States*, 172 USPQ 670, 19 BULL. CR. SOC. 361, Item 255 (Ct. Cl. 1972).

285. Are computer programs ever patentable? Did the Patent Office win? *BNA's Patent, Trademark & Copyright Journal*, no. 124 (Apr. 19, 1973), pp. C1-C6.

An analysis of the decision in the case of *Gottschalk v. Benson*, 409 U.S. 63 (1972), in which a conclusion is reached that the "decision does not resolve the question of computer program patentability and alternatives to patent protection leave much to be desired."

286. Copyrights — infringement by photocopying. *Texas Law Review*, vol. 51, no. 1 (Dec. 1972), pp. 137-148.

A note on the report of Commissioner Davis in the case of *Williams & Wilkins Co. v. United States*, 172 U.S.P.Q. 670, 19 BULL. CR. SOC. 361, Item 255 (Ct. Cl. 1972).

287. GAWTHROP, ROBERT S., III. An inquiry into criminal copyright infringement. *Copyright Law Symposium*, no. 20 (1972), pp. 154-169.

An essay, awarded Honorable Mention in the 1970 Nathan Burkan Memorial Competition, which examines "the law of criminal copyright infringement in an effort to determine exactly what constitutes the substantive and procedural law in that field, to raise questions potential to or already realized in its administration, and to suggest possible solutions to these problems."

288. KNIGHT, LOUISE O. Permissible uses of copyrighted music in a broadcast licensee's "in house" productions of commercials. *Federal Communications Bar Journal*, vol. 25, no. 3 (1973), pp. 177-250.

"The discussion to follow will approach the question in three phases. First, a review will be undertaken of the specific rights afforded under the Copyright Act to the owner of a copyrighted composition; in addition, the possible protection available to musical works under state law will be examined. Second, the rights

of the broadcast licensee in using copyrighted music in its local spot announcement productions will be explored; specific recommendations will be offered as to the precautions a broadcast licensee should take before appropriating copyrighted music for commercial use. The article will then conclude with a brief review of the effect which the still pending general revision of the Copyright Act will have upon the use of copyrighted music in local broadcast commercials."

289. KURLANTZICK, LEWIS S. The constitutionality of state law protection of sound recordings. *Connecticut Law Review*, vol. 5, no. 2 (Fall 1972), pp. 204-254.

"This article is part of a more comprehensive treatment of record duplication, which will appear in the near future. The forthcoming article will attempt to determine the need for protection against duplication, and to define the dimensions of an optimal balance between the requirements of record producers for protection and the interests of the public in the widest dissemination of music at the lowest possible prices. The article rejects most of the traditional arguments for protection and attempts a more intensive and sophisticated inquiry than Congress has undertaken in its ongoing revision of current copyright legislation. The article concludes that although record producers require some measure of protection, they need less protection than they have requested and than Congress seems prepared to give them."

290. MACLEAN, ANN W. Education and copyright law: an analysis of the amended copyright revision bill and proposals for statutory licensing and a clearinghouse system. *Copyright Law Symposium*, no. 20 (1972), pp. 1-35.

A paper, awarded National First Prize in the 1970 Nathan Burkan Memorial Competition, which was first published in 56 Va. L. Rev. 664 (1970). See 18 BULL. CR. SOC. 274, Item 151 (1971).

291. MEADOW, ROBIN. Television formats—the search for protection. *Copyright Law Symposium*, no. 20 (1972), pp. 72-111.

"This paper [awarded National Third Prize in the 1970 Nathan Burkan Memorial Competition] will discuss the writer's need for legal protection of his format, the protection currently available, and a new approach to protection which conforms to present commercial realities."

292. PANTLE, W. DAVID. Copyright practice and Colorado lawyers. *The Colorado Lawyer*, Sept. 1972, pp. 7-12.

A brief, informational presentation of U.S. copyright law for the general practitioner, with special attention to the Colorado bar.

293. PAVELIC, RADOVAN. The protection of private rights in a socialist state: recent developments in Yugoslav copyright law. *Harvard International Law Journal*, vol. 14, no. 1 (Winter 1973), pp. 111-130.

"This Comment will analyze the major changes that have resulted from the 1968 copyright law revisions. These changes will be discussed against an introductory historical backdrop of Yugoslav copyright law and a brief description of the constitutional bases of copyright in that country. After surveying the 1968 revisions, the major procedures for enforcing copyright guarantees will be explained. The final section will consider the impact of copyright reform on other areas of the Yugoslav legal system."

294. SCHRADER, DOROTHY M. Sound recordings: protection under state law and under the recent amendment to the Copyright Code. *Arizona Law Review*, vol. 14, no. 4 (1972), pp. 689-715.

An examination of the status of sound recordings fixed before the effective date of the amendment and an analysis of the impact of that enactment on present copyright doctrine.

295. SINCLAIR, KENT, JR. Liability for copyright infringement — handling innocence in a strict-liability context. *Copyright Law Symposium*, no. 20 (1972), pp. 36-72.

An essay, awarded National Second Prize in the 1970 Nathan Burkan Memorial Competition, which was adapted from the author's comment, published under the same title in 58 Calif. L. Rev. 940 (1970). See 18 BULL. CR. SOC. 454, Item 410 (1971).

296. SPIRER, JULIAN H. In re Johannesburg Operatic and Dramatic Society v. Music Theatre International: boycott of the South African stage. *Copyright Law Symposium*, no. 20 (1972), pp. 140-153.

An expanded version of this paper, which was awarded National Fifth Prize in the 1970 Nathan Burkan Memorial Competition, appears at 11 HARV. INT'L L. J. 565 (1970) under the title "Copyright — Application of South African Compulsory Licensing

Provision to Americans." See 18 BULL. CR. SOC. 275, Item 156 (1971).

297. STANTON, LAURENCE A. "Expression" and "originality" in copyright law. *Washburn Law Journal*, vol. 11, no. 3 (Spring 1972), pp. 400-417.

"This paper was entered in the Nathan Burkan Memorial Competition May 1972."

298. STORK, PHILIP. Legal protection for computer programs: a practicing attorney's approach. *Copyright Law Symposium*, no. 20 (1972), pp. 112-139.

An essay, awarded National Fourth Prize in the 1970 Nathan Burkan Memorial Competition, which examines the problems and uncertainties surrounding the legal protection of computer programs.

2. Foreign

1. In English

299. BRACK, HANS. Aspects of the Legal Committee's work within the framework of the EBU 1965-1972. *EBU Review: Programmes, Administration, Law*, vol. 24, no. 1 (Jan. 1973), pp. 37-43.

A survey of the activities of the Legal Committee of the European Broadcasting Union during the period when the author was its chairman.

300. DESJEUX, XAVIER. Photocopying and copyright. *Copyright*, vol. 9, no. 3 (Mar. 1973), pp. 51-56.

After an introductory statement on the proliferation of photocopying practice, "leading to a disregard for the protection afforded by the law to the author of a literary, artistic or scientific work," the pertinent French, comparative, and international laws are examined, and, "the elements of a solution" are considered.

301. GRASSI, ALESSANDRO. Notes on the protection of photographs. *EBU Review: Programmes, Administration, Law*, vol. 24, no. 1 (Jan. 1973), pp. 53-57.

A "brief outline of the protection of the photographic work in the development it has undergone both in the Berne Conven-

tion and under Italian law," written in the light of a recent decision of the Italian Constitutional Court "in a knotty international copyright problem concerning the coordination between the provisions of the Italian Copyright Act and those of the Berne Convention on the protection of photographs."

302. Intergovernmental Committee Established Under Article 32 of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations. *Extraordinary Session, ILO, Geneva, 21-22 September 1972*. [Proceedings] *Unesco Copyright Bulletin*, vol. 6, no. 4 (1972), pp. 7-14. Contents: Working documents. Report. List of participants.

The Committee was "convened to discuss the implications for the Rome Convention of recent developments which raise major problems for the protection of performers, record manufacturers and broadcasters. ILO believed that the Rome Convention offered the best framework for satisfactory solution of these complicated questions."

303. N'DIAYE, N'DENE. Letter from Senegal: creation of the Copyright Office of Senegal. *Copyright*, vol. 9, no. 4 (Apr. 1973), pp. 79-81.

A brief description, by the Director General, of the Senegal Copyright Office (Bureau sénégalais du droit d'auteur), which "has been operational only since December 1, 1972."

304. REIMER, DIETRICH. The right of distribution with special reference to the hiring and lending of books and records. *Copyright*, vol. 9, no. 3 (Mar. 1973), pp. 56-62.

A comparative study which examines the reasons for favoring the legal regulation of the right of distribution and the advantages this would contribute toward effective copyright protection, with a conclusion that "[i]t should be acknowledged that the author has to be paid equitable remuneration when copies which have been distributed with his consent are hired or loaned by a third party for profit-making purposes."

305. UNITED NATIONS EDUCATIONAL, SCIENTIFIC AND CULTURAL ORGANIZATION. Rough first draft of a model law concerning the protection of performers, producers of phonograms, and transmitting organizations. *Unesco Copyright Bulletin*, vol. 6, no. 4 (1972).

The draft "was prepared for the purpose of illuminating the problems involved rather than of suggesting solutions to them. The

draft is intended to elicit criticism on both substantive issues and technical points of drafting, and thereby lead to further drafts that are more substantively viable and technically sound." Cf. "Brief commentary on rough first draft of model neighboring rights law" at pp. 23-26 of the same issue of the *Copyright Bulletin*.

2. In French, English & Spanish

306. DESJEUX, XAVIER. La mise en scène de théâtre est-elle une oeuvre de l'esprit? A propos de l'arrêt Darnel du 8 juillet 1971. *Revue Internationale du Droit d'Auteur*, no. 75 (Jan. 1973), pp. 42-83.

A comment on a July 8, 1971, French decision of the Court of Paris, in which the Court recognized a theatrical production as an intellectual work under the French copyright law, noting "the originality of the means used by (the producer) to express visually the thought of the authors of the work."

307. IONASCO, OVIDIU. La protection du droit d'auteur dans les pays socialistes. *Revue Internationale du Droit d'Auteur*, no. 75 (Jan. 1973), pp. 84-133.

A survey of copyright protection in the socialist countries of Europe.

308. UNGERN-STERBERG, JOACHIM VON. La transmission d'émissions de radiodiffusion par satellites et le droit d'auteur. *Revue Internationale du Droit d'Auteur*, no. 75 (Jan. 1973), pp. 2-41.

A study which seeks to determine the legal status of communications satellites in relation to copyright.

3. In German

309. DILLENZ, WALTER. Filmwerk und "Fernsehwerk" im österreichischen Recht. *Osterreichische Blätter für Gewerblichen Rechtsschutz und Urheberrecht*, vol. 21, no. 6 (Nov.-Dec. 1972), pp. 133-144.

A study of the cinematographic work and the "television work" in Austrian law, divided into the following headings: I. Introduction. II. Historical development of the cinematographic work: 1. Austria. 2. Germany. 3. Switzerland. III. Concept of the cinematographic work under Austrian law. IV. The author of the cinematographic work under Austrian law. V. Cinematographic work and television work. VI. Conclusion.

310. GOOSE, DIETER. Urheberrechtliche Probleme der Pressedatenbank. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 75, no. 1 (Jan. 1973), pp. 4-15.

An examination of questions, under the copyright law of the German Federal Republic, raised by the storage in, and retrieval of copyright protected material from, data banks, using the concrete example of a so-called press data bank in an attempt to answer the questions.

311. HANDL, JOSEF. Zur Novellierung des österreichischen Urheberrechtsgesetzes; gesetzliche Angleichungsregelungen. *Film und Recht*, vol. 17, no. 2 (Feb. 15, 1973), pp. 60-67.

An analysis of some of the principal features of the newly revised Austrian copyright law of December 29, 1972, most of the provisions of which become effective June 1, 1973.

312. KATZENBERGER, PAUL. Die Frage des urheberrechtlichen Schutzes amtlicher Werke. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 74, no. 12 (Dec. 1972), pp. 686-695.

A discussion of the question of copyright protection for official works under the copyright law of the German Federal Republic.

313. OTERO LASTRES, JOSE MANUEL. Das Mustergesetz für Entwicklungsländer zum Schutz von gewerblichen Mustern und Modellen. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 11 (Nov. 1972), pp. 407-413.

An introduction to, and the basic principles of, the *Model Law for Developing Countries on Industrial Designs*, and an analysis of its principal. See 18 BULL. CR. SOC. 464, Item 452 (1971).

314. PEDRAZZINI, MARIO M. Zur Revision des schweizerischen Urheberrechts; Vorbereitung einer gesetzlichen Gesamtreform. *Film und Recht*, vol. 17, no. 2 (Feb. 15, 1973), pp. 67-72.

A German translation of an article on the draft revision of the Swiss copyright law, an English version of which was published in the March 1972 issue of *Copyright* under the title "Letter from Switzerland." See 19 BULL. CR. SOC. 420, Item 283 (1972).

315. PUSCHEL, HEINZ. Gemeinschaftliches Eigentum der Ehegatten und Urheberrecht. *Neue Justiz*, vol. 26, no. 23 (1, Dezemberheft 1972), pp. 703-707.

A discussion of copyright questions involving community property rights of husband and wife under the laws of the German Democratic Republic.

316. ROEBER, GEORG. Neues Urheberrechtsgesetz in Luxemburg; Anpassung an Entwicklungen und Erkenntnisse im Zuge einer urheberrechtlichen Gesamtreform. *Film und Recht*, vol. 17, no. 2 (Feb. 15, 1973), pp. 72-75.

For the most part, a brief examination of the new Luxembourg copyright law of March 29, 1972, with special attention to the provisions dealing with cinematographic works.

317. UNGERN-STERNBERG, JOACHIM VON. Drahtfunk- und Rundfunkvermittlungsanlagen in urheberrechtlicher Sicht. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 75, no. 1 (Jan. 1973), pp. 16-17.

A discussion of the question whether there is any liability under the present copyright law of the German Federal Republic, on the part of the receiver of radio or television broadcasts who retransmits such broadcasts by wire or wireless.

C. ARTICLES PERTAINING TO COPYRIGHT IN TRADE MAGAZINES

1. United States

318. ASTRACHAN, ANTHONY. Concern voiced in U.S. at Soviet copyright law. *The Washington Post*, Mar. 23, 1973, p. A14.

An article on a divided American publishing industry's "first cautious response to what it calls 'dismaying reports' that Soviet adherence to the Universal Copyright Convention 'will be accompanied by repressive measures against Soviet authors.'"

319. Burch engaged in secret try at compromise on copyright for cables. *Broadcasting*, Apr. 9, 1973, p. 46.

An article on FCC chairman Burch's recent attempts to mediate the differences over cable-television copyright legislation, involving Senator McClellan, cable operators and copyright owners.

320. DOEBLER, PAUL. Proprietary rights problems confront micropublishers. (New media publishing) *Publishers' Weekly*, vol. 203, no. 12 (Mar. 19, 1973), pp. 52-54.

"Like other traditional publishers, those who issue new informational products in microform are finding a need to protect them from illegal copying. Because many micropublished products are compilations of public domain materials, they have special problems obtaining copyright protection and often must fall back on state unfair competition law."

321. Eyes turn hopefully to Congress after court's cable ruling; decision on distant signals fails to decisively solve problem in opinion of many observers. *Broadcasting*, Mar. 19, 1973, p. 117.

An article on the implications of the appellate decision, with particular emphasis on copyright revision, in the case of *Columbia Broadcasting System, Inc. v. Teleprompter Corporation*.

322. FRASE, ROBERT W. The meaning of value added import taxes on books. *Publishers' Weekly*, vol. 203, no. 12 (Mar. 19, 1973), pp. 36-37.

A discussion, in the light of a forthcoming intergovernmental conference of experts from all member countries of UNESCO "to review the application and the possible extension" of the Florence and Beirut Agreements, of the problem of the value added tax (VAT) and VAT equivalent import duties, using boxes as an example.

323. GARFIELD, EUGENE. Copyright revision bill requires priority action to meet needs of the information revolution. *Current Contents*, no. 16 (Apr. 18, 1973), pp. 5-8.

An article devoted mainly to the question of photocopying by libraries, with some solutions suggested.

324. HALL, MILDRED. Study Soviet copyright bid. *Billboard*, vol. 85, no. 12 (Mar. 24, 1973), pp. 1, col. 4; 10, cols. 3-5.

An article on the possible effect of the forthcoming adherence of the Soviet Union to the Universal Copyright Convention.

325. INFORMATION RETRIEVAL COLLOQUIUM, 9th, Philadelphia, May 1972. *Panel on Copyright*. The copyright controversy: issues and opinions. Stella Keenan & Mary E. Stillman, issue editors. Philadelphia, Graduate School of Library Science, Drexel University [1972], pp. 377-602. *Drexel Library Quarterly*, vol. 8, no. 4, October, 1972.

Devoted, for the most part, to the issues involved in the *Williams & Wilkins* case. The panelists were Mr. Irwin Karp, speaking for the author, Professor Julius J. Marke, speaking for the librarian, and Mr. Ben Weil, speaking as "an activist." Appendices (pp. 415-602) contain portions of the report on the case to the U.S. Court of Claims by Commissioner Davis, together with selected amici curiae briefs that were filed by organizations that represented different interest groups.

326. KAISER, ROBERT G. Making it in Moscow. *The Washington Post*, Mar. 25, 1973, pp. C1, C3.

An article on the extent of translation of American literature in the Soviet Union over the years.

327. Russia and UCC: how it looks from Moscow. *Publishers' Weekly*, vol. 203, no. 20 (May 14, 1973), pp. 31-32.

A summary of a report to American publishers and some of the major conclusions brought back by Mr. Curtis G. Benjamin, consultant to McGraw-Hill, "from a recent visit to the Soviet Union in which he discussed the implications of adherence to UCC with a wide range of Russian officials and experienced U.S. observers in Moscow. Mr. Benjamin was accompanied by Mr. Paul Gottlieb, president of the American Heritage Press Division of McGraw-Hill, who speaks Russian fluently and has a wide knowledge of Soviet affairs.

328. TELESIN, JULIUS. Inside "Samizdat." *Encounter*, vol. 40, no. 2 (Feb. 1973), pp. 25-33.

An article on the development of, and Soviet attitude toward, "samizdat," i.e., all kinds of texts which are produced unofficially in the Soviet Union and circulated through unofficial channels.

329. WAGNER, SUSAN. Goldman hails Soviet move on copyright — with reservations. *Publishers' Weekly*, vol. 203, no. 17 (Aug. 23, 1973), p. 49.

An article on the views of Abe A. Goldman, Acting Register of Copyrights, and several others, toward the forthcoming adherence of the Soviets to the Universal Copyright Convention, in which Mr. Goldman voiced concern over recent changes in Soviet copyright law, including a new "fair use" provision.

330. WAGNER, SUSAN. Senate bill would amend copyright laws to thwart Soviet action on dissident authors. *Publishers' Weekly*, vol. 203, no. 14 (Apr. 2, 1973), p. 26.

An article on S. 1359, the McClellan bill, "designed to prevent the Soviet government from appropriating or using U.S. copyrights to block publication of dissident Russian authors in this country."

331. WAGNER, SUSAN. A visit with Williams & Wilkins. *Publishers' Weekly*, vol. 203, no. 14 (Apr. 2, 1973), pp. 22-23.

An article which starts out giving the background of the Baltimore publisher of medical books and periodicals and finishes with the publisher's attitude about its copyright infringement case against the Government.

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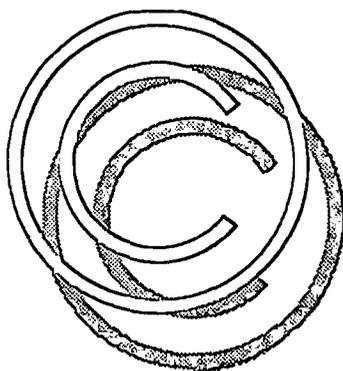
332. BAUMGARTEN'S BOOK ON SOVIET COPYRIGHT RELATIONS WITH U.S.

Jon A. Baumgarten's timely "*U.S.-U.S.S.R. Copyright Relations under the Universal Convention*", to be published by Practising Law Institute, New York, in July, will be a welcome discussion of the many questions now being asked in copyright circles on what may be expected in light of past experience with the Soviet Union. Mr. Baumgarten, well known to readers of the BULLETIN for his digests of decisions over the past five years, presents a full background of U.S.-U.S.S.R. relations in discussing the protection that will now become available to U.S. literary, musical, and graphic works, recordings, as well as works created or published prior to the Soviet adherence to the Universal Convention. The texts of the original Convention of 1952 and as revised in 1971 are also included. (Approx. 100 pages, vinyl cover, \$10.)

333. REVISION BILL INTRODUCED IN THE HOUSE.

A counterpart of the Senate Copyright Revision Bill was introduced in the House by Congressman Bertram L. Podell during the week of June 1, 1973. *Billboard* (June 9, 1973, p. 3) quotes Mr. Podell as saying, "In toto, this bill represents a workable compromise."

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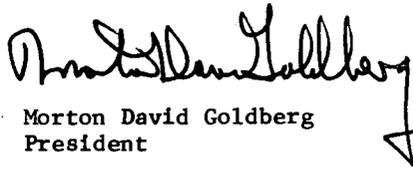
September 6, 1973

To Our Members:

Because of the rising costs of publication of The Bulletin, The Society, at the request of its Board of Trustees, has extensively reviewed its membership and dues structure. As a result, and in order to meet those increasing costs, it has adopted a new schedule of membership and dues, which is set forth below and which will commence with Volume 21, the first issue of which will be dated October, 1973.

We urge our members, in determining their respective dues categories, to bear in mind that The Society operates under a non-profit educational charter and is supported solely by dues and subscription income from The Bulletin.

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Morton David Goldberg
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PART I.

ARTICLES

334. SOME OBSERVATIONS ON CERTAIN CONSEQUENCES OF
THE SOVIET UNION'S ACCESSION TO UCC.*

By CURTIS G. BENJAMIN**

This report is submitted to the U.S. book industry as an effort to sort out and respond to some of the troublesome questions, misgivings, and fears that have bothered many authors, publishers, journalists, and public officials since the announcement of the U.S.S.R.'s accession to the Universal Copyright Convention, which becomes effective on May 27, 1973. It is based largely on a week of conferences and observations in Moscow (April 5-13) by Paul Gottlieb and me, who went there for a first-hand assessment of what could be learned at that early stage about prospects and problems of dealing with the Soviets under the new conditions of international copyright control. For my part, I have for some fifteen years been exhorting Soviet officials, whenever and wherever possible, on the desirability of their country's accession to an international copyright convention. For his part, Paul Gottlieb (who is President of American Heritage Publishing Company, a subsidiary of McGraw-Hill) has had considerable first-hand experience with Soviet people and affairs, dating back to 1959 when he was a student-guide at the historic U.S. exhibit at Sokolniki Park. Mr. Gottlieb, born in a Russian-speaking family, is fluent in the language. He has traveled widely in the Soviet Union on several occasions, and he has a deep interest in Soviet culture, politics, and social behavior. The two of us enjoyed the able assistance and guidance of Mr. Axel Krause, head of the McGraw-Hill World News bureau in Moscow, who has wide connections among Soviet journalists, intellectuals, and officials.

This report should be taken only for what it is worth as personal observations and opinions on certain emerging matters, some of which

* Submitted on April 27, 1973.

** Curtis Benjamin is former president and chairman and, presently, Consultant of McGraw-Hill, Inc. He served for many years as Chairman of the Book Industry Joint Copyright Committee; has been for several years a member of the State Department Advisory Panel on International Copyright, and was in 1962 Chairman of the State Department-sponsored Delegation of U.S. Book Publishers to the U.S.S.R.

will certainly remain unclear for some time to come. In sharing it with other interested individuals, our only purpose is to try to offset some of the confusion and uncertainty that has been generated by several uninformed or misinformed press reports which have been widely debated. We shall hope that this report will in no way add to the confusion or give rise to more controversy over conjectural and speculative matters.

In Moscow we had conferences, some quite lengthy, with the following:

1. Boris I. Stukalin, Chairman of the Press Committee of the Council of Ministers of the U.S.S.R., and two of his chief administrators for book publishing, S.S. Ivanko and V.V. Ezhkov, in charge, respectively, of belles-lettres and art publishing programs and of science and technology publishing programs. (The Press Committee has the governmental status of a ministry.)

2. The directors and chief editors of most of the larger publishing houses.

3. The acting President of Mezhdunarodnaia Kniga, Yuri Leonov, and several of his principal deputies and assistants. (Mezh-Kniga, for short, is the central export-import agency for books and periodicals.)

4. The deputy director, the editor-in-chief, and the chief of the Department of Foreign Literature of Novosti. (Novosti is the central "commercial" agency for the dissemination of Soviet news and information to foreign countries.)

5. The Charge d'Affaires of the U.S. Embassy, and a Cultural Affairs officer and the ranking Commercial Affairs officer.

6. Several generally knowledgeable U.S. Press correspondents, all old Moscow hands and all anxious to learn more about book publishing in general and about copyright, both domestic and international, in particular.

From these conferences, we deduced or sensed the following:

1. That the heads of the Soviet publishing houses, and their immediate administrative supervisors and editors-in-chief were uninformed and unprepared on the U.S.S.R.'s sudden decision to join UCC. Many of them still are uninformed on the basic purpose, principles, and practices of the Convention. Moreover, only a few of them were informed on the meaning and terms of the recent enabling revision of the Soviet copyright law, as decreed by the Presidium of the Supreme Soviet of the U.S.S.R. on February 28.

2. Many basic points with regard to the implementation of practices under the new law have not yet been sorted out and decided at higher levels. This is an unfamiliar task which probably will require several months for completion.

3. It may be several weeks or even months, before a decision is taken on the exact nature and placement of the announced centralized agency for handling international buying and selling of translation rights. It appears, however, that there are three possibilities: (a) A continuation of centralized commercial and contractual control by MezKniga; (b) A new agency in Chairman Stukalin's office; and (c) A new sub-agency in the MezKniga. It appears quite certain, however, that this agency will handle all contracts and payments, and it can be assumed that it will also serve as the political screening agency.

4. It probably will be several months before formal contractual arrangements for the licensing of translation rights will be possible. Meanwhile, publishing houses appear to be free to exchange information with U.S. publishers on their present publishing plans and to discuss general terms and conditions for acquiring rights.

5. It appears certain that the Soviets will be very hard-nosed in negotiating sales on a "best-offer" basis, or on a *quid pro quo* arrangement—meaning, "I will sell to you if you will buy from me." They are very sensitive to the threat of an imbalance of payments, and they warned that a heavy imbalance will not be tolerated at higher levels, either for the book industry generally or for an individual house.

6. It appears certain that, having to pay for translation rights in hard currency, their present volume of translation of U.S. books and periodicals will be cut back substantially. Also, they noted that their pipelines will be full of translations of books published prior to their accession to UCC; hence it will be at least one or two years before they will be looking for anything other than the exceptional work published after that date. Preference will be given to translations of the kinds of books that are needed for commercial, industrial, and agricultural development.

7. The Soviets plan to continue the present level of their large program for publishing English language editions of their own books (largely textbooks, reference books, and propaganda works) produced primarily for low-priced markets in developing countries in Southeast Asia, Africa, and Latin America. They do not feel a need for "outside help" in their world-wide distribution of these editions.

8. The Soviets are well aware of the fact that they are in a favorable position in the buyer-seller relationship. They can negotiate in selling rights with a number of houses, either U.S. or British, on a competitive basis; on our side a publisher can deal with only one Soviet state publishing house in a given area, so no competition comes into play.

9. The Soviets appear to be willing to *negotiate* contractual terms and conditions on a house-to-house and book-by-book basis. They assume, however, that all actual contracting will be done by the central All-Union agency and that all payments will be handled in the same way.

10. There appears to be a general acceptance of the fact that rights for translations into Soviet languages other than Russian will have to be negotiated separately.

It goes without saying that one or another aspect of copyright was the central point of almost every one of our formal conferences or informal discussions in Moscow. As expected, we found Soviet officials annoyed by the several speculative and conjectural stories that had appeared in the American press. Still they were willing to discuss the matters openly and to try to explain their views on certain points of misunderstanding or misinterpretation. Based on these discussions in Moscow and on earlier information from our State Department in Washington, the following observations are offered purely as personal opinions and interpretations.

1. The Soviet decision for accession to the UCC came about suddenly and unexpectedly, both here and there, as a *quid pro quo* concession in the trade agreement negotiations last fall. U.S.S.R. officials were anxious to gain a tax concession for the elimination of a withholding tax by the U.S. on amounts paid to the U.S.S.R. for certain items, including payments for industrial patent rights. Ex-Secretary Peterson was firm in saying that a final treaty containing such a tax concession certainly would not be approved by our Congress unless the U.S.S.R. was prepared to pay for the use of U.S. copyrighted materials. As the New York Times reported in its March 21 issue, the Soviet decision for UCC seemed to be the direct result of this confrontation.

2. It makes little sense to argue, as many have, that the major motivation for the decision was the desire to use the UCC as an international mechanism for further suppression of dissident Soviet writers. To begin with, there appears to be little need for additional means to that end—obviously, Soviet authorities already have certain well known internal powers to deal with the dissidents in other ways. Second, copy-

right would be a clumsy and exposed tool for suppression. Third, under UCC, the Soviets cannot possibly control any work that has not been first published in the U.S.S.R., nor can they claim any rights, suppressive or otherwise, in a work first published and copyrighted in another country. Fourth, it seems highly unlikely that the Soviets would get away with "tokenism" publishing as a repressive measure, or that they would even try to do so. In summary, it appears that any attempt to use copyright as a suppressive tool would expose the Soviets to international detection and censure of a kind which they are anxious to avoid at the present time of "détentism."

3. In spite of the foregoing comment, one can be sure that the Soviet authorities will use their accession to UCC for internal propaganda purposes, including the claim that it promotes wider dissemination of the works of writers faithful to Socialist ideals and further restrict writers who are traitors to those ideals. Everyone should recognize that this is the way the Soviet System works.

4. Some confusion and uncertainty was caused by the announcement that "further legislation" on U.S.S.R. copyright would be forthcoming. We were told that there will be no All-Union legislation in addition to the decree of the Presidium of the Supreme Soviet on February 21. The "further legislation" referred to will be revisions of the copyright laws of each of the Soviet Republics in order to bring them into conformity with the central law. Also, there will be further decrees for the *regulation* and administration of copyright affairs, but these will in no way change the basic law as revised by the decree of February 21. In any event, all Americans with whom we discussed the matter in Moscow were of the opinion that the Soviets would scrupulously observe all their explicit obligations under UCC.

5. There remains some doubt as to the exact meaning of the revised Article 103 (utilization of a work without author's agreement and without payment of compensation to author) which allows: "Reproduction of printed works for non-profit scientific and educational purposes." In an effort to test the translation of the language of this point, we asked a knowledgeable senior editor for distinctive definitions of two different words in the article, both of which appear as "reproduction" in our translated copy. He said that the first word "vosproizvedeniye," which was used generally in the article, was a generic term meaning reproduction of any kind, while the second word "reproduktivniye," which was used in Point 7 only, was a specialized term meaning "to make one perfect copy of a printed page without change." Then he

added that the English word closest to the latter would be "Xerox" or "photocopy." Next, we asked whether this definition would allow a university professor to make for his students 100 copies of a journal article or a chapter of a book. He replied, "Yes, but it is not likely that a machine or the necessary paper would be available to a professor for such use." And could the professor sell the copies to his students? "No, that would be criminal!" Then could he charge the students for the cost of reproducing the copies? "No. The copies would have to be given to the students at no cost. That is where the non-profit consideration would come." Thus it seems that even the Soviets are coming up against the nonprofit photocopying problem. In any event, it appears that Article 103 as revised is no more than a liberal version of our fair use doctrine. One official said that they were merely following British, Swedish, and Finnish practices.

6. When we asked about the reasons for the change in Article 101 wherein the word "heir" is replaced by "legal successors" and for the new language of Article 102, which permits the translation of work into another language only "with the consent of the author and his legal successors," the reply was, "merely to bring our law and practices closer into conformity with Western laws and practices." It seems that this response should be taken at face value, because neither change permits the Soviet government to do anything to suppress an author's rights that could not be done before. Since 1925 the All-Union copyright law has provided for possible "nationalization" of a Soviet author's work, either published or unpublished. ("Nationalization" as here used means an expropriation by the state of a private work, not of a work produced for the state or by a public agency.) In view of this pre-existing legislation, the new legislation has the appearance of increasing rather than diminishing the author's control of rights in his work, both domestically and internationally. However, only the test of time and actual experience will prove the point.

7. As to the often expressed fear of difficulty in dealing with a centralized agency for translation rights, one can only surmise that under the Soviet system of state monopoly, it probably would be much more difficult initially to deal directly with the individual publishing houses. Moreover, it is possible that after some experience with the centralized system, the authority will be decentralized. In any event, it seems that we should experience no more difficulty with the U.S.S.R. than we have had in dealing with the centralized systems of Yugoslavia, Czechoslovakia, and Hungary — where the difficulty has not been at all onerous.

The following is offered as a summary of our conclusions:

1. It will be several weeks, or even a few months, before the buying and selling of translation rights can be formally consummated.
 2. The Soviets realize that they have both a balance-of-payments problem and certain built-in trading advantages, so they will buy and sell closely. No one is likely to get rich quick in selling rights to them in the near future.
 3. The preponderance of overtly observable evidence indicates that further suppression of dissident writers was not the major consideration in the Soviet decision for accession to UCC.
 4. While the matter has not yet been clarified exactly, it appears that the provision for free use for nonprofit scientific and educational purposes (Article 103 of the revised Soviet law) is not as broad as some commentators have presumed it to be.
 5. It appears reasonable that the revisions providing for rights "legal successors" (Articles 101 and 102) were made for practical purposes, rather than the sinister intentions which some observers have feared.
 6. Publishing officials in Moscow seem to be ready and willing to carry on business with U.S. publishing houses as fully and freely as the differences in their and our economic and administrative systems will allow.
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335. STATUTORY COPYRIGHT PROTECTION FOR ANSWER SHEETS.

By HARRIET L. OLER*

I. INTRODUCTION

The Copyright Office has traditionally required, as a prerequisite to registering a claim to copyright, that the work contain a "substantial amount" of original literary, artistic, or musical expression.¹ This policy has been expressed in the Regulations as a preclusion of statutory copyright (and thus of registration) for "ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing"² and for works which are designed for recording information but which "do not in themselves convey information."³ In the latter category of works fall such items as time cards, graph paper, account books, diaries, bank checks, score cards, address books, report forms, and order forms, as well as answer sheets which lack original text and are unaccompanied by any other original textual matter.

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1. See, for example, Copyright Office Circular 32 "Blank Forms and Other Uncopyrightable Works" (April 1964) for a statement of the Office position.
2. Copyright Office Regulations, 37 C.F.R. § 202.1 (1966). The Regulation provides as follows:

Material not subject to copyright.

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

- (a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents;
 - (b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;
 - (c) Works designed for recording information which do not in themselves convey information, such as, time cards, graph paper, account books, diaries, bank checks, score cards, address books, report forms, order forms and the like;
 - (d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, and lists or tables taken from public documents or other common sources.
3. *Id.*

The Copyright Office has subjected such works to the standard tests of other "book" type material, and has registered them only if it finds substantial original literary expression or compilation authorship in the material comprising the unit of first publication.⁴ Of course, other types of original authorship, such as musical, dramatic or artistic authorship, could conceivably also qualify a work for registration under present Copyright Office standards. However, these kinds of creative expression are normally not present in answer sheets.

Two recent district court decisions may have called these Copyright Office practices into question. The earlier case, *Trebonik v. Grossman Music Corp.*,⁵ held copyrightable a guitar chord chart, while the more recent *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*,⁶ found that an answer sheet was a proper subject for statutory copyright. Although the latter decision may be explained by the presence of additional textual material sufficient to support a registration under present Copyright Office standards, both cases undeniably contain language which suggests lower and different standards of copyrightability for literary works from those currently employed by the Copyright Office.

The typical answer sheet, for which separate copyright might be claimed, consists of numbers corresponding to the numbers of questions in a question booklet, followed by a series of blocks or ovals coded alphabetically which may be darkened by the student to indicate his selection of a multiple choice answer for a given question. Groups of numbered blocks are organized under appropriate title headings, such as "Reading Skills", "Punctuation", "Spelling", etc. Answer sheets also contain blanks for recording the student's name, school, address, test date, birth date, and other standard testing information.

These works raise questions of interpreting the *Harcourt* decision in its most extreme extension: are answer sheets designed for recording multiple choice answers identified only by symbols and without substantial textual material or other traditionally acceptable "expression" registrable by the Copyright Office? Clearly such works do not contain a sufficient quantity of copyrightable expression to be registered under current Office standards. But are those standards viable?

Two principal arguments are advanced in support of protection for separate answer sheets containing only minimal literary or artistic ex-

4. Conference with Richard Glasgow, Chief of the Examining Division, on February 2, 1972.

5. *Trebonik v. Grossman Music Corp.*, 305 F. Supp. 339 (N.D. Ohio 1969).

6. *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*, 329 F. Supp. 517 (S.D.N.Y. 1971).

pression. The first is that such sheets contain substantial original expression in that their numbers, which correspond to the numbers of test questions and to the multiple choice answers, are symbols which incorporate by reference the words in the corresponding original test booklets, published somewhat earlier than the answer sheets. The numbers on the answer sheets are alleged to be code symbols which have meaning with reference to the test itself and are thus copyrightable.⁷ The second argument is that the format or arrangement of the works supports a copyright registration.⁸ The purpose of this paper is to examine recent case law, as well as the validity of arguments proffered in favor of copyright registration for separate answer sheets to determine whether such works are entitled to statutory copyright protection.

II. *Legal Precedents*

Recent cases in point are few and are of diminished precedent value in that they are the product of lower courts. *Trebonik v. Grossman Music Corp.*,⁹ was an action for copyright infringement whose outcome initially depended upon a ruling as to whether plaintiff's "Chord-o-Matic" was a proper subject for copyright protection. The work consisted of three concentric circles which could be rotated to depict various fingerings for guitar music chords. It was allegedly infringed by defen-

7. This claim harks back to plaintiff's argument in the Harcourt case that:

... the Harcourt Brace answer sheets constitute symbolic reproductions of the alternate answer selections which constitute a substantial portion of plaintiff's admittedly copyrighted test questions.

... [T]he student is advised that the letter or number stands for the particular answer response it precedes and when the student sees the same letter or number at the appropriate place on the answer document, he understands that it is merely a shorthand or translated version of a portion of the test question.

• • •

The recognition of such copyright protection is expressly set forth in the Copyright Act itself. Sec. 1(b) of the Copyright Act grants the owner of a copyright work the exclusive right '... to translate the copyright work into other languages or dialects or to make any other version....'

Plaintiff's Memorandum of Law at 19, 20, Harcourt, Brace & World, Inc. v. Graphic Controls Corp., 329 F. Supp. 517.

8. This argument was not raised by the plaintiff in the Harcourt case or accompanying briefs, though the Court considered it in its opinion as discussed *infra*.
9. *Trebonik v. Grossman Music Corp.*, 305 F. Supp. 339 (N.D. Ohio 1969).

dant's similarly organized booklet entitled "How to Play Rock and Roll Moveable Chords."

District Judge Lambros' opinion upheld statutory copyright protection for plaintiff's chart on the grounds of the originality exhibited in his arrangement of standard musical chords. He noted that there are from 700 to 1000 possible guitar chords and found plaintiff's work copyrightable because it was one of the few attempts to describe, organize and teach "a large portion of the available chords."¹⁰

It is difficult to determine, at this late date, just what quantity of original expression, apart from arrangement, was present in the *Trebonik* chart. The District Court opinion states that the chart contained one wheel which included "graphic illustrations of the fingering of various guitar chords,"¹¹ and that the guitar chord chart was "sold with a two-page instruction sheet explaining its operation."¹² Copyright Office records indicate that the work was registered in Class I (as a drawing or plastic work of a scientific or technical character) in 1947, but the deposit copy is no longer in the Office files. One therefore cannot determine whether the registered work included substantial text in the form of an instruction sheet.

The *Trebonik* decision may be evaluated both in terms of the authority upon which it is founded and the desirability of the practical result of its dictates. Interestingly, the sole legal authority cited as precedent for the court's finding of copyrightable authorship was the New York District Court's decision in *Pantone, Inc. v. A. I. Friedman, Inc.*¹³ From this case the *Trebonik* court derived its principal reasoning thus:

The test for determining copyrightability is originality; i.e., independent creation or individuality of expression, rather than novelty; and originality of even the slightest degree, even if it amounts to no more than a re-arrangement of age-old ideas, is sufficient.¹⁴

Again, citing *Pantone*, the court found the following infringement of plaintiff's Chord-o-Matic, after noting the similarity of organization of plaintiff's and defendant's works:

On the basis of the Court's factual finding that Palmer and Hughes (defendants) substantially copied the essential features of the Chord-

10. *Id.*, at 342-43.

11. *Id.*, at 341.

12. *Id.*

13. *Pantone, Inc. v. A. I. Friedman, Inc.*, 294 F. Supp. 545 (S.D.N.Y. 1968).

14. 305 F. Supp. at 346.

o-Matic's arrangement and organization, the Court finds that the Palmer-Hughes book infringes on the plaintiff's copyright. *Pantone, Inc. v. A. I. Friedman, Inc.*, *supra*.¹⁵

Is *Pantone* valid precedent for the *Trebonik* decision? In *Pantone*, the originality which sustained plaintiff's copyright was the arrangement and presentation of various colors, rather than the colors *per se*:

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 plaintiff's original creation.¹⁶

On the basis of his original arrangement, plaintiff succeeded in obtaining a preliminary injunction to restrain his business competitor defendant from publishing or selling a leaflet that contained a color matching system. Although this New York District Court opinion was not binding on the Ohio court in *Trebonik*, the latter was certainly free to adopt its legal dictates, since the copyrightability issue was similar.

A business competitor was also successfully sued for infringement in the Pennsylvania District Court's 1960 decision in *Amplex Manufacturing Co. v. A.B.C. Plastic Fabricators, Inc.*¹⁷ There, plaintiff's work was a catalog of "pen-and-ink line drawing" illustrations of plexiglass letters and other products sold by him. The court disclaimed the possibility of statutory copyright protection in the standard styles of lettering depicted, and instead found copyrightable subject matter in the arrangement and format of the work. Specifically, it found that plaintiff's illustrations showed "distinguishable variation in the arrangement and manner of presentation — the dark background, the particular size of the letters, their spacing, their arrangement into three rows. . . ." ¹⁸

Of course, it must be noted that the authority of the *Amplex* decision on the issue of the copyrightability of slight arrangements is weakened because this factor was not crucial to the court's conclusion; defen-

15. *Id.*, at 349.

16. 294 F. Supp. at 548.

17. *Amplex Manufacturing Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285 (E.D. Pa. 1960).

18. *Id.*, at 288.

dant was found to have copied illustrations of other products from the same catalog.¹⁹

The precedent value of *Amplex* on the arrangement issue is narrowed even further by a decision rendered by the same court two years later. In *Surgical Supply Service, Inc. v. Adler*,²⁰ price lists registered as commercial prints were denied protection by the court for want of a minimum degree of artistic or literary merit.

In the case at bar, there is a mere advertisement consisting of a bare list of articles and prices. The trial judge cannot, under any test of literary or artistic merit, find such advertisement to be the proper subject of a valid copyright. It clearly lacks the legal minimum of originality necessary for a copyright.

The catalogues or other advertisements held to be copyrightable had some originality or quasi-artistic character.²¹

This decision also read prior law as requiring that a work "be connected with the fine arts" to be copyrightable,²² suggesting that perhaps the *Amplex* case would have been decided differently were it not for the presence of the original pictures of products, augmented, perhaps, by the court's sympathies against commercial usurpation of plaintiff's work product by a business competitor.

More recently, the District Court for the Southern District of New York decided *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*²³ There plaintiff was granted a partial summary judgment upon a finding that his printed answer sheets, designed for use in student achievement and intelligence tests, and for correction by optical scanning equipment, were copyrightable "writings" within the meaning of the Copyright Law.²⁴

Tests of the type for which plaintiff's answer sheet was designed in the *Harcourt* case are designed so that only one answer, denoted by a single symbol, is correct.

The number of the question is repeated on the separate answer sheet next to a series of slots or spaces in which the student is to indicate his response, each slot being marked with the letter or

19. *Id.*

20. *Surgical Supply Service, Inc. v. Adler*, 206 F. Supp. 564 (E.D. Pa. 1962).

21. *Id.*, at 569.

22. *Id.*

23. 329 F. Supp. 517 (S.D.N.Y. 1971).

24. Copyright Act, 17 U.S.C. Sec. 4 (1964).

number corresponding to the alternative possible response appearing in the test booklet.²⁵

The format of the answer sheets is largely dictated by requirements of the optical scanning equipment used to correct them.

The format of the answer sheets is designed to meet the requirements of the optical scanning machine. These requirements are tailored to the needs of the specific scanning machine to be used—either the 'IBM 805' or the 'IBM 1230' or the 'Digitek' or 'MRC' machines. The machine's manufacturer recommends the size and the shape of the paper used for the answer sheet and the size and shape of the spaces in which the student is to record his response (rectangular boxes are most frequently suggested). The manufacturer provides master blanks as models or mock-up sheets for the design of any particular customer's answer sheet, and the grid area for these response spaces is limited and fixed by the 'timing marks' printed on the side of each answer sheet. The maximum number of answer spaces and the distance between the spaces is fixed by the scanning machine's capabilities.

The designer of a given answer sheet fashions the balance of the answer sheet's content within the confines of the master blank just described. He decides where on the page the student shall record such information as his name, the date, his school, teacher, and whatever other specific information may be desired. He determines which of the possible response spaces shall be used and which left blank within the grid area. He directs the placing of the numbers corresponding to the numbered questions in the test booklet, and the letters or numbers indicating the multiple choice responses. Separate sections of the page may be titled to correlate with the appropriate sections in the test booklet. Each answer sheet is given a title and code number by the designer to identify it both to the person administering the examination and to the person responsible for its scoring by means of the optical scanning machine.²⁶

The court recognized that these machine requirements necessarily limit the extent of original authorship in any work designed to comply with them. The limits of originality in designing such an answer sheet are defined by the court in the following terms:

25. 329 F. Supp. at 520.

26. *Id.*

To be sure, the area for originality of design is limited by the requirements of the optical scanning machine used. Thus the parameters of the field of creativity for designing of test sheets are defined by the timing marks on the side of the page, the shape and maximum number of response positions and whether they shall be set horizontally or vertically, the weight of the paper and the size of the sheet, and the number of lines per inch. However, within these confines the designer may structure the division of the response positions across the page, may ask what information (name, age, date, etc.) the student should record on the face of the answer sheet, may devise the symbolic code indicating what question is being asked and what possible alternative answer slots may be selected, may insert any instruction explaining how to use the answer sheet in conjunction with an examination, may set forth examples illustrating such use, etc. Accordingly, while limited in scope, the area for originality exists. The creation of an answer sheet requires the skill, expertise and experience together with the personal judgment and analysis of the designer or author.²⁷

The court's analysis led it to conclude, then, that "answer sheets may be substantially the same in appearance even when independently created,"²⁸ and that the concomitant "measure of protection resulting from the determination that answer sheets may be copyrighted is narrow"²⁹ because "the requirements of optical scanning machines are fixed, and severely limit the range for originality in each design of an answer sheet."³⁰

The outcome of this case seemed to be influenced by the Copyright Office's prior administrative action, which was arguably misinterpreted by the court. Namely, the Office had previously registered plaintiff's answer sheet *in conjunction* with a test booklet, which contained substantial amounts of original literary authorship and would have supported a book registration under present Copyright Office standards. The court accorded considerable weight to the Office's registration. For instance, the opinion began its discussion of the copyrightability of the answer sheet by saying:

The Copyright Act protects *properly registered* printed answer sheets created for use in conjunction with student achievement and

27. *Id.*, at 523.

28. *Id.*, at 518.

29. *Id.*, at 518, n. 1.

30. *Id.*

intelligence tests and designed to be corrected by optical scanning machines.³¹

In according such weight, it seems the court assumed the copyrightability of the individual elements included in the copyrighted work. This assumption is mistaken; for, in registering a work, the Copyright Office need not, and does not, delimit the extent of original authorship upon which the registration is made.³² Hence, as long as a work contains some original copyrightable authorship, registration will be made in spite of the doubtful nature of the copyrightability of other elements. The other elements are accepted as part of the unit of publication; i.e., the unit constitutes a complete copy of the "work" as first published.

The originality found in plaintiff's particular answer sheet was set forth in the *Harcourt* opinion:

Analysis of plaintiff's answer sheets also reveals that they convey information. On their face they inform a reader that they are designed to be the page upon which one records responses to an examination in a certain way; explanations and examples appear in the design of some answer sheets.

The sheets, of course, derive additional meaning from and by reference to the examinations with which they are used. Even without such reference, however, the symbols designating questions or response spaces are by themselves an expression which may be protected.³³

Thus, the court found that the answer sheets were protectible without regard to the accompanying booklets.

Furthermore, the decision that answer sheets may be separately copyrighted does not necessitate a finding that the sheets are integrally tied to the protection of the test booklet. An answer sheet could conceivably be created without reference to a test booklet and for use with any number of examinations.³⁴

Again, the court expressly rejected defendant's contention that plaintiff's work was not a proper subject of copyright protection under

31. *Id.*, at 522 (emphasis added).

32. *See*, for example, R. Crowley, "The Register of Copyrights as an Art Critic," 11 *ASCAP Law Symposium* 155 (1962).

33. 329 F. Supp. at 523.

34. *Id.*, at 519.

the rule of *Baker v. Selden*,³⁵ in that it was a blank form. Its position on this point also seems to have been influenced by the Copyright Office's prior registration of plaintiff's work.

The answer sheets here, alone, have their own meaning, convey information, involve original creation, have their uses, and are thus "writings" under the Copyright Act. In so ruling we do not accept defendant's argument that answer sheets are merely forms which may not enjoy copyright protection under 37 C.F.R. Section 202.1(c), or under the rule of *Baker v. Selden*, 101 U.S. 99, 25 L. Ed. 841 (1879), and *Taylor Instrument Companies v. Fawley-Brost Co.*, 139 F. 2d 98 (7th Cir. 1943). The regulations referred to, embodying the rule of *Baker v. Selden*, *supra*, provide that forms usable only for the recording of information are not copyrightable. *Here, the record indicates that the Copyright Office has registered separate answer sheets for copyright and thus has construed its own regulations contrary to the interpretation urged by the defendant.* More significantly, the answer sheets involved here are designed to guide the student in recording his answers; their particular format, in its clarity and convenience, is important to the successful completion of the examination. The expression is peculiar to each answer sheet, and it is this expression which the student reads, independently of the fact that later the completed answer sheet will be scored by an optical scanning machine.³⁶

It is true, as the court states, that by law, a certificate of copyright registration is *prima facie* evidence of the facts stated therein. This presumptive validity by statute extends *only* to the facts stated in the application, and does not extend to the question of the copyrightability of any particular portion of the subject matter involved.³⁷ But, in practice, courts seem to attach more weight than the statute prescribes to a Copyright Office certificate of registration. In this writer's opinion, the *Harcourt* court incorrectly assumed that the Copyright Office's willingness to register "multiple submissions" (including answer sheets)

35. *Baker v. Selden*, 101 U.S. 99 (1879).

36. 329 F. Supp. at 524 (emphasis added). Contrary to the statement by the court, the Copyright Office does not register separate claims to copyright in the ordinary answer sheet. Any separate registration would be predicated on an appreciable amount of textual material. The Copyright Office would not and did not separately register some of the answer sheets litigated in the *Harcourt* case.

37. 17 U.S.C.A. § 209, cited in the opinion *id.*, at 525.

as a unit work indicated a view that the answer sheets alone were proper subjects of statutory copyright.³⁹ In fact, the practice of the Copyright Office has been one of refusal to register answer sheets of the type involved in *Harcourt* by themselves, on grounds that they lack the required minimum quantity of original authorship necessary to sustain a registration under the present copyright law.

Similarly, the fact that the Copyright Office had, subsequent to the instigation of the *Harcourt* suit, registered answer sheets separate and apart from their accompanying test booklets would not seem to be valid precedent in the present case; nor would it seem to support the court's interpretation of Copyright Office practice. An examination of the separately registered works (*Howell Geometry Test*, registration number A86734; *Dubins Earth Science Test*, registration number A86735; and *Durrell Listening-Reading Series*, registration numbers A86736 and A86737) shows that each of these works contains a substantial amount of original descriptive and instructional text and/or artistic expression which would support a book registration under current Copyright Office standards. No such quantity of authorship is present on the deposit copies of the *Otis-Lennon Mental Ability Tests* involved in the *Harcourt* case. The answer sheets accompany the *Stanford Achievement Tests*, also involved in the *Harcourt* case, each contain a paragraph of instructions which might be separately registrable if the text were original.

From this examination, it seems clear that Judge Lasker in the *Harcourt* case upheld the copyrightability of certain answer sheets which were not separately registered by the Copyright Office but were parts of unit registrations partly on the basis that the Office later entered separate registrations for answer sheets very different in their quantities of original expression.

III. Conclusion

In conclusion, the copyrightability of separate answer sheets containing only minimal quantities of original text would have to be based on a finding of authorship either in the "arrangement" of numbers and symbols or on the theory that the numbers and symbols "translate" into copyrightable expression.

38. M. Nimmer, *Copyright* Sec. 139 (1971).

39. As explained in this paper, the answer sheets in litigation here were all parts of multiple part works which had been registered as units, though the court also admitted into evidence answer sheets by other publishers which had been separately registered after the inception of the *Harcourt* litigation.

The *Trebonik* and *Pantone* cases stand as authority for the proposition that arrangements of public domain material can support a claim to statutory copyright. Both are lower court decisions and discuss works comprised of the arrangement of substantial quantities of matter. The *Pantone* seventy-two page booklet offered "a series of over 500 gradual shade variations, each keyed to a basic color or mixture of basic colors,"⁴⁰ and the *Trebonik* work arranged some 700 to 1000 musical chords.⁴¹ Any argument favoring copyrightability for the ordinary answer sheet on the basis of an original arrangement would be weaker than for the above-mentioned cases. For, while the works involved in those cases were arrangements of *substantial quantities* of uncopyrightable elements, which might have been arranged or presented in an *infinite* number of ways, the same is not true for ordinary answer sheets. As was previously mentioned, the order and format of answer sheets is largely dictated by the requirements of the optical scanning equipment designed for their correction. Also, similar (though perhaps not identical) formats for answer sheets have long been in existence, which was not the case either in *Trebonik* or in *Pantone*. Arguably, for this reason, in the event of litigation, a court considering the copyrightability of separate answer sheets would not be swayed by sympathies against the use of a work by a business competitor as were the courts in those cases.⁴²

Another argument is that the answer sheets are "translations" in that they contain symbols (i.e., standard numerals or letters) which incorporate (by reference) the original matter in the corresponding test booklets. Thus, the answer sheets alone are allegedly copyrightable.

This argument is at the same time novel and unsupported by case law. Copyright protection traditionally has been either available or

40. 294 F. Supp. at 547.

41. 305 F. Supp. at 339, discussed *supra* pp. 6-8.

42. For example, in granting plaintiff's motion for a preliminary injunction to restrain defendant from copying and vending a like booklet, the *Pantone* court held that "plaintiff's mode of expression, combination and arrangement of colors in its booklet" possessed "sufficient originality and uniqueness" to qualify the work for copyright. "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 the already described unique quality which apparently gained ready recognition on the part of artists in a critical profession." 294 F. Supp. 548. Evidence showed that defendant business competitor distributed with his alleged copy of plaintiff's advertising booklet a cross-reference sheet designed to create the false impression that plaintiff's and defendant's color matching systems were interchangeable. *Id.*, at 550.

not depending upon the quantity of tangible expression evidenced on a work.⁴³ In no case has a symbol been held to incorporate the material which it represents.⁴⁴ If that were the case, in some future work a mere listing of letters or numbers might be registered on grounds that the component represented some unexpressed code. Such a policy arguably would unfairly restrict the public use and dissemination of standard symbols, letters, shapes, forms, etc. It would, in effect, result in the grant of limited monopolies for "ideas," without any sort of patent-type examination. That result has always been anathema to copyright.⁴⁵ It is submitted that for a court to consider a work copyrightable on the grounds of the incorporation by reference argument would be a complete reversal of present copyright standards, and that ordinary answer sheets are not so clearly deserving of separate protection as to justify this drastic change.

43. The rejection of qualitative standards for copyright protection was enunciated by Justice Holmes in the famous case of *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903) where, upholding copyright for a circus poster, he said:

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. * * * 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.

44. *Reiss v. National Quotation Bureau, Inc.*, 276 Fed. 717 (S.D.N.Y. 1921), found a code book copyrightable on grounds that the "writing of an author" need not be meaningful to qualify for protection under the law. However, the decision was based squarely on the tangible expression in the work in question; protection was not extended to the decoded words represented by the code book. See, *Hartfield v. Peterson*, 91 F.2d 998 (2d Cir. 1937) (code book held copyrightable on grounds that "the phrase, so far as they were his, and the arrangement were proper subjects of copyright." *Id.*, at 999); *Korzybski v. Underwood and Underwood, Inc.*, 36 F.2d 727 (2d Cir. 1929) (scientific relief diagram of system of symbols stated in *dicta* to be the proper subject of statutory copyright).
45. *M. Nimmer, supra* note 39, at Sec. 166 n. 1, citing *Holmes v. Hurst*, 174 U.S. 82 (1899); *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911); *Dymow v. Bolton*, 11 F.2d 690 (2d Cir. 1926); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930); *Dellar v. Samuel Goldwyn Inc.*, 150 F.2d 612 (2d Cir. 1945); *Gaye v. Gillis*, 167 F. Supp. 416 (D.C. Mass. 1958).

In sum, although answer sheets lacking appreciable original textual or pictorial authorship continue to be registered by the Copyright Office together with their accompanying test booklets as “units of first publication,” neither case law nor policy considerations warrant statutory copyright protection for such sheets standing alone.

336. ROSETTE v. RAINBO: *Its Impact on Copyright Law and the Music Industry*.*

By JANE BECKER GARZILLI**

During the past quarter century, law professors, the music industry and the copyright bar have frequently discussed and expressed concern over the following question: Is the distribution of phonograph records without copyright registration of the musical composition embodied thereon a "publication" that results in a loss of the common law copyright in the underlying composition and a dedication of that musical composition to the public?

In a thorough and creative decision, *Rosette v. Rainbo Manufacturing Corporation*,¹ Judge Gurfein recently addressed himself to this question. Balancing the practical needs of the music industry, the doctrine of federal preemption as set forth in *Sears*² and *Compco*³ and traditional copyright law interpretation, he concluded as follows: A phonograph record is not a "copy" of a musical composition and there is no "publication" divesting the composer of his common law right when the phonograph records are distributed, *but* failure to file notice of use precludes the owner from recovering for infringement until statutory copyright is obtained and notice of use is filed. This article will discuss the development of copyright law and the industry practices which led to the decision. In addition, certain problems which arise as a result of Judge Gurfein's apparently novel solution will be explored.

Although "publication" is nowhere precisely defined in the Copyright Act, the concept of publication has been characterized as "the heart of our present copyright system."⁴ When publication occurs, the author is divested of the plenary common law rights reserved to him in section 2 of the Copyright Act and is invested with statutory copyright rights and privileges, provided his work has been published with the proper notice. Section 10 provides that the notice must be "affixed

* © Jane Becker Garzilli, 1973.

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1. 354 F. Supp. 1183 (S.D.N.Y. 1973) (hereinafter cited as *Rosette*).

2. 376 U.S. 225 (1964) (hereinafter cited as *Sears*).

3. 376 U.S. 234 (1964) (hereinafter cited as *Compco*).

4. A. Latman, HOWELL'S COPYRIGHT LAW 61 (rev. ed. 1962) (hereinafter cited as HOWELL).

to each copy thereof published or offered for sale",⁵ implying that the distribution of a "copy" of the work is essential to publication.

The question of whether a pianola roll could be considered a copy of the musical composition embodied thereon was first considered in *White-Smith Publishing Co. v. Apollo Co.*⁶ The Court said in that suit for infringement that "we cannot think that [pianola rolls] are copies within the meaning of the Copyright Act."⁷ By analogy, one would not have infringed the exclusive right to copy the musical composition by reproducing it on a phonograph record either.⁸

Although Congress modified the practical results of the *White-Smith* decision by enacting the compulsory license provision⁹ the following year, it left the basic holding of the case and the concept of "copy" as interpreted by the Supreme Court intact. Since a phonograph record under *White-Smith* is not a copy of the underlying musical composition for purposes of infringement, proponents of the music industry's position have long asserted that "it follows that sale of a phonograph record is not the sale of a copy of the recorded work, and thus not a publication of the work."¹⁰ Therefore common law rights could be retained

5. 17 U.S.C. § 10.

6. 209 U.S. 1 (1908).

7. *Id.* at 18.

8. In *Corcoran v. Montgomery Ward & Co.*, 121 F.2d 572 (9th Cir. 1941), the court held that a phonograph record is not a "copy" of the underlying work for infringement purposes, thereby explicitly extending the *White-Smith* doctrine to phonograph records.

9. 17 U.S.C. § 1(e). In enacting the provision, Congress attempted to "accomplish the double purpose of securing to the composer an adequate return for all use made of his composition and at the same time prevent the formation of oppressive monopolies." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909). Prior to the *White-Smith* decision, many thought that the copyright proprietor retained exclusive mechanical rights in the musical composition. Congress feared that under such an interpretation, one company would buy up all such rights and form a great music trust. Thus, in basic respects it was content with the *White-Smith* holding that the copyright proprietor had no such exclusive rights. In rewriting the law, therefore, Congress sought to do no more than to modify the practical implication of the holding to assure the composer "an adequate return" for the use made of his composition. It did so by providing the copyright proprietor with the right to the first mechanical use and some set compensation for the later mechanical uses by others.

10. M. Nimmer, 1 NIMMER ON COPYRIGHT § 50.1, at 197-8 (1972) (hereinafter cited as NIMMER). Nimmer questions the necessity of defining "copy" in an identical manner for the purposes of determining whether infringement has occurred and whether an unpublished work has been published. The proponents of the music industry's position logically must rely on such an

in the composition even though there had been distribution to the public of phonograph records embodying the song.

Those supporting the music industry's position also rely on the basic rule that performance of a work does not divest common law copyright and constitute a dedication of the work to the public. This doctrine was first enunciated in *Ferris v. Frohman*,¹¹ a case concerned with public performance of a play. In *McCarthy v. White*¹² the *Ferris* rule was applied to the public performance of a musical composition. Because a record can be viewed as no more than a captured performance, it is argued that the sale of the phonograph records should be deemed a public performance.

The views and reasoning of the traditional copyright bar and the music industry set forth above formed the basis for the widespread practice of releasing records prior to registration or publication. Economic realities of the industry reinforced the practice. Music publishers were reluctant to go to the expense of publication until they had a chance to measure public reaction to a recording of the song.¹³ Although registration under section 12 as an unpublished work would have enabled the music publishers to measure a work's popularity through the release of a record prior to publication and certainly would have prevented dedication to the public,¹⁴ this method was rarely employed. Publishers continued to rely on common law protection under section 2, apparently "to avoid subjecting the recorded composition to the compulsory license provisions of Sec. 1(e), in an attempt to exploit a medium regulated by statute without submitting to that regulation."¹⁵ In view of several decisions in the late 1940's and 1950's which held that the sale of records embodying an unpublished, unregistered composition constituted a divestitive publication, many publishers have in

identity of definition of "copy". Note that it is now well accepted that different standards apply to determine whether "publication" has occurred depending upon whether the publication is divestitive or investitive. *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1957); HOWELL, *supra* note 4, at 61-62 and 65; NIMMER, *supra* note 10, § 59, at 227.

11. 223 U.S. 424 (1912).

12. 259 Fed. 364 (S.D.N.Y. 1919).

13. R. Burton, *Business Practices in the Copyright Field*, SEVEN COPYRIGHT PROBLEMS ANALYZED 87, 103 (1951) (hereinafter cited as Burton).

14. *Yacoubian v. Carroll*, 74 U.S.P.Q. 257, 258 (D.C.S.D. Cal. 1947), held that "The sale of phonograph records of a musical composition registered under Section 11 of the Copyright Act does not terminate its copyright protection." (What was then Section 11 is now Section 12). This reasoning was approved in *Shilkret v. Musicraft Records*, 131 F.2d 929 (2d Cir. 1942).

15. NIMMER, *supra* note 10, § 50.5, at 203.

recent years switched from reliance upon common law protection to section 12 registration as an unpublished work prior to the release of records.¹⁶ Nonetheless, a large number of compositions, particularly those recorded over twenty years ago, still rely solely on common law protection.¹⁷

As noted above, several cases decided fifteen to twenty-five years ago cast doubt on the wisdom of the theories and practices espoused and employed by the music publishers. The first of these decisions, *Blanc v. Lantz*,¹⁸ involved the well-known "Woody Woodpecker" musical laugh. The court in that case refused to apply the *White-Smith* concept of "copy" to the facts at hand and found that a phonograph record was a copy for purposes of divestitive publication. The court concluded that such reproduction "in tangible form for general distribution"¹⁹ amounted to a publication.

Numerous other sources²⁰ have also relied upon the "tangible" quality of a phonograph record in questioning the reasonableness of extending the *Ferris* rule, mentioned earlier, to phonograph records as a gender of public performance. Professor Benjamin Kaplan, for example, notes as follows:

The argument for refusing to give mere performance the status of "publication" on the ground that it is evanescent, creates no tangible things which can be the subject of purchase and sale, or is not a full communication since of itself it leaves no permanent memorial, seems to have little application to phonograph records; the more natural analogy is to a book or sheet music.²¹

In the *Rosette* case Judge Gurfein recognizes the pure logic leading to the conclusion that a phonograph record is not a performance, but

16. *Id.*

17. Burton, *supra* note 13, at 103, predicted in 1951 that if a Circuit Court ever held that sale of records divested common law rights "you [would] have the largest public domain this side of Venus . . ."

18. 83 U.S.P.Q. 137 (Cal. Sup. Ct. L.A. Co. 1949 (hereinafter cited as *Blanc*)); P. Morrison, *Copyright Publication: The Sale and Distribution of Phonograph Records*, 10 A.S.C.A.P. COPYRIGHT LAW SYMPOSIUM 387, 394 (1959) (hereinafter cited as *Morrison*), questions the weight which should be given this case because it deals with motion pictures, rather than records, and is based on a state statute which secures protection to the owner until he "makes it [the work] public."

19. *Blanc* at 140.

20. B. Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 479-481 (1955) (hereinafter cited as *Kaplan*); Selvin, *Should Performance Dedicate?*, 42 CALIF. L. REV. 40 (1954) (hereinafter cited as *Selvin*); Morrison, *supra* note 18, at 395-96.

21. Kaplan, *supra* note 20, at 480-81.

nevertheless chooses the more traditional interpretation. He observes that "[t]he argument that the permanency of the recording makes it more than a mere performance is an argument that the Congress did not accept or it could easily have made such an enactment."²²

Following *Blanc v. Lantz*, several district court decisions in the 1950's confirmed the case's reasoning by finding, all by way of dictum, that a phonograph record constituted a "copy" of the underlying musical composition for purposes of divestitive publication. The first of these decisions, *Shapiro, Bernstein & Co. v. Miracle Record Co.*,²³ written by Judge Igoe, caused great consternation among the members of the copyright bar and the music industry²⁴ in view of the large number of compositions which would have been thrown into the public domain had a higher court accepted Judge Igoe's interpretation of the law.²⁵ The same view of the issue was also announced in *Mills Music v. Cromwell Music*²⁶ by Judge Leibell and in *McIntyre v. Double A-Music Corporation*²⁷ by Judge Solomon. The reasoning in all three cases was similar:

When phonograph records of a musical composition are available for purchase in every city, town and hamlet, certainly the dissemination to the public is complete, and is as complete as by sale of a sheet music reproduction of the composition.²⁸

Nimmer is apparently comfortable with the view of the law expressed in *Miracle*, *Mills* and *McIntyre*. He finds the conclusion arrived at in those three cases "consistent with the common understanding of the term 'copy' . . . [and] in accord with the underlying rationale

22. *Rosette* at 1191-92. In so concluding, Gurfein probably relies on the legislative history of the 1909 Act, see *supra* note 9, which basically approved of the approach taken by the Court in *White-Smith*. Earlier in the opinion, Gurfein states that the "*White-Smith* result can also be rationalized as an opinion that mechanical reproduction is performance, like live performance, and is therefore, not publication."

23. 91 F. Supp. 473 (N.D. Ill. 1955) (hereinafter *Miracle*).

24. Burton, *supra* note 13, at 103; Tannenbaum, *Practical Problems in Copyright*, SEVEN COPYRIGHT PROBLEMS ANALYZED 7, 15 (1951); Schulman, *Authors' Rights, Id.*, at 19, 23-25; McDonald, *Id.*, at 31, 45-46.

25. See note 16 *supra*.

26. 126 F. Supp. 54 (S.D.N.Y. 1954). This case involved the song "Tzena, Tzena".

27. 166 F. Supp. 681 (S.D. Cal. 1958). Here the song was "Tonight You Belong to Me".

28. *Miracle* at 475.

of the publication doctrine.”²⁹ Judge Gurfein was more skeptical, however, noting that all three judges failed to make “any reference to *White-Smith* or the impact of the 1909 Act on its doctrine.”³⁰ As indicated earlier,³¹ such an analysis is crucial to an interpretation of the law consistent with traditional music industry practices. With the luxury of purely academic debate unavailable to him,³² Judge Gurfein was forced to make a choice. Basing his decision on the *White-Smith* concept of “copy” and the conventional view of a record as a performance, he selected the view of the law consistent with industry practice.³³

This choice, however, still left unanswered another important question: Must the scope of Section 2, which preserves plenary common law rights in unpublished works, be limited, in view of the doctrine of federal preemption, by the statutory scheme provided for and applicable to phonograph records embodying unpublished musical compositions registered under section 12?

Judge Gurfein answered this question affirmatively. In doing so, he softened the impact which the first part of the holding would have had, if it had stood alone. The solution adopted by Judge Gurfein was to limit the scope of section 2 protection to preclude an author relying upon it from recovering for infringement until statutory copyright is obtained and notice of use is filed. One relying upon section 2 would thus be in the same position for purposes of recovery for infringement as one relying upon section 12 for his protection. With respect to those relying on section 12 statutory protection, it had previously been held, in *Norbay Music, Inc. v. King Records, Inc.*,³⁴ that failure of a copyright owner to file the notice of use required by section 1(e) inhibits suits for infringement until notice of use is filed. The *Norbay* holding was thus applied in *Rosette* to musical works relying on section 2 for protection without forcing such works into the public domain. This

29. NIMMER, *supra* note 10, § 50.2, at 199.

30. *Rosette* at 1191.

31. See note 9, *supra*.

32. “On this modern version of a scholastic dialogue the law professors enjoy the disputation, but the judicial process must resolve the dispute one way or the other.” *Rosette*, *supra* note 1, at 1188.

33. This choice was consistent with a previous decision in the Southern District of New York, *Nom Music, Inc. v. Caslin*, 227 F. Supp. 922 (S.D.N.Y. 1964), *aff’d on other grounds*, 343 F.2d 198 (2d Cir. 1965) where Judge Cooper said, in dictum, that a record is not a copy of a musical composition and thus sale of the record does not constitute publication of the underlying composition.

34. 290 F.2d 617 (2d Cir. 1961).

compromise solution was adopted to preserve the supremacy of federal copyright law and to effect its policy.³⁵

Various authorities³⁶ had previously suggested that an all or nothing approach—to the question of whether a phonograph record was a copy of the underlying composition capable of publication—would likely have been inequitable and severe. Thus, Judge Gurfein's idea of retaining the traditional rule while restricting its impact was not entirely original. One author suggested that if the traditional rule that a record is not a copy capable of divestitive publication were to be changed, "they could change the rule prospectively, enforcing it in its old tenor only in those cases where the literary property involved had been acquired or created in reliance on it."³⁷

Kaplan, another such author, in 1955, was able to envision retention of the old rule with the possibility of a compromise through the limitation of the scope of section 2:

It is open to the courts to say that while sale of records does not automatically dedicate, neither is it a wholly colorless act without effect on the scope of the common law protection. Sale of records could be held to entail appropriate limitations of the composer's exclusive rights, limitations which could be given form by reference to the scope of the monopoly secured to works copyrighted under the Code but which need not follow the limits of that monopoly in all their details.³⁸

This solution was proposed by Kaplan shortly after Judge Learned Hand's prophetic dissent in *Capitol Records v. Mercury Records Corp.*³⁹ which foreshadowed the doctrine of federal preemption enunciated by the Supreme Court almost a decade later in *Sears*⁴⁰ and *Compco*.⁴¹ Nonetheless, Kaplan apparently believed that if his scheme were applied, it would be by common law courts because the "measure of rights to be accorded to unpublished works is essentially a matter for determination by the states."⁴² Thus, his proposal was based on equitable notions that to treat the "unexploited but unpublished song in

35. *Rosette* at 1193.

36. Selvin, *supra* note 20, at 51; Morrison, *supra* note 18, at 400; Kaplan, *supra* note 20, at 486-88.

37. Selvin, *supra* note 20, at 51.

38. Kaplan, *supra* note 20, at 487-88.

39. 221 F.2d 657 (2d Cir. 1955).

40. *Sears*, *supra* note 2.

41. *Compco*, *supra* note 3.

42. Kaplan, *supra* note 20, at 47.

the same way as the unexploited and unpublished book manuscript is to attach merely talismanic, not rational, significance to the concept of publication."⁴³

By contrast, Judge Gurfein's adoption of a scheme similar to that proposed by Kaplan was compelled primarily by the necessity of the application of the intervening *Sears-Compco* doctrine to the issue, as well as by considerations of what was just and fair. Judge Gurfein noted that together *Sears* and *Compco* made clear that a state cannot encroach upon federal copyright laws directly or indirectly by giving protection of a kind that clashes with the objectives of those laws.⁴⁴ It is interesting to note that Judge Gurfein foresaw a potential constitutional clash growing out of *Sears* and *Compco*, although he denied that distribution constituted publication, whereas Nimmer felt "the constitutional inhibition on these states is raised . . . only if sale of records is indeed a 'publication'."⁴⁵ Nimmer apparently viewed section 2, once deemed applicable, as plenary in scope.

Problems and inconsistencies arise out of Judge Gurfein's solution, suggesting that there may be a certain safety and wisdom in an uncompromising view of the scope of section 2 protection. In *Rosette*, the court observes that one relying on common law rights under section 2 is not required to file notice of use, whereas one who has chosen section 12 must do so. Noting that this places the latter at an apparent disadvantage, Judge Gurfein asks the following two questions:

Can the States, by virtue of the common law, constitutionally impose a lesser requirement when copyright has been vested by the Constitution in the national Government? Must the impediments to the free exercise of the statutory copyright be held to limit the exploitation of the common law copyright to the same degree?⁴⁶

Should Judge Gurfein, before answering the second question affirmatively, have explored its implications beyond the scope of the *Rosette* case?

For example, under the traditionally interpreted plenary scope of section 2, an author of an unpublished, unregistered musical composition would have the exclusive right to the work's public performance, whether for profit *or not*. One relying on section 12, however, would only have the exclusive right to inhibit the public performance if for

43. *Id.*

44. *Rosette* at 1192.

45. NIMMER, *supra* note 10, § 50.3, at 200.

46. *Rosette* at 1192.

profit.⁴⁷ Would the limitation on the scope of section 2 imposed by the *Rosette* decision logically extend to this situation, as well, depriving the author of the unpublished, unregistered work of the traditional common law right to restrain its not-for-profit public performance? Would the limitation, by further logical extension, restrict the term of copyright protection for an unpublished, unregistered work to a period of time, following sale of the records, no longer than statutory copyright?⁴⁸ If one answers the above two questions affirmatively, it appears to this author that there would be little if any meaning left to section 2 where an unpublished, unregistered musical composition reproduced on a record was in issue. When enacted in 1909, the Congress, as noted above, was extremely sensitive to the problems raised by mechanical reproduction and how they affected the author's rights in the underlying musical work. Had Congress intended an exception to section 2 for unpublished, unregistered musical works reproduced mechanically, would they not have explicitly so provided? Thus, it seems unlikely that Congress intended such a full exception to section 2 for all such works.⁴⁹

The idea of the limitation on the scope of section 2 solely to inhibit suit for infringement until statutory copyright is obtained and notice of use is filed is, however, consistent with legislative history. A large loophole would exist unless such a limitation is read into the Act, for one could retain exclusive rights in mechanical reproduction in a work never technically published, while at the same time exploiting the work through the sale of records. This could lead to the great music trust Congress explicitly tried to kill through enactment of the compulsory license provision.⁵⁰

47. 17 U.S.C. § 1(e).

48. Kaplan, *supra* note 20, at 488, hints at the extension of his proposed limitation of common law copyright into these two areas: "But it would not be anything to find that, upon sale of records common-law protection would extend for a period no longer than statutory rights; public performance of the composition not for profit would be held non-tortious." It should be remembered, however, that here Professor Kaplan envisions such rules being carved out by state courts as a matter of fairness, rather than by federal courts compelled to do so by the doctrine of federal preemption.

49. One should note, however, that in 1909 it was still essential to sell sheet music to profitably exploit a work. It might have been difficult for Congress to have foreseen a time when large profits could be derived from a musical work through record sales alone.

50. See note 9, *supra*. The fact that this loophole exists provides further confirmation that Congress found it difficult to imagine profitable exploitation of a work solely from mechanical means. See note 49, *supra*.

Such a limitation also looks ahead to and would be consistent with enactment of the proposed Copyright Revision Bill,⁵¹ where both published and unpublished works would be subject to the terms of the Act.⁵² The compulsory license provision⁵³ would apply to both published and unpublished musical works; "notices of intention to obtain compulsory license"⁵⁴ would have to be filed for both; and both would have to be registered with the Copyright Office to collect royalties under a compulsory license.⁵⁵ Furthermore, the Bill provides that "the owner is entitled to royalties for phonorecords made and distributed after he [has registered] but he is not entitled to recover for any phonorecords previously made and distributed."⁵⁶ These provisions are strikingly similar to Judge Gurfein's resolution of the problem posed by the current Act in *Rosette*.

All things considered, the *Rosette* holding appears to have been creative, fair, and wise. Judge Gurfein's decision: (1) expresses a view of "copy" and "publication" consistent with traditional copyright interpretation, (2) takes into consideration the practical needs of the music industry, (3) reflects the intention of Congress as indicated by legislative history, (4) resolves the constitutional problems posed by *Sears* and *Compco* and (5) anticipates the requirements of the proposed Copyright Revision Bill. Assuming no higher court feels compelled to extend Judge Gurfein's limitation on the scope of section 2 beyond the boundaries he has delineated, he will be credited with fashioning a fresh and workable solution to an old and difficult problem in copyright law.

51. S. 644, 92nd Cong., 1st Sess. (1971).

52. *Id.* at § 104 (a).

53. *Id.* at § 115(a).

54. *Id.* at § 115(b).

55. *Id.* at § 115(c) (1).

56. *Id.*

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. United States of America and Territories

337. U.S. CONGRESS. HOUSE.

H.R. 8186. A bill for general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. Podell, May 29, 1973, and referred to the Committee on the Judiciary. 85 p. (93d Cong., 1st Sess.)

A companion bill to S. 1361. See 20 BULL. CR. SOC., 247, Item 191 (1973). In an extension of remarks on his introduction of the bill (119 *Congressional Record* H 4060 (daily ed. May 29, 1973)), Congressman Podell states that “[a]fter all these years of delay, I hope that 1973 will be the year of this omnibus copyright reform. Our writers, composers, and other creative artists have been waiting for this revision for a long time.”

338. U.S. CONGRESS. HOUSE.

H.R. 8240. A bill to amend title 39 and title 18, United States Code, to provide for licensing and protection of distinctive designs, legends, and insignia of the United States Postal Service. 3 p. (93d Cong., 1st Sess.)

A proposal for the establishment and collection by the Postal Service of “use or royalty fees for the manufacture, reproduction, or use of any distinctive design, legend, or insignia originated under authority of and certified by the Postal Service for use in connection with the operation of the Postal Service.” It is also proposed to make it a criminal offense subject to fine or imprisonment or both for the unauthorized use of such designs, legends, or insignia, “in such a manner as is likely to cause confusion, or to cause mistake or to deceive.”

339. U.S. CONGRESS. SENATE. *McClellan, John L.*

Soviet copyright law. *Congressional Record*, vol. 119, no. 82 (daily ed., May 31, 1973), pp. S10047-S10049.

Additional remarks in connection with Senator McClellan's introduction, on March 26, of S. 1359. Articles reprinted from the *New York Times* and *Time* magazine are included, indicating the concern of Soviet authors and intellectuals that the purpose of Soviet ratification of the U.C.C. was primarily to facilitate the suppression abroad of writings of dissident Soviet authors.

340. U.S. LIBRARY OF CONGRESS.

Annual report of the Librarian of Congress for the fiscal year ending June 30, 1972. Washington, 1973. 147 p.

A survey of activities in the Library of Congress, including the *Annual Report of the Register of Copyrights*, which contains 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 June 30, 1972.

2. Foreign Nations

341. GERMANY (FEDERAL REPUBLIC, 1949-) *Laws, statutes, etc.*

Law amending the Copyright Act. (Of November 10, 1972). *Copyright*, vol. 9, no. 5 (May 1973), pp. 88-89.

An English translation of amendments, effective January 1, 1973, of sections 26, 27, 46, and 135 of the copyright law of the German Federal Republic.

342. GREAT BRITAIN. *Privy Council.*

The Copyright (Hong Kong) Order, 1972. (No. 1724, of November 14, 1972, coming into force on December 12, 1972). *Copyright*, vol. 9, no. 5 (May 1973), pp. 91-93.

"This Order extends the provisions of the Copyright Act 1956 with certain exceptions and modifications to form part of the law of Hong Kong.

"The Order also extends three Orders in Council made under Part V of that Act. The extension of these Orders will give protection in Hong Kong to works originating in countries party to International Copyright Conventions, to works produced by certain international organisations and to lawfully authorised broadcasts originating in other Commonwealth countries to which the 1956

Act has already been extended. Broadcasts by Hong Kong organisations will also have protection in Hong Kong and in those countries by virtue of this Order.

“The copyright protection given by the law of Hong Kong will be similar to that by the law of the United Kingdom.”

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

343. Convention for the Protection of Producers of Phonograms against Unauthorized Duplication of their Phonograms.

State of ratifications, acceptances and accessions up to 10 February 1973. *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1973), pp. 16-17.

344. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.

State of ratifications, acceptances and accessions up to 10 February 1973. *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1973), pp. 10-14.

345. UNIVERSAL COPYRIGHT CONVENTION.

Universal Copyright Convention adopted at Geneva in 1952 and annexed Protocols 1, 2 and 3: State of ratifications, acceptances and accessions up to 10 February 1973. *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1973), pp. 3-8.

346. UNIVERSAL COPYRIGHT CONVENTION. Revisions, 1971.

Universal Copyright Convention as revised at Paris on 24 July 1971 and annexed Protocols 1 and 2: State of ratifications, acceptances and accessions up to 10 February 1973. *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1973), pp. 8-9.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

I. Federal Court Decisions.

347. *Mercury Record Productions, Inc., et al. v. Economic Consultants, Inc., et al.*, Not yet reported (U.S. Dist. Ct., E.D. Wisc., July 11, 1973).

In view of the potential significance of this case, particularly in light of other recent decisions in the area of record and tape "piracy" see, e.g., *Donald Goldstein, et al. v. State of California*, 177 USPQ No. 12, Part II (June 18, 1973), 20 BULL. CR. SOC. 345, Item 274 (1973)), the BULLETIN here publishes the text in full.

The plaintiffs, nine record recording studios, initiated this action in the Circuit Court of Milwaukee County. They allege that the defendants are making tape reproductions of certain of their recordings and selling them to the public in competition with plaintiffs. These reproductions were made without the consent of the plaintiffs or the particular recording artists. No payment was made to the company or artist. Plaintiffs allege that this practice violates the state's unfair competition laws and that it is an infringement of plaintiff's common law copyright. Defendants removed the action to this court. It is before me now on plaintiffs' motion to remand and defendants' motion to amend the removal petition. I grant the plaintiffs' motion to remand.

Section 1441(b) of Title 28 of the United States Code provides for the removal of "[a]ny civil action of which the district courts have original jurisdiction founded on a claim or right arising under the Constitution, treaties or laws of the United States * * *." In order to remove an action to federal court under this section, the federal ground must either appear in the complaint or federal law must dominate the subject area so thoroughly that it must necessarily control the outcome of the case. IA Moore's Federal Practice at 472-481. The question in this case is whether the unfair competition or the common law copyright claim satisfies either of these criteria.

On its face, the allegation that state unfair competition laws have been violated clearly provides no federal ground for removal. Defendants contend, however, that in this case the result must depend on relevant copyright laws which are solely within the province of the federal government. They argue that *Sears, Roebuck and Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), require this result. In *Sears* and *Compco* the Supreme Court held that states could not use their unfair competition laws to prevent manufacturers from copying items which could not be patented under federal law. It follows, defendants feel, that federal copyright law prevents the states from stopping individuals from copying noncopyrightable musical recordings.

This issue has been specifically dealt with by several courts. In *Tape Industries Association of America v. Younger*, 316 F.Supp. 340 (1970), a nonstatutory three-judge court refused to hold California's "tape-piracy" law unconstitutional because it regulated an area pre-empted by the federal copyright laws. The judges distinguished between "copying" and "appropriating" and felt that tape pirating fell into the latter category. In *Tape Head Company v. R.C.A. Corporation*, 452 F.2d 816 (1971), the Tenth Circuit Court of Appeals specifically found that *Sears* and *Compco* did not apply in a similar set of circumstances. 452 F.2d at 819, footnote 1. A district court in Florida, however, held in *International Tape Manufacturers Association v. Gerstein*, 344 F.Supp. 38 (1972), that a Florida statute making it a crime to "pirate" sound recordings was unconstitutional. The Court in *Gerstein* felt that *Sears* and *Compco* implied that a state could not prevent individuals from copying a recording which was not copyrighted.

I agree with the majority. I think that *Gerstein* pushes the logic of *Sears* and *Compco* too far. The distinction between copying and appropriating is, under the circumstances of this case, extremely subtle, but it is a valid distinction. It may be in the public interest to make nonpatentable or noncopyrightable ideas, designs, or compositions freely available to the public. It does not follow, however, that when a manufacturer uses its money, personnel, and technical expertise to produce a merchantable product, the final product may be used by anyone without limitation. I believe that record manufacturing companies attain an interest in their recordings which may be protected by state unfair competition laws.

The alleged violation of plaintiffs' common law copyright also fails to provide a federal ground for removal. Federal copyright

law in wholly statutory. *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908). Common law copyrights may be regulated by the states and provide no basis for original federal jurisdiction. *Wells v. Universal Pictures Co.*, 166 F.2d 690 (1948); *Smith v. Paul*, 345 P.2d 546, 554 (Cal. 1959). Therefore, to the extent that plaintiffs have a common law copyright in their recordings, an action for infringement of that copyright is properly brought in the state court.

I am also granting defendants' motion to amend the removal petition, but the amendment does not change the outcome of my decision to remand the action. Title 28, § 1338(b) of the United States Code provides for original federal jurisdiction over "any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trademark laws." The copyright law referred to in § 1338 is federal statutory law. See *Hurn v. Oursler*, 289 U.S. 238 (1933); *Musher Foundation v. Alba Trading Co.*, 127 F.2d 9 (2d Cir. 1942). The complaint in this action raises no issue of federal copyright law. Therefore, this court would not have original jurisdiction in this action under § 1338, and that section provides no justification for removal.

For the above reasons,

IT IS ORDERED that plaintiffs' motion to remand this action to the Circuit Court of Milwaukee County, Wisconsin, be and it is hereby granted.

IT IS FURTHER ORDERED that defendants' motion to amend the removal petition be and it is hereby granted.

PART V.

BIBLIOGRAPHY

B. LAW REVIEW ARTICLES

1. United States

348. AARON, BARRY L. Copyright law—record piracy: compliance with the compulsory license provisions of the Copyright Act does not permit one to pirate an identical copy of another's recordings; recording equipment used to make the infringing copies is subject to impoundment under the Act. *Brooklyn Law Review*, vol. 39, no. 3 (Winter 1973), pp. 730-740.

A comment on *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 20 BULL. CR. SOC. 116, Item 74 (9th Cir), cert. denied, 409 U.S. 847 (1972).

349. ECLAVEA, ROMUALDO P. Annotation: Liability as "vicarious" or "contributory" infringer under Federal Copyright Act. *ALR Federal, Annotated*, vol. 14, pp. 825-844.

"The primary question treated in this annotation relates to the circumstances under which liability for copyright infringement may be imposed on one who is not a direct, primary participant in the infringement."

350. Educational media producers discuss copyright licensing. *BNA's Patent, Trademark & Copyright Journal*, no. 133 (June 21, 1973), pp. A16-A19.

A summary of discussions at an "Open Forum" on "Licensing of Copyrighted Materials," sponsored jointly by the Bureau of National Affairs and producers of audio-visual materials and firms engaged in creating and marketing information products. The meeting, held in Washington, D.C., June 18-19, 1973, was moderated by Morton David Goldberg, Esq.

351. FIFER, SAMUEL. United States v. Midwest Video Corp.—cable television and the program origination rule. *DePaul Law Review*, vol. 22, no. 2 (Winter 1972), pp. 461-480.

A comment on the *Midwest Video Corp.* case, 406 U.S. 649 (1972), *rev'g* 441 F.2d 1322 (8th Cir. 1971).

352. RUDOLPH, GILBERT L. Administrative law—communications—radio and television—FCC's jurisdiction over CATV under the Communications Act of 1934 includes authority to impose program origination requirements. *University of Cincinnati Law Review*, vol. 41, no. 4 (1972), pp. 983-996.

A note on the decision in *United States v. Midwest Video Corp.*, 406 U.S. 649 (1972), with a conclusion that it "represents a significant step toward full recognition of the potential of CATV and the extensiveness of the FCC's power over Community Antenna Television Systems."

353. SAIDMAN, PERRY J. Copyrights: novelty or originality? *Journal of the Patent Office Society*, vol. 55, no. 5 (May 1973), pp. 314-339.

"Submitted in partial fulfillment of the course requirements for Advanced Topics in Patent Law at the George Washington University National Law Center . . . Spring, 1972." A critical comment on the dissent of Justice Douglas from a denial of certiorari by the rest of the Court in *Lee v. Runge*, 404 U.S. 887 (1971), in which he argued that no reason can be offered for the application of "more lenient constitutional standards to copyrights than to patents."

2. Foreign

1. In English

354. DIETZ, ADOLF. The social endeavors of writers and artists and the copyright law. *IIC*, vol. 3, no. 4 (1972), pp. 451-471.

An outline of "the approximate field in which the economic and social situation of authors can be achieved with the help of the copyright law." The original German version appeared in 74 GRUR 11 (1972) under the title "Die sozialen Bestrebungen der Schriftsteller und Künstler und das Urheberrecht." See 19 BULL. CR. SOC. 422, Item 291 (1972).

355. United Nations Educational, Scientific and Cultural Organization. *General Conference, 17th Session, Paris, October-November 1972*. [Documents] *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1973), pp. 33-37.

Contents: Resolution concerning possible satellite convention. Report on the desirability of modifying existing conventions or preparing a new international instrument on the protection of television signals transmitted by communications satellites.

2. In French

356. FINKELSTEIN, HERMAN. Le droit d'auteur et la législation antitrust aux Etats-Unis. *Il Diritto di Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 524-528.

A brief report on the consent decrees governing the licensing of performing rights by ASCAP and BMI, made at the 28th Congress of CISAC, Mexico, October 1972.

3. In French, English and Spanish

357. AMRI, ABDERRAHMANE. Les problèmes des sociétés d'auteurs dans les pays en voie de développement. *Interauteurs*, no. 183 (1972), pp. 87-106.

A brief report on the problems of authors' societies in developing countries, made at the 28th Congress of CISAC, Mexico, October 1972. The French version also appears in *Il Diritto d'Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 515-524.

358. GAUDEL, DENISE. Les vidéogrammes à la recherche de leur identité. (Droit français—Convention de Berne). *Revue Internationale du Droit d'Autoreur*, no. 76 (Apr. 1973), pp. 2-53.

A study of problems raised in the field of literary and artistic property, under French law and the Berne Convention, by the exploitation of audio-visual works in the form of video-cassettes, covering on the one hand the legal status of such works and on the other the application of the economic rights of authors.

359. SANCTIS, VALERIO DE. L'avenir du droit d'auteur international à la lumière des Conférences de revision de juillet 1971. *Interauteurs*, no. 183 (1972), pp. 39-63.

A report on the future of international copyright in the light of the simultaneous conferences in July 1971 at Paris for revision of the Universal Copyright Convention (1952) and the Stockholm text (1967) of the Berne Copyright Convention.

360. UCHTENHAGEN, ULRICH. Le droit des auteurs qui créent des oeuvres sur commande ou en execution d'un contrat de travail. *Inter-auteurs*, no. 183 (1972), pp. 103-114.

A brief survey of the principal legislative formulae governing relations between authors, on the one hand, and those who employ them or commission works from them, on the other. Proposals are made for a system of presumptions when contracts concluded between the parties are so incomplete that their interpretation is very difficult.

4. In German

361. KELBEL, GÜNTER. Der Schutz typographischer Schriftzeichen; Bericht über die Sitzung des Sachverständigenausschusses vom 18.-23. März 1972 in Genf. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 2 (Feb. 1972), pp. 66-67.

A report of the sixth meeting of the Committee of Experts for the Study of the Protection of Type Faces, held at Geneva in March 1972 under the auspices of WIPO. This meeting constituted the last step prior to the Vienna Diplomatic Conference on Industrial Property, May 17 to June 12, 1973, for considering, among other matters, the revised draft Agreement for the Protection of Type Faces and their International Deposit prepared by the Committee of Experts.

362. MAUNZ, THEODOR. Das geistige Eigentum in verfassungsrechtlicher Sicht. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 75, no. 3 (Mar. 1973), pp. 107-115.

A study of constitutional aspects of the protection of intellectual property in the German Federal Republic.

363. PETER, FRANZ WILHELM. Beitritt der Sowjetunion zum Welturheberrechtsabkommen; Klarstellungen und Ungewissheiten. *Film und Recht*, vol. 17, no. 4 (Apr. 15, 1973), pp. 166-170.

Explanations for and unanswered questions about, the Soviet Union's recent accession to the Universal Copyright Convention.

364. RUMPHORST, WERNER. Das Filmurheberrecht in den USA. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 1 (Jan. 1973), pp. 10-17.

An examination of motion picture copyright in the United States, including a "glance" at the pertinent provisions of the pending copyright revision bill.

365. ULMER, EUGEN. Die Beitritt der Sowjetunion zum Welturheberrechtsabkommen. *Gewerblicher Rechtsschutz und Urheberrecht*, no. 3 (Mar. 1973), pp. 93-95.

An article on the recent accession of the Soviet Union to the Universal Copyright Convention.

366. UNGERN-STERNBERG, JOACHIM VON. Die Wahrnehmungspflicht der Verwertungsgesellschaften und die Urheberrechtskonventionen. *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 2 (Feb. 1973), pp. 61-65.

A study of the range and application of international copyright conventions with respect to article 6 (1) (Rights and Duties of a Collecting Society) of the Act dealing with the administration of copyright and neighboring rights of the German Federal Republic.

5. In Italian

367. ALGARDI, ZARA. Nota in tema di parodia e particolarmente di parodia dell'opera inedita. *Il Diritto di Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 391-408.

A discussion of the problem of parody-infringement under the Italian copyright law, with particular emphasis on parodies of unpublished works.

368. GALTIERI, GINO. Pubblico dominio e film d'archivio. *Il Diritto di Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 409-415.

A case is made for the proposition that motion pictures stored in film archives are in the public domain under Italian laws.

369. LEONELLI, LEONELLO. Il contratto di edizione musicale. *Il Diritto di Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 428-441.

An article on legal problems involved with respect to publishing contracts for musical works under the Italian copyright law.

370. MOSCON, GIORGIO. Una tesi sul diritto morale dell'autore alla diffusione delle opere. *Il Diritto d'Autore*, vol. 43, no. 4 (Oct.-Dec. 1972), pp. 416-427.

A comment on a leading decision of a court in Venice, involving the question whether the distribution or exhibition of a work, without the consent of the author, after it had been lawfully acquired, was a violation of the moral right of the author.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

371. U.S. writers big in U.S.S.R.: Oates joins Jack London. *Publishers Weekly*, vol. 204, no. 3 (July 16, 1973), pp. 90-91.

Some statistics on the number of translations of American authors published in the Soviet Union, revealed in a recent interview given by Mr. Boris Stukalin, the Soviet minister responsible for publishing affairs.

372. WAGNER, SUSAN. Publishers may face a "real rumble" on copyright. *Publishers Weekly*, vol. 204, no. 2 (July 9, 1973), pp. 34-35.

An article on the current uncertain status of general revision on the copyright laws, with reference to the controversial fair use issue between publishing and education and library people.

NEWS BRIEFS

373. SENATE REVISION HEARINGS HELD ON JULY 31-AUGUST 1.

Senate hearings on the general copyright revision bill, S. 1361, were held on July 31-August 1. The only issues scheduled to be heard were library photocopying, including general educational exemptions, and cable television rights. No hearings were held on certain issues that may seem highly controversial to the music recording and publishing industries, according to Copyrights Subcommittee Counsel Tom Brennan.

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H.R. 3152, January 29, 1973. A bill relating to the income tax treatment of charitable contributions of copyrights, artistic compositions, or a collection of papers	186	245
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